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WHEN MICKEY MOUSE ENTERS THE PUBLIC DOMAIN

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THE LINES FOR MUSIC
CREATIVITY?

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THE WORLD'S IP
HUB CONTINUES

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THE BUYING
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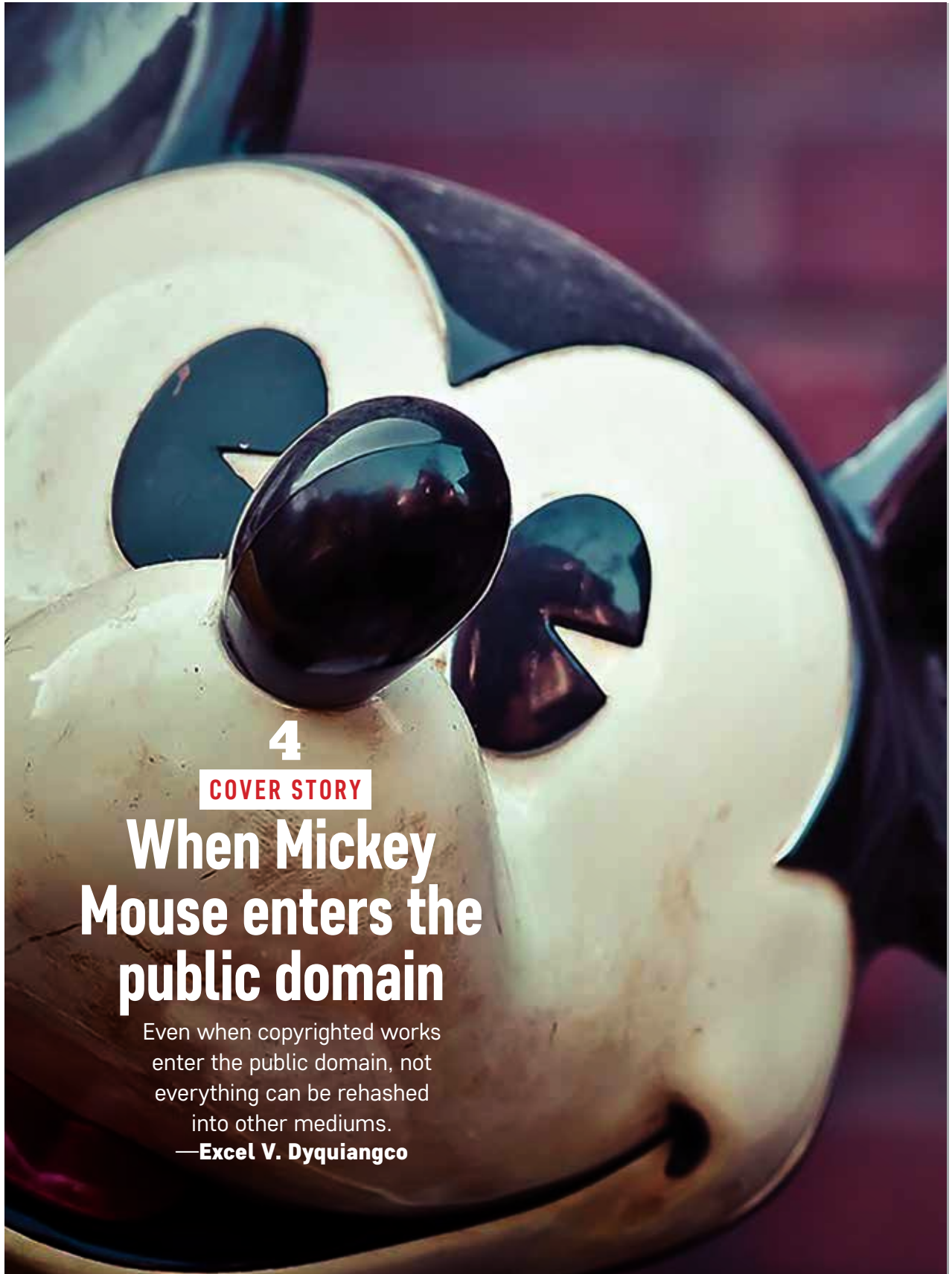
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OPINION



ED SHEERAN, STEAMBOAT WILLIE AND COPYRIGHT

Copyright law has been given more than its share of attention in the traditional media lately.

If there's a Gen Z or Millennial in your life, they might know about the 2023 verdict in New York that found that British pop star Ed Sheeran did not violate copyright in an old Marvin Gaye song called "Let's Get It On."

"Sheerios" everywhere breathed a sigh of relief when the verdict was announced, as Sheeran had threatened during his testimony to retire if copyright claims like the one against him continue. Sheeran said in a post-trial statement that he is "unbelievably frustrated that baseless claims like this are allowed to go to court at all. It's simply wrong. By stopping this practice we can also properly support genuine music copyright claims so that legitimate claims are rightly heard and resolved," calling the claim against him a "bogus claim."

If your favourite Gen Z'er asks you whether the most recent Sheeran case (in 2015, he was involved in a different copyright infringement case, when he was accused of using music from a different Gaye song) represents a change in how cases involving music copyright infringement are proceeding, Excel V. Dyquiango has been in touch with lawyers across Asia, finding out what they have to say.

"For every two disputed songs in every case, we are looking at differing chord progressions and harmonic rhythms and whether one party can claim copyright in something that may be considered common," explained Alyshea Low, a partner at Skrine in Kuala Lumpur. "In the Ed Sheeran case, the defendants were able to distil the commonalities between the two songs in question and, with that commonality, reduce it to something that cannot be afforded copyright protection."

At the same time, on the other end of the age spectrum, Steamboat Willie, the first iteration of Mickey Mouse, has slipped into the public domain in the United States. Dyquiango explores how Steamboat Willie's newfound freedom parallels the journey of Winnie the Pooh, whose public domain status led to surprising adaptations such as *Winnie the Pooh: Blood and Honey*. Now, Mickey Mouse is in a similar position, facing legal entanglements as creators explore fresh and unexpected contexts, such as the upcoming horror film *Mickey's Mouse Traps*.

It's a wonderful time in IP, when the rest of the world is talking about what we talk about each and every day, and these two stories complement our annual survey of the top copyright practices in Asia perfectly. We hope you enjoy this issue!

Darren Barton

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WHEN MICKEY MOUSE ENTERS THE PUBLIC DOMAIN



As Mickey Mouse joins the public domain, questions arise about the implications for derivative works and the balance between IP protection and fostering creativity. **EXCEL V. DYQUIANGCO** checks in with legal experts.

The recent entry of Steamboat Willie, the earliest version of Mickey Mouse, into the public domain in the United States has ignited discussions on the implications for Disney's extensive character portfolio and the potential for new creative interpretations.

Steamboat Willie's newfound freedom parallels the journey of Winnie the Pooh, whose public domain status led to surprising adaptations such as *Winnie the Pooh: Blood and Honey*. Now, Mickey Mouse is in a similar position, facing legal entanglements as creators explore fresh and unexpected contexts, such as the upcoming horror film *Mickey's Mouse Traps*.

The move raises questions about the implications for Disney's extensive character portfolio and the potential for a more lenient stance on derivative works. It has sparked a broader conversation about the balance between protecting IP and fostering creative reinterpretations in the digital era.

According to Danielle Francesca T. San Pedro, a partner at Villaraza & Angangco in Manila, this usually happens when copyrighted work goes into the public domain. "A unique aspect of storybook characters that may not apply to other creative works is that, unlike a written story or song, characters can exist in various versions and interpretations," she said. "While the core concept may be in the public domain, specific artistic

depictions or character traits might still be under copyright."

Further, she added that characters can gain further protection through other types of IP rights. For instance, registering a unique appearance or portrayal of a character, along with their names, as trademarks. Even if the original literary or artistic work containing the characters is already in the public domain, certain aspects of the character can still be safeguarded under specific conditions.

Mudit Kaushik, a partner at Verum Legal in New Delhi, emphasized that only the 1928 iteration of Mickey Mouse has entered the public domain. Subsequent developments of the character remain under Disney's copyright protection, including distinctive features such as Mickey's rounded ears and personality traits. "While artistic reinvention of *Steamboat Willie* is permissible, commercial exploitation of later versions of Mickey without Disney's express permission remains prohibited," he said.

He added: "Disney possesses a robust portfolio of trademarks encompassing the name and various visual representations of Mickey Mouse. These trademarks safeguard the character's distinct identity and ensure an unwavering association with the Disney brand. Therefore, while artistic reinterpretation of *Steamboat Willie* is permissible, exploiting later versions of

"Unlike a written story or song, storybook characters can exist in various versions and interpretations. While the core concept may be in the public domain, specific artistic depictions or character traits might still be under copyright."

—DANIELLE FRANCESCA T. SAN PEDRO, partner
Villaraza & Angangco, Manila

"Characters from stories or books can indeed be eligible for copyright protection, but certain criteria must be met to enjoy this safeguard. These criteria pertain to the uniqueness and non-generic nature of the characters."

—MUDIT KAUSHIK,
partner, Verum Legal, New Delhi

"If a business is keen to use Steamboat Willie, it would be prudent to seek legal advice on whether Steamboat Willie is still subject to copyright protection in that jurisdiction. This is especially so since each case will have to be decided on its own facts."

—MERYL KOH, director,
Drew & Napier, Singapore



Mickey on merchandise or in works potentially leading to consumer confusion with Disney is expressly forbidden. This trademark protection extends beyond mere appearance, encompassing even the characteristic gestures and personality traits that have cemented Mickey's status as a cherished cultural icon."

Interestingly neither Winnie the Pooh or *Steamboat Willie* were the firsts. When Disney Studios produced their animated film *The Little Mermaid* in 1989, the original Little Mermaid story, also known as *Den lille havfrue*, penned by Danish author Hans Christian Andersen, had already entered the public domain. The tragic narrative was significantly altered in Disney's rendition, which included giving the main character, Ariel, a new name, as well as adding memorable supporting characters like Sebastian and Flounder and even rewriting the story's conclusion. Even with this change, Disney still has the copyright on its own adaptation of Hans Christian Andersen's *The Little Mermaid*, which includes Ariel's name and appearance.

This pattern extends to other Disney classics, including the 1967 adaptation of Rudyard Kipling's *The Jungle Book* (1894), the 2013 adaptation of Hans Christian Andersen's *The Snow Queen* (1844) and the 1992 adaptation of *Aladdin* from the collection of Middle Eastern folktales compiled in *One Thousand and One Nights*.

Meeting certain conditions

Even with copyrighted works entering the public domain, not all can be rehashed into other mediums. "Characters from stories or books can indeed be eligible for copyright protection, but certain criteria must be met to enjoy this safeguard," said Kaushik. "These criteria pertain to the uniqueness and non-generic nature of the characters."

Kaushik said that characters can be categorized into two main types: graphic characters and fictional characters. "These distinctions are crucial because courts have established different tests for copyright protection for each category."

Graphic characters are those that can be visually depicted, typically through cartoons or other graphic representations. Their physical appearance and characterization are readily apparent to readers or viewers. On the other hand, fictional characters exist as word portraits, with their physical attributes and personality traits residing in the minds of readers. The imagination of these characters is crafted through the pages of a book rather than through a single paragraph or line. Consequently, fictional characters are not immediately apparent to the reader.

"Given that images are more easily identifiable than literary descriptions, pictorial or graphic characters tend to be more straightforward to protect under copyright law, even when divorced from their original context," Kaushik said. "However, it's important to note that copyright protection for a graphic character does not extend to the character as

a whole. Instead, copyright law can only protect the specific visual representation of the character. The character's personality and traits, which are integral to its identity, do not fall under the purview of copyright protection as an 'artistic work'. This is because these aspects of a character are not visually expressed but are rather aspects that can only be perceived by the human mind.

Moreover, the application of IP law can vary across countries. Pertaining to Kaushik's discussion of fictitious characters, he notes that while Indian copyright law protects original literary, artistic, dramatic and musical works, including films and sound recordings, there is no explicit legislation in India addressing the protection of fictitious characters.

So, when storybook characters become part of the public domain, what are the consequences for derivative works or adaptations, and how does this influence the capacity of others to generate new content featuring these characters?

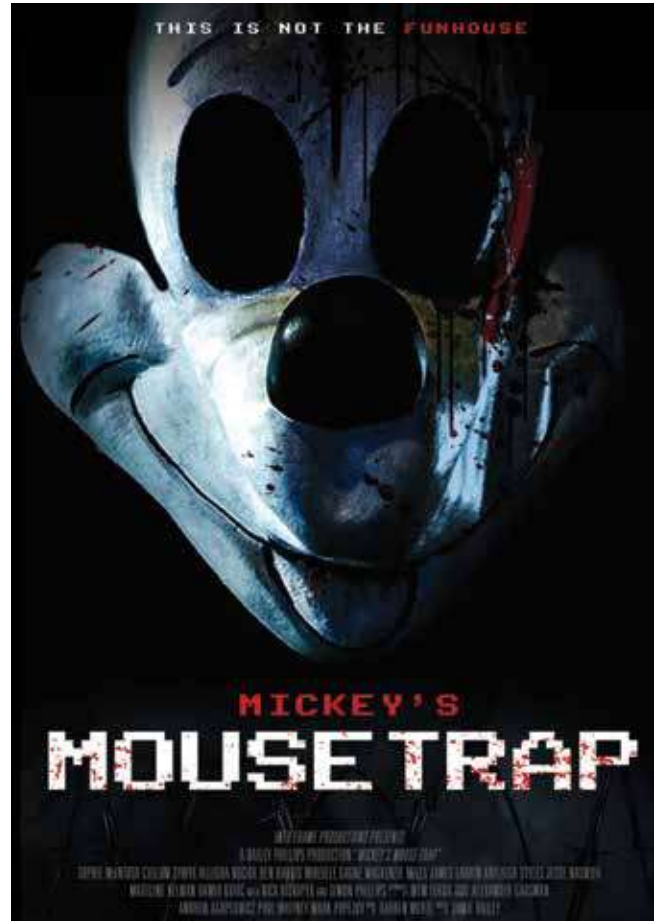
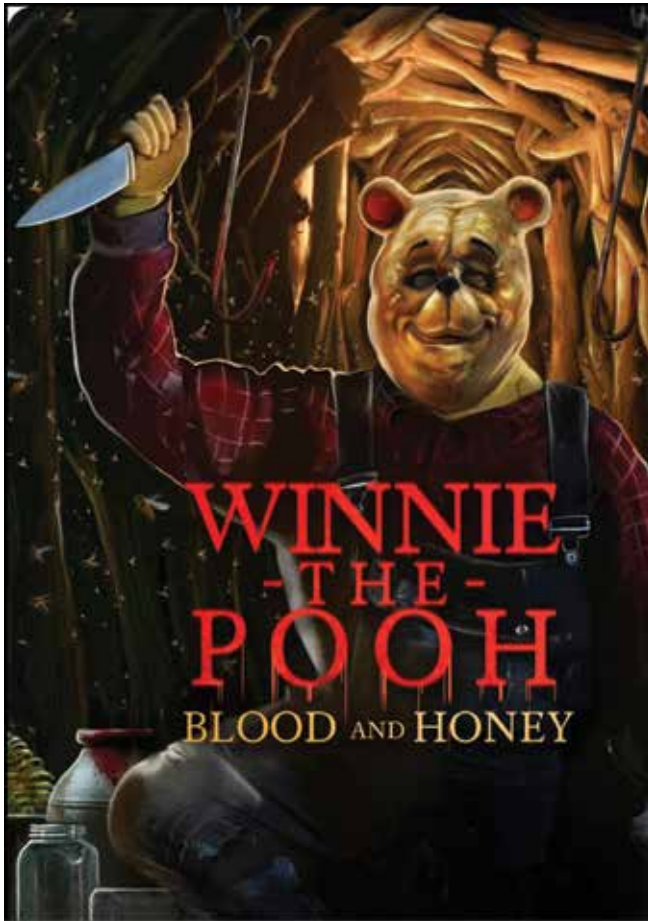
Kaushik said: "The public domain liberates creativity. When the copyright on storybook characters expires, creators are granted unparalleled artistic freedom. They can reimagine characters' appearances, personalities and narratives without the need for permissions or adherence to copyright restrictions. This fosters a climate of unfettered creativity, enabling bold interpretations, experimental storytelling, and even subversive takes on beloved characters. It democratizes storytelling, allowing anyone with a creative spark to contribute, diversifying perspectives, and enriching our cultural tapestry. The public domain also stimulates commercial exploration. Characters become free for commercial use, opening doors for merchandise, spin-off stories and various ventures. This expansion of economic possibilities around these characters incentivizes further creative engagement and contributes to a vibrant ecosystem of content."

Since the public domain applies only to specific iterations of characters in their copyrighted forms, later evolutions may still be under copyright protection. Trademarks associated with characters' names or logos can also impose restrictions on commercial use.

Derivative works versus copyrighted works

To explain better this derivative work, San Pedro said that derivative works refer to copyrighted works that come from another copyrighted work. "The author has either obtained the appropriate consent of the author or copyright owner of the original work, or the original work is in the public domain," she explained. "To be protected as a derivative work, the new work must contain sufficient original creative content to be distinguishable from the original work while still recognizably connected to it. Slight modifications or updates will not suffice."

Under the IP Code of the Philippines, derivative works are treated as new works, deserving of their own copyright protection. This means that while the original work retains its copyright status, the derivative



work is also safeguarded under copyright law. “That said, the derivative work’s protection is not lost when the original or parent work enters the public domain. Others may use the original work, but they cannot use the modifications or new elements introduced by the derivative work,” she said.

Furthermore, San Pedro highlighted the importance of the public domain in fostering creativity. Once a literary piece enters the public domain, its characters and elements become “freely and unconditionally used by third parties as-is, or in other forms, versions, and variations as in the case of new storylines, artworks, movies, and cartoons.” However, she noted that these derivative works must exhibit sufficient originality to qualify for copyright protection, ensuring that creators are rewarded for their innovative contributions.

“Contrary to what copyright owners may think, the copyright system and the public domain are two necessary sides of the same coin,” she said. “While the public domain fosters creativity and innovation, the copyright system protects and incentivizes them. Otherwise, allowing a system of perpetual copyright protection would result in a monopolistic and stagnant environment where audiences have no other options but to watch uninspired live-action movie adaptations.”

Permissible in other jurisdictions?

With Steamboat Willie entering the public domain in

the United States, is his use also permissible in other jurisdictions? Not necessarily so, said Meryl Koh, a director at Drew & Napier in Singapore.

“If a business is keen to use Steamboat Willie for activities in a particular jurisdiction, it would be prudent to seek legal advice on whether Steamboat Willie is still subject to copyright protection in that jurisdiction,” she said. “This is especially so since each case will have to be decided on its own facts.”

Concerning copyright, Koh highlighted that each case must be evaluated individually, considering factors such as the origin of the expression and intended usage if the business intends to make changes to the expression. “From the perspective of Singapore law, legal counsel can then assess issues including whether the whole or a substantial part of that expression has been used such that the business may be found liable for copyright infringement and whether the business can rely on defences (fair use),” she said.

Meanwhile, concerning trademark or passing off, Koh underscored the necessity of conducting trademark searches to ascertain whether an expression has been registered. She advised businesses to be clear about their intended use and goods or services associated with the expression to assess the likelihood of consumer confusion and potential trademark infringement.

Regarding international treaties, such as the Berne Convention for the Protection of Literary

and Artistic Works and the TRIPS Agreement, Koh explained that businesses from signatory countries receive automatic protection in Singapore. However, she advised caution and recommends consulting local legal counsel to ensure compliance with international copyright treaties and local registration requirements.

In Singapore, trademark registration is not mandatory, but it grants a 10-year statutory monopoly over a trademark in the country, enabling access to rights and remedies under the Trade Marks Act. “Without registration, businesses are limited to the common law action of passing off. If businesses are interested in registering their trademarks, it would be a useful rule of thumb for businesses to market and use their trademarks regularly,” said Koh, as this can deter others from registering similar marks. Local laws and counsel guidance are essential due to differing registration regimes.

Aside from the conventional practices above, businesses should also explore options and implement measures which keep pace with the rapid development of technology and the changing landscape of digital content creation, distribution, and consumption. First, with the advent of technology comes emerging technologies such as artificial intelligence and machine learning. “Businesses may look towards

patent law or the law of confidence (in particular, trade secrecy) to protect innovations in these areas,” said Koh. “Businesses may also wish to consult with local subject matter experts to ensure that they are not infringing upon the rights of others when developing such technologies – for example, a legal expert in Singapore could advise a business on the scope of Section 244 of the Copyright Act 2021, which provides that computational data analysis may be an exception to copyright infringement.”

Aside from copyright and trademark laws, businesses can consider implementing technological or confidentiality measures to minimize the risk of unauthorized use of valuable materials and information.

“For example, businesses can adopt technical protection measures such as encryption, authentication systems, or digital rights management,” she said. “They can also ensure that employees or key personnel have executed confidentiality agreements or non-disclosure agreements, and consumers have agreed to certain terms of use or terms of service. If, despite such measures, businesses find that third parties have unlawfully exploited their materials and information, they may consider an action for breach of confidence and/or breach of contract.”⁶¹





Did the Ed Sheeran copyright case blur the lines for music creativity?

While Ed Sheeran’s recent copyright case was lauded as a victory for creativity, there are still ongoing challenges for songwriters and performers. *Excel V. Dyquiango* discusses the effects of this victory on copyright infringement and the caution musicians must exercise.

When a jury found that the group responsible for Robin Thicke’s “Blurred Lines” violated a Marvin Gaye copyright in 2015, a new era of caution for composers and songwriters began. However, a 2023 verdict in a New York courtroom found that Ed Sheeran did not violate a separate Gaye copyright sends a different message.

Sheeran was found not liable in the infringement trial that accused his song “Thinking Out Loud” of infringing on Gaye’s “Let’s Get It On.”

