

AsiaIP

INFORMED ANALYSIS



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MONEY MATTERS

While trademark registration and litigation are troublesome, the financing aspect of the two is even more so.

IP MATTERS TO REMEMBER WHEN THE COMPANY IS ON THE VERGE OF CLOSING DOWN

If Covid-19 has forced you out of business, your IP probably still has value.

WHAT TECH STARTUPS NEED TO KNOW IN THIS TIME OF PANDEMIC

Although opportunities in some industries have dried up during the pandemic, tech startups are booming.

CARE TO SHARE? THE PROS AND CONS OF IP SHARING

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Money, money, money

We've spent a fair amount of time lately looking at money.

Not just money, generally, though we *do* miss the look and feel of having different currencies in our pockets as we cross borders visiting lawyers around the region.

Instead, we've been exploring how money and intellectual property intersect, because it has become an increasingly vivid intersection.

Intellectual property owners have long been divided into two main camps. Many believe that protecting IP is a cost centre; this was, indeed, a long-held view stemming from the nascent days of intellectual property protection. More recently (and many more people, we believe) now see IP protection as an investment in a company's assets – and in a company's future.

We have three stories in this month's issue focusing on IP and money, all of which seem quite relevant in the midst of a global economic slowdown.

First, Johnny Chan takes a look at why IP owners should not allow the slowdown to act as an excuse to stop spending money on IP protection. We all know that during hard economic times, client budgets can often drop – and, sometimes, very quickly. “The financial departments of many major brand owners in luxury and fashion goods often see the IP enforcement budgets as a cost rather than as an essential part of maintaining the brand integrity and exclusivity,” John Eastwood, a partner at Eiger in Taipei, told us. “For law firms, it's important to be creative to find solutions. For example, we had a European luxury group whose enforcement team lost half their budget during an economic downturn. We worked with them to find cheaper ways to get more value.”

In the second part of our cover package, Excel V. Dyquiango, examines how the coronavirus pandemic, while pinching budgets in the short-term, can result in increased “IP values” for some industries.

“All the IP assets related to companies that have embraced the challenge of the health emergency and launched themselves into the research arena – vaccines, testing, tools, masks or any medical device somehow related to the health emergency – are greatly on the rise,” notes Fabio Giacomello, a partner at HFG Law and Intellectual Property in Shanghai, who was quick to point out that the Covid-19 pandemic has not hit all companies and IP assets in an equal way.

But while some companies are seeing an increase in their value, others are feeling the walls close in and closing their doors. But just because you've had to shutter your business doesn't mean it's worthless. In the final piece of our cover package, Espie Angelica A. de Leon takes a look at how IP owners can extract whatever value remains when a company goes out of business.

We hope you'll find this issue of *Asia IP* informative and entertaining. As always, we invite your comments and suggestions through one of the channels listed on this page.

Darren Barton
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Gregory Glass
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Subscribe today to gain the intelligence you need to protect your IP assets in Asia

MONEY MATTERS

While trademark registration and litigation are troublesome, the financing aspect of the two is even more so. Lawyers tell **Johnny Chan** what kind of monetary issues brand owners face when devising IP strategies.

Protecting your intellectual property is essential to protecting and growing your business. But it comes at a cost – and some IP owners view it exactly that way. Lawyers across the region stress that while there is an expense involved in protecting your IP, it's also an essential part of maintaining your brand and shouldn't be overlooked, even in the depths of a global pandemic.

"In terms of changes due to the pandemic, IP budgets for Korean corporations have remained at the similar level to last year or even [a bit higher]," says Yung Joon Kwon, managing partner at Kwon & Kim Patent & Trademark Attorneys in Seoul. "The Korean Intellectual Property Office reports actually show filing numbers are higher than before Covid-19 started."

During hard economic times, client budgets can often drop – and, sometimes, very quickly. "The financial departments of many major brand owners in luxury and fashion goods often see the IP enforcement budgets as a cost rather than as an essential part of maintaining the brand integrity and exclusivity," says John Eastwood, a partner at Eiger in Taipei. "For law firms, it's important to be creative to find solutions. For example, we had a European luxury group whose enforcement team lost half their budget during an economic downturn. We worked with them to find cheaper ways to get more value."

Christina Cavallaro, special counsel at Eakin McCaffery Cox in Sydney, says that if a client is seeking to commence proceedings in relation to the alleged infringement of a trademark, then first and

foremost, trademark practitioners need to manage client expectations regarding the envisaged litigation, including:

- Legal costs of litigation must be weighed against the potential benefits, risks and commerciality of pursuing enforcement proceedings;
- The differences, in procedure, remedy and cost, between litigation for registered and unregistered trademarks; and
- If the mark operates internationally, the choice of proper and/or best forum for proceedings.

Litigation may attract publicity which, if negative, could affect an entity's bottom line while the litigation is on foot, says Cavallaro.

Ultimately, the economic value that the ownership of a trademark brings to an organization needs to be evaluated when developing a trademark strategy or considering litigation, she says.

"It can be much more expensive to enforce rights in respect of an unregistered trademark than it is for a registered trademark. Enforcement or defence litigation is much harder if a trademark is not registered, given the amount of evidence required to prove reputation," she adds. "That is not so much the issue for a registered trademark – unless the litigation is, for instance, about expungement for non-use."

An alleged infringer may make an application seeking security for costs against the trademark owner to ensure that their legal costs can be recovered if the action is successfully defended, she says.

"In Australia, this may require the trademark owner to provide a sum for security, which is usually in the form of a bank guarantee. If the court does make an order that security for costs be provided, then the trademark owner will not be permitted to proceed with the litigation until adequate security has been arranged."

Another common issue for trademark owners at an operational level is whether they can afford the cost and expense of registering in multiple jurisdictions in which their trademark is used, she adds.

Key financial concepts for trademark practitioners

It is important to help clients avoid "going down the rabbit hole" with their trademark filings. "Clients will get excited and want to register in way too many classes or marks. I suppose it goes against a trademark practitioner's financial interests to tell them to file for less but it can often be the only ethical thing to do," Eastwood says. "For our licensing clients, we're always of course looking at things from a financial mindset – return on investment and the time value of money. For companies centred on their patents and trade secrets, these can be considered a capital asset."

How do lawyers "talk the talk" with those who hold a company's purse strings to build the right team and IP programme for their clients and how do they use numbers to tell the best stories?

"We don't use buzzwords, but when we talk with clients we make sure that we respect their priorities and their long- and short-term needs," says Eastwood.

The pandemic impact

According to lawyers, Covid-19 has changed many practices and decision-making processes regarding trademark financing. More importantly, a lot of the changes are expected to be long-lasting.

Some of Eastwood's clients have found a tighter discipline on issues that they had allowed to linger in the pre-coronavirus days. "Many of our clients are simply not willing to tolerate unpaid invoices from their customers and use all the leverage they have to pry money out of counterparts that have misbehaved," he says.

"Indeed, the pandemic caused a global recession, and we did change our financial strategies right away to fit the new norm in Taiwan," says Benjamin Lai, managing partner at Giant Group Law Firm in Taipei. "First of all, cost saving is imperative and mandatory for us as well as for our clients, so we changed our regular monthly lectures into online events twice a month. Not only did the enrollment dramatically increase, but it also retrenched our expenditures. Online lectures bring more convenience to people's schedules and they will be more willing to participate. The effect of it is beyond what we expected."

Covid-19 has made a significant change in financial decisions of enterprises involving trademarks in particular and IP in general, says Duc Nguyen Xuan, managing partner at Ageless IP Attorneys and Consultants in Hanoi. "There are decisions that are temporary and also decisions that are permanent to fit into the new context.

- First of all, enterprises must tighten their spending policies. Expenditures should be reviewed more carefully and priority should be given to the fixed items such as salary and maintenance.
- Covid-19 could also be viewed as an opportunity for restructuring and optimizing business activities of enterprises to suit the market. A number of measures have been effectively applied by many enterprises such as:
 - Focusing on internal training, improving quality and knowledge for human resources, improving processes, redefining business plans and creating new visions;
 - Applying software and technology applications to work remotely with customers and competent state agencies while still ensuring effective and continuous interaction;
 - Switching to working from home instead of going directly to the office, especially during the period of social distancing; and
 - Enhancing security measures to ensure that all services and data transfer while working remotely are not compromised.

"IP budgets for Korean corporations have remained at the similar level to last year or even a bit higher.

KIPO reports actually show filing numbers are higher than before Covid-19 started."

—YUNG JOON KWON, managing partner, Kwon & Kim Patent & Trademark Attorneys, Seoul



"Clients will get excited and want to register in way too many classes or marks.

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—JOHN EASTWOOD, partner, Eiger, Taipei



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Enforcement is much harder if a trademark is not registered, given the amount of evidence required to prove reputation."

—CHRISTINA CAVALLARO, special counsel, Eakin McCaffery Cox, Sydney



"A common strategy is for the IP to be held in a standalone company. If the trading entity suffers financial difficulties, the licence agreement for the IP can be terminated while the separate standalone entity retains ownership of the IP."

—GREGORY ROSS, partner, Eakin McCaffery Cox, Sydney



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"We changed our monthly lectures into online events. Not only did the enrollment dramatically increase, but it also retrenched our expenditures. Online lectures bring more convenience to people's schedules and they will be more willing to participate."

—BENJAMIN LAI, managing partner, Giant Group Law Firm, Taipei



Managing development, protection and enforcement of brands with budget pressure

“Being adaptable to changed circumstances is essential,” says Eastwood.

When developing a brand and creating a trademark, an organization may consider isolating the IP so that it is owned by a different entity to the one which is conducting the business, in order to achieve adequate asset protection, says Gregory Ross, a partner at Eakin McCaffery Cox.

“A common strategy for taxation and asset protection purposes is for the IP to be held in a standalone company, which then licenses the use of the IP for an appropriate license fee to the trading entity,” Ross says. “Provided that the licensing agreement has been properly documented with relevant termination clauses, then if the trading entity suffers financial difficulties, the licence agreement for the IP can be terminated while the separate standalone entity retains ownership of the IP.”

If an entity is looking to develop a brand on an international level, then consideration needs to be given in taking steps to register the IP in all jurisdictions where it could potentially be applied, he says.

That includes whether trademark owners can afford the cost and expense of registering and maintaining registration in multiple jurisdictions in which their trademark is used in connection with the goods and/or services covered by a trademark, he adds.

If there are budget pressures, then a proper business strategy needs to be formulated to realistically identify the jurisdictions where the IP may be applied, as opposed to simply obtaining (and paying for) legal advice and registering the IP in as many countries as possible, he says.

At a practical and cost-containment level, IP owners should have a standard cease and desist letter available, whether in house or through a law firm sufficiently familiar with the IP owner’s business, he adds.

“In saying that, an entity needs to ensure that it has sufficiently achieved adequate protection on an international level as, whilst not registering in anticipated jurisdictions may be more cost effective in the short term, it may end up being more costly for an entity in the long term if it is required to challenge a registrant, a squatter or competitor trying to use the same or similar trademark in a foreign jurisdiction,” he says.

At a practical level, an IP owner is well-served by setting up and maintaining a formal register of its IP assets and, from time to time, doing a bit of a check in the market place to see if there is anything in the marketplace too similar its IP being sold, particularly in context of trademarks and trade names, he adds.

As far as how to determine trademark values for tax or financial reporting purposes and how to reconcile those values relative to other assets and total company values, Eastwood says trademarks are notoriously hard

to value, and that his clients struggle with that a lot.

The best practices for negotiating licensing or other deal terms

Most licensors tolerate a certain amount of fudging of figures, but licensees who try to lie blatantly will likely lose badly in the future, Eastwood says. “For example, we’ve had cases in Taiwan where fairly large companies have attempted to pretend not to know about their subsidiary that happened to share the same CEO and the same address. One licensee’s counsel once told me that he ‘would try’ to reach somebody at the subsidiary, so I told him that should be simple because he could go down the hallway to his boss.”

According to Xuan, the assignment of a trademark from company A to company B is not merely the assignment of that trademark but one also needs to consider the following aspects:

- The assigned trademark must not be identical or similar to the remaining trademarks of the assignor. If so, it is necessary to assign all identical/similar trademarks to avoid the possibility of confusing consumers about the origin of the branded goods/services.
- The assigned trademark must not be identical or similar to the trade name of the assignor to avoid the possibility of confusing consumers about the origin of the branded goods/services. In this case, the trademark assignment is only acceptable if it falls into one of the following situations:
 - The assignor transfers to the assignee all the business establishments and activities under that trade name; or
 - The assignor eliminates the business sectors related to the branded goods/services and such elimination must be recorded in the business registration certificate; or
 - The assignor has dissolved, ceases to exist after signing the trademark assignment contract; or
 - In fact, the National Office of Intellectual Property of Vietnam may accept the assignment of trademark that is similar to the trade name of the assignor if it is able to provide documents proving that the transferor is the parent company/capital contractor (accounting for more than 50 percent of the capital contribution) to the assignee.
- In addition, when assigning the trademark, it is necessary to negotiate to transfer all other means/forms of the trademark such as domain names, the system of branded stores, etc.
- When negotiating trademark assignment, it is also necessary to note whether or not the assignment fee includes taxes payable to the government such as value-added tax or income tax. 

The value of IP assets in the time of pandemic

The Covid-19 pandemic has brought a complete overhaul of traditional businesses.

Excel V. Dyquiango explains where IP assets have retained their pre-pandemic value.

The Covid-19 pandemic has brought a complete overhaul of traditional businesses. While a large number of businesses will likely not survive in their current form, the pandemic brings a good opportunity for some companies with sufficient cash and appropriate business model to acquire some important technologies.

In fact, the Covid-19 health emergency just gave another upward push to the dematerialized economy and thus to the value of the IP assets. Look at the boom of online meetings, online learning, online shopping, online work, among others, which one lawyer collectively calls ‘the online crew.’

“For those IP which are suitable for a business model under Covid-19 pandemic, their values will grow,” says Alan Chen, managing director at Talent Attorneys-at-Law in Taipei. “For example, some software companies with IP online services or remote working, have IP values that grow definitely. Of course, for those companies that provide medical equipment, services or pharmaceuticals, their IP values would definitely increase. On the contrary, for those companies with a traditional transaction business model, their brand value (IP value) would decrease. For example, the IP values of some restaurants, chain stores, and department stores have gone down drastically.”

Chen adds that some companies that cannot survive in their current form during the Covid-19 pandemic, such as department stores, might go bankrupt. He adds that their IP values, such as brand, may go down.

"The bankruptcies for some businesses under Covid-19, such as airlines and travel agencies, among others, not only gives rise to the value of IP assets but also their business," he says.

In part, this was echoed by Fabio Giacobello, a partner at HFG Law and Intellectual Property in Shanghai, who says that the Covid 19 pandemic has not hit all companies and IP assets in an equal way.

"Some companies have taken advantage of the mutated environment and others suffered a disadvantage," he says. "In addition to those mentioned above (the online crew), all the IP assets related to companies that have embraced the challenge of the health emergency and launched themselves into the research arena – vaccines, testing, tools, masks or any medical device somehow related to the health emergency – are greatly on the rise."

He does, however, add that with companies going bankrupt which give rise to IP assets, this point is yet to be seen.

"I imagine that there will be a shift of ownership of assets in industries where the virus hit hard," he says. "After some time, some of these IP assets will be revamped and re-launched. As said, it is yet to be seen. For brands and businesses doing online services now, their IP assets are going higher and higher. It is really [impressive], how the Covid-19 emergency is pushing

up online services. Once again, the trend, the surpass and replacement (online versus offline) was already there, but with the virus, the pace of being online has accelerated."

Chen adds that, these days, IP assets need to be innovative and acceptable in the current environment, especially so that they will be able to remain valuable under any social changes, such as the pandemic.

"For those IP assets that cannot overcome social changes, their value will decrease tremendously," he says. "When it comes to this, we do not see a big change for the trend in the coming months as Covid-19 has not yet been resolved. As to the trend for the next year, IP values for online services will remain valuable as most of their users get used to those services. IP value for traditional transactions will increase from the bottom, but its value from before the Covid-19 pandemic will be very difficult to recover."

Meanwhile, Giacobello notes that the super expansive market for online services and related IP assets is making the competition very tough, and often unfair.

"Expansion requires investment," he says. "Value increases, of course, but the sustainability and profitability in the medium term are to be discovered. For sure the 'online crew' and all the health-related IP assets will go up for a while, probably at a slower pace than in the previous month but still up. Also, I believe that some of the new stuff we tried due to the virus will become permanent, like online conferences and team meetings, and then IP assets will keep growing for years." 

"All the IP assets related to companies that have embraced the challenge of the health emergency and launched themselves into the research arena are greatly on the rise."

—FABIO
GIACOPELLO, partner,
HFG Law and Intellectual
Property, Shanghai

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—ALAN CHEN,
managing director, Talent
Attorneys-at-Law, Taipei





And the nominees are...

Law firms across Asia Pacific are stepping up their game in a race to the top, whether by expansion, merger or good old-fashioned poaching, all of which makes it increasingly challenging for us to stay on top of the practice.

In the December 2020/January 2021 issue of *Asia IP*, we will reveal the current edition of our top copyright, patent and trademark law practices. The awards were to be given at an awards ceremony in Gold Coast, Australia, this month, and would have been our 11th such ceremony.

Covid-19, of course, had other ideas for us, as it has had for so many events this year. All the same, we will crown 51 winners in jurisdictional awards from across the region in that issue, with three regional Asia Pacific winners to cap everything off. The only thing that will be missing will be the champagne, but please do feel free to raise a toast next month!

All of the shortlisted firms in jurisdiction are presented in the following pages in alphabetical order. Each firm has received a brief write-up from our editorial team at no cost to the firm. All shortlisted firms were given an opportunity to advertise their firm as part of this feature, but the decision to advertise or not advertise will not influence the winners of the awards next month.

The five shortlisted firms in each category were based on key cases and other information provided by law firms in the region. More than 5,000 in-house counsel from Asia, Europe and the Americas – the very people who frequently work with the firms and know them best – were then polled by *Asia IP* magazine throughout the first part of 2020. The firm receiving the most votes in each category will be named the winners in each of 19 jurisdictions, plus in the Asia Pacific categories.—*Gregory Glass*

The 2020 *Asia IP* Awards Shortlist

AUSTRALIA

Australia Copyright Firm of the Year

McCullough Robertson Lawyers

Ashurst Australia

Davies Collison Cave

K&L Gates

Sparke Helmore

Ashurst Australia's intellectual property team provides a complete range of contentious and non-contentious specialist IP services. It has an excellent reputation for providing cutting-edge advice on strategic IP matters, acting

Australia Patent Firm of the Year

Ashurst Australia

Davies Collison Cave

K&L Gates

King & Wood Mallesons

Spruson & Ferguson

for some of the world's leading companies. The full-service firm has over 375 partners among 1,600 lawyers and staff in 25 offices throughout Australia and the Pacific region to provide corporate services in conjunction with IP support. Key members of the team are Lisa Ritson, Anita Cade, Kellech

Australia Trademark Firm of the Year

Davies Collison Cave

K&L Gates

King & Wood Mallesons

Macpherson Kelley

Spruson & Ferguson

Smith, Stuart D'Aloisio and Nina Fitzgerald. Paul Jenkins, who is based in Sydney and London, is the firm's global managing partner.

Davies Collison Cave was acquired by QANTM IP Limited in 2016 and is now part of the Australian Securities Exchange-listed firm of over 370 employees

across key offices in Melbourne, Sydney, Brisbane and Singapore. DCC continues to operate as an independent business with former partners retaining over 50 percent interest in QANTM and restructuring to enable increased investment in IT and other systems innovation and expansion into other jurisdictions. Principal Marion Heathcote received INTA's 2019 President's Award. Jack Shan and Aaron Yates have been named principal while Edith Hamilton, an expert in complex patent opposition matters, has been named senior patent counsel. Key contacts are Stuart Green for trademarks; Craig Finlayson for corporate and commercial; and Scott Sonneman for patent work. DCC was named *Asia IP* trademark firm of the year for Australia in 2019.

K&L Gates boasts some 300 lawyers in Australia, including those handling intellectual property and related matters. Jonathan Feder leads the firm's Australia IP group from Melbourne, where he brings experience in a broad range of legal areas relating to IP, including registration of trademarks and designs, trademark and design enforcement, copyright protection, trade protection and licensing. Feder and his team have acted for clients in numerous leading IP cases in the Federal Court of Australia, including *Elwood Clothing v. Cotton On Clothing*, *Seafolly v. City Beach* and numerous cases for the G-Star group of companies. More than half of the firm's global IP lawyers are registered to practice before the U.S. Patent and Trademark Office.

King & Wood Mallesons boasts more than 140 partners and over 1,100 lawyers across five major cities in Australia. Its IP practice covers patents, trademarks, copyright, designs, trade secrets, strategic IP advice and IP disputes. Based in Sydney, partner-in-charge Katrina Rathie is a pre-eminent intellectual property lawyer and litigator

who focuses on the advertising, marketing, brands, luxury and consumer goods and media sectors. Other key practitioners include Bill Ladas, Kim O'Connell, Matthew Swinn and Cate Nagy.

Established in 1905, **Macpherson Kelley** is a full-service law firm with offices in Brisbane, Dandenong, Melbourne and Sydney. Its IP practice is strengthened by a team of award-winning lawyers who deliver services in the areas of licensing, application, counterfeit goods, confidential information and trade secrets, international protection, IP ownership consolidation and transfer, IP reviews and audits, plant breeders rights, IT advice and others.

McCullough Robertson is a full service, independent Australian law firm with a team of specialist lawyers, associates and paralegals lending a commercial approach to trademark prosecution, advice and enforcement. With more than 4,000 trademarks under management worldwide, the firm has a wealth of experience in both Australian and international filings. Named as *Asia IP* copyright firm of the year for Australia in 2019, the firm prides itself on holistic approach, providing innovative and practical solutions that includes ongoing assistance in relation to portfolio management, enforcement and protection. Belinda Breakspear, who heads up the firm's IP practice, is a key contact.

Sparke Helmore Lawyers is a firm with more than 700 people working from eight offices across Australia. Sydney-based Shannon Platt who leads the corporate group and is the national service line leader of the IP team has more than 20 years' experience representing clients in IP disputes in courts and litigation arising from misleading and deceptive conduct and protecting trade secrets. In July 2020, the firm merged with Laycock Burke Castaldi, with new partner Julien Castaldi bringing substantial IP experience to the merged firms.

Senior associate Wyn Davies is a notable new hire.

Spruson & Ferguson companies are incorporated entities owned by IPH Limited, a publicly listed holding company for a number of IP professional services brands operating across Asia. Rory Anderson and Scott Philp were promoted to principal. Among the new hires are Ken Bolton and Ryan Boe, both of whom joined the patent – engineering practice. The firm was named *Asia IP* patent firm of the year for Australia in 2019. Fisher Adams Kelly Callinans and Cullens combined business operations from April 2018 after a three-way merger and the new firms are now fully integrated into Spruson & Ferguson. Russell Davis heads the firm's Australian offices while Coral Toh leads the Asia trademarks group from Hong Kong.

