2024 AsiaIP AWARDS TOASTING THE WINNERS

AsiaIP

LEADING THE CONVERSATION

DECEMBER 2024 - JANUARY 2025 • VOLUME 17 ISSUE 1

Apex Asia

15 THINGS COMPANIES SHOULD START DOING IN 2025 TO BETTER LEVERAGE THEIR IP FOR BUSINESS GROWTH

ASIA STRENGTHENS IP PROTECTIONS AMIDST GROWING TECHNOLOGICAL INNOVATION

The legal playbook of Schedule A: Tactics of intellectual property litigation

PIKACHU WITH GUNS? NINTENDO FIRES BACK

PROTECTING INNOVATION IN THE REAL ESTATE INDUSTRY

VIETNAM'S IP COURT READY TO TAKE OFF

ANAND & ANAND

ANAND AND ANAND

PRACTICE AREAS

Patents | Litigation and Dispute Resolution | Trademarks | Designs

Art and Antiquities | Competition | Antitrust | Compliance | Regulatory

Plant Variety | Biodiversity | Contractual and Commercial IP | Copyrights

IT law and Domain name disputes | Sports law | Fashion and Luxury law

Media and Entertainment law | Licensing and Franchising | Advertising law

Anti-Counterfeiting | Criminal law | Customs and Border Enforcement

+91-120-4059300 +91-120-4243056 – 058 email@anandandanand.com www.anandandanand.com

NOIDA | NEW DELHI | MUMBAI | CHENNAI | BENGALURU

CONTENTS

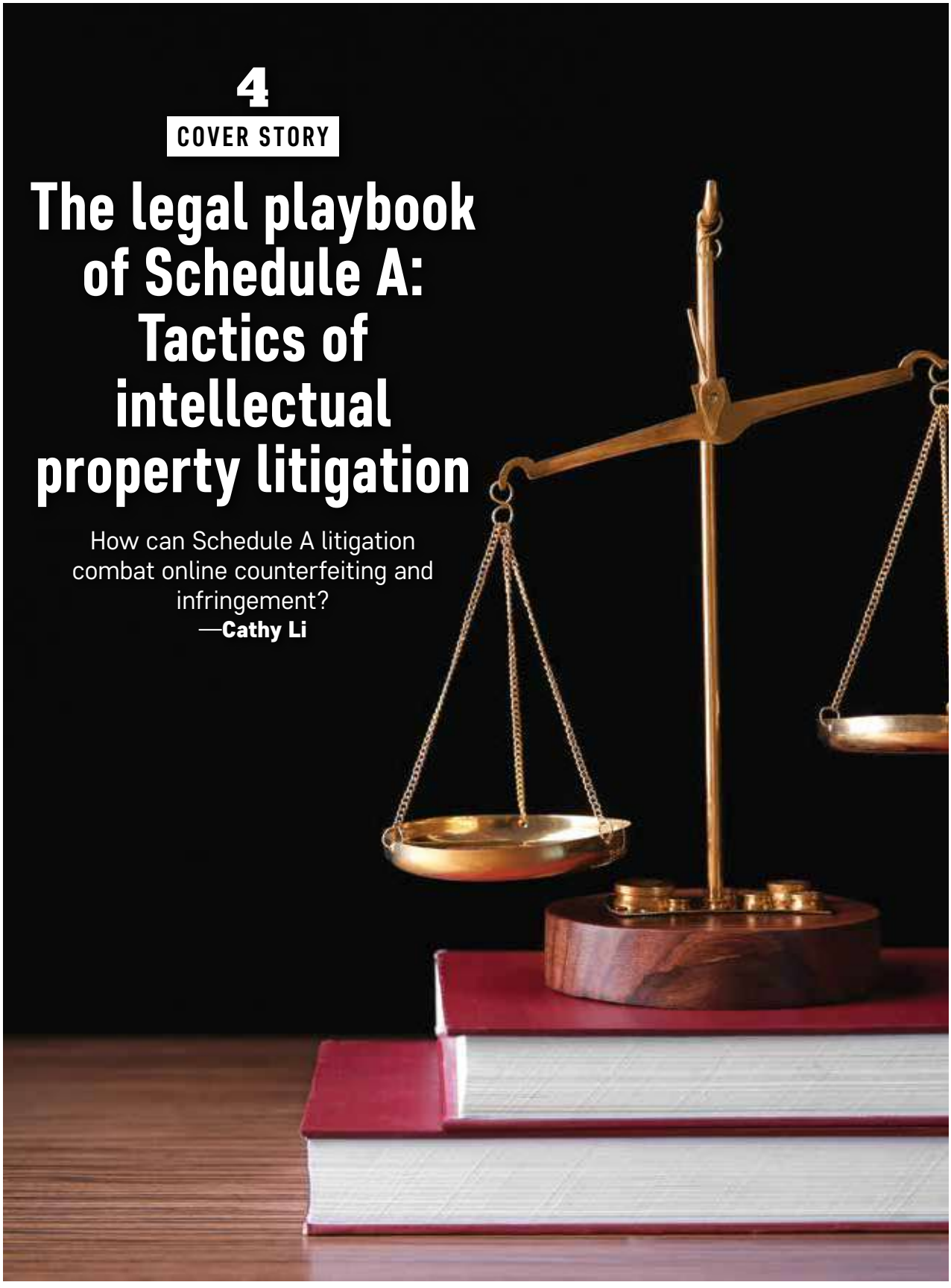


TABLE OF CONTENTS

AsiaIP
LEADING THE CONVERSATION

DECEMBER 2024 - JANUARY 2025
VOLUME 17, ISSUE 1
ISSN: 2072-3229

MANAGING EDITOR
Gregory Glass
T: +852 3749 9558 E: gglass@asiaiplaw.com

STAFF WRITERS
Espie Angelica A. de Leon
E: gdeleon@asiaiplaw.com

Excel Dyquiangco
E: edyquiangco@asiaiplaw.com

Cathy Li
E: cli@apexasiamedia.com

SUBEDITOR
Kristin Jerome Reyna

CREATIVE DIRECTOR
Richard Arroyo

GRAPHIC DESIGNER
Raymund Escat

HEAD OF BUSINESS DEVELOPMENT
Patrick Chu
E: pchu@asiaiplaw.com

BUSINESS DEVELOPMENT MANAGER
Isaac Man
E: iman@asiaiplaw.com

CONTRIBUTORS
Anju Agrawal, Vladimir Biriulin
Editha R. Hechanova, Dinesh Kumar
Denise Mirandah, Vaishali R. Mittal
Dmitriy Ratnikov, Manisha Singh
Pankaj Soni

DIGITAL MEDIA AND EVENTS EXECUTIVE
Yang Mo

OFFICE MANAGER
Edna Chow

PUBLISHER
Darren Barton
T: +852 3996 9540 E: dbarton@asiaiplaw.com

CONTACT US

EDITORIAL
E: editorial@asiaiplaw.com

SUBSCRIPTIONS/CUSTOMER SERVICE
E: cs@asiaiplaw.com

ADVERTISING
E: enquiries@asiaiplaw.com

PUBLISHED BY

Apex Asia

Apex Asia Media Limited
21/F Gold Shine Tower
346-348 Queen's Road Central Hong Kong

T: +852 3996 9540
E: enquiries@asiaiplaw.com
W: www.asiaiplaw.com
© Apex Asia Media Limited 2025

DISCLAIMER

The copyright of this magazine is held by the publisher. No part may be reproduced, copied, or stored in a retrieval system without the prior written consent of the publisher. The material in this magazine does not constitute advice and no liability is assumed in relation to it. The views expressed in this magazine are the views of the respective authors, and do not necessarily reflect the views of the publisher, its staff, or members of the editorial board.

Suing by email

Chinese ecommerce sellers are finding themselves targeted by intellectual property owners in the United States, unaware of lawsuits against them until a ruling has been issued, closing their U.S. bank accounts and instantly shutting down their online storefronts.

The complaint does not identify specific wrongdoings or name any individual defendants. Instead, it claims ownership of copyrights, trademarks or patents and includes a list that identifies dozens or even hundreds of defendants who sell products online. If defendants do not appear, the plaintiff obtains a final judgment for US$150,000, disgorgement of frozen funds and the closure of accounts.

"As defendants, sellers often operate independently, compete with each other, without any collaboration. Plaintiffs always improperly group them based solely on selling similar items, failing to show a direct connection between the defendants' activities," Barclay Jiang, a partner at Beijing Qinghui Law Firm and Tsingyuan Hui IP Agency in Beijing and a patent attorney in both New York and Beijing, told our Cathy Li, who reports from Shenzhen on this judicial balancing act.

"We have many links, and due to this issue with one link, their lawyer applied to freeze all links in our store, freezing the entire store," said a Chinese Amazon seller, expressing one of their frustrations to *Asia IP* over the legal actions taken against their store. They received a temporary restraining order (TRO), followed by a preliminary injunction. The seller emphasized that freezing a single link should not lead to the entire account being frozen, as it causes significant operational losses.

Li explores this issue from the sides of both the IP owners and the ecommerce sellers, and how it could affect steadily rising ecommerce sales from China to the rest of the world.

The online version of this story marks our launch into using video on our website, so don't miss your chance to visit www.asiaiplaw.com to see and hear some of the Amazon sellers, and their lawyer.

• • •

Elsewhere in this issue, we celebrate the winners of the 2024 *Asia IP* Awards at Blackbird Restaurant in Manila. Blackbird is located in Nielson Tower on the site of Manila's first international airport. The evening honoured 59 firms from 21 Asia-Pacific jurisdictions. Photos of the evening are in this issue. Make plans now to attend next year's event in Kuala Lumpur!

Darren Barton
PUBLISHER

Gregory Glass
MANAGING EDITOR

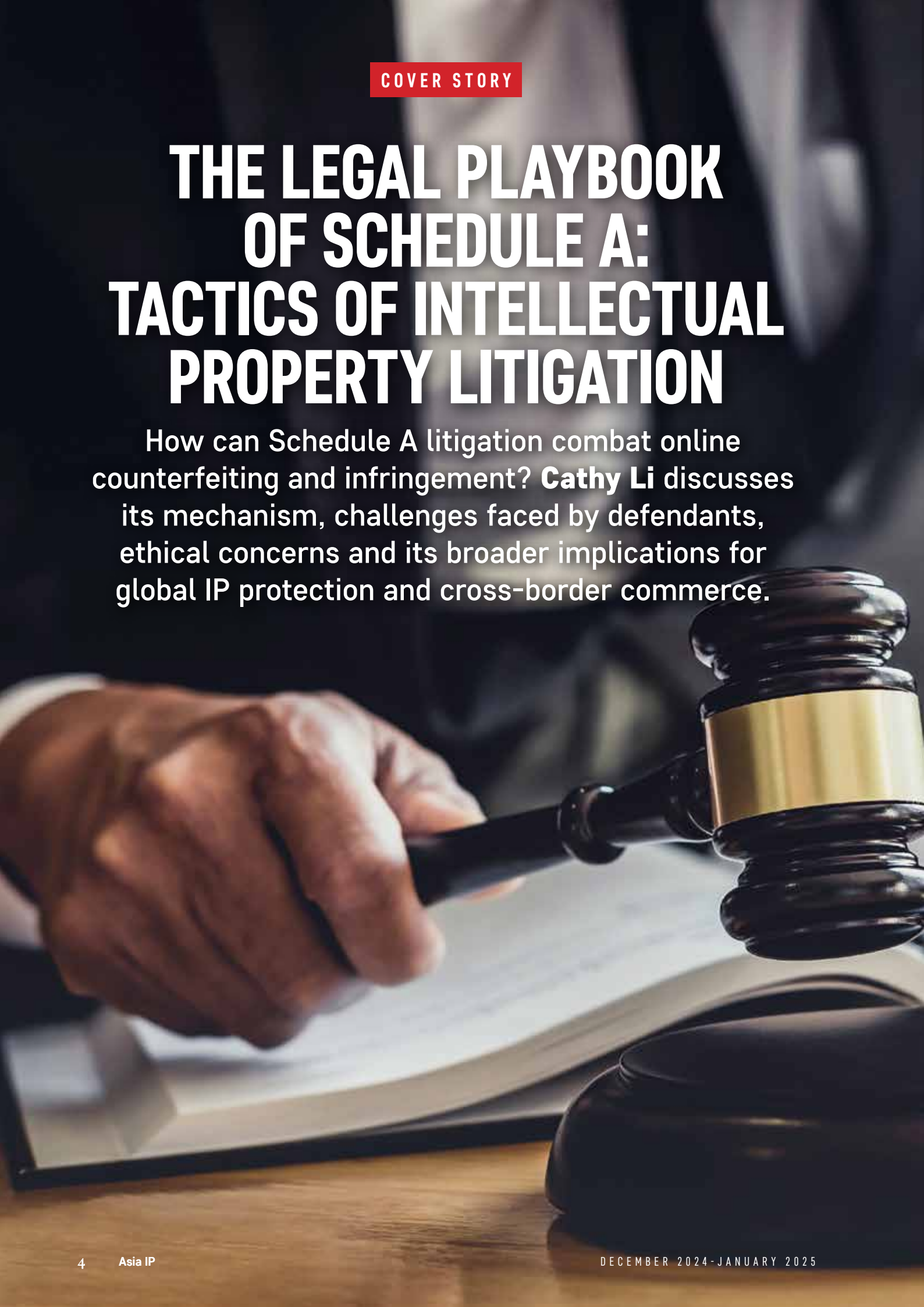
SUBSCRIBE TODAY

Asia IP is published 10 times per year, with subscriptions costing US$595 per year. To subscribe, use one of the following channels
Subscribe at www.asiaiplaw.com to start your subscription immediately Call +852 3996 7152 enquiries@asiaiplaw.com
Subscribe today to gain the intelligence you need to protect your IP assets in Asia

COVER STORY

THE LEGAL PLAYBOOK OF SCHEDULE A: TACTICS OF INTELLECTUAL PROPERTY LITIGATION

How can Schedule A litigation combat online counterfeiting and infringement? **Cathy Li** discusses its mechanism, challenges faced by defendants, ethical concerns and its broader implications for global IP protection and cross-border commerce.



Sealed files stack high on the desk of the U.S. District Court for the Northern District of Illinois, each a catalyst in the battle against intellectual property theft. Behind their labels lies a relentless game of strategy thriving in the shadows of ecommerce.

In these cases, identities are rarely straightforward. Defendants, cloaked in aliases and scattered across the internet, are listed collectively in Schedule A. Plaintiffs, just as cautious, often file entire complaints under seal, seeking to outmaneuver counterfeiters poised to dismantle and rebuild their operations at a moment's notice.

Each file opened sets the stage for swift action. If defendants do not appear, the plaintiff obtains a final judgment for US$150,000, disgorgement of frozen funds and the closure of accounts, according to Baruch S. Gottesman, the U.S. counsel representing the defendants in the *Zhaoyou Chen v. Partnerships and Unincorporated Associations Identified on Schedule A* case. Temporary restraining orders (TROs) can instantly shut down online storefronts. It's a judicial tightrope walk where every ruling echoes across the battlefield of global ecommerce.

Many defendants remain unaware of lawsuits against them until judges issue TROs that freeze their U.S. bank accounts and shut down their online stores. At this point, defendants often find themselves with no choice but to agree to undisclosed settlements.

The complaint does not identify specific wrongdoings or name any individual defendants. Instead, it claims ownership of copyrights, trademarks or patents and includes a list – a "Schedule" – that identifies dozens or even hundreds of defendants who sell products online.

"As defendants, sellers often operate independently, compete with each other, without any collaboration. Plaintiffs always improperly group them based solely on selling similar items, failing to show a direct connection between the defendants' activities," said Barclay Jiang, a partner at Beijing Qinghui Law Firm and Tsingyuan Hui IP Agency in Beijing and a patent attorney in both New York and Beijing.

As these techniques protect intellectual property, they are potentially becoming a way to seek profit. The nature of Schedule A cases, which can be served through email and give defendants less than a month to appear, presents challenges to defendants.

"We have many links, and due to this issue with one link, their lawyer applied to freeze all links in our store, freezing the entire store," said a Chinese Amazon seller, expressing one of their frustrations to *Asia IP* over the legal actions taken against their store. They received a TRO, followed by a preliminary injunction (PI). The seller emphasized that freezing a single link should not lead to the entire account being frozen, as it causes significant operational losses.

Despite resolving issues, sellers worry about Amazon's new policy on repeated account health violations. Introduced in October 2024, this policy could lead to account suspension or closure if a seller repeatedly violates the same policy within 180 days.

"From Amazon's perspective, they want to better control sellers and reduce the frequency of performance issues and violations. However, from our perspective, we do not frequently violate rules. But we are concerned that if we step on a landmine again, the performance issue from the first case has not been removed, it will count as a repeated violation," the Chinese Amazon seller told *Asia IP*, highlighting that the fight is not over for them.

Rules of Schedule A

Schedule A litigation, now widely used in the Northern District of Illinois, has emerged as a critical legal mechanism for intellectual property owners to combat online counterfeiting and infringement. The cases are filed under seal, allowing plaintiffs to secure TROs that freeze Amazon Standard Identification Numbers (ASINs) and associated funds without notifying defendants in advance. This secrecy ensures that alleged infringers cannot relocate assets or modify listings, giving plaintiffs a strategic advantage.

According to Santa Clara University law professor Eric Goldman and Chicago-Kent College of Law professor Sarah Burstein, the strategy reveals a sophisticated yet underreported system of mass-defendant intellectual property litigation known as the Schedule A Defendants Scheme (SAD Scheme).

Predominantly occurring in the Northern District of Illinois, this "scheme" primarily targets online merchants based in China. The SAD Scheme exploits vulnerabilities in the Federal Rules of Civil Procedure, judicial deference to IP rights owners and the liability exposure of online marketplaces.

"Most judges allow hundreds of unrelated defendants in a single lawsuit, and almost all judges decide motions on the papers and allow virtual appearances," said Gottesman.

The Northern District of Illinois is a preferred venue for Schedule A litigation due to its specialized expertise in managing complex ecommerce cases. Judges in this district have established a reputation for consistent and efficient rulings, making it an attractive jurisdiction for intellectual property enforcement. The quick adjudication of these cases further solidifies its standing as a hub for addressing widespread online infringement.

The Schedule A filing system capitalizes on modern interpretations of the Federal Rules of Civil Procedure that have come to recognize the difficulty in finding or serving parties outside of the United States.

Eunice Yan, a senior partner at Zhiheng Law Firm in Shenzhen and a local counsel advising some of the defendants in the *Zhaoyou Chen v. Partnerships and Unincorporated Associations Identified on Schedule A* case, told *Asia IP*: "The defendants need to engage with these cases. The defendants need counsel in the United States to fight these cases." She expressed that this is another challenge Chinese defendants may need to overcome.

The defendants faces multiple obstacles. In Case No. 1:24-cv-07164, some are claiming there is no infringement, while others are seeking an answer from the plaintiff but have not received a proper response to resolve the matter. Legal tactics in Schedule A cases also highlight some ethical concerns. In cases involving patents, for example, defendants often face accusations of infringement based on designs that bear minor similarities to the plaintiff's product.

"The plaintiff compared each of the defendant's patent pictures one by one, and when it came to me, he claimed the connector of my tube has ribbed patterns just like his. His patent has a ribbed pattern on the exterior of the tube; however, ours did not, and he claimed ours did," one of the defendants, Yu, told *Asia IP*, explaining that his adapter's patterns also served different purposes.

"We sold this product around 2019; he registered his patent in 2020, and in 2021, it was approved. We also have not seen this product on the market at the time," Yu added. He pointed out that the plaintiff's patent and his own demonstrated similar products, but the specific designs served different purposes, arguing that it does not constitute infringement. Yu also claimed to have never seen the plaintiff's product on the market when his product was sold in 2019.

In the realm of intellectual property, there are instances where legal experts exploit gaps in the system to their advantage. For example, in the United States, there is a one-year grace period for patent applications. This means that after a product is publicly disclosed, the inventor has one year to file for a patent. However, if the original inventor fails to apply within this period, others can potentially file for the patent themselves, capitalizing on the inventor's oversight.

This situation often arises when a product is already on the market but has not been patented by its creator. Observing the product's success, another party might step in and file a patent application, effectively claiming the rights to the invention. This practice, while legally permissible, raises ethical questions about the exploitation of the grace period.

In the United States, the U.S. Patent and Trademark Office (USPTO) allows a one-year grace period from the earliest date of public disclosure to file a patent application. This grace period applies to both utility and design patents and is available only for the inventor's own prior public disclosures, not for those made by others.

Tactics using Schedule A litigation blurs the line between strategic exploitation of legal provisions and outright bad faith. Critics argue that such practices undermine the spirit of intellectual property laws, which aim to reward true innovation rather than opportunistic maneuvering.

In the context of Schedule A litigation, these legal grey areas are often amplified. Defendants like Yu, for example, face significant hurdles in proving non-infringement when the plaintiff's claims hinge on seemingly minor design similarities. Yu's assertion that his product predates the plaintiff's patent application highlights a broader issue: the potential for abuse of the grace period by parties seeking to weaponize intellectual property laws against legitimate competitors.

Adding to the complexity, defendants in these cases often lack the resources or expertise to navigate the intricacies of U.S. patent law, particularly when faced with procedural advantages such as sealed filings and TROs. As Yan pointed out, Chinese defendants must overcome not only legal challenges but also logistical

barriers, including the need to retain U.S.-based counsel and contend with unfamiliar legal norms.

Defendants strike back

Recent developments in Case No. 1:24-cv-07164 highlight a shift in the narrative. "In some ways, this case is most unusual because the defendants are fighting back, rather than quickly settling on unfavourable terms," Yan told *Asia IP*. She explained that there are several unusual factors.

In this case, the court rejected the plaintiff's motion for a preliminary injunction, citing procedural missteps, including a failure to release frozen funds in a timely manner. The judge also raised concerns about the patent's legitimacy, given its connection to a notorious patent "house" implicated in fraudulent filings, which had led the USPTO to cancel over 3,000 related applications.

"It is also unusual because the patent was obtained through a patent 'house' that turns out to have engaged in very problematic filings. The USPTO (U.S. Patent Authorities) cancelled more than 3,000 applications from that firm. Some Defendants have argued that the patent in this case should also be cancelled," Yan told *Asia IP*.

The USPTO issued a final order to terminate proceedings for approximately 3,100 patent applications due to an unauthorized individual's fraudulent use of practitioner Jie Yang's S-signature, an electronic signature format permitted by the USPTO. The scale of the fraud has drawn attention to the importance of maintaining security over practitioner credentials and ensuring compliance with patent rules.

> Defendants have produced evidence indicating that they have lost a total of $62,771.00 due to their accounts and products being frozen by Amazon. Plaintiff does not contest this evidence. Therefore, the Court orders Plaintiff to pay Defendants $62,711.00.

Image courtesy of Eunice Yan

Gottesman explained that for early Schedule A cases, the plaintiff's motive is to protect their brand and punish infringers to clear the market. Settlements are discretionary, especially for premium brands like the NBA or Nike. However, for non-practicing entities (NPEs), also known as patent trolls, the plaintiff's motive is often to secure cash settlements from defendants, source products from the plaintiff and eliminate competitors.

According to Gottesman, there has been a significant increase in Schedule A cases involving Chinese plaintiffs since 2019. During the pandemic, most of these cases involved trademark or copyright infringement. "Schedule A cases have been successful," Gottesman said, attributing this success to the rising number of such cases, including those filed by Chinese plaintiffs.

"The success of earlier Chinese plaintiffs has

"Defendants often don't share legal strategies, weakening their ability to present a cohesive defence. Without joint efforts, smaller defendants may struggle against well-funded plaintiffs, leading to settlements or default judgments, even if the claims are weak."

—**BARCLAY JIANG**, partner, Beijing Qinghui Law Firm, Beijing

"In some ways, this case is most unusual because the defendants are fighting back, rather than quickly settling on unfavourable terms."

—**EUNICE YAN**, senior partner, Zhiheng Law Firm, Shenzhen

"Often, it seems like they are producing according to popular trends without having first-hand information about consumer behaviours. But making a product from an idea is incredibly difficult and requires a lot."

—**CHAO ZHANG**, head, legal services department, Shenzhen Cross-Border E-Commerce Association, Beijing

encouraged others to pursue similar actions, showing that the U.S. legal system can be an effective way to protect their rights," Jiang said.

While the rise in Schedule A cases points to a growing trend of aggressive legal action by Chinese plaintiffs, the dynamics on the defendant's side complicate the landscape. As Jiang noted, the defendants' fragmented approach adds to the challenges they face in countering these claims.