Sheeran, who threatened during his testimony to retire if copyright claims like the one against him continue, said in a post-trial statement that he is “unbelievably frustrated that baseless claims like this are allowed to go to court at all. It’s simply wrong. By stopping this practice we can also properly support genuine music copyright claims so that legitimate claims are rightly heard and resolved,” calling the

claim against him a “bogus claim.”

“These chords are common building blocks which were used to create music long before ‘Let’s Get It On’ was written, and will be used to make music long after we’re gone,” Sheeran said in his statement. “They are in a songwriter’s alphabet, our toolkit, and should be there for all of us to use. No one owns them or the way they are played, in the same way nobody owns the colour blue.”

Singer John Legend even claimed that the earlier ruling would set a harmful precedent for musicians who create music inspired by others. It undoubtedly established a precedent for legal action since other seasoned composers made the decision to sue hitmakers they believed were overly influenced by their work. Several musicians started giving composition credit to earlier songs, some because the melodies were similar and others to prevent a repetition of the



“Blurred Lines” reaction. Some cases proceeded to trial, while others were handled outside the courts.

Given this scenario, does the Ed Sheeran case represent a change in how these cases are proceeding? Is a discernible shift in how courts are approaching music copyright infringement cases these days?

According to Alyshea Low, a partner at Skrine in Kuala Lumpur, it is still premature to say, based on this one decision, whether there is a shift in how courts approach music copyright infringement cases. Whether there is copyright infringement will be “highly dependent on the individual facts.”

“For every two disputed songs in every case, we are looking at differing chord progressions and harmonic rhythms and whether one party can claim copyright in something that may be considered common,” she explained. “In the Ed Sheeran case, the defendants were able to distil the commonalities between the two songs in question and, with that commonality, reduce it to something that cannot be afforded copyright protection.”

She added: “However, a potentially deciding factor was that in the Ed Sheeran case, Sheeran himself sang and played ‘Thinking Out Loud’ on a guitar to the jury when he took the stand to passionately defend himself against accusations of plagiarism. In contrast with the ‘Blurred Lines’ case, Thicke and Williams’ own counsel in an interview stated that ‘My artists were not as involved or as engaged as Ed Sheeran was.’ It is possible that Sheeran’s demonstration of the works in question, coupled with the facts of the case likely impacted (or at least influenced) the jury’s perception

over the matter when they heard the artist as a witness defending himself.”

A cautionary tale of copyright infringement?

With the “Blurred Lines” case seen as a significant turning point for the music industry, leading to increased caution among songwriters and with the recent ruling in favour of Sheeran, is this caution of others in the industry be alleviated, or do other factors continue to contribute to the complexity of copyright issues in music?

“We think it’s a bit premature to say how the Ed Sheeran case will influence the impact made by the ‘Blurred Lines’ case,” said Low. “After all, the ‘Blurred Lines’ case has not been expressly overruled. As such, the odds are even, so to speak, between plaintiffs and defendants now that there are two paradoxical judgments on the degree of similarity that needs to be proven to establish infringement.”

Gooi Yang Shuh, a senior associate at the same law firm, said songwriters and composers – like John Legend, above – widely panned the “Blurred Lines” case for fear that it set a precedent, which blurred the lines between being inspired by a song and actually copying it. He added that this is particularly so given that most music – even art and culture, in general – is inspired by previous works and what has come before.

As artists can readily name multiple other artists who inspired and influenced their musical style and career, this has caused concern on its effect on creative expression in music, according to Shuh.

Meanwhile, many artists and songwriters have vocally lauded the Ed Sheeran case as a victory for creativity. Many regard it as a message that there cannot be copyright monopoly over commonplace elements of musical composition, particularly chord progressions. However, Shuh noted that this may deter copyright owners from suing for infringement due to mere similarities in chord progressions and allow songwriters to continue making music without constant fear that they cannot use a chord progression already used in other songs.

In addition, Shuh advised that the success in the Ed Sheeran case should be “viewed on its specific factual matrix.” Since copyright infringement is multi-faceted, each case must be assessed on a case-by-case basis. With this, he said that songwriters should not take the Ed Sheeran case win to mean that this brings an end to music copyright infringement lawsuits over similarities in chord progression or even “feel and sound.”

According to Pravin Anand, managing partner at Anand and Anand in Noida, the “Blurred Lines” case led to songwriters and music producers needing to be overzealous in terms of maintaining caution, lest they are found to be infringing another composer or songwriter’s work.

“The amicus brief, signed by more than 200 producers and other persons from the music industry subsequent to the jury decision in the ‘Blurred Lines’

case is a testament to the fear that songwriters, composers and producers would be compelled to work ‘always with one foot in the recording studio and one foot in the courtroom,’” he said. “In my opinion, the change in the approach of the judiciary witnessed in the Zeppelin, Katy Perry and Ed Sheeran cases was quite welcomed. It reinstated the freedom that artists, while creating music, should have the legal principle that only specific expressions or arrangements of musical notes should be protected under copyright law and not the idea itself.”

He added: “Having said that, we feel that the level of caution exercised by songwriters, composers and producers would not *per se* be affected or alleviated

on account of the Ed Sheeran decision. The reason behind this is that when the two cases are compared and contrasted, it becomes clear that decisions of courts and juries are significantly dependent on the particular facts and circumstances of each case. We therefore feel that songwriters would continue to err on the side of caution. The trend of artists giving credit to other singers or songwriters, such as Taylor Swift crediting Right Said Fred on her single ‘Look What You Made Me Do’ and Ed Sheeran adding the writers of TLC’s ‘No Scrubs’ to his song ‘Shape of You’ indicates that they would continue to be careful of potential copyright claims.”

"For every two disputed songs in every case, we are looking at differing chord progressions and harmonic rhythms and whether one party can claim copyright in something that may be considered common."

—ALYSHEA
LOW, partner, Skrine,
Kuala Lumpur

"It's a challenging world for songwriters, and the advent of AI composition tools won't make that any easier. We are seeing a fragmentation of laws across the world in relation to how copyright laws will apply, and it is going to get a lot more confusing before it is all resolved."

—PAUL
GORDON, partner,
Wallmans Lawyers,
Adelaide

"The amicus brief, signed by more than 200 producers and others from the music industry is a testament to the fear that songwriters, composers and producers would be compelled to work ‘always with one foot in the recording studio and one foot in the courtroom.’"

—PRAVIN ANAND, managing partner, Anand and Anand, Noida



When similar becomes too similar

According to Anand, this case has not established any new legal precedents or interpretations of copyright law *per se*.

“The case essentially revolved on the question ‘how similar is too similar?’ It has been noted that exclusivity cannot be claimed in musical patterns, such as the competing four-chord progressions in both the songs, which are fairly common in the industry,” he said. “The case has thus reinstated the principle that only original compositions are protected under the copyright law and commonplace elements, such as common chord progressions, do not fall within its fold.”

Anand added that the narrowing down of evidence that could be presented to a jury by the judge in the Ed Sheeran case is worthy of note.

“The judge removed reference to the bass element since the same did not appear in the sheet music deposit copy that formed the basis for copyright for ‘Let’s Get It On’ in 1973,” he said. “Further, the judge clarified in the pre-trial ruling that the plaintiff’s expert musicologist was not allowed to testify that the chord progression or harmonic rhythm in ‘Let’s Get It On’ were distinctive or unique. This was based on the reasoning that there existed uncontested proof that such elements are common musical techniques. This case would certainly be referenced in cases where claims are sought to be levelled based on basic genre elements to strengthen the case of the defence that the use of the common elements in music is fair and non-infringing.”

This was echoed by Paul Gordon, a partner at Wallmans Lawyers in Adelaide. He said that while the case demonstrated a return to the normal, the lack of any judicial reasoning means that the case is of limited value, and that the breadth of infringement established by the “Blurred Lines” case continues to be available.


“The other thing to remember is that music is a global industry,” he said. “I’ve been commenting on a U.S. case, but the position, for example, in Australia is significantly different and only tangentially concerned with the U.S. position. As laws continue to diverge from each other, we will likely see new battle lines being drawn in cases of this type.”

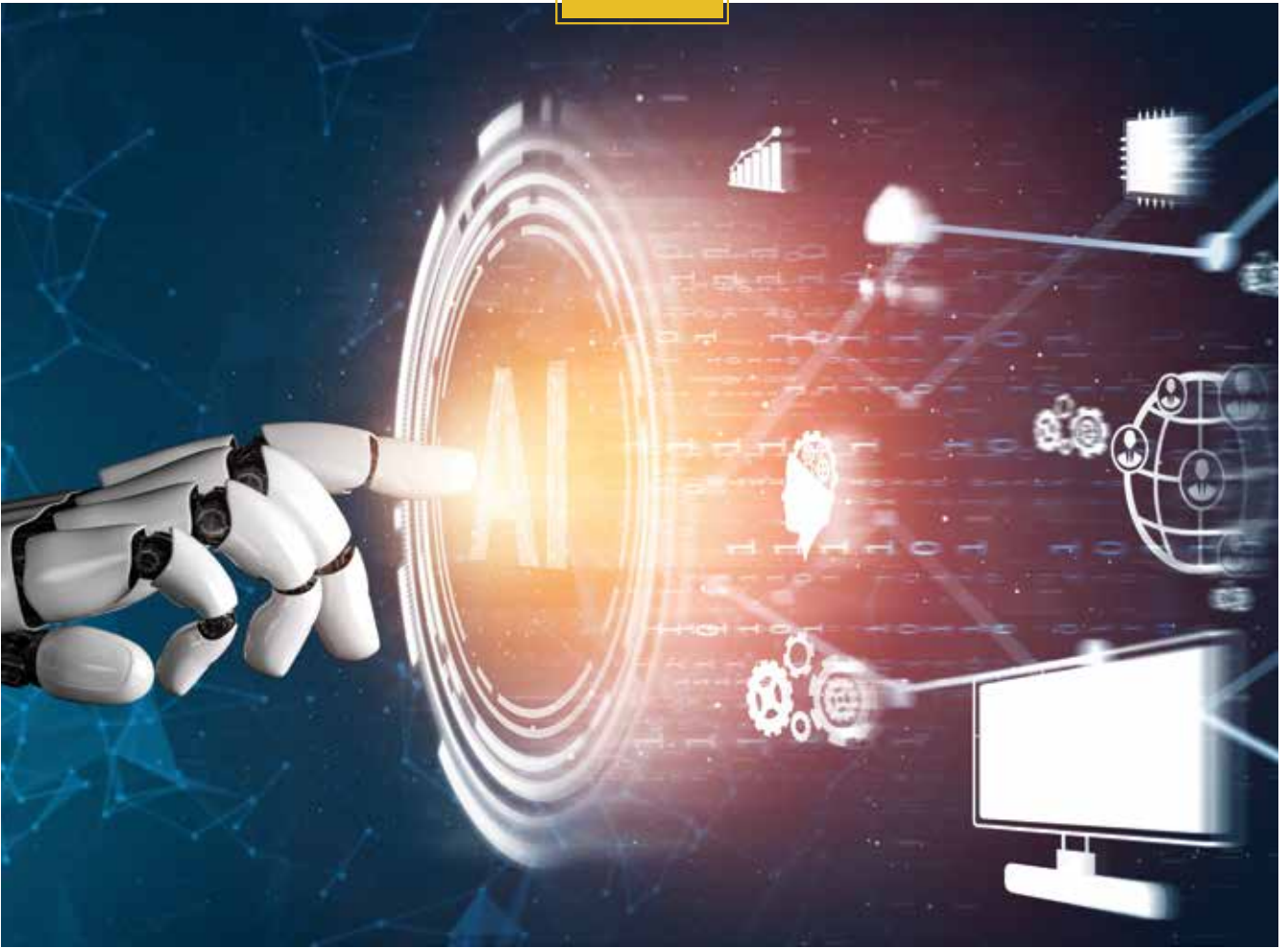
In both cases, much of the trials were dedicated to receiving evidence from expert musicologists who conducted comparative analysis of the two works in question, he added.

“In doing so they looked at repetition of melody, the presence of certain stylistic markers in each song and how they sounded,” he explained. “In the Sheeran case, I don’t believe it was ever contested that the songs used a similar chord progression. Instead, what was in question was whether there was any copyright in that progression. The experts for Sheeran argued that it was such a common pattern and were used by artists for so long that no one could legitimately claim ownership of it.”

Evolution of music copyright

Considering the broader context of technological advancements and changing artistic trends, Gordon mused that the technological changes that everyone is seeing will allow experts to be more precise as to how much of a particular work has been reproduced but is unlikely to change the subjective analysis that is inherent to decision making of this kind.

“It’s a challenging world for songwriters, and the advent of AI composition tools won’t make that any easier,” he said. “We are seeing a fragmentation of laws across the world in relation to how copyright laws will apply, and it is going to get a lot more confusing before it is all resolved.” 



COPYRIGHT PROTECTION FOR AI-GENERATED WORKS: A LANDMARK CHINESE COURT RULING

A landmark ruling from the Beijing Internet Court carries significant implications for the future of AI and IP in China, as it indicates that the Chinese courts would be willing to recognize the copyrightability of AI-generated works in appropriate cases.

Loke-Khoon Tan, James Lau and Harrods Wong explain.

Artificial intelligence (AI) has revolutionized various aspects of our lives. Specifically, the use of generative AI has transformed the way we create artwork and other forms of digital content. However, this technological advancement has also raised significant intellectual property concerns. In China, the intersection of AI and IP has become a focal point for legal deliberation. Recently, a groundbreaking court judgment marked a milestone in Chinese IP law

by recognizing copyright protection for AI-generated images. This article provides a summary of the court ruling and discusses its implications.

The landmark court ruling

In November 2023, the Beijing Internet Court in China handed down a groundbreaking ruling in a copyright infringement case involving an AI-generated image. The judgment answers the important questions of



(1) whether AI-generated works are protectable by copyright, and (2) if yes, who owns the copyright.

The plaintiff used Stable Diffusion (a text-to-image generative AI model) to generate a picture of a young woman (the Picture) by inputting various prompts (including negative prompts) and adjusting the parameters. The plaintiff posted the Picture on the social media platform Xiaohongshu using the hashtags #AI, #AI Illustration (AI插画) and #AI Drawing (AI绘画). Later, the plaintiff discovered that the defendant used and published the Picture on another platform without permission and brought a claim against the defendant for copyright infringement.

The Beijing Internet Court examined the facts of the case and rendered a detailed ruling. First, the court considered the meaning of “works” under the Copyright Law of the People’s Republic of China, which provides that copyrightable works must be original and reflect intellectual achievement, among other things.

In terms of intellectual achievement, the court noted that the plaintiff did not merely use existing pictures returned by search engines or rearrange pre-designed elements when it created the Picture. Instead, the plaintiff designed how the woman in the Picture should look, and entered relevant prompts to generate an image that matched expectations. The plaintiff inputted detailed prompts such as “*Japan idol*”, “*cool pose*”, “*viewing at camera*” and “*film grain*”, and then further adjusted the prompts based on the preliminary images generated by Stable Diffusion before finally completing the Picture in question. These actions demonstrated the plaintiff’s intellectual input.

Regarding the concept of originality, the court noted that this generally means the work should be independently completed by the author, and that it should reflect the author’s subjective expression. In general, if the same work can be created by different people following a fixed set of procedures, formula

or structure, then it cannot be original. In the context of AI-generated images, the determination of originality should be made on a case-by-case basis. The more specific the prompts are (e.g., by inputting specific descriptions of the pictorial elements and the overall composition of the image), the more the work would show its author’s original expression of ideas. In this case, although the plaintiff did not physically draw the Picture using pen and paper, the plaintiff designed the different elements of the image by inputting and fine-tuning the prompts and adjusting the parameter settings. Doing so demonstrated the plaintiff’s subjective aesthetic choice and original judgment. The court, therefore, held that the Picture is protected by copyright as an original work.

Consequently, the court categorized



the Picture as a “work of fine arts” in accordance with Article 3 of the Copyright Law, recognizing the artistic nature of AI-generated images and affirming their place within the realm of copyrightable works.

On the issue of copyright ownership, the court noted that (1) the Copyright Law provides that copyright shall be owned by the author of the work (which can be a natural person, legal person or an unincorporated association), and an AI model cannot be an author (and hence copyright owner) because it is not a natural person, legal person or an unincorporated association, (2) the designer of Stable Diffusion only created the AI model, but was not involved in the intellectual input leading to the creation of the Picture, and (3) the license for using Stable Diffusion expressly states that the designer of Stable Diffusion does not claim rights in any output content. Considering the above, and given the plaintiff’s significant role in the creation process, the plaintiff is the rightful author and copyright owner of the Picture.

Implications of the judgment


The court’s ruling in this case carries significant implications for the future of AI and IP in China, as it indicates that the Chinese courts would be willing to recognize the copyrightability of AI-generated works in appropriate cases.

Whether or not an AI-generated work is copyrightable will still need to be determined on a case-by-case basis, taking into consideration the factual circumstances of each case. Nonetheless, the court’s detailed analysis in this case provides us with insight into the factors that come into play when determining this issue. For example, in this case, the court discussed in detail the various positive and negative prompts inputted by the plaintiff, as well as the subsequent fine-tuning and adjustments made by the plaintiff to the prompts and the parameter settings when creating the Picture. In a different case scenario where the user’s input is more limited, the court could have come to a different conclusion. The court’s analysis on the concepts of intellectual achievement and originality provides helpful guidance for future disputes involving AI-generated content in China.

While this case brings clarity to the proposition that AI-generated content may be copyrightable in China, there are still legal uncertainties surrounding AI and IP, including on the possible liability of AI service providers for copyright infringement. On this issue, in a more recent case decided in February 2024, the Guangzhou Internet Court ruled that an AI company has infringed on the copyright of the iconic Japanese superhero, Ultraman, through unauthorized copying and adaptation, as some images generated by the company’s AI service were found to be substantially similar to the character. This case illustrates the potential liability of service providers for the output of their AI tools, and sparks discussion on their responsibilities regarding IP protection.

Looking forward

As AI technologies continue to develop and permeate our daily lives, the associated legal issues will continue to be brought into the limelight in more and more cases both in China and abroad. At the same time, governments around the world are also seeking to more formally regulate the various IP, compliance and other legal issues in the AI realm, though they may be taking different approaches and have different priorities. In China, for example, the Interim Measures on the Administration of Generative AI Services became effective in August 2023, and it imposes obligations on generative AI service providers to, among other things, ensure that training data come from lawful sources and do not infringe the IP rights of others. There is also indication that a comprehensive AI law may be proposed in China.

In this evolving era of AI, finding the delicate balance between safeguarding rights and fostering technological advancement will be crucial. It will be fascinating to see how China and other countries tackle this challenge with regard to the interests of various stakeholders as well as society as a whole, and pave the way for a future where the full potential of AI can be harnessed responsibly and beneficially for all. 

ABOUT THE AUTHORS

Loke-Khoon Tan is the head of Baker McKenzie’s Asia Pacific Consumer Goods & Retail (including Luxury and Fashion) Industry Practice, and a senior partner in the IP and Technology Group in Hong Kong and mainland China. His practice focuses especially on IP law in the People’s Republic of China, with particular emphasis on the structuring of rights and anti-counterfeiting planning in the area of trademarks, design patents, copyright, trade names, computer software, passing-off, unfair competition, designs, labelling laws, food, drug and health regulations, consumer, media and advertising laws.



Loke-Khoon Tan

James Lau is a special counsel with Baker McKenzie in Hong Kong with extensive experience in advising on China’s IP law. His practice covers trademark prosecution and enforcement, and he also regularly advises on a wide range of intellectual property matters, including IP in AI-generated content, copyright, unfair competition, trade names, domain names, designs, licensing, advertising and product labelling laws, Chinese branding, parallel imports and OEM issues. Lau is also licensed to practice in the Guangdong-Hong Kong-Macao Greater Bay Area.



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Corrs Chambers Westgarth	2
Davies Collison Cave	2
Herbert Smith Freehills	2
McCullough Robertson	2
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HongFang Law	1
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- "2023 Asia-Pacific Guide (Intellectual Property: Litigation)", Chambers and Partners
- "ALB China Domestic Trademarks/Copyright, Patents Law Firm 2016-2023", ALB
- "China IP Awards 2020, 2021, 2022, 2023", Asia IP
- "China Business Law Awards 2023: Winner in Intellectual Property (Copyright)", China Business Law Journal
- "China's Elite 100 Lawyers (The A-List 2022)", China Business Law Journal
- "A Client's Guide: Top Ranked Law Firms 2021, 2022, 2023 (IP Litigation)", LEGALBAND
- "China's outstanding intellectual property service team 2013, 2014, 2015, 2016, 2017, 2018, 2019, 2020, 2021, 2023", China Intellectual Property Journal



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AN INSIDE LOOK AT INTERIOR DESIGN AND IP

With the internet making it easy to copy creative works without permission, designers, architects and businesses in the interior design industry must stay vigilant. *Espie Angelica A. de Leon* discusses the importance of awareness, education and proactive action, urging stakeholders to take necessary steps to prevent violations and protect their creative works.

In 2021, MindChamps PreSchool in Singapore accused a school in China's Shaanxi province of trademark infringement for using MindChamps and its Chinese name, Maijiesi. The Chinese school also copied MindChamps's logo, school uniform and interior decoration designs. On June 28, 2023, the Chinese court ruled in favour of MindChamps, having found the Chinese school to have engaged in unfair competition and trademark infringement of the preschool chain's brand and corporate identity.

"Currently, infringement is quite frequent in our jurisdiction," said Dong Wang, a partner and patent team co-head at Jadong IP Law Firm in Beijing. "The main reasons usually include the lack of awareness of IP protection among rights holders, difficulties in defining IP rights in interior design and difficulties in obtaining evidence, among others."