CAMBODIA

Cambodia IP Firm of the Year

Abacus IP
BNG Legal
Bun & Associates
Sok Siphana & Associates
Tilleke & Gibbins

Pheng Thea is co-founder of **Abacus IP**, a full-service intellectual property agency in Phnom Penh. His practice involves the registration and maintenance of hundreds of trademarks, patents, industrial designs and other forms of IP. Co-founder David Haskel and external advisor Tom Pearson are also key contacts. The firm completed a successful enforcement programme on behalf of a global, US-based real estate firm for trademark infringement and unfair competition, and has filed dozens of patent filings for PCT national phase and validation of foreign patents in Cambodia.

BNG Legal has a deep understanding of the local

business environment and culture, which has led to the firm being recognized as one of the leading IP firms in the country. Services offered include trademark search and registration, due diligence, licensing, franchising, anti-counterfeiting and enforcement. Principal partner Darwin Hem is a key contact for patent matters; Keopichchenda Long is another, as she heads the IP and technology practice group.

Premier firm **Bun & Associates** specializes in emerging markets and has been ranked as one of the top law firms in the country. It combines international and local business knowledge to advise foreign investors throughout the investment process. Sophealeak Ing is the key contact for IP matters.

Sok Siphana & Associates is the Phnom Penh member of the ZICO Law network. Managing partner Siphana Sok is a former Commerce Secretary of State (vice minister) in the Cambodian government, where he worked extensively on issues related to commercial and investment legal framework, trade promotion, trade policies, trade development and economic integration. Mealy Khieu and Leakena Chhim are key contacts. The firm has assisted Yeo Hiap Seng Limited in filing a complaint letter to the Department of Custom regarding the parallel importation of Yeo's products into Cambodia by unauthorized local importers. The firm was named the 2019 *Asia IP* firm of the year for Cambodia.

The **Tilleke & Gibbins** office in Phnom Penh provides guidance to clients on all aspects of intellectual property in Cambodia, and advises on licensing and regulatory issues for clients in sectors such as chemicals, food and agribusiness, franchising, life sciences, and technology. Its Cambodia practice offers a team of dedicated Khmer advisors who draw on the international expertise of its Bangkok office to provide advice on IP, licensing, and regulatory issues. Director

Jay Cohen leads the IP practice; Sokmean Chea is highly-regarded for her work with clients on a range of IP issues; and David Mol is regularly praised by clients for his responsiveness and practical, business-minded advice.

CHINA

China Copyright Firm of the Year

Baker McKenzie

Bird & Bird

Deacons

Eversheds Sutherland

Hogan Lovells

China Patent Firm of the Year

Bird & Bird

Deacons

Hogan Lovells

Eversheds Sutherland

Spruson & Ferguson

China Trademark Firm of the Year

AWA Asia

Baker McKenzie

Deacons

Eversheds Sutherland

SIPS

Swedish law firm Awapatent operates its Asia units out of **AWA Asia** in Hong Kong and AWA Asia's wholly-owned Chinese IP consultancy, AWA IP (Beijing). Ai-Leen Lim serves as the chief executive officer and principal counsel of AWA Asia, and serves mainland Chinese, Hong Kong and international clients with a focus on brand management and social media matters. AWA IP (Beijing) is a licensed PRC trademark agency that is able to file and enforce trademarks directly in China before the Trademark Office and the administrative authorities.

Named *Asia IP* Trademark Firm of the year for China and Asia

Pacific in 2019, **Baker McKenzie** has offices in Beijing, Shanghai and Hong Kong, and maintains an impressive team of IP specialists backed by an international network. China and Hong Kong IP practice head Loke-Khoo Tan also co-leads the firm's luxury and fashion industry practice, working extensively with global brands in major jurisdictions.

Named *Asia IP* Patent Firm of the year for China and Asia Pacific in 2019, **Bird & Bird** established its Hong Kong office in 1995, followed by Beijing in 2004 and Shanghai in 2008. The international firm entered into an association with local firm Lawjay Partners in 2009 to increase coverage in contentious IP matters in Chinese courts. The China and Hong Kong team is led by partner Matthew Laight, who has represented some of the world's leading companies in a broad range of sectors including electronics, pharmaceuticals, communications, information technology, media, broadcasting, and food and beverage.

Deacons combines one of the most established teams in Hong Kong with a solid presence in China. Assisting global brands including 50 of the world's top 100 brands as identified by Interbrand, the IP practice operates out of the firm's Hong Kong main office. Key contacts are partners Annie Tsoi, Charmaine Koo and Catherine Zheng.

The well-respected Cedric Lam runs **Eversheds Sutherland's** IP practice in greater China from the firm's Hong Kong office. Lam, a prominent IP strategist in the region, has more than two decades of experience counselling cross-border, complex, high-stakes intellectual property-related transactions and disputes. Lam is known for his work helping multinational corporations acquire, exploit and enforce their IP rights and trade secrets, as well as implement technology transfer, IP protection, licensing, litigation and anti-counterfeiting strategies. The firm also advises on legal issues affecting advertising,

marketing and sponsorship campaigns, including strategy and providing fast copy clearance to ensure advertisements and packaging comply with the relevant advertising codes and regulations, and on data protection laws. It regularly advises on this area of the law, including all data privacy in Hong Kong and Asia, and in relation to cross-border data flows and direct marketing.

Named *Asia IP* Copyright Firm of the year for Asia Pacific in 2019, **Hogan Lovells** operates its China IP practice out of Hong Kong, Shanghai and Beijing offices. Eugene Low now leads the IP practice from Hong Kong, joined by Beijing partner Helen Xia and Shanghai partner Katie Feng. Feng led the 2016 association with Fujian Fidelity Law Firm in the China (Shanghai) Free Trade Zone that emphasized growing the firm's IP litigation offering. Fidelity was established in 1989 and is one of the largest law firms in Fujian province.

Named *Asia IP* copyright firm of the year for China in 2019, **SIPS** helps clients in managing their IP portfolios, including registration, enforcement and licensing of trademark, copyright and patent. The firm also assists clients with investigations management, advice on supply chain integrity, trade secret protection, data privacy, retail and wholesale distribution, ecommerce, distribution and sourcing agreements, and regulatory matters relating to IT and other high-tech sectors. The firm's expertise is mainly in the Greater China region, but members also assist clients with IP matters throughout Asia. Partner Helen Tang is a key contact.

Spruson & Ferguson established a significant presence in Hong Kong and China in 2016 by acquiring Ella Cheong (Hong Kong) and its subsidiary Ella Cheong Intellectual Property Agency (Beijing). Principal Oliver Lutze is the country manager for China and is based in Beijing. Spruson & Ferguson is part of the publicly-listed IPH Limited, the

holding company for a number of intellectual property professional services and adjacent businesses operating under different brands across the Asia-Pacific region.

HONG KONG

Hong Kong Copyright Firm of the Year

Baker McKenzie

Bird & Bird

Deacons

ELLALAN

Mayer Brown

Hong Kong Patent Firm of the Year

Baker McKenzie

Bird & Bird

Deacons

ELLALAN

Spruson & Ferguson

Hong Kong Trademark Firm of the Year

Baker McKenzie

Deacons

ELLALAN

Eversheds Sutherland

SIPS

Baker McKenzie has offices in Beijing, Shanghai and Hong Kong, and maintains an impressive team of IP specialists backed up by an international network. China and Hong Kong IP practice head Loke-Khoon Tan also co-leads the firm's luxury and fashion industry practice, working extensively with global brands in major jurisdictions.

Bird & Bird's intellectual property group is led by partner Matthew Laight, who is noted for his expertise in both contentious and non-contentious matters in sectors including electronics, pharmaceuticals, communications, IT media, broadcasting and F&B. The firm counts Alison Wong and Christine Yiu among its leading

trademark practitioners, Ted Chwu for patent work, and Rieko Michishita for copyright-related matters.

Deacons' IP practice remains one of the best among the city's firms; partner Annie Tsoi and Charmaine Koo co-head the practice, while Catherine Zheng heads the patents and designs group. The firm was named *Asia IP* patent firm of the year for Hong Kong in 2019. Vivien Poon and Patsy Lau are key contacts for trademark work. Jeffrey McLean and Catherine Zheng for patent, and Charmaine Koo for copyright.

Well-respected Ella Cheong and Alan Chiu head Hong Kong-based **ELLALAN**; Chiu is the firm's managing partner. The firm, which until June 2020 had been known as Ella Cheong & Alan Chiu, advises on IP enforcement, transactional and commercial IP and internet-related issues, as well as matters concerning entertainment and media, dispute resolution, commercial law and regulatory law. The firm was named *Asia IP* trademarks firm of the year for Hong Kong in 2019.

The well-respected Cedric Lam runs **Eversheds Sutherland's** IP practice in greater China from the firm's Hong Kong office. Lam, a prominent IP strategist in the region, has more than two decades of experience counselling cross-border, complex, high-stakes intellectual property-related transactions and disputes. Lam is known for his work helping multinational corporations acquire, exploit and enforce their IP rights and trade secrets, as well as implement technology transfer, IP protection, licensing, litigation and anti-counterfeiting strategies. The firm also advises on legal issues affecting advertising, marketing and sponsorship campaigns, including strategy and providing fast copy clearance to ensure advertisements and packaging comply with the relevant advertising codes and regulations, and on data protection laws. It regularly advises on this area of the law, including all data privacy

in Hong Kong and Asia, and in relation to cross-border data flows and direct marketing.

Simone Intellectual Property Services, also known as **SIPS**, is headquartered in Hong Kong with offices in Shanghai and Beijing. With the opening of its China trademark agency in mid-2017, the firm now has over 60 members of staff. The bulk of its work relates to trademark portfolio management (particularly clearance, registration and elimination of pirated registrations) and all types of IP enforcement, with an emphasis on anti-counterfeiting, online enforcement, trade secret protection, copyright, and patents. Key contacts include founding Joe Simone and partners Dan Plane, Helen Tang, and Troy Rice.

Spruson & Ferguson established a significant presence in Hong Kong and China in 2016 by acquiring Ella Cheong (Hong Kong) and its subsidiary Ella Cheong Intellectual Property Agency (Beijing). The highly-recommended Coral Toh, head of trademarks and head of the greater China practice at the firm, is based in Hong Kong; principal Robert Jackson is a go-to lawyer for chemicals and life sciences matters. Spruson & Ferguson is part of the publicly-listed IPH Limited, the holding company for intellectual property professional services and adjacent businesses operating under different brands across the Asia-Pacific region.

INDIA

India Copyright Firm of the Year

Anand and Anand
Beruar & Beruar
Lall & Sethi
Rahul Chaudhry & Partners
RNA, Technology & IP Attorneys

Anand and Anand is one of India's top IP firms, housing more than 200 professionals led by managing partner Pravin Anand. Senior

India Patent Firm of the Year

Anand and Anand
LexOrbis
Rahul Chaudhry & Partners
Remfry & Sagar
Singh & Singh

India Trademark Firm of the Year

Anand and Anand
Lall & Sethi
Rahul Chaudhry & Partners
Remfry & Sagar
RNA, Technology & IP Attorneys

partners Safir Anand, Archana Shanker and MS Bharath are all excellent lawyers. Clients include Mars, Microsoft, Toyota, Louis Vuitton and Pioneer. Anand and Anand was named trademark firm of the year for India at the 2019 *Asia IP Awards*, as well as the National IP Firm of the Year at the 2020 *Asia IP India IP Awards*.

Beruar & Beruar's practice areas include copyright, trademarks, patents, design, geographical indications, dispute resolution, corporate advisory, investigation and enforcement. Partner Rahul Beruar co-founded the law firm and heads its IP practice. Heading the dispute resolution team is partner and co-founder Nidhi Jain. The firm has its head office in New Delhi and has additional offices in Mumbai and Ranchi. It was named IP Boutique of the Year at the 2020 *Asia IP India Awards*.

Managing partner Raghav Malik leads the team at **Lall & Sethi** in Delhi, which won multiple awards at the 2020 *Asia IP India Awards*, including New Delhi and NCR Firm of the Year. The firm focuses on trademarks, copyrights, designs, patents, confidential information and trade secrets, entertainment and sports laws and information technology laws. The firm prides itself on having a top-notch IT system; its IP Management Software, developed

in-house, ensures that timely responses are sent and deadlines are strictly adhered to. The firm was founded in 1994 by Chander Lall and Sandeep Sethi, both of whom have been elevated to senior advocates. Partners Anju Khanna, Tia Malik and Jyotideep Kaur are key contacts.

Key IP practitioners at New Delhi-based **LexOrbis** include Manisha Singh and Abhai Pandey. The firm was successful in a domain name complaint filed with the WIPO against the misuse of the domain name www.indiafashionweek.com on behalf of the Fashion Design Council of India, even though the other party had been the owner of the disputed domain name for almost 14 years. The firm was named *Asia IP Patent Firm of the Year for India* at the 2019 *Asia IP Awards* in Taipei, and IP Prosecution Firm of the Year at the 2020 *Asia IP India Awards*.

Gurugram-based **Rahul Chaudhry & Partners**, formerly known as Lall Lahiri & Salhotra, is led by managing partner Rahul Chaudhry, who has owned the firm since March 31, 2013. The team, team composition, team structure including the partners and support staff continues to be the same as that of LLS. The firm offers reliable, business-centric legal counsel to both national and international clients. Founding partner Anuradha Salhotra, and senior partners Ramesh C Dhawan and Veena Poolakal are key contacts. The firm was named Pharma, Biotech & Life Sciences Firm of the Year at the 2020 *Asia IP India Awards*.

IP powerhouse **Remfry & Sagar** is a go-to firm for multinationals in India. The firm is advising the World Trade Centers Association in ongoing enforcement work in which damages to the tune of Rs5 million (US\$75,000) have been claimed. In one matter, relating to use of the company's trademarks and service marks. The firm traveled to a work site in Nashik, Maharashtra, with local police to remove signage when it was learned that the

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- IAM Strategy 300, 2020 - Manisha Singh has been recognized as world's leading IP strategist
- IAM 1000, 2020 - LexOrbis is recognized as "Recommended Firm"
- IAM 1000, 2020 - Manisha Singh is recognized as "Recommended Individual"
- The Asia-Pacific Trademark Law Firm Rankings (India), 2020 - LexOrbis is recognized most well-respected law by The Trademark Lawyer Magazine.
- Managing IP, 2020 - Manisha Singh recognized as as "IP Star" 2020 for Patent litigation, Patent strategy & counselling.
- Managing IP Trademark Rankings for 2020 - "Trade mark prosecution tier 2 firm"
- India Business Law Journal's - Indian Law Firm Awards 2020 for Intellectual Property Protection
- "Patent Law Firm of the Year" by Legal Era - Legal Media Group, 2020
- Manisha Singh recognized as Star Women in law for the year by Legal Era-Legal Media Group, 2020
- WTR 1000, 2020 - LexOrbis has been recognized as "Recommended Firm"
- 2019 IP Star women of the year by Legal Era - Legal Media Group awarded to Manisha Singh
- 2019 GIPC - Award for Excellence for invaluable services in the field of IP to Manisha Singh
- Ranked in WTR1000 2019
- Innovation & excellence - IP law firm of the year 2019" by The Corporate LiveWire.
- Awarded as "Corporate INTL Global awards 2019"-"Intellectual Property Law firm of the year in India".
- IAM Patent 1000 : Most recommended prosecution firm for 2019 recognized Manisha Singh
- The IAM Strategy 300 -- The World's Leading IP Strategists
- The Award for "IP Excellence Recognition" for 2019, at Questel Executive IP Summit 2019
- Diversification of Practice - 2019 by Indian Corporate Counsel Association (ICCA).
- The Acquisition International for 2019 Global excellence award: Manisha Singh recognized as the most influential women in IP
- Asia Law: Recognized for the category Intellectual Property in AsiaLaw Profiles 2020
- Best Patent Law Firm in India - 2019 Asia IP awards.
- India Business Law Journal, 2019: Manisha Singh recognized as one of India's Top 100 Lawyers, The A-List

infringing company was flouting a High Court order to cease using the marks. A main suit is pending with the High Court of Bombay. Led by managing partner Ashwin Julka, the firm won multiple awards at the 2020 *Asia IP* Awards, including runner-up for the National IP Firm of the Year.

Ranjan Narula leads **RNA, Technology and IP Attorneys** from its Gurugram base. The firm recently acted for Puma in seeking a permanent injunction restraining infringement of trademark, passing off, damages, delivery up before the Delhi High Court against Pasco Sports, which was engaged in manufacturing and marketing footwear and filed several trademark applications for registration of deceptively similar marks and owned the domain name www.pamasports.com. The court granted an *ex parte* interim injunction and appointed a local commissioner to visit the defendant's premises, where 350 pairs of infringing sports shoes and 35 bags bearing the PAMA

mark were seized. Pasco has since changed its mark to ZAMA. The firm won multiple awards at the 2020 *Asia IP* India Awards, including Enforcement Firm of the Year and, was runner-up for the New Delhi and NCR Firm of the Year.

Singh & Singh was founded by Maninder Singh and Pratibha Singh in 1999, both of whom have been elevated to the position of senior advocate; Maninder Singh is currently Additional Solicitor General of India. The firm handles a variety of IP, media and telecommunications, arbitration, competition law, tax, pharma regulatory matters. The firm has five partners and four associate partners working with more than 40 attorneys and patent agents. Bitika Sharma and Sudeep Chatterjee are particularly well-regarded; Saya Choudhary is recommended for patent work. The firm was named Copyright Firm of the Year for India at the 2019 *Asia IP* Awards in Taipei; it won multiple awards at the 2020 *Asia IP*

India Awards, including runner-up honors in the National IP Firm of the Year category.

INDONESIA

Indonesia Copyright Firm of the Year

Heru Lukito & Partners

HHP Law

K&K Advocates

Rouse

Tilleke & Gibbins

Indonesia Patent Firm of the Year

HHP Law

Januar Jahja and Partners

K&K Advocates

SKC Law

Tilleke & Gibbins

Acemark is a boutique firm established in 1999, focusing on IP both domestically and

Indonesia Trademark Firm of the Year

Acemark

Heru Lukito & Partners

HHP Law

K&K Advocates

Tilleke & Gibbins

internationally. Clients range from multinational corporations to small and medium enterprises across industries. Professionals have backgrounds of chemistry, biology, pharmaceuticals, electronics and mechanical engineering.

Founded by Heru Lukito, **Heru Lukito & Partners** handles issues including trademarks, patents, industrial designs, copyright, trade secrets and layout of integrated circuits for both local and foreign companies across the fields of retail manufacturing, computers, food and beverage, finance and pharmaceuticals.

HHP Law, formerly known as Hadiputranto, Hadinoto & Partners, is the Indonesian member firm of Baker McKenzie. The firm was named the *Asia IP* trademark firm of the year in 2019. Its IP team helps international clients with cease-and-desist campaigns, anti-counterfeiting raids, infringer investigations and other related matters. The IP team is led by partner Daru Lukiantono. Another key practitioner is Wiku Anindito for trademark and copyright.

Januar Jahja & Partners is a boutique IP firm with almost 30 years of experience. Services include trademark and patent prosecution, IP-related litigation and other contentious matters. After the passing of founding partner Januar Jahja in 2017, daughter Prudence Jahja has taken the reigns as managing partner. Foreign IP consultant Andrew Diamond remains a key contact, and the team continues to provide outstanding services to well-known international businesses as well as local companies. Juanitasari Winaga is another leading

practitioner. Among its new hires are patent attorney Wulan Mogesmiranti (Moges), patent specialist Mitha Fuji Adiati and litigation associate John.

Managing partner Justisiari Perdana Kusumah and partner Risti Wulansari as well as senior associate Siti Mariam Nabila lead **K&K Advocates**, a boutique firm specializing in IP matters with particular strength in copyright, patent and trademark registration and enforcement. Named *Asia IP* copyright firm of the year for Indonesia in 2019, the firm is regularly sought by multinational clients and foreign governments. It also acts for or is involved with bodies responsible for developing IP and technology laws.

Rouse, in association with **Suryomurcito & Co**, is led by deputy CEO Nick Redfearn, and has particular experience managing regional IP enforcement programmes and filings, and commercial deals and compliance exercises. Gunawan Suryomurcito, Kin Wah Chow, Arifia Fajra, Yurio Astar, Tania Lovita and Lisa Yong provide domestic litigation/enforcement and trademark and patent services. Rouse provides comprehensive IP services to its clients, including trademark filing, counselling and portfolio management, patent drafting, filing, and counselling. Rouse has a new senior trademark manager in the person of Gayatri Putri Utami.

Led by Purnomo Suryomurcito, Nidya Kalangie and Andrew Conduit, **SKC Law** provides clients with strategic counseling and transactional advice, particularly on matters involving commercialization of IP, advertising, broadcasting, and the internet and consumer law. The firm can efficiently complete due diligence on IP assets particularly during merger transactions. Other types of transaction the firm advises on include franchising, licensing, technology transfer, R&D contracts, music and film productions, confidentiality agreements and model release. The firm was named *Asia IP* patent firm

of the year for Indonesia in 2019.

Tilleke & Gibbins' Jakarta office began serving clients in September 2013 and has been operated as a dedicated IP agency. Its leading Southeast Asian IP practice has decades of experience in the region and has been instrumental in the development of IP law and practice in a number of jurisdictions. As a result, multinational clients such as Bvlgari, Gap, Giorgio Armani, Starbucks, Toyota, Grab, Lazada and Walmart have rapidly come to rely on the firm to protect their trademarks, patents, copyright, and other IPRs. Director Wongrat Ratanaprayul and partner Somboon Earterasarun are key contacts.

JAPAN

Japan Copyright Firm of the Year

Baker McKenzie

Hogan Lovells

Nakamura & Partners

Sugimura & Partners

Yuasa and Hara

Japan Patent Firm of the Year

Nakamura & Partners

Ryuka IP

Sugimura & Partners

TMI Associates

Yuasa and Hara

Japan Trademark Firm of the Year

Hiroe and Associates

Hogan Lovells

Nakamura & Partners

Sugimura & Partners

TMI Associates

The IP/IT group at **Baker McKenzie** provides a full range of IP services including infringement litigation on patents, designs, trademarks, copyright, unfair competition and

trade secret disputes. The firm is also active in prosecution and proceeding management related to trademark design applications and registrations, as well as technology transfer and other acquisition, licensing and protection issues. Many of its members, such as partner Kensaku Takase and Kei Matsumoto, have abundant experience in both domestic and foreign jurisdictions, which enable them to handle IP matters for the US and European markets and work with their international counterparts to coordinate inbound and outbound work.

Hiroe and Associates provides services concerning patents, utility models, trademarks, industrial designs, copyright, unfair competition, licensing, searches, prosecution, litigation, opinions, maintenance, renewal, technology transfer, counseling, and more. The firm's well-rounded team of professionals, which is based in Gifu Prefecture outside Nagoya, provides expertise in a wide range of technical fields and intellectual property law. Director Masanori Hiroe is a key contact.

The IP team at **Hogan Lovells** in Tokyo – including managing partner Lloyd Parker and partner Frederick Ch'en – offers IP services for both contentious and non-contentious matters on patents, trademarks, copyright, designs, trade secrets and unfair competition. Parker is widely-regarded as one of the best IP lawyers in Japan.