"Defendants often don't share legal strategies, weakening their ability to present a cohesive defence. Without joint efforts, smaller defendants may struggle against well-funded plaintiffs, leading to settlements or default judgments, even if the claims are weak," Jiang added.

The defendants see their actions as a necessary response to systemic challenges. However, this case could reshape industry norms, influence future legal strategies and change the balance of power in similar disputes. These cases are not just isolated legal battles; they reflect changes in cross-border commerce, especially for manufacturers and small businesses dealing with intellectual property rights and online sales.

Broader implications

"China is a manufacturing powerhouse, the world's largest producer of goods. With so many products (if you want to export them) and traditional large-scale trade declining, cross-border ecommerce becomes the simplest way forward. You look at what sells well, and you sell that to minimize risk," said Chao Zhang, the head of the legal services department at the Shenzhen Cross-Border E-Commerce Association in Beijing.

According to Zhang, it is likely that many individuals behave in this manner due to a lack of clear awareness. In some cases, people do not fully understand how to protect their intellectual property rights. Consequently, many people do not apply for patents, or the patents they hold have expired or are invalid. Additionally, some individuals apply for patents in China but do not extend these applications to international jurisdictions.

"While it's not as challenging to make a new trademark, you only have a few product types and designs. From this perspective, patent protection is much stronger," said Zhang, explaining that in the field of cross-border ecommerce, patent protection is crucial for small- and medium-sized sellers.

"Often, it seems like they are producing according to popular trends without having first-hand information about consumer behaviours. But making a product from an idea is incredibly difficult and requires a lot," Zhang told *Asia IP*.

The traditional manufacturing model in China has been largely reactive, focusing on the mass production of trending items rather than proactive innovation. However, the rise of ecommerce is changing this landscape. Ecommerce platforms offer factories a direct line to consumer shopping styles and demands, enabling them to make real-time adjustments to their products. This shift not only enhances the relevance of their offerings but also opens new avenues for protecting their innovations through IP rights.

According to the National Bureau of Statistics of China, online retail sales reached Rmb14 trillion (US$1.9 trillion) in the first 11 months of 2024, reflecting a 7.4-percent increase compared to the same period in 2023. Sales of physical commodities rose by 6.8 percent, while online sales of kitchen hoods and smart home devices saw significant year-on-year growth of 62.7 percent and 22.2 percent, respectively. Additionally, sales of services increased by 18.3 percent, with takeaway deliveries and tourism services experiencing growth rates of 48.2 percent and 18.2 percent, respectively.

Data from the Ministry of Commerce of China shows that sales of industrial ecommerce platforms with a scale above Rmb10 billion (US$1.4 billion) rose steadily from January to November 2024.

"Nowadays, ecommerce gives factories the chance to be at the forefront of consumer shopping styles and demands and make changes accordingly," Zhang continued. "All of this can be protected by intellectual property. Factories now have access to sales channels that provide valuable insights into consumer preferences, allowing them to innovate and protect their creations."

Ecommerce and IP protection are boosting innovation in Chinese manufacturing, allowing factories to create products that connect with consumers. Schedule A litigation helps fight intellectual property theft in ecommerce by using tools like sealing filings, TROs and injunctions. Though it can be tough on defendants, especially those outside the jurisdiction, and raise ethical concerns, it remains a crucial method to protect IP in the fast-moving online market.

15 things companies should start doing in 2025 to better leverage their IP for business growth

Intellectual property strategies are vital for business growth. ***Espie Angelica A. de Leon*** highlights key priorities for 2025.

Resolutions are a staple of every New Year. Some resolutions are fulfilled, some are not, ending up merely as lip service by someone excited by the new slate readily available on New Year's Day.

For enterprises, resolutions involving their businesses should not merely be lip service. Business is business and profits, growth, expansion, customer service and whatnot are an indelible part of it. Companies should therefore take their New Year's resolutions seriously.

Asia IP spoke with five IP lawyers around the region and asked them for the most important IP-related things that companies should start doing in 2025 to better leverage their IP assets and further enhance business growth. In short, we asked them the best New Year's resolutions that enterprises should have for 2025 in terms of their IP.

Here are their suggestions:

Take stock of your IP assets.

List your non-physical assets. Determine which ones are IP assets and which are not. "Pay special attention

to your intangible assets including colour scheme, tag lines, images, packaging, shape and other features that help to distinguish your products from the competitors," said Ranjan Narula, managing partner at RNA Technology and IP Attorneys in Gurugram.

Then, rank them according to each one's contribution to your company's value.

After making an inventory of your IPs, check whether you have secured registrations for each one, including industrial designs and utility models. For trade secrets, develop a system that will make their disclosure or discovery remote – whether via non-disclosure agreements or by providing limited access.

Do an IP audit and health check.
Are the registrations in active condition? You may have to streamline by giving up outdated IP. Doing this will also allow you to save on maintenance costs.

Check on any developments in the last 12 months or any upcoming or proposed ideas in the coming 12 months. These might require further protection. "Was there a new product that took off in 2024? Was it protected? Have they never filed patents? Maybe they have grown and developed innovations that warrant another rethink to include patents in their portfolio," said Audrey Yap, managing director at Yusarn Audrey & Partners in Singapore.

Review any IP rights due for renewal in the coming 12 months. Assess whether the IP right should be protected. "If trademarks are due for renewal, consider whether there have been changes in the trademark as used which might require a new application. If the trademark as used 'alters the distinctive character of the trade mark' or 'substantially affects the identity of the trade mark,' then that use may not save the registration from third party attack in New Zealand or Australia respectively," Elena Szentiványi, a director at Henry Hughes Intellectual Property in Wellington, disclosed.

Value your IP.
According to Editha Hechanova, president and CEO of Hechanova and Co. and managing partner of Hechanova, Bugay, Vilchez & Andaya-Racadio in Manila, access to funds needed for growth and expansion is a common and recurring problem for business enterprises.

"The Philippine government has issued a number of laws that allow IPs to serve as collateral for loans, but banks have been reluctant to accept these as collaterals due to a lack of capacity to value or rely on the IP valuation submitted to it. Business enterprises should have their IPs valued. There are IP practitioners who provide IP valuation service," Hechanova revealed.

The Intellectual Property Office of the Philippines (IPOPHL) is also currently boosting its capability to do IP valuation. Additionally, IP owners may seek the assistance of the Technology Application and Promotion Institute of the Department of Science and Technology in Manila.

Rethink your monetization strategy.
Explore IP licensing and franchising.

"Is it time to truly relook at monetizing what [you] have? Should [you] consider IP financing to support [your] business expansion or fund [your] next R&D for newer, better products? Today, debt financing using IP is very real; don't just rely on equity financing. We support many in this phase of growth, and inadvertently, the companies are surprised it can be done! Ask the right questions and maybe [you] can release value streams [you] had not considered possible," Yap shared.

Review your agreements regularly.
Check out the wording of contracts, agreements and guidelines for your employees, contractors, vendors and strategic partners. Make sure everything is expressed clearly, including ownership of IP.

"Have clear IP creation and assignment terms in your employment, contractor and work-for-hire agreements to ensure that all current and created IP is owned by your company and not by other parties," said Darani Vachanavuttivong, managing partner and managing director at Tilleke & Gibbins in Bangkok.

Ensure that non-disclosure obligations are in place during the product creation stage.

Make this a regular practice. Most especially, do this ahead of public announcements of trade shows, product launches, investor showcases and the like.

Keep records.
Prioritize making use of your IP, particularly your trademarks. In many jurisdictions, continuous non-use of a trademark for three years may result in removal from the Register. If a party files a non-use action, you have to prove you have been using your trademark. If you need to enforce your rights, your IP advisor is likely to request information about the use of that IP right.

"In both scenarios, your good record-keeping skills will make the process more streamlined. Save copies of your marketing and promotional plans, capture examples of use of the mark particularly in advertising, sale numbers for each market by financial year, names of authorized partners and any examples of customers due to third-party activity," said Szentiványi.

Ensure your IP rights are properly protected. Monitor for third party use.
It is always good practice to perform online research using any search engine and IP register searches to check if any party or anybody is encroaching on your rights or whether you are infringing any third-party rights. Don't forget to include image searches for your logo marks and product designs. Do this regularly.

This is especially important whenever your company has a new business strategy or is aiming for market expansion. For example, if you are launching a new product line or entering a new market, make sure to undertake IP register searches first, both in your local and export markets, prior to your launch or new market entry.

"Was there a new product that took off in 2024? Was it protected? Have they never filed patents? Maybe they have grown and developed innovations that warrant another rethink to include patents in their portfolio."

—**AUDREY YAP**,
managing director,
Yusarn Audrey & Partners,
Singapore

"Every leader of a business enterprise wants its organization to succeed and earn profits, but how to do, maintain and grow it, and satisfy its stakeholders is the pressing concern. What is the value of your company to your customers? Is it the superior quality of your products or services?"

—**EDITHA HECHANOVA**,
CEO, Hechanova and Co.,
Manila

"Pay special attention to your intangible assets including colour scheme, tag lines, images, packaging, shape and other features that help to distinguish your products from the competitors."

—**RANJAN NARULA**,
managing partner, RNA Technology and IP Attorneys, Gurugram

"Have clear IP creation and assignment terms in your employment, contractor and work-for-hire agreements to ensure that all current and created IP is owned by your company and not by other parties. "

—**DARANI VACHANAVUTTIVONG**, managing partner, Tilleke & Gibbins, Bangkok

"Rebranding is expensive, so is defending your right to make or market a particular product in the face of third-party action. Investing the time and money to make sure that you can safely launch a new product or brand or enter a new market is time and money well spent."

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

"Keep a close eye on ecommerce platforms and social media platforms for IP infringement and take timely action to protect your market share," reminded Narula.

"Rebranding is expensive," Szentiványi emphasized, "so is defending your right to make or market a particular product in the face of third-party action. Investing the time and money to make sure that you can safely launch a new product or brand or enter a new market is time and money well spent."

Next, consider the timing of your applications. In several jurisdictions, registration can take 12 months or more. Therefore, it is important to develop a plan to ensure that the timeline for your IP application aligns with your company's product timeline.

"Finally, increase your competitive edge by keeping an eye out for competitor announcements and media releases about upcoming products and launches to keep your finger on the pulse," added Szentiványi.

Adapt your IP strategies to fast-paced technological changes.
This will ensure resilience and leverage growth opportunities.

Regularly review your IP strategy.
Make sure it continues to support your strategic goals.

"Every leader of a business enterprise wants its organization to succeed and earn profits, but how to do, maintain and grow it, and satisfy its stakeholders is the pressing concern. What is the value of your company to your customers? Is it the superior quality of your products or services? Is it your price or the attendant freebies that go with each purchase? Is it the attentiveness of your staff – always ready to assist with a smile? An evaluation of your business and how you stand against your competitors would lead you to create an IP strategy or assess what you have now that aligns with and supports your business strategy," explained Hechanova.

Be alert to security issues.
Scam warnings, nefarious marketing and behaviour, unsolicited invoices, requests for payment, unexpected notifications or information-sharing relating to your IP – these are common place so be suspicious.

"IP security is no joke. In December 2024, the Trans-Tasman IP attorneys' board warned IP rights holders, IP professionals and attorneys about a new scam involving an unknown actor contacting Australia and New Zealand IP rights holders fraudulently purporting to be a registered IP attorney demanding that action be taken and money paid," related Szentiványi.

Hence, before taking any action, verify requests first. Check the accuracy of contact details, web addresses and account details before arranging payment. If in doubt, seek advice from your IP advisor. If appropriate, report the activity to your local IP office or your government fraud office.

Also, disable a resigned employee's access to files and online services. Do this as well for an employee who has changed positions within the organization. Update passwords and access to password storing services. Do these before the employee's resignation or before he gets the chance to commit IP theft. It can be more damaging to the company if the departing employee is transferring to a competitor.

Harness the power of AI.
"Implement AI-driven technologies that can streamline IP management processes, IP monitoring, infringement detection and improve efficiency," said Vachanavuttivong.

"Use AI to watch competitors and analyze industry trends in terms of innovation, branding activity and new product launches," Narula added.

Train your employees.
Educate them about the significance of IP and their role in protecting the company's IP. Make them aware of your company's procedures for addressing potential infringement of IP rights. Training should be comprehensive.

Make sure your contact details are correct and up to date.
Has your company rebranded and changed its business name? Has your office relocated? Or have you acquired or sold IP rights?

New information about your business such as these should not be set aside. Be diligent with regard to such details. Don't wait until an imminent deadline to ensure the correct information is recorded on the relevant IP Register and that your attorney has your new contact information.

"Not all IP deadlines can be extended. It would be unfortunate to miss an opportunity or lose a right only because correct contact details were not recorded," Szentiványi reminded.

Automate.
Automating your processes will save your company time and money. To make your business agile, have SOPs in place.

Set reminders for upcoming deadlines.
For upcoming deadlines, set reminders at least one month in advance. Some deadlines can be extended, but this adds to the time and costs incurred.

May these proposed New Year's resolutions come in handy for enterprises at this time of the year as they rethink their strategies and cook up new ways to grow their business and strengthen their market position this 2025 and beyond.

ASIA STRENGTHENS IP PROTECTIONS AMIDST GROWING TECHNOLOGICAL INNOVATION

As intellectual property protection across Asia undergoes significant legal changes, ***Excel V. Dyquiangco*** discusses how regions commit to adapting IP laws to meet demands of a dynamic global environment.

Intellectual property protection across Asia is undergoing significant transformations as various jurisdictions adapt to the rapidly evolving technological landscape.

The introduction of text and data mining exceptions in the copyright regime in jurisdictions such as Singapore, as well as the ongoing considerations in Hong Kong, fosters the development and adoption of artificial intelligence (AI) systems by enabling these systems to access vast amounts of training data.

In mainland China, the courts have made high-profile rulings in the past year on cases at the intersection of AI and intellectual property rights. Beyond recognizing the subsistence of copyright in AI-generated works, the courts have also addressed instances of infringement of copyright and other related rights by AI-generated content, reinforcing the importance for businesses to maintain lawful practices in the rapidly evolving landscape of AI and IP. In addition, in tangent with the adoption of the new World Intellectual Property Organization (WIPO) Treaty on Intellectual Property, Genetic Resources and Associated Traditional Knowledge in May this year, there is now renewed enthusiasm for the protection of genetic resources and traditional knowledge. For example, as part of China's 2024 IP Powerhouse National Development Plan, the government plans to draft regulations on the management of access to

genetic resources and benefit-sharing and to advance the legislative process for protecting the traditional knowledge of traditional Chinese medicine.

"A number of Asian jurisdictions are updating their copyright laws to facilitate AI adoption. Singapore's new Copyright Act, which was enacted in November 2021, includes a new computational data analysis exception, which enables the use of copyright works for commercial and non-commercial text and data mining purposes," said Sher Hann Chua, managing associate at Linklaters in Singapore. "Hong Kong is also mulling an amendment to its Copyright Ordinance to include text and data mining exceptions."

She added: "Also in the field of music, as music markets continue to glocalize, we are also witnessing an emerging trend in music catalogue acquisitions in the region by both private equity and strategic buyers. This underscores the growing importance of understanding the complexities of the local copyright landscape in different jurisdictions, particularly as AI becomes more prevalent in the global entertainment industry."

Legislative changes

As several countries across the continent establish themselves as centres of creativity and technological innovation, there is a marked rise in legislative reforms and stronger enforcement measures. In India, this trend is evident in the surge of IP filings, the creation of specialized IP divisions and the implementation of stricter penalties for infringement.

- **Increase in IP filings.** India has witnessed a remarkable surge in IP filings over the past few years, with the country ranking third globally in trademark filings at the Indian IP Office, sixth for patents and 11th for design applications as of 2022. The rise in patent filings from 2022 to 2023 was particularly sharp – 24.6 percent over the previous year. In a similar vein, design filings in India have skyrocketed 165 percent since 2013 despite the worldwide increase in the same period being only 19.8 percent. In addition, WIPO's recent report "Patent Landscape Report on Generative Artificial Intelligence" stated that India ranks fifth globally (behind China, the U.S., the Republic of Korea and Japan) in terms of the number of generative AI (Gen AI) patents published between 2014 and 2023. "The rise in filings may be attributed to India's maturing innovation ecosystem – for instance, today, India is the third largest startup ecosystem in the world," said Ashwin Julka, managing partner at Remfry & Sagar in Gurugram. "Its rise in the Global Innovation Index rankings from 60th to 40th place between 2017 and 2023 is also indicative of the same."
- **Legislative reforms for efficiency.** Legislative reforms have also taken place simultaneously. The establishment of specialized IP divisions at the Delhi High Court and Madras High Court has streamlined judicial processes, reducing the time to resolve disputes. The Karnataka High Court is also set to have its own IP division soon. One can measure the impact of the IP divisions from the fact that interim injunctions are now granted within one to two months at the Delhi High Court, compared to the three to six months taken previously. Similarly, final orders are issued within three years instead of five.

  "The Jan Vishwas (Amendment of Provisions) Act, 2023 is another recent effort on the part of the government to simplify and streamline the regulatory framework governing businesses. It does so by omitting minor offences, decriminalizing certain kinds of offences, or revising penalties, overall reducing the complexity of compliance requirements thus promoting ease of business," said Julka.
- **Penalties for infringement.** Stricter enforcement of IP rights is another trend observed in recent years. Once few and far between, in the past few years Indian courts have developed a regular practice of granting damages and monetary awards in intellectual property suits.

"Regulatory changes in India reflect a response to technological advancements, the globalization of creative industries and the need for stronger protection against counterfeiting and infringement."

—**ASHWIN JULKA**,
managing partner, Remfry & Sagar, Gurugram

"A number of Asian jurisdictions are updating their copyright laws to facilitate AI adoption. Singapore's new Copyright Act, which was enacted in November 2021 includes a new computational data analysis exception, which enables the use of copyright works for commercial and non-commercial text and data mining purposes."

—**SHER HANN CHUA**,
managing associate, Linklaters, Singapore

"Regulatory changes in India reflect a response to technological advancements, the globalization of creative industries and the need for stronger protection against counterfeiting and infringement," said Julka. "The IP divisions are already mentioned above. But the Commercial Courts Act, 2015 was a valuable precursor in ensuring timely adjudication – IP suits in the country are generally commercial suits. It introduced global practices such as 'case management hearings' and 'summary judgements,' as well as simplified procedures to ensure speedy disposal."

He added: "Similarly, through the Trade Mark Rules 2017, the Indian government streamlined trademark filing and prosecution proceedings by reducing the number of forms from 75 to a mere eight whilst simultaneously digitizing systems and incentivizing online filing of applications. The Patent (Amendment) Rules, 2024, which took effect in March 2024, have increased flexibility (for instance, when it comes to extending time with respect to filing the request for examination or response) and reduced the burden connected with filing details of corresponding applications and the statement of working."

Digital piracy and counterfeiting

A recent report indicated that India ranks third globally in the consumption of content on websites featuring pirated content with over 7 billion visits, trailing closely behind Russia and the U.S. In terms of tools to curb this menace, the law prescribes both civil and criminal remedies. Civil actions entail IP infringement and passing off claims seeking injunctions to stop websites from infringing trademarks or hosting copyright-infringing data.

"Due to the anonymous nature of online piracy, it can be difficult for IP owners to identify infringers, and relief is often found in the form of John Doe orders where an injunction is sought against a person whose identity is not known at the time of the issuance of the order," said Julka. "John Doe orders enable right holders to search premises of counterfeiters and seize evidence of infringement."

Practically speaking, post an injunction, pirates can easily move infringing content to a different server or re-upload it on a different platform. To deal with such "mirror websites," an effective tool embraced by the Indian courts of late is that of the grant of dynamic injunctions. A dynamic injunction allows a right-holder to approach the courts to extend the main injunction order against all mirror websites providing access to the same infringing online locations that were the subject of the main injunction. The relief was first granted in India in 2017 by the Delhi High Court in a suit filed by UTV Software Communication.

The Bombay High Court follows a slightly modified approach. In a matter involving Eros International Media, it stated that for a blocking order to be passed against an entire website, the applicant must show that the entire website contains only illicit and infringing material with no legitimate content whatsoever. The court also called for a three-step verification process which included the verification and assessment by an external agency of the infringement.

"When it comes to online infringement, the Domain Name Dispute Resolution Policy (in line with WIPO's UDRP model) allows entities who believe other

companies or individuals have registered websites (with the .in ccTLD) with identical or confusingly similar names or trademarks to their own to file a complaint and seek redress," said Julka. "In terms of physical counterfeit goods, IPR owners can register trademarks, copyrights and designs on the website of the Customs Department in India for blocking their import."

The recently enacted Cinematograph (Amendment) Act, 2023 aims to curb film piracy with stricter penalties. Under this act, the government may take action against any intermediary that abets an unlawful act or fails to disable access to pirated content expeditiously.

For maximum deterrence, criminal remedies may be pursued against counterfeiters in parallel with civil suits.

Julka said: "At a governmental level, the Department of Promotion of Industry and Internal Trade (DPIIT), in association with the Federation of Indian Chambers of Commerce and Industry, has prepared an IPR enforcement toolkit to aid police with handling IP crimes, in particular counterfeiting and piracy. Also, the Maharashtra IP Crime Unit (MIPCU), formerly Maharashtra Cyber Digital Crime Unit (MCDCU), was established in August 2017 as a public-private partnership to enable the industry to work directly with state police to combat theft of IP on digital platforms, particularly digital piracy. The unit serves as a potential model for digital enforcement that other Indian states can emulate and replicate."

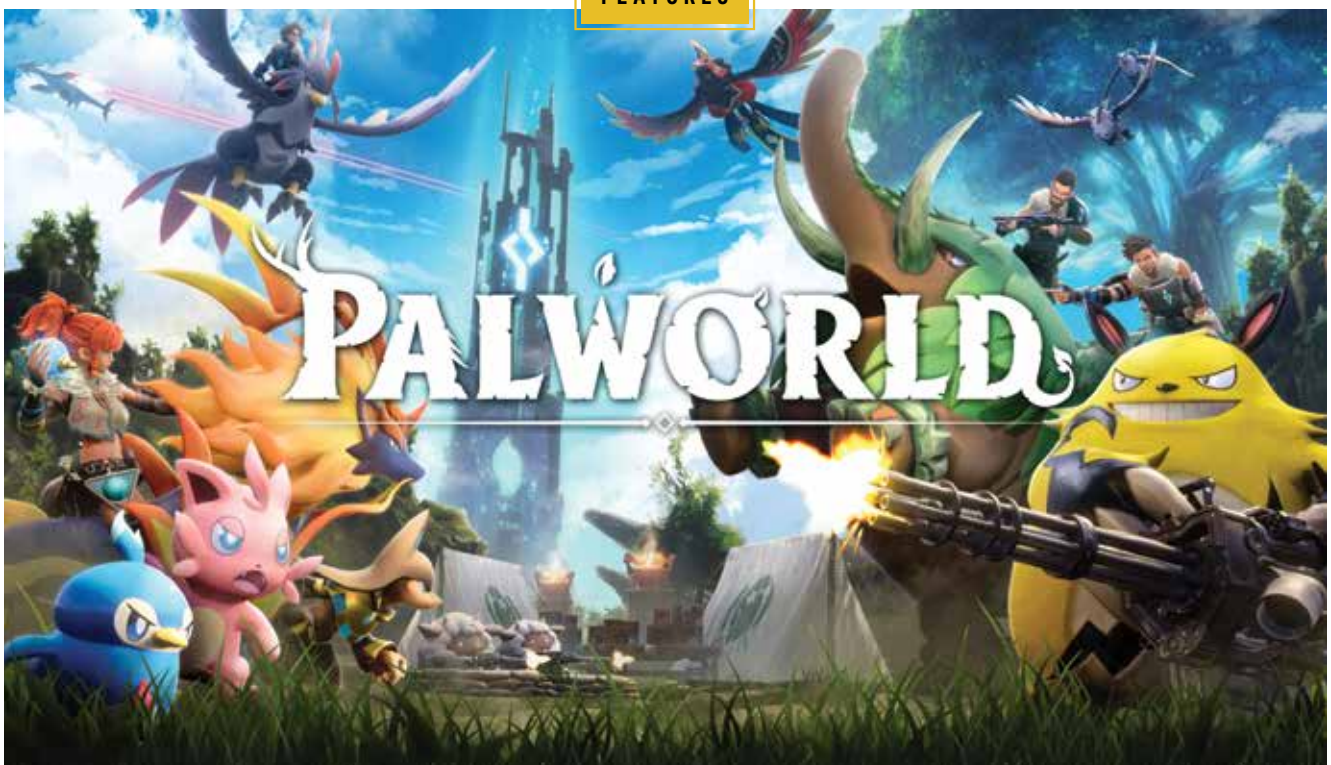
"Further, under the aegis of India's National IP Policy and the Cell for IPR Promotion and Management (CIPAM), several IP awareness programs have been conducted to familiarize citizens, and children in particular, with the nuances and importance of IP rights. The aim here is to ensure that all of society pivots towards respecting and protecting IP rights," he said.