According to Yvonne Tang, director of intellectual property at Drew & Napier in Singapore, reported cases of IP infringement in the interior design space in the country are few and far between. "It may be that cases are settled before they reach the courts. It may also be that many interior design companies are SMEs which lack the knowledge and/or resources to pursue infringement of IP," shared Tang.

In Indonesia, many creative professionals, including architects, are well aware their interior design works are being copied without their consent. "However, they tend to let it go, or even sometimes believe that it is a recognition that people love their works," said Fortuna Alvariza, founding partner at FAIP Advocates & IP Counsels in Jakarta. "This lack of action to defend the IP rights has led people to believe that violating other people's IP rights is common and has low risk."

This is unfortunate. Interior design is IP-rich; designers, architects and business enterprises better get down to the business of protecting their designs and brands as soon as possible.

IP assets involved in interior design

Aside from trademarks, copyright is the main type of protectable IP right. In interior design, copyright generally applies to the following: original illustrations, sketches, drawings, photographs, diagrams, architectural plans, 3D rendering, collages, models, mood boards, the entire design of the interior space, written proposals and the like.

Interior design also mainly involves design patents, which protect the design of a reproducible product. Any invented system, method, technical solution and the like that facilitates the work of a designer for interior spaces may be covered under invention patents, utility model patents, confidential information or trade secrets.

Furniture design falls under the protection of industrial design. Protection for registered designs may also apply to cabinetry, light fittings and articles of adornment and ornamentation (where, for example, customization of designs of these items is provided as

a service), among others.

According to Wang, physical objects made according to the design may also be protected as works of applied art or architectural works, depending on the circumstances. Additionally, the decorative commercial appearance generated in design can be protected under the Anti-Unfair Competition Law if it holds a certain influence.

Wang explained: "The decorative commercial appearance mainly includes two types. One is the decorative commercial appearance of a product, including its name, shape, packaging, slogan, decoration and so on. The other one is the decorative commercial appearance of business premises. For example, a unique overall business image is formed by the combination of decoration, signs, styles of business utensils and clothing of business personnel in service industries such as catering and retail. As for the meaning of 'having a certain influence,' it refers to 'having a certain market awareness and significant characteristics that can distinguish the sources of goods or services.' It should be pointed out that these decorative commercial appearance rights protected by the Anti-Unfair Competition Law are usually acquired by the managers of the goods or businesses premises who use them, and have little to do with the designer."

Common forms of IP infringement

Copyright infringement is likely the most common form of IP infringement occurring in the interior design industry.

In the industry, it isn't unusual for potential customers to receive draft design proposals before signing the contract. We these materials in hand, the consumer may then decide not to proceed with working with the interior designer. This leads to opportunities wherein the illustrations, drawings, sketches and others are used without the copyright owner's consent and exploited for someone else's benefit. "One of the classic cases usually happens when an architect sends her interior design work for pitching to gain a tender and it is not successful, but experiences a bad surprise later when she finds out the work is actually being used without consent," Alvariza said.

Social media makes the job of copycats easier, even in the interior design industry. As interior designers freely share their works online, there's always a risk of others copying them, sometimes at the request of a client. This is common in the hotel and hospitality industry, where designs are copied for their own interior spaces. Tang noted that in private homes, copyright infringement might even go unnoticed due to the private nature of the setting.

"When we put our interior design in our social media, we should know that people from all over the world can see the interior design work and be ready for the use of works without consent," noted Alvariza.

The furniture industry is not immune to the same challenges, with reports of manufacturers duplicating designs from renowned designers like Axel Vervoordt.

DIY websites also contribute to the problem by selling knockoffs of home accessories and furniture.

"It is not uncommon for copies or replicas of popular furniture designs to find their way to the New Zealand market," said Elena Szentiványi, director at Henry Hughes Intellectual Property in Wellington.

To-do list for IP protection

Aside from registering their IPs for protection, what other measures can designers, architects, interior design companies and other business establishments take to protect their IP in terms of interior decoration and design? Our interviewees suggest the following:

- **IP rights should be explicitly set out and flagged in contracts.** "In the case of a designer being employed by a company, reasonable agreements and arrangements should also be made to

distinguish personal IP and professional IP," said Wang.

- **Set out terms and conditions.** Alvariza shared: "One of the steps that can be taken by architects or interior designers is to prepare brief terms and conditions before presenting the works in front of the potential clients in a meeting, accompanied with the list of attendees to be signed by the potential clients that will be useful as evidence of their attendance to see the interior design works. The terms and conditions may consist of the direct or indirect acknowledgement of the ownership of IP rights of the interior design works owned by the architect or interior designers."
- **Use copyright notices.** According to Szentiványi, it is not possible to register copyright in New Zealand. Instead, it is advisable to use the

"It is not uncommon for copies or replicas of popular furniture designs to find their way to the New Zealand market."

—ELENA SZENTIVÁNYI,
director, Henry Hughes Intellectual
Property, Wellington



"It may be that cases are settled before they reach the courts. It may also be that many interior design companies are SMEs which lack the knowledge and/or resources to pursue infringement of IP."

—YVONNE TANG,
director of intellectual property,
Drew & Napier, Singapore

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—FORTUNA ALVARIZA,
founding partner, FAIP Advocates & IP
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—DONG WANG, partner, Jadong IP Law Firm, Beijing



internationally recognized copyright notice for finished artistic works.

- **Describe your work as original or authentic.**
- **For designers and companies that accept client commissions, transmit, deliver design results or display design results on the internet:**
 - 1) Take confidentiality measures for information that is not for public disclosure
 - 2) Confirm ownership of design results through third-party authentication methods. These include blockchain and timestamp.
 - 3) Insert watermarks and the copyright symbol.
- **Keep design documents intact as evidence.**
- **Monitor your works online to track down infringement activities. Use social media and tools such as Google Alerts.** “Many third-party online sale platforms have robust IP infringement policies which can be used to have the infringing products removed from the platform. There are a number of third-party agencies that can handle the monitoring for infringing use online,” said Szentiványi.
- **File border protection notices.**
- **Send cease and desist letters to infringers.**
- **Learn about IP rights, and educate your**

customers. “Many stakeholders are not aware of the existence of IP rights or the extent of the same in the interior design industry. It is critical that interior designers themselves have knowledge of the types of IP rights surrounding their business and then take steps to protect them,” said Tang.

According to Szentiványi, suing for copyright infringement can be costly, so it’s not always worth it. However, if the infringing products are valuable, it might be worth considering legal action to send a clear message to potential infringers. “The bringing of infringement proceedings can send a clear signal to other potential infringers that they may not get away with it!” she said.

IP infringement is happening in every industry, including the field of interior decoration and design. With the internet making it easy to copy creative works without permission, IP owners mustn’t ignore such violations.

“We encourage interior designers and architects and other creative people to actively take the necessary steps to protect their works,” said Alvariza. “By omitting the necessary action to protect their IP rights, they actually indirectly let others violate their IP rights and believe that it is commonly accepted.” ^{AIP}

SINGAPORE'S MARCH TO BE THE WORLD'S IP HUB CONTINUES

As the world is shifting towards an innovation-based economy, Singapore has made strides to position itself as a global hub for intangible assets and intellectual property. *Ivy Choi* reports from Singapore.



To strengthen its position as a global hub for intangible assets (IA) and IP, in 2021 Singapore initiated the Singapore IP Strategy 2030 (SIPS), as a continuation of the success of the 2013 IP Hub Master Plan, in which Singapore has developed itself as an IP hub in Asia. As the world is shifting towards an innovation-based economy, Singapore has made of a good example of the dedication and tactful planning it takes to remain a top-ranked IP regime with this 10-year blueprint.

According to the SIPS 2030 Report published by the Government of Singapore and the Intellectual Property Office of Singapore (IPOS), SIPS consists of three main objectives: to strengthen Singapore's position as a global hub for IA and IP; to attract and grow innovative enterprises using IA and IP; and to develop good jobs and valuable skills in IA and IP. While these objectives may sound broad and general, SIPS also details the specific areas Singapore is working on, with actual policies and initiatives in place to achieve these goals. At the same time, it also means that businesses should fully utilize the opportunities afforded in this thrust of initiatives, as suggested by Kok Keng Lau, head of intellectual property, sports and gaming at Rajah & Tann in Singapore.

“Singapore businesses should be aware of the impending changes to Singapore's IA and IP regime, both in terms of policy and infrastructure,” Lau said. “Businesses should also consider how they can benefit from the government's efforts to increase enterprises' access to IA and IP services and to help enterprises unlock potential new sources of capital through IA and IP.”

Lau explained what businesses should expect from SIPS's planning for Singapore to strengthen itself as a global hub for IA and IP. “Businesses should expect further reform to the IA and IP regime through policy reviews and digitalization initiatives, including enhanced IA and IP filing and management systems. It should also be anticipated that Singapore will continue to develop its position as a node supporting ASEAN and connecting the world, and to grow its IA and IP dispute resolution capabilities.”

Rena Lee, chief executive of IPOS, said that in order to keep pace with technological and other advancements in innovation and creativity, IPOS regularly reviews its policies, processes, and programmes to ensure that they are relevant. She shared some examples: “Singapore concluded the most comprehensive review of its copyright regime to date, resulting in the Copyright Act 2021, which ensures that Singapore remains responsive to digitalization. As part of the review, Singapore introduced a copyright exception for computational data analysis that supports AI and data-driven innovation by permitting the responsible use of copyright works for purposes such as text and data mining, sentiment analysis and machine learning.” She also shared about the work IPOS has done with other parties to monitor developments

of AI technologies for IP. “For example, IPOS and the Infocomm Media Development Authority supported a study by the Singapore Management University Centre for AI and Data Governance on the intersection of AI and IP.”

Speaking of the progress of digitalizing Singapore's IP filing and management systems, Lee said: “IPOS has been offering digital services for filing and managing IP in Singapore through an online portal since 2000. The IPOS Digital Hub has gone through several iterations and now features a user-friendly interface, enhanced search function, IP management features, and enhanced support for IP dispute resolution processes. With the help of AI and automation, processes have been streamlined for a faster and more efficient user experience.”

In addition to the online portal, IPOS also introduced the world's first mobile app for trademark registration in 2019. Named IPOS Go, the mobile app allows businesses to file trademarks in less than ten minutes. It also features a “brand search” function for simultaneous search of similar business names, trademarks, web domains, and social media usernames. What's more, businesses can renew multiple types of IP, including trademarks, patents and designs, and manage their IP portfolios via the app.

One of the strengths of Singapore is its strong interconnectivity with ASEAN, and thus SIPS aims to position Singapore as a node for ASEAN. Lau said: “As IP is territorial in nature, IP protection is a key consideration for investment as it assures foreign investors that their creations are adequately protected overseas. Singapore thus aims to deepen its economic integration with ASEAN and progress towards greater interoperability in the ASEAN IP sector.”

Lee said that to overcome challenges posed by territoriality, Singapore is signatory to international treaties and work-sharing agreements with other IP offices to help IA and IP owners take their innovations internationally more easily. She said: “As a founding member of the ASEAN Working Group on IP Cooperation (AWGIPC), Singapore participates in several task forces to improve the regional IP framework with best practices for IP protection. Singapore was an early adopter of the ASEAN Patent Examination Co-operation (ASPEC) programme, which is the first regional patent work-sharing programme to improve the quality of patent search and examination. Singapore is also the first ASEAN country appointed as an International Searching Authority and International Preliminary Examining Authority (ISA/IPEA) of the World Intellectual Property Organization's (WIPO) Patent Cooperation Treaty.”

According to Lee, IPOS is well-connected with other IP offices through the Global Patent Prosecution Highway (GPPH) network, as well as bilateral Patent Prosecution Highway (PPH) agreements with partner IP offices. One of the latest schemes is a PPH agreement with the Saudi Authority for Intellectual Property (SAIP). These IP networks and programmes

can help accelerate patent applications in ASEAN and over 30 markets, including China, Japan, South Korea, Germany, the United States, Europe, the Middle East, etc.

Another focus of SIPS is to further develop Singapore's international IP dispute resolution services. Lau said: "As a leading international dispute resolution hub in the world, Singapore is in a strong position to be a choice venue for IP dispute resolution. SIPS builds on initiatives targeting areas that are unique to IP and technology disputes and concentrates on two fronts – building IP dispute resolution capabilities in Singapore, and marketing Singapore's IP dispute resolution services internationally."

"We have built a suite of international IP dispute resolution services and expertise across litigation, arbitration, and mediation for a variety of cross-border commercial disputes," Lee said. "Our dispute resolution institutions have access to global experts, and Singapore is also the only country in the world where the WIPO Arbitration and Mediation Centre (WIPO Centre) has an office outside of Geneva."

Lee suggested that Singapore's open regime can facilitate cross-border dispute resolution, as parties may engage lawyers from their own jurisdictions to represent them. She noted that non-resident lawyers who come to Singapore to represent their clients do not need a work pass if they are only staying for up to 90 days.

To promote Singapore's dispute resolution services internationally, Lee said that the WIPO-Singapore ASEAN Mediation Programme (AMP) was launched in July to promote mediation in the ASEAN region. "It offers funding of up to S\$8,000 (US\$6,000) for each mediation of a technology or IP dispute mediated by a Singapore-based mediator and administered by the WIPO Centre's Singapore Office."

Besides funding, IPOS has also recently put together a list of Singapore-based technical and IP valuation expert witnesses who can assist in IP and technology disputes. Lee said: "This is alongside the enhanced IPOS business clinic to advise enterprises on internationalizing their IP and building a sound IP dispute resolution strategy as they expand into markets such as ASEAN and China." In addition, she said that a promotional brochure – available for English- and Chinese-speaking audiences – also provides links to the model dispute resolution clauses of Singapore's international dispute resolution institutions, so parties can include relevant clauses into their cross-border contracts.

Some updates have been made to Singapore's legislative framework regarding IP dispute resolution as well. Lee said: "The most recent enhancements were introduced in April 2022, through the new Supreme Court of Judicature (Intellectual Property) Rules 2022 (SCJIPR 2022). A key improvement was the optional track for IP litigation – Simplified Process for Certain

"IPOS has been offering digital services for filing and managing IP in Singapore through an online portal since 2000. The IPOS Digital Hub has gone through several iterations and now features a user-friendly interface, enhanced search function, IP management features, and enhanced support for IP dispute resolution processes."

—RENA LEE, chief executive, Intellectual Property Office of Singapore



"As IP is territorial in nature, IP protection is a key consideration for investment as it assures foreign investors that their creations are adequately protected overseas. Singapore thus aims to deepen its economic integration with ASEAN and progress towards greater interoperability in the ASEAN IP sector."

—KOK KENG LAU, head of intellectual property, sports and gaming, Rajah & Tann, Singapore





Intellectual Property Claims, aimed at helping small and medium-sized enterprises save time and costs in litigation. Under the Simplified Process, qualifying IP disputes which do not exceed S\$500,000 (US\$376,000) in relief claimed can now be resolved in a more simplified and streamlined manner.”


Furthermore, Lee said that the SCJIPR 2022 also streamlined the Rules of Court relating to IP rights into a single piece of legislation, which included obligations to notify the Registrar of Designs, Geographical Indications, Patents and Trademarks, and harmonized related provisions across IP rights. “Other enhancements in 2022 included the consolidation of most civil IP cases in the High Court, which simplifies the previous system where civil IP disputes are heard in multiple fora, depending on the nature of the IP right, the type of proceeding or the value of the claim. In 2019, amendments were also made to the International Arbitration Act to enhance Singapore’s legal framework for international arbitration. Amendments made clear that IP disputes can be arbitrated in Singapore, and arbitral awards for IP disputes are enforceable in Singapore.”

The second focus of SIPS is to attract and grow innovative enterprises. According to Lau, deeper and sustained public-private partnerships are one of the means to help local enterprises capture new business opportunities. For example, IPOS and the Singapore Business Federation have jointly developed the Workforce for IP-Savvy Enterprises programme (WISE) to help enterprises build their foundational IA and IP knowledge, access preliminary IA and IP advice, and be plugged into the global IA and IP network. Another example is GRIT, standing for Growing with Resilience through InTangibles, which is an inter-agency initiative offering a range of sector-specific engagements, resources, and training to help equip businesses and communities with IA and IP knowledge and skills tailored to address their individual IA and IP challenges.

The third focus of SIPS is to create job opportunities and develop a talented workforce with IA and IP skills

and competencies. Lee said: “Key initiatives to develop IP skills in the workforce include the Skills Framework for IP launched in 2019 that was jointly developed by SkillsFuture Singapore (SSG), Workforce Singapore and IPOS, along with industry associations, training providers, organizations, and unions. The Skills Framework for IP, which builds on the IP Competency Framework, provides information on the sector, career pathways, job roles, skill requirements, and relevant training programmes, enabling enterprises to better plan for their IA and IP manpower. Some job roles covered under the Framework include IP executive, patent attorney, IP strategist, and IP analyst.”

Lee said IPOS has also been working with the institutes of higher learning (IHLs) and professional associations to offer full-time IP programmes and professional development courses for working and IP professionals. “In 2017, IPOS collaborated with the Singapore University of Social Sciences to roll out the Master of IP and Innovation Management (MIPIM) programme that integrates IA and IP knowledge and skills from the legal, business, and technology domains.” IPOS also established IP Academy, Singapore’s only dedicated centre for IP education and training, through which over 7,000 attendees are trained annually, including enterprises, individuals, public officers, professionals and students. IPOS has also developed IA and IP training modules for senior business leaders to deepen capabilities in IA and IP management and capitalize on IA and IP for business growth.

Finally, Lau advised that businesses should familiarize themselves with the changes regarding the enhancements to Singapore’s IA and IP regime, and consider whether they will require any amendments to their operations or policies. “As for the impending and existing initiatives to help enterprises make better use of their IA and IP resources and to obtain financing through IA and IP, businesses should access which initiatives are applicable and seek to utilize the relevant opportunities,” he said. 



VIDEO GAMES, ESPORTS AND GAMBLING: An IP practitioner's perspective on the opportunities and limits

IP is the core of the video game and eSports industry, but other legal disciplines such as contract law and gambling law also play important roles in regulating the industry. *Meryl Koh* and *Justin Lai* from Singapore law firm Drew & Napier examine the evolution of the industry and the challenges it faces, from copyright and trademark infringement in the VR and AR era to the IP implications with regards to using AI in game creation.

It has been said that the very first video game was invented in 1958 by physicist William Higinbotham. This was a simple tennis game built for an exhibition to entertain exhibitiongoers and showcase the relevance of science to society. Fast forward 50 years, the emergence of various gaming platforms like the arcade, home console, PC and handheld device have led to a booming video game industry, now bigger than the movie and music

industries put together, according to Investopedia. Coupled with the accessibility of mobile gaming and the development of new gaming technologies, the industry is predicted to generate a revenue of US\$282.30 billion in 2024; this number is projected to grow at an annual rate of 8.76 percent, according to Statista.

With the proliferation of video games and the development of the video game industry came the worldwide phenomenon of competitive gaming as

a form of spectator sport. Known as eSports, video gaming tournaments have been gaining popularity since the 2000s, and this rapidly growing market is expected to gather more than 532 million viewers worldwide and generate more than US\$1.6 billion in revenue by 2024.

With statistics suggesting that there are over 3.22 billion gamers globally, according to Grand View Research, video games have been cemented as a popular form of entertainment. However, success is never without its challenges. With numerous industry stakeholders vying for consumer attention and a market share, commercial and legal conflicts are inevitable. This article seeks to provide an overview on how intellectual property and gambling laws may apply to the video game industry, and briefly discuss trending issues such as video game cloning, eSports contracts, and online gambling.

Protecting IP

To protect such a lucrative industry, valuable gaming assets and creative works must be safeguarded. IP laws play a vital role in granting IP owners exclusive rights to extract value from their creations and to defend against infringement of their work. These assets may be generally protected in a number of ways.

First, video games comprise different components such as music, art, plot, and source code, all of which are the game's assets. Many of these assets are, in principle, protectable under copyright law. Further, as copyrights subsist independently of one another, each individual asset may have its own copyright (or, indeed, multiple copyrights). (Copyright Act 2021, §107). Subject to nuances of national copyright legislation, copyright protection is typically conferred automatically once the work is created, and in most jurisdictions, no registration is required.

Second, identifying signs or indicia such as video game titles, eSports team names and logos, and gamer tags may be protected under trademark law and/or the common law tort of passing off (to the extent that existing goodwill is associated with that sign or indicia). These two regimes operate to prevent consumer confusion, protecting traders against imitation/impersonation by others seeking to free ride on the strength of their brands or the goodwill they have painstakingly acquired.

Third, novel and inventive gameplay mechanics can in principle be protected under patent law. For example, Bioware patented the dialogue choice wheel in *Mass Effect*, which allows players to select from different responses on a wheel interface. Warner Brothers patented the Nemesis system in *Shadows of Mordor*, which generates in-game villains who respond dynamically to the player's gameplay thus influencing the game's later narrative.

A common theme is that, once crystallized, these IP rights generally grant their owner/proprietor the right to sue others to prevent unauthorized use or exploitation. Further, IP rights are generally regarded

as personal property, meaning that they may be sold, assigned, licensed, or mortgaged. Therefore, IP rights have immense value – they are often the product of significant investments in time, effort, and money, representing developments in the areas of art, science, and commerce. Having, acquiring or even obtaining a licence of IP rights can be a key factor leading to the success of one's business endeavour whereas lacking or infringing upon them can spell disaster.

Video game cloning

It is not easy to develop a video game, let alone one that achieves widespread popularity or commercial success. With successful video games being so profitable, it is no surprise that there will be other game developers who want to piggyback off existing cult-favourites and capitalize on their success by creating similar games. These games which are influenced or inspired by popular game concepts or have expanded on popular game mechanics may in some cases, be acceptable since ideas and gameplay are generally not protected by copyright. However, clones / copycats can sometimes stray into copyright infringement territory if the creative aspects of the popular game are copied.