Named *Asia IP* trademark firm of the year for Japan in 2019, **Nakamura & Partners** in Tokyo is an international patent and law firm which provides IP services inside and outside of the country. It provides services for patents (including designs) and trademarks, and has a strong legal section and the administration group to support the firm. Outstanding practitioners include managing partner Hiroyuki Itaki as well as partners Kazuhiko Yoshida and Hiroshi Uesugi.

Led by president Aki Ryuka,

Ryuka IP's IP team comprises attorneys, paralegals, engineers and translators. Clients come from domestic companies and MNCs in South Korea, Taiwan, China, Hong Kong, Malaysia and Singapore in the fields of electronics, telecommunications, software, optics, mechanical engineering, semiconductors, electronic materials, chemicals and biochemistry.

Led by managing partners Kenji Sugimura and Koji Sugimura, **Sugimura & Partners** is an IP specialist firm which represents both Japanese and international clients pursuing patent, design, and trademark protection in Japan. Its clientele ranges from single inventors and startups to well established academic institutions and multinational corporations from all sectors of the global economy. Top practitioners include Tetsuo Tsukanaka, Yuko Muramatsu, Kenichi Nakayama and Osamu Suzuki.

Yoshiyuki Inaba, Mitsuko Miyagawa and Toyotaka Abe are key practitioners at **TMI Associates**. The firm was named *Asia IP* patent firm of the year for Japan in 2019; its clients range from venture businesses to well-established high-tech companies. It also liaises with government agencies and has increasingly had opportunities to advise on policy. Besides copyright services, it also handles patent, utility model, design, trademark, trade secret, unfair competition, action plan, antitrust as well as licensing matters.

Founded in 1902, **Yuasa and Hara** is one of the oldest and largest law and patent firms in Tokyo. The firm was named *Asia IP* copyright firm of the year for Japan in 2019 and is a pioneer in multidisciplinary practice, consisting of a legal division, a patent division, a trademark & design division and an accounting division. Kozo Yabe, Kazuhiro Nakata, Hiromichi Aoki and Toshiaki Iimura closely cooperate with each other to provide complete and multiple IP services

to both domestic and foreign clients.

MACAU

Macau IP Firm of the Year
C&C Lawyers & Notaries
DSL Lawyers
FCLaw
MdME
RPmacau

C&C Lawyers & Notaries provides legal advice and services on a wide range of legal issues for both domestic and international clients. On top of general advice on IP issues, the firm's practice includes registration and IP portfolio maintenance; IP enforcement and protection; licensing and franchising; anti-counterfeiting and customs actions. Partner Lu Zhao leads the IP practice and acts as the top liaison for the firm's Chinese-speaking clients. The firm also has offices in Portugal, East Timor and Cabo Verde.

DSL Lawyers has developed a strong and highly experienced global IP practice. Some of its lawyers qualify as pioneers in the field of IP law, being responsible for establishing the largest portfolio of IP clients in Macau. Its practice includes trademarks, patents, utility models, designs and copyright. The firm's co-founding partner Carlos D. Simões heads the firm's IP and property practices. The firm was named *Asia IP* Firm of the Year for Macau in 2019.

Established in 2003, **FCLaw Lawyers & Private Notaries'** IP practice mainly focuses on patent and trademark work. The firm endeavours to manage and mitigate the risk of maximizing return from IP assets for the benefit of its clients. It provides assistance in all procedures for IP registration and protection, as well as formulation of strategies in order to safeguard and defend IPRs.

General practice **MdME**

Lawyers was only established in 2006, but it has quickly grown to include some of the most-experienced and most-active IP lawyers in Macau. Its clients encompass key corporations operating in Macau, covering diverse sectors such as banking, insurance, finance, gaming, real estate, energy, construction, infrastructure, retail, pharmaceuticals and telecommunication. Partner João Encarnação, head of the IP team, has advised and assisted on prosecution of thousands of applications for trademark, design, patent and other IP rights in Macau and overseas.

RPmacau is a full-service IP firm which is able to provide assistance on the full spectrum of matters including managing IP portfolios, determining the scope of IP, advising on registrability, acquisition and exploit value of IP as well as ensuring their protection. The firm handles both contentious and non-contentious matters including availability searches, registration, licensing, anti-counterfeiting, enforcement, and litigation.

MALAYSIA

Malaysia Copyright Firm of the Year

LAW Partnership

Rahmat Lim & Partners

Shearn Delamore & Co

Wong & Partners

Zaid Ibrahim & Co

Malaysia Patent Firm of the Year

LAW Partnership

Marks & Clerk

Shearn Delamore & Co

Wong & Partners

Zaid Ibrahim & Co

Gan Partnership is a dispute resolution- and IP-focussed firm based in Kuala Lumpur.

Malaysia Trademark Firm of the Year

Gan Partnership

Rahmat Lim & Partners

Shearn Delamore & Co

Wong & Partners

Wong Jin Nee & Teo

Partner Foong Lam Tai is a recognized expert in IP, IT and telecommunications. His telecommunications clients include many of the telecoms companies in Malaysia. He has a wide-ranging experience in negotiating and drafting commercial agreements relating to intellectual property and related fields. Partner Bahari Yeow is noted for his work on trademark infringement cases for local and global brands; with his teams, he is able to advise on every aspect of intellectual property. Partner Zhi Jian Lim is a skilled litigator who also advises on protection, management and monetization of IP, for clients including Fortune 500 companies, listed companies and tech startups.

The **LAW Partnership** is the relationship firm of Singapore firm **Harry Elias Partnership**. LAW Partnership is helmed by managing partner and IP head Suaran Singh Sidhu, IP practice group co-head Brian Law (who is also head of the Harry Elias IP group) and Cheah Chiew Lan. Brian Law has recently represented a Japanese battery manufacturer in successfully invalidating and expunging a substantially similar trademark in Malaysia on the basis that it was, among others, obtained by way of fraud, and represented one of the largest security seal manufacturers in managing its global trademark and patent portfolio, and in securing a permanent injunction and paid settlement sum in a successful patent infringement claim in Malaysia.

Well-established IP specialist **Marks & Clerk** handles all areas of intellectual property, with particular strengths in life science, information technology

and electronics. The firm has a global reputation for delivering quality parent prosecution and its Malaysia office handles patent drafting to UK and European standards. The Kuala Lumpur office is led by directors Gerald Samuel and Chris Hemingway.

The IP and technology team at **Rahmat Lim & Partners** offers a wide range of contentious and non-contentious IP-related services and advises on a broad spectrum of enforcement, management and transactional issues. The firm assists clients in making urgent court applications for injunctions and search and seizure orders as well as participating in raid actions. Partner Pauline Khor, head of the intellectual property and technology department, is known for her fresh perspective and creative resolutions and has 18 years of experience advising and acting for foreign and local multinational companies. Notable clients include Chanel, Walt Disney, Sony and Philips. The firm won the 2019 *Asia IP* Malaysia copyright firm of the year award.

Full-service firm **Shearn Delamore & Co's** IP practice is led by Karen Abraham, with its IP team providing professional services for more than 40 years and being widely recognized as one of the leading firms for patent filing, patent infringement and invalidation actions in Malaysia. Some of its notable clients include Marriott, Hermes, Formula One Management and British American Tobacco. Other top practitioners include Jyeshta Mahendran, Indran Shanmuganathan, Timothy Siaw and Yap Khai Jian. The firm was named the 2019 *Asia IP* patent firm of the year for Malaysia.

Wong & Partners, the Malaysia member firm of Baker McKenzie, is known for its work in patent litigation, filing and strategies. The firm has been engaged by La Pointique against its previous distributor, SJC Solex, in trademark infringement cases. Lead partner Kherk Ying Chew, one of the top litigators in the

country, heads up the practice, which has advised clients both major Malaysian companies like Measat Broadcast Network Systems as well as international businesses.

IP and technology boutique **Wong Jin Nee & Teo** provides a wide-spectrum of IP and technology law services and is renowned for its work in trademark application, litigation, as well as brand protection and enforcement work. Partners Jin Nee Wong and Bong Kwang Teo are recognized for their expertise in handling both litigation and non-contentious matters that extend to integrated IP services including portfolio management and exploitation both locally and abroad. The firm was named the 2019 *Asia IP* trademark firm of the year for Malaysia.

As part of the **ZICO Law** network, **Zaid Ibrahim & Co** provides a full range of IP law services encompassing both contentious and non-contentious aspects of IP since 2014. Its IP team has a shining reputation in the field thanks to the leadership of seasoned IP specialist Linda Wang who is experienced in IP litigation and disputes in all IP rights.

MYANMAR

Myanmar IP Firm of the Year

Kelvin Chia Yangon Ltd

Khine Khine U

Rouse

Tilleke & Gibbins

U Myint Lwin Law Office

Kelvin Chia Yangon, which has been active in Myanmar since 1995, is the oldest foreign legal consultancy firm based in Yangon. The firm maintains a large intellectual property registration portfolio and represents many international trademark and patent agents. Foreign consulting attorney Pedro Jose Fausto Bernardo is a key contact.

Khine Khine U Law Firm is

led by Khine Khine U, an important IP lawyer in Yangon. She advises on registering trademarks, patents and designs, and frequently assists in resolving problems with counterfeiters in Myanmar.

Rouse opened its Yangon office in November 2013. It offers patent, design and trademark filing and prosecution and portfolio management as well as a strong focus on IP commercialization, licensing and technology transfer. Senior IP lawyer Moe Mynn Thu and country manager Fabrice Mattei are key contacts.

Regional firm **Tilleke & Gibbins** has particular strength in intellectual property in its Yangon office. The Myanmar practice is supported by a team of more than 150 lawyers and consultants spread across five other countries. Yuwadee Thean-ngarm is a director and key contact; in 2017, she was elected secretary-general of the Thai Business Association of Myanmar, further strengthening an already significant platform for advocacy of IP legislative development and the firm's ties with the Myanmar business community. Notable clients include Bayer, CBS Corporation, Red Bull, Siam Cement and Sanofi.

U Myint Lwin Law Office is one of the most reliable firms in the country, with founder Myint Lwin providing consistent, high-quality service. The firm, which was founded in 1994, works with domestic and international clients in obtaining and maintaining trademark registrations. The firm was named the *Asia IP* intellectual property practice of the year for Myanmar in 2018 and 2019.

NEW ZEALAND

New Zealand Copyright Firm of the Year

AJ Park

Buddle Findlay

Chapman Tripp

Create IP

Simpson Grierson

New Zealand Patent Firm of the Year

AJ Park

Chapman Tripp

Ellis Terry

James & Wells

Simpson Grierson

New Zealand Trademark Firm of the Year

AJ Park

Buddle Findlay

Ellis Terry

Ironside McDonald

James & Wells

Asia IP trademark firm of the year for New Zealand in 2019 **AJ Park** houses a leading IP practice for both contentious and non-contentious works, further boosted by its acquisition of Baldwins in October 2020. Thus, in addition to its already dynamic team of lawyers led by Wellington-based principal Damian Broadley, the firm's capabilities have been heightened with the addition of former attorneys from Baldwins, which was named 2019 *Asia IP* copyright firm of the year for New Zealand. These lawyers include Penny Catley and Thomas Huthwaite for trademarks; Wes Jones and Chris Way for patents; and Paul Johns for copyright. Sarah Barclay, who specializes in patent, design and related IP law, has been promoted to principal while Andrea Dickens has taken the role of managing director. AJ Park itself is part of IPH Limited, the intellectual property company holding company.

General practice law firm **Buddle Findlay** offers both contentious and non-contentious work with an emphasis on trademarks and copyright matters. The firm also handles patent advisory, dispute resolution and litigation work, and carries out anti-counterfeiting actions as well as provides transactional support to IP owners. Partner John Glengarry, a specialist intellectual property lawyer with

extensive experience both in New Zealand and overseas, heads up the trademark team and co-leads the IP practice. British American Tobacco and Yahoo! are counted among the firm's clients.

Chapman Tripp is a full-service firm with 56 partners and a team of over 200 staff in Auckland, Wellington and Christchurch. The IP practice's notable work includes representing Twentieth Century Fox in copyright litigation over geo-blocking circumnavigation technology, and acting as counsel for global industrial player Allegion to defend patent infringement allegations in a three-week High Court trial. Partner Matt Sumpter is a key contact noted for his work in IP, competition law and civil litigation.

Create IP has considerable expertise in the management and commercialization of IP assets. It advised the Motion Picture Association of America, Microsoft (on its anti-piracy and copyright enforcement programme) and Starbucks, among others. The firm was founded by partner Robert Snoep, a Christchurch-based registered patent attorney who specializes in mechanics and engineering. In September 2020, partner Pip England was appointed as the firm's new chief executive partner, taking over from Nick Wells. He will assume the position in February 2021.

IP boutique **Ellis Terry** has offices in Auckland and Wellington, and provides a full suite of IP advice throughout New Zealand. Its software and electronics patent practice is one of the largest in New Zealand. Director John Terry is an established patent practitioner; director Blayne Peacock is a highly-regarded patent attorney. Director Emily Ellis is a key contact for branding and copyright matters. Among the firm's top-performing lawyers in recent years are principals Mathew Campbell for patent prosecution and Rachael Koelmeyer for trademark prosecution and trademark contentious.

Ironside McDonald lawyers

in Auckland bring a combined 40 years of experience to the table, having worked aside some of the most ambitious and innovative brands in Australasia. The firm advises on both local and international IP issues, including trade mark protection, copyright, designs, IP enforcement and defence, as well as IP licenses and agreements. The firm was formed in May 2019 by former Baldwins partner Sue Ironside and former Baldwins senior associate Rachel McDonald; both bring a wealth of experience, particularly in trademarks work. The firm recently added trademark attorney Ingrid Seegers and China-focused trademark consultant Solanda Chen.

James & Wells is a strong boutique player in New Zealand. Christchurch-based co-founding partner Ceri Wells is known for his work in the Society of Beer Advocates case against DB Breweries, and served as a past president for the New Zealand Institute of Patent Attorneys. Hamilton-based partner Ian Finch is a key contact for litigation. The firm's trademark team in Auckland is led by partner Carrick Robinson, who also has a focus in food & beverage innovation and related IP implications. Other key practitioners are Jonathan Lucas and Jason Rogers in the patent practice, and Gus Hazel for copyright. Britta Fromow, formerly of Catalyst IP, has joined the firm as a consultant.

Simpson Grierson has a strong IP practice. The firm's trademark prosecution work is particularly praised. Sony, Coca-Cola, Google and Novartis, etc. are among its notable clients. Partner Richard Watts, known for his trademark enforcement and border protection actions, heads the IP group. Sarah Chapman is a leading practitioner.

PAKISTAN

Founded in 1972, **Ali & Associates** is an internationally-recognized law firm specializing in IP, media

Pakistan Copyright Firm of the Year

Ali & Associates
Remfry & Son
Sheikh Brothers
United Trademark & Patent Services
Vellani & Vellani

Pakistan Patent Firm of the Year

Ali & Associates
Bharucha & Co.
Remfry & Son
Sheikh Brothers
Vellani & Vellani

Pakistan Trademark Firm of the Year

Ali & Associates
Bharucha & Co.
Sheikh Brothers
United Trademark & Patent Services
Vellani & Vellani

and IT. The firm was named the 2019 *Asia IP* patent firm of the year for Pakistan. The firm is led by senior partner Syed Auqil Ali Shah and managing partner Karimullah Adeni. The team is well-known for enforcement and litigation work, and has represented domestic and foreign clients in the cosmetic, chemical, textile, oil and gas, pharmaceutical, machinery, electronic, automobile and agriculture sectors. The firm has domestic offices in Karachi and Lahore, and foreign offices in Kabul and the Washington area.

Founded by Abdur Bharucha in 1948, **Bharucha & Co** is one of the oldest firms for patent and trademark prosecution work in Karachi. The firm collaborates with an IP-focused investigation agency, so time-restricted projects can be handled swiftly.

Founded in 1827 by Henry Remfry, **Remfry & Son**, located in Karachi, is a venerable law firm providing IP services in the fields of trademarks, domain names, patents, designs and copyright.

Top practitioners include Riffat Chughtai and Iffat Chughtai.

Founded in February 1948 in Karachi by the late Sheikh Fazal Ellahi, **Sheikh Brothers** is an IP boutique providing services covering all aspects of IP including patents, trademarks, trade secrets, copyright, unfair competition, licensing, franchising, technology transfer, litigation and enforcement. Amongst two partners, four associates and 10 other staff members, Sultan Ahmad Sheikh and Salman Ahmed Sheikh stand out of the crowd and represent well with clients at all forums including the Supreme Court of Pakistan. The firm bagged the *Asia IP* Pakistan trademark firm of the year award in 2019.

Based in Lahore, **United Trademark & Patent Services** offers services including anti-counterfeiting, administrative actions, and raids and seizures; arbitration and dispute resolution; acquisition and divestiture of trademarks; as well as enforcement, due diligence, investigation, inspection, litigation and portfolio management. Yawar Irfan Khan and Hasan Irfan Khan are top practitioners at the firm.

Vellani & Vellani was established in 1937 and is located in Karachi. Partners Badaruddin Vellani and Ameen Vellani have extensive corporate law practice in most prosecution work and, together, they lead a team which advises on matters related to trademarks, patents, copyright, domain names and anti-counterfeiting to both domestic and MNC clients as well as government agencies in fields such as pharmaceuticals, chemicals, vehicles and computer software. Erum Rasheed and Anwer Ghani are key patent practitioners, Khushnum Muncherji is a key contact for copyright work and Seema Mansoor is a good contact for trademark matters. The firm was named the 2019 *Asia IP* Pakistan copyright firm of the year.

PHILIPPINES

Philippines Copyright Firm of the Year

Angara Abello Concepcion Regala & Cruz

Cruz Marcelo & Tenefrancia

Hechanova Group

Quisumbing Torres

SyCip Salazar Hernandez & Gatmaitan

Philippines Patent Firm of the Year

Angara Abello Concepcion Regala & Cruz

Hechanova Group

Quisumbing Torres

SyCip Salazar Hernandez & Gatmaitan

Villaraza and Angangco

Philippines Trademark Firm of the Year

Angara Abello Concepcion Regala & Cruz

Cruz Marcelo & Tenefrancia

Quisumbing Torres

SyCip Salazar Hernandez & Gatmaitan

Villaraza and Angangco

Angara Abello Concepcion Regala & Cruz (ACCRALAW) has advised Fresenius Kabi Oncology in defending a patent infringement case filed by Aventis Pharma and its Philippine subsidiary. The firm has also represented Phillips Seafood Philippines in a patent infringement suit filed by Kanemitsu Yamaoka, the patent holder of a tuna smoking process. Senior partner Alex Ferdinand Fider, partners Victor N. De Leon, John Paul M. Gaba, Richmond K. Lee, Jose Eduardo T. Genilo and of counsel Aleli Angela G. Quirino and Rogelio Vinluan are top practitioners. The firm was named the *Asia IP* trademark firm of the year for the Philippines in 2019.

Led by senior partner Patricia AO Bunye, **Cruz Marcelo & Tenefrancia's** services include prosecution of applications for the registration of trademarks and patents and applications for issuance of copyright deposit; protection of business models,

trade secrets and undisclosed information; IP commercialization; handling administrative, civil and criminal cases; dispute settlement; mediation involving IPRs; and anti-piracy programs and intellectual property enforcement cases. Among others, the firm handles IP matters for the Department of Science and Technology–Technology Application and Promotion Institute and the Asian Institute of Management. Cruz Marcelo & Tenefrancia likewise represents the heirs and estate of National Artist for Theater and Literature Rolando S. Tinio for IP audit, contracts review and protection of his works through copyright deposit among others. Senior partner Susan Villanueva is a key IP contact. Among its lead lawyers are Rowanie A. Nakan and Criselda Santiago for patents and Divina Gracia E. Pedron and Carlo B. Valerio for copyright.

The **Hechanova Group – Hechanova & Co. and Hechanova Bugay Vilchez & Andaya–Racadio** – is based in Manila, where the former firm focuses on prosecution matters and the latter on litigation work. With key IP practitioners including president Editha Hechanova and partner Maria Gladys Vilchez, the firm advises on matters related to trademarks, patents, copyright, domain names, utility models, designs, litigation, licensing and franchising. One of its foremost clients is Alibaba Group Holding Limited for which the firm filed 44 applications covering various technologies in a 12-month period. Its newest hires are Chrissie Anne Barredo for patent prosecution and litigation, Ruhjen Osmena for litigation and Grace Carbonell for chemical patents. The firm was named *Asia IP* copyright firm of the year in the Philippines 2019.

As the first member firm of Baker McKenzie in Asia, **Quisumbing Torres** has been advising organizations such as Business Software Alliance and Warner Bros for 50 years. Led by partner Bienvenido Marquez III, who heads the firm's IP and

technology group in Manila, and highly-regarded partner Divina Ilas-Panganiban, the firm brings in-depth knowledge of local IP laws and business practices to matters ranging from licensing and franchising, technology transfer, to IP prosecution, litigation and enforcement.

Headquartered in Manila with branches in Cebu, Subic and Davao, **SyCip Salazar Hernandez & Gatmaitan** is one of the country's largest law firms in terms of client base and range of IP services. Led by partner Enrique T. Manuel, the IP team includes litigation specialists for inter partes and other administrative proceedings before IPOPHL as well as cases in courts designated to try unfair competition, copyright infringement, etc. Partner Vida M. Panaganiban-Alindogan is a key IP contact in the firm, which was named *Asia IP* patent firm of the year in the Philippines in 2019.

Based in Manila, senior partner Bienvenido I. Somera Jr. and partner Katrina Doble and Sophia C. Cruz-Abrenica lead **Villaraza & Angangco (V&A Law)** in providing services of trademark and patent prosecution, copyright registration, IP commercialization, licensing, franchising, litigation as well as enforcement actions.

SINGAPORE

Singapore Copyright Firm of the Year

Allen & Gledhill
Bird & Bird ATMD
Dentons Rodyk
Drew & Napier
Harry Elias Partnership

Singapore Patent Firm of the Year

Allen & Gledhill
Amica Law
Baker McKenzie Wong & Leow
Bird & Bird ATMD
Drew & Napier

Singapore Trademark Firm of the Year

Allen & Gledhill
Baker McKenzie Wong & Leow
Dentons Rodyk
Drew & Napier
Harry Elias Partnership

Allen & Gledhill provides advice on both contentious and non-contentious matters including prosecuting, enforcing and defending IPRs worldwide. Partner Stanley Lai heads the IP department with well-known clients such as Turner Broadcasting System, Pfizer, Inland Revenue Authority of Singapore, Nanyang Technological University, and Singapore Telecommunications. Other leading practitioners at the firm include Pei Lin Low for patents and trademarks and Tham Kok Leong for copyright matters.

Established in 2006, **Amica Law** is a specialist intellectual property and technology practice with patent and trademark practitioners, attorneys and associates. Cofounder and director Jason Chan and Jo-Ann See respectively lead the litigation and enforcement team as well as IP protection and management matters.

With more than 30 years of experience operating in Singapore, **Baker McKenzie Wong & Leow** provides full IP services including enforcement and litigation, patent transactions as well as portfolio management. Walt Disney and Ralph Lauren are clients. Managing principal Andy Leck has more than 20 years of experience in contentious and non-contentious IP matters and currently heads up the firm's IP practice. Principal Celeste Ang leads the litigation team. The firm was named *Asia IP* copyright firm of the year for Singapore in 2019.