Trade agreements

In March 2024, India signed the Trade and Economic Partnership Agreement (TEPA) with the European Free Trade Association (comprised of Liechtenstein, Norway, Iceland and Switzerland), which is slated to bring investments into India worth US$100 billion over 15 years. The agreement addresses IP rights amongst a myriad of other topics (such as investment, sustainable development and market access to services, amongst others), emphasizing that the commitments related to the same are at a Trade-Related Aspects of Intellectual Property Rights (TRIPS) level. "This comprehensive approach to IP protection in the TEPA is expected to foster a stronger economic partnership between the countries, which in turn would significantly benefit foreign companies hoping to operate in the region," said Julka.

India is also in the midst of negotiating a trade agreement with the UK, but IP issues were reportedly at play. The UK is said to be pressing for some changes regarding patent and geographical indication (GI) laws, while India views the current framework as satisfactory. Nothing is finalized, but the narrative underscores the importance of intellectual property rights when it comes to cross-border commerce.

"In that context, it can be emphatically stated that India's IP laws are in sync with global trends and where lacuna does exist, the Indian judiciary is very receptive and proactive in aligning practice with international benchmarks. At the level of the IP office, it has been collaborating with various IP offices around the world for several years now – the U.S., Japan, EU, etc. Officials frequently have dialogue with their overseas counterparts on various issues and this is also ensuring that Indian prosecution frameworks are harmonized with global practices," said Julka.



PIKACHU WITH GUNS? NINTENDO FIRES BACK

A new game imagines Pokémon-like creatures thrust into a dystopian landscape where they build factories and wield firearms. Nintendo has filed suit in Tokyo District Court against *Palworld*, claiming it infringes patents behind its US$100 billion *Pokémon* franchise. ***Cathy Li*** reports

Your beloved, colourful *Pokémon*-like creatures, once confined to playful battles, now wielding firearms, building factories and even being sacrificed in the name of survival. Welcome to *Palworld*, a chaotic, dystopian playground where pals are more than just companions – they're labourers, warriors and tools for a brutal, unforgiving world.

Imagine a game where every corner reveals a new twist, green forests suddenly darkened by the thrum of industrial machinery, creatures that once seemed innocent now caught in the crossfire of warfare. This daring combination of charm and violence has captured the imagination of gamers and sparked fierce debate. But it has also caught the attention of Nintendo, which claims that *Palworld* has borrowed too much from its *Pokémon* franchise, including key gameplay mechanics like the iconic creature-capture system and mounting system. As *Palworld* continues to blur the lines between innocence and brutality, its fate now rests in the hands of a Tokyo courtroom, where Nintendo is challenging its creators over patent infringement.

At the heart of the dispute is Nintendo's assertion that *Palworld* infringes on patented gameplay mechanics integral to its US$100 billion *Pokémon* franchise. Pocketpair, on the other hand, argues that its darker, ethically complex gameplay – and Pocketpair's claim to creative evolution, offering darker, ethically charged gameplay where cuddly creatures double as factory workers or gun-wielding allies in combat – represents a bold reimagining of the genre.

According to statements released by the parties, Nintendo and The *Pokémon* Company have sued Pocketpair in Tokyo District Court, seeking both an injunction and compensation for patent infringement on the grounds that *Palworld* infringes multiple patent rights. The Pocketpair statement adds that Nintendo

Source: Pictures comparing Palworld and Pokemon creatures from IGN.

and The Pokémon Company are each seeking ¥5 million (US$32,000) plus late payment damages from Pocketpair.

Despite Nintendo's legal action against *Palworld*, indie studio Pocketpair is pressing ahead with the success of its monster-filled survival game, announcing an exciting new expansion, *Feybreak*, which launched in late December.

Steam

Heart of the dispute

At first glance, *Palworld* is known to the public as "*Pokémon* with guns," since many of its creatures resemble those from *Pokémon*, but with a unique twist. However, Nintendo did not sue over the design patents of its characters, but rather over patents related to specific game mechanics.

Both games share a foundation in the "monster-collection" and "mounting" genre, with both *Pokémon* and *Palworld* involving capturing creatures using a ball-like object and featuring mechanics where players can ride their captured creatures. While *Pokémon* arguably popularized the genre, it didn't invent it. Titles like *Dragon Quest V* (1992) and *Shin Megami Tensei* (1992) also featured creature-collecting mechanics before *Pokémon* debuted in 1996.

"Sure, some might call this game a *Pokémon* knockoff, but I'd say it's more like the glow-up *Pokémon* never knew it needed!" said Krex, a player commenting about *Palworld* on Steam, an online game platform. "This game takes everything I have been wishing for and delivers it with style, filling the gaps where *Pokémon*'s been playing safe." On the other hand, part of the player base says they play it because it has connections to *Pokémon* and allows them to do things they can't do in *Pokémon*.

Pocketpair's *Palworld* innovates on the genre in ways that may distance it from *Pokémon*. Unlike the family-friendly themes of Nintendo's franchise, *Palworld* introduces ethically complex gameplay elements, such as using creatures for industrial labour or combat scenarios involving firearms. This tonal and thematic divergence could support Pocketpair's argument that *Palworld* represents a creative evolution rather than a derivative work.

"However, once you get past the pal designs and capture mechanic, it's not like *Pokémon* at all, it's Ark and Zelda," comments a player on *Palworld*'s Steam forum.

This raises a question in the ongoing intellectual property debate: could *Palworld*'s similarities to *Pokémon* confuse customers into thinking it's part of that franchise?

Legal experts point out that determining whether such confusion exists, it depends on factors like the customer's prior familiarity with *Pokémon*. Courts must evaluate confusion as a factual matter, considering surrounding circumstances, and while anecdotal evidence, such as forum comments, can be influential, it may not be definitive in determining whether the public is misled.

"Whether there is such leveraging would depend on, amongst other things, whether customers are 'confused' and/or mistaken as to *Palworld* being a part of the *Pokémon* franchise. This is a key, yet difficult, question to answer because it is impacted by a whole host of other factors including, whether that individual was already familiar with the *Pokémon* franchise and the extent of that familiarity," said Meryl Koh, a director at Drew & Napier in Singapore. She explains that confusion is a factual inquiry to be undertaken by the court in light of surrounding circumstances. This means that anecdotal evidence can be used, though not necessarily definitive by parties to prove the relevant public was or was not confused.

Infringement or creative evolution?

The legal question lies less in thematic originality and

more in the technical execution of gameplay. If *Palworld* employs systems that mirror patented elements of *Pokémon* – such as the mechanics for capturing creatures or their role in battles – these similarities could outweigh broader creative differences.

The complexity of Nintendo's claims lies in determining whether these mechanics, while seemingly similar, cross the line into patent infringement. The divisional patents filed by Nintendo (JP7545191, JP7493117, and JP7528390) were issued well after the release of *Palworld*, leading to questions about the timing and whether these claims represent a legitimate application of Nintendo's intellectual property. All of these patents were applied for between February and July of 2024 and registered between May and August. Notably, all of these applications came after the release of *Palworld*, which launched in early access on January 19, 2024.

The core issue is whether *Palworld*'s creature mechanics are "substantially similar" to the systems protected under Nintendo's patents. The patents in question cover specific technical details such as how creatures are summoned, how they interact within the game environment, and the mechanics for mounting and using creatures in gameplay scenarios.

"Pocketpair's public statement listed only the actual filing dates of these divisional patent applications, which may give rise to some confusion that Pocketpair has a prior use right," said Justin Davidson, a Hong Kong-based partner at Norton Rose Fulbright who heads the firm's Asia intellectual property team.

This right allows for the continued production of a product or use of a process that is later patented, provided that the initial manufacture or use occurred before the patent's filing date – or priority date, if applicable.

"However, the three divisional patents here received the filing date of their ultimate parent patent, which was filed back in 2021, so before the release of *Palworld*, and therefore any prior use defence should not apply," said Davidson.

While the current legal battle between Nintendo and Pocketpair primarily focuses on patent

"Whether there is such leveraging would depend on, amongst other things, whether customers are 'confused' and/or mistaken as to Palworld being a part of the Pokémon franchise. This is a key, yet difficult, question to answer because it is impacted by a whole host of other factors, including whether that individual was already familiar with the Pokémon franchise and the extent of that familiarity."

—**MERYL KOH**, director, Drew & Napier, Singapore

"PocketPair's public statement listed only the actual filing dates of these divisional patent applications, which may give rise to some confusion that PocketPair has a prior use right. However, the three divisional patents here received the filing date of their ultimate parent patent, which was filed back in 2021, so before the release of Palworld, and therefore any prior use defence should not apply."

—**JUSTIN DAVIDSON**, partner, Norton Rose Fulbright, Hong Kong

"It has been recently reported that Sega is also suing another Japanese game developer, Bank of Innovation, based on patent infringement, and it remains to be seen whether the protection of a monopoly right on a gameplay mechanism via the patent law will be an increasing trend for the gaming industry."

—**STANLEY NG**, lawyer, Norton Rose Fulbright, Hong Kong

infringement, there are other legal frameworks that could potentially be leveraged in this dispute. One such avenue is the doctrine of trade dress, which protects the visual appearance and design of a product that signifies its source to consumers.

Trade dress encompasses the overall look and feel of a product, including its shape, colour, and design elements. In the context of *Palworld* and *Pokémon*, this could involve the distinctive appearance of the creatures and the game's interface. However, establishing trade dress protection can be challenging, as it requires proving that the design is inherently distinctive and serves as a unique identifier of the product.

In Japan, trade dress can be protected under the Japanese Trademark Act and the Unfair Competition Prevention Law. However, the criteria for protection are stringent, requiring the trade dress to be non-functional and to have acquired secondary meaning among consumers. This means that the design must be recognized by the public as being associated with a particular source.

"The biggest hurdle in a case like this, assuming a claimant has registered a trade dress in Japan, is that it is not always easy to prove that the appearance of claimant's game is so inherently distinctive as to be worthy of exclusive protection. For example, it remains to be seen how one can prove that fantasy characters based off real-life animals are so inherently distinctive so as to be given trade dress protection," said Koh.

Legal challenges and market implications

As the legal dispute between Nintendo, The Pokémon Company, and *Palworld* developer Pocketpair continues, the game has undergone significant updates to its creature summoning mechanics.

Prior to the November 29, 2024, patch 0.3.11, *Palworld* featured a mechanic where players could throw a Pal Sphere onto the battlefield to summon their Pal, a system reminiscent of *Pokémon*'s Poké Ball mechanics. This similarity raised concerns about potential patent infringement.

Following the latest update to *Palworld*, the game's summoning mechanic has been altered: instead of throwing a Pal Sphere to summon a creature, players will now see their Pal appear immediately next to their character. While some have speculated that this change is linked to the ongoing legal challenges involving Nintendo's *Pokémon* franchise, there has been no official statement confirming this connection.

In addition to the mechanic overhaul, the update introduces several new features, including new pals, weapons, and architectural styles for town building. One of the most significant additions is a vast new island, described by Pocketpair as being approximately six times the size of the previously added Sakurajima island. Players will be able to explore this expansive area, catch new pals, and face off against a new faction leader in a boss fight.

Looking ahead, Pocketpair is preparing for the release of another *Palworld* update, titled *Feybreak*, which was announced at the 2024 Game Awards. The update, set to launch on December 23, will feature new content, including a new faction leader and a variety of new weapons, showcased in a 92-second cinematic trailer. As with previous updates, it is expected that the patch will first launch on PC before becoming available on consoles.

Traditionally, gaming disputes have predominantly centred around copyright issues, often involving claims related to art assets, storylines, and character design, along with potential trade dress or unfair competition concerns. In these cases, the gameplay mechanics themselves were often overlooked since they can only be protected under patent law, a domain traditionally not often used in the gaming industry. However, as the market for video games continues to grow exponentially, disputes are increasingly extending into the realm of gameplay mechanics and patent law.

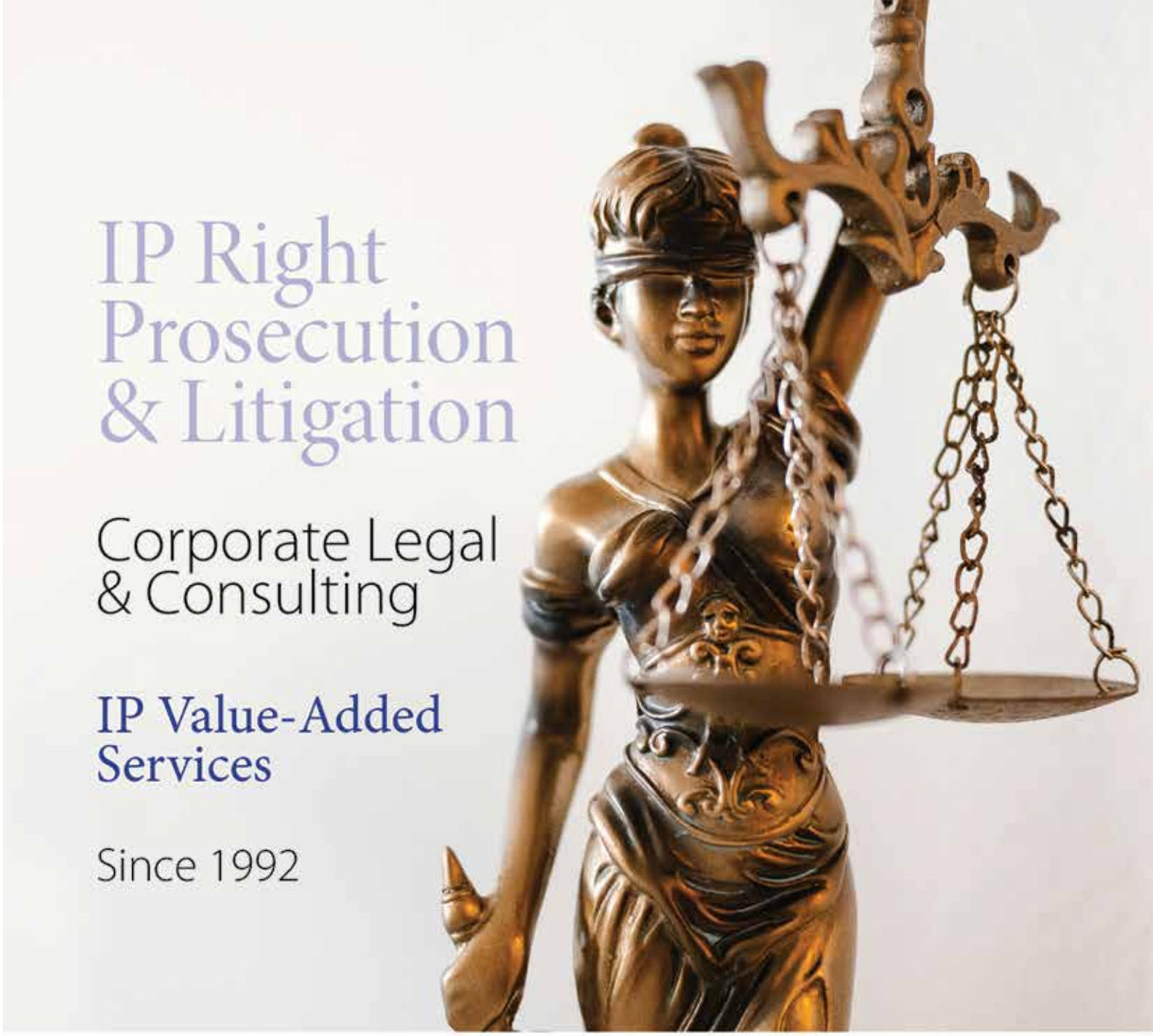
"Since copyright does not protect gameplay mechanisms, in this case Nintendo is seeking to enforce on the basis of its patent rights, which is a far less frequent enforcement tool in the gaming industry," said Stanley Ng, a lawyer at Norton Rose Fulbright in Hong Kong.

One of the most notable examples of this shift is the *Tetris Holding, LLC v. Xio Interactive, Inc.* case, which became a landmark in video game cloning litigation. In this case, the developers of the iconic puzzle game *Tetris* sought to protect not only its visual assets but also its core gameplay mechanics, arguing that the game's unique design and playstyle constituted intellectual property that deserved patent protection. The case, which revolved around the alleged copying of *Tetris* by a mobile game app, brought attention to the growing significance of patents in the gaming world. While copyright remains the primary form of protection for many video games – especially those that rely on creative visual and narrative content – there has been an increasing recognition of the importance of patent law in safeguarding innovative gameplay mechanics.

It is estimated that the global gaming market will amount to US$503.14 billion annually in 2025, up from US$396 billion in 2023. Asia Pacific is set to remain the top-grossing gaming market worldwide, according to Statista.

"It has been recently reported that Sega is also suing another Japanese game developer, Bank of Innovation, based on patent infringement, and it remains to be seen whether the protection of a monopoly right on a gameplay mechanism via the patent law will be an increasing trend for the gaming industry," said Ng. In the gaming industry, technological advancements have led to more patents for game mechanics, hardware, and algorithms.

As gaming companies increasingly seek to protect unique gameplay mechanics, this case could set a precedent for how intellectual property law is applied to the evolving mechanics of video games. More companies are now exploring patent rights not only for visual assets but for core game functions.



IP Right Prosecution & Litigation

Corporate Legal & Consulting

IP Value-Added Services

Since 1992

Quality • Profession • Enthusiasm

FOCUS

Patents, Trademarks, Copyrights, Trade Secrets, Unfair Competition Licensing, Counseling, Litigation, Transactions

FEATURES

Our patent attorneys and patent engineers hold outstanding and advanced academic degrees
Our prominent staff is dedicated to provide the best quality service in IPRs
Our international cleints include **Armani, Baidu, Beckhoff, BYD, CICC, Cypress, Dr. Reddy, Infineon, Intercept, InterDigital, Gleason, Grenzebach, Haribo, Intercept, Lenovo, Lupin, Motorola, MPS, NovaLed, Oppo, Piramal, Schott Glass, Sun Pharma, Torrent, Toyo Ink**.

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.

道法法律事務所
DEEP & FAR Attorneys-at-Law

13th Floor, 27, Sec. 3, Chung San N. Road, Taipei, Taiwan
TEL NO: 886-2-25856688 • FAX: 886-2-25989900/ 25978989
EMAIL: email@deepnfar.com.tw • WESITE: www.deepnfar.com.tw

TOASTING THE WINNERS

Fifty-nine firms from 21 Asia-Pacific jurisdictions took home trophies at the 15th annual *Asia IP* Awards, held November 17 at Blackbird restaurant in Manila.

At the same event, eight law firms from India received trophies for awards won in October's *Asia IP* India Awards, honouring the best in domestic Indian intellectual property work.

Blackbird is located in Nielson Tower on the site of Manila's first international airport. In July 1937, Nielson Airport was inaugurated, with a terminal building and control tower designed to resemble an airplane from a bird's eye view. What are now Ayala Avenue and Paseo de Roxas were once the runways. When Philippine Air Lines was established in 1941, their first flight departed from Nielson Airport for Baguio carrying nine passengers onboard a Beechcraft Model 18.

The awards named top trademarks, patents and copyright practices as determined by in-house counsel from Asia, Europe and the Americas. More than 5,000 in-house counsel were polled by *Asia IP* throughout the first part of 2024. The event also named Asia-Pacific award winners in each of the

practice areas. The complete list of winners follows on the next page.

"There is so much high-level intellectual property work being done in Asia," said *Asia IP* publisher Darren Barton. "Each year, winning an *Asia IP* trophy becomes more and more difficult."

Three international law firms won multiple awards at the event, either in multiple practice areas or multiple jurisdictions. Regional firm Tilleke & Gibbins was recognized for its work in Cambodia, Indonesia, Laos, Thailand and Vietnam and for its regional patent work. Global firm Baker McKenzie-affiliated firms won five awards on the evening, including the regional Asia Pacific award for its trademark work, as well as its work in China, Hong Kong, Indonesia (as HHP Law Firm), Malaysia (as Wong & Partners) and Vietnam. Bird & Bird won for its regional copyright work, as well as for its work in China. The firm also won an award in Singapore, where it operates as Bird & Bird ATMD.

The China awards given at the evening's ceremony honour international law firms for their work in China. Leading Chinese law firms are recognized annually with the *Asia IP* China Awards early each year.

Asia IP is a vital source of intelligence for IP-owning companies active in Asia, and for international law firms which want to keep ahead of the key issues. The magazine includes a range of in-depth features, news and analysis designed to meet the information needs of in-house counsel, senior business leaders and partners at Asian and international law firms.

The 2025 *Asia IP* Awards will be held in Kuala Lumpur. —ASIA IP

AUSTRALIA

Australia Copyright Firm of the Year

King & Wood Mallesons boasts more than 140 partners and over 1,100 lawyers across Brisbane, Canberra, Melbourne, Sydney and Perth. Its IP practice covers patents, trademarks, copyright, designs, trade secrets, strategic IP advice and IP disputes. Among the firm's roster of clients are business establishments in food and agriculture, health and pharma, media/entertainment, technology and energy sectors as well as government and key research and industry bodies. Key practitioners include Bill Ladas, Kim O'Connell, Matthew Swinn and Cate Nagy.

Australia Patents Firm of the Year

Spruson & Ferguson companies are incorporated entities owned by IPH Limited, a publicly listed holding company for a number of IP professional services brands operating across Asia and the Pacific. The team is mostly made up of professionals with solid, real-world experience in science, engineering, legal, defense, telecommunications, ICT, electronics, computing and finance, thus boosting their capabilities of delivering effective, insightful solutions to their clients. Simon Potter is managing director for Australia; he has also overseen the development of the firm's chemical and life sciences patent team in Australia.

Mathew Lucas, left, a principal at Davies Collison Cave, receives the Australia Trademark Firm of the Year award from *Asia IP's* Patrick Chu.

Australia Trademark Firm of the Year

Davies Collison Cave was acquired by QANTM IP in 2016 and are now part of the Australian Securities Exchange-listed company. Principal Marion Heathcote received INTA's 2019 President's Award; she specializes in trademark work, and with her scientific qualifications, she has developed an expertise in geographical indications and agroeconomic and ecology issues. The team provides the full range of trademark services, from prosecution and portfolio management to working with the Australian Border Force, from plant name protection to oppositions and cancellation actions.

BANGLADESH

Bangladesh Intellectual Property Firm of the Year

Remfry & Son traces its roots to 1827 in British India; the firm has been advising on matters of law in Bangladesh since the country's formation in 1971. The firm is noted for its work in trademark, patent, copyright, design and domain name management. Its clientele is made up of small local businesses, FTSE companies and large organizations, including Honda, BMW, KFC, Suzuki, Google, Facebook, Twitter, New Zealand Dairy, LG, Mercedes Benz, BMW and Audi.

Justin Phua, left, an associate at CCW Partnership, receives the Brunei Intellectual Property Firm of the Year award from *Asia IP's* Patrick Chu.

BRUNEI

Brunei Intellectual Property Firm of the Year

With four partners, three associates and one consultant, **CCW Partnership** is a full-service commercial law firm in Brunei. The firm was founded in 1980 and used to be known as Choo, Chan & Wong; today, it has a leading reputation in IP and other areas of commercial and civil disputes, including construction, banking, property and insurance. Partner On Hung Zheng is a key IP contact at the firm; he has appeared before the High Court and Court of Appeal of Brunei Darussalam. The firm has four partners and four associates; it filed 109 trademark and eight patent applications last year, and has acted in trademark infringement proceedings and trademark opposition proceedings.

Loc Xuan Le, left, a principal at T&G Law Firm, receives the Cambodia Intellectual Property Firm of the Year award on behalf of Tilleke & Gibbins from *Asia IP's* Patrick Chu.