In 2018, Riot Games' parent company sued Moonton's CEO in China for copyright infringement for developing a game called *Mobile Legends*, alleged to be a "straight lift" of *League of Legends* (LoL). The Chinese Court eventually ordered Moonton's CEO to pay damages worth US\$2.9 million.

In 2022, Riot Games sued NetEase for copyright infringement and/or passing off in multiple jurisdictions for developing a game called *Hyper Front*, alleged to be a clone of *Valorant*. Riot claimed that *Hyper Front* copied with minor cosmetic modifications all their creative choices such as the character designs, maps, and weapons. NetEase eventually shut down *Hyper Front*'s servers in April 2023.

More recently, public forums were debating whether *Palworld* is a *Pokémon* clone. Pals in *Palworld* are caught by throwing balls at them and there is much commentary about the Pals bearing visual similarities to *Pokémon* character designs. Other than that, it is also argued that there are still, numerous differences in gameplay.

The question remains: Is there copyright infringement? First, the concept and idea behind catching cartoon monsters are not in and of themselves copyrightable. This is because copyright only protects *expressions* in tangible form and not *ideas per se*. Further, in jurisdictions such as Singapore, the extent of copyright protection over modern-day video games has yet to be conclusively determined. Second, for there to be copyright infringement, a qualitatively substantial amount of the original work must have been copied. While Pals may have some similar stylistic designs to *Pokémon*, both can be said to draw some inspiration from real-world animals such that it could be argued that copying was not involved or that the threshold of substantial copying has not been crossed.



These issues (and more) mean that actions to enforce IP rights in video games are usually less straightforward than they may first appear. Game developers who are looking to create games inspired by or building upon popular games must be careful not to directly copy copyrighted elements. If there are substantial similarities between the developing game and the original game, developers should seek legal advice to see if these parts will be considered infringing and/or if any exceptions (such as fair use) apply to them. Should developers want to use copyrighted material, they can consider acquiring the necessary licences. It is also important to note that copyright is territorial in nature, so it is always prudent to approach local counsel for advice on copyright protection and infringement.

eSports content, contracts and commercial deals

eSports is invariably built upon IP held by game developers/publishers. As games contain significant amounts of copyrighted and/or trademarked material, event organizers who host commercial eSports tournaments using those games will likely have to do so under licence from the game developers/publishers and the relevant IP owners. Failure to do so may expose the event organizers to claims of IP infringement.

A unique situation arises when one party owns the game content rights and another party owns the rights to player-generated gaming content. In 2015, a Twitch channel called “SpectateFaker” dedicated itself to streaming games of a well-known LoL player “Faker”. Streaming platform Azubu who then held the exclusive rights to stream Faker’s games sent Twitch a DMCA takedown notice and Twitch complied. However, SpectateFaker was streaming his spectator view of the games from a third-party client and not streaming content directly from Azubu. Riot, the developer and

publisher of LoL, thus asserted that as they owned the IP rights to LoL, Azubu did not possess the legal rights to issue the takedown. Nevertheless, Riot recognized that the stream could harm Faker’s brand and subsequently issued a policy allowing players to file takedown claims if they believe a stream is “harming” them.

A significant amount of revenue generated by the eSports industry comes from sponsorship and advertising. Besides the usual sale of physical licensed merchandises, sponsors and advertisers also market heavily in the digital realm. For example, Louis Vuitton partnered with Riot for the 2019 LoL World Championship to design skins (i.e. in-game cosmetic features) and outfits for specific LoL characters in-game. Burger King and Mountain Dew also collaborated with *Call of Duty* to produce limited-time skins. This presents a great opportunity for sponsors and advertisers to gain extra revenue while increasing brand exposure by incorporating their trademark onto such digital assets. However, eSports teams must be careful not to commercialize in-game merchandise with registered trademarks without permission as there could be a case for trademark infringement.

The line between online gambling and gaming

Singapore introduced the Gambling Control Act (GCA) and established the Gambling Regulatory Authority (GRA) in 2022 to regulate gambling activities and penalize unlawful gambling offences in Singapore. Under the GCA, “gambling” is defined as the act of betting, playing a game of chance and participating in a lottery. (GCA §4) Only social gambling, gambling with licensed operators and jackpot gambling in private clubs are allowed. Online gambling is currently prohibited in Singapore unless licensed or exempted. The GRA has powers by virtue of the GCA to block

access to online remote gambling locations, to block payment transactions (GCA Part 9, Division 4) and to ban individuals from gambling online (GCA §79).

Like traditional betting, betting on eSports games is illegal in Singapore as the betting still involves a game of chance (GCA §5). It involves staking items of value on a competition outcome hoping for the chance to win something else of value. There is less clarity surrounding the legality of “skin betting” (i.e. using virtual goods as virtual currency to place stakes and bet on potential outcomes of sports matches or other games of chance). Skins can be traded on online marketplaces and can hold real-world value, thus skin betting can be akin to betting with real money. However, this remains relatively less regulated.

Video games themselves, from the players’ perspective, are skill-based so they are generally excluded from regulation under the GCA. However, this line blurs when video games introduce features with gambling mechanics like loot boxes (i.e. virtual item that contain other randomized selection of virtual items) and *gacha* (i.e. toy typically sold in plastic capsules, from vending machines), which are chance-based. The former are mystery boxes containing unknown virtual items that players can purchase in game with in-game currency or real-world money. The latter shares a similar mechanic where players “roll” for a randomized item. As the chances of getting something valuable are randomized, these features have been compared to gambling.

The question then is whether and to what extent gambling laws should apply to video games. In Singapore, loot boxes and *gacha* would generally not be caught under the GCA as the player does not win any money or items with real-world value. (GCA §§7 and 9) However, once the virtual item is exchanged for real-world payouts, it could be considered gambling.

Scanning commentary on this issue from the perspective of other jurisdictions, it appears that contrary to Singapore, Macau permits online casino gaming, betting, and lottery (except horse racing/sports betting) as there are no laws or regulations governing online gambling. The UK also allows eSports betting provided that operators hold a gambling licence. Like Singapore, most countries do not licence skin betting and some deem it illegal, however Isle of Man is the first jurisdiction to licence and legitimize skin betting. Many countries also do not actively regulate or ban loot boxes and *gacha*. Well-known exceptions being Belgium, which has taken a strict stance on banning loot boxes and Japan, which has banned “complete *gacha*”.

Conclusion

IP is the core of the video game and eSports industry. Without IP laws, anyone will be able to profit off successful IP without putting in the hard work, thus disincentivizing innovation and original creations within the industry. However, a fine balance must be struck between protecting private commercialization

interests, promoting creativity and innovation as well as benefiting society.

Other legal disciplines such as contract law and gambling law also have a role to play in regulating the industry. Industry stakeholders must be aware of their obligations and liabilities under such laws, and compliance is key to smooth operations and a thriving business. However, some areas still lack proper supervision and with the industry growing bigger, it is only fitting that attention be placed on establishing an overriding governing authority and formulating overarching legislation.

Finally, one must also be clued into the new challenges which surround the protection of IP. Will there be copyright or trademark infringement when copyrighted works and registered trademarks are used in virtual reality and augmented reality games, or will the fair use defence apply? Can eSports players protect their in-game brand by taking steps to protect the design of their virtual avatars? What are the IP implications with regards to using AI in game creation, for example when game assets are generated using copyrighted material? These are some of the questions which demonstrate the complex interplay between the industry and IP laws. Industry stakeholders are always invited to seek legal advice to help them navigate the complicated legal terrain. ^{AP}

ABOUT THE AUTHORS

Meryl Koh is a director in Drew & Napier’s dispute resolution and intellectual property departments. Koh is particularly well-versed in corporate / commercial disputes and arbitration, defamation, intellectual property, digital media, gaming and technology. Lauded as a “polished litigator”, clients described Koh as a “sharp and appropriately aggressive lawyer whom you will want on your side.” Notably, Drew & Napier won the Editor’s Choice - Impact Deal and Case of the Year at the Asialaw Awards 2023 for acting in the *Riot games v. NetEase Interactive Entertainment* matter, where Koh acted as lead counsel. Koh is a Fellow of the Singapore Institute of Arbitrators and Assistant Secretary at International Association for the Protection of Intellectual Property (AIPPI) Singapore Group. She also contributes to the copyright committee within the Law Society’s IP Sub-Committee.



Meryl Koh

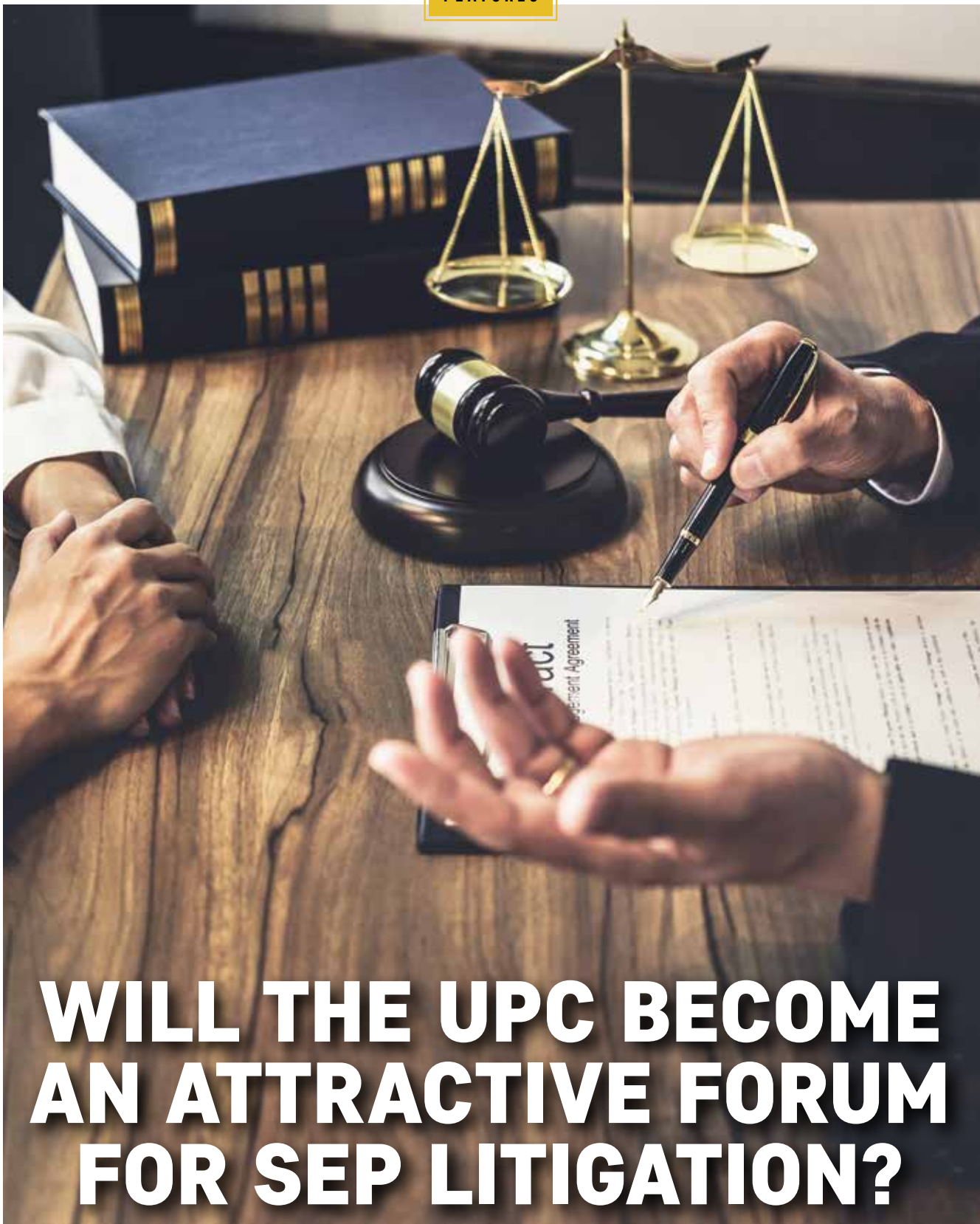
Justin Lai is a senior associate at Drew & Napier’s dispute resolution and intellectual property departments. He graduated from the National University of Singapore, having developed a keen interest in intellectual property. Lai has honed legal expertise across diverse legal areas, including gaming, technology, and media. He has represented clients in complex disputes touching on novel legal issues and developing areas of the law and also takes pride in providing practical advice to clients on a wide spectrum of intellectual property and/or technology matters – from assignments, to licences, to software agreements and beyond.



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WILL THE UPC BECOME AN ATTRACTIVE FORUM FOR SEP LITIGATION?

Europe's Unified Patent Court may soon become an attractive forum to litigate Standard Essential Patents. *Bas Berghuis*, *Oscar Lamme*, *George Chan* and *Jingyuan Shi* explore some of the issues that may arise during such litigation.

The Unified Patent Court (UPC) may become an attractive forum to litigate Standard Essential Patents (SEPs), as the pressure of a pan-European injunction or a central attack on a European patent(s) may revive stalled negotiations about a FRAND-licence. The UPC is, however, a new court system with new procedural rules, no case law of its own, and judges with a mixture of national legal backgrounds. There will thus be uncertainty on how exactly FRAND litigation will play out at the UPC. This article explores some of the issues that may arise during such litigation.

Will FRAND be litigated before the UPC?

The first question is whether FRAND can be litigated at all at the UPC. When the UPC Agreement was drafted, FRAND was not as important a topic as it is now. The UPC Agreement therefore does not explicitly address whether the UPC has jurisdiction to decide on FRAND issues. The expectation is, however, that the UPC will, in any event, deal with FRAND issues as a defence to an infringement action. Article 32 (1)(a) of the UPC Agreement states that the UPC will have exclusive jurisdiction in respect of *actions for actual or threatened infringements of patents and supplementary protection certificates and related defences, including counterclaims concerning licences*.

There seems to be no basis for the UPC to decide on FRAND as an independent claim, whether this would be a declaratory action that a patentee or implementer acted in compliance with its FRAND obligations, that a certain set of licence terms would be FRAND, or an action to have the UPC decide the terms of a FRAND licence.

If, however, a FRAND defence is raised as a defence to an infringement action, the SEP holder may ask the UPC to grant a UK-style FRAND injunction, where an injunction is granted unless the implementer accepts a FRAND licence as settled by the court. The court may grant injunctions, but it is not clear whether this would then also encompass the granting of such conditional injunctions. The UPC Agreement is silent on this, so one could argue that a procedural basis is lacking. If the UPC would nevertheless accept that it can hand down such injunctions, the next question would be which metrics it should use for that.

The legal approach to FRAND

When it comes to the legal approach, we have seen that case law is converging in Europe with a focus on the behaviour of parties. Whether they behave as a willing licensee or willing licensor. The framework as set out in *Huawei v. ZTE* is thereby used as guidance. The national courts of the major European patent jurisdictions agree that this framework should not be seen as a strict set of rules. We would expect the UPC to take a similar approach to FRAND, albeit it being unclear on which legal concept it will be based. The German courts, for example, focus on competition law (Art. 102 TFEU) and the limited case law in Italy suggests that the Italian

courts do the same. On the other hand, the Dutch courts have so far kept it open whether the fact that the patentee has a dominant position and there is an abuse thereof is the most relevant consideration. Instead, the Dutch courts mainly focus on the concept of willingness through the lens of precontractual good faith. Should the UPC focus on competition law, it can apply EU law (Art. 24 (1)(a) UPC Agreement), but if it wants to rely on a legal concept such as precontractual good faith, it will have to rely on national law (Art. 24(1)(e) and Art. 24(2) UPC Agreement). Article 12 of the Rome II Regulation then states which law would then be applicable. Since parties will oftentimes have not yet agreed on the law that would be applicable to the licence, this may lead to a debate as well. For ETSI standards, the FRAND declaration is made pursuant to French law (Art. 12 of the ETSI IPR policy), it may be that French law would be applicable (Art. 12(1)(c) of the Rome II Regulation).

Although case law is converging, differences remain. For example in Germany, the implementer is still able to improve its position during proceedings by making improved counter-offers, whereas the Dutch approach is that the implementer cannot. The relevant question in the Netherlands is whether bringing the action for an injunction and/or recall of infringing products was FRAND. So until the UPC's Court of Appeal decides on the specifics of FRAND, differences between the UPC divisions may remain. It is thereby noted that in major jurisdictions the local divisions will have two local legally qualified judges (out of three), so the local view is likely to be dominant in the beginning.

Procedural considerations

Differences may also exist when it comes to important procedural considerations, such as the disclosure of licences, the speed of proceedings and automatic injunctions.

Disclosure of licences

An important aspect of FRAND proceedings is the disclosure of comparable licences. Owing to disclosure, this is standard in UK proceedings, but also German and Dutch courts have developed a standard practice that at the request of parties, the court orders both the patentee and implementer to disclose their comparable licences. Also, in France the Paris Court of Appeal has ordered the disclosure of some terms of comparable licences in the proceedings between Conversant Wireless and LG.

Article 59 of the UPC Agreement also gives the UPC the possibility to order parties, or even a third party, to produce evidence, subject to the protection of confidential information. Rule 190 of the UPC Rules of Procedure further specifies that the requesting party should first present reasonably available and plausible evidence in support of its claims and specify the evidence which lies in the control of the other party or third party. It also specifies that for the protection of confidential information, the court may form a confidentiality club, limiting the disclosure to certain

named people. These are all discretionary powers of the UPC, so also here differences in approach between the divisions of the UPC may be expected.

In the Netherlands, it is currently standard practice that the disclosure of licences is limited for use in the proceedings only. In-house persons who have a commercial role are also excluded from access. At least the Munich district court has taken a similar approach when allowing the disclosure of licences in Germany, but it is questionable whether German procedural law allows for such limitations. In the French proceedings between Conversant Wireless and LG, disclosure was limited to lawyers only. In the recent UK Interdigital litigation, the UK court took a more liberal approach and also allowed access to a broader team of people for the purposes of negotiating a licence / settlement. Since the lack of transparency due to confidentiality provisions in the licences is often perceived as the biggest barrier between parties to reach a FRAND licence, this approach by the UK court may provide parties with the opportunity to reach an agreement without further litigation. It will be interesting to see whether the UPC judges will make use of these discretionary powers to order parties to disclose licences, and if so how they will do it.

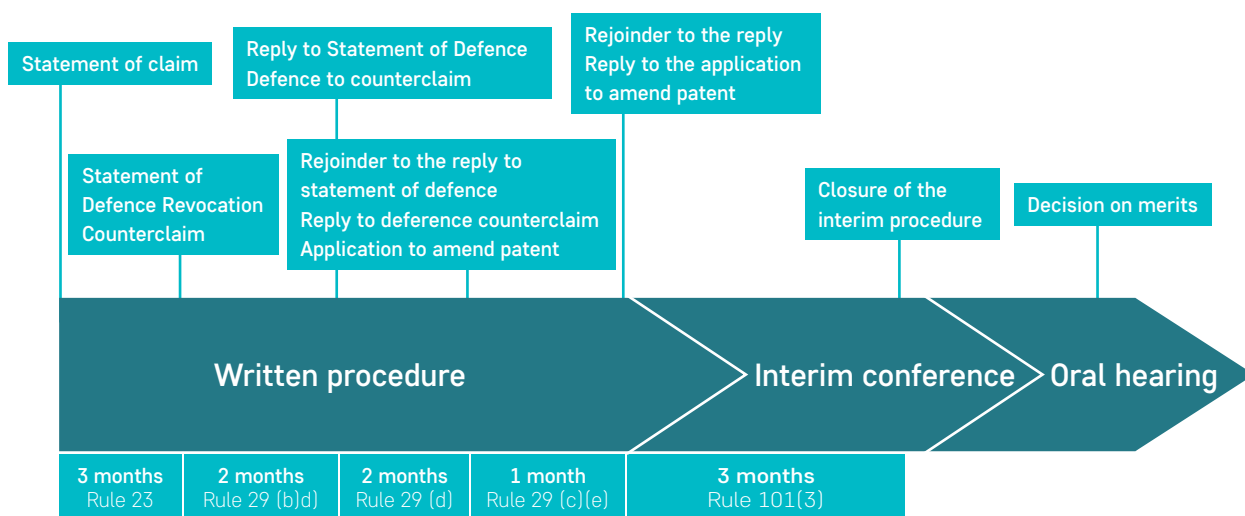
Speed of proceedings

The Rules of Procedure for the UPC were drafted to ensure that they provide for quick and efficient proceedings. They are front-loaded for both claimant and defendant, and provide for two written rounds of pleadings for each party for both a main claim and a possible counterclaim within a period of eight months. The aim is for formal pleadings to last 11 months, and a decision would normally be expected in about a year from the start of the proceedings. Infringement proceedings with a counterclaim for invalidity should follow the following timetable:

However, as stated above, both the UPC Agreement and the Rules of Procedure were not drafted with FRAND proceedings in mind in which a parallel FRAND debate would take place in addition to a determination of infringement and validity. If the UPC would order parties to disclose their licences, this timetable is unlikely to be adhered to. The FRAND debate would first need to have a debate and decision on the disclosure of licences, and if disclosure is ordered, the parties subsequently need sufficient time to actually disclose the licences and have the opportunity to have an (economic) debate about the licences and how this ties in with the FRAND obligations back and forth. Some parties may have dozens of licences, which are often complex and difficult to unpack. A proper FRAND debate may thus take more time than the eight months that is now anticipated for the written and interim procedures.

Automatic injunctions

Articles 62(2) and 63(1) of the UPC Agreement allow for discretion to grant an injunction when infringement of a valid patent is found. The UPC furthermore has to take into account that, among others, the Enforcement Directive (2004/48/EC) provides for a proportionality test. The UPC may therefore deviate from normal practice in most of mainland Europe to grant “automatic” injunctions. The question is whether the UPC will do so, and if so, whether it will do so in FRAND proceedings. On the one hand one could say that a European wide injunction may give too much power for the patentee to force the implementer into accepting terms that are not FRAND. On the other hand there is only room for an injunction if a FRAND defence fails, which may render the question whether an injunction is proportionate moot.