Named *Asia IP* trademark firm of the year for Singapore in 2019, **Bird & Bird ATMD** opened in Singapore in 2009 and has since represented high-profile clients, including Nestlé, in infringement

dispute. Partner Alban Kang is well-known for his significant expertise in representing major companies in complex litigation, while joint managing partner Lorraine Tay is noted for her experience in international and cross-border issues. Anan Sivananthan is a top practitioner for patent and copyright matters. Litigation specialist Lijun Chui joined the firm as a partner in its dispute resolution practice.

Global law firm **Dentons** and venerable Singapore firm **Rodyk & Davidson** formalized their combination on April 25, 2016. In Singapore, the firm operates as **Dentons Rodyk**, and the IP practice was rebranded as Rodyk IP. Key contacts include Woon Chooi Yew, Gilbert Leong and Catherine Lee. The firm offers transactional and contentious services as well portfolio management.

Named *Asia IP* patent firm of the year for Singapore in 2019, **Drew & Napier** is a full-service firm with expertise across the range of contentious and non-contentious IP work including litigation, trademarks and service marks, copyright and designs, licensing, distributorship, franchising and confidentiality agreements. The firm accounts for approximately 20 percent of all patent filings in Singapore with the largest IP department. Director of IP Yvonne Tang, is a key contact. Following his appointment as a judicial commissioner of the Supreme Court of Singapore, former IP department managing director Dedar Singh Gill was sworn in as a judge on the High Court of Singapore in August.

Singapore firm **Harry Elias Partnership** was founded almost 30 years ago; after a merger with Eversheds Sutherland in 2017, the firms amicably demerged in June 2020. It assists clients with defending and taking action against offenders in trademark infringement and passing-off claims as well as in patent, design and copyright litigation. The firm has an advance system that

enables it to manage the filing and registration of large trademark, design and patent portfolios in a timely and cost-effective manner. Regional head of IP Brian Law is the key contact.

SOUTH KOREA

South Korea Copyright Firm of the Year

Cho & Partners

Kim & Chang

Lee & Ko

Lee International IP & Law Group

Yoon & Yang

South Korea Patent Firm of the Year

FirstLaw

Kim & Chang

Lee & Ko

Lee International IP & Law Group

Yoon & Yang

South Korea Trademark Firm of the Year

Cho & Partners

FirstLaw

Kim & Chang

Lee & Ko

Y.P. Lee, Mock & Partners

Cho & Partners is a favourite among luxury fashion and high-end retail brands; it also has top clients in the electronics industry. Tae-Yeon Cho is one of Asia's leading IP lawyers, and Ik-Hyun Seo is experienced in both American and Korean IP litigation and prosecution work. Attorney-at-law Yoon-Kyung Anne Kim, is recommended for negotiating and drafting licensing, franchising, joint venture and distribution agreements as well as overseeing the development of internet and e-commerce initiatives.

FirstLaw is noted for its prosecution work, especially in patents. The firm boasts experts in chemistry, including

organic and inorganic chemistry, chemical engineering, textile engineering and cutting-edge technology including polymers, nanotechnology and semiconductors; electronics and information technology; and mechanics. The firm is led by president Changse Leon Kim, who has a PhD in chemical engineering and has represented companies including Procter & Gamble and SKC in patent infringement actions.

Based in Seoul and headed by Jay Yang, **Kim & Chang's** IP practice is the largest in the country, with more than 300 professionals, including IP litigators, patent attorneys, and foreign IP attorneys, as well as over 550 patent engineers, trademark paralegals, and support staff. The firm was named *Asia IP* trademark firm of the year for South Korea in 2019.

With offices in Seoul, Beijing, Ho Chi Minh City and Hanoi, **Lee & Ko** is a full-service law firm headquartered in Seoul and offers IP services in the fields of electronic, chemical, pharmaceutical, genetic technology, mechanical, telecommunication, computer software and semiconductor. The IP team comprises former judges specializing in IP laws at the Supreme Court and Patent Court, as well as former KIPO examiners. Partner Hyeon Gil Ryoo is a key contact; the firm was named *Asia IP* patent firm of the year for South Korea in 2019.

Since 1961, **Lee International IP & Law Group** has been a leader in Korean IP with one of the largest and most active domestic practices, advising on patent prosecution, trademark registration, and a wide range of IP disputes, including patent litigation, trademark litigation, anti-counterfeiting and infringement matters, domain name disputes, copyright disputes and trade secret enforcement. Managing partner Terry Taehong Kim, Jin-Hoe Kim and Yoon Suk Shin are top practitioners at the

firm, which was named the *Asia IP* copyright firm of the year for South Korea in 2019.

Yoon & Yang's IP practice comprises an IP practice group and a separate patent prosecution group. Both of the patent and IP attorneys are experienced in many technical disciplines, which allow them to offer services from securing, protecting and defending IP to advising on IP transactions in a wide range of technologies. Partner Wonil Kim is a key contact.

Led by representative patent attorney YoungPil Lee, **Y.P. Lee, Mock & Partners** offers services in technology fields including electronic engineering, IT, nanotechnology, computer hardware and software, semiconductors, mechanical engineering, biotechnology and healthcare.

SRI LANKA

Sri Lanka Copyright Firm of the Year

DL&F De Saram

John Wilson Partners

Julius & Creasy

Neelakandan & Neelakandan

Sudath Perera Associates

Sri Lanka Patent Firm of the Year

DL&F De Saram

John Wilson Partners

Julius & Creasy

Neelakandan & Neelakandan

Sudath Perera Associates

Sri Lanka Trademark Firm of the Year

DL&F De Saram

FJ&G de Saram

John Wilson Partners

Julius & Creasy

Sudath Perera Associates

DL&F De Saram was founded in Colombo in 1901 by Richard

Francis De Saram. Manjula Sirimane and Prabash De Saram are key practitioners to register patents, trademarks, industrial designs and copyright, as well as to advise on infringement and litigation.

Founded in 1841 in Colombo, **FJ&G de Saram** covers all areas of corporate and commercial law with a particular strength in IP. Many Fortune 500 companies are clients of the firm. Partner Jayathri Kulatilleke is among the firm's key IP practitioners.

John Wilson Partners, which was named the 2019 *Asia IP* trademark firm of the year for Sri Lanka, offers clients responsive, professional and fast turnaround for all types of IP filings. Managing proprietor John Wilson has invested considerable resources over the years to develop in-house custom docketing software, which facilitates efficient handling of large client portfolios, applications and renewals. Among its top IP practitioners are Sameendra Perera for trademark, patent and copyright; John Wilson for patent and copyright; and Benazir Hassan for trademark.

Century-old civil law firm **Julius & Creasy**, the 2019 *Asia IP* patent firm of the year for Sri Lanka, offers advice on enforcement, management and transactional matters pertaining to IP law. The firm has acted for several Fortune 500 companies and has acted as Sri Lanka correspondent of several trademark and patent attorney firms in Europe, the US and Asia. Key IP practitioners include J.M. Swaminathan and Anomi Wanigasekera.

Neelakandan & Neelakandan is led by partners Sashidevi Neelakandan and Saravanan Neelakandan. Partner Pranavan Neelakandan leads an IP team which handles a large volume of trademark, industrial design and patent applications for both local and foreign clients, such as Rolls Royce, Google, Hilton, Audi, Panasonic, LG, Hyundai, Levi Strauss, Singer and Hermes

International. The team also advises on trademark infringement and litigation.

Sudath Perera Associates is a full-service law firm whose clients include local, multinational, Global 1000 and Fortune 500 enterprises as well as emerging companies. Key IP practitioners include managing partner Sudath Perera and partner Himani Perera. The firm was named the 2019 *Asia IP* copyright firm of the year for Sri Lanka.

TAIWAN

Taiwan Copyright Firm of the Year

Chen & Lin

Eiger

Lee and Li

Saint Island International Patent & Law Offices

TIPLO

Taiwan Patent Firm of the Year

Lee and Li

Tai E International Patent & Law Office

TIPLO

Tsai, Lee & Chen

Tsar & Tsar

Taiwan Trademark Firm of the Year

Eiger

Lee and Li

Tai E International Patent & Law Office

Tsai, Lee & Chen

Tsar & Tsar

Chen & Lin is noted for its general business advice in Taiwan, including a top intellectual property practice, as well as providing advice in corporate, securities, finance and business litigation. The firm's clients include a wide variety of clients including a world-class semiconductor foundry

company, several multinational corporations and many major national and international players in high tech and information industry involved in patent, copyright, trademark and trade secret license or infringement, telecommunication, depositary receipt or convertible bond issuance, joint venture, merger and acquisition, trade practices, syndicated loan arrangement and environment protection. The firm, which was founded in 1992, is led by Che-Hung Chen, who has extensive experience in legal issues that could be faced by industries such as semiconductor, telecommunication, pharmaceuticals and information and high tech.

Eiger provides a variety of services for clients in and outside Taiwan, including handling trademark enforcement efforts in Taiwan on behalf of major American fashion label Tory Burch. Senior partner John Eastwood, of the firm's greater China practice, has headed up the firm's intellectual property and technology practice for the past several years. Of counsel Eve Chen is an experienced litigator and counselor with a strong background in intellectual property enforcement, working with many major brands on their country-wide efforts. The firm has done anti-counterfeiting work against sellers of fake TOMS shoes, resulting in more than US\$2 million in fakes being seized and destroyed by authorities. It has also done licensing work for Dolby.

With headquarters in Taipei and branch offices in Hsinchu, Taichung and southern Taiwan, **Lee and Li** was named the *Asia IP* patent firm of the year for Taiwan in 2019. The firm has formed an alliance with Leaven IPR Agency in Beijing to develop the mainland China market. Senior counselors Joseph Yang and Cathy Ting and partners Ruey-Sen Tsai, Dennis Huang and Hsiu-Ru Chien are key contacts at the firm.

With offices in major cities of Taiwan including Taipei, Taichung,

Tainan, Chiayi and Kaohsiung, **Saint Island International Patent & Law Offices** has engaged in assisting domestic clients seeking IP protection not only domestically but also globally. The Taipei office in particular is well-staffed with lawyers, patent attorneys and engineers experienced in international IP practice and capable of meeting the needs of international clients in all aspects. Managing partner Patrick I.C. Yun is a key contact. The firm was named the *Asia IP* copyright firm of the year for Taiwan in 2019.

Tai E International Patent & Law Office has about 260 staff in all affiliates, and has developed into a highly respected international IP law firm providing a full range of services. Tai E has been continually voted by overseas peers and clients as one of best IP law firms in Taiwan and earned a reputation by consistently ranking at the top in terms of issued patents and trademarks obtained for our national clients. Key IP practitioners include managing partner Fred C.T. Yen, partner and CEO Jerry C.Y. Lin and president Henry C.H. Guei.

TIPLO, also known as Taiwan International Patent & Law Office, was founded in 1965; five decades, later the firm is one of the largest and most reliable intellectual property law firms in Taiwan with diversified expertise to encompass IP as well as general legal services provided by a full-service law firm. Director J.K. Lin is an expert in IP law, licensing and anti-monopoly/unfair competition/fair trade law. Nelson Yu, who is chief of the firm's patent department, is especially knowledgeable in patent drafting and prosecution and assessment in the high-tech areas, including circuit design, semiconductor, communication, and computer software field. He helps global companies like Intel, Apple, Sun Microsystems, Genesis and many others in practicing and enforcing their patents in Taiwan and worldwide.

Taipei-based **Tsai, Lee & Chen** is particularly well-known

for its work with high-tech patents. The firm has seen extensive growth in recent years, especially in its domestic patent department. The firm manages more than 30,000 patents and 18,000 trademarks worldwide and has established 1,300 professional networks with global IP law firms and associates. Victor S.C. Lee, Thomas Q.T. Tsai, Crystal J. Chen and Candy K.Y. Chen are top IP practitioners. The firm was named the *Asia IP* trademark firm of the year for Taiwan in 2019.

Tsar & Tsai is a full-service law firm founded in 1965 by Ruchin Tsar and Paul C. Tsai. The firm has considerable experience and expertise on IP matters, including the protection of trade secrets. The firm represented a well-known chocolate manufacturer in a trademark opposition case and successfully obtained TIPO's grant to revoke the opposed mark. Partner Jennifer Lin and Joyce Ho are key contacts for IP matters. The firm has offices in Taipei and Hsinchu.

THAILAND

Thailand Copyright Firm of the Year

Baker McKenzie
ILAWASIA
SCL Nishimura
The Legal
Tilleke & Gibbins

Thailand Patent Firm of the Year

Baker McKenzie
Domnarn Somgiat & Boonma
ILCT
SCL Nishimura
Tilleke & Gibbins

Partners Say Sujintaya, Dhiraphol Suwanprateep, Nont Horayangura and Tanakrit Tangburanakij consistently make **Baker McKenzie** one of the top IP law firms in the region; it was named *Asia*

Thailand Trademark Firm of the Year

Baker McKenzie
Domnarn Somgiat & Boonma
ILCT
Satyapon & Partners
Tilleke & Gibbins

IP's trademark firm of the year for Asia Pacific in 2019. The firm manages the patent and trademark portfolios of some of the world's largest pharmaceutical, software and consumer goods companies. It also regularly advises on patent and trademark prosecution matters as well as licensing and is heavily involved in all manners of enforcement, including the coordination of anti-counterfeiting and anti-piracy campaigns, as well as IP-related litigation.

One of the oldest and largest IP firms in the country, **Domnarn Somgiat & Boonma** is led by partner Rutorn Nopakun. The practice handles many trademark applications filed in Thailand and almost half of the patent applications filed by foreign companies. Among its leading practitioners are Nathapong Tongkaew for trademark, Chakrapat Mongkolsit and Prabjote Busdee for patent, and Juthatip Vejsureeyakul for copyright. Associates Padcha Ritkasem and Nutthakarn Phongphunpunya are the latest additions to the firm. The firm was named the *Asia IP* trademark firm of the year for Thailand in 2019.

ILAWASIA is experienced in dealing with trademarks, trade names, industrial designs, inventions, copyright, geographical indications, trade secrets and domain names. The firm's services include due diligence, prosecution, customs recordal, enforcement and litigation for both domestic and overseas clients. Saowaluck Lamlert, Tatchaporn Natprasertkul and Dhanasun Chumchuay are key IP contacts.

Founded in 1966, **ILCT**, formerly International Legal Counsellors Thailand, is Russian

& Vecchi's office in Bangkok. The IP practice offers services such as registration, copyright protection, contesting infringement and counterfeit issues. Partner Palawi Bunnag is a key IP contact.

Named the *Asia IP* patent firm of the year for Thailand in 2019, **Satyapon & Partners** was founded by Satyapon Sachdech in 1995 and practices IP law exclusively. Sachdech is a skilled lawyer who was president of the Intellectual Property Association of Thailand from 2009 to 2019 and is a lecturer of IP law at both Dhurakij Pundit University and Thammasat University. Other key members are Kritchawat Chainapasak who is the head of the patent & design practice and Kritsana Mingtongkhum who is the head of the trademark and litigation practice.

Chavalit & Associates, the IP and IT arm of **SCL Nishimura**, is led by managing partner Chavalit Uttasart. Partner Pavinee Bunyamisara specializes

particularly in the fields of e-commerce and trademarks. Partner Phatthawat Nakaranuruck was once senior legal officer with the Department of Intellectual Property in the Ministry of Commerce; he has had extensive experience in IP and IT litigation as well as arbitration on several high-profile matters.

Newcomer **The Legal** is a boutique law firm in Bangkok founded by experienced lawyers from several renowned law firms in Thailand. The firm provides legal services to clients from individuals to juristic entities and local to multinational companies, as well as government authorities. The full-service firm's IP practice is helmed by Panisa Suwanmatajarn, who is also the firm's managing partner. She has a dozen years of experience in intellectual property, corporate and commercial and information technology fields. She was senior associate at Siam Premier International Law Office and a partner at RWT

International Law Office. She has been involved with inbound and outbound trademark prosecutions, intellectual property infringement, contracts related to intellectual property such as licensing agreements, franchise agreements, and outsourcing agreements. Jinnaphat Srithepnamrong has joined the firm recently as part of its IP team.

Named *Asia IP* copyright firm of the year for Thailand in 2019, **Tilleke & Gibbins'** IP team in Bangkok consists of key practitioners Darani Vachanavuttivong, Alan Adcock, Nandana Indananda, Sukontip Jitmongkolthong, Suebsiri Taweepon, Wiramrudee Mookhavesa and Somboon Earterasarn. The prosecution practice handles patent and trademark searches, registration, recordal, annuity, opposition, cancellation, watches, infringement assessment, freedom to operate analyses, validity assessments and license

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agreements. For contentious work, the firm handles investigations, training, market surveys, anti-counterfeiting campaigns, preventive strategies, civil and criminal actions, raids, alternative dispute resolution, public relations, lobbying and enforcement liaison work.

VIETNAM

Vietnam Copyright Firm of the Year

Ageless IP Attorneys and Consultants

Baker McKenzie

Pham & Associates

Schmitt & Orlov

Vision & Associates

Vietnam Patent Firm of the Year

Ageless IP Attorneys and Consultants

Bross & Partners

Pham & Associates

Tilleke & Gibbins

Trung Thuc

Vietnam Trademark Firm of the Year

Baker McKenzie

Pham & Associates

Schmitt & Orlov

Tilleke & Gibbins

Vision & Associates

Established in 2001, Hanoi-based **Ageless IP Attorneys & Consultants** specializes in the full-range of IP services, from registration, prosecution, transactional services to litigation and enforcement of IP rights. The strong team has advised for domestic and international corporations such as GM, Daewoo, Hyundai, Honda and Lenovo. The firm is one of the five largest IP firms in the country in terms of the number of patent and trademark applications filed. Chairman Nguyen Duc Than is a former deputy director general of NOIP

and has more than a half-century of experience in the field. Leading practitioners are Nguyen Duc Xuan for patent and trademark work, Pham Thi Tuoi for trademark work and Nguyen Thi Khanh Linh for patent. Among the firm's new hires is Nguyen Thi Thanh Vanm, former director of the trademark department of the National Office of Intellectual Property. Her other area of expertise is geographical indications.

Named *Asia IP* trademark firm of the year for Vietnam in 2019, the IP teams at **Baker McKenzie** in Hanoi and Ho Chi Minh City have played an instrumental role in helping both local and multinational clients realize the value of their IP portfolios. The firm is represented before the NOIP, courts and authorities by BMVN International, a fully-licensed law firm and IP agent. Partner Tran Manh Hung heads the firm's IP practice in Vietnam. Partner Minh Tri Quach in Hanoi is a key contact.

The IP practice at full-service firm **Bross & Partners** boasts a client list including corporations listed in *Forbes* Magazine's "Asia's 200 best under 1 billion USD" list, companies in the "Top 500 Vietnamese Largest Private Enterprises (VNR500)" list and a great deal of regional and local entrepreneurs. Hanoi-based partner Le Quang Vinh is a key IP contact at the firm; he has more 15 years of experience in advising and representing regional and international industrial and commercial groups on the spectrum range of IP rights-related issues.

Named *Asia IP* patent firm of the year for Vietnam in 2019, **Pham & Associates** provides one of the best all-round IP services in the country from offices in Hanoi, Ho Chi Minh City, Da Nang and Hai Phong. Its respected work in patent prosecution and enforcement has attracted international clientele including Honda, BMW and Johnson & Johnson.

Schmitt & Orlov operates in Greater China, Russia and CIS

countries, and Southeast Asia including Thailand, Cambodia and Vietnam, where its office is located in Ho Chi Minh City. It specializes in patents, copyright and trademark prosecution, enforcement, media and entertainment and personality rights including data privacy and protection. Yen Pham, who has extensive IP prosecution and contentious matter experience, has joined the firm as a senior IP attorney. Meanwhile, Ho Chi Minh-based Hau Nguyen has been promoted to the role of deputy director for Southeast Asia where she will work directly with Daniel Greif, the firm's director for Southeast Asia.

Led by managing director Thomas J. Treutler, **Tilleke & Gibbins** handles all aspects of IP including anti-counterfeiting and strategic filing. In terms of contentious work, the firm has full in-house investigative teams in both Hanoi and Ho Chi Minh City, staffed with seasoned experts who have worked for top international law firms as well as law enforcement. It is one of the largest IP registration practices in Vietnam, with over 1,000 patent and trademark filings annually. Principal Loc Xuan Le is a key contact.

Trung Thuc provides services in all areas of intellectual property law, including acquisition, prosecution, maintenance and enforcement of trademarks, patents, copyright and licensing matters in Vietnam. The firm represents clients in motor engineering, telecommunications, pharmaceutical and biotech industries from the United States, United Kingdom, Japan, Australia and other countries. Nguyen Viet Thang is senior partner.

The IP group at **Vision & Associates** handles all aspects of IP including filings and prosecutions, availability searches, licensing and franchising as well as enforcement. It has acted for Unilever in an infringement investigation against a local company which resulted in a seizure and destruction of over

5,000 infringing products. Other notable clients include HP, P&G and Coca-Cola.

ASIA PACIFIC

Asia Pacific Copyright Firm of the Year

Baker McKenzie

Bird & Bird

Dentons

Hogan Lovells

Tilleke & Gibbins

Asia Pacific Patent Firm of the Year

Baker McKenzie

Bird & Bird

Eversheds Sutherland

Spruson & Ferguson

Tilleke & Gibbins

Asia Pacific Trademark Firm of the Year

Baker McKenzie

Dentons

Eversheds Sutherland

Hogan Lovells

Tilleke & Gibbins

Baker McKenzie serves Asia through its offices in Australia, China, Jakarta, Tokyo, Kuala Lumpur, Manila, Singapore, Seoul, Taipei, Bangkok, Yangon, Almaty, Doha, Jeddah, Riyadh, Abu Dhabi, Dubai and Vietnam. The firm boasts the largest IP brand management practice in the world, overseeing some of the world's biggest portfolios for more than 200 multinational companies. Baker McKenzie was named *Asia IP* trademark firm of the year for Asia Pacific in 2019.

After establishing its footprint in Asia-Pacific nearly 20 years ago, international commercial firm **Bird & Bird**'s Asia network comprises offices located in Beijing, Hong Kong, Shanghai, Singapore and Sydney, with a team of over 140 lawyers and legal



professionals. It also has teams advising on matters throughout ASEAN, Japan, South Korea and India. Bird & Bird was named *Asia IP* patent firm of the year for Asia Pacific in 2019.

Through the 2015 merger between **Dentons** and Dacheng Law Offices, the global law firm has the best coverage in mainland China of any of its peers: more than 45 offices in the PRC, plus another in the Hong Kong Special Administrative Region. The firm also has Asia Pacific offices in Baku, Muscat, Port Moresby, Auckland, Wellington, Yangon, Ulaanbaatar, Kuala Lumpur, Nur-Sultan, Almaty, Amman, Jakarta, Doha, Jeddah, Riyadh, Singapore, Seoul, Abu Dhabi, Dubai, Tashkent and in five cities across Australia.

Eversheds Sutherland has made important strides in Asia in recent years, despite the amicable dissolution of its venture into Southeast Asia with the Harry Elias Partnership. The firm boasts offices in Shanghai, Beijing, Hong Kong, Baghdad, Doha, Abu Dhabi, Dubai and Riyadh. Eversheds also has a Japan Business Group and an India Group, both of which are managed out of its London headquarters.