CAMBODIA

Cambodia Patent Firm of the Year

The **Tilleke & Gibbins** office in Phnom Penh provides guidance to clients on all aspects of intellectual property in Cambodia, and advises on licensing and regulatory issues for clients in sectors such as chemicals, food and agribusiness, franchising, life sciences, and technology. Its Cambodia practice offers

a team of dedicated Khmer advisors who draw on the international expertise of its Bangkok office to provide advice on IP, licensing, and regulatory issues. Director Jay Cohen leads the IP practice; Sokmean Chea is highly-regarded for her work with clients on a range of IP issues; and David Mol is regularly praised by clients for his responsiveness and practical, business-minded advice. The firm's IP team in Phnom Penh consists of two partners, six associates, two paralegals and four support staff, making it one of the largest in Cambodia.

Cambodia Trademark Firm of the Year

Pheng Thea is co-founder of **Abacus IP** a full-service intellectual property agency in Phnom Penh. His practice involves the registration and maintenance of hundreds of trademarks, patents, industrial designs and other forms of IP. Co-founder David Haskel, of counsel Sreypeou Chaing and external advisor Tom Pearson are also key contacts. The firm has completed a successful enforcement programme on behalf of a global, U.S.-based real estate firm for trademark infringement and unfair competition, and has filed dozens of patent filings for PCT national phase and validation of foreign patents in Cambodia. Over the past year, its trademark litigation work has involved several investigations, contentious licensing and mediation procedures before the Cambodian Department of Intellectual Property Rights. Its clients are primarily multinational corporations seeking to protect their rights in Cambodia.

Victor Tse, left, a partner at Bird & Bird, receives the China International Copyright Firm of the Year award from *Asia IP's* Patrick Chu.

CHINA

China International Copyright Firm of the Year

Bird & Bird established its Hong Kong office in 1995, followed by Beijing in 2004 and Shanghai in 2008. In late 2023, it opened a Shenzhen branch, which is led by Hank Leung, co-head of the firm's greater China intellectual property practice. The international firm entered into an association with local firm Lawjay Partners in 2009 to increase coverage in contentious IP matters in Chinese courts. The China and Hong Kong team is led by partner Matthew Laight, who has represented some of the world's leading companies in a broad range of sectors including electronics, pharmaceuticals, communications, information technology, media, broadcasting, and food and beverage. Ted Chwu is head of greater China and co-head of global tech and comms at the firm.

Abe Sun, left, a partner at Baker McKenzie, receives the China International Trademark Firm of the Year award from *Asia IP's* Patrick Chu.

China International Trademark Firm of the Year

Baker McKenzie has offices in Beijing, Shanghai and Hong Kong, and maintains an impressive team of IP specialists backed by an international network. Senior artner Loke-Khoon Tan's practice on IP law in China, with particular emphasis on the structuring of intellectual property rights and anti-counterfeiting planning. He is currently on the firm's Steering Committee for the Consumer Goods & Retail (including Luxury and Fashion) Industry Practice. He is also the author of various IP publications including the Pirates in the Middle Kingdom: The Art of Trademark War trilogy. Maria Smith heads the Hong Kong and Regional Brand Protection and Enforcement Team. The firm has established Baker & McKenzie IP Agency in Beijing and Shanghai to handle China trademark, copyright and enforcement matters.

HONG KONG

Hong Kong Copyright Firm of the Year

Long-time Hong Kong lawyer Ella Cheong practices her craft from Hong Kong-based **ELLALAN** along with managing partner Alan Chiu. The firm, which until June 2020 had been known as Ella Cheong & Alan Chiu, advises on IP enforcement, transactional and commercial IP and internet-related issues, as well as matters concerning entertainment and media, dispute resolution, commercial law and regulatory law. The firm boosted its entertainment and media capabilities in late 2023 with the arrival of senior consultant Kenny Wong from Hogan Lovells.

Catherine Zheng, left, a partner at Deacons, receives the Hong Kong Patent Prosecution Firm of the Year award from *Asia IP's* Patrick Chu.

Hong Kong Patent Prosecution Firm of the Year
Hong Kong Trademark Contentious Firm of the Year

Deacons' IP practice remains one of the best among the city's firms. It has one of the largest specialist IP teams in Hong Kong, with 12 partners and more than 110 staff in total. The firm filed Hong Kong's first-ever e-filings of patent and design applications; it has advised on inventions ranging from baby strollers, to mechanics and electronics, to genetic sequencing, to biotherapeutics, to plant variety rights, network communication, AI, robotics and autonomous vehicles. Key contacts include Catherine Zheng, who heads the firm's IP department and specializes in cross-border IP protection strategy and contentious matters, and Ian Liu; Liu is qualified to practice in the Greater Bay Area, and previously worked in the hi-tech software industry with a Silicon Valley-based company and was a financial software consultant with Reuters.

Abe Sun, left, a partner at Baker McKenzie, receives the Hong Kong Patent Contentious Firm of the Year award from *Asia IP's* Patrick Chu.

Hong Kong Patent Contentious Firm of the Year

Baker McKenzie has offices in Beijing, Shanghai and Hong Kong, and maintains an impressive team of IP specialists backed up by an international network. Isabella Liu is head of the firm's Asia Pacific IP and technology group, with expertise in IP matters in the pharmaceuticals sector. Hong Kong-based partner Andrew Sim helped secure a landmark win for International Fruit Genetics (IFG) in a plant variety right infringement case in Yunnan, China, involving IFG's proprietary grape variety IFG Six (Chinese variety name IFG六), which is sold under the trademark Sweet Sapphire (Chinese trademark 甜蜜蓝宝石). The local Ministry of Agriculture and Rural Affairs (MARA) acknowledged the infringement and imposed significant administrative fines against the infringer, which had illegally produced and sold propagation and harvested material for IFG Six. The case was one of the first successful administrative cases under China's recently amended Seed Law. The firm has established Baker & McKenzie IP Agency in Beijing and Shanghai to handle China trademark, copyright and enforcement matters.

East IP
TRUSTED IP ADVISORS FOR GREATER CHINA
www.east-ip.com
mail@east-ip.com

By the Numbers

430+
Total professionals and support staff

25+
Ranked IP professionals

170+
Trademark prosecution and enforcement team members

Top 4
Firm for successful trademark oppositions in China*

IP SERVICES
- Trademarks
- Patents
- Copyright
- Litigation
- IP Investigations & Enforcement
- IP Licensing & Transactions
- Domain Recovery
- Data Protection
- Technology Transfer

TECHNICAL EXPERTISE
- Artificial Intelligence
- Biotechnology
- Chemistry
- Computer & Electrical Sciences
- Cyber Fraud
- Engineering
- Medical Technology
- Defense Technology
- Space Industries

*CNIPA 2023 statistics

OFFICES: BEIJING | HONG KONG | SHANGHAI | GUANGZHOU | TIANJIN | CHANGSHA | JINAN

Helen Tang, left, a partner at East IP, receives the Hong Kong Trademark Prosecution Firm of the Year award from *Asia IP's* Patrick Chu.

Hong Kong Trademark Prosecution Firm of the Year

East IP was formed through the combination of four well-known practices, including a combination of Hong Kong-based SIPS, Beijing East IP and East IP Law Firm. The new East IP is also being joined by a team of six partners from Zhong Lun led by China trademark veteran Jimmy Huang. The new East IP Group is co-chaired by SIPS founder Joe Simone and the head of the firm's patent practice, Xiaodong Li, while Huang will lead the trademark prosecution team. The firm notes that women comprise half of its partners and 72 percent of its 90-member IP team. East IP partners include Joe Simone, Dan Plane and Helen Tang, who were SIPS founding partners, and Joann Chan, Joshua Miller and Mai Lin.

Anju Khanna, left, a partner at Lall & Sethi, receives the India Copyright Firm of the Year award from Asia IP's Darren Barton.

INDIA

India Copyright Firm of the Year

Managing partner Jyoti Kaur leads the team at **Lall & Sethi** in Delhi, which was named the winner of the New Delhi & NCR Firm of the Year at *Asia IP*'s 2024 India Awards. Over the past year, the firm has successfully filed numerous copyright applications for creative works, handled multiple copyright infringement cases, issued and responded to cease and desist letters, drafted and negotiated several copyright licensing agreements and coordinated with international counsel on cross-border copyright issues. The firm prides itself on having a top-notch IT system; its IP Management Software, developed in-house, ensures that timely responses are sent and deadlines are strictly adhered to. The firm was founded in 1994 by Chander Lall and Sandeep Sethi, both of whom have been elevated to senior advocates. Nancy Roy is a key contact for copyright matters.

Ranjna Mehta-Dutt, left, a partner at Remfry & Sagar, receives the India Patent Firm of the Year award from *Asia IP's* Darren Barton.

India Patent Firm of the Year

IP powerhouse **Remfry & Sagar** is a go-to firm for multinationals in India. The firm has pioneered patent litigation in India's post-TRIPS regime, advising, and acting on behalf of, leading international pharmaceutical companies on seminal matters including Section 3(d) of the Patents Act and the issue of compulsory licensing. More recently, telecom disputes involving fair, reasonable and non-discriminatory (FRAND) licensing agreements in standard-essential patents (SEPs) have been an area of focus. The firm has one of the largest, most experienced patent litigation teams in the country. Led by managing partner Ashwin Julka, the firm also won multiple awards at *Asia IP*'s 2024 India Awards, including national firm of the year runner-up, as well as IP litigation firm and IP prosecution firm of the year.

Pravin Anand, left, managing partner at Anand and Anand, receives the India Trademark Firm of the Year award from *Asia IP's* Darren Barton.

India Trademark Firm of the Year

Anand and Anand is one of India's top IP firms, housing more than 200 professionals led by managing partner Pravin Anand, who was the recipient of the International Trademark Association's (INTA) prestigious 2021 President's Award. Pravin Anand, Safir

Anand and Vaishali Mittal are all excellent lawyers and key to the firm's trademark practice, which handled more than 3,000 successful trademark oppositions last year, as well as more than 2,500 trademark applications. In an unprecedented feat, the firm secured well-known status for 11 marks belonging to various leading Indian and international companies, all on the same day, including marks owned by pharma giant Abbott Laboratories, ecommerce platform Nykaa, apparel manufacturer Jockey, Indian conglomerate Tata Group, Indian Hotels Company and Titan Company and Japanese multinational Bridgestone Corporation. The firm, which has 27 partners, five associate partners and 86 associates, won multiple awards at *Asia IP*'s 2024 India Awards, including national firm of the year.

Abe Sun, left, a partner at Baker McKenzie, receives the Indonesia Copyright Firm of the Year award on behalf of HHP Law Firm, a Baker McKenzie member firm, from Asia IP's Darren Barton.

INDONESIA

Indonesia Copyright Firm of the Year

HHP Law Firm, formerly known as Hadiputranto, Hadinoto & Partners, is the Indonesian member firm of Baker McKenzie. Its IP team helps international clients with cease-and-desist campaigns, anti-counterfeiting raids, infringer investigations and other related matters. The IP team is led by partner Daru Lukiantono, who has experience in complex intellectual property due diligence and management cases; in addition to copyright work, he also has a range of experience in patent prosecution, patent portfolio management, commercial patent work and patent litigation.

Indonesia Patent Prosecution Firm of the Year

Tilleke & Gibbins' Jakarta office began serving clients in September 2013. Its leading Southeast Asian IP practice has decades of experience in the region and has been instrumental in the development of IP law and practice in many jurisdictions. Director Wongrat Ratanaprayul has advised on a portfolio of more than 1,500 industrial designs, copyright and trademarks for a global jewelry designer and manufacturer. The firm is regularly entrusted by leading IP firms in South Korea to act for LG Electronics on patent prosecution matters in Indonesia, including translating patent specifications and filing local patent applications; over the past year, it assisted LG Electronics with the prosecution of more than 110 patents in Indonesia. It also assisted a Chinese law firm in conducting freedom-to-operate

Irene Djalim, left, manager, regulatory affairs, at Tilleke & Gibbins, receives the Indonesia Patent Prosecution Firm of the Year award from Asia IP's Darren Barton.

searches on sanitary pad technology in Indonesia, which uncovered 45 patents and/or patent applications for the client to assess the risks in selling their sanitary products in the Indonesian market.

Risti Wulansari, left, a partner at K&K Advocates, receives the Indonesia Patent Contentious Firm of the Year award from Asia IP's Darren Barton.

Indonesia Patent Contentious Firm of the Year

Managing partner Justisiari Perdana Kusumah and partner Risti Wulansari as well as senior associate Siti Mariam Nabila lead **K&K Advocates**, a boutique firm specializing in IP matters with particular strength in patent, trademark and copyright registration and enforcement. The firm is regularly sought by multinational clients and foreign governments. It also acts for or is involved with bodies responsible for developing IP and technology laws. In recent ligitation, it has represented one of the largest chemical suppliers in ASEAN on an industrial design lawsuit.

Indonesia Trademark Prosecution Firm of the Year

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

has advised Rigo Trading, whose unique bear-shaped gummies – GoldBears – have acquired distinctiveness through extensive sales in the market since 1922. Since 2016 it has been possible to register non-traditional trademarks in Indonesia, and the firm has been advising Rigo on navigating the challenges of a relatively untested system of registration of 3D trademarks. This has involved coordination with Trademark Office Examiners to stay abreast of evolving practice updates, formulating prosecution strategy, and attending to appeals to the Trademark Appeals Commission.

Indonesia Trademark Contentious Firm of the Year

Rouse, in association with **Suryomurcito & Co**, is led by deputy CEO Nick Redfearn, and has particular experience managing regional IP enforcement programmes and filings, and commercial deals and compliance exercises. It was one of the first foreign firms to enter the Indonesia IP market more than 25 years ago; today it is home to more than 90 IP professionals and staff. Rouse provides comprehensive IP services to its clients, including trademark filing, counselling and portfolio management, patent drafting, filing, and counselling.

JAPAN

Japan Copyright Firm of the Year

Nakamura & Partners in Tokyo is an international patent law firm which provides IP services inside and outside of the jurisdiction. Shinichiro Tanaka is a key partner the legal section of the firm, and Daisaku Fujikura is head of the trademark section. Yuriko Sagara and Shoichi Satake are part of the firm's entertainment practice, while Akira Watanabe and Masahiko Matsuno are members in its media practice. Clients include Sony and FujiFilm.

Japan Patent Prosecution Firm of the Year

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

Japan Patent Contentious Firm of the Year

Founded in 1902, **Yuasa and Hara** is one of the oldest and largest law and patent firms in Tokyo. The firm is a pioneer in multidisciplinary practice, consisting of a legal division, a patent division, a trademark and design division and an accounting division. Kazuhiro Nakata, Hiromichi Aoki and Toshiaki Iimura closely cooperate with each other to provide complete and multiple IP services to both domestic and foreign clients.

Japan Trademark Prosecution Firm of the Year

Hiroe and Associates provides services focusing on trademark, patent, design and utility model applications. Virtually of its searches are handled in-house, using state-of-the-art systems linked to search databases. The firm's well-rounded team of professionals, which is based in Gifu Prefecture outside Nagoya, provides expertise on a wide range of technical fields and intellectual property law. Masanori Hiroe and Takenori Hiroe are key contacts.

Yugo Endo, left, and Toshifumi Onuki, partners at TMI Associates, receive the Japan Trademark Contentious Firm of the Year award from Asia IP's Darren Barton.

Japan Trademark Contentious Firm of the Year

Yoshiyuki Inaba and Toyotaka Abe are key practitioners at **TMI Associates**. The firm is one of Japan's five largest firms, with more than 90 patent and trademark attorneys in addition to some 570 attorneys-at-law and more than 100 paralegals and other staff members. The firm has assisted Stokke, a Norwegian maker of childrens' chairs, in court in an attempt to stop the sale of lookalike chairs in Japan; the trademark prosecution team at the firm has now filed a mark for a 3-dimensional trademark. The firm's clients range from venture businesses to well-established high-tech companies. It also liaises with government agencies and has increasingly has had opportunities to advise on policy.

Loc Xuan Le, left, a principal at T&G Law Firm, receives the Laos Intellectual Property Firm of the Year award on behalf of Tilleke & Gibbins from Asia IP's Espie Angelica A. de Leon.

LAOS

Laos Intellectual Property Firm of the Year

Tilleke & Gibbins provides legal advice for foreign investors and others in Laos through its office in Vientiane. The firm has particular expertise in trademark and other IP law in Laos, but is also positioned to provide advice on a range of corporate and commercial matters. Prisna Sungwanna heads the firm's Laos office. The team assisted a multinational technology and hardware company in overcoming a previously rejected international trademark registration to co-exist with another business's registered mark in Laos. It also assisted a U.S.-based health and fitness company in overcoming partial provisional refusals in Laos for two international trademark registrations filed via the Madrid System.

Rui Cunha, centre, founding parter at C&C Lawyers & Notaries, and Nuno Sardinha da Mata, right, senior partner at the firm, receive the Macau Intellectual Property Firm of the Year award from Asia IP's Darren Barton.

MACAU

Macau Intellectual Property Firm of the Year

C&C Lawyers & Notaries provides legal advice and services on a wide range of legal issues for both domestic and international clients. In addition to general advice on IP issues, the firm's practice includes registration and IP portfolio maintenance; IP enforcement and protection; licensing and franchising; anti-counterfeiting and customs actions. Partner Lu Zhao leads the IP practice and acts as the top liaison for the firm's Chinese-speaking clients. The need to provide specific and focused IP solutions led the C&C group to create **IPSOL**, a full-service dedicated intellectual property agency. Focused on the planning, registration and management of trademarks, patents and other IP rights, IPSOL offers solutions that maximize the protection of IP assets. C&C also has offices in Portugal, East Timor and Cabo Verde.

MALAYSIA

Malaysia Copyright Firm of the Year

The IP and technology team at **Rahmat Lim & Partners** offers a wide range of contentious and non-contentious IP-related services and advises on a broad spectrum of enforcement, management and transactional issues, including work on criminal copyright enforcement of data centres hosting AI and experimental IP litigation, such as fair doctrine defences for copyright infringement in the AI context. Among its most interesting copyright work, the firm Acted for Joey Yap Research Group and Joey Yap Private Limited, a Chinese metaphysics consulting group in initiating a lawsuit against third-party online

Partner

Takenori HIROE
Chairman

Masanori HIROE
Director

Satoshi HASHIMOTO
Vice-director

Tetsunori YOSHIDA

Chinese Trademark Agent

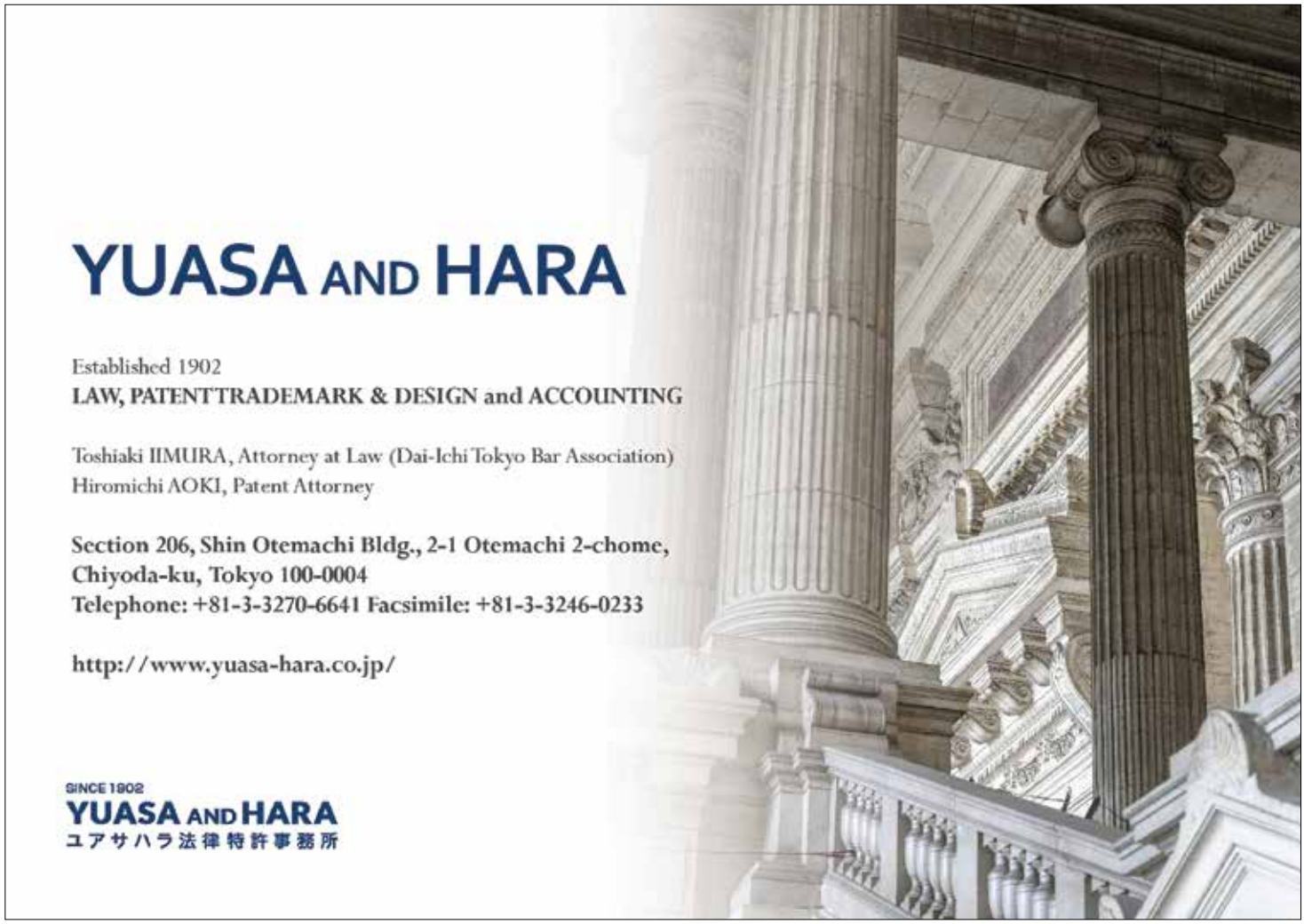
Jinmei HU

Japanese Patent Attorneys

Motoaki HATTORI
Naoya TANIGUCHI
Kimihiro NAKAYAMA

HIROE AND ASSOCIATES

4-3, Usa 3-Chome, Gifu-City, 500-8368 JAPAN
Tel +81-58-276-2175 Fax +81-58-268-7602
www.hiroe.co.jp intl_s@hiroe.co.jp



YUASA AND HARA

Established 1902
LAW, PATENT TRADEMARK & DESIGN and ACCOUNTING

Toshiaki IIMURA, Attorney at Law (Dai-Ichi Tokyo Bar Association)
Hiromichi AOKI, Patent Attorney

Section 206, Shin Otemachi Bldg., 2-1 Otemachi 2-chome,
Chiyoda-ku, Tokyo 100-0004
Telephone: +81-3-3270-6641 Facsimile: +81-3-3246-0233

http://www.yuasa-hara.co.jp/

SINCE 1902
YUASA AND HARA
ユアサハラ法律特許事務所

Pauline Khor, left, a partner at Rahmat Lim & Partners, receives the Malaysia Copyright Firm of the Year award from Asia IP's Espie Angelica A. de Leon.

infringers who have been distributing and selling hundreds of copyrighted works belonging to Joey Yap and bearing Joey Yap's trademarks on websites and various e-commerce platforms such as Shopee and Lazada. Despite the first defendant selling pirated Joey Yap products on its online stores in foreign currencies, the firm successfully identified and linked the second defendant with the first defendant after many months of surveillance. The firm says the lawsuit is particularly noteworthy as the second defendant turned out to be an existing student of Joey Yap, who managed to conceal his true identity behind multiple accounts and foreign IP addresses, knowing full well that his actions in selling hundreds of Joey Yap's books and programs online for profit were unlawful. After pleadings closed, the defendants filed a security of costs interim application as a delay tactic. Recently, the defendants security for cost application has dismissed by the court and costs were awarded to Joey Yap. Parties are now in the midst of filing pre-trial documents and trial dates have been set. Partner Pauline Khor, head of the intellectual property and technology department, is known for her fresh perspective and creative solutions.

Fiona Jeffrey, left, a senior associate at Marks & Clerk, receives the Malaysia Patent Prosecution Firm of the Year award from Asia IP's Espie Angelica A. de Leon.