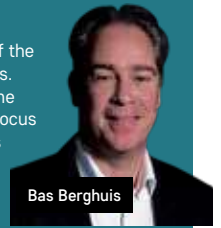


Concluding remarks

Although case law in Europe is converging with respect to FRAND, it will be interesting to see how the UPC will deal with this and how the approach may vary between the various local and regional divisions. We do not expect that each of the UPC's first instance courts will immediately do something that is completely different from the way the judges are currently handling FRAND in their current national proceedings. The new UPC system will provide ample opportunity for discussing different approaches to FRAND proceedings, and in due course the UPC Court of Appeal will have to decide how arguments relating to FRAND will be handled in a uniform way under the new international system. ^{AIIP}

ABOUT THE AUTHORS

Bas Berghuis is advocaat and the national head of the Simmons & Simmons IP practice in the Netherlands. For more than 25 years, his practice has covered the full range of intellectual property activities with a focus on patent and technology based litigation. Berghuis and his team have a particular expertise in the life sciences sector, handling matters regarding medical devices, pharmaceuticals and biotech, and in the TMT sector, acting in matters regarding electronics, telecoms and software. He acts before national and international courts, as well as the Dutch and European Patent Offices. As advocaat he has been involved in all aspects of litigation, as well as other IP related issues such as licensing, prosecution strategy, negotiation of research and development agreements and the protection of trade secrets and know-how.



Bas Berghuis

Oscar Lamme is a partner in the Simmons & Simmons IP practice in the Netherlands. He has over 15 years of experience and specializes in international patent and trade secret litigation, tech licensing and other technology-related matters. Having a background in engineering, Oscar is well-placed to represent a wide variety of multinational clients active in telecom, electronics, biotechnology and the pharmaceutical industry. His cases are mostly cross-jurisdictional, and he often works on the convergence of different areas of law, such as patent law and competition law. Lamme regularly publishes on patent law topics, such as the Unified Patent Court and the Unitary Patent, and frequently speaks at national and international congresses. He is also a member of EPLAW, the European Patent Lawyer's Association.



Oscar Lamme

Dr. George Chan is a partner in the Simmons & Simmons dispute resolution group in China and serves as the head of the Simmons & Simmons (Beijing) Intellectual Property Agency. In this capacity, Chan is a leading authority on intellectual property for mainland China and leads a veteran team that specializes in securing and enforcing IP rights, as well as advising on commercial IP and regulatory IP matters. He is also at the forefront of the rapidly changing field of online branding for China, and his online branding strategies have been adopted by various governments. Chan is known for his bespoke, creative legal solutions for his clients' matters, and often finds solutions to legal problems that others had overlooked. In addition, he is regularly consulted by industry experts and commentators for his views on developing IP issues in China.



Dr. George Chan

Jingyuan Shi is the key contact for Simmons & Simmons' Shenzhen office, and a partner leading its TMT practice in the Greater China region. She is a PRC-qualified lawyer and a practising solicitor in England and Wales. Shi specializes in data and technology laws. She has supported a large number of telecoms, media and technology (TMT) companies, life science companies, strategic and financial investors, asset managers, financial institutions and fintech companies on an impressive selection of mandates, including without limitation data compliance, PE/VC and M&A transactions, regulatory and intellectual property. She has been based in Shanghai, Beijing, London, Hong Kong and Shenzhen for her practice.



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IP EXPERTS 2024

Japan



Publishers in Japan are concerned about whether the country's copyright laws adequately protect against generative AI – and worse, according to a statement released by an industry group last August, they say that copyright protection is not being adequately considered in the development of generative artificial intelligence, a story in *The Japan Times* said.

The Japan Newspaper Publishers & Editors Association, the Japan Magazine Publishers Association, the Japan Photographic Copyright Association and the Japan Book Publishers Association released a joint statement in which they said current generative AI “creates content based on the analysis of large amounts of data collected from the internet without the consent of and payments to copyright holders,” the story said.

The statement, according to the newspaper, said that Japan's copyright law is more favourable to AI learning than copyright laws in other countries, and pointed to the unclear nature of the interpretation of a provision of the law that prohibits the use of copyrighted material for learning purposes if it would “unreasonably prejudice the interests of the copyright owner.”

As a result, the four associations said, large amounts of content could be created without providing any benefit to copyright holders, which could make it difficult for them to continue their creative activities, the four associations said.

The associations said that interpretation of the law must be clarified, which could lead to its revision. They also called for creating a mechanism for copyright holders and government authorities to discuss the copyright law.

As technology continues to evolve, Japan will almost certainly be at the forefront, which suggests that there will be great demand for the professional services of intellectual property lawyers in Japan for local and overseas clients. In this issue, we pay tribute to the best of them by presenting this year's Japan's IP Experts list. We asked a large number of IP professionals in the region, who are mostly in-house counsel and corporate legal managers, about what they were looking for from their legal service providers, so as to understand better what clients need and want today. Based on these answers, we have compiled our list of the Top 50 IP experts in Japan, lawyers who can best understand what their clients need and provide



them with the best practical advice.

Nowadays, it takes more than a degree from a top-notch university and a couple of decades of practice for IP lawyers to convince clients that they are the best in the field. When looking for IP advice, clients would opt for outstanding lawyers who can also understand how IP impacts the rest of their business, and advise them with practical, real-world, and business-savvy solutions. Not only do the lawyers need to have sound knowledge of the current law, but they also need to perceive coming trends that might affect clients' business.

Our list is categorized with the specialized fields of the experts, including patents, trademarks, copyright, enforcement, licensing and franchising, media and entertainment, IT and telecoms, pharma and biotech, and IP litigation. A total of 50 top experts from 38 law firms are presented, including Japan's largest IP firms and practices. Nakamura & Partners placed five lawyers on our list (Kei Iida, Yoshio Kumakura, Shinichiro Tanaka, Koichi Tsujii, and Kazuhiko Yoshida). Eight different firms placed two lawyers each on our list:

Abe, Ikubo & Katayama (Eiji Katayama and Hiroshi Kobayashi); Anderson Mori & Tomotsune (Akihito Nakamachi and Masayuki Yamanouchi); Asamura Patent Office (Masahiro Asamura and Yoichi Inoue); Hiroe & Associates (Masanori Hiroe and Takenori Hiroe); Mori Hamada & Matsumoto (Atsushi Okada and Yoshifumi Onodera); Shiga International Patent Office (Shinya Jitsuhiro and Yasuhiko Murayama); TMI Associates (Yoshiyuki Inaba and Shunji Sato); and Yuasa and Hara (Hiromichi Aoki and Toshiaki Iimura). In addition to the large law firms, as the legal market of Japan keeps on maturing, there are also many competent boutique firms arising. Among our top 50 list, 29 firms are represented by one lawyer.

Most of the lawyers named to our list have multiple practice specialties. Many of them are litigators, while others concentrate on prosecution work or provide strategic advice.

All of them have something in common: they are experts in their fields and, in one way or another, they provide extra value for their clients. They are *Asia IP's* Japan IP Experts.—GREGORY GLASS ^{ALP}

JAPAN IP EXPERTS TOP 50

JAPAN 2024	FIRM	PATENTS	TRADEMARKS	COPYRIGHT	ENFORCEMENT	LICENSING & FRANCHISING	MEDIA & ENTERTAINMENT	IT & TELECOMS	PHARMA & BIOTECH	IP LITIGATION
Takanori Abe	Abe & Partners	✓	✓	✓					✓	✓
Atsushi Aoki	Seiwa Patent & Law	✓	✓							
Hiromichi Aoki	Yuasa and Hara		✓							
Masahiro Asamura	Asamura IP	✓				✓				✓
Toshiaki Etoh	Tashiro & Etoh Patent Bureau	✓								
Tomoyo Fujimoto	Shiomizaka		✓	✓			✓			
Kensaku Fukui	Kotto Dori Law Office		✓	✓			✓			
Yoshiki Hasegawa	Soei Patent & Law Firm	✓								
Masanori Hiroe	Hiroe & Associates	✓	✓	✓						✓
Takenori Hiroe	Hiroe & Associates	✓	✓	✓		✓				✓
Kei Iida	Nakamura & Partners		✓	✓		✓	✓			
Toshiaki Iimura	Yuasa and Hara	✓	✓		✓					✓
Yoshiyuki Inaba	TMI Associates	✓	✓			✓				✓
Yoichi Inoue	Asamura IP	✓								
Shinya Jitsuhiro	Shiga International Patent Office	✓							✓	
Chie Kasahara	Atsumi & Sakai	✓	✓				✓	✓		
Eiji Katayama	Abe, Ikubo & Katayama	✓	✓		✓				✓	
Hirohito Katsunuma	Katsunuma International Patent Office	✓	✓			✓				✓
Yoshitake Kihara	Fukami Patent Office	✓								
Hiroshi Kobayashi	Abe, Ikubo & Katayama	✓							✓	
Kumpei Kogure	Borders IP		✓							
Eiichiro Kubota	Kubota	✓	✓		✓					✓
Yoshio Kumakura	Nakamura & Partners	✓	✓						✓	✓
Masatoshi Kurata	Suzuye & Suzuye	✓						✓		
Masaki Mikami	Marks IP		✓		✓	✓				
Manabu Miyajima	Kyowa Patent and Law Office		✓							✓
Yoshiyuki Miyashita	Nishimura & Asahi	✓					✓	✓		
Hidekazu Miyoshi	Miyoshi & Miyoshi	✓	✓	✓						✓
Masashi Moriwaki	M & Partners, IP	✓				✓		✓		✓
Yasuhiko Murayama	Shiga International Patent Office	✓								
Akihito Nakamachi	Anderson Mori & Tomotsune	✓	✓			✓		✓		
Kenichi Nakayama	Sugimura & Partners	✓	✓	✓						✓
Seiji Ohno	Ohno & Partners	✓				✓				✓
Atsushi Okada	Mori Hamada & Matsumoto	✓	✓		✓			✓		✓
Yoshifumi Onodera	Mori Hamada & Matsumoto	✓	✓		✓	✓				✓
Katsumasa Osaki	Kawaguti & Partners	✓			✓				✓	✓
Hideo Ozaki	City-Yuwa Partners	✓				✓				✓
Akihiro Ryuka	Ryuka IP Law Firm	✓				✓				✓
Masahiro Samejima	Uchida & Samejima Law Firm	✓				✓		✓		✓
Shunji Sato	TMI Associates		✓	✓	✓					✓
Takamitsu Shigetomi	Oh-Ebashi LPC & Partners	✓	✓			✓			✓	✓
Masayuki Shobayashi	Shobayashi International Patent & Trademark Office	✓	✓						✓	
Yoshitaka Sonoda	Sonoda & Kobayashi	✓								✓
Shinichiro Tanaka	Nakamura & Partners	✓	✓		✓		✓			✓
Hideya Tsuba	Tokyo Kyodo Patent Office	✓	✓		✓	✓				✓
Koichi Tsujii	Nakamura & Partners		✓							✓
Kozo Yabe	Midosuji LPC	✓	✓	✓	✓					✓
Kensaku Yamamoto	Shusaku Yamamoto	✓	✓			✓				✓
Masayuki Yamanouchi	Anderson Mori & Tomotsune	✓				✓				✓
Kazuhiko Yoshida	Nakamura & Partners	✓	✓			✓		✓		✓

Extended biographies of lawyers highlighted above appear on Pages 41-48



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Takanori Abe is an attorney-at-law, admitted in both Japan and New York. He is currently a guest professor at Osaka University's Graduate School of Medicine and formerly a lecturer of The University of Tokyo Graduate School of Medicine and Faculty of Medicine. He is an arbitrator in Japan and sits on various positions in Japanese medical/pharmaceutical societies.

Mr. Abe works in wide areas of international and corporate matters with a focus on intellectual property law and international commerce. The patent litigations in which he has participated cover the fields of pharmaceuticals, chemistry, IT and telecommunications, electronics and machinery, which involve advanced technology such

as biotechnology, semiconductors, etc., and which are cross-border matters. He has extensive experience on representing and advising multinational and domestic clients in pharmaceutical industry and is currently involved in the drastic battle between brands and also the one between brands and generics. He also has experience of IP due diligence in the largest pharmaceutical M&A in Japan between big pharmaceuticals. FTO search is his daily works. He has been advising on FRAND matters. He also has experience in trademark, copyright and unfair competition litigation.

For *Mr. ABE's detailed information and activities*, please visit www.abe-law.com or email abe@abe-law.com



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Masahiro Asamura is a senior managing partner at Asamura IP and Asamura Law Offices, where he successfully leads both firms.

Besides management responsibilities, he is involved in consultations regarding patent-, trademark-, design- and copyright-related disputes, unfair competition concerns, inter-party trials (invalidation trials and trials for cancellation), warning letter correspondence, negotiations, cross-border injunctions and litigation. Mr. Asamura has

extensive experience as both a patent attorney and as an attorney-at-law advising Japanese and foreign companies in a wide range of intellectual property matters.

Mr. Asamura also served as a member of the Japan Patent Attorneys Association's Amicus Brief Committee (2011-2013) and as a member of the Association's Intellectual Property Litigation Committee (2013 – 2014) where he was involved in examining court cases and the Japanese litigation system.



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Masanori Hiroe has around 20 years of experience handling cases related to trademarks, designs, copyright and unfair competition. He specializes in the field of trademark acquisition and infringement proceedings, but also handles trademark prosecution for companies and businesses in various industries based in Japan and around the world. Mr. Hiroe is active as a member of the Trademark Committee and the Copyright Committee of the Japan Patent Attorneys Association (JPAA) and has a track record of participating in public research groups on the trademark and copyright systems. Seeing growth as an integral personal goal, Mr. Hiroe attends international conferences such as INTA yearly in order to understand international trademark protection trends and strengthen his business practices. As an extension of this goal, he is a part-time lecturer at Gifu University, educating students and working adults in IP law, as well as training future IP specialists.

Mr. Hiroe graduated from Ritsumeikan University Faculty of Law, Graduate School of Law. He is director, managing partner and patent attorney at Hiroe & Associates, where he heads the trademark, design, copyright and unfair competition sections. He is a member of the Asian Patent Attorneys Association, INTA, Japan Intellectual Property Association, Japan Trademark Association and JPAA. He chairs the JPAA Gifu Prefectural Committee (2020-) and has been a member of the Intellectual Property Support Centre of the JPAA (2012-2016), the JPAA Trademark Committee (2016-2018) and the JPAA Copyright Committee (2018-2020). He takes part in the Gifu University Research Promotion and Social Cooperation Organization Intellectual Property Seminar (2016-), the Gifu University Common Courses Intellectual Property Law (2016-), and the IP business symposium in Gifu (2018).



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Takenori Hiroe is the founding partner of Hiroe & Associates (H&A). After graduating from Gifu University in 1971 he worked for the R&D department of Japan Vilene Co. in Tokyo. He obtained his patent attorney's license in 1978 and founded H&A in 1979. In February 2004, Takenori was registered as an Intellectual Property Law Infringement Lawyer. In 2011 he received the Medal of Merit from the Emperor of Japan for his longstanding services as a patent attorney. To this date, he has been involved in numerous patent and trademark applications and proceedings, contributing to the protection of IP.

In 1998 he delivered a lecture regarding the Japanese Intellectual Property System at the AIPLA conference in Florida. In June 2001, he received the JPO Commissioner's Award for outstanding practice of IP rights. From April 2006-April 2007 he was a member of the Conference on Brinks Countermeasures Against Materials that Infringe the Unfair Competition Prevention Law at the Ministry of Economy, Trade and Industry. In June 2011 he was recommended by

the Commissioner of the Japan Patent Office to receive a Medal of Merit, and was awarded a Yellow Ribbon Medal by the Emperor of Japan.

He is a former member of JPAA's International Activity Committee, Trademark Committee, Copyright Committee, Unfair Competition Prevention Law Committee and IP Enforcement Facilitation Committee. He lectures at seminars sponsored by the Japan Intellectual Property Association, Japan Institute of Invention and Innovation, JPO, etc. He was also a part-time professor at Gifu University (2005-2017), and still regularly teaches extracurricular IP seminars there.

His typical work includes IP rights disputes (including infringement cases) and consultancy on licensing and agreements. He has the insightfulness and ability to instantly understand the content of a case, grasp the points of dispute and come up with the best solution. He is a member of AIPPI, INTA, FICPI, JPAA, APAA and JIPA.



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Kei Iida, an attorney-at-law and patent attorney, is a partner in the legal section of Nakamura & Partners, where he has practiced IP related matters on behalf of international and domestic clients for around 30 years. He specializes in IP law, strategy and management including litigation, ADR, negotiation, contract and opinion, technological alliance, fashion, entertainment, sports, media, agribusiness, international transaction, and antitrust.

He graduated from the Faculty of Law at The University of Tokyo and obtained an LL.M. in IP at the Franklin Pierce Law Center in the United States. He is an active member of several international IP organizations such as APAA, AIPPI

and LES, and several IP academic societies in Japan such as Japan Association of Industrial Property Law. He has taught IP law as adjunct lecturer at the Graduate School of Business Sciences, University of Tsukuba, for around 15 years. He has been a member of several research and study committees for reform of the IP system for the Japan Patent Office and the Institute of Intellectual Property. Further, he has been appointed as IP Expert Advisor for Japan Customs and Advisory on Unfair Competition Prevention Law for Ministry of Economy, Trade and Industry of Japan. In Chambers Asia Pacific 2017, he is described as "a walking dictionary of IP law."



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Yoichi Inoue is a director of the Chemical Department at Asamura IP and an experienced patent attorney who specializes in biology, agricultural chemicals, medical treatment and medicine. He focuses his practice on domestic and international patent prosecution and has extensive experience handling dispute-related matters, including litigation.

Prior to joining Asamura, Yoichi was involved in the research and development of new pesticides at a biological research laboratory. Fluent in English, he has visited numerous patent firms in the United States and Europe and has represented Asamura IP at various IP summits. He was also involved with the seminar on European patents sponsored by the Research Institute of Economy, Trade and Industry of Japan.



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Yoshio Kumakura is an attorney at law in the legal section as well as a patent attorney. His main areas of focus include intellectual property law, antimonopoly law, unfair competition prevention law, litigation, arbitration, dispute resolution, and international transaction law. Upon graduating from The University of Tokyo Faculty of Law, he passed the Japanese Bar Examination, but initially began his career in the financial sector at Sumitomo Bank LTD. After his time there he joined Nakamura & Partners. He later studied at Harvard University, receiving his LL.M. through an exchange scholarship program sponsored by the Legal Training Institute of the Supreme Court.

Most notably, however, is that Mr. Kumakura has won many IP litigations including four successful appeal cases before the Japanese Supreme Court. He has also written and lectured extensively on a number of topics such as Japanese IP law, IP litigation, trademark issues and developments, and a host of specific case judgements made by the Japanese high courts. He received the Award of Minister of Economy and Industry on Intellectual Properties, the AIPPI Member of Honour, and the APAA Enduring Award.



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Shinichiro Tanaka is a partner in the legal section at Nakamura and Partners. As an attorney at law and a patent attorney, he has represented numerous clients often in the fields of intellectual property law, entertainment media, antimonopoly law, unfair competition prevention law and international transaction law. He graduated from the Faculty of Law at Hitotsubashi University in Japan and studied at the University of Munich, where he gained German and English language skills as well as knowledge related to

international patent issues. He is an active member of the Daini Tokyo Bar Association, the Japan Federation of Bar Associations and the Japan Patent Attorneys Association, among others. Mr. Tanaka has given lectures on recent court decisions in Japan and their implications in practice, and also written articles on topics such as the international application of the theory of equivalency, patent litigation, and parallel import and trademark infringement.

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Koichi Tsujii is a licensed patent attorney in Japan and a licensed attorney at law in both Japan and the U.S. In the legal section, his main practices include intellectual property law, international transactions, and general corporate law matters. He studied at Chuo University and the Legal Training Institute of the Supreme Court in Japan and at Cornell University in the United States, providing him with well-rounded knowledge of both domestic and international IP rights.

He is a member of a number of IP organizations as well as entertainment and sports-related organizations such as the All Japan Concert & Live Entertainment Promoters Conference, Japan Anti-Doping Agency, and Japan Sports Arbitration Agency. Mr. Tsujii has gained recognition for writing numerous articles on topics such as parallel imports, licensing agreements, trademark issues, and the analysis of various specific case judgements made in Japan. He has given lectures for the International Trademark Association, the AIPPI World Congress, and the Tokyo University of Technology among others.



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Kazuhiko Yoshida, who goes by Kaz, is an attorney-at-law and patent attorney in the legal department and a representative/managing partner of Nakamura & Partners. He handles many of the firm's major client cases in matters related to intellectual property litigation, opinion and negotiation, licensing, international transaction, sports and entertainment, and antitrust. After graduating both The University of Tokyo Faculty of Law and the Legal Training and Research Institute in Japan, he joined the firm, and after gaining six years' experience, he studied at Harvard Law School, obtaining his LL.M. degree and thereafter worked for Hughes Hubbard & Reed (New York) in the U.S.