Hogan Lovells' intellectual property group helps drive its clients' business growth by protecting and leveraging ideas and innovations, brands and creative works. With almost 400 lawyers, specialists, and paralegals worldwide, the firm combines

a strategic, global outlook with local knowledge and a keen understanding of the technological and business factors involved in this area of law. It also has one of the strongest networks in Asia, with offices in Hanoi, Ho Chi Minh City, Jakarta, Beijing, Hong Kong, Shanghai, Singapore, Tokyo and Ulaanbaatar. Hogan Lovells was named *Asia IP* copyright firm of the year for Asia Pacific in 2019.

Spruson & Ferguson companies are incorporated entities owned by IPH Limited, a publicly listed holding company for a number of IP professional services brands operating across Asia and the Pacific. Russell Davis heads the firm's Australian offices while Coral Toh leads the Asia trademarks group from Hong Kong. The firm has offices in Brisbane, Melbourne, Sydney, Beijing, Hong Kong, Jakarta, Kuala Lumpur, Singapore and Bangkok.

Stalwart **Tilleke & Gibbins** is a leading firm for work in Southeast Asia, with 190 lawyers spread across Bangkok, Hanoi, Ho Chi Minh City, Jakarta, Phnom Penh, Vientiane and Yangon. The full-service firm is particularly noted for its work in intellectual property, but also boasts strong commercial transactions, M&A and dispute resolution practices. Darani Vachanavuttivong is co-managing partner and managing director of the firm's IP practice; Alan Adcock is a partner and deputy director of the firm's IP and regulatory affairs groups. 

IP matters to remember when the company is on the verge of closing down



If Covid-19 has forced you out of business, your IP probably still has value. **Espie Angelica A. de Leon** speaks with five lawyers from around the region who can help you extract whatever value remains.

We are headed toward the end of 2020 and the pandemic continues its ugly reign. As a result, businesses around the world have either closed down some outlets or shut down altogether.

When a business is on the verge of closing down, do its owners know how to go about it? In particular, do they know what to do about their intellectual property assets?

To some of them, this could be unfamiliar territory.

According to Patricia Bunye, senior partner and deputy managing partner for administration at Cruz Marcelo & Tenefrancia in Manila, many of their clients, mostly the large companies and those from the technology industry, do have some awareness of IP's importance. They also generally have adequate IP provisions in their agreements to protect their interests.

Some other businesses, however, do not.

"Unfortunately, there are also companies such as some startups, that tend to be aggressive," said Bunye, "but overlook or do not pay attention to IP protection or IP strategy as much as they should."

Elena Szentivanyi, director at Henry Hughes Intellectual Property in Wellington, said that based on her experience, clauses on IP matters in employee agreements can be unclear and potentially do not achieve what they intend to achieve. In some cases, the parties to the agreement do not understand these clauses at all.

"The New Zealand Law Society standard form company constitution does cover the use of company information by directors but does not otherwise address IP matters. If the business is not incorporated, it is highly likely that there is no documentation addressing IP matters. This is particularly so if the business has a single founder. If there are multiple founders or the business is established as a partnership, there is likely to be an agreement between the parties which I would expect to address IP matters in some manner," said Szentivanyi. "However, it is likely that that the agreement does not adequately cover all aspects of IP ownership, use and what happens when the business winds up."

Under this scenario, business enterprises about to fold up may indeed be stepping into territory that is not just unfamiliar, but also potentially damaging.

Asia IP reached out to five IP attorneys from different jurisdictions in the region to discuss IP matters that businesses should know about and act upon before finally closing shop.

Below are questions which some business owners and IP leaders may be asking, with the relevant answers provided by the attorneys.

If a company is on the verge of closing down, who will retain ownership of the IP?

"When a company is on the verge of closing, just like the other assets of the company, the intellectual property rights can be sold by the promoters and/or directors. In case the assets are under lien to a bank or financial institution, the bank will have the right over these assets," said Ranjan Narula, managing partner at RNA, Technology & IP Attorneys in Gurugram.

In Thailand, there is no specific law that addresses this situation. However, some IP laws have provisions regarding the status of an IP right after the shutdown. For example, the country's trademark law states that if the owner of a registered trademark ceases to have its office or address or its company is dissolved in Thailand, its trademark registration may be cancelled by the Trademark Registrar pursuant to Section 59 of the Thai Trademark Act.

"Thus, before the closure of a company, it is advisable to complete the assignment of the IP to a particular person while the company directors are still authorized to do so in the name of the company," said Ratinuch Kawnachaimongkol, a partner at ILCT Ltd. in Bangkok.

According to Szentivanyi, if the company owns the IP, it can transfer ownership to anyone including a founder or director of the company. "This should be done for fair value," she said.

In the Philippines, ownership of a registered trademark is maintained by its continuous use.

"[This is] proven through the periodic filings of Declarations of Actual Use with the IPOPHL. Hence, in the event that a company ceases operations permanently and there are trademarks registered under its name, the company's ownership over the same may be cancelled by the IPOPHL after the covered period has lapsed for reasons of abandonment or non-use," explained Bunye.

Can the company owners/founders license or transfer ownership of the IP to themselves?

Yes they can, said Narula, "so long as they owned all of the shares of the company, they can create the structure that IP is owned by them and they license it to the company or vice versa."

"As the company and directors/shareholders are viewed as different legal entities, the company as the IP owner may license or assign the IP to its directors/shareholders as long as the applicable law is complied with," said Kawnachaimongkol.

Indeed, there is no stopping company owners and founders to license the IP to themselves. But, this should be done on arms' length commercial terms, said Siau Wen Lim, director of IP at Drew & Napier in Singapore.



“If the company is wound up due to its insolvency, company owners and founders should pay particular attention to certain prohibitions against undervalue transactions or unfair preference transactions, as the transaction may be rendered void at the application of a liquidator or manager. This is applicable even if the transaction was made three years prior to the commencement of the winding up, and only if the company was insolvent then, presumed insolvent, or became insolvent as a result of the transaction,” explained Lim.

“Even where a licensing transaction is valid, other impediments may arise. Where an IP right is licensed, ownership continues to vest in the company. The implications of this are important. When a company shuts down, its assets will be dissipated or transmitted, or liquidated and paid out to creditors. The outstanding assets of a defunct company will generally vest in the

Official Receiver. To avoid complications relating to the continued validity of the license, company owners and founders can consider purchasing or otherwise assigning the IP rights to themselves instead, subject to the above caveats,” she added.

Should IP be sold before or after the shutdown?

“It can be done both ways. However, it is advisable to sell before the shutdown in order to maximize its value and find the right buyer,” said Narula. “Generally, if it is sold after closing, it can substantially erode IP value.”

Selling and assignment of IP prior to the shutdown also helps to avoid complications arising from the closure of a company, according to Kawnachaimongkol.

In New Zealand, things are more complicated. Still, transferring ownership before the closure is the wiser move.

Szentivanyi explained: “Any property owned by the company, including all rights vested in or held on trust for the company, that have not been assigned before the removal of the company from the Companies Register, vests in the Crown with effect from the removal of the company from the Register. This includes any IP rights or registrations that have not been transferred before the company is wound up. The property becomes *bona vacantia* or ownerless property.”

“As the company no longer exists as a legal entity, it is not able to assign the ownership of the IP to any interested party. Where the ownership of the IP has vested in the Crown, it is possible to request the Crown to transfer ownership of the registration,” she said.

Since the process can be complicated, it is better to transfer ownership of the IP before the company folds up.

Can the developer of a technology who was an employee of the company, continue to work on that technology on his own after the company folds up (say, he forms his own company and continues to work on the technology for his own firm)?

Employment agreements should contain IP clauses as to ownership. In most cases, the patent or copyright for any invention or work created by an employee in the course of his employment in the company is owned by the latter, unless otherwise stipulated in the agreement.

In the case of an independent contractor, he is likely to have signed an agreement as well, assigning IP rights to the company for which he is rendering his services.

“In both scenarios, once the company shuts down, the potential buyer will carry out due diligence and identify the IP assets, thus can stop any third party from exploiting its IP assets. Therefore, if the original developer of the technology wishes to continue to work on the technology, he will be required to buy the same or license the same from the defunct company or the new owner of the company,” said Narula.

In the absence of an agreement containing such clauses, the patented invention is owned by the company or employer.

"Under the Covid-19 pandemic, whether a public health emergency qualifies as a ground for mutual termination of the agreement or a ground for avoiding liability for non-compliance with contractual obligations may also be considered during the closure process."

—PATRICIA BUNYE,
senior partner, Cruz
Marcelo & Tenefrancia,
Manila

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—RANJAN NARULA, managing partner, RNA, Technology & IP Attorneys, Gurugram

“Under this circumstance, to enable the original developer of the technology or employee in this case to use such invention on his own after the shutdown without infringing any IP rights of the employer, the said patented invention must be assigned from the company to its employee before the shutdown,” said Kawnachaimongkol. “The developer can also sell his patented technology to another person.”

“If the creator or developer was a founder or director of the company and is the owner of a registered IP right, it is probable they are holding the IP rights on trust for the company,” according to Szentivanyi. “In that role he or she should not gain any personal benefit from the use of the IP.”

“If the invention was made outside of his regular duties, however, the developer-employee will be able to appropriate it as he sees fit,” said Bunye, “since the right to the patent would belong to him and not the company.”

Bunye added that many companies also include non-compete clauses into their employees’ contracts. This is to ensure protection for their IP during the period of employment as well as after employment or after the employee has left his employer.

“It is generally recommended that these stipulations be incorporated into any contract involving the development of technologies that will be utilized or commercialized by a company in order to avoid any complications that may arise in determining who has the right to appropriate said technologies,” said Bunye.

Does the same hold true for trade secrets? For example, can a member of a restaurant’s kitchen staff who developed a secret recipe for the restaurant, use the same recipe when the business closes and he decides to open his own food venture?

“The owner of a trade secret is a person who discovers, invents, compiles or creates trade information that is eligible for protection as a trade secret under Section 3 of the Thai Trade Secret Act,” said Kawnachaimongkol. “In the absence of the agreement providing otherwise, the developer of a trade secret could, therefore, be regarded as the owner of a trade secret who can continue using the same after the closure of his previous employer’s shop.”

But, if the developer of the trade secret is an employee, said trade secret is owned by the company under the terms of the employment agreement, as with all IP rights, said Szentivanyi. In this case, the developer should then acquire the trade secret for good value before using it for his benefit, including selling it.

However, considering that the trade secret in question is a recipe and the restaurant business has folded up, Narula said that the chances of objection are slim. “It may be difficult to prove that recipe has been stolen as opposed to a technology. Also, on trade secrets, we do not have a sui generis law in India and is based on common law rights and generally clubbed with copyright infringement,” Narula explained.

In the Philippines, trade secret protection is also a challenge since it is not expressly provided for under

the IP Code. However, other laws such as the Revised Penal Code, New Civil Code and Consumer Protection Act do address the issue and penalize the unauthorized disclosure or acquisition of trade secrets.

“Nevertheless, trade secrets are usually protected by contractual provisions in non-disclosure agreements and/or confidentiality clauses in employment contracts. Whether or not trade secret protection is enforceable will also depend on the particular circumstance of each case. Usually, the developer of a trade secret will not be permitted to sell or utilize the same, especially if confidentiality is expressly provided for under his employment contract. Many agreements involving the sharing of trade secrets also incorporate non-compete and non-disclosure clauses preventing employees from utilizing sensitive commercial information or setting up competing companies after separation from employment,” Bunye added.

What other IP-related matters should company owners and investors look into before actually closing down their firm?

According to Narula, they should examine the following:

- Claims for infringement of IP, including any IP litigation or arbitration
- Liens or encumbrances on the IP
- Domain names
- Source code or object code escrows
- Social media accounts (Twitter, Facebook, LinkedIn, etc.)
- Software and databases
- Open-source software used in (or used to create) the seller’s products and services
- Third-party contract manufacturing agreements, non-disclosure agreements
- Technology licenses
- Contracts providing for indemnification of third parties for IP matters

They may want to check their franchising and licensing contracts and other IP agreements with third parties to see if these contain provisions relating to bankruptcy or closure as a ground for termination of such agreements.

It would also be best to identify which obligations will survive the termination of a contract.

Note that these matters should be viewed through the lens of the present health crisis.

“Under the current novel coronavirus Covid-19 pandemic, whether a public health emergency qualifies as a ground for mutual termination of the agreement or a ground for avoiding liability for non-compliance with contractual obligations may also be considered during the closure process,” explained Bunye. “The applicability of force majeure as a ground that would release both parties from liability under the contract is an important factor to take into consideration, as it would essentially exempt the closing company from further complying with its contractual obligations without the usual repercussions that may come with unilateral pre-termination.” 

What tech startups need to know in this time of pandemic

Although opportunities in some industries have dried up during the pandemic, tech startups are booming. *Excel V. Dyquiango* reports on which boxes startup companies should make sure are ticked.



Although opportunities in some industries have completely dried up due to the impact of Covid-19, many more opportunities have opened up. Tech startups, for one, have grown these past few months because of the newest innovations that they can offer.

In Singapore, the government set aside S\$150 million (US\$112 million) for the Startup SG Founder programme, which currently provides mentorship and a startup capital grant of S\$30,000 (US\$ 22,400) to first-time entrepreneurs with innovative business ideas. In addition, in February this year, the government announced that S\$300 million (US\$225 million) would be allocated for a programme called the Startup SG Equity co-investment scheme, which provides equity investments for tech startups with strong intellectual property and global market potential.

Kok Keng Lau, head of intellectual property at Rajah and Tann in Singapore, says that only technological companies and businesses that are able to adapt and leverage on the digital economy are likely to survive the Covid-19 pandemic. “Businesses that adopt the traditional brick-and-mortar model with little to no digital presence will not be able to leverage on the current wave of digitalization and thrive in a post-pandemic environment,” he adds.

So in these times of crisis, how can tech startups not only survive, but thrive, in a changing world?

Strategies for tech startups to survive

“For tech startups, in particular software companies, the most important thing to protect would be the software code followed by business processes,” says Lau. “Computer programs can be protected by copyright, and such protection is automatic without the need for registration in order to be protected under copyright law. However, because there is no register, proof of ownership may be difficult and open to challenge. Hence, tech startups should properly document the development process at each step of the way so as to be able to establish that their employees were the original creators of the programs. Patenting software can also be considered, but seeking protection in multiple jurisdictions can be very costly, and may only be a feasible option if funding is available. Business processes can be protected as trade secrets under the law of confidentiality.”

For Anton Blijlevens, principal at AJ Park in Auckland, startups should be quick to decide on the right types of IP to put in place for their innovations.

“The luxury of time to make that decision is not there because for many pandemic related opportunities, especially those creating a solution to problems arising from Covid-19, competitors are also working on capitalizing on the same opportunities or solving the same problems,” he says. “As you know, first to file (a patent) is best dressed. I have been in several races to the patent office for patent applications for clients with PPE and tracing app innovations.”

He adds: “If patents are to be filed, startups with pandemic related innovations should push the patents through to grant quickly if a) there is a high risk others are independently developing a solution the same problems or chasing the same opportunities, and b) those problems or opportunities may vaporize once the pandemic has passed. Fast-track procedures exist in many countries to get a patent granted more quickly thereby given the patent owner enforceable rights.”

As more businesses pivot to working online during this pandemic, the infringement of their IP rights, in particular copyright and trademarks, poses a very real risk. Often, startups underestimate or overlook the importance of managing their IP rights early on due to certain financial limitations, business decisions or even lack of awareness. However, this could lead to unwanted consequences and difficult situations in the future in the form of legal disputes, loss of their IP rights or undervaluing of their work and ideas. Therefore, it is crucial for startups to understand the importance of IP and have a strategy in place to manage, secure and protect their brand and innovations so that they can exploit them with peace of mind, which can also serve to increase their competitiveness in the market and benefit them in the long-term.

Meanwhile, Karen Abraham, a partner at Shearn Delamore & Co. in Kuala Lumpur, says there are numerous ways for tech startups to keep in step with the pandemic, including having an active strategy, not infringing upon the IP rights of others and thinking globally.

She explains: “Startups should choose an active strategy and be proactive in implementing standard IP practices throughout the beginning stages of their company. Startups should implement individualized strategies that relate to the specific goals of their businesses and concentrate on the type of protection and rights required for their individual assets. Although it may be intimidating for startups and new businesses, it is always a good idea to engage qualified IP lawyers to help identify their specific needs, which IP rights are most relevant and strategic and what steps need to be taken to protect these valuable assets from the outset.”

She adds that, aside from protecting their own IP rights, it is also crucial that startups do not unknowingly infringe upon the IP rights of others as this could pose serious problems.

“Startups need to ensure they do sufficient due diligence into the IP rights related to their specific industries that are already in existence so as to avoid any unwelcome third party obligations or future infringements,” she says. “Lastly, but of no less importance, tech companies should think globally when establishing their businesses and protecting their IP. Now that the pandemic has shifted everything into the digital world, IP rights are open to infringement by competitors from all around the world. Therefore, when startup companies focus on merely building their business locally, it can impact the breadth of their

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—KAREN ABRAHAM, partner and head of intellectual property, Shearn Delamore & Co., Kuala Lumpur



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—ANTON BLIJLEVENS, principal, AJ Park, Auckland



"One of the key considerations while establishing a tech startup is to have an IP strategy that is aligned to the business goals of the organization. Most are facing a volatile market during this pandemic, and the odds are that the business goals of a tech startup may pivot."

—MANISHA SINGH, partner, LexOrbis, New Delhi



"Most companies have adopted strict budget constraints and reduced their legal spend in 2020, and the budget would indeed be an issue for startups. Even so, startups still need to properly address their IP issues."

—MINGMING YANG, partner, Wanhuida Intellectual Property, Beijing



IP protection around the world. A global strategy would be an important asset to a startup in the event that they expand to international markets. Startups will not then find themselves high and dry without protection of their intellectual property assets in key jurisdictions. It is crucial to understand the global impact that intellectual property will have on startups.

Manisha Singh, a partner at LexOrbis in New Delhi, adds: “One of the key considerations while establishing a tech startup is to have an IP strategy that is aligned to the business goals of the organization. When it comes to tech startups, invariably, there is going to be more than one core intellectual property asset that will be created. The core IP asset could be a combination of patents, trademarks, or copyrights. Equally important for tech startups is the need for a strategy around data protection and usage of open source software. Considering the fact that most businesses in the world are facing a volatile market during this pandemic, the odds are that the business goals of a tech startup may pivot, keeping this in mind, startups can hold on to some of their intellectual property as trade secrets and seek protection once the pandemic subsides. It is imperative that tech startups should have a well-thought out IP strategy that would consider data protection, usage of open source software and trade secrets vis-à-vis creation and protection of the core IP assets like patents, trademarks, and copyrights.”

The challenge of funding

Even with the blossoming of tech startups in this time of pandemic, they still need to take consideration of every step, especially when it comes to money and investments. “Most companies have adopted strict budget constraints and reduced their legal spend in 2020, and the budget would indeed be an issue for startups,” says Mingming Yang, a partner at Wanhuida Intellectual Property in Beijing. “Even so, startups still need to properly address their IP issues. IP is still key to the great majority of companies, and companies with strong R&D and IP rights will outperform others when the crisis is over. During the pandemic, with tight budgets, startups need to give great consideration as to how to appropriately address and manage IP rights in a cost-effective manner.”

Lau agrees, adding that there may be problems with cash flow during these tough economic times – which could hinder the ability of tech startups to protect or enforce their IP rights, such as applying for trademark or patent registration.

“Tech startups may want to be strategic in relation to the countries in which they choose to apply for protection, to minimize costs,” he says. “This would require an evaluation of which markets the tech startups would want to target the most, and which markets have the greatest potential to yield the highest returns.”

He says that with increased government support for tech startups in these difficult times, Singapore tech startups are still doing relatively well with

industries such as health technology, food, advanced manufacturing and education tech catching the eye of investors in Singapore. He cites an example in plant-based meat startup Karana, which closed US\$1.7 million in seed funding in July 2020, while digital wealth management platform StashAway raised US\$16 million in a recent funding round.

“So, investors are still active, although pickier in terms of the quality and type of products and services they put their funds in,” he says.

He adds: “However, the situation in other countries does not seem to be as optimistic. For example, in China, the original ground zero of the crisis, Chinese venture capital deals have contracted between 50 to 57 percentage points since the onset of the crisis. If this is taken to be a precedent for the impact of the crisis on startups worldwide, this would mean that US\$28 billion in startup investment will go missing in 2020, which would dramatically impact startups. As for Silicon Valley, according to reports, sales people at tech startups are running into trouble closing deals, while SoftBank’s vision fund anticipates that some startups in its portfolio may not have enough cash to make it through the end of the year. The uncertainty is also aggravated by political and social tensions brewing in the U.S., which is not only the country worst affected by the pandemic, but has also failed to address social and racial discrimination issues.”

Singh adds that financing from banks has become more difficult and angel investing has come to a standstill during the pandemic. “However, we see some traction in funding from VCs, depending upon the sector in which the startup operates. If the startup operates in a sector such as edtech, which is in demand, then VC funding is available. In the month of September alone we have seen several mid to large ticket size funding, and more than US\$118 million was raised by a handful of startups. However, valuations of startups may be lower than usual given the parity of funding options for the startups and the greater demand for VC funding. Companies and promoters are willing to settle for lower valuations considering their dire need for funding during the pandemic.”

According to Abraham, the pandemic has had a significant impact on funding for startups as investors and financial markets remain cautious to the adaptation of businesses in the current market.

“While many traditional sectors may have taken a hard hit, tech startups may find that the financial impact of this pandemic may have less of an effect on their operations,” she says. “This current, as well as future, reliance on technology and digital products and services would have widened access to startup capital during the pandemic due to the hunger of investors to clinch these rising opportunities in the tech world.”

She adds that in relation to gaining capital, some startups have also gotten creative on ways to access funding, such as through investment crowdfunding platforms which utilize either an equity crowdfunding system to raise money from investors in exchange

for equity, or a reward crowdfunding system where funding comes from the public or potential clients and customers who pledge their support and receive various rewards in return.

“Conversely, startups may have to cross more hurdles in order to be at the receiving end of capital. The criteria with which investors assess companies may have narrowed as investors may be more careful of where their money goes,” she says. “With venture capitalist firms carrying out more stringent due diligence before making their investments, startups would have to prove that they have a solid business concept, a strong existing market, viability and the ability to generate income. However, investors will surely continue to back companies that fulfil these vital criteria. I think venture capitalists and angel investors would be more willing than ever to meet with innovative entrepreneurs who are able to create scalable and pandemic-proof businesses.”

Yang adds: “The money from VCs and angel investors are still available but we saw the news that the VCs are cutting the valuation, and adding stricter clauses to protect the investors’ interests.”

The other challenges of tech startups

With tech usually equating to patents and/or trade secrets as the types of IP tech companies should be relying on, tech startups should be very aware that with pandemic related innovations, others are trying to capitalize on the same opportunities and solving the same problems.