Malaysia Patent Prosecution Firm of the Year

Well-established IP specialist **Marks & Clerk** handles all areas of intellectual property, with particular strengths in life science, information technology and electronics. The firm has a global reputation for delivering quality parent prosecution and its Malaysia office handles patent drafting to UK and European standards. The patent practice, led by director Chris Hemingway, is one of the very few Malaysian patent practices to have a UK- and Europe-qualified patent attorney which, it says, has found that this expertise has attracted drafting work that otherwise would likely have been sent offshore to firms in Singapore or Australia. Key patent clients include Petronas, NGLtech, Panasonic, Sengenics, Vulcan Photonics and LuxTag, as well as a number of the local Universities such as USM, UTP, IIUM and UMP. New clients include Cancer Research Malaysia, Areodyne, Medika and Cryocord.

Malaysia Patent Contentious Firm of the Year

Skrine's sizeable IP department provides comprehensive IP services with an excellent track record in contentious and advisory matters. The firm acted for Dyson in patent dispute involving its bladeless fan technology. It also successfully has Ronic Corporation's application for leave to appeal to the Federal Court dismissed in its infringement claim against Cadware. The outstanding Charmayne Ong is head of the intellectual property division.

Malaysia Trademark Prosecution Firm of the Year

Full-service firm **Shearn Delamore & Co**'s IP practice is led by Karen Abraham, with its IP team providing professional services for more than 40 years and being widely recognized as one of the leading firms in Malaysia. The firm is one of the very few firms in Malaysia which manages very large trademark portfolios of clients, with several large profile clients with sizable trademark portfolios worldwide, namely the Astro and Petronas groups. With a team comprising of more than 100 support staff, clerks and lawyers and its international networks, the firm has the ability and capacity to handle urgent and bulk filings within the day. Other trademark clients include technology companies such as Google, Facebook and Tesla; pharmaceutical companies such as Johnson & Johnson and Pfizer; and luxury brands such as Louis Vuitton Malletier and LVMH Fashion Group, Hermes and BVGARI. Other top practitioners include Jyeshta Mahendran, Indran Shanmuganathan, Timothy Siaw, Janet Toh, Raghuram Supramanium and Sook Eng Sim.

Abe Sun, left, a partner at Baker McKenzie, receives the Malaysia Trademark Contentious Firm of the Year award on behalf of Wong & Partners, a Baker McKenzie member firm, from Asia IP's Espie Angelica A. de Leon.

Malaysia Trademark Contentious Firm of the Yearh

Wong & Partners, the Malaysia member firm of Baker McKenzie, is known for its work in patent litigation, filing and strategies. The firm has been engaged by La Pointique against its previous distributor, SJC Solex, in trademark infringement cases. Lead partner Kherk Ying Chew, one of the top litigators in the country, heads up the practice, which has advised both major Malaysian companies like Measat Broadcast Network Systems and international businesses.

MONGOLIA

Mongolia Intellectual Property Firm of the Year

IPPI focuses on IP and technology transfer matters, making it one of very few Mongolia-based firms doing IP work exclusively. D. Damdinbayar, a Mongolian patent attorney and member of the Association of Mongolian Intellectual Property Agents, says the firm can provide services including national phase PCT applications and filing patent, trademark and related applications in Mongolia. Damdinbayar spent more than a decade working in Japan in a Japanese patent attorney office and has brought high-quality service from that office to Ulaanbataar. The firm also operates a certified translation bureau that handles Japanese, English, Russian, German and Korean translations. The firm also serves as the Ulaanbaatar branch of Clover International Patent Firm in Tokyo.

Wong & Partners.
Member Firm of
Baker & McKenzie International

2024 Asia IP AWARDS WINNER

In a competitive and globalised marketplace, your brand helps define your business and sets you apart. At Wong & Partners, we help you protect your trademarks, optimise brand value, and secure your brand identity through our strategic trademark protection and portfolio management services.

Trademarks | Copyright | Patents & Industrial Designs | Commercial IP | IP Enforcement | IP Litigation

More information available at **www.wongpartners.com**

Myint Lwin, left, a lawyer at U Myint Lwin, receives the Myanmar Intellectual Property Firm of the Year award from Asia IP's Espie Angelica A. de Leon.

MYANMAR

Myanmar Intellectual Property Firm of the Year

U Myint Lwin Law Office is one of the most reliable firms in the country, with founder Myint Lwin providing consistent, high-quality service. The firm, which was founded in 1994, works with domestic and international clients in obtaining and maintaining trademark registrations.

NEPAL

Nepal Intellectual Property Firm of the Year

Janak Bhandari & Associates, previously known as Global Trademark Protection Services, was founded in

Greg Lynch, left, a lawyer and patent attorney at Catalyst IP, receives the New Zealand Patent Firm of the Year award from Asia IP's Darren Barton.

Hamish Selby, left, a partner at Buddle Findlay, receives the New Zealand Trademark Firm of the Year award from Asia IP's Darren Barton.

1997 and specializes in the protection and enforcement of trademarks, patents, copyrights and designs. Services offered include trademark searches, filing, prosecution and registration, renewals, licensing and franchising, IP litigation, anti-counterfeiting and anti-infringement actions. Janak Bhandari is the firm's principal lawyer.

NEW ZEALAND

New Zealand Copyright Firm of the Year

AJ Park houses a leading patent practice for both contentious and non-contentious works. For more than 130 years, AJ Park has helped companies and individuals identify, develop, protect, commercialize, manage, and enforce their IP rights in New Zealand, Australia and throughout the world in practice areas organized around specialist aspects of IP law, including copyright, patents, trademarks, designs, strategy and commercialization, plant variety rights, domain names, trade secrets, geographical indications, dispute resolution and litigation, border protection and renewals. AJ Park is part of IPH Limited, the intellectual property holding company.

New Zealand Patent Firm of the Year

Boutique firm **Catalyst Intellectual Property** houses a small but well-experienced team of professionals. With the technical backgrounds of its partners, the firm has developed particular strength in patent work. Greg Lynch is a registered patent attorney with expertise in chemistry. John Mansell and Emily Ellis are also directors at the firm. The firm handles many patent oppositions through IP Australia and the Intellectual Property Office of New Zealand.

New Zealand Trademark Firm of the Year

General practice law firm **Buddle Findlay** offers both contentious and non-contentious work with an emphasis on copyright and trademarks matters, including copyright litigation. The firm handles patent advisory, dispute resolution and litigation work, carries out anti-counterfeiting actions and provides transactional support to IP owners. Consultant John Glengarry, a specialist intellectual property lawyer with extensive experience both in New Zealand and overseas, co-leads the IP practice; he brings significant experience in copyright advisory and dispute work.

PAKISTAN

Pakistan Copyright Firm of the Year

Founded in 1972, **Ali & Associates** is an internationally-recognized full-service law firm specializing in IP, media and IT. The firm is led by senior partner Syed Auqil Ali Shah and managing partner Karimullah Adeni. The team is well-known for enforcement and litigation work, and has represented domestic and foreign clients in the cosmetic, chemical, textile, oil and gas, pharmaceutical, machinery, electronic, automobile and agriculture sectors. The firm has domestic offices in Karachi, Islamabad and Lahore, and foreign offices in Kabul and the Washington area.

Talib Ali Shah, left, a lawyer at Ali & Associates, receives the Pakistan Copyright Firm of the Year award from Asia IP's Darren Barton.

Pakistan Patent Firm of the Year

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

Pakistan Trademark Firm of the Year

Founded by Abdur Bharucha in 1948, **Bharucha & Co** is one of the oldest firms for patent and trademark prosecution work in Karachi. The firm collaborates with an IP-focused investigation agency, so time-restricted projects can be handled swiftly. It has developed an extensive and dynamic network of law firms in neighbouring countries, mainly South Asian and Gulf countries, to assure its clients of reliable assistance in said jurisdictions. The law firm filed an opposition against the application for registration of a local company's trademark on behalf of a foreign company – the real proprietor of the trademark – whose marks are already in use in many countries. The opposition was allowed and the local company's application was refused for registration.

PHILIPPINES

Philippines Copyright Firm of the Year

Cruz Marcelo & Tenefrancia's services include prosecution of applications for the registration of trademarks and patents and applications for issuance of copyright deposit; protection of business models, trade secrets and undisclosed information; IP commercialization; handling administrative, civil and criminal cases; dispute settlement; mediation involving IPRs; and anti-piracy programs and intellectual property enforcement cases. The firm

Carlo B. Valerio, left, a senior associate at Cruz Marcelo & Tenefrancia, receives the Philippines Copyright Firm of the Year award from Asia IP's Darren Barton.

works closely with clients such as visual artists, collective management organizations, art galleries, the heirs of a National Artist for Theater and Literature, and software developers, to name a few. Its experience in dealing with creators and artists from copyright protection, commercialization, and enforcement of their copyrights provides it a distinct advantage as a go-to firm in copyright matters. Susan D. Villanueva and Divina Gracia E. Pedron are senior partners who are key to the copyright practice.

CRUZ MARCELO &TENEFRANCIA

A LEADING PHILIPPINE FULL-SERVICE LAW FIRM

The Intellectual Property lawyers of Cruz Marcelo & Tenefrancia are well known for their ability to provide excellent and effective legal services covering the full spectrum of IP practice:

- Trademark, Patent and Copyright Prosecution
- IP Commercialization (Licensing and Franchising)
- IP due diligence, valuation and audit of IP assets
- Registration of technology transfer agreements
- Registration of food, cosmetics and drugs and all related regulatory matters
- Protection of business models, trade secrets and undisclosed information
- Patentability and clearance searches
- IP Litigation (Infringement and Unfair Competition: Opposition and Cancellation Proceedings)
- IP Enforcement

- Chambers Asia-Pacific, Band 1 for Intellectual Property (2019-2020, 2022-2024)
- The Legal 500 Asia-Pacific, Top-tier Firm in Intellectual Property (2016-2024)
- Asia Business Law Journal Awards, Top Philippine Firm in IP Enforcement and Protection (2019-2020, 2022/2023, 2024/2025), Top Philippine Firms in IP Protection (2018-2019)
- Asia IP, Copyright Firm of the Year (2014-2018, 2021), Tier 1 in Copyright Survey (2019-2020), Tier 1, Patent Contentious and Patent Prosecution (2020), Tier 1, Trademark Prosecution (2018) and Trademark Contentious (2020/2021)
- Asialaw Profiles, Highly Recommended for IP (2018-2020) and Outstanding for IP (2021-2024)
- Asian Legal Business IP Rankings, Tier 1 in Patent, Copyright, and Trademark (2018-2023), Philippine Law Awards, IP Law Firm of the Year (2016-2017, 2019-2020, 2022-2023)
- Benchmark Litigation Asia-Pacific, Tier 2 in Intellectual Property (2022-2024)
- IAM Patent 1000, Gold Band (2023)
- IP Stars, Ranked (2018, 2020-2024)
- The Asian Patent Lawyer Magazine Law Firm, Ranked in Top 10 Patent Firms (2020-2021)
- Who's Who Legal, Recommended for IP-Trademarks-Philippines (2024)
- World Trademark Review 1000 (WTR 1000), Gold Band Firm (2020-2023)

CONTACT PERSONS:

SUSAN D. VILLANUEVA - sd.villanueva@cruzmarcelo.com
PATRICIA A. O. BUNYE - po.bunye@cruzmarcelo.com
DIVINA GRACIA E. PEDRON - de.pedron@cruzmarcelo.com
ROWANIE A. NAKAN - ra.nakan@cruzmarcelo.com

MAIN OFFICE: 9th, 10th, 11th & 12th Floors, One Orion, 11th Ave. corner University Parkway
Bonifacio Global City, Taguig 1634, Metro Manila, Philippines
Tel. No.: +632.8810.5858 I Email: info@cruzmarcelo.com I Website: www.cruzmarcelo.com

Augusto R. Bundang, left, and Neptali L. Bulilan, right, attorneys at Sapalo Velez Bundang & Bulilan, receive the Philippines Patent Prosecution Firm of the Year award from Asia IP's Darren Barton.

Vida M. Panganiban-Alindogan, left, a partner at SyCip Salazar Hernandez & Gatmaitan, receives the Philippines Patent Contentious Firm of the Year award from Asia IP's Darren Barton.

Philippines Patent Prosecution Firm of the Year

Sapalo Velez Bundang & Bulilan is based in Manila with branch offices in Cagayan de Oro, Cebu, Davao and Iloilo. Led by managing partner Ignacio Sapalo and senior partner Neptali Bulilan, the IP team represents clients worldwide, including Toyota Technical Development Corporation, JFE Steel Corporation, Yamaha Motors Corporation, Sony Computer and Entertainment Inc., Unicharm Corporation and Dart Industries.

Philippines Patent Contentious Firm of the Year

Headquartered in Manila with branches in Cebu, Subic and Davao, **SyCip Salazar Hernandez & Gatmaitan** is one of the country's largest law firms in terms of client base and range of IP services. Led by partner Vida M. Panganiban-Alindogan, the IP team includes litigation specialists for *inter partes* and other administrative proceedings before IPOPHL as well as cases in courts. Panaganiban-Alindogan has successfully represented intellectual property owners and stakeholders in various negotiations and proceedings, which prevented

47 YEARS 1976
SVBB
Sapalo Velez Bundang & Bulilan Law Offices
The Philippines' leading Intellectual Property Firm
"2022 Patent Prosecution Law Firm of the Year, Tier 1"
- Managing IP
Established in 1976, the firm led by Ignacio S. Sapalo, a former Director of the Bureau of Patents, Trademarks & Technology Transfer, IP professor and author, is one of the Philippines' leading Intellectual Property law firms. Over the years, SVBB succeeded in diversifying its law practice to include Corporate, Tax, Immigration, IP enforcement and Litigation, representing clients from the U.S., Europe and Asia. It is also known as a champion of seafarers' rights.
The Partners
Ignacio S. Sapalo
Augusto R. Bundang
Neptali L. Bulilan
Romeo H. Duran
Romeo B. Fortea
Ma. Consuelo C. Agno
Dennis R. Gorecho
www.sapalovelez.com

the registration and, in certain instances use, of infringing third-party trademarks. She counsels clients regarding domain name issues as well as trademark and copyright issues in social media.

Philippines Trademark Prosecution Firm of the Year

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

Noemi P. Rivera, left, a principal at the Hechanova Group, receives the Philippines Trademark Prosecution Firm of the Year award from Asia IP's Darren Barton.

Philippines Trademark Contentious Firm of the Year

Angara Abello Concepcion Regala & Cruz (ACCRALAW) has assisted a famous U.S. fast food restaurant chain in successfully prosecuting an infringement/unfair competition case against a local company, as well as a trademark opposition case against another local fast food entity seeking to register a confusingly similar mark, and a European footwear company in protecting its trademark in the Philippines by successfully prosecuting a cancellation case against a local company that had been able to register the European company's trademark. It also recently assisted a Japanese footwear company in securing a conviction against a seller of counterfeit goods. Senior partner Alex Ferdinand Fider, partners Victor N. De Leon, John Paul M. Gaba, Richmond K. Lee and Jose Eduardo T. Genilo are top practitioners.

Richmond Lee, left, a partner at Angara Abello Concepcion Regala & Cruz (ACCRALAW), receives the Philippines Trademark Contentious Firm of the Year award from *Asia IP's* Darren Barton.

Pin-Ping Oh, left, a partner at Bird & Bird ATMD, receives the Singapore Copyright Firm of the Year award from Asia IP's Darren Barton.

SINGAPORE

Singapore Copyright Firm of the Year

Bird & Bird ATMD opened in Singapore in 2009 and has since represented high-profile clients, including Nestlé and Fox Network, in infringement disputes as well as the BBC, Discovery and La Liga in securing site blocking orders in Singapore, among others. More recently, the firm has acted for Fox Networks Group, for which it successfully acted against a copyright infringement claim brought by a music collecting society. The firm also handles global brand management and IP advisory work for one of the largest operators of serviced apartments in Singapore with a global presence. Lorraine Tay, who leads the firm's IP group in Singapore, is noted for her experience in international and cross-border issues. Anan Sivananthan is a top practitioner for patent and copyright matters.

Fiona Jeffrey, left, a senior associate at Marks & Clerk, receives the Singapore Patent Prosecution Firm of the Year award from Asia IP's Darren Barton.

Singapore Patent Prosecution Firm of the Year

Marks & Clerk comprises 15 attorneys and seven patent trainees in Singapore. The patent attorneys and

HECHANOVA
GROUP

Hechanova & Co., Inc.

IP Prosecution Specialists

Hechanova Bugay Vilchez & Andaya-Racadio, Lawyers

IP Contentious, Corporate

Passion for Service...
...Service with Integrity

Address: Ground Floor Salustiana D. Ty Tower, 104 Paseo de Roxas Avenue
Makati City 1229, Philippines
Tel. Nos.: (632) 8888-4293; (632) 8812-6561
Fax Nos.: (632) 8888-4290; (632) 8893-5878
Email: mail@hechanova.com.ph
Website: www.hechanova.com.ph

Pauline Khor, left, a partner at Rahmat Lim & Partners, receives the Singapore Patent Contentious Firm of the Year award on behalf of Allen & Gledhill from Asia IP's Darren Barton. Rahmat Lim & Partners is part of the Allen & Gledhill network.

patent trainees all have technical degrees, and most of the attorneys are qualified in two jurisdictions or more. Their strategy is to not only provide expertise in the law but also technical proficiency across a range of technologies.

Singapore Patent Contentious Firm of the Year

Allen & Gledhill provides advice on both contentious and non-contentious matters including prosecuting, enforcing and defending IPRs worldwide. Partner Stanley Lai heads the IP department. The firm represented Pfizer and Bristol Myers Squibb in patent linkage proceedings brought against Sandoz under the Health Products (Therapeutic Products) Regulations 2016 in the High Court of Singapore. Pfizer and BMS alleged that the acts for which Sandoz was seeking registration of its therapeutic products would infringe their Singapore-registered patents, seeking a declaration and injunction to restrain Sandoz' intended acts. There are few reported cases surrounding the patent linkage scheme in Singapore under the regulations; this litigation presents a valuable opportunity for the Singapore courts to clarify the laws and available remedies under the scheme. The firm has also been engaged in patent linkage proceedings on behalf of Pfizer and BMS against Natco, and Pfizer and Warner-Lambert against Natco.

Yvonne Tang, left, a director at Drew & Napier, receives the Singapore Trademark Contentious Firm of the Year award from *Asia IP's* Darren Barton.

"A one-stop shop for legal matters in Singapore and a real powerhouse of a firm in SE Asia."
– Client feedback, Chambers Asia-Pacific

Asia IP Awards 2024
Singapore Trademark Contentious Firm of the Year
Singapore Trademark Prosecution Firm of the Year

Asia IP Awards 2023
Singapore Copyright Firm of the Year

Asia IP Awards 2022
Singapore Trademark Firm of the Year

Asia IP Awards 2020
Singapore Trademark Firm of the Year

Asia IP Awards 2019
Singapore Patent Firm of the Year

Asia IP Awards 2018
Double winner at the 2018 awards:
Singapore Trademark Firm of the Year
Singapore Patent Firm of the Year

Asia IP Awards 2012 – 2016
Singapore Trademark Firm of the Year (5 consecutive years)

Singapore Trademark Contentious Firm of the Year

Drew & Napier is a full-service firm with expertise across the range of contentious and non-contentious IP work including litigation, trademarks and service marks, copyright and designs, licensing, distributorship, franchising and confidentiality agreements. The firm is a market leader in trademark filings, regularly among the top filers in Singapore. The firm advised Hotel Cirpriani (the opponent) against a Singapore trademark application for "Cipriani" in the name of Altunis Trading, which the firm has been advising since the beginning of this matter. The opponent was established in 1956 by, amongst others, Giuseppe Cipriani, Sr., who owned part of the shares in the opponent. In 1958, the opponent opened a hotel named Hotel Cipriani. In 1967, after various changes in the holding of the shares in the opponent, Cipriani sold his shares in the opponent to a third-party entity, making the said entity the sole shareholder of the opponent. The sale was governed by an agreement, which also stipulated the use of the Cipriani mark. The interpretation of the clause pertaining to the said use was disputed, with the opponent taking the position that it has the exclusive right to use (and register) the Cipriani mark. The Applicant disagreed and argued that it, too, had the right to use the mark. The opposition in Singapore was commenced on the basis that the subject application was filed in bad faith under Section 7(6) of the Trade Marks Act, in view of the agreement in 1967 and the clause pertaining to use of the Cipriani mark, and that the use of the mark in question was identical/confusingly similar to the opponent's marks, including Cipriani under Sections 8(1), 8(2), 8(4)(b)(i), and 8(7)(a) of the act. The matter is of particular interest as the opponent did not have a trademark registration for Cipriani in Singapore, and the hotel services provided by the opponent are not physically located in Singapore. These circumstances are not common to the typical trademark opposition proceedings where relative grounds of refusal are involved. This matter is related to an earlier opposition, in which the firm also represented the opponent, against Cipriani. In the past year, the value of IP matters handled by the firm exceeded US$134 million.

SOUTH KOREA

South Korea Copyright Firm of the Year

Since 1961, **Lee International IP & Law** has been a leader in South Korean IP with one of the largest and most active domestic practices, advising on patent prosecution, trademark registration, and a wide range of IP disputes, including patent and trademark litigation, anti-counterfeiting and infringement matters, domain name and copyright disputes as well as trade secret enforcement. Key contacts include managing partner Terry Taehong Kim as well as senior partners Jin-Hoe Kim and Yoon Suk Shin.

South Korea Patent Prosecution Firm of the Year

Based in Seoul since 1952, the **NAM IP Group**, formerly known as NAM & NAM, is one of the oldest IP law firms in the country. The team comprises patent attorneys as well as Korean and American attorneys-at-law. The clientele includes MNCs, NPOs, universities, SMEs and individual inventors. Ben Yuu, who was previously vice president and patent counsel at Samsung Electronics' IP Centre, is the managing partner.

Ben Yuu, left, managing partner at the NAM IP Group, receives the South Korea Patent Prosecution Firm of the Year award from *Asia IP's* Darren Barton.

Keum Nang Park, left, a partner at Lee & Ko, receives the South Korea Trademark Prosecution Firm of the Year award from *Asia IP's* Darren Barton.

South Korea Patent Contentious Firm of the Year
South Korea Trademark Prosecution Firm of the Year

Lee & Ko is a full-service law firm headquartered in Seoul. Lee & Ko's IP Practice Group advised and represented multinational companies covering a wide spectrum of industries including pharmaceutical & bio, chemical, mechanical, electrical, telecommunications, and computer software industries. Its patents team has set numerous Korean Supreme Court precedents and litigated landmark cases, including *Kimberly-Clark v. Procter &* Gamble and LG Life Sciences, a patent infringement claim in connection with Kimberly-Clark's diaper related patent in which the firm successfully vitiated the largest damages claim ever asserted in South Korea. Lee & Ko's patents team actively represented Samsung in the *Samsung v. Apple* worldwide patent dispute on smartphone technologies, which recently, resulted in the largest damages claim in the past decade in South Korea. On the trademarks side, the firm represents numerous foreign trademark owners, including Giorgio Armani, Prada, Jack Daniel's, Estée Lauder, Giordano, Williams Sonoma (the owner of Pottery Barn), Mars (the maker of M&M's), eBay, Chick-fil-A, Lacoste, Vera Wang and domestic trademark owners such as BTS, BLACKPINK, LG Household & Healthcare.

Jong Kyun Woo, left, a patent attorney at Kim & Chang, receives the South Korea Trademark Contentious Firm of the Year award from *Asia IP's* Darren Barton.

South Korea Trademark Contentious Firm of the Year

Based in Seoul and headed by Jay Yang, **Kim & Chang**'s IP practice is one of the largest in the jurisdiction, with some 400 IP litigators, patent attorneys and foreign IP attorneys, and nearly 600 patent engineers, trademark paralegals and support staff. The firm represented LEGO in a case against LegoChem Bio, which in 2016 filed applications for the subject mark, as well as for their "LegoChemBio" logo in English and in Korean (10 applications in total). Kim & Chang filed oppositions against them all but requested suspensions of the other cases, pending the dispute over the subject LEGOCHEMPHARMA mark. Lego's opposition was accepted on the basis of consumer confusion and dilution, but LegoChem Bio successfully appealed to the Intellectual Property Trial and Appeal Board (IPTAB), which thereafter also dismissed LEGO's invalidation action on the basis that consumer confusion would be unlikely, and denied the dilution claim. Kim & Chang successfully appealed the invalidation decision to the IP High Court, and LegoChemBio then appealed to the Supreme Court. The firm successfully argued that since the LEGO mark has obtained a very high level of fame in South Korea and the compared marks are similar, the reputation which LEGO enjoys as a result of its significant investments in its brand, the brand's marketing power and consumer appeal would be diluted from any use of the subject mark regardless of whether there is a likelihood of confusion or any competition between the parties' products.