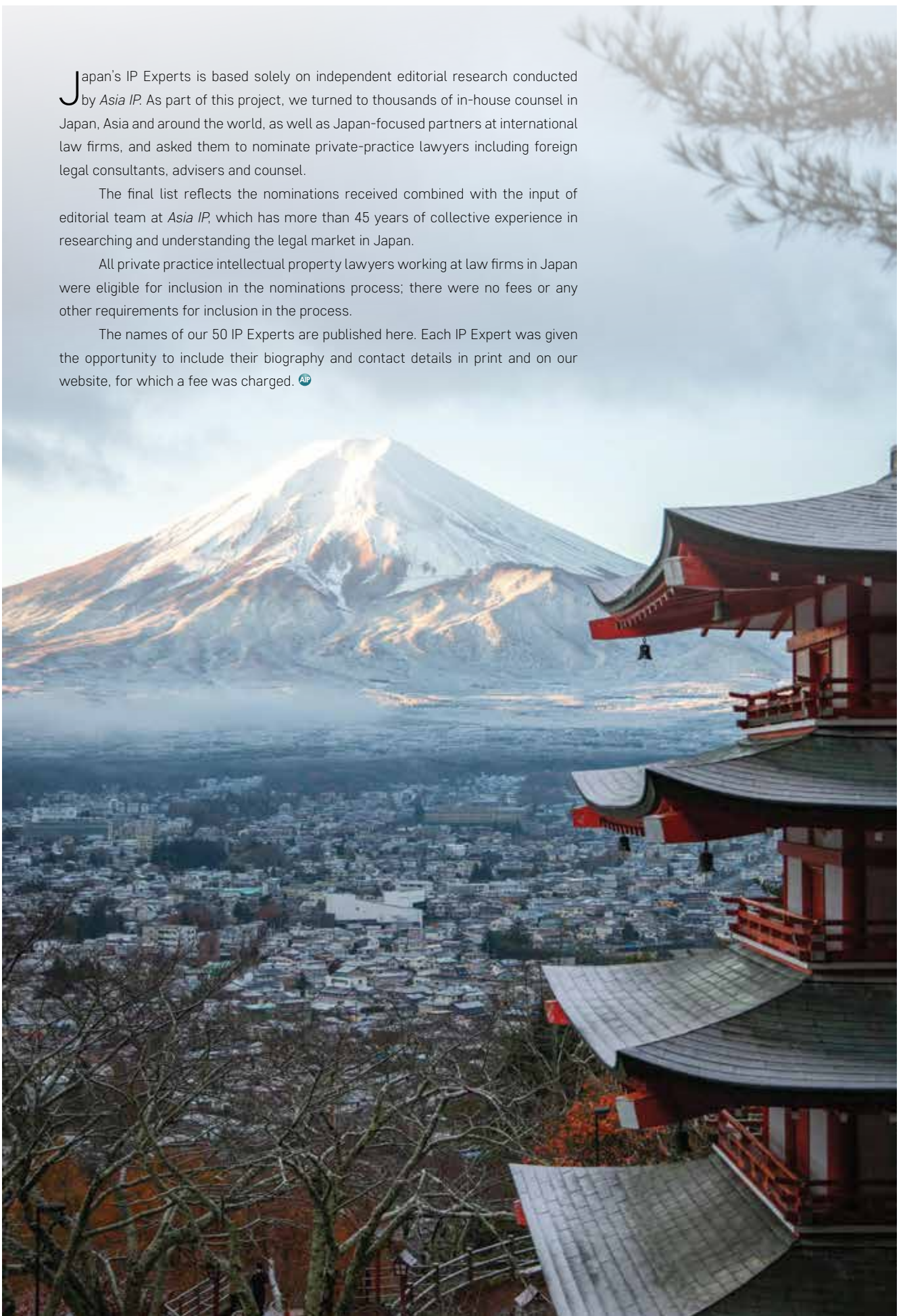
He has been a visiting professor at Tohoku University and has lectured on computer laws as an adjunct lecturer for The University of Tokyo School of Law. Mr. Yoshida has also written numerous articles in both Japanese and English regarding specific court judgements and their influence on current IP law and trending practices and procedures in Japan covering a wide range of IP issues. He is a member of various organizations such as AIPPI-JAPAN, The Law Association for Asia and the Pacific, and the Japan Association of Industrial Property Law. He was an Assistant to the Reporter General of AIPPI International from 2010 to 2014 and has been the chief editor of the AIPPI Journal (both the Japanese and English versions) published by AIPPI Japan.

Japan's IP Experts is based solely on independent editorial research conducted by *Asia IP*. As part of this project, we turned to thousands of in-house counsel in Japan, Asia and around the world, as well as Japan-focused partners at international law firms, and asked them to nominate private-practice lawyers including foreign legal consultants, advisers and counsel.

The final list reflects the nominations received combined with the input of editorial team at *Asia IP*, which has more than 45 years of collective experience in researching and understanding the legal market in Japan.

All private practice intellectual property lawyers working at law firms in Japan were eligible for inclusion in the nominations process; there were no fees or any other requirements for inclusion in the process.

The names of our 50 IP Experts are published here. Each IP Expert was given the opportunity to include their biography and contact details in print and on our website, for which a fee was charged. 





TRADEMARKS FOR SALE: The buying and selling of mark rights

Asian entities are leading the world in buying up existing trademarks, and are increasingly heavily represented on the selling side, too. *Espie Angelica A. de Leon* examines the world of buying and selling trademark rights.

Barring a case of trademark hoarding by bad faith owners, there are several reasons why a trademark owner might decide to sell a mark. It may be due to a shift in focus to other areas of business or the trademark may no longer align with the owner's branding strategy. The decision to sell may also be dictated by other factors like brand revolution, market demand and retirement. Or, it could be that the owner just wishes to monetize the trademark's value or no longer wants to use the mark.

"If he does not sell the mark, once any third party challenges it by non-use cancellation, he could not maintain it. If he sells the mark, he will get some benefits from this sale and this mark will be used by another party. It is a triple-win by the owner, the buyer and the society," explained Lina Li, a partner at Jadong IP Law Firm in Beijing.

A trademark can only be sold by the owner of the rights to that mark – whether said owner is an individual, business or other entity.

Anybody can also make the purchase – an individual, company, association or body of persons, corporate or incorporate. This includes the employees of the business enterprise that is selling the trademark as well as its business competitors.

“In China, as for the assignee or buyer whose nationality is not Chinese, anyone or any legal entity can buy a trademark. As for the assignee or buyer whose nationality is Chinese, any legal entity that is active can buy a trademark, while the natural persons not only need to have civil capacity but also be authorized to engage in business activities in accordance with the law. The assignee’s ID card and business activities certificate would be verified,” said Xia Zheng, founder of AFD China in Beijing.

For example, if the assignee is an individual industrial and commercial household, they can use either the trade name indicated on their Individual Industrial and Commercial Household Business License or the operator’s name as the name of the assignee. “When recording the trademark assignment before the CNIPA, the copies of the assignee’s ID card and Individual Industrial and Commercial Household Business License should be submitted,” Zheng added.

Steps involved in selling and purchasing marks

The process of selling and purchasing marks process typically involves due diligence. “Both the buyer and seller should conduct thorough due diligence to assess the trademark’s value, legal status and potential risks. It is important to bear in mind that trademarks are territorial in nature,” said Ren Jun Lim, a principal at Baker McKenzie Wong & Leow in Singapore.

Selling and buying also involves negotiation, with the parties negotiating the terms of the trademark sale. These include the purchase price, payment structure and any conditions or restrictions.

A legally binding assignment agreement is also put in place. The terms of the sale set out in the agreement include the transfer of trademark rights.

Filing with the relevant IP offices is, of course, also an important step in the process of trademark selling and buying. “The assignment of a trademark may need to be updated in the respective countries’ registers to reflect the change of ownership,” Lim said.

Several online marketplaces facilitate the purchase of trademarks on a global scale. One of these is RedCoin. Based in the United Kingdom, RedCoin has been engaged in the acquisition of trademarks since the late 1990s.

“We use built-in trademark data APIs to do the work of providing the necessary formal information, so when a seller enters the registration number and the associated country, the system auto-populates the platform with all the official data. All the seller has to do is enter the price, whether they will negotiate on that price and any other information they think may be useful. They can add connected domain names to the listing too,” said Gavin Hyde-Blake, the London-based co-founder of RedCoin.

“For buyers, it is even more straightforward. There is a search page for people to search by term, class and territory – and if there are some marks they want to keep an eye on, there is a watchlist facility to bookmark interesting listings. Buyers get to deal directly with the seller through a messaging system, negotiating the price with them and being able to send and receive contract agreements and assignment documents,” Hyde-Blake added.

Would our interviewees recommend a client sell a trademark?

According to Rahul Bajaj, an attorney at Ira Law in New Delhi, there is no blanket answer to this question.

“Whether a client wishes to assign a trademark is a call that must be taken based on the consideration of multiple factors,” Bajaj said. “These include the value that the mark is able to fetch, the impact that assigning rights in the mark would have on the assignor’s IP portfolio and business more generally and the motivations for why the assignor is considering the assignment of the mark.”

Lim agrees.

“Selling a trademark can be beneficial if the client wishes to monetize its intellectual property, shift focus to other areas of business or if the trademark no longer aligns with their branding strategy,” he explained. “However, it is crucial to consider the potential loss of exclusive rights and the impact the sale of trademarks will have on the client’s brand identity. Therefore, the decision to sell a trademark should be one that is based on a comprehensive evaluation of the client’s business strategy.”

“Actually, if the mark is not their house mark, it does not enjoy high reputation, and the client does not use it frequently, we will suggest the client sell the mark,” Li said. “This mark may face non-use cancellation and the client may lose it in the future.”

In terms of the lifecycle of trademarks, when a mark is at the end of its life, brand owners are now able to break out of the lapse-or-renew loop and proactively sell something that they no longer need, Hyde-Blake said. “The process gives trademark holders and IP professionals real options for positive action for portfolios and allows real change in the strategic approach to marks. Selling removes renewal and maintenance costs from businesses and allows for a new revenue stream from dead assets that can be reinvested into new IP.”

Would they recommend a client to buy a trademark instead of creating one? Our interviewees said this also depends on a host of factors – the client’s specific needs and goals, budget, potential benefits and risks associated with purchasing a mark.

“Buying a trademark can be a strategic decision, especially if the client seeks to acquire an established brand with a strong market presence. Purchasing an existing trademark can save time and resources compared to creating a new one from scratch. Additionally, an acquired trademark may already have a loyal customer base and brand recognition, which the

"Buying a trademark can be a strategic decision, especially if the client seeks to acquire an established brand with a strong market presence."

—REN JUN LIM, principal,
Baker McKenzie Wong &
Leow, Singapore

"A brand owner can begin using a pre-registered mark as soon as they legally own the mark - a much quicker process than waiting for an application to clear, so the path to market for products or services is quicker and easier."

—GAVIN HYDE-BLAKE,
co-founder, RedCoin, London

"In China, for the assignee or buyer whose nationality is not Chinese, anyone or any legal entity can buy a trademark. As for the assignee or buyer whose nationality is Chinese, any legal entity that is active can buy a trademark, while the natural persons not only need to have civil capacity but also be authorized to engage in business activities."

—XIA ZHENG, founder,
AFD China, Beijing

"Whether a client wishes to assign a trademark is a call that must be taken based on the consideration of multiple factors. These include the value that the mark is able to fetch and the impact that assigning rights in the mark would have on the assignor's IP portfolio."

—RAHUL BAJAJ, attorney,
Ira Law, New Delhi

"If the mark is not their house mark, it does not enjoy high reputation, and the client does not use it frequently, we will suggest the client sell the mark. This mark may face non-use cancellation and the client may lose it in the future."

—LINA LI, partner,
Jadong IP Law Firm, Beijing

client can build on to further develop their business," said Lim.

However, Lim also added that clients aiming for brand originality and who prefer to have greater creative control over the name, design and brand strategy of their business might choose to create a mark from scratch instead.

"Generally speaking, it may make sense to create a new mark, based on an analysis of the marks that are already registered, as opposed to becoming an assignee of a mark since acquiring a trademark may entail its own set of expenses and a thorough due diligence," said Bajaj.

"We suggest that the client create a new one

instead of buying,” revealed Li. “The reason is that before buying, the client must do a lot of investigation work such as the total numbers of marks filed by the owner and affiliated companies, and whether they have assigned their marks to different third parties, whether or not the mark is pledged, whether the mark is frozen by a court, etc.”

Generally, buying a trademark can save time and resources compared to creating a new brand from scratch, but the purchased mark may have potential legal disputes, such as infringement litigation or disputes of ownership, Zheng added.

According to Hyde-Blake, pre-owned marks could potentially have vital prior rights to provide protection and comfort to the buyer. “A brand owner can begin using a pre-registered mark as soon as they legally own the mark – a much quicker process than waiting for an application to clear, so the path to market for products or services is quicker and easier,” he said.

Tips for trademark buyers and sellers

Our interviewees offered the following tips for trademark sellers and buyers:

- 1) Before selling, the trademark owner should investigate the adversary, including their business mode, main products/services, legal actions involved, and others.
- 2) Before buying, one should investigate as well and get information on the following: the total number of marks filed by the trademark owner/their affiliated companies, whether they have assigned their marks to different third parties, that the mark is not pledged and that the mark is not frozen by a court, among others.
- 3) If the buyer is a foreign company, it will be more cost-effective to conduct the negotiation through a third party.
- 4) Parties should carefully assess the type of assignment they would like to enter into. In India, according to Bajaj, there are three types of assignments under the country’s trademark law. These are:
 - **Complete assignment.** All the rights flowing from the trademark are assigned.
 - **Limited assignment.** Only some rights are assigned. These include the rights over that trademark without respect to a particular good/service or particular classes
 - **Assignment with or without goodwill.** The assignor can either assign the goodwill associated with the mark to the assignee or choose to retain the same with itself, while assigning rights in the mark.
- 5) Compute the cost intelligently. “It is critical to intelligently compute the cost of the trademark for the purpose of assignment,” said Bajaj. “There are two methods commonly deployed for this purpose. Direct cost, which is based on the actual cost incurred by the assignor on the mark and indirect cost which takes into account the brand

image and customer awareness of the mark.”

- **Cost approach.** The cost incurred in positioning the brand
- **Income approach.** The estimated income that the mark may generate based on a projection as to its useful life
- **Market-based approach.** The value of the mark is ascertained based on the value of similarly situated marks in the market

Trademark buying and selling in Asia

Assignment of trademarks is fairly common in India, where a registered mark which has not been used for at least five years from the date of registration, may be vulnerable to cancellation for non-use.

In Singapore, the practice of selling and purchasing trademarks occurs primarily in the context of business acquisitions, mergers or the transfer of IP assets.


In Asia in general, there is a generally high acceptance of the practice. “It’s something the Asian market is used to and open to. The further westwards from there, the more conservative people seem to be about the practice at the moment – although the interest we’re generating shows the appetite may be changing elsewhere to catch up with the Asian market,” Hyde-Blake said.

It didn’t seem that way at first though. Hyde-Blake acknowledged that RedCoin initially focused on Europe, its home ground in IP investigations for the last 15 years. “We were, I’m sorry to say, a little parochial in our outlook,” he confided.

Yet, one week after opening the platform, the realization set in: The business of buying and selling marks was more global than they thought. “We were receiving calls and emails from contacts in other parts of the world,” Hyde-Blake recalled, “and we soon widened our platform to include North America and Asia.”

The 2023 International Trademark Annual Meeting (INTA) in Singapore, in which RedCoin participated, reinforced this decision. “We had an overwhelmingly positive response from attendees and showed IP is a ‘Glocal’ market – one that is both simultaneously global and local. The experience was both encouraging and educational and showed that Asia is an important market for us,” explained Hyde-Blake, adding that sales used to be undertaken as one-off deals where a buyer approached a trademark holder to acquire a specific mark for a specific project.

“Asia is the area currently showing the strongest interest in terms of buyers,” he continued. “They are also increasingly heavily represented on the selling side and the platform currently has a large number of marks from South Korea and India. We are getting enquiries in from potential Asian buyers, including from China, South Korea and Singapore, so it’s an area that is high in activity for us at the moment.”

Trademarks, anyone? 

IP EXPERTS 2024

United Arab Emirates

The future for intellectual property in the United Arab Emirates appears bright, thanks to a number of government initiatives.

When the government launched its first corporate income tax in June 2023, income from intellectual property was explicitly marked for taxation. But when Cabinet Decision No. 100 was released on November 3, 2023, which provided guidance on qualifying free zone tax exemptions, intellectual property owners in the UAE rejoiced.

The cabinet decision, which carved out an exemption from corporate income taxes for income derived from the ownership or exploitation of qualifying intellectual property, moved certain intellectual property income into a zero percent corporate tax bracket.

Qualifying IP includes copyrighted software and patents, as well as rights that are functionally equivalent to a patent, including “utility models, intellectual property assets that grant protection to plants and genetic materials (and) orphan drug designations.”

Foreign investment consultancy Dezan Shira & Associates in Dubai explained in its Middle East Briefing in November 2023 that the proportion of the expenses

incurred to fund R&D activities directly connected with the creation, invention or significant development of such qualifying IP – along with a deemed “uplift expenditure” – will determine how much income from qualifying IP can enjoy a zero percent rate.

Copyrighted software was included in the decision due to a 2020 ministerial decision that recognized its similarity to patent assets. Observers expect the Federal Tax Authority to release a document highlighting details of the application of the zero percent rate to IP.

PwC, in a client alert, noted that the definition of qualifying income expanded to include income derived from the ownership or exploitation of qualifying intellectual property. “The inclusion of this definition seems to be targeted for companies who generate income from intellectual property but not trademark royalty, and actually carry out research and development themselves or via third parties,” the firm said.

David Daly, a partner at the Gulf Tax Accounting Group in Dubai. Daly, writing in *The National News*, said that the decision was aimed at creating “what we can call the UAE patent box.” Daly further said the strategy is “a well-developed framework” used by governments



globally to encourage the development and domiciling of commercial intellectual property in their respective domestic markets.

“This demonstrates the UAE’s determination to compete internationally within the norms of other standard government approaches,” Daly said.

In February 2024, the UAE’s Ministry of Economy introduced a programme aimed at better protection for IP. The IP Ecosystem initiative will become a “cornerstone” for growth by attracting more foreign direct investment, Minister of Economy Abdulla bin Touq said on February 6. The IP Ecosystem is anchored by 11 key initiatives in economic and creative sectors, including programmes aimed at student awareness and support for new technologies.

bin Touq said that the initiative will “significantly boost revenues of the UAE’s intellectual property sector by facilitating the export of innovative, cutting-edge national products and services based on innovation and modern technologies to other international markets. Intellectual property plays a key role. It supports business development, fosters innovation and enhances the overall market value of businesses.”

This suggests that the UAE – a country made up of seven separate emirates, including Abu Dhabi and Dubai, as well as Ajman, Fujairah, Ras Al Khaimah, Sharjah and Umm Al Quwain – may soon see a boom in the local IP legal market. In this issue, we pay tribute to many of the best IP lawyers in the country by presenting our UAE Top 40 IP Experts list. We asked a large number of IP professionals in the region, who are mostly in-house counsel and corporate legal managers, about what they were looking for from their legal service providers, so as to understand better what clients need and want today. Based on these answers, we have compiled our list of the Top 40 IP experts in the UAE, lawyers who can best understand what their clients need and provide them with the best practical


advice.

Nowadays, it takes more than a degree from a top-notch university and a couple of decades of practice for IP lawyers to convince clients that they are the best in the field. When looking for IP advice, clients would opt for outstanding lawyers who can also understand how IP impacts the rest of their business, and advise them with practical, real-world, and business-savvy solutions. Not only do the lawyers need to have sound knowledge of the current law, but they also need to perceive coming trends that might affect clients’ business.

Our list is categorized with the specialized fields of the experts, including patents, trademarks, copyright, enforcement, licensing and franchising, media and entertainment, IT and telecoms, pharma and biotech, and IP litigation. A total of 40 top experts from 25 law firms are presented, including the UAE’s largest IP firms and practices. Some of the region’s top firms are heavily represented in the list: Al Tamimi & Company placed five lawyers on our list (Rasha Al-Ardah, Omar Obeidat, Ahmad Saleh, Ahmad Zaza and Xiaodi Wang), while Gowling WLG (Rachel Armstrong, Tamara El-Shibib, Noor Hasan and Jon Parker) and Rouse (Bassel El Turk, Sara Holder, Samantha Grainger and Paul Muscat) each placed four lawyers.

Two firms each placed three lawyers on our list: CWB (Cameron Crawford, Halim Shehadeh and Theuns van de Merwe).


Most of the lawyers named to our list have multiple practice specialties. Many of them are litigators, while others concentrate on prosecution work or provide strategic advice.

All of them have something in common: they are experts in their fields and, in one way or another, they provide extra value for their clients. They are *Asia IP*’s UAE IP Experts.—GREGORY GLASS 

The United Arab Emirates’ IP Experts is based solely on independent editorial research conducted by *Asia IP*. As part of this project, we turned to thousands of in-house counsel in the Middle East, Asia and around the world, as well as UAE-focused partners at international law firms, and asked them to nominate private-practice lawyers including foreign legal consultants, advisers and counsel.

The final list reflects the nominations received combined with the input of editorial team at *Asia IP*, which has more than 45 years of collective experience in researching and understanding the legal market in Asia and the Middle East.

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The names of our 40 IP Experts are published here. Each IP Expert was given the opportunity to include their biography and contact details in print and on our website, for which a fee was charged. 