“Some of these opportunities and problems may be very short lived and may not be there once the pandemic is over,” says Blijlevens. “Startups should bear this in mind in deciding whether to keep their innovations as trade secrets or to file patents. A patent is not going to be granted for several months

if not years at many patent offices, by which time the pandemic and its related opportunities and problems may have vaporized. In most countries a patent has no effect against infringers until the patent is granted. Some innovations may hence not be worth spending money on to get patent protection for and are best kept as a trade secret for as long as possible.”

He says that patents normally not published for 18 months from filing creates blind spots for patent FTO risks for startups because a competitor may have filed a patent application that cannot yet be found.

“Because of the pace of innovation that is focused on the same problems or opportunities in times of crisis, there is a real risk that FTO issues may arise in the future that cannot be quantified,” says Blijlevens. “Startups should take this risk into account and be well prepared. This may include being able to easily change product design to design around future FTO hurdles, having their own IP position to be able to negotiate a settlement, moving fast with their own R&D and regular FTO searching. FTO searching should be done monthly if the innovation is a Covid-19 related one. Even though patents are not published normally 18 months from filing, some patent owners are fast-tracking their patents through the patent offices to get early grants and such are able to be found within 18 months from filing.”

“It goes without saying, be frugal in your expenses without cutting corners on the quality of product or service being offered,” says Singh. “Tech startups should have a well thought out IP strategy that would consider data protection, usage of open source software and trade secrets vis-à-vis creation and protection of the core IP assets like patents, trademarks, and copyrights. Entrepreneurs should look for opportunities, be flexible to pivot from existing business models if the right opportunity comes through. 

Thinking about starting a tech business? Read this first!

If you’re seriously thinking about starting a tech business during the pandemic, Kok Keng Lau, head of intellectual property at Rajah and Tann in Singapore, says that it is important to:

- **Think about how the business idea is relevant now, and understand how the needs of the market and consumers have changed.** For example, a company that makes software that allows security cameras to detect firearms and weapons in real time can pivot to sell systems that use thermal cameras to detect a person with a fever in real time.
- **Understand what investors are thinking.** There may be more conservative investors who are unwilling to put a significant amount of money in such uncertain times, while there may be bargain hunters with a good eye for potential and who may be willing to take the risk with undervalued opportunities. It would be good to understand what type of investor one is dealing with, so as to be able to better pitch to them.
- **Remember that cash is still king.** It is important to have a lean organization and be able to operate on a realistic budget with sufficient cash flow so that potential investors can see that you manage your cash wisely and know how to cut expenses.



CARE TO SHARE?

The pros and cons of IP sharing



As the sharing of intellectual property has taken off in the high-tech sector and has started to become more common in other sectors, *Espie Angelica A. de Leon* delves into the pros and cons of such sharing with IP lawyers from around the world.

In 2014, Tesla Inc. founder and CEO Elon Musk announced that for the sake of sustainable transport, the company would be sharing its patents for its electric vehicle technology, free for anybody to use.

The following year, Toyota announced it was sharing over 5,600 patents related to its hydrogen fuel cell cars, royalty-free.

And then, Ford made its electric vehicle patents available to its competitors who had to pay a fee to access the patents.

More such patent sharing initiatives from the automotive industry have come forth since then, which is not to say that sharing of intellectual property assets hadn't been taking place before Musk's announcement. High-technology industry players have been resorting to IP sharing, including patent pooling, for several years. Pharmaceutical companies, laboratories and research organizations have been doing it as well.

This year, more companies are sharing their patents, utility models, designs and copyright to researchers, manufacturers, developers and the like. This time, the objective is to contribute to the development of products that will help address the novel coronavirus Covid-19 problem and stop its spread.

Some of them are doing it under the United States' "Open COVID Pledge" launched in April. As of October 2020, around 30 companies, laboratories and institutions have joined. Among them are Microsoft, Mitsubishi, Fujitsu, Uber and AT&T.

In Japan, a similar initiative was established, the "Open COVID-19 Declaration." Among the pledgors are Nissan, Toyota, Mitsubishi, NTN Corporation and Sumitomo Metal Mining.

IP sharing is undeniably a noble, practical and commercially beneficial exercise. However, it does pose some risks to IP rights owners, their collaborators and customers.

IP lawyers from six APAC jurisdictions share some of these pros and cons.

PROS

IP sharing encourages innovation

Patent sharing usually involves licensing. Sometimes, the other party belongs to the same industry and is therefore a competitor of the patent owner. In return, the latter is also given access via a license to the former's own suite of technologies.

"This means that both parties can access a wider pool of technology than that which they can develop independently and are able to overcome patent obstacles for which they would have to spend resources to overcome," said Sheena Jacob, director at CMS Holborn Asia in Singapore.

It could also be easier to steer efforts at innovation in a particular direction with more companies using the innovation without the need for licenses and royalty payments, according to Franck Fougere, managing partner at Ananda IP in Bangkok.

Citing Toyota as an example, Fougere said that in 2018, the Japanese car maker debuted at the Consumer Electronics Show knowing that the competition now also included Google, Apple and Facebook, in addition to traditional automakers.

"Toyota understood that they needed to change their model of a traditional car manufacturer to become a mobility company focusing on connected, autonomous, shared and electric vehicles. From a

model of closed innovation where Toyota was aiming to be independent," Fougere explains, "Toyota has now opted for an open innovation model focusing on making friends, releasing patents and using open-source software."

IP sharing promotes imitators and compatible solutions, rather than direct challengers to your technology.

This could help create a standard for the technology and allow the IP right owners to control how the new technology will be brought into the market. If the collaboration goes well, it may even result in strategic partnerships.

It cultivates the process of commercialization in new jurisdictions where the patentee might not have a presence.

"When I say sharing IP, I mean through a legitimate process like licensing, etc.," said Archana Shanker, senior partner and head of patents and designs at Anand and Anand in Noida. "This will be a great stimulus for the economy of the country and also a good business opportunity for the patentee."

It can help build consortiums, technology clusters, attract inventors and businesses to opt for one technology, use it and further develop it.

"Economies of scale often result from such strategies as more products are, for example, produced, and the price for the consumer is also generally dropping," said Fougere. "Think for example of patents related to electric cars, batteries, and the like."

It minimizes the costs incurred from R&D since expenses are shared among the partners. This includes costs of failure since risks and losses are distributed among the partners.

In a Covid 19 world where the race to find solutions and create the right vaccine is at a frenzied pace, IP sharing offers advantages. It facilitates research and builds up the trust factor and corporate image.

"Historically, collaborative approaches to difficult scientific questions have generally led to better outcomes than researching in isolation," said Ted Chwu, a partner at Bird & Bird in Hong Kong. "Particularly in a pandemic situation, releasing IP and sharing research outcomes can prevent researchers from progressing down paths that have already failed."

Additionally, several established companies working together on some, if not all, areas of research for the development of a vaccine help convince the public that the end-product will be safe and effective.

"There is also another dimension which is that some companies want to avoid being perceived as making profit out of a crisis such as the Covid-19 pandemic," said Fougere. "Opening their IP, granting voluntary licenses, is also a way to avoid backlash from a very informed public opinion."



It hastens the provision of needed treatments and medical products, including vaccines.

“In the current pandemic where time is of the essence, the greater the resources available to researchers, including IP such as patents and know-how as well as equipment and brainpower, the higher the likelihood of developing a vaccine,” said Jacob.

This produces added benefits, particularly for the company that developed the vaccine: Not only will it spell financial success; it will also thrust the company into the global spotlight.

It reduces the risk of compulsory licensing of IP or creation of patent pools by governments on social and public policy grounds.

It allows a company to potentially control how much of the IP is released.

CONS

IP sharing may result in loss of rights.

“Even if the technology owner is not motivated by financial gains, it is important that its technology is protected by appropriate IP rights before it is shared or disclosed to other parties,” said Rowanie Nakan, a partner at Cruz Marcelo & Tenebrancia in Manila.

Nakan referred to the public sector and academe, where collaborations are mostly funded externally. Such collaborations are also driven not as much by financial profit as by national interest and development.

“For instance, patent protection is a very important tool to maintain control over how innovations are scaled up to give access to the relevant public,” she said. “Otherwise, enterprising entities may be able to secure ownership and dictate how the technology is distributed and sold to the public.”

It may reduce potential market share and ROI.

This is especially so when too much IP is made available. This may lead to a scenario where a competitor is able

to develop the IP more effectively than the owner of said IP. Having done that, it may ultimately grab a bigger slice of the market, overtake the IP owner faster than expected, thus reducing his ROI.

It may cause problems related to the partners’ share in the revenue.

“The outcome of the project can deliver unexpected results and the parties’ relative contributions may not be equal,” said Jacob. “In such a case, each often believes their contribution was invaluable to the success and may demand a higher share of the revenue.”

It may be anti-competitive and therefore lead to economic disadvantages to consumers in the form of significant increases in the prices of goods.

More collaborations entail more development costs. More development costs lead to higher prices of commodities.

It can lead to complicated administrative procedures.

Some matters may not be acted on as quickly as the parties desire. Even something as simple as filing an application in a certain country requires the consent of the other parties involved before the decision could be finalized and acted upon.

As always, copycats are lurking and are bound to copy.

“Industries, particularly generics companies, should not use this as an opportunity to become copycats and take undue advantage of the situation in the garb of public interest,” said Shanker, referring to IP sharing during the pandemic.

Some trade secrets and other non-registrable but valuable know-how may be disclosed.

According to Christopher Rourke, a partner at Jackson Walker in Dallas, the pros and cons of IP sharing depend on the specific IP assets which were shared and the manner by which they were made available. An IP with general applications and is released without restrictions may lead to bigger commercial loss than

"IP sharing means both parties can access a wider pool of technology than that which they can develop independently and are able to overcome patent obstacles for which they would have to spend resources to overcome."

—SHEENA JACOB, director, CMS
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"When I say sharing IP, I mean through a legitimate process like licensing. This will be a great stimulus for the economy of the country and also a good business opportunity for the patentee."

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"From a model of closed innovation where Toyota was aiming to be independent, Toyota has now opted for an open innovation model focusing on making friends, releasing patents and using open-source software."

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Bangkok



"Even though the artist might have generated licensing revenue if they had charged for that work, the fact that it was available at no charge may have been a contributing factor to its commercial use. The artist can then charge more for new graphic images."

—CHRISTOPHER ROURK, partner,
Jackson Walker, Dallas



"In a pandemic situation, releasing IP and sharing research outcomes can prevent researchers from progressing down paths that have already failed."

—TED CHWU,
partner, Bird & Bird,
Hong Kong



"Even if the technology owner is not motivated by financial gains, it is important that its technology is protected by appropriate IP rights before it is shared or disclosed to other parties."

—ROWANIE NAKAN,
partner, Cruz Marcelo &
Tenefrancia, Manila



IP with more limited applications and shared with restrictions. Still, both could make commercial sense.

“For example, an artist might provide an open source license to a graphic image that they create to increase public awareness of their style. That graphic image may become popular and be used on commercial works, such as T-shirts and advertisements,” said Rourk. “Even though the artist might have generated substantial licensing revenue if they had charged for that work, the fact that it was available at no charge may have been a contributing factor to its commercial use. The artist can then charge more for new graphic images. This is a one-way sharing of IP, where the IP creator is sharing their IP with others and getting nothing in return, at least not immediately, although public awareness could be considered something of commercial value.”

“On the other extreme, an equipment manufacturer might share its hardware design with a firmware creator, and the firmware creator might share its firmware with the equipment manufacturer in return. While that shared IP would be very specific and very limited, the equipment manufacturer might be able to sell more of the equipment with the new firmware, and the firmware creator might be able to sell its firmware adapted to other hardware platforms based on the success of the equipment. While the shared IP would have very little use beyond what is originally contemplated, it could still make commercial sense for both parties to share their IP,” Rourk added.

How then can an organization go about participating in a project which requires sharing of IP without getting entangled in a legal dilemma?

The IP created should be protected and there should be an agreement.

The participating parties should think about the possible outcomes and provide for some flexibility so that the terms will be fair to all. There should be limits on disclosure to third parties and clear penalty and termination clauses for misuse.

“Any collaborative research efforts that involve IP sharing must have pertinent clauses that provide for the ownership of the direct and/or incidental IP arising from such research. All such ownership provisions must likewise be incorporated and/or mirrored in the written contracts of every party with their own employees and/or partners who, by virtue of the sharing, may gain access to the IP,” said Nakan. “This will invariably prevent any ownership dispute in the future.”

She added that If the IP is registered and is a mature technology, the parties may have standard licensing agreements in compliance with the IP Code [of the Philippines] and the Philippine Technology Transfer Act. Section 6 of the Act states that IPs and IP rights arising from research funded in whole or in part by a government funding agency, are owned by

the research institution which undertook the research, with specific exceptions.

If the IP is unprotected, a non-disclosure agreement should be drawn up. The NDA may also contain clauses on ownership and extend confidentiality to one’s own employees and partners.

Rourk added that due diligence can help identify and reduce risks.

Ask questions.

The parties must first answer these questions: Why do we want to share our IP? What can it be used for? What do we wish to gain business-wise? Who do we want to share our IP with? Which parts of the IP shall we share? What are the limits and methods by which it will be shared?

A team of people in the organization should monitor and audit the use of the shared IP, including patent filings by the other parties. This will help control the IP and make sure it belongs to the rightful owner.

Opening up the IP to other countries and governments should be done on a case-by-case basis depending on a public health crisis faced by a jurisdiction.

Consider patent pooling.

“Patent pooling is an option wherein the company shares their IP rights and the technologies are cross-licensed, as a result of which there is some amount of predictability, uniformity and competitiveness in terms of price for the patented product,” explained Shanker.

IP sharing certainly has its pros and cons. A lot of questions also need to be answered before any organization can decide to make its IP assets available to other individuals and entities.

For Chwu, however, this is only applicable under normal business conditions. Different considerations must be made in the event of a pandemic.

“If sharing IP assists in creating a vaccine or viable treatment,” he said, “the benefit of sharing should outweigh the downsides overall.”

Although she believes sharing of protected IP rights should be the norm to meaningfully implement the IP Code of the Philippines, Nakan provides another angle to the struggle that comes with deciding whether or not to share an IP.

“The above ideal must be tempered with the appreciation that IP owners’ reluctance to share their IP are sometimes based on their lack of confidence in the IP system. The effectiveness of IP rights, after all, very much depends on the public’s level of confidence in the enforceability of such rights,” she said. “On this point, IP owners must be assured that in revealing their IP, the concomitant enforcement remedies are not only available but the swiftness by which these remedies are implemented must also be satisfactory.”

Care to share your IP? 

AI intersects India's patent regime

Artificial intelligence continues to advance and become more intelligent, but the potential of AI not only lies in the adoption of AI, but also in how it is created and protected.

India's patent laws must keep up, argue *Gopi Trivedi* and *Shiva Mehta* explain.

Machines at the time of Industrial Revolution were developed by humans to ease their work. Gradually, these traditional machines and industrial practices gained momentum, reducing considerable human labour. In the current scenario of Industry 4.0, the automation of traditional machines and industrial practices using smart technologies has paved the way. Machine-to-machine learning (M2M), internet of things (IoT) and artificial intelligence (AI) are integrated for automation. AI adoption is growing faster than many had predicted. AI itself is described as the fourth industrial revolution, transforming all our jobs and lives in the coming decade. Such advancement in technology was merely a fantasy – or we may call it a thoughtful representation of fiction – until few years ago. But now, the concept of AI is no longer completely foreign to the general public and is right out there in the public domain.

What is artificial intelligence?

From Amazon and Facebook to Google and Microsoft, leaders of the world's most influential technology giants are highlighting their enthusiasm for AI. But what is AI? Machines have been in use since long ago, but what's different today, and is enabling this revolution, is the evolution of machine learning systems. No longer are machines just capturing explicit knowledge, where a human can explain a series of fairly logical steps. Machine learning is already all around us, unlocking our phones with a glance or a touch, suggesting music we might like to listen to and teaching cars to drive themselves. Fuelling this machine learning with data is what AI is all about. Global research and advisory firm Gartner perhaps put it best: "Artificial intelligence is technology that appears to emulate human performance typically by learning, coming to its own conclusions, appearing to understand complex



content, engaging in natural dialogues with people, enhancing human cognitive performance or replacing people on execution of routine tasks.”

AI can be simplistically classified as technology that is created by a human, improved by a machine and has the power to disrupt almost all aspects of human existence. Technology so developed can behave intelligently by thinking as a human (i.e., strong AI), or even surpass humans (i.e., super intelligence). For better implementation and understanding, it is to be noted that currently we are in the weak AI phase.

Artificial intelligence in India

In 2017, India's Ministry of Commerce and Industry set up the Task Force on AI for India's Economic Transformation, with the mandate advising to create a framework to promote the deployment of AI, taking all social factors into account. As a further development, India's National Strategy for Artificial Intelligence was released by the NITI Aayog in 2018, establishing AI as a 'garage' for emerging and developing economies under the proposed brand #AIforAll. These initiatives were to study the full potential of AI in the Indian context, marking India's journey from AI outlier to AI adopter – and, later, to AI creator.

The potential of AI, along with promoting AI, has been largely discussed in various sectors of technological development. Despite these discussions, there has not been as much discussion on the legal implications of AI in those sectors. Each sector does embrace AI. But the potential not only lies in the adoption of AI, but also in how it is created and protected. There is this fundamental question of who owns AI which also needs more contemplation. It is therefore imperative that our laws should be more exemplified to deal with the implications of AI.

Artificial intelligence versus IP laws

When talking about implications of the law on AI, intellectual property law comes in to the picture. The foremost object of the IP laws and IP system is to encourage innovation through new technologies and creative mechanisms, which includes human creation as well as invention created and developed by AI. However, there arises a doubt as to the ownership of creations made by AI (strong AI), i.e., ownership concerning both the data as well as the technology that are the pillars to any such creation.

Creation and development of new innovation, technology is generally followed by the protection of the same through intellectual property rights, with patent law appearing to be the most effective IP protection.

There are several legal implications revolving around the patentability of AI inventions and AI-created inventions. It is imperative to understand that AI-related inventions are in context of algorithms and computer programming and that the same does qualify for patent protection in India, subject to its patentability under Section 3(k) of the Patents Act, 1970, stipulating that mathematical and business methods,

computer programmes *per se*, are non-patentable. In other words, for the patentability of algorithms and computer programs, the Patents Act demands the industrial applicability of the same along with novelty and non-obviousness of the invention.

Non-obviousness of the invention to the person skilled in the art, i.e. in the field of AI, is also a point of concern. Yet another concern: Per the act, patent protection is extended only to the true and first inventor, where the inventor must be natural person. The act also requires the proof of right to be filed in cases where the applicant and the inventor varies. In this case, the question arises that when AI is listed as the inventor, how such formal requirements shall be met or who shall sign the requisite forms. When we dig further into this, the issues arising are:

- Whether AI as an invention is eligible subject matter; and
- Who is the true and first inventor (i.e., inventorship).

AI inventorship in India

Looking at the Indian patent law, there is no ambiguity as to who would be counted as the inventor for AI-based inventions that involves human intervention. But, as the transition is made from weak AI to strong AI (and towards super intelligence), the question that creates dilemmas in our minds is whether AI technology can be considered as an inventor for the technology that itself further creates patentable inventions.

At present the answer is unclear. The act is silent on the inventorship of AI; however the law is always open to interpretation and debate. Section 6 of the Patents Act explicitly provides a list of what *persons entitled to apply for patents*, stating that an application for a patent for any invention can be made only by the true and first 'inventor' of the invention or his assignee. Thus, it indirectly does implies that the *person* is the true and first inventor.

Further a 'patentee', according to Section 2(1)(p), is the 'person' entered on the patent office register as the grantee or owner of the patent. Intuitively, this suggests that an inventor and person must mean a *natural person*. Now the debate arises where, Section 2(1)(s) defines 'person' to include the government, a non-natural entity. Moreover, 'true and first inventor' has an exclusionary definition in Section 2(1)(y) – excluding “either the first importer of an invention into India, or a person to whom an invention is first communicated from outside India” – and there is no mention of a natural person in there.

While these provisions do not expressly impose the requirement for an inventor to be a natural person, the predisposition appears to require human intervention for an invention to be considered patentable. The first order of business is to interpret whether an inventor must be a natural person.

Ownership

Considering AI as an inventor probably would also give rise to the liability issues. Section 48 of the Patents Act

confers on the patentee “the exclusive right to prevent third parties, who do not have his consent, from the act of...” The pertinent question here is whether AI has the power to give consent. If it does, how would someone receive the requisite consent?

The same issue lies with ownership through assignment or acquisition. If ownership of the invention is transferred to a business entity that can enforce the patent, does an AI have the power to assign (i.e., give consent for change of ownership)? When it comes to courts and patent infringement; how would the courts enforce liability on an infringing AI? Does the legal responsibility arising through an AI’s illegal action lie with the AI, its owner or its user or operator? If the cause of the illegal act cannot be traced back to a specific human, who has liability? These and many similar concerns are now the subject of debates on the ambiguities of AI, not only in the IP context, but also in the context of criminal liability or civil tort liability.

Corresponding decisions in other jurisdictions

In its recent decision April 22, 2020, the United States Patent and Trademark Office (USPTO) concluded that an AI system could not be recognized as an inventor in a US patent application in which an AI machine called DABUS was designated as sole inventor. In doing so, it has ruled that only natural persons are eligible as inventors. It is interesting to note that the USPTO’s opinion relies on the “current” state of U.S. patent law, which limits inventorship to natural persons. By using this qualifier, the U.S. patent authority seems to be open to the possibility that legislation and case law may evolve over time to expand the concept of inventorship to include AI machine as inventors.

The European Patent Office (EUIPO), in January 2020, refused two patent applications that were filed listing AI as the inventor. The EUIPO rejected the applications stating that the same “do not meet the requirement of the European Patent Convention (EPC) that an inventor designated in the application has to be a human being, not a machine.” The EPO held that the European legal framework pursuant to the European Patent Convention makes reference only to natural persons in the context of inventorship, noting that legislators clearly intended for an inventor to be a natural person.

The UKIPO also refused to recognize AI as the inventor because the relevant sections of the UK Patents Act and case law in the United Kingdom also anticipates that an inventor be a natural person.

Conclusion

The current patent system is suited to adjudicating the patentability questions related to the existing generation of AI technology (weak AI). However, the time has come for the Indian government to begin carefully consider how computer-related inventions pertaining to the next generation of AI (i.e., strong AI and super intelligence) should be treated in the patent ecosystem. It is a known fact that the existing laws and the changes that are looked forth need to be bridged in

order to give acceptance to the inventions created by AI. The existing patent law recognizes an inventor as a natural person only. At some point in the future, when AI transits from weak to strong and, finally, the super intelligent stage, inventive AI might even represent the person skilled in the art. This indeed calls for appropriate guidelines for the act that deals with AI-generated works.

AI is growing exponentially and it would not be wrong if we say AI is gradually stepping into the human shoes. Meaning thereby, inventive AI has become a significant part of research and development and is now moving a foot forward for being an inventive AI. And when it does, it will be quite challenging if we lack clear rules or guidelines on whether AI-generated inventions can be protected; who, or what, should be listed as an inventor; and who owns these inventions and related patents. It therefore appears imperative to turn our attention towards these pertinent issues arising where AI intersects IP and India’s patent regime. 