Sabeera Shariff, left, an associate at Julius & Creasy, and Anomi Wanigasekera, managing partner at Julius & Creasy, receive the Sri Lanka Patent Firm of the Year award from *Asia IP's* Darren Barton.

SRI LANKA

Sri Lanka Patent Firm of the Year

Century-old civil law firm **Julius & Creasy** offers advice on enforcement, management and transactional matters pertaining to IP law. The firm has acted for several Fortune 500 companies and has acted as Sri Lanka correspondent of several trademark and patent attorney firms in Europe, the U.S. and Asia. Anomi Wanigasekera heads the firm's IP practice; she has extensive experience in the full range of enforcement, management and transactional matters pertaining to IP law. She also overlooks the drafting and reviewing of contracts at the firm, and advises on regulatory compliance matters. The firm has filed numerous patent applications, hundreds of patent renewals, and many responses to substantive examination reports

John Wilson, left, managing principal at John Wilson Partners, receives the Sri Lanka Trademark Firm of the Year award from *Asia IP*'s Darren Barton.

Sri Lanka Trademark Firm of the Year

John Wilson Partners offers clients responsive, professional and fast turnaround for all types of IP filings. Managing principal John Wilson has invested considerable resources over the years to develop in-house custom docketing software, which facilitates efficient handling of large client portfolios, applications and renewals. The firm advises the media and entertainment industries on corporate issues, production and rights acquisition, exploiting media rights, intellectual property protection and enforcement, and regulatory and administrative issues. It undertakes litigation involving claims in defamation and libel and handles recovery actions for unpaid foreign broadcasters. It advises broadcasters, advertisers, international and national associations, rights holders, agencies and promoters, studios, distributors, event promoters, sponsors and other leading corporations and individuals in the field. It also advises in regard to television programme format issues.

TAIWAN

Taiwan Copyright Firm of the Year

Taipei-based **Tsai, Lee & Chen** is particularly well-known for its work with high-tech patents. The firm has seen extensive growth in recent years, especially in its domestic patent department. The firm manages more than 30,000 patents and 18,000 trademarks worldwide. Victor S.C. Lee, Thomas Q.T. Tsai, Crystal J. Chen and Candy K.Y. Chen are top IP practitioners.

Julius & Creasy

est.1879

Julius & Creasy is a Civil law firm established in the year 1879. With its 145-year history, Julius & Creasy is the oldest law firm in Sri Lanka. Its reputation is one that has been built on rich tradition as well as the calibre of professionals passing through its corridors. The firm offers an extensive range of full legal services and a specialised Intellectual Property Department and advise on all aspects of IP.

The Intellectual Property division of the firm advises on diverse areas ranging from patent, trademark, copyright, industrial designs, domain names, involving sundry fields such as biotechnology, healthcare, pharmaceuticals, computers, software, media, entertainment etc. Our clients represent numerous multinational companies, which include a majority of the Fortune 500 companies. We also act for several leading Sri Lankan conglomerates. We are regularly instructed by some of the leading Trademark Agents in the UK, USA, EC, Australia, Japan, Hong Kong, Singapore, Malaysia and India.

We undertake a full range of enforcement, management and transactional matters. We advise foreign and local clients on the registration, clearance, protection and exploitation of Intellectual Property rights, as well as manage and co-ordinate our clients' Intellectual Property portfolios in Sri Lanka. We represent clients before the National Intellectual Property Office (NIPO) in respect of application, registration, ex parte and/or opposition inquiry, recording of assignment, recording of license, renewal of registration etc. of trademarks/patents or industrial designs to overcome objections. We regularly liaise with the relevant authorities and keep clients appraised of the status of their applications. We also undertake Intellectual Property audits and due diligence exercises and also file trademark applications with the Sri Lanka Customs.

Mrs. Anomi Wanigasekera, holder of LL.M (Wales) and Diplomas in Intellectual Property Law, International Trade Law, Banking and Insurance Law of Institute of Advanced Legal Studies of the Incorporated Council of Legal Education is in charge of the Intellectual Property Division of our firm., Ms Sayo Adachi, holder of LL.B (London), Ms Charuni Hewage, holder of LL.B (London), B.A. (University of Kelaniya), Ms Sabeera Shariff, Attorney-at-Law, holder of LL.M (University of Colombo), Ms Randula Seneviratne, holder of LL.B (Honours) (London), Ms Janaki Wanninayake, holder of B.Sc. Special (Honours) in IT (SLIIT), Mr B. Sidhdhartha,holder of LL.B (London) are professional Associates of the Intellectual Property Group.

No. 371, R A De Mel Mawatha, Colombo 3, Sri Lanka
Tel: +94 11 2422 601-5, +94 11 2421 056;
Fax: 94 11 24466 663, +94 11 2435 451
Email: anomi@juliusandcreasy.lk; pts@juliusandcreasy.lk
Web: www.juliusandcreasy.com

Bruce Ping, left, and Parkson Hsu, right, partners at Tsai, Lee & Chen, receive the Taiwan Copyright Firm of the Year award from *Asia IP*'s Darren Barton.

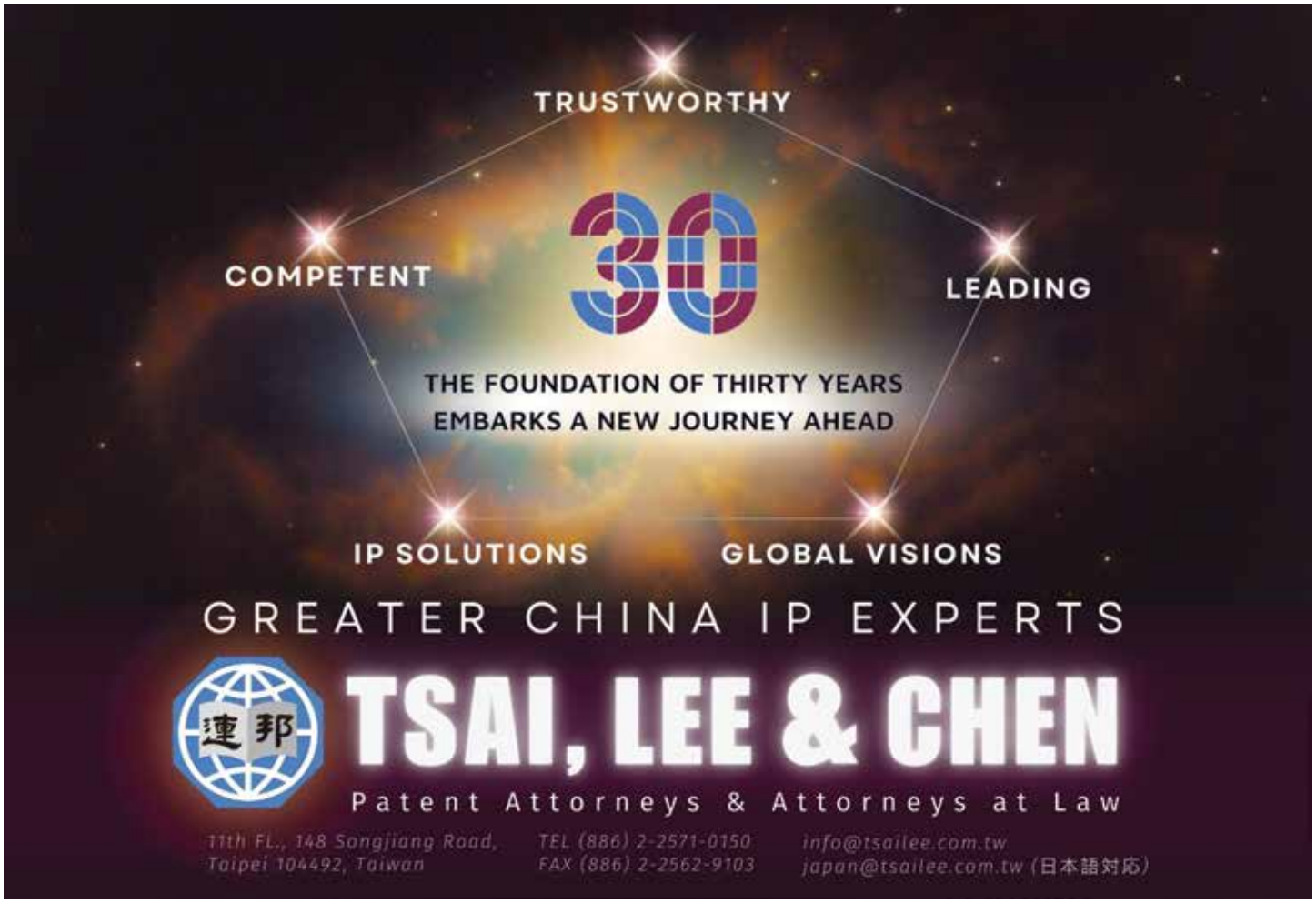
Yi-Sheng Yang, left, an attorney and patent agent at TIPLO Attorneys-at-Law, receives the Taiwan Patent Prosecution Firm of the Year award from *Asia IP*'s Darren Barton.

Taiwan Patent Prosecution Firm of the Year

TIPLO Attorneys-at-Law, also known as Taiwan International Patent & Law Office, was founded in 1965 by M.S. Lin and a group of professional legal and technical associates specializing in intellectual property rights. The firm is currently staffed by 285 full-time members, many of whom are multilingual professionals fluent in English, Chinese, Japanese, Taiwanese and other languages, who staff the firm's patent, trademark and legal departments. The firm is a leader in patent and trademark prosecution, invalidation and opposition proceedings, infringement assessment and validity appraisal, and is well-noted for its IP enforcement prowess, particularly for infringement litigation and coordination of police raids. During director J.K. Lin's tenure since 1997, he has set out to further streamline the hierarchy of the staff and adopted effective formulae leading to a significant quality improvement in the firm's services.

Taiwan Patent Contentious Firm of the Year

Tsar & Tsai is a full-service law firm founded in 1965 by Ruchin Tsar and Paul C. Tsai, and has grown to its present size of more than 70 professionals, including lawyers, trademark agents, patent attorneys and engineers. The firm has considerable experience and expertise on IP matters, including the protection of trade secrets. Partners Jennifer Lin and Joyce Ho are key contacts for IP matters.



LEE AND LI, ATTORNEYS-AT-LAW

Our firm, Lee and Li, is a full-service law firm. In response to the rapid developments in trade and technology and to satisfy the needs of our clients, we are constantly refining and expanding our practice areas. Now we have more than 20 practice groups, which cover corporate, investment, banking, capital markets, labor, tax, environment protection, litigation, intellectual property, and so on.

8F, No. 555, Sec. 4, Zhongxiao E. Rd.,
Taipei 110055 Taiwan, R.O.C.
Tel: (886-2) 2763-8000
Fax: (886-2) 2766-8855
General email: attorneys@leeandli.com
https://www.leeandli.com

理律法律事務所
LEE AND LI
ATTORNEYS-AT-LAW

Over the decades, we have built one of the largest intellectual property right practices in Taiwan; more specifically, together with our exclusive Chinese alliance firm, Lee and Li-Leaven IPR Agency in Beijing, we have successfully established a unique platform for our Greater China IP Services. We stay relevant by staying current on the latest developments in every industry and apply our legal skills to help clients achieve their business goals. Our services are performed by over 100 lawyers admitted in Taiwan, patent agents, patent attorneys, trademark attorneys, and more than 100 technology experts and specialists in various fields.

Joyce Ho, left, a partner at Tsar & Tsai, receives the Taiwan Patent Contentious Firm of the Year award from *Asia IP*'s Darren Barton.

May Chen, left, an associate partner at Lee and Li, and Ivy Chin, right, a senior counselor at Lee and Li, receive the Taiwan Trademark Contentious Firm of the Year award from *Asia IP*'s Patrick Chu.

Jerry Lin, left, partner and CEO at Tai E International Patent & Law Office, receives the Taiwan Trademark Prosecution Firm of the Year award from *Asia IP*'s Darren Barton.

Taiwan Trademark Prosecution Firm of the Year

Tai E International Patent & Law Office has about 280 staff and has developed into a highly respected international IP law firm providing a full range of services. The firm is specialized in IP prosecution, litigation and disputes, often involving cross-border elements. Its clientele includes entities in the life sciences as well as from pharmaceutical, automobile, electrical engineering, technology, and fashion industries. In 2021, the firm filed about 3,500 patent applications and about 6,000 trademark applications with the Taiwan Intellectual Property Office. Key IP practitioners include managing partner Fred C.T. Yen, partner and CEO Jerry C.Y. Lin and president Dewey W.C. Jeang.

Taiwan Trademark Contentious Firm of the Year

Lee and Li is a key player in Taiwan. The firm has formed an alliance with Leaven IPR Agency in Beijing to develop the mainland China market, and has a long-standing, collaborative relationship with Taiwan's Intellectual Property Office and is frequently called upon to provide consultation on the developments of the law and practice. It is also the key firm assisting the TIPO in preparing English translations of trademark-related laws, regulations and guidelines as well as Chinese translations of foreign articles and papers. It has been involved in a number of landmark cases, including the Hisamitsu sound mark and motion trademark cases, the three-dimensional "blue box with white satin ribbon" trademark case for Tiffany and Company and the three-dimensional trademark case for the Taiwan External Trade Development Council. The firm recently advised USA Pro IP to defend against a trademark revocation action. As the TIPO and the Board of Appeal of the Ministry of the Economic Affairs (MOEA) did not revoke all of the products designated to be used on the client's trademark, the applicant of the revocation action filed an administrative suit with the Intellectual Property and Commercial Court (TIPC). The firm successfully convinced the TIPC that "use of trademark" shall include use on the internet and provided additional supporting evidence, the TIPC maintained the decisions of the TIPO and MOEA. Since the trademark owner did not file an appeal, this case has become irrevocable and binding.

THAILAND

Thailand Copyright Firm of the Year

The Legal is a boutique law firm in Bangkok founded by experienced lawyers from several renowned law firms in Thailand. The firm provides legal services to clients from individuals to juristic entities and local to multinational companies, as well as government authorities. The full-service firm's IP practice is helmed by Panisa Suwanmatajarn, who is also the firm's managing partner. The firm advised a client who previously worked for a prestige magazine, providing etiquette training courses to their elite clientele. After departing the magazine on unfavourable terms, the client started her own competing business which offered similar upscale etiquette classes. The magazine took issue with our client's new venture, alleging it infringed on their branding and course materials and filed a criminal complaint against her claiming copyright violation over the name of her course and the training materials being substantially similar to what she had used while employed at the magazine. The firm uncovered draft documents proving the client had authored the written training descriptions herself prior to her employment with the magazine. As such, the magazine could not rightfully claim copyright over materials created by the client before the existence of an employment relationship. The magazine subsequently withdrew their complaint without any settlement or concession from the client.

Navigating IP Challenges? We're Here to Assist You.

mail@so-ipr.com www.so-ipr.com

Award-Winning
IP Expertise Across Southeast Asia

"Thailand Trademark Prosecution Firm of the Year"
"Vietnam Trademark Prosecution Firm of the Year"

AsiaIP IP EXPERTS 2022 | AsiaIP IP EXPERTS 2023 | AsiaIP IP EXPERTS 2024 | AsiaIP TRADEMARK SURVEY 2024 RANKED FIRM

SATYAPON & PARTNERS
THAILAND Intellectual Property Law Firm

THAILAND
CAMBODIA
LAOS
MYANMAR
VIETNAM

Kritsana Mingtongkhum
Partner

Satyapon Sachdecha
Managing Partner
Founder

Kritchawat Chainapasak
Partner

2024 AsiaIP AWARDS WINNER | 2023 AsiaIP AWARDS WINNER | AsiaIP PATENT SURVEY 2024 | AsiaIP TRADEMARK SURVEY 2024

The LEGAL 500 ASIA PACIFIC LEADING FIRM 2020 | The LEGAL 500 ASIA PACIFIC TOP TIER 2021 | The LEGAL 500 ASIA PACIFIC TOP TIER 2022

BOUTIQUE SERVICE
GLOBAL PROTECTION

OUR GLOBALLY RECOGNIZED AND AWARD WINNING TEAM PROTECTS THE IP RIGHTS OF OWNERS ACROSS ALL SPECTRUMS AND INDUSTRIES.

GET OUR WINNING TEAM IN YOUR CORNER
satyapon@satyapon.com

visit us at **www.satyapon.com**

Apiwatt Kongsoowan, left, a partner at Domnern Somgiat & Boonma, receives the Thailand Patent Prosecution Firm of the Year award from *Asia IP*'s Darren Barton.

Thailand Patent Prosecution Firm of the Year

One of the oldest and largest IP firms in the country, **Domnern Somgiat & Boonma** is led by partner Rutorn Nopakun. The practice handles almost half of the patent applications filed by foreign companies. Among its leading practitioners for patent work are Chakrapat Mongkolsit and Prabjote Busdee.

Loc Xuan Le, left, a principal at T&G Law Firm, receives the Thailand Patent Contentious Firm of the Year award on behalf of Tilleke & Gibbins from *Asia IP*'s Darren Barton.

Thailand Patent Contentious Firm of the Year

Tilleke & Gibbins is a leading regional full-service law firm with an outstanding IP team led by Darani Vachanavuttivong and Alan Adcock. Tilleke & Gibbins' boasts a patent team comprised of practitioners with highly technical expertise and credentials and an unrivalled breadth of industry experience. As the most active patent group in Thailand, we handle a full range of work in relation to patents, petty patents, and designs. This includes patent and design searches; registration and prosecution of patents, petty patents, and designs throughout Southeast Asia and in other countries; recordal of changes/assignments; annuity payments; oppositions; cancellations; watch services; infringement assessments; freedom to operate analyses; validity and invalidity assessments; registration of patent license agreements. Its IP litigation handles a full range of criminal and civil IP disputes, including disputes related to patents, trade secrets, infringement, invalidity, cancellations, appeals of decisions by the Board of Trademarks and Board of Patents, and other commercial disputes involving IP assets. The firm has successfully secured rare Anton Piller orders and emergency injunctions from Thailand's Intellectual Property and International Trade Court and Central Administrative Court.

Thailand Trademark Prosecution Firm of the Year

S&O IP deals with the full-range of IP matters in Thailand, from registration and commercialization to the enforcement of IP rights, with a strong focus on trademarks and copyright. The firm works closely with the Thai enforcement authorities including the Department of Intellectual Property, Economic Police and Thai Customs at all levels, and has an in-house investigation team that identifies sightings, conducting in-depth investigations and monitoring online counterfeits. Daniel Greif, the firm's director for Southeast Asia, has consistently been rated as one of the leading trademark lawyers in the Asia Pacific region; he is ably aided by deputy director Hau Nguyen. Over the past 12 months, S&O IP has been involved in a wide range of prosecution tasks including trademark search and analysis, application filing, opposition proceedings, portfolio management, etc., working with a diverse range of industries, ensuring that the trademarks align with the specific business needs and objectives of each client.

Patthariya Sirinunthaphapakorn, left, a senior associate at S&O IP, receives the Thailand Trademark Prosecution Firm of the Year award from *Asia IP*'s Darren Barton.

Thailand Trademark Contentious Firm of the Year

Satyapon & Partners was founded by Satyapon Sachdecha in 1995 and practices IP law exclusively. Sachdecha is a skilled lawyer who was president of the Intellectual Property Association of Thailand from 2009 to 2019 and is a lecturer of IP law at both Dhurakij Pundit University and Thammasat University. The firm has registered more than 28,000 trademarks in Thailand alone. Its in-house investigations and enforcement team executes more raids each year than any other firm in Thailand, working closely with the Royal Thai Police, Customs and the Department of Special Investigations (DSI). Over the last 12 months, the firm has filed more than 120 complaints at the IPIT Court against the Trademark Office's erroneous decisions. In over 90 percent of the cases initiated by the firm, it was able to deliver wins for its clients, including registering trademarks deemed unregistrable by the DIP, successfully cancelling a registered trademark on the ground of non-use, and invalidating trademarks filed in bad faith. It also took civil and criminal actions

Kritsana Mingtongkhum, left, partner, and Satyapon Sachdecha, centre, managing partner at Satyapon & Partners, receive the Thailand Trademark Contentious Firm of the Year award from *Asia IP*'s Darren Barton.

against several third parties on behalf of clients on the grounds of trademark infringement and/or passing off under the Trademark Act, Thai Civil and Commercial Code as well as the Thai Penal Code. In over 95% of the contested cases, it was able to get a favourable verdict from the IPIT Court, and appropriately punish the offenders. During various IP Infringement proceedings, the firm was also able to successfully reach a settlement upon request from the infringers to amicably settle the dispute. In doing so, it successfully managed to obtain record compensation amounts for its clients from the infringers.

Loc Xuan Le, left, a principal at T&G Law Firm, receives the Vietnam Copyright Firm of the Year award on behalf of Tilleke & Gibbins from *Asia IP*'s Darren Barton.

VIETNAM

Vietnam Copyright Firm of the Year

Led in Vietnam by partner and director Michelle Ray-Jones, **Tilleke & Gibbins** handles all aspects of IP, including anti-counterfeiting and strategic filing. In terms of contentious work, the firm has full in-house investigative teams in both Hanoi and Ho Chi Minh City, staffed with seasoned experts who have worked for top international law firms as well as law enforcement. Key contact Loc Xuan Le is a Hanoi-based principal at the firm's Vietnam affiliate, **T&G Law Firm (TGVN)**. Linh Thi Mai Nguyen, Trung Nguyen and Hien Thi Thu Vu are also key practitioners. Clients include Bulgari, Marriott International, Cole Haan, Merck, Pfizer, Thermos, Rolls-Royce Motor Cars and Otis Elevator.

Vietnam Patent Prosecution Firm of the Year

The IP group at **Vision & Associates** handles all aspects of IP including filings and prosecutions for patents, trademarks, copyrights, designs and internet domain names; availability searches; licensing and franchising; assignments and renewals; technology transfer; franchising and distribution; as well as enforcement. In the past 12 months, its annual patent filings accounted for approximately 15 percent of the total patent filings at the IP office of Vietnam. It provides professional patent services to many large foreign and domestic clients in a broad range of technical fields such as biotechnology, chemistry, pharmacy, material sciences, electrics, electronics, computer sciences, information technology, etc.

Hoang Thien Pham, left, a lawyer at Pham & Associates, receives the Vietnam Patent Contentious Firm of the Year award from *Asia IP*'s Darren Barton.

Vietnam Patent Contentious Firm of the Year

Not only is **Pham & Associates** the oldest (and one of Vietnam's premier) IP law firms, it is also one of the biggest filers in the country. The firm provides one of the best all-around IP services in the country from offices in Hanoi, Ho Chi Minh City, Da Nang and Hai Phong. Its staff of more than 100 works in a broad range of technical areas including pharmaceuticals, chemistry, telecommunication, mechanics, electronics, biotechnology and material science. Its respected work in patent prosecution and enforcement has attracted an international clientele, including Honda, BMW and Johnson & Johnson.

Vietnam Trademark Prosecution Firm of the Year

S&O IP covers the full scope of IP services: copyright, trademarks, patents, industrial designs, copyrights, domain names, cybersquatting and online infringements, trade secrets, unfair competition, contractual IP, and provides wide range protection for its clients, from prosecution to enforcement of their rights, negotiation and drafting. The firm assisted a client in the energy industry in responding to the provisional refusal of their key mark in Vietnam and successfully helping it to register the mark. The mark had been provisionally refused in some classes in Vietnam due to citations, which is difficult to overcome. The firm suggested a comprehensive strategy for its client to respond to the refusal, including limitation of some goods/services in the refused classes to increase the distinctiveness of the mark compared to the cited marks, arguing on the overall differences of the

Hau Nguyen, left, a vice director at S&O IP, receives the Vietnam Trademark Prosecution Firm of the Year award from *Asia IP*'s Darren Barton.

mark and the cited marks, and arguing on the wide-use status of the mark and tradename, which have not caused any likelihood of confusion to consumers. Given arguments and evidence, the IPO agreed with the firm's response and issued a statement of grant of protection for the mark in Vietnam.

Abe Sun, left, a partner at Baker McKenzie, receives the Vietnam Trademark Contentious Firm of the Year award from *Asia IP*'s Darren Barton.