UAE IP EXPERTS TOP 40

NAME	FIRM	PATENTS	TRADEMARKS	COPYRIGHT	ENFORCEMENT	LICENSING & FRANCHISING	MEDIA & ENTERTAINMENT	IT & TELECOMS	PHARMA & BIOTECH	IP LITIGATION
Geraldine Ahern	Eversheds Sutherland					✓		✓		
Rasha Al Ardah	Al Tamimi & Company		✓							
Paul Allen	DLA Piper						✓	✓		
Saba Al-Sultani	DLA Piper		✓						✓	✓
Abdalla AISuwaidi	BSA Ahmad Bin Hezeem & Associates	✓	✓	✓	✓					✓
Rachel Armstrong	Gowling WLG	✓		✓	✓	✓	✓			
Hoda Taysir Barakat	Hoda Barakat Legal Consultancy		✓							
Joby Beretta	The Bench		✓		✓	✓	✓			
Cameron Crawford	CWB						✓	✓		
Rob Deans	Ownership	✓	✓							
Mark Devaney	Abion		✓		✓					
James Dunne	Hadef & Partners		✓	✓	✓					
Amjad El-Husseini	Abu-Ghazaleh Intellectual Property		✓							
Tamara El-Shibib	Gowling WLG	✓								
Bassel El Turk	Rouse	✓	✓		✓					✓
Nicole Giblin	Abion		✓		✓					
Samantha Grainger	Rouse		✓		✓					
Noor Hasan	Gowling WLG		✓	✓	✓	✓				
Mark Hill	Charles Russell Speechlys		✓	✓	✓		✓			
Sara Holder	Rouse	✓	✓							
Nasser Ali Khasawneh	Eversheds Sutherland						✓	✓		
Hady Khawand	Saba Intellectual Property	✓	✓	✓	✓	✓	✓	✓	✓	✓
Nevin Jacob Koshy	United Trademark & Patent Services	✓								
Leila Laila	Alem & Associates		✓	✓	✓	✓	✓			
Sarmad Manto	Audiri Vox	✓	✓	✓	✓	✓	✓	✓	✓	✓
Melissa Murray	Bird & Bird		✓			✓				
Paul Muscat	Rouse	✓						✓		
Omar Obeidat	Al Tamimi & Company	✓	✓							
Jon Parker	Gowling WLG	✓								
Raza Rizvi	Simmons & Simmons		✓						✓	
Raka Roy	Galadari Advocates & Legal Consultants		✓	✓	✓		✓	✓		
Jamie Ryder	Reed Smith					✓				
Ahmad Saleh	Al Tamimi & Company	✓								
Halim Shehadeh	CWB		✓							
Munir Suboh	Taylor Wessing	✓	✓	✓						
Kate Symons	Symons IP		✓	✓				✓		✓
Theuns van de Merwe	CWB		✓							
Xiaodi Wang	Al Tamimi & Company	✓								
Victoria Woods	Hadef & Partners		✓			✓				
Joycia Young	Clyde & Co.	✓	✓			✓				
Ahmad Zaza	Al Tamimi & Company		✓		✓	✓				✓



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- PATENTS
- TRADEMARKS
- COPYRIGHT
- ENFORCEMENT
- LICENSING & FRANCHISING
- IT & TELECOMS
- PHARMA & BIOTECH
- IP LITIGATION

With over 25 years of leadership and excellence in legal expertise, **Hady Khawand** serves as Partner at Saba IP - UAE. Leading a dynamic team, he delivers cutting-edge IP advisory services, portfolio management, and enforcement solutions to top-tier global clients. Renowned for his strategic IP thinking, Hady is a key figure in the UAE's IP community, actively shaping and enhancing IP laws. As Secretary of AIPPI UAE (AIPPI UAE), he advocates for IP awareness and collaborates to improve IP protection.

Holding an Executive MBA from the American University of Beirut and an LLB from the Lebanese University, Hady is a certified Valuation Analyst (CVA), and a qualified Lebanese Attorney At Law member of the Beirut Bar Association.

Recognized for excellence and innovation, Hady Khawand continues to redefine the landscape of Intellectual Property in the UAE.



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PATENTS
TRADEMARKS
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LICENSING & FRANCHISING
MEDIA & ENTERTAINMENT
IT & TELECOMS
PHARMA & BIOTECH
IP LITIGATION

With almost twenty-five years of experience in the Middle East, Asia and Africa, **Sarmad Manto** is the managing partner at Audiri Vox. He also acts as the global portfolio manager for a number of Middle Eastern companies.

Sarmad's specialization includes trademark prosecution, negotiations, anti-counterfeiting, litigation, due diligence, franchising, licensing, corporate and regulatory affairs. He has extensive experience in advising brand owners on portfolio development, management, franchising, licensing, data protection and enforcement strategies in the tobacco, information technology, electronics, telecommunication, cosmetics, luxury goods, pharmaceutical, foodstuff and auto industries. He also provides advice on a wide range of legal and compliance issues and is well-versed with the requirements and demands of the in-house and outside counsel aspects of the legal practice. His work includes, but is not limited to, drafting, prosecution and enforcement

of patent and trademark applications, handling oppositions and enforcement actions, franchising and divestiture of IP rights, providing expert advice on data protection, entering negotiations and drafting a wide range of commercial contracts and rendering advice on compliance issues.

Sarmad was instrumental in setting up an ISP in North Africa and was part of one of the biggest seizures of counterfeit medicines in the Middle East. He has successfully overseen prosecution of almost 30,000 trademark and patent applications in almost 180 jurisdictions worldwide. He actively advises numerous blue-chip companies on contentious and non-contentious issues.

Sarmad is a member of numerous IP organizations and regularly writes on IP issues for leading publications. He has received a number of accolades from prominent IP powerhouses.

AUDIRI VOX

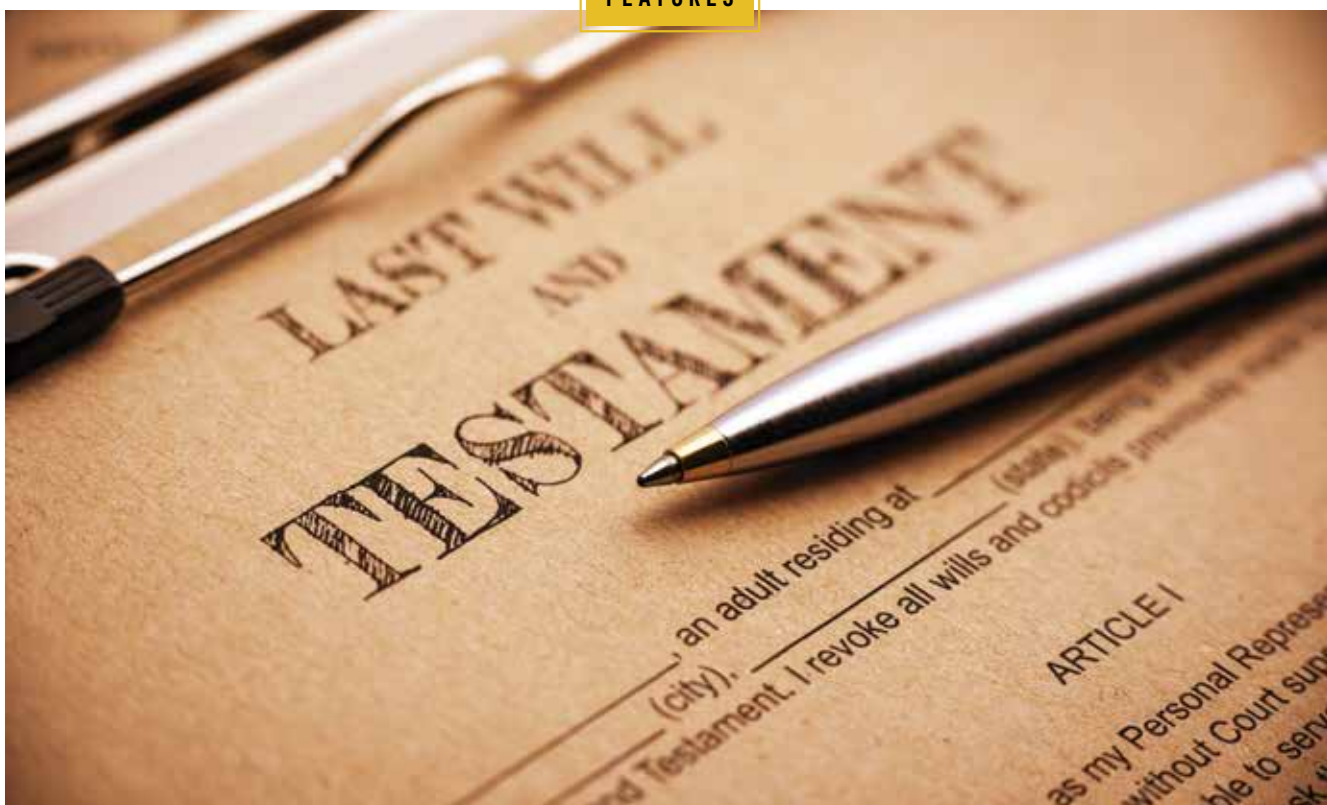


Audiri Vox stands as the premier choice for Intellectual Property services in the Middle East, boasting unparalleled growth. Specialized in the registration, protection, and divestiture of IP rights across the Middle East, Asia, and Africa, Audiri Vox aids its global clientele in securing their valuable IP assets. The firm is the global portfolio manager for the largest pharmaceutical, tobacco, foodstuff, and electronics entities in the Middle East. Audiri Vox's exponential expansion is a testament to client confidence which is evident from the multitude of cases managed by the firm. Leveraging a robust local clientele with expansive global portfolios, Audiri Vox operates as a truly multi-jurisdictional firm, actively advocating for trademark and patent rights worldwide. Beyond its Middle Eastern client base, Audiri Vox represents various global industry leaders in managing their portfolios across the Middle East, South Asia, and Africa.

Audiri Vox's seasoned attorneys streamline trademark and patent processes, ensuring swift registrations and minimal objections. Managing multiple high-value global trademark and patent portfolios, the firm diligently monitors clients' IP rights to maintain their validity and providing proactive notifications to prevent cancellations. Known for proficiently advising on complex issues, Audiri Vox serves as the trusted resource for freedom-to-operate searches, registerability opinions, patent drafting, Arabic translations, prosecution, litigation, Customs seizures, licensing, franchising, data protection, and divestiture of rights.

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THE INHERITANCE OF IP RIGHTS

Inheritance of IP rights is inherently complex and varies from country to country. In some countries, it even varies from person to person based on religion. *Espie Angelica A. de Leon* discusses the various legal frameworks, including the challenges and the necessary planning.

Can intellectual property rights be inherited? Yes, they can.

“Copyrights are categorized into moral rights and economic rights. The economic right of copyright is inheritable, but the moral right belongs exclusively to the author and cannot be inherited according to Article 21 of the Taiwan Copyright Act,” said Crystal Chen, a partner at Tsai, Lee & Chen in Taipei.

“For copyrights, only economic rights and the right to publish the works can be inherited. Inheritance of copyright is not only regulated for works created by one person but also applies to works created by co-authors,” added Chi Lan Dang, an associate at Tilleke & Gibbins in Hanoi. According to her, organizations can also inherit IP rights in Vietnam, as long as the will specifies it. Moreover, inheritance extends to the

right to register or file applications for IP protection. In Vietnam and Taiwan, heirs can inherit these rights if they meet the respective registration conditions.

“The inheritor shall have *no locus standi* against any third party unless the patent application has been filed in the name of the inheritor at the time of filing, or a request of recordal of changing the applicant has been filed with the Taiwan Intellectual Property Office (TIPO),” Chen explained. “If the details of inheritance are not provided in the patent, trademark or copyright acts, one should refer to the provisions of the civil code for the relevant rights or obligations,” she added.

In India, patents, trademarks, copyrights and trade secrets are considered to be movable properties, and the rules of law applicable to the ownership and devolution of movable property apply to IPs, said Pravin Anand, managing partner at Anand and Anand

in Noida. “The inheritance laws will only come into play when the IP right in question is a personal property. Courts in India have ruled that IP disputes amongst family members ought to be treated as a property dispute and all legal heirs to have equal rights to use the IP.”

Inheritance rights in India are governed by two sets of laws: the Indian Succession Act and the personal laws based on the religion of the person. Application of these laws will depend upon whether the IP right holder died with a will, in which case there will be a testamentary succession of IP, or without a will, in which succession of IP will be intestate.

IP in estate planning, last wills and trusts

To allow inheritance, the IP right owner should execute a last will as part of succession planning. Careful successional planning includes establishing trusts and estate planning strategies for the IP assets involved in succession, among others. Mary Wendy Duran, a senior partner at Duran & Duran-Schulze Law in Manila, emphasizes that these assets can hold significant value and income potential. Without a clear plan, they might be distributed according to default rules, potentially against the owner’s wishes.

“For example, a patent may be the subject of extant licensing arrangements that produce consistent revenue streams, and copyrights along with trademarks possess the potential to continue to yield economic returns well beyond the life of the IP owner,” she said. “Absent a comprehensive estate plan, these IP assets may become subject to default rules of intestate succession, potentially contravening the decedent’s distributive preferences and could lead to suboptimal administration of the IP assets.”

During successional planning, the IP owner should be proactively involved in identifying and documenting all his IP assets. He should also specify how they should be handled, whether through trusts or other means. If he decides to establish a trust, he should provide instructions for the administration of these assets. These instructions must cover licensing, selling or otherwise managing the IP assets, among others.

“Likewise, it is imperative that the IP owner engages in a discourse with the intended beneficiary or beneficiaries of his IP assets, ensuring they are informed and assent to their prospective administration and management thereof,” said Duran. “Such dialogue will equip them for the responsibility of safeguarding the IP owner’s creations posthumously.”

In India, where the Indian Succession Act governs testamentary succession, making a will is also strongly advised for IP owners. However, this law does not apply to Muslims. Family settlement agreements are also common practice to clarify the distribution and management of IP assets among heirs, explained Anand.

“It is imperative that wills and the manner of use, territory of use, scope of use of IP is carefully elaborated

upon prior to the death of the individual since too much division of IP between multiple stakeholders may also negatively impact the valuation of the IP. Every decision, including on protection, scope of protection, enforcement, etc., has a significant effect on the value of the IP,” said Anand.

However, in Taiwan, IP rights owners are not required to act before death. “An inheritor, however, should be aware that, for patent and trademark, the inheritance shall have no *locus standi* against any third party unless it is recorded by the TIPO. On the other hand, the economic right of copyright will be automatically inherited, so the copyright inheritor does not need to take any action,” Chen said.

In the absence of a last will and testament

In the event that an IP owner dies without a will, the fate of these rights varies depending on the legal system of the country in question.

In Vietnam, IP rights are subject to division according to the law. If there is no heir or if the heir refuses to receive the inheritance or is ineligible to do so, the rights automatically transfer to the state. On the other hand, Taiwan’s Civil Code dictates the order of inheritance. Spouses, lineal descendants by blood, siblings and grandparents are entitled to inherit, and if no eligible heirs exist, the IP rights are extinguished upon the right holder’s death. Similarly, the Philippine Civil Code also prioritizes compulsory heirs and the same transfer of rights if no lawful heirs exist.

Meanwhile, in India, the rules vary depending on the family’s religion. Generally, the spouse is the first to inherit, followed by the children and then close relatives. For Buddhists, Jains, Sikhs and Hindus, succession follows the Hindu Succession Act, while for Christians, succession follows the Indian Succession Act. Muslims in India have their own laws on succession based on tenets of Islamic law.

Anand added that the Indian Succession Act prohibits the bequeathment of property in perpetuity, ensuring it passes to further legal heirs per the inheritance laws. He also emphasized that while personal laws differ based on religion, they generally operate similarly, ensuring that property is passed down to legal heirs according to inheritance laws.

The challenges of inheriting IP rights

- **No mention of IP rights in the last will or agreement.** This will lead to confusion and difficulty in enforcing the rights. In the document, IP matters should be mentioned, defined separately and in detail.
- **Family members may challenge the will on different grounds.** “In India, inheritance issues are very complex, and wills are subjected to challenge by family members,” said Anand. “The will may be challenged on the grounds that it was improperly executed, or on the genuineness of signatures of the executor and/or witnesses.”
- **Depositions or the exercise of the IP right held**

in common are prone to dispute. Chen said: "According to the civil code, when the IP right owner dies and more than one person are entitled to inherit, the IP right is owned in common by all inheritors before its partition. Any deposition or the exercise of the right held in common shall be made with the consent of all the inheritors, which is prone to disputes."

In India, the court may refer to the family settlement agreement or may follow the laws of inheritance. "Thus, in family disputes, where the IP is devolved upon more than one heir, specific covenants should be drafted to divide the IP, the nature of business and its operational jurisdiction, thus, clarifying the scope of the rights," explained Anand.

- **Heirs may not have the knowledge or skill to manage or enforce them.** The result: Underutilization or misuse of the IP assets which may diminish their value.
- **Inaccurate identification and documentation of IP assets.** Certain rights tend to be overlooked or inadequately recorded. This may lead to disputes or mismanagement of the IP assets.
- **IP valuation comes with challenges.** The process is inherently complex due to its unique characteristics and the fluctuating nature of market conditions. "In contrast to tangible assets, the valuation of IP assets can be highly speculative and is often contingent on prospective profits, market possibilities and the remaining term of the IP right," said Duran.

"It is imperative that the IP owner engages in a discourse with the intended beneficiary or beneficiaries of his IP assets, ensuring they are informed and assent to their prospective administration and management thereof."

—MARY WENDY DURAN, senior partner, Duran & Duran-Schulze Law, Manila

"Copyrights are categorized into moral rights and economic rights. The economic right of copyright is also inheritable, but the moral right belongs exclusively to the author and cannot be inherited."

—CRYSTAL CHEN, partner, Tsai, Lee & Chen, Taipei

"Only economic rights and the right to publish the works can be inherited. Inheritance of copyright is not only regulated for works created by one person but also applies to works created by co-authors."

—CHI LAN DANG, associate, Tilleke & Gibbins, Hanoi

"In India, inheritance issues are very complex, and wills are subjected to challenge by family members. The will may be challenged on the grounds that it was improperly executed, or on the genuineness of signatures of the executor and/or witnesses."

—PRAVIN ANAND, managing partner, Anand and Anand, Noida



Moreover, multiple stakeholders may negatively impact the valuation of IP, added Anand. Differing strategies among owners for brand management, promotion and positioning can weaken the brand's overall strength, impacting its valuation. Additionally, controversial practices or negative publicity involving one owner can lead to negative associations, further diminishing the brand's value.

Further, extending the brand across too many products or services that deviate from the company's original mission or values can increase the risk of brand dilution.

- **Tax implications.** There are substantial tax considerations. These involve appraisal of the estate for tax purposes upon the decedent's or IP right owner's demise and income tax implications relative to revenues generated by the IP assets. Strategic planning and expert advice are needed to handle these tax obligations.
- **Navigating IP transfer and registration processes in multiple jurisdictions has its own difficulties.** Duran explained: "The conveyance of proprietorship of IP rights requires navigating an array of registration systems, each possessing jurisdiction-specific peculiarities. Each type of IP – be it patents, copyrights, trademarks, or trade secrets – is governed by their respective procedural protocols for transfer and recordation, which mandate scrupulous adherence to."
- **International considerations.** Different countries may have different statutory provisions on the inheritance of IP rights. The process can thus be intensive. Worse, it can be financially draining as well.
- **Conflicting regulations on the validity of the IP subject to inheritance.** In Vietnam, according to Article 95 of the IP law, a protection title is terminated when the owner no longer exists. However, under the law on notarization and authentication, heirs must prove the continued existence and legality of the inheritance left by the deceased during the inheritance declaration process. This verification challenge can hinder the declaration and division of the inheritance, explained Dang.

She related a case their firm handled involving the trademark rights of a famous French designer who had passed away. "We have faced difficulties in renewing the validity of his trademarks, which were due to expire when the lawful legatee had not yet been decided by the court. Theoretically, his IP rights have been terminated since his death. However, there is a time gap between such date and the time the IP rights are transferred to the heirs, in which the status of the IP titles are uncertain, causing problems to some procedures and actions such as renewal, license, etc.," said Dang.

- **Continuing legal disputes or claims in relation**

to the IP assets. This will force successors-in-interest to engage in intricate legal contests which can be both financially and psychologically taxing.

According to Duran, the handling of Elvis Presley's estate after his death exemplifies the inherent value and complexities involving post-mortem management of IP assets. Presley's portfolio of IP assets included his image, name and likeness, in addition to music royalties.

Upon his demise on August 16, 1977, Presley's estate was hounded with enormous financial problems, but thanks to the strategic handling of his executors, particularly his former wife Priscilla Presley, critical decisions were made and solutions were brought to the table.


Among the most notable of these solutions is the popular tourist destination that is Graceland, Presley's Memphis, Tennessee, home. Converted into a museum, Graceland has become a lucrative source of revenue generated from the throngs of tourists who visit the property, eager to see the legendary singer's abode, cars, gold records, dazzling costumes and other memorabilia.

Furthermore, establishing Elvis Presley Enterprises (EPE) was pivotal in managing his IP assets. "The continued expansion in the commercial utilization of Elvis's image and proprietary marks, by venturing into new markets and modern media platforms, further escalated the estate's value and ensured that his legacy continued to provide financial benefits accruing to his heirs," explained Duran.

In 1993, Presley's sole heir, Lisa Marie Presley, established the Elvis Presley Trust, of which she was owner and board chair until 2005. Her mother Priscilla and the National Bank of Commerce were named co-trustees. The living trust was created to manage Graceland, EPE and the rest of Presley's estate, further boosting its continued success and prosperity.

"Lisa Marie Presley played a pivotal role in the consummation of the sale of a predominant stake in EPE, encompassing the stewardship of Elvis's name, likeness and image, musical royalties, collection of photographs and other investments," said Duran. "This strategic divestiture reflected an ingenious appreciation for the intrinsic attributes of IP assets, adeptly leveraging their economic potential while maintaining substantial influence and perpetuating the homage to her father's illustrious legacy."

Many people aren't aware that inheritance of IP rights is possible and that it comes with complications. Many more are probably clueless about IP to begin with. But the fact remains: Yes, you may pass on your IP rights to someone or an organization as a legacy.

The key is getting the right information about IP and the laws in your jurisdiction, having the right preparation to see to it that such inheritance is achieved and the heir(s) having adequate knowledge, and skills to be able to manage the IP assets and make these work for their financial benefit. 



ASEAN

A different Monster

This decision arose from Monster Energy Company's opposition against the registration of the Application Mark "GENTLE MONSTER" (a word mark) by IICOMBINED Co., Ltd, in Class 9 for "smartglasses", on the following grounds:

- (1) That the Application Mark is confusingly similar to its "MONSTER ENERGY" marks, one of which was registered in 2014 in Class 9;
- (2) That by using a confusingly similar trademark, IICOMBINED is passing off its goods and services as Monster Energy's.