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Gopi Trivedi is senior partner and head of the patent division at Y. J. Trivedi & Co. She is also a computer engineer and a registered patent agent and holds a Bachelor’s of Law. Her wide knowledge in various areas of science such as engineering, software, chemicals and pharmaceuticals has led her to handle patent projects nationally and internationally and makes her a favourite of clients to cater to any patent assignment. She has secured the grant of multifarious patents for clients belonging to all walks of industry, be they grassroots innovators, students, professors, domestic inventors, MSME or those of multinational firms. Her involvement with students, professors, the startup community and incubators, in terms of guiding them in their research work to improvise on their inventions, has led to her empanelment at various engineering universities and institutions. Her background in both science and law helps her understand the innovator’s needs better and deliver technical protection through IP prosecution as well as the legal enforcement of IP rights. She is also a part of her firm’s IP valuation and management team.



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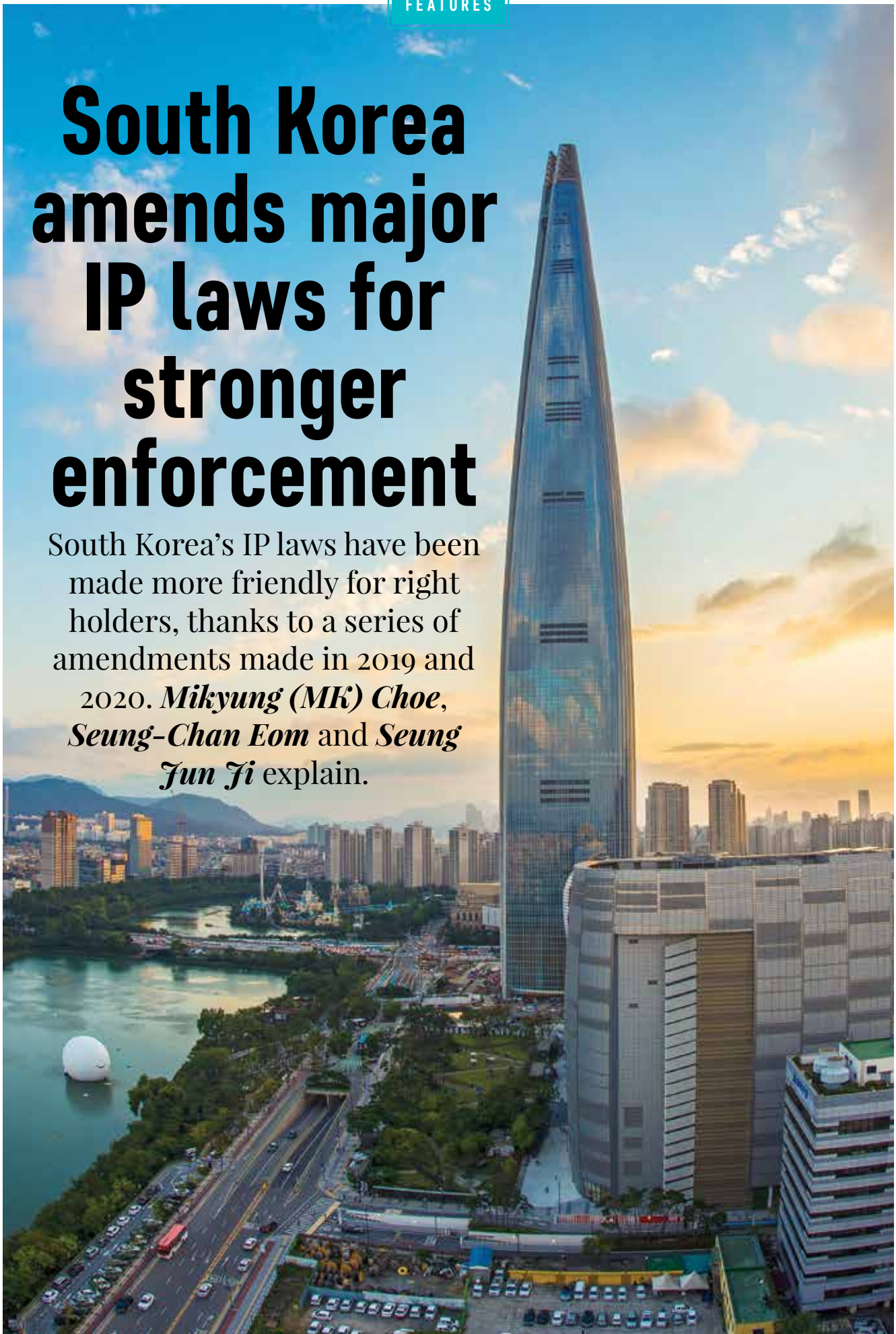
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South Korea amends major IP laws for stronger enforcement

South Korea's IP laws have been made more friendly for right holders, thanks to a series of amendments made in 2019 and 2020. *Mikyung (MK) Choe*, *Seung-Chan Eom* and *Seung Jun Ji* explain.



A number of South Korea's main intellectual property laws were amended in 2019 and 2020 to become more friendly to right holders. Key amendments are discussed below.

Damages now more broadly available for trademark and design infringement as well as patent infringement and trade secret misappropriation in Korea

Recently, the major South Korean intellectual property statutes were amended to be more right holder-friendly with respect to the calculation of damages for infringement, including a new provision for treble damages for intentional or willful infringement or misappropriation. The Patent Act (PA) and the Unfair Competition Prevention and Trade Secret Protection Act (Trade Secret Act) were amended on July 9, 2019, to reflect these changes. As of October 20, 2020, the Korean Trademark Act (TMA) and the Korean Design Protection Act (DPA) have also been amended.

In South Korea, to obtain an award of damages, a patent, utility model, trade secret, design or trademark owner must prove the amount of damages caused by the infringement with a relatively high degree of specificity. Showing the amount of such damages with sufficient precision is usually difficult. There are several statutory methods for calculating damages. One is to calculate the amount of actual damages incurred by the right holder due to the infringement/misappropriation. However, due to the limited discovery available in Korea, it is often difficult to prove the amount of actual damages in a given case.

The above-mentioned statutes provide for a presumption that the following methods are reasonable measures for calculation of damages, and the recent amendments were designed to solve certain practical difficulties in the calculation of damages. Before the amendments, rights holders could claim damages compensation from an infringer based on (i) the infringer's profits gained from the infringement, (ii) the right holder's lost profits due to the infringement, or (iii) royalties "ordinarily expected" from an arm's length license. However, as with actual damages, it has generally been difficult to ascertain infringers' profits as most infringers are not cooperative regarding providing the relevant financial data. Moreover, when it comes to claiming lost profits, since such profits are limited to the right holder's own sales and production capacity, many infringers end up paying a relatively minimal amount of damages despite committing significant infringing acts over many years. Accordingly, there have been discussions about the need for stronger punitive damages as a protective measure not only for right holders but also for consumers who may be victimized by infringing goods.

Reasonable royalty. The "ordinarily expected royalties" damages calculation method has also been criticized as being out of touch with actual market conditions, where there often is no existing royalty

standard, and thus failing to result in sufficient damages awards. Therefore, the amendments to the TMA, DPA, PA and Trade Secret Act have changed the "ordinarily expected" royalty standard to a "reasonable" royalty standard, to help properly protect right holders by broadening the royalty calculation to include any reasonable factors under the totality of the circumstances, rather than focusing on "expected" royalties. The amended TMA and DPA apply to infringing acts committed after the effective date of October 20, 2020. The amended PA and Trade Secret Act have applied to infringing acts committed after this effective date of July 9, 2019.

Punitive damages. The PA and the Trade Secret Act were previously amended on July 9, 2019, to introduce treble damages for cases of willful or intentional patent infringement or trade secret misappropriation. Such treble damages have now been added to the TMA and DPA as well. The amended TMA and DPA apply to infringing acts committed after the effective date of October 20, 2020. The amendments allow courts to order willful or intentional trademark or design infringers to pay up to three times the assessed damages amount. This amendment reflects a recognition by the Korean legal system that increased penalties are needed to effectively discourage acts of infringement and to better protect IP rights holders in South Korea. Damages amounts for intentional or willful patent infringement/trade secret misappropriation are expected to increase significantly in size.

When calculating the amount of such punitive damages, courts are instructed to consider the following factors: (i) whether the infringer has a dominant position in the market; (ii) whether the infringer knew the act of infringement would cause harm to the right holder, or intended to cause such harm; (iii) the significance of any such damages incurred to the right holder; (iv) the economic benefits to the infringer from the infringement; (v) how frequently and how long the infringing activity was committed; (vi) the criminal penalty for the infringing activity; (vii) the infringer's financial status; and (viii) what efforts the infringer has made to reduce the harm to the right holder. For willful trademark infringement, the same factors apply, with the exception of the first factor (i) which is replaced by consideration of the significance of any damages to the distinctiveness or reputation of the infringed trademark caused by the infringing activity.

Statutory damages. The TMA provides for statutory damages compensation, for which the maximum amount has been increased by the recent amendment. Courts hearing trademark infringement cases previously were able to order statutory damages compensation up to ₩50 million (US\$46,000) for an infringer who intentionally or negligently infringed a trademark right without calculating actual damages. After the amendments, this statutory damages compensation limit has been substantially increased to ₩300 million (US\$276,000) for intentional

infringement, and ₩100 million (US\$92,000) for negligent infringement. This amendment to the TMA applies to trademark infringing acts committed after the effective date of October 20, 2020.

Lost Profits. As noted above, the “lost profits” damages calculation method is currently subject to the limitation that damages will not be awarded beyond the right holder’s own production capacity. As a result, the damages available to the patentee under this calculation method have tended to be quite low, even where the infringer is a far larger company with much greater capability to produce and market the infringing products or services. This situation has been criticized as insufficient to deter patent infringement, particularly infringement by large companies.

On May 20, 2020, an amendment to the PA was passed to ameliorate this limitation, by adding a provision that if the “sales amount of an infringer” exceeds the right holder’s own production capacity, the patentee is now entitled to receive reasonably expected royalties for such excess sales (Article 128, Paragraph 2). By increasing the potential liability for damages through express provisions in the Patent Act, the amendment is expected to strengthen patent rights in Korea and to help curb abuses by large infringers. This amendment applies to patent actions filed on or after the effective date of December 10, 2020, and applies to utility model rights as well.

Equivalent amendments to the TMA, the DPA and the Trade Secret Act were passed by the National Assembly on December 1, 2020, and will take effect six months after promulgation.

Recent amendment to Patent Act will facilitate more criminal investigations of patent infringement

The Patent Act provides for criminal remedies for patent infringement as well as civil remedies. A willful patent infringer can be punished with imprisonment of up to seven (7) years, or a fine of up to ₩100 million (US\$92,000). However, under the previous Patent Act, a criminal investigation and indictment for patent infringement could only be initiated if a criminal complaint was filed by the right holder with the police or prosecutor’s office, who would then conduct a criminal investigation pursuant to the complaint.

In recent years the Korean Intellectual Property Office (KIPO) has expanded the role of the Special Investigation Police (SIP) within KIPO (which was originally established to investigate trademark infringement and counterfeiting matters) to include investigations of patent infringement, to improve enforcement of patent rights. While the SIP also has power to conduct criminal investigations of infringement, it is also limited by the requirement that a complaint be filed in order to initiate criminal patent proceedings. This has been a hurdle to the SIP’s efforts to effectively investigate patent infringement, even if it often becomes aware of such infringement in the course of its duties or when pursuing other cases.

The recent amendment to the Patent Act, which became effective on October 20, 2020, revised Article 225, paragraph (2), which previously provided that “[n]o person shall be prosecuted for committing a crime under paragraph (1) without a complaint filed by the injured party.” The article now reads “...under paragraph (1) against the explicit intent of the injured party.” This change to remove the requirement of a formal complaint was intended to allow the SIP to more actively pursue criminal investigations of patent infringement it may encounter in any context. The amendment applies to acts of infringement committed after the effective date of October 20, 2020. 

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VIETNAM

Practical insights in inbound technology transfer

Vietnam's technology market has become more vibrant since the introduction of the Technology Transfer Law 2017. *Yen Vu*, *Trung Tran* and *Bao Nguyen* provide investors and companies with important notes on the practical issues facing parties engaging in inbound technology transfer.

Vietnam's technology market has become more vibrant since the introduction of the Technology Transfer Law 2017. The new law is aimed at encouraging transfer of advanced and clean technologies and eliminating importation of outdated and hazardous technologies. More state intervention in reviewing technology subject to the transfer has therefore been adopted; the registration and approval process of technology transfer has been streamlined. For successful inbound transfer of technologies in Vietnam, the parties should be mindful about not only commercial aspects but also legal compliance in the transfer.

Practical issues that parties engaging in inbound technology transfer in Vietnam should note include, among other things, determining whether the types of technologies to be transferred are regarded as restricted or prohibited technologies, drafting the technology transfer contract in accordance with the law, consolidating documents for timely registration and designing the timeline for implementation of the transferred technology. This article provides investors and companies with important notes consolidated by lawyers from their practice of technology transfer consultancy on the aforementioned issues.

Technologies encouraged for transfer

The Technology Transfer Law 2017 categorizes technologies into three types, i.e., encouraged, restricted and prohibited technologies. Encouraged technologies are those regarded as novel and/or advanced technologies, e.g., clean technologies that are suitable to the socioeconomic conditions of Vietnam, technologies that can generate or use new or renewable energy or store energy in highly efficient ways, medical machinery/equipment and pharmaceutical products serving medical diagnosis and treatment, protection of human health and improve the physical strength for Vietnamese people, etc. The detailed list of technologies encouraged to transfer is set out in Annex 1 of Decree 76/2018/ND-CP dated 15 May 2018 guiding Technology Transfer Law 2017 (Decree 76).

Although the Technology Transfer Law 2017 provides that organizations or individuals making transfer of encouraged technologies will enjoy tax incentives (Article 39.4), there have not yet been any regulations implemented elaborating and guiding on the application of such incentives. In practice, each province across Vietnam has designed a specific plan to stimulate and support the transfer of the encouraged technologies. For instance, Tra Vinh province provides for a support of 30 percent of the cost incurred for purchasing machinery used for technologies encouraged to transfer under the Technology Transfer Law (Resolution No. 82/2019/NQ-HDND dated April 12, 2019, of the People's Council of Tra Vinh province.) Meanwhile, Thanh Hoa province provides for a support of 30 percent of the cost incurred for making new software under the condition that organizations

receiving such support shall replace the outdated technologies with the advanced technologies and those encouraged to transfer under the Technology Transfer Law (Resolution No. 81/2017/NQ-HDND dated December 7, 2017, of the People's Council of Thanh Hoa province.)

The new Law on Investment 2020 specifies projects involving transfer of technologies encouraged to transfer among those that enjoy investment incentives. Forms of incentives may include corporate income tax incentives, import tax exemption, exemption from or reduction of land levy and land rents, accelerated depreciation and increased deductible expenses upon calculation of taxable incomes. This provision needs further guidance by the government for implementation.

Technologies restricted and prohibited from transfer

Restricted technologies are those that are no longer popular or can be considered quite hazardous to the environment, but are still in the acceptable range under the national technical standards of Vietnam, such as technologies that use toxic chemicals, generate hazardous waste, or use/create radioactive substances, but are still in conformity with national standards and regulations, etc. The detailed list of technologies restricted from transfer is prescribed in Annex 2 of Decree 76.

Prohibited technologies are those that are outdated and hazardous to humans and the environment outside of the acceptable range of the national standards of Vietnam, such as technologies that use toxic chemicals or generate wastes, or use or create radioactive substances that do not satisfy the national technical standards and regulations. The detailed list of technologies prohibited from transfer is prescribed in Annex 3 of Decree 76. Apart from the outdated technologies, technologies that are state secrets under Vietnamese laws are also subject to prohibition. In practice, the lists of state secrets are scattered in many legal documents issued by different government agencies in charge of different sectors, and are being updated and/or replaced due to the issuance of the new Law on State Secret Protection 2018, which came into effect on July 1, 2020.

In addition to the above-mentioned restricted and prohibited technologies under Vietnamese laws, Annexes 1 and 2 of Decree 76 also mention that the restriction and prohibition can extend to the technologies that are provided in any international treaties in which Vietnam is a member. Nonetheless, neither the Technology Transfer Law 2017 nor Decree 76 lists out any international treaties covering such restricted and prohibited technologies.

In practice, there are no specific international treaties that Vietnam is a member of which prescribe in detail technologies restricted or prohibited to transfer. As such, in order to decide whether certain technologies to be transferred are restricted or prohibited, it is important to understand the nature, functions,

products and by-products of such technologies. It is essential to consider crucial elements, e.g., whether the technologies in question can generate any effects that are considered harmful to human health or the environment. For example, if the technologies in question can create organic byproducts, the parties to the transfer agreement might want to refer to the Stockholm Convention on Persistent Organic Pollutants 2011, apart from Vietnamese laws, for details on what type of organic substances are deemed to be pollutant and can therefore be prohibited from transfer.

Registration of technology transfer agreements

Under the Technology Transfer Law 2017, agreements on inbound/outward technology transfer to/from Vietnam must be registered with the competent state authority. Failure to register results in invalidity of the agreement. The mandatory registration of technology transfer agreements is legislatively aimed at controlling the flow of obsolete technologies transferred to Vietnam and the act of transfer pricing in technology transfer. For successful compliance with the registration rules, businesses should be mindful of the following key issues:



Registration deadline: The application dossier must be submitted within 90 days from the signing date of the technology transfer agreement. Meeting this deadline is not always straightforward, since the dossier involves many required documents subject to a variety of formalities (e.g., notarization and legalization). In complicated cases which involve more than two parties and/or require careful analysis of the technologies and/or patents in questions, it may take the parties months to put together the application documents. Therefore, it is advisable that businesses note carefully the deadlines for registration/application to consolidate necessary documents as soon as the agreement is signed for timely submission.

Mandatory contents of technology transfer agreements: Beside the registration requirement, the Technology Transfer Law 2017 also involves state intervention in contract terms. Article 23 of the law sets out 14 contents that a technology transfer agreement must have, including:

- Name of the technology to be transferred;
- Technologies to be transferred, products created by the transferred technology and their quality standards;
- Transfer of the ownership and/or the right to use technology;
- Method of technology transfer;
- Rights and obligations of the parties;
- Price and method of payment;
- Duration and effective date of the technology transfer agreement;
- Definitions and terms used in the technology transfer agreement (if any);
- Technology transfer plan or schedule, and location; and
- Warranty on transferred technology.

Absence of any of such contents may result in office refusal. In addition, the registry will raise shortcomings of the agreement if the contents do not meet the formality requirements in their course of examination. From technology lawyers' experience, some contract shortcomings commonly raised by the registry include:

- **Effective date:** The Technology Transfer law provides that a technology transfer agreement subject to the registration requirement becomes effective as of the date of issuance of the technology transfer registration certificate. Accordingly, many agreements that prescribe an effective date other than such date (e.g., agreements commonly define "effective date" as the date on which the agreement is signed) have been rejected.
- **Term of agreement:** Agreements usually provide that the technology transfer continues in force indefinitely. The registry in many cases does not accept an indefinite term for the agreement in Vietnam. In such cases, the technology transfer is considered as part of an investment

project. According to Vietnam's Investment Law, investment project activities, including technology transfer, will be terminated upon the expiration of the project term.

- **Technology transfer price:** The total value of an agreement, which is determined based on the transfer price is necessary for calculation of the examination fee, so the registry usually requires the agreement to provide a specific amount of price. However, the transfer price in most cases is royalty-based, i.e. the license fee is not settled in one go, but calculated based on the amount, revenue, or earnings from selling of the products manufactured with the use of the transferred technology. In such approach, the transfer price is not clear enough for the registry to calculate the examination fee.

In any case of contract shortcomings, the applicant may need to submit their clarification or amend the contract to avoid a possible refusal by the registry.

Registration procedure: The procedures for registering a technology transfer agreement are stipulated in the Technology Transfer Law 2017 and Decree 76. However, in case the technologies to be transferred are considered restricted technologies, the parties have to apply for license to transfer technologies, of which process shall be more complicated and time consuming. Vietnamese laws have not provided for any mechanism where the submitted dossier for registration of technology transfer agreement could be converted to dossier to apply for license for technology transfer in case the technology in question is deemed to be restricted during the process of examination. Therefore, it is necessary for foreign investors to carefully consider all aspects of the technology subject to transfer or consult a local technology expert for assessment of technologies before making the technology transfer transactions into Vietnam to avoid prolonged procedure in applying for registration or license to transfer.

Timing for implementation of transferred technology

A common practice follows that parties implement the technology transfer, e.g., by providing documents, trainings and technical assistance, as soon as the agreement is established. However, in the case of inbound technology transfer where registration is required, the technology can only be transferred upon the grant of the registration certificate. Otherwise, the implementation will constitute "making inbound technology transfer from overseas to Vietnam without a technology transfer registration certificate." This act results in administrative fines at the ranges of D30 to 40 million (US\$1,300 to US\$1,700) and seizure of materials and means related to the transferred technology (Article 25, Decree 51/2019/ND-CP prescribing Administrative Fines for Violations Arising from Scientific and Technological Activities, and Technology Transfer, issued by the Government on June 13, 2019.) 

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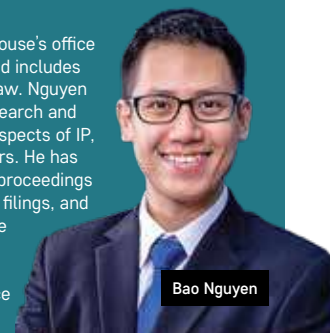
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PHILIPPINES

Who owns the mark? Prior user vs. the first-to-file registrant

When two pharmaceutical trademarks with similar names hit markets in the Philippines – one of which is a user in good faith and the other a registrant in good faith – things can get sticky. *Editha R. Hechanova* takes us through the tale of how confusingly similar trademarks can co-exist in the same market.

In the landmark decision in the case of *Zuneca Pharmaceuticals v. Natrapharm Inc.*, (G.R. No. 21850, September 8, 2020), the Supreme Court of the Philippines ruled that registration is the exclusive means of acquiring ownership of a trademark, overturning its earlier rulings in 2010 in the cases of *Berris Agricultural v. Abyadang* (G.R. 183404), and *E.Y. Industrial Sales v. Shen Dar Electricity and Machinery* (G.R. 184850), where it pronounced that “a trademark is a creation of use and belongs to one who first used it in trade or commerce.”

This case arose from a trademark infringement case filed by Natrapharm against Zuneca Pharmaceutical on November 29, 2007, before the regional trial court (lower court). A side-by-side comparison of the contending marks and the goods covered is shown below.

Zuneca	Natrapharm
ZYNAPS	ZYNAPSE
Class 5: Pharmaceutical products for neuropathic pain and seizures.	Class 5: Pharmaceutical medicine for human use.

Both parties agree that their marks are confusingly similar, especially so when the goods bearing their marks are both pharmaceutical products. ZYNAPS is the brand name for a drug called *carbamazepine*, which is an anti-convulsant used to control all types of seizure disorders, such as epilepsy, among others. ZYNAPSE is the brand for a drug manufactured by Natrapharm called *citicoline* used for treating cerebrovascular disease or stroke.