Vietnam Trademark Contentious Firm of the Year

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

ASIA-PACIFIC

Asia-Pacific Copyright Firm of the Year

After establishing its footprint in Asia-Pacific nearly 20 years ago, international commercial firm **Bird & Bird**'s Asia network comprises offices located in Beijing, Hong Kong, Shanghai, Singapore, Sydney, Dubai and Abu Dhabi with a team of over 140 lawyers and legal professionals. It also has teams advising on matters throughout ASEAN, Japan, South Korea and India.

Asia-Pacific Patent Firm of the Year

Tilleke & Gibbins is a leading regional full-service law firm with an outstanding IP team led by Darani Vachanavuttivong and Alan Adcock. With one of the largest trademark practices in Thailand, the firm regularly handles trademark searches, registration and prosecution of marks throughout Southeast

Victor Tse, left, and Pin-Ping Oh, partners at Bird & Bird, receive the Asia Pacific Copyright Firm of the Year award from *Asia IP*'s Darren Barton.

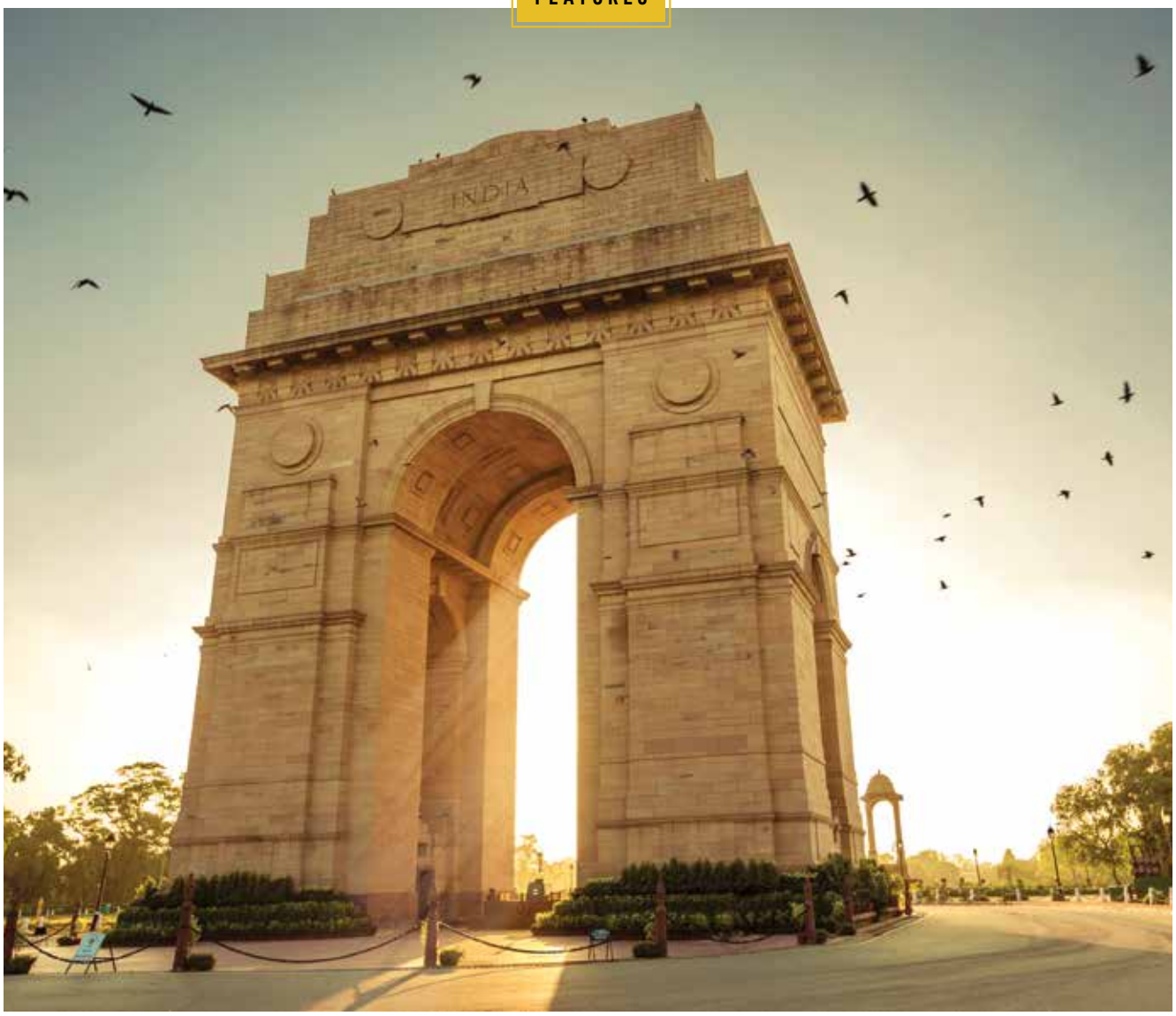
Loc Xuan Le, left, a principal at T&G Law Firm, receives the Asia Pacific Patent Firm of the Year award on behalf of Tilleke & Gibbins from *Asia IP*'s Darren Barton.

Bienvenido Marquez III, left, a partner at Quisumbing Torres, and Abe Sun, right, a partner at Baker McKenzie, receive the Asia Pacific Trademark Firm of the Year award from *Asia IP*'s Darren Barton.

Asia and in other countries, recordal of changes and assignments, oppositions, cancellations, renewals, registration of trademark and service mark license agreements, watch services, coexistences, due diligence, and customs recordals. The firm's list of clients includes AmorePacific, Amazon, BASF, Monsanto, Bayer, GAP, Dow Global Technologies, Grab Taxi Holdings, John Deere, Philip Morris, ThaiBev, Walmart and many others.

Asia-Pacific Trademark Firm of the Year

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



SEVEN KEY DECISIONS OF 2024 ON COMPUTER-RELATED INVENTIONS AND THEIR IMPACT ON HIGH-TECH INNOVATIONS IN INDIA

A 2019 ruling of the Delhi High Court held that CRIs demonstrating technical advancements beyond ordinary computing processes can qualify for patents. Even so, the IPO did not follow the decision with uniformity and rejected applications that may have otherwise proceeded to grant under the new standard. Applicants appealed the refusals, and in 2024, decisions were rendered setting the stage for a more uniform application of construing patentability of CRIs. ***Pankaj Soni*** reports.

In the most rudimentary sense, artificial intelligence (AI) involves complex algorithms, machine learning, data analysis, and computational power to solve problems, automate tasks, and improve efficiency across various domains. In this avatar, AI is increasingly becoming critical to businesses involving advanced, cutting-edge technologies and, consequently, is considered a cornerstone of the high-tech industry.

As the AI revolution gathers pace, the legal landscape for patenting AI-based inventions has never been more crucial. In India, Section 3(k) of the Indian Patents Act, 1970, expressly excludes, *inter alia*, "algorithms" and "computer programs *per se*" from patentability. A flurry of recent decisions have been permissive and made the position of the Indian Patent Office (IPO) clearer with regard to the patentability of computer-related inventions (CRIs); however, the IPO has not promulgated any Rules as yet to govern the examination of AI-driven inventions. Also, there is no AI-specific statutory framework in the country. In this context, will the Section 3(k) exclusion possibly stifle the patentability of AI-driven innovation? This is a question sought to be answered by this article by analysing AI-driven inventions through the lens of rulings regarding computer-related inventions (CRIs) and Section 3(k).

Section 3(k)

Over the years, the ambiguity surrounding Section 3(k) has led to significant debate on whether the provision appropriately balances the need for innovation with the goal of preventing monopolies on abstract algorithms and computer programs. The erstwhile Intellectual Property Appellate Board (IPAB) took some baby steps to offer clarity but was plagued with significant delays, consequent to which no clear direction emanated from its decisions. It was only after the Tribunals Act, 2021 abolished the IPAB did the country embark on a path of much-needed clarity on the interpretation of Section 3(k). With appeals from IPO decisions being heard by various High Courts, recent rulings have shed light on how CRIs should be evaluated for patentability and, correspondingly, how AI-driven inventions can overcome the algorithmic exclusion based on their technical contribution or transformative impact. Here's a look at seven key decisions of 2024 and their prospective impact on high-tech innovations in India.

2024 court rulings

The 2019 ruling of the Delhi High Court in *Ferid Allani v. Union of India* has proved transformative. Here the court held that CRIs demonstrating technical advancements beyond ordinary computing processes can qualify for patents, provided they offer real-world applications and technical effects. Even so, the IPO did not follow the *Ferid Allani* decision with uniformity in subsequent cases and rejected applications that may have otherwise proceeded to grant under the new standard. Several applicants appealed the refusals, and in 2024, quite a few decisions were rendered setting the stage for a more uniform application of construing patentability of CRIs.

In April, the Delhi High Court addressed Microsoft's appeal (IPD-PAT 185/2022) from the IPO's refusal under Section 3(k) holding that the invention was performed by a processing unit that executes computer-executable instructions, without inclusion of novel hardware (relying on the 2016 CRI guidelines). The operative issue was the interpretation of '*per se*' in the context of the eligibility of computer programs for patent protection under Section 3(k). In reaching its decision overturning the refusal, the court noted that the IPO erred in applying the novel hardware criteria. It agreed with Microsoft's position that the patent application addressed the technical problem of inefficiency in encoding blocks of 2D digital media data by partitioning the media data into macroblocks, applying a reversible 2D overlap operator offset from the borders of these blocks, and employing a reversible 2D block transform aligned with the borders of the macroblocks. The invention, the court found, provided a real-world application for complex mathematical transformations and integrated its operations into a hardware setup that directly contributed to improved system performance and efficiency.

Reaffirming a progressive standard and striking down reliance on the 2016 CRI Guidelines that mandated novel hardware, in *Lava v. Ericsson* (a case fundamentally related to an SEP battle), the Delhi High Court in March held that inventions that enhance *"the functionality of a system or hardware component, and meet all the criteria for patentability, can indeed be considered patentable*", subject to demonstration of a tangible technical effect. In *Lava*, the Court unequivocally stated that "*an invention should not be deemed a 'computer programme* per se*' merely because it incorporates algorithms and computer executable instructions... [and] if the subject matter is implemented on a general-purpose computer, but results in a further technical effect that improves the computer system's functionality and effectiveness, the claimed invention cannot be rejected as non-patentable.*"

Following this decision, in July, the Madras High Court, also in an appeal filed by Microsoft (PT No. 49 of 2023), clarified that Section 3(k) does not exclude all computer related inventions from patent eligibility. Here the IPO had refused the application on the grounds that the invention related to a computer program *per se*. On appeal, the Court analysed legislative history and jurisprudence to affirm that if a patent application involving a CRI "*results in a technical effect that improves the system's functioning and efficacy (effect on hardware), or provides a technical solution to a technical problem*", it would not fall under Section 3(k). After analyzing the invention, the court held that since the invention's technical effect lay in enabling the outflow of commands to unrelated applications from a single command surface, this outcome avoided the need of having multiple command surfaces and,

therefore, increased a system's efficiency. Since these features resulted in a technical effect that improved a system's functioning and efficacy, it did not form non-patentable subject matter and should be allowable.

Back at the Delhi High Court, on July 30, in AB Initio's appeal (IPD-PAT 26/2021) against a refusal, the court held that the invention claimed in AB Initio's patent demonstrated technical effect and structural features beyond a computer program *per se*, rendering the rejection unsustainable. AB Initio had filed two divisional patent applications focused on improving data profiling and analysis efficiency using specialized processing modules and the IPO had rejected both applications under Section 3(k).

On appeal, the patentee contended that the inventions showcased tangible benefits such as faster data processing, parallel processing capabilities, reduced storage requirements, and improved computational efficiency. These technical effects extended beyond the routine interaction between software and hardware. Further, specialized components like partition and rollup modules indicated a technical process distinct from mere algorithmic execution. The court agreed that the method increased computational efficiency, enabled parallel processing, and saved storage space without duplicating data, all contributing to a technical effect and, therefore, the invention was allowable.

A month later, on August 30, the Delhi High Court issued two decisions with differing opinions for Blackberry Limited, nuancing the evaluation criteria under Section 3(k). In the first *Blackberry* decision (IPD-PAT 229/2022), the court dismissed Blackberry's appeal contesting the rejection of its patent application. The court agreed with the IPO which had concluded that the invention for administering wireless systems to resolve configuration conflicts between primary and secondary servers was primarily algorithmic. Despite Blackberry's claims of technical contribution and inventive features, the court determined that the core of the invention was a sequence of logical instructions for regulating data flow between servers and devices and, therefore, non-patentable.

The court emphasized that Blackberry's invention failed to show hardware transformation or technical advancements beyond algorithms. It highlighted key parts of the specification, including references to "policy agents" and "communication policies," which indicated reliance on algorithmic processes. It also analyzed terms like "if-then-else" logic, concluding that the invention's contribution was inherently algorithmic, not technical and thus, non-patentable. Though the court criticized the IPO's reliance on inventive hardware, it reinforced that technical contributions beyond algorithms are required.

The second *Blackberry* appeal (IPD-PAT 318/2022)

fared better. Blackberry contended that the invention, relating to a method for managing media content based on confidence levels derived from metadata, did not fall under the ambit of a computer program *per se*. Rather, the invention presented a technical solution, offering advancements in dynamic media synchronization and storage management by automating file management by evaluating metadata to assign confidence levels to media files. Based on these confidence levels, media files are categorized, selected, and stored dynamically. The Delhi High Court analyzed the invention's ability to enhance device functionality by enabling dynamic media synchronization, categorization, and storage optimization. Features like cache management and metadata-driven categorization were deemed to provide technical effects beyond mere automation of user preferences. Thus, the invention was found to lie outside the ambit of Section 3(k).

Interestingly, the court considered persuasive the patent's acceptance in jurisdictions like the U.S. and Australia, emphasizing the invention's global recognition as novel and inventive, but also found the refusal by the EPO to be unpersuasive as it was based on criteria of the invention lacking novelty.

In November, in an appeal by Comviva Technologies (IPD-PAT 492/2022), the Delhi High Court set aside a patent refusal for being related to a computer programme *per se* and business method. The patent application in question aimed to improve the security of electronic payment cards through various measures. First, it stored electronic tokens on the card for a limited time, preventing unauthorized transactions using invalid tokens. Second, the token was only transmitted when the card was near the mobile device, minimizing the risk of token theft. Third, it incorporated two-step verification before authorizing any transaction.

Beyond a contention that the invention was a mere commercial transaction, the IPO emphasized the claims were essentially a set of executable instructions that neither demonstrated technical advancement nor exceeded the conventional interactions between software and hardware. As a result, the invention was excluded on the grounds of being a '*computer program* per se.'

The court analyzed the object of the invention and the subject matter of the claims and found that the invention improved security by eliminating invalid tokens and ensured only authorized tokens are accepted for conducting transactions. Thus, the invention did not relate to a business method or financial transaction but rather addressed a technical problem which was to prevent unauthorized transactions using electronic payment cards. The court also noted that the invention resulted in a technical advancement in contactless payments. After reviewing existing judicial precedents on the issue, and in view of the technical problem and technical advancement disclosed by the invention, the court found that the subject matter of the invention did not relate to a computer programme *per se.*

As if on cue, the Madras High Court, on the same day, in an appeal filed by Idemia (PT No. 198 of 2023), quashed a non-speaking order passed by the IPO refusing the grant of an application pertaining to a secure method for applying cryptographic calculation to a message through algorithms inserting arbitrary values into the elliptical curves. The invention applies cryptographic calculations using algorithms on elliptical curves, and is designed to mask encoded message information, and prevent timing attacks by ensuring constant computation time through probabilistic insertion.

On review, the court found that the invention passed the technical effect test as it results in improvement in calculation performance, while not allowing any attack linked to the execution time of the cryptographic calculation. The court allowed the appeal and noted that the IPO had failed to appreciate the practical application of the invention which, though based on an algorithm and/ or set of rules, is accompanied by several technical contributions.

Conclusion

All in all, 2024 was a good year for CRIs as the High Courts of Delhi and Madras passed judgments reinforcing the interpretation that hardware features are not required for computer-related inventions and a technical effect and technical contributions can overcome a seeming bias that an invention is nothing more than an algorithm. All indications are that this trend will continue into 2025 and beyond, which is particularly important for AI inventions as all such applications will be scrutinized under the CRI guidelines, at least until the Indian IP regime comes up with guidelines for AI related inventions. Stay tuned!

ABOUT THE AUTHOR


Pankaj Soni

Pankaj Soni is a partner at Remfry & Sagar, where he leads the patent litigation with several successes before high courts in India for Fortune 500 clients. He is recognized for his expertise in creating successful litigation strategies and handling technical aspects of claim construction and infringement/invalidity analysis. With experience in patent litigation in federal courts in the United States, his technical expertise includes electronics/telecom, mechanical and medical devices litigation. He has also led client negotiations relating to litigation settlements and cross-licensing agreements. He is also in charge of the U.S. desk at the firm, where he manages a team of patent prosecution attorneys handling electrical/electronics, computer and mechanical inventions. He is a sought-after speaker in various fora across the globe and is admitted to practice in India, New York and New Jersey.

Remfry & Sagar
Remfry House at the Millennium Plaza, Sector 27,
Gurugram – 122 009, New Delhi National Capital Region, India
T: +91 124-280-6100, +91 124-465-6100
F: +91 124-280-6101
E: remfry-sagar@remfry.com
W: remfry.com

Inception to realisation,

we tie it all together.

Shaping Intellectual Property law
for over 190 years

YOUR VISION. OUR EXPERTISE.

GURUGRAM | CHENNAI | BENGALURU | MUMBAI

TRADEMARKS | PATENTS | COPYRIGHT | DESIGNS
IP LITIGATION | PATENT LITIGATION | TECHNOLOGY.
MEDIA & TELECOM | PLANT VARIETIES & BIODIVERSITY
GEOGRAPHICAL INDICATIONS | CORPORATE LAW

www.remfry.com

GUIDING INNOVATION. SINCE 1827

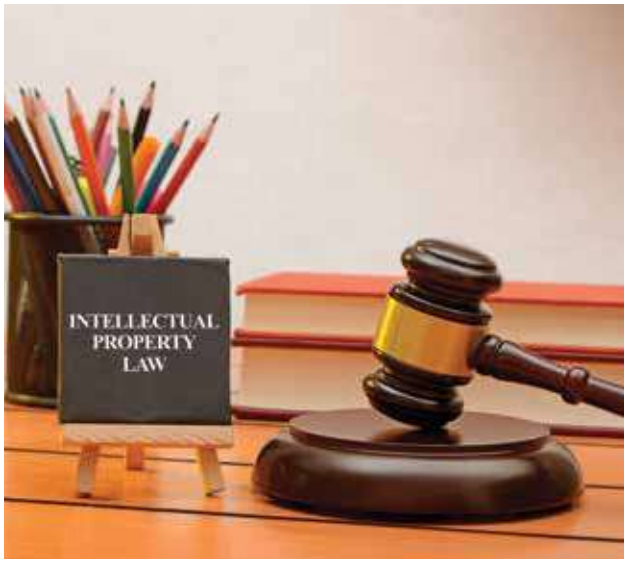
Remfry & Sagar
ATTORNEYS-AT-LAW

IP ASPIRATIONS FOR NEW YEAR

2025 presents a fresh opportunity to address emerging challenges. IP experts share with ***Excel V. Dyquiangco*** their primary aspirations for the evolution of IP laws and policies in the coming year, highlighting accessible IP systems, the role of AI, green technology and more.

As the global landscape of intellectual property continues to evolve, IP lawyers are setting their sights on a future where innovation and creativity are safeguarded more effectively than ever before. The coming year presents a fresh opportunity to address emerging challenges, from navigating the complexities of digital advancements to strengthening enforcement mechanisms in an interconnected world. With technological breakthroughs and cross-border collaborations reshaping industries, these legal professionals are committed to fostering a system that not only protects IP rights but also drives economic growth and cultural preservation.

At the heart of their aspirations lies the goal of creating a more robust and inclusive framework for IP protection. This includes advocating for clearer international regulations, enhancing enforcement strategies and embracing the potential of artificial intelligence (AI) in managing and securing IP assets. By aligning their expertise with the dynamic needs of innovators, creators and businesses, IP lawyers aim to ensure that intellectual property continues to be a cornerstone of progress and opportunity in the years ahead.



Primary aspirations

For 2025, what are your primary aspirations for the evolution of intellectual property laws and policies in the upcoming year?

"Looking ahead to the coming year and beyond, I would be hoping to see IP evolve into a more accessible tool for communities, not just corporations, to create value, foster innovation and offer protection – not merely focusing on monetary value, but perhaps add other forms of value, such as the protection of local art, local foods, of other cultural and societal relevant works," said David Mol, a senior associate at Tilleke & Gibbins in Phnom Penh. "IP should be regarded as a public policy too, not merely a tool for the private sector. I see this is already happening, with the concepts of Indigenous and traditional knowledge, and their intersection with IP, and I hope this trend continues to evolve."

Cross Liu, an executive manager at Rich IP & Co. and Rich IP International Patent & Trademark in Taipei, hopes that the evolution of IP laws and policies can pay more attention to green technology (environmental technology), especially how to encourage people to research and invent what can protect the Earth and keep up its life.

"Doubtlessly, some people with lofty ideals have been improving the pollution people made to the Earth and doing anything good for the health of the Earth, without any commercial purposes," Liu said. "Nevertheless, it is also undeniable that some people taking part in green technology aim to profit from it. Despite what purposes these people have, the more attention people pay to green technology, the more chances the Earth can be cured."

He continued: "In addition, an IP system is always a good inducement for those aiming to make profit to put resources into improving green technology. Therefore, it should be good for the Earth that parts of IP laws and policies can evolve in a way to attract more people to develop green technology. Of course, to ensure green technology can be implemented in emergencies, mechanisms such as the compulsory licensing of green technology patents should evolve accordingly."

In Nepal, the people are generally not very aware of IP rights. "In this backdrop, it is most essential to make people aware that IPRs exist and that violations can result in legal penalties," said Janak Bhandari, managing partner at Janak Bhandari & Associates in Kathmandu. "Additionally, it is crucial to encourage IP owners to pursue legal avenues for the protection and enforcement of their rights."

For Tris Xavier, an associate director at Yuen Law in Singapore, it is about AI. "Increased clarity and protection for creators in a world where AI is becoming more prevalent and in fact replaces some of the work that they do – how do we make proper attribution for those whose input from the database used in large language models (LLMs) and AI generators? How do we continue to incentivize content creators to create content when AI is bringing the technical barriers down, and how do laws and policies help with that balance?" he said.

Changes and benefits

What changes in global IP cooperation would you hope to see in the new year, and what benefits do you think these changes could bring to businesses and creators worldwide?

According to Mol, making IP protection more affordable is essential. "IP is a valuable tool to ensure innovation, and to perhaps put a price on innovation," he said, adding that there should be more accessible ways for smaller businesses and creators to be protected and enforce their rights. "Basically, using it to reward innovation and support investment in innovation."

"I opine that the harmonization of IP systems among different countries (regions) will still be a big deal in the years to come," said Liu. "As you know, each country may hope to establish its own IP system under the considerations including its economic development, technical level, industrial distribution, cultural characteristics, political situation and diplomatic strategies, and this may be why it is hard to harmonize IP systems among different countries. Even so, the primary IP offices (IP5) and World Intellectual Property Organization (WIPO) are still dedicated to realizing the harmonization, especially for procedural affairs. I go along with that the procedural affairs among different countries should be harmonized to the greatest extent because such a harmonization can facilitate the application or registration of IP rights in different countries without substantially affecting each country's concerns. Therefore, it is glad to see more global IP cooperation in the harmonization of IP systems in the upcoming year."

For Bhandari, "The world business was going down in the post-Covid-19 years, and the same also affected the world IP system. However, in the last couple of years, the global business has been reviving slowly. Therefore, I am expecting that there will be

some changes in global IP cooperation in the coming year, and I believe that the same will be more helpful in increasing global business, and the IP owners will also get the easy route to protect their IP rights worldwide."

"More regional initiatives to encourage cross-border IP cooperation would be helpful, such as collaboration between IP offices," added Xavier. "Separately, unification at some level globally would go a long way. One easy place to start is trademark classes – oftentimes, differences in descriptors and even spelling lead to costs for clients (though great for trademark agents and attorneys). Worldwide synchronization would go a long way to helping clients have certainties in determining how to plan for costs."

On IP enforcement strategies

"From the Cambodia perspective, there is a recent development that is very positive, in that Cambodia Customs is taking a much more active interest in IP enforcement, through adopting laws, and regulations, and very recently implementing a Customs Recordal system. We are yet to see if the actual implementation and execution of these new tools for Customs will lead to tangible results, but this is a great improvement in the overall legal system, and we expect this to lead to much more effective enforcement for Cambodia," said Mol.