IICOMBINED owns luxury eyewear brand "GENTLE MONSTER", whose first Singapore trademark registration for the word mark "GENTLE MONSTER" was registered in 2013, in Class 9 for "spectacles, sunglasses".

The present application filed in 2018, concerns electronics-equipped "smartglasses" that were first sold internationally in August 2019, and subsequently in Singapore in November 2019.

For purposes of this opposition, the Registrar took the opponent's strongest case and compared the opponent's word mark "MONSTER ENERGY" to the Application Mark "GENTLE MONSTER".

As regards visual similarity, the Registrar rejected Monster Energy's argument that "GENTLE" was descriptive of IICOMBINED's smartglasses, instead holding that "GENTLE", "MONSTER" and "ENERGY" are all ordinary English words that do not describe smartglasses. The Application Mark and the Opponent's Mark should be considered as their respective wholes. As such, contrary to Monster Energy's arguments that "MONSTER" rather than "GENTLE" was the dominant element of the Application Mark,



there was no dominant element in either mark.

As regards aural similarity, the Registrar held that the marks were aurally different, with only two common syllables out of four in the Application Mark and five in the Opponent's Mark, and the common syllables "MON-STER" appeared at the start of the Opponent's Mark and the end of the Application Mark.

As regards conceptual similarity, the Registrar held the marks to be completely different. Despite the same word "MONSTER" appearing in both marks, the words "GENTLE" in the Application Mark and "ENERGY" in the Opponent's Mark completely change the character of the monster that the marks refer to – the former mild and temperate; the latter imbued with great power



and energy.

As the marks were overall different, Monster Energy could not establish passing off because there was no misrepresentation. The Registrar also observed that Monster Energy did not sell significant amounts of eyewear in Singapore vis-à-vis IICOMBINED.

The Registrar therefore dismissed the opposition on both grounds, and the Application Mark proceeded to registration. ^{AP}



PHILIPPINES

Towards a more equitable copyright system

For the second time, the Supreme Court of the Philippines has urged the Philippines Congress and the Intellectual Property Office of the Philippines (IPOPHL) to amend RA 8293 or the Intellectual Property Code of the Philippines (IP Code), to allow the exemption of small businesses from copyright infringement in the case of *Icebergs Food Concepts, Inc. and Allan John T. Young v. Filipino Society of Composers, Authors, and Publishers, Inc.*, G.R. No. 256091, promulgated on April 12, 2023, but uploaded to its website only on January 19, 2024.

This case arose from the complaint for copyright infringement against Icebergs filed by the Filipino Society of Composers, Authors, and Publishers, Inc. (FILSCAP), a non-stock, non-profit association of composers, a Collective Management Organization (CMO) accredited by the IPOPHL. It is authorized to acquire, administer, license, and enforce

the public performance rights over copyrighted musical works or compositions of its members and affiliate foreign societies. FILSCAP is also a member of the International Confederation of Societies of Authors and Composers (CISAC). FILSCAP derives its right to issue licenses and collect license fees from the Deeds of Assignment executed by its members. Icebergs is a Philippine corporation engaged in the business of operating several branches of restaurants within the country while Young is the president and general supervisor of Icebergs.

From 2010 to 2014 FILSCAP monitored several Iceberg restaurants and discovered that the latter publicly played in its restaurants around 324 copyrighted songs in its musical repertoire without the required public performance license. FILSCAP sent Icebergs and Young a total of five letters, from 2009 to 2010, requiring them to secure a public performance license, as well as to pay the corresponding license fees. With no response from Iceberg, FILSCAP sent a final demand letter on September 30, 2014, and on December 1, 2014,

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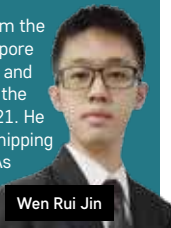
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a director at mirandah asia, which has offices in Singapore, Malaysia, Vietnam, Thailand, Indonesia and the Philippines. She has played an important role in the international promotion of mirandah asia, helping to share its family values and its successful one-stop-shop approach to IP.



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Wen Rui Jin graduated from the National University of Singapore with an LLB (Hons) in 2020, and was subsequently called to the Singapore Bar in August 2021. He started his legal career in shipping law at a Big Five law firm. As an associate at Mirandah Law, Jin works on various trademark matters and disputes, and takes on a broad range of other matters including general civil disputes. He also assists with patent infringement cases of the firm.



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filed a complaint for copyright infringement before the Regional Trial Court demanding payment of license fees for P627,200 (US\$11,330), moral and exemplary damages of P500,000 (US\$9,030) each and attorney's fees of P100,000 (US\$1,800), or a total of P1,227,000 (US\$22,165).

In its answer, Icebergs denied committing copyright infringement and claimed that FILSCAP had no substantial proof of its authority to collect and receive royalties or license fees of the owners of the songs. During trial, Icebergs presented Young, its president, as its lone witness. Young insisted that there were no public musical performances in their restaurants, and that whatever musical sounds were heard in the restaurants were due to the occasional tuning in to the local FM radio, and that the tuning in to the local radio stations was not done to entice customers or generate patronage in the concept of public performance or for commercial gain. Young also claimed that Icebergs did not advertise the musical works or charge a fee for playing the same, as the customers were billed only for food and drinks consumed.

The Regional Trial Court (RTC) on December 5, 2018, found Icebergs guilty of copyright infringement and ruled that FILSCAP, by virtue of the Deeds of Assignment executed by its members and the Reciprocal agreements with its affiliate foreign societies, was effectively the owner of the copyrighted songs and has standing to sue Icebergs and demand compensation. Not satisfied with the RTC's ruling, Icebergs appealed the decision to the Court of Appeals (CA) which affirmed the RTC's decision, and as a last resort appealed the CA decision to the Supreme Court, which decided the case in favor of FILSCAP as follows:

- The Supreme Court, quoting its ruling in *FILSCAP v. Anrey, Inc.* in 2022, reiterated

that the act of playing radio broadcasts containing copyrighted music through the use of loudspeakers amounted to public performance, a right that belongs to the copyright holder, making Icebergs liable to FILSCAP for damages;

- The only exception to copyright infringement is fair use, but the Supreme Court held that Icebergs' use of FILSCAP's copyrighted songs did not constitute fair use. Under Section 85 of the IP Code, In determining whether the use made of a work in any particular case is fair use, the factors to be considered shall include: (a) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes; (b) the nature of the copyrighted work; (c) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (d) the effect of the use upon the potential market for or value of the copyrighted work.
- The Supreme Court found justification to award actual and exemplary damages and attorney's fees but deleted moral damages since FILSCAP is a juridical entity and not a natural person who can experience physical suffering, wounded feelings, etc.

The Supreme Court, however, had the occasion for the second time to say that its decision may have far-reaching consequences on small if no distinction is made between big businesses, such as the Icebergs restaurants, and small businesses, such as small eateries, canteens, *carinderias*, food carts, etc. The Supreme Court, however, noted that there currently exists no exemption for small businesses in the IP Code which deficiency the Philippine legislature must take note of, and recommended the adoption of the three-step test which provides the conditions to the exemptions to the copyright holders' rights, to wit:

(1) cover only certain special cases; (2) not conflict with the normal exploitation of the work; and (3) not unreasonably prejudice the legitimate interest of the copyright holder.

"Small business" refers to small commercial establishments that are unlikely to significantly impact the market for copyrighted work, and thus, must concentrate on the establishment's size, type, usage, and the manner in which the music is transmitted (*i.e.*, the use of a single receiving apparatus of a kind commonly used in private homes and physical arrangement of the sound system.) The Supreme Court stressed that "Ultimately, the objective of the three-step test is to ensure that the right of the copyright holders is protected, and, at the same time, the right of small businesses to use their creations in accordance with the limitations set forth in the three-step test." ^{AP}

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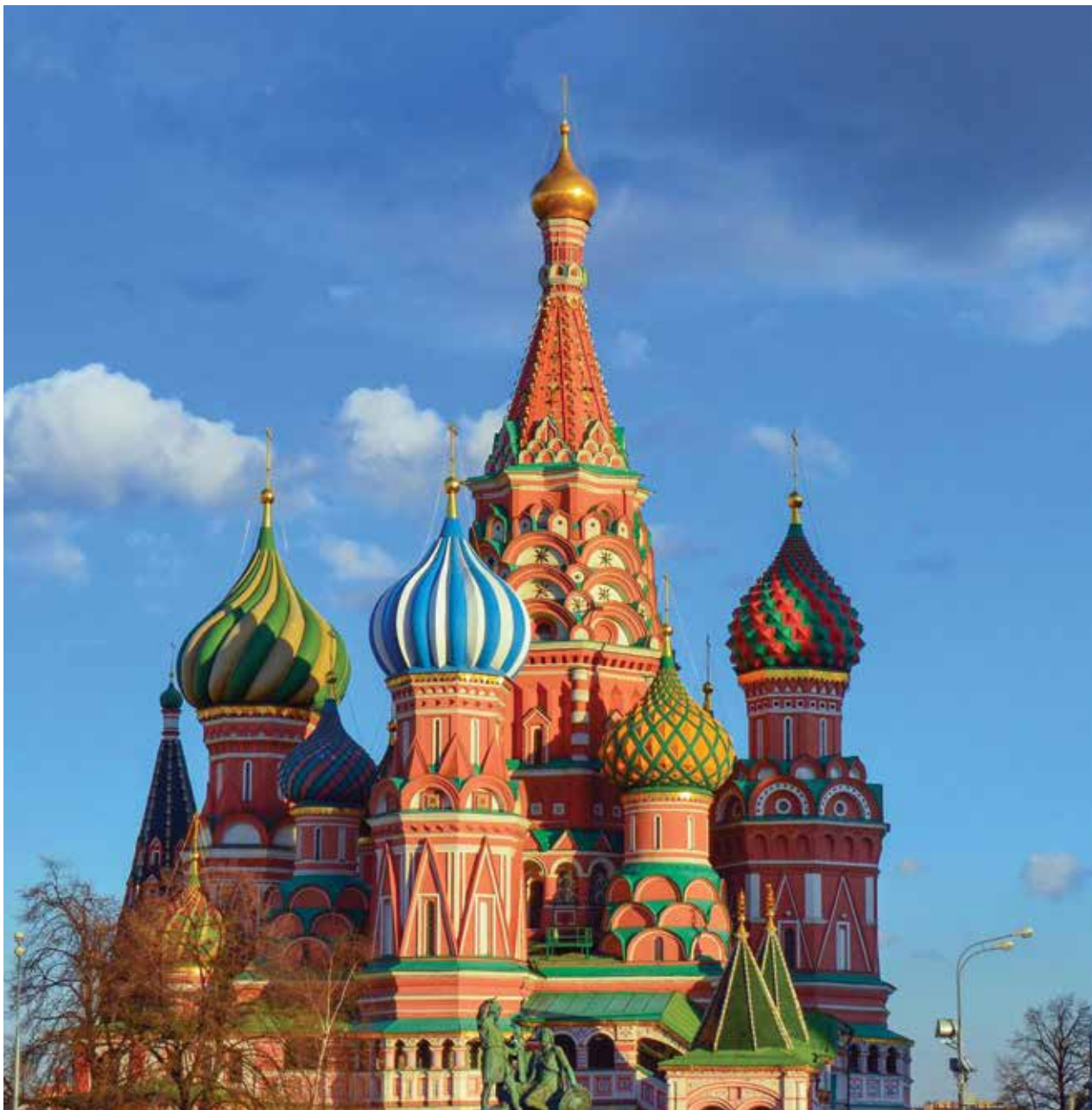
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RUSSIA

Eurasian Patent Organization debuts amended patent regulations

Starting from January 1, 2024, the Eurasian system of inventions and industrial designs patent protection are guided by amended Patent Regulations, approved by the decision of the Administrative Council of the Eurasian Patent Organization (EAPO), adopted at the 43rd (30th regular) meeting of December 5-7, 2023.

Perhaps the main, strategically directed amendment is substantially extending the period within which an appeal for administrative revocation of a granted Eurasian patent can be submitted. The period was originally six months. In 2022, the period was extended to nine months for both invention and industrial design patents; with the recent amendments, the period became three years calculated from the date of EAPO publication of a notice of patent grant. Such amendment very clearly demonstrates the first steps towards establishing a Eurasian

regional patent court system, one of the several ambitious strategic aims that were proclaimed by Dr. Grigory Ivliev, president of the EAPO.

Although being granted as a unitary-type one, a Eurasian patent has countrywide validity and can be challenged and invalidated after expiration of the administrative revocation period with the national patent offices of the Eurasian countries on which territories it is maintained. Its invalidation in one of such countries does not have any effect on validity in others until national invalidation procedures in them

result in the same conclusion. Notably, at the invalidity proceedings on a Eurasian patent at the national patent offices, the latter should apply to Eurasian legislation.

Challenging a Eurasian patent within the administrative revocation procedure is done by submitting to the EAPO an appeal, which initiates invalidity proceedings at the EAPO level and, if the appeal is successful, results in recognizing the granted Eurasian patent invalid in all member-states immediately.

Therefore, the recent elongation of the administrative revocation period to three years may not be unanimously favoured by actual and further Eurasian patent holders exactly because of the possibility of potentially losing a patent immediately and in all Eurasian jurisdictions.

It is clear that by elongating the administrative revocation period, the EAPO was motivated by the desire to ensure authenticity, i.e. by the EAPO itself, applying Eurasian legislation and regulations at the invalidation proceedings – a matter that was raised in a number of court cases in Russia and other member states when invalidity decisions were reverted namely due to the failure of national patent authorities to correctly apply the Eurasian law in invalidity proceeding. Moreover, due to feasibly different regulations and approaches between EAPO and certain national patent offices of the Eurasian member states in special categories of inventions, like selective inventions, polymorphs protection and computer-implemented inventions, it is indeed important that Eurasian law is correctly applied on them in invalidation proceedings.

However, it is also clear that for a large number of patent holders and market competitors, in their international business strategies, split administrative invalidation proceedings would outweigh the attractiveness of centralized proceedings with

the EAPO, which they may not routinely use but by which they receive a higher possibility to immediately lose their own patent in all jurisdictions. Perhaps, like the EPO system with a “sunrise period” for electing the Unitary patent system, the EAPO could also allow a choice for the patent holders between short and long administrative revocation periods to elect.

Second by importance, amendments that have effect from January 1, 2024, relate to industrial design examination and expand the list of revisions that are done by the EAPO examiners in relation to the claimed industrial design at the substantive examination stage, regardless of existing third-party objections against the grant of a Eurasian patent for an industrial design. It is worth remembering that the Eurasian industrial design examination system, in the way it was initially introduced, in substantial part relied on objections of third parties, with a minimal examining role on novelty and originality criteria in absence of such objections. The introduced amendments show the desire of the EAPO to become a full examining authority with regard to industrial designs and by that, to increase the value of Eurasian industrial designs in business turnover across eight Eurasian member-states.

With such new amendments, the EAPO will verify the compliance of the claimed industrial design with novelty conditions based on publicly available information available to the EAPO and information received by the EAPO during substantive examination. Furthermore, starting from January 1, 2024, the EAPO also checks whether a claimed industrial design is identical, confusingly similar to or includes trademarks protected or applied for registration and published in the territory of at least one of the Eurasian member states; is identical, confusingly similar to or includes titles or names of works of science, literature or

art, characters or quotations from such works, works of art or their fragments rights for which exist in the territory of at least one of the Eurasian member states; or represents an article’s design that may mislead the consumer of a product for which such article serves as a container, packaging, or label. A possibility of resolving a dispute through a mediation procedure in the event of an industrial design being identical or confusingly similar to trademarks with earlier priority has been added.

Further amendments that came into force are of a less significant nature and mainly introduce a number of procedural deadlines.

Some fees were also increased to address the past two-year fluctuations of the official currency in which the EAPO accepts payments. However, due to the existing exchange rates with the main world currencies, the rise of the Eurasian official fees appears insignificant compared to the EAPO fees that existed two years ago. 

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Yuri Kuznetsov is a partner and head of the patent practice at Gorodissky & Partners.

He joined the firm in 1999 and in 2002 was promoted to partner. He has led the patent practice since 2014. Kuznetsov represents multinational

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Yuri Kuznetsov



SOUTH AFRICA

Piracy of traditional knowledge: urgent need for equitable solutions

We all identify with our heritage, homes, cultures and traditions. None of us would be happy to see the same misappropriated or exploited by another, lest we lose our identity or claim to what makes us unique.

Traditional knowledge (TK) represents the know-how, skills and practices developed, sustained and passed on from generation to generation within a community. Still, unlike most other forms of intangible cultural heritage, such as rituals and spiritual beliefs, TK can clash damagingly with modern legal systems, finding itself at loggerheads with

national Intellectual Property (IP) frameworks.

Nature's bounty

TK is commonly associated with using diverse plants as home remedies and for various medicinal applications. However, in Southern Africa, different plants also have deeply entrenched spiritual significance, for example, protecting homesteads against lightning and witchcraft. In the community's eyes, using and exploiting such knowledge without asking, not even getting to the issue of offering payment, is tantamount to theft.

Whether termed as theft or biopiracy, it ultimately refers to the same thing – the exploitation of an indigenous group, usually by a multinational corporation that utilizes local practices as a basis to conduct research into the

pharmaceutical properties of a plant. Subsequently, they secure patent protection for a drug derived from this research, which then garners billions in revenue.

The indigenous community would likely have never conducted the pharmaceutical research, development and clinical trials necessary to launch a market-ready drug. Nevertheless, the issue is one of equity. The traditional use of the plant may have initially guided the research in the right direction, resulting in the development of a successful drug with an identified active pharmaceutical ingredient (API).

Cooperation and compromise

Many countries have acknowledged that there is a need for the protection of TK and adequate benefit sharing while also recognizing that the defense

of TK does not have to exclude patentability.

There are many examples of TK from all over the world and how it has been used in developing pharmaceutical products. To cite just a few:

- The Central African people of Gabon and Cameroon have used the brazzein berry for generations to help wean infants by letting them “forget” their mothers’ milk (presumably due to the sweetness of the berries). A U.S. university isolated and reproduced the protein in these berries and was granted three U.S. patents and a European patent, the protein finding extensive application as an artificial sweetener. Since then, there has been no benefit sharing with the indigenous community for this TK. The knock-on effect has been an economic one, causing many local women who drew an income harvesting the berries to lose their jobs.
- In India, the TK of the Kani tribe was used to assist the development of Jeevani, a medicament to alleviate stress and fatigue. Fortunately, India’s patent laws provide protection to indigenous communities. They ensure a benefit-sharing system between the patent holder and the local population achieved through a trust vehicle, which effectively allows the community to share in the profits.
- In South Africa, generations of San people have used the plant *Hoodia gordonii* on hunting trips to suppress hunger and thirst and boost their energy. This appetite suppressant quality would become of huge interest to a pharmaceutical company, which went on to isolate the API and commercialize it as a drug. In contrast to the brazzein precedent,

hoodia was a landmark case for benefit sharing in South Africa, with money held in trust for various San organizations.

These examples illustrate that there have been wins and losses in the fight for benefit sharing and the protection of indigenous communities. Yet, there is still another concern: Where the TK indicates a certain medical use, how can that medical indication be patentable in so much as it meets the basic substantive requirements for patentability, namely, novelty and inventive step?

A place for opposition

This question is less of a concern where mainstream APIs are protected, given that patents applied for by pharmaceutical companies are never directed to the naturally occurring compounds or extracts from the plants. Instead, the development conducted by these companies is geared toward the extraction, purification or artificial production of proteins and the creation of medicaments (including the testing and formulation of the same). Together with carefully crafted patent claims, it is foreseeable that the bar for patentability should be met in such instances, albeit with the possibility that TK may have hinted at a medicinal use.

What happens, though, in the instance of pure natural extracts where the plant’s medicinal use is identified by TK? This was looked at in the “pelargonium cases.” Pelargonium, also called the African geranium, has long been known in South Africa for its potent medicinal properties in treating respiratory illnesses. In this example, issues were raised regarding both biopiracy and the absence of a benefit-sharing agreement between a European pharmaceutical company and the indigenous community.

The company had created a remedy for respiratory diseases and other medications without negotiating with the community.

There were also doubts about the originality of the treatment as it used pelargonium, which suggested a possible lack of inventiveness on the part of the company. The European Patent Office (EPO) allowed for revocation on the basis of a lack of inventive step, thereby proving a direct interplay between TK and the patent process.

Work still to be done

The TK invalidated the patent, yet one must wonder if this was a true victory. With the TK appropriated and the chance for a benefit-sharing arrangement lost, the community found itself no better off. Whilst IP can serve indigenous peoples and benefit them in a virtuous environment, it would, unfortunately, seem as though pirates are still all too common.

In the absence of regulatory oversight, it is up to drug manufacturers and legal practitioners to wield the patenting system not as a cudgel against local communities nor as a barrier but as a tool to unite the traditional and the modern worlds in a spirit of fairness and mutual betterment. ^{AIIP}

ABOUT THE AUTHOR

Robyn-Leigh Merry is registered to practice as a patent attorney before the South African Patent Office and is also an attorney at law and notary public admitted before the High Court of South Africa. She combines her legal knowledge with a technical background in molecular and cellular biology. Since establishing Dennemeyer & Associates’ South African office in 2017 with her colleague, Christophe van Zyl, Robyn-Leigh Merry has been a joint partner, overseeing operations and fulfilling the needs of clients based on and off the continent.



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COMPETENCE

It would be easier to ascertain exact competence of a firm by, e.g. 1) sending it a pending or granted patent for its comments about how it can improve the claims, 2) sending it a pending patent specification without the claims for it to draft the claims for the client's comparison with the original claims, or 3) sending to it and the firm the client is currently using at the same time an initial disclosure so that the client can compare and find out which firm can provide the better claims. This firm welcomes such challenges.



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