Zuneca, which has not filed a trademark application for its ZYNAPS brand, claimed that it is a prior user in good faith and has been using the mark since 2004, and prayed for the cancellation of Natrapharm’s registration on the ground of bad faith considering that the latter was aware of the ZYNAPS mark before the ZYNAPSE’s trademark application for registration was filed and obtained. Zuneca alleged that both of them had advertised in the same publication and joined the same conventions to promote their products. In the case of Natrapharm, it filed its ZYNAPSE mark on June 1, 2007, and was registered on August 24, 2007, and also claimed good faith since it alleged lack of knowledge of the existence of ZYNAPS prior to the registration of ZYNAPSE. Further, it gave an account of how they came about the mark ZYNAPSE, which came from the neurological term “synapse” and the measures taken such as checking the Bureau of Food and Drug (now Food and Drug Administration), the Intellectual Property Office of the Philippines (IPOPHL) and other databases for the availability of the ZYNAPSE name. After trial of the case, the lower court ruled that the first filer in good faith defeats a first user in good faith which did not file any application for registration. Natrapharm, therefore, as the first registrant has all the trademark rights over ZYNAPSE and can prevent

others, including Zuneca, from registering an identical or confusingly similar mark. It rendered judgment against Zuneca, finding it guilty of infringement and ordered it to pay Natrapharm damages amounting to P2.2 million (US\$46,000). Further, Zuneca was enjoined from using ZYNAPS, and further ordered the destruction of all infringing materials, without compensation. Feeling aggrieved, Zuneca appealed the decision to the Court of Appeals, which affirmed the lower court’s decision, and ultimately appealed to the Supreme Court as the final arbiter of its dispute.

Proving bad faith

During the trial, Zuneca had the burden of proving that Natrapharm was in bad faith and obtained the ZYNAPS registration fraudulently. Citing the case of *Mustang Bekleidungswerke GMBH v. Hung Chiu Ming* (Appeal No. 14-06-20, Aug. 29, 2007, IPOPHL ODG), “bad faith means that the applicant or registrant had knowledge of prior creation, use and/or registration by another of an identical or similar mark.” The lower court found the evidence submitted by Zuneca insufficient, and held that the fact that ZYNAPS and Natrapharm’s other brands were listed in a common directory was not enough to show bad faith considering that Zuneca’s own witness admitted not having knowledge of the drugs listed in the said directory, and the same level of knowledge should be applied to Natrapharm, giving the latter the benefit of a doubt. Had the evidence of Zuneca been found sufficient, Natrapharm’s registration could have been cancelled since it would not be reflective of the ownership of the holder, as in the following instances: (i) the first registrant has acquired ownership of the mark thru registration but subsequently lost it due to non-use, (ii) the registration was done in bad faith, (iii) the mark itself became generic, or (iv) the mark was registered contrary to the provisions of the IP Code.

The Supreme Court ruling

Under Section 122 of RA 8293 (IP Code), the rights on a mark shall be acquired through registration made validly in accordance with its provisions. To remove any doubt on the intention of the lawmakers, the Supreme Court reviewed the deliberations of the lawmakers in crafting the IP Code, and quoted the sponsorship speech of the late Senator Raul Roco to show that in order to comply with the TRIPS agreement and other international commitments, the proposed law no longer requires prior use of the mark as a requirement for filing a trademark application, and abandoned the rule that ownership of a mark is acquired thru use by now requiring registration of the mark in the IPOPHL. Two justices dissented and could not agree that the present IP Code abandoned use as a mode of acquiring ownership since the IP Code mandated the filing of declarations of use. This was explained away by making the distinction that use is not a mode of acquiring trademark ownership, but use is required to maintain ownership of the registration.

The prior user in good faith

The IP Code under Section 159.1 provides that a registered mark shall have no effect against any person who in good faith before the filing or priority date was using the mark for the purposes of his business or enterprise. The Supreme Court ruled that Zuneca, being in good faith, is not liable for trademark infringement. Hence, the award for damages and the other penalties were removed. Section 159.1, however, limits the right of the prior user in good faith as regards transferring or assigning its trademark rights, by mandating that the business or that part of the business involving the mark should be transferred as well. The Supreme Court highlighted this provision by stating that the mark ZYNAPS cannot be transferred independently of the business or enterprise using it.

The implications of the decision

Co-existence of confusingly similar marks in the market. Since Natrapharm is a registrant in good faith, and Zuneca is a prior user in good faith protected by Section 159.1 of the IP Code, the ZYNAPS mark of Zuneca and ZYNAPSE mark of Natrapharm will co-exist, notwithstanding that they are confusingly similar, to the possible detriment of the consumers. The drugs are directed towards different ailments and have different composition, and the possibility of medical switching, whether deliberate or by inadvertence, can occur, resulting in injury to the patient. The Supreme Court believes that the occurrence of confusion to the public is mitigated by the fact that the Generics Act of 1988 as amended by the Cheaper Medicines Act requires the generic name of the drugs to be written in prescriptions, and physicians who fail to do so are subject to penalties. Recognizing, however, the possibility that medical switching could arise, the Supreme Court ordered the parties to indicate on their respective packaging, in plain language understandable by people without medical background or training, the medical conditions that each drug is supposed to treat, and a warning what each drug is not supposed to treat, and to show to the court compliance with said directive within 30 days. Whether this will actually work or not remains to be seen, and because the marks are nearly identical in appearance and sound, the likelihood of confusion remains a high possibility.

Need to make trademark owners more aware of their IP rights. This landmark decision clearly underscores the necessity for trademark owners to file and obtain registration for their trademark. The Philippine economy is driven by SMEs and MSMEs, which comprise about 99.6% of the total number of enterprises in the country. The potential prior users would most likely come from this sector, particularly since intellectual property is not usually top of their mind. While some degree of awareness has been noted as evidenced by the increasing number of filings coming from domestic entities, many of these businesses do not regard protecting their IP rights as important as

getting their goods or services sold and accepted by the consumers. Only when others start copying them do they become aware of its importance. From a limited survey of SMEs that we conducted earlier this year, the lack of interest stems mostly from the lack of awareness of IP, and the attendant cost and access to the IPOPHL for the registration. While the access has been made easier by the IPOPHL in the sense that online filing is encouraged, the challenge to the SMEs is connectivity and investment in computers.

Review of IP Code to recognize the rights of prior users who have no registered marks. Building awareness of IP rights take time and must be coupled with some form of incentives for SMEs to seriously think of. The current IP Code is being revised, and the dissenting opinions of Justices Leonen and Lazaro-Javier would be instructive in crafting clearer provisions that could be more practical and fair to the SMEs that would allow for the recognition of prior use in good faith as a mode of acquiring ownership of a trademark.

The current Section 159.1 limits the commercial exploitation of the prior user in the sense that the business has to be assigned or transferred with the mark. Why can't the mark be sold without selling the business?

Review of FDA Rules. By agreement between the IPOPHL and FDA, the latter left to the IPOPHL the matter of confusing similarity of trademarks. In the past, the FDA checked their own records and did not allow a similar name of the drug to be registered. Since the FDA is the first agency that would be approached by a manufacturer or drug trader to obtain product registration which is required before the drug is sold or offered for sale in the market, the authority to check not only the technical specification of a drug, but also its name as well should be part of its function. 

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ASEAN

Valentino S.p.A loses to Matsuda & Co. over dispute in trademark name 'Valentino'

Valentino S.p.A. v Matsuda & Co [2020] SGIPOS 8

Choosing a trademark for businesses comes with a risk, whether it is a given name, a surname, or a combination of the two. It is because others may be able to use these names in good faith without impinging upon the trademark owner's rights. The more common the name, the more likely it is to be difficult to protect the trademark, except in combination with a given name.

This case is an example of a dispute between two businesses who have chosen such trademark.

Matsuda & Co. (the applicant) is a company that sells a wide range of goods such as bags, clothing, footwear, headgear and jewelry. The applicant applied to register the Valentino Rudy trademark (the application mark) in Singapore on 12 October 12, 2017, under Trade Mark No. 40201719905R in Classes 18 and 25.



VALENTINO S.p.A (the opponent) is a well-known Italian company that operates luxury fashion businesses worldwide, and was founded in Rome in 1959. The opponent is the registered proprietor of 33 earlier trademarks and filed its Notice of Opposition to the registration of the Application Mark on January 24, 2018.

The applicant filed its counterstatement on March 14, 2018.

Grounds of opposition

Section 8(2)(b) of the Trade Marks Act (the act). The application mark is similar to an earlier registered trademark for identical goods and services that already exists and may create confusion on the part of the public.

Section 8(4) of the act.

The application mark shall not be registered if the whole or an essential part of the trademark is identical with or similar to an earlier registered trademark that is well known in Singapore that would (i) indicate a connection between those goods or services and the proprietor of the earlier trademark, and (ii) would cause dilution in an unfair manner of the distinctive character of the earlier trademark.

Section 8(7)(a) of the act.

The application mark shall not be registered if its use in Singapore is liable to be prevented by virtue of

any law protecting an unregistered trademark or sign used in the course of trade (ie., the law of passing off).

Decision of the Registrar

Decision on Section 8(2)(b) of the act. The ground of opposition under the act fails at the initial impediment. The registrar based its decision on the following reasons.

As per the opponent, the average consumer of the goods (bags, wallets, clothing, headgear footwear, and other sorts of products) would not pay a high degree of attention when selecting the goods. On the other hand, the applicant considered that the consumer would pay a higher than normal attention when choosing the goods.

The Registrar said that the consumers are reasonably aware of the brand, thus giving a medium degree of attention to his/her choice of product.

Although the opponent relied on 33 earlier trademarks, the counsel of the opponent accepted in the hearing that these three marks (opponent's composite mark) are its best case.



The application mark and the opponent's composite mark must not be broken down into parts and shall be taken as a whole. Overall, the Registrar found that both of the marks have its own degree of significant distinctiveness.

Visual/aural/conceptual similarity

Visual similarity. The application mark and the opponent's composite mark are more dissimilar than similar. The mark "VALENTINO", as characterized by the Court of Appeal, is a common name, as well as the central positioning of a device element above the word elements.

The application mark and the opponent's composite mark are both comprised of two words, 'Valentino Rudy' for the former, and 'valentino garavani' for the latter. Though both of them contain the letter 'V' logo on the center of its marks, the application mark is more of an asymmetrical logo in a square box.

Therefore, in the perspective of an average consumer, the dominant element in the application mark would be the cursive script, and written in lower cases for the opponent's composite mark.

Aural similarity. The word 'VALENTINO' is present in both the application mark and the opponent's composite mark, but does not take element in the 'Rudy' and 'Garavani'. It is also taken into consideration that

the pronunciation of the word 'VALENTINO' may be emphasized in the application mark by an average consumer, which is shared with the opponent's composite mark.

The application mark contains exactly half of the aural content of the opponent's composite mark, making it more dissimilar than similar. Overall, the Registrar found the aural similarity neutral and favors no one.

Conceptual similarity. Simply because the word 'VALENTINO' is present in both marks does not make it the same. Conceptually, the dominant element in the application mark is the cursive style of the name 'Valentino Rudy' and does not in any way resemble the opponent's composite mark.

Decision on Section 8(4) of the act. The ground of the opposition under Section 8(4) fails. Though the opponent contends that the presence of the word 'Valentino' in the application mark makes it the dominant element, the Registrar does not consider it correct. The application mark contains two essential features (the 'V' logo and the stylized "Valentino Rudy") and must be interpreted as a whole.

Decision on Section 8(7) of the act. The ground of opposition under Section 8(7) of the act fails. It is proven that the opponent owns goodwill in Singapore due to its sales, advertising, promotional activities. The opponent also

operates two boutiques, and a website that is accessible in the country.

However, the use of the application mark does not establish any misrepresentation to the opponent's mark because there is no similarity, thus, creating no harm in the relationship of the consumer and opponent's products.

Overall Conclusion

Considering all the finding of lack in similarity and failure on all grounds of the opponent, the IP Adjudicator allowed the application of the application mark to be registered. 

ABOUT THE AUTHOR

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INDIA

Go digital and be simple in 2020 with new patent rules in India

The year 2020 has transformed the world by empowering people to continue working during the pandemic lockdown through digitization and IT tools providing online access of all required information.

There have been several

changes in the Indian Patent Rules in the past two years. The main changes have been related to recognition and incentives for startups and SMEs, as well as for female applicants for patents in terms of fee concessions and expedited examinations. The recent Indian Patent (Amendment) Rules 2020, notified on October 20, 2020, (Rules 2020) made procedural changes with respect to the submissions of the statement of commercial working along with document submissions

in PCT national phase applications.

PCT national phase applications: Priority and translation

The Rules 2020 clarify that the requirement of filing a certified copy of the priority document within 31 months of PCT priority date would be considered to be satisfied if said document is available in the digital library of the International Bureau (IB) and a request is made for its access. Thus, a priority claim cannot be disregarded by the Indian patent office if it has digital access of the

priority document.

Further, the Rules 2020 relaxes the translation requirement of non-English PCT priority documents. The English translation of the priority document is required to be submitted only if Rule 51bis1(e) of the PCT Regulations are applicable. This means that the English translation of priority document is required to be submitted only if (i) validity of priority claim is relevant to patentability determination; or (ii) where the international filing date was accorded on the basis of the incorporation by reference of an element or part; or addition of missing parts; or correction of erroneously filed elements. The translation filing is thus for the purposes of determining whether such corrected element or part is completely contained in the priority document concerned.

Indian granted patents:

Commercial working statements

Indian patent law considers that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations. Thus, patents are granted to encourage inventions and to secure that the inventions are worked in India on a commercial scale and to the fullest extent that is reasonably practicable.

Patent post-grant formality requirements in India include a commercial working statement to be submitted annually besides the payment of a maintenance fee. The Rules 2020 bring to the limelight some of the aspects of commercialization that a patentee needs to consider while submitting such statements before the Indian patent office.

The term "patentee" denotes the person or entity entered on the Indian patent register as the grantee or proprietor of the patent



and also includes an exclusive licensee. The obligation to submit a commercial working statement of Indian patents is on the patentee as well as the licensee, exclusive or otherwise. The registration of license agreement(s) of a patent is thus critical.

The Indian patent law requires that any licence, mortgage, or assignment of a patent or of a share in a patent, or the creation of any other interest in a patent, to be in writing specifying all the rights and obligations. Further the licensee or any person who becomes entitled by any interest in a patent is required to apply for registration of his title or notice of interest in the Indian patent register. The patentee may also fulfil this obligation of the licensee by registering such document before the patent office. However, the patentee cannot file a commercial working statement on behalf of licensee as per the changes brought about in the Rules 2020.

Commercial working statement under Rules 2020

The prescribed format for making commercial working statements had been in controversy the past few years, with right owners finding the format to be too vague and intruding on one side and public stakeholders challenging the submissions to be not sufficient and useful. The Indian patent office was directed by the courts in view of a public interest litigation to rectify the situation and the result is the new format under the Rules 2020. The statement format has

been simplified and the statement period has been adjusted to correspond with the Indian Financial year, i.e., from April 1 to March 31 of the subsequent year. The submission time period has been increased from three months to six months, thus making the due date September 30.

The two substantial changes that a patentee needs to consider are:

- *One commercial product one statement.* A single statement for multiple patents may be filed if the working of the invention is such that the commercial aspects are difficult to segregate. The only criteria is that all such patents should be owned by the same entity. Thus, this provision cannot be applied when two different patentees are commercially working their invention by way of cross-licensing. A combined statement for a patent would be preferable when it cannot be performed without substantial risk of infringement of a claim of any other patent, especially when a reference to the other patent has been inserted in the complete specification. The patentee needs to evaluate carefully as to which patents should be combined in a single statement.
- *Patentee and Licensee to file separate statements.* The Rules 2020 no longer allow the patentee and licensee to file joint statements of commercialization. This saves the patentee from facing the penal charges of non-compliance related to commercial working statements if the licensee does not fulfil his obligation. However, this also burdens the patentee to provide evidence for the working data in compulsory license proceedings and even enforcement proceedings, where the opposite party may challenge the licensee working data if the licensee

has not submitted such statement. The patentee needs to ensure that that patent license agreement clearly mentions filing of commercial working statement as an obligation of the licensee.

Conclusion

The potential of digitization and innovation to add value to society is unquestionable in today's world. The monetization of patents is the main goal of patentee. The commercial working statements are indicators of the same. The valuation of patents and patented products in terms of quantum and value would bring the statements under scrutiny during infringement proceeding and compulsory license proceedings as well as benefit sharing requirements in case of inventions using biological resources. The commercial working statements therefore need to be prepared with utmost care. 

ABOUT THE AUTHOR

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is a partner at Anand and Anand in Noida, where she specializes in intellectual property management and protection with customized planning, per her clients' business needs, and in IP monetization-related strategic advice, as well as in licensing, management, opposition, revocation and infringement. Wilson is a lawyer with a Ph.D in applied sciences, making her an expert in handling technical as well as legal issues effectively. She appears before various legal authorities, including the Indian Patents, Designs and Trademark Office, the Plant Variety Authority, the National Biodiversity Authority, the Intellectual Property Appellate Board (IPAB) and judicial courts in India.



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INDIA

Claim miners: Working around the patented claims

Claim mining is a technique by which a later inventor can work around the claimed patented invention. Knowingly or unknowingly, inventors look for a successful prior art or a prior patent and work on the difficulties left unresolved by the prior inventor(s). The difficulties in any patented invention are reflected by the way the claim limitations are cleverly drafted. When any later inventor looks for a solution in the same field, he sees to it that he avoids the prior disclosure and clearly distinguishes the invention from the prior art.

The difficulty of enforceability of broad claims make it rather easy for the drafter of claims to cleverly bring out any limitations so anticipated. However, it leaves a possible gap for a later inventor to capture the patent during the marketing of the product. It is understood that literal infringement does not occur in the case of the marketed product for infringement purposes if it falls outside the claims. This type of working around the claimed patented invention for the purpose of marketing is visible and prevalent in the United States in particular, where generic pharmaceutical companies are permitted to apply for Food & Drug Administration approvals before the expiry of the target patent. Where patent claims are based on the physical form of the compound or special properties which link thereto, the generics companies normally venture to market the product not covered by the targeted patented claims. Enforcement of such claims are fraught with difficulties where the patentee surrenders the broad claims to avoid patentability rejections and settle for self-imposed limitations.

Difficulties in claims with physical form of a compound

To illustrate this point let us look at the proceeding in *Bayer AG v. Elan Pharmaceutical Research Corp.* [212 F.3d 1241]. Relating to US Patent No. 5,264,446 on sustained release of nifedipine owned by Bayer AG and Bayer Corporation. This patent claimed a pharmaceutical composition that contains nifedipine crystals of a defined specific surface area (SSA). Claim 1, which Bayer asserted against Elan, recites the broadest SSA range: "1. A solid pharmaceutical composition comprising as the active ingredient an effective amount of nifedipine crystals with a *specific surface area of 1.0 to 4 m²/g*, in admixture with a solid diluent, to result in a sustained release of nifedipine."

Elan, on the other hand, asserted that their composition only covered nifedipine crystals of a SSA of 5 m²/g or greater. Elan submitted to FDA that it intended to measure the SSA of its nifedipine no more than five business days before tablet manufacture and that it would discard any nifedipine having a SSA of less than 5 m²/g.

Interestingly, during prosecution, Bayer had surrendered claim coverage to nifedipine crystals beyond the range of 1.0 to 4 m²/g SSA. Bayer's amendment changing Claims 1, 2, and 3 from a SSA range of 1.0 to 6 m²/g to 1.0 to 4 m²/g and Bayer's general arguments for patentability clearly established this.

The court concluded that Bayer's amendment to a SSA range of 1.0 to 4 m²/g was an attempt to overcome an obviousness rejection and that Bayer had made statements that constituted a "clear and unmistakable surrender" of subject matter outside of the claimed range of 1.0 to 4 m²/g.

In view of these facts court held: "We believe that the specification in Elan's ANDA mandates a finding of no literal infringement. Elan's specification indicates that 'the specific surface area of the micronized nifedipine



is to be 5 m²/g or greater,’ and that this SSA ‘will be reflected in certification of analysis provided by Elan’s supplier (AWD).’ Elan further defines its specification by noting that it is ‘Elan’s intention to measure specific surface area on the micronized Nifedipine material prior to use (within 5 working days prior to blend manufacture) to ensure that the 5 m²/g specification for specific surface area is met. Material not meeting this specification will not be used for manufacture.’

The court continued: “Thus, according to Elan’s ANDA specification, nifedipine used in its drug cannot have a SSA of less than 5 m²/g within five working days prior to manufacturing. Significantly, Bayer does not allege that within five working days, the nifedipine’s SSA will decrease from 5 m²/g to a literally infringing size of 4 m²/g or less. *Therefore, under the ANDA specification, Elan cannot literally infringe the ‘446 patent.’*”

Spray dried lactose patent case

In an earlier case, *Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals* [170 F.3d at 1376-79], that was relating to certain pharmaceutical formulations of the anti-diabetic drug glyburide where Upjohn alleged that Mylan’s commercial manufacture and sale of two of the accused products constituted infringement of Upjohn’s US Patent No. 4,916,163. During the proceedings, Upjohn acknowledged that Mylan has not literally infringed the ‘163 patent and relied on the doctrine

of equivalents to assert the infringement.

Interestingly, in this case also, the patentee argued that the use of spray-dried lactose was “a critical feature” of the claimed invention and that using lactose that was not spray-dried resulted in a pharmaceutical powder that was not readily processed.

In view of that, the court concluded that the patentee had relinquished claim coverage to any type of lactose that was not spray-dried. The court held that the commercial manufacture, use and sale of Mylan’s micronized glyburide products do not infringe on the ‘163 patent, since these products *do not contain spray-dried lactose as required by the ‘163 patent claims.*

Cautionary note

A patent claim of a compound by reciting its chemical structure is the most desirable type of claim. Such claim is considered a claim to the chemical *per se*, and it is easy for a court to construe such claims. It is generally believed and understood that such a claim would be literally infringed by any physical form of the chemical. Such claims are preferred for new chemical entities. Working around such a claim is rather difficult and fraught with application of the doctrine of equivalence by the courts.

However, the trend of patenting activity has now shifted to improvements of old products rather than looking for new entities. In the race to get more

patents, the patentee seeks to get patents for every possible physical form of a compound that may also be important to the properties of disclosed and claimed chemical compositions. However, this tactic leaves sufficient space for the claim miners to work around the invention and capture the market space left open. If sufficient care is not taken during claim drafting and prosecution, claim miners can take advantage and market the product before expiry of the patent. ^{AP}



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D.P.S Parmar heads the Intellectual Property Appellate Board (IPAB) practice group at LexOrbis. After joining the IPAB as Technical Member (Patents) in 2011, he has been instrumental in writing some path breaking and insightful decisions on Indian patent law issues. These include establishing legal positions on excluded subject matter under Sections 3(d), 3(i) and 3(k), divisional applications, disclosure requirements under Section 8, working statements and compulsory license, to name a few. Before joining the IPAB, Parmar worked with the Indian Patent Office for more than 27 years and played a vital role both at the administrative and policy levels. He also served as the head of the Intellectual Property Training Institute in Nagpur, which was responsible for providing training to new examiners at the IPO.



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