Liu noted: "In my opinion, what industries relying heavily on IP protection worry about in IP enforcement

"It is most essential to make people aware that IPRs exist and that violations can result in legal penalties. Additionally, it is crucial to encourage IP owners to pursue legal avenues for the protection and enforcement of their rights."

—**JANAK BHANDARI**, managing partner, Janak Bhandari & Associates, Kathmandu

"Increased clarity and protection for creators in a world where AI is becoming more prevalent and in fact replaces some of the work that they do – how do we make proper attribution for those whose input from the database used in LLMs and AI Generators?"

—**TRIS XAVIER**, associate director, Yuen Law, Singapore

"IP should be regarded as a public policy, too, not merely a tool for the private sector. I see this is already happening, with the concepts of Indigenous and traditional knowledge, and their intersection with IP, and I hope this trend continues to evolve."

—**DAVID MOL**, senior associate, Tilleke & Gibbins, Phnom Penh

"An IP system is always a good inducement for those aiming to make a profit to put resources into improving green technology. Therefore, it should be good for the Earth that parts of IP laws and policies can evolve in a way to attract more people to develop green technology."

—**CROSS LIU**, executive manager, Rich IP & Co., Taipei

mostly relate to whether time-consuming litigation procedures can stop their loss in the IP infringement activities in time and how to calculate the actual damages for their loss with convincing evidence."

"However, there is always a balance between two parties with opposite grounds (sometimes the pros and cons of the public may also need to be considered together) needed to be considered by the authority as making or amending the rules for IP enforcement, so it is not easy to solve the dilemma in a way that satisfies everyone. In recent years, I have observed that some authorities have made some rules which allow the judges to compulsorily request the accused party to hand in the information helpful for calculating the damages for IP infringement under certain circumstances because such information is mostly held by the accused party. I go along with the change because such rules make the balance move to a fairer position and also benefit industries relying heavily on IP protection," he added.

Bhandari said: "Looking from my country's perspective, the number of IP violations would increase through several ways, i.e. through online or internet shopping, squatting, counterfeiting, among others. Therefore, it is required to changes in the laws to protect and enforcement of IPRs. As well, my country Nepal is drafting the new IP law and the same will be passed by the parliament and will be enforced soon."

"In a world with increasing globalization and access to online sales, it would be nice to see countries agree on a unified approach to dealing with ecommerce IP issues, including global parallel imports and distributorship agreements, and how far exhaustion can go as a defence where the mark is exhausted in a different jurisdiction. This would help agents seeking to bring in foreign products have greater certainty on how to structure their distributorship agreements and to factor in appropriate costs for among other things enforcement," said Xavier.

Economic and cultural growth

In your view, what role will intellectual property play in fostering economic and cultural growth in 2025, and how can IP professionals contribute to realizing this potential?

"IP professionals must be able to concisely explain the value-add of IP to businesses of all sizes, but also communities of all kinds, universities, individuals and others," said Mol. "For example, small business owners may not always understand the value-add of IP and the need to register IP, including sometimes investing in IP registrations. If IP professionals can bridge that gap, it should lead to more examples of smaller brands having value sitting in the IP, more designs bringing value or more patents bringing value. Ultimately leading to more innovation, as it can pay off to invest in this early on."

"Regarding the economic growth of a country, I think that IP rights can play two different roles. First, it is unimaginable nowadays that businesses can be run in a country with solid IP systems without any protection of IP rights. Thus, IP rights can play the role of exploiting foreign markets. On the other hand, to prevent other countries from maliciously contesting or destroying the domestic economy, the second role of IP rights is to defend against various economic attacks. As for cultural growth, I think that IP rights can conduce various exchanges (including technical, artistic and cultural exchange) among different countries or regions, and such exchange is important to domestic cultural growth. To realize the potential, the IP professionals should assist in building and maintaining a good enough IP system and adaptively guide the IP policies to an appropriate position," said Liu.

Xavier added: "The balance with IP law remains the encouragement of new creators to come forward and know their works enjoy some protection while protecting the goodwill and brand power of existing giants. IP professionals remain a valuable resource to guide clients on when to drop the hammer and (of course, subject to the client's wishes) pull back and urge some restraint. The world is a richer place with more innovation and invention, and IP professionals with their salient and measured advice can be a helpful bridge for innovation to appropriately thrive."

PROTECTING INNOVATION IN THE REAL ESTATE INDUSTRY

Technological advancements are reshaping real estate, necessitating a deeper understanding of intellectual property issues within the sector. ***Excel V. Dyquiangco*** discusses the critical role of IP in navigating these shifts and maximizing opportunities for development and competitive advantage.

Real estate and intellectual property may be viewed as two distinct industries, each with its own regulations, principles and market dynamics. However, the convergence of these two fields is creating a fertile ground for innovation and strategic growth. This intersection is not merely a byproduct of modern business practices but a reflection of the increasing complexity and interconnectedness of the global economy. For example, smart buildings have made integrating proprietary systems and patented technology necessary, increasing the dependence of real estate development on intellectual property issues. Moreover, trademarks and copyrights are increasingly important for branding and marketing real estate assets, significantly impacting how properties are seen and valued in the market.

As technology advances and globalization accelerates, the strategic management of intellectual property within the real estate sector will become even more crucial, driving innovation and offering new

pathways for competitive advantage.

According to Namrata Pahwa, an advocate at the Chambers of Namrata Pahwa in New Delhi, in the competitive world of property development, safeguarding innovative strategies and proprietary information in real estate is paramount.

"The concept of trade secrets becomes particularly relevant, as it encompasses a range of practices, methods and confidential information that, when kept hidden from competitors, can provide a significant business edge," she said. "And just like any other business, real estate developments can benefit from trademark protection for their names, logos or slogans. Both IP and real estate can have significant financial value. Intellectual property rights can represent valuable assets for companies, providing them with competitive advantages and revenue streams. Similarly, real estate properties have tangible value, either for their use or potential for development and appreciation."

She added that owners of both IP and real estate can monetize their assets through various means. "For example, real estate owners can generate income through renting or leasing their properties, while owners of intellectual property can earn royalties through licensing agreements or by selling their IP rights," she said. "Overall, understanding the relationship between IP and real estate is important for developers, investors and businesses looking to maximize the value of their assets and protect their creative works."

"Real estate developments can benefit from trademark protection for their names, logos or slogans. Both IP and real estate can have significant financial value. Intellectual property rights can represent valuable assets for companies, providing them with competitive advantages and revenue streams."

—**NAMRATA PAHWA**, advocate, Chambers of Namrata Pahwa, New Delhi

Building names

One of the most crucial parts to consider in real estate is selecting a building name. Pahwa said that the chosen name should not already registered or in use by another party in the real estate sector.

"You can search the trademark databases maintained by the relevant trademark offices, such as the United States Patent and Trademark Office (USPTO) in the U.S. or the European Union Intellectual Property Office (EUIPO) in the EU," she said. "Real estate falls under Class 42 of the Nice Classification. Additionally, conducting internet searches and consulting with a trademark attorney can help uncover any potential conflicts."

She recommended choosing a name that stands out and isn't generic to increase the chances of approval and brand recognition and avoid choosing a name that is not descriptive of its goods and/or services.

"Once you've determined that the building name is available for trademark registration, file a trademark application with the relevant trademark office," she said. "The application should include detailed information about the building name, its intended use and the goods or services associated with it. After filing the trademark application, monitor its progress through the registration process. The trademark office will examine the application to ensure that it meets the necessary criteria for registration, including distinctiveness and non-conflict with existing trademarks. If any objections or challenges arise during the examination process, your trademark attorney can help address them effectively."

According to Pahwa, the most important step overall is enforcement. She noted that IP owners can further protect their rights and maintain the distinctiveness of their brand if they regularly monitor the market and take prompt action against any unauthorized use of their trademark.

Architectural designs

Second is its architectural designs. Mudit Kaushik, an advocate at Delhi High Court and a managing associate at Anand and Anand in Noida, said that architectural designs can be safeguarded through both copyright and trademark protection.

"Copyright law protects the artistic expression of the architectural design, shielding it from unauthorized reproduction, distribution or adaptation as soon as it is fixed in a tangible medium like plans or computer-aided design (CAD) files. However, copyright does not extend to functional elements or standard building features. Registering architectural works with the appropriate copyright office is highly recommended to establish legal ownership and facilitate infringement remedies. Additionally, trademarks can protect distinctive architectural designs that serve as source identifiers for the architect or developer," he said.

In protecting architectural designs under copyright law, Kaushik emphasized the importance of maintaining comprehensive documentation, including dated sketches, drawings and CAD files. He also urged developers to prominently display copyright notices, such as the copyright symbol (©), year of creation and copyright owner's name, on all relevant materials. It's also crucial to have confidentiality or non-disclosure agreements (NDAs) when sharing designs with third parties to prevent unauthorized use or disclosure.

As for trademark protection, he recommended consistently using distinctive architectural designs and prominently displaying them to establish source recognition. Registering trademarks with the relevant trademark office can strengthen legal rights and enforcement options.

"Careful drafting of licensing agreements and contracts is vital when granting others the right to use or modify architectural designs. These agreements should clearly define the scope of use, limitations and any royalty or payment terms for both copyrights and trademarks. Regular monitoring for potential infringement is advisable, as prompt action can protect the design and deter future violations. Consulting qualified IP attorneys can provide valuable guidance on understanding rights, ensuring compliance with relevant laws and developing effective strategies for safeguarding architectural designs through copyrights, trademarks and other IP protections," he said.

But when acquiring or developing properties with pre-existing trademarks or copyrighted architectural designs, it's essential to conduct due diligence. Investigating, researching and complying are the three most critical aspects to look into when developing properties with pre-existing IP, according to Pahwa.

"At the outset, one must identify the owner of the trademark associated with the property. This could be the previous owner, architect or a separate entity entirely. The more thorough due diligence you do in the beginning will save more time and energy later. This includes reviewing relevant documentation, such as property deeds, construction plans and licensing agreements, to determine the extent of existing intellectual property rights. One must always respect someone else's IP," she explained.

It is also imperative to understand the extent of copyright protection. Does it cover the entire design, specific elements or just the blueprints? This will determine the level of permissible modification or redesign during development.

"Now comes the time to recognize usage rights," said Pahwa. "Negotiation might be needed to secure permission for continued use of the name for marketing or branding purposes. One must obtain the necessary permissions. If significant changes are desired, negotiate with the copyright owner to secure a license to modify the design. This could involve upfront fees or ongoing royalties. Consider the impact of pre-existing trademarks on the property's brand identity and marketing strategy. Developers should assess whether incorporating existing trademarks enhances the property's value or presents challenges in branding and positioning."

"By addressing these considerations proactively and seeking professional guidance, investors and developers can mitigate risks and maximize the value of properties with pre-existing trademarks or copyrighted architectural designs," she added.

"The rise of virtual real estate and the integration of augmented reality in built environments are necessitating significant changes in IP laws to address these emerging challenges. Virtual property rights have gained importance as platforms create robust digital economies around virtual land and properties."

—**MUDIT KAUSHIK**, managing associate, Anand and Anand, Noida

Addressing new challenges

With the rise of virtual real estate and the integration of technology in built environments, how are intellectual property laws evolving to address new challenges such as virtual property rights and augmented reality experiences within real estate developments?

Kaushik said: "The rise of virtual real estate and the integration of augmented reality (AR) in built environments are necessitating significant changes in intellectual property laws to address these emerging challenges. Virtual property rights have gained importance as platforms like Decentraland and The Sandbox create robust digital economies around virtual land and properties. Copyright laws now extend to digital creations, protecting virtual architectural designs and 3D models from unauthorized use and reproduction. Similarly, trademark laws are adapting to allow the registration of trademarks for virtual properties, thus safeguarding the brand identity of virtual real estate developers and preventing misuse in digital spaces."

"Augmented reality further complicates the landscape by overlaying digital content onto physical spaces, enhancing real estate experiences. Innovations in AR technology are being protected through patents that cover display technologies and interaction methods, securing developers' rights. Copyright protection also extends to digital content used in AR, such as virtual walkthroughs and interactive maps, preventing unauthorized replication. Additionally, data privacy laws like the General Data Protection Regulation (GDPR) set strict guidelines on data collection and usage, addressing privacy concerns associated with AR applications in real estate. These legal adaptations ensure that IP laws evolve to protect innovations and investments in the rapidly expanding sectors of virtual real estate and augmented reality," he added.

VIETNAM'S IP COURT READY TO TAKE OFF

As Vietnam prepares to establish its first dedicated IP court, ***Espie Angelica A. de Leon*** highlights how this development will strengthen the country's IP framework and build trust from local and foreign companies in its IP protection.

On June 24, 2024, Vietnam's National Assembly approved the amended Law on the Organization of People's Courts. The amendments were anchored on the creation of courts of first instance for hearing specific types of cases. These included cases dealing with intellectual property.

With the revised Law on the Organization of People's Courts entering into force on January 1, 2025, Vietnam will soon have its own specialized courts, including a dedicated IP court. "This development is considered an important milestone in the judicial reform process in Vietnam," said Nghiem Pham Xuan Bac, managing partner at Vision & Associates in Hanoi.

Why does Vietnam need a specialized IP court?

First, IP infringement activities are rampant. Not only are IP cases in the country rapidly increasing, but they are also becoming more complex and lengthy.

Second, the civil lawsuit mechanism in the country is often cumbersome, expensive and ineffective due to limitations and disadvantages under the civil procedural law. There are inconsistencies in substantive law in terms of copyright and industrial property rights.

Vietnam also lacks specialized judges for IP cases. "For a long time, local judges have not been familiar with IP matters, especially when it comes to complex issues of patent, design, copyright and trade secrets," revealed Hai Dinh, senior associate for enforcement at

"Previously, the general court system and adjudicating panels faced significant pressure from a high volume of IP cases. The specialized IP court, with its dedicated and highly trained judges, will alleviate this burden and improve adjudication efficiency."

—**THAI GIA HAN**, senior associate, Indochine Counsel, Ho Chi Minh City

"The court system is urgently conducting professional training sessions for judges to ensure the process of establishing the specialized IP court, which is expected to be established in Hanoi or expanded in Ho Chi Minh City and Da Nang."

—**QUOC CHIEN LE**, managing partner, Annam IP & Law, Hanoi

"The dedicated IP court could help expedite proceedings, reducing delays and backlogs that are common in general courts. It will enhance the timeliness and effectiveness of IP rights protection and enforcement in Vietnam."

—**NGHIEM PHAM XUAN BAC**, advocate, Chambers of Namrata Pahwa, New Delhi

S&O IP in Ho Chi Minh City. Training initiatives have been inadequate and ineffective, and the few trained ones are not even directly adjudicating cases. This partly explains the prolonged duration of the cases, leading to rulings that are inefficient and inconsistent, as well as a high rate of case reversals and amendments.

These factors cause IP rights holders to go for administrative measures such as negotiation and mediation instead of filing a case in court. The administrative route, via the market surveillance agencies or the Inspectorates of Science and Technology, is faster and less expensive than civil litigation. But there's a problem: No damages may be claimed.

Furthermore, administrative measures are not always a suitable avenue because of the very nature of IP.

"IP is a complicated field, and there are more and more disputes in this field which are not always suitable to be resolved through the administrative route," noted Hoa Tran, patent department director at D&N International in Hanoi.

"In many cases, administrative sanctions are not strong enough to handle the infringements resolutely nor it may deter the infringers from repeating the infringements," added Son Doan, founding and managing partner at IP Max in Hanoi. "The administrative enforcement authorities, while capable of handling straightforward infringements, would have difficulties in handling complicated infringements causing a delayed or never-ending process."

According to Doan, the number of IP cases handled through civil litigation is small compared to the number of cases resolved through administrative measures. From 2012 to 2015, there were 25,543 IP cases taken up via administrative enforcement. During the same period, there were only 43 IP cases handled via civil litigation. In 2020, IP cases handled through administrative measures totalled 1,302. There were 327 in 2021, 546 in 2022 and 644 in 2023. Meanwhile, only 403 cases by civil litigation were recorded from 2015 to 2022, and merely 12 in 2023.

"IPR infringements, except for making or trading of counterfeiting or pirated goods, are more characteristic of civil interest conflicts, i.e. infringing upon and causing damage to the rights holder than of consequences that might affect or harm the interests and order of the state and public as a whole," explained Doan. "Therefore, such infringements should be resolved through civil litigation between the parties rather than being handled administratively by enforcement agencies."

These challenges will soon be a thing of the past with Vietnam's very own IP court in the offing.

"In the digital era, IP rights play a crucial role in fostering innovation, attracting investment and ensuring fair competition while also bringing many consequences due to increasingly complex infringements. To address this, many countries, including Russia, the United States, Japan, Korea, etc., have established specialized IP courts to enhance IP protection, ensure consistency and leverage judicial expertise,"

shared Thai Gia Han, senior associate and head of IP and TMT at Indochine Counsel in Ho Chi Minh City.

Expectations from the IP court

Our interviewees said they expect the following from the IP court:

- *Training and appointment of IP specialized judges*

  "To the best of my comprehension, the court system is urgently conducting professional training sessions for judges to ensure the process of establishing the specialized IP court, which is expected to be established in Hanoi or expanded in Ho Chi Minh City and Da Nang," shared Quoc Chien Le, managing partner at Annam IP & Law in Hanoi.

  According to Doan, the dedicated IP court will facilitate and foster international collaboration, exchange and support in training judges with substantial knowledge and best practices in handling IP disputes.

  The training and appointment of highly capable judges is key to solving the other problems besetting Vietnam's legal system, particularly for IP lawsuits.
- *Streamlined procedures and timeframe*

  "The dedicated IP court could help expedite proceedings, reducing delays and backlogs that are common in general courts. It will enhance the timeliness and effectiveness of IP rights protection and enforcement in Vietnam," explained Bac.

  The IP court's pool of trained judges will help make this possible. As they bring their newly acquired knowledge to the table, cases will be handled more expertly, thus cutting down the duration of the resolution process.

  By shortening what used to be lengthy trial periods, the IP court will also ease financial requirements which otherwise would have deterred parties from pursuing their rights.
- *Reduced pressure on the general judicial system*

  "Previously, the general court system and adjudicating panels, which often lacked specialized expertise in IP, faced significant pressure from a high volume of IP cases. The specialized IP court, with its dedicated and highly trained judges, will alleviate this burden and improve adjudication efficiency," said Han.
- *Consistency in judgment*

  A team of judges with specialized knowledge in IP will result in fair, accurate, consistent, objective and timely judgments. This will help improve the effectiveness of IP rights protection in Vietnam.
- *Utilization of preliminary injunctions as stipulated in the current laws*

  This is another direct effect of having specialized IP judges. Dinh explained: "IP stakeholders always see the challenge in requesting the court approve the application of preliminary injunctions. Therefore, under the assessment of the specialized judge, it should be less challenging for the IP stakeholders to interpret the infringement as well as mitigate the

"IP stakeholders always see the challenge in requesting the court approve the application of preliminary injunctions. Under the assessment of the specialized judge, it should be less challenging for the IP stakeholders to interpret the infringement as well as mitigate the possible damages caused by the infringement."

—**HAI DINH**, senior associate, S&O IP, Ho Chi Minh City

"IP is a complicated field, and there are more and more disputes in this field which are not always suitable to be resolved through the administrative route."

—**HOA TRAN**, director, D&N International, Hanoi

"In many cases, administrative sanctions are not strong enough to handle the infringements resolutely nor it may deter the infringers from repeating the infringements. The administrative enforcement authorities would have difficulties in handling complicated infringements causing a delayed or never-ending process."

—**SON DOAN**, managing partner, IP Max, Hanoi

possible damages caused by the infringement."

- *Clearer guidance on damages*

  Seeking compensation in IP disputes is another major challenge. "Together with the foundation of the IP specialized court, it is expected that the Supreme Court will promote more updated and clear guidance on IP damages that practically encourages the IP stakeholders to pursue the damages that are suitable to the level of the infringement," said Dinh.

- *More simplified and less cumbersome paperwork requirements*

  "This issue is truly a great concern for lawsuits involving foreign elements, typically where plaintiffs are often foreign companies seeking to protect their IP rights in Vietnam," Tran said.

- *Stronger public trust in the IP protection system, more litigation activities*

  The IP court will also help promote confidence among IP rights owners, thereby encouraging them to bring their cases to the court. "In the long run, judicial proceedings in the event of IP disputes will reveal one of the most effective resolutions," Le stated.

- *More innovation*

  A strong framework for the protection of IP rights will further encourage individuals, businesses and academic institutions to innovate. "The specialized IP court can contribute to a more transparent and fairer legal environment for creators, inventors and businesses to protect and enforce their IP rights. Hence, it will encourage research, development and creativity in Vietnam," said Bac.

- *Greater public awareness of and education about IP*

  Having an IP court will benefit everyone in Vietnam as its very existence can raise public awareness about the concept of IP and educate people about their rights. People and organizations will begin to see the importance of IP rights and the role of IP in Vietnam's economic growth, cultural development and technological advancement.

- *Economic growth for Vietnam*

  "As the IP legal system is improved, Vietnam expects to see growth in high-value sectors. The specialized IP court strengthens Vietnam's ability to capitalize on its creative and technological potential, leading to more diversified and sustainable economic growth," said Bac.

Vietnam's place in the global community: The IP court's impact

On August 22, 2019, then-prime minister of Vietnam Xuan Phuc Nguyen issued the Intellectual Property National Strategy Until 2030 to promote innovation, contribute to Vietnam's economic, cultural and social development and increase the country's competitiveness. The IP National Strategy Until 2030 is designed to propel Vietnam into the ranks of ASEAN countries that are leading the region in terms of the creation, protection and exploitation of IP rights by the year 2030. Among its objectives are to significantly improve the effectiveness of IP rights enforcement and lessen IP infringement activities considerably. It also aims to increase the role of the courts in the handling of IP disputes.

A strong IP system is critical in creating a favourable business climate for enterprises, both domestic and foreign. Having a dedicated IP court will definitely strengthen Vietnam's IP framework, enabling local and foreign companies to trust that their IP rights can be protected in the country and that their enforcement actions will be efficiently and fairly resolved under its system.

"As highlighted by Chief Justice of Supreme People's Court Mr. Nguyen Hoa Binh, prominent Vietnamese brands such as ST25 Rice, Trung Nguyen Coffee, etc. have faced the challenge of having their ownership registered abroad without effective infringement resolution mechanisms. A specialized IP court will play a vital role in protecting such national brands and supporting Vietnamese businesses," said Han.

The same goes for foreign companies operating in Vietnam or planning to set up shop in the country.

"The establishment of the IP court signals to international investors that Vietnam is committed to upholding IP rights, which is crucial for attracting foreign investment, especially in high-tech and creative industries," Bac added.

A specialized IP court will also enable Vietnam to fulfil its commitments under the Comprehensive and Progressive Agreement for Trans-Pacific Partnership, the EU-Vietnam Free Trade Agreement and the Regional Comprehensive Economic Partnership, thus allowing the country to comply with global best practices.

The establishment of the IP court indeed marks a significant step forward for Vietnam, according to Han. "However, as with any new system, there will be challenges in moving away from the traditional court model," she said. "It will take time to implement, refine and optimize its operations."

Hence, there's much work ahead to ensure the success of the IP court. Aside from the training of judges, another important and urgent move is the issuance of detailed guidance and regulations for the court's operations.

"Looking ahead, I'm optimistic," declared Han. "With the proper implementation, sufficient training for judges and clear procedural frameworks, the specialized IP court has the potential to become a cornerstone of Vietnam's IP protection system."

Le agreed. "Although the exact time of operation of the specialized IP court has not been determined and to better understand such an establishment, it will be necessary to wait for further legal guidance documents together with numerous practical challenges in the early stages," he said, "then we can fully trust in bright prospects in the effective enforcement of IP rights in Vietnam eventually."

ASEAN

Singapore – *Fonterra Brands v. Consozio del Formaggio Parmigiano Reggiano*

In *Fonterra Brands (Singapore) Pte Ltd v. Consorzio del Formaggio Parmigiano Reggiano* [2024] SGCA 53 (*Fonterra*), the Court of Appeal illuminated the Singapore courts' position on the protection of geographical indications under the Geographical Indications Act 2014 (GIA). Fonterra Brands (a wholly owned subsidiary of a New Zealand-based cooperative company owned by 10,000 New Zealand dairy farmers) successfully satisfied the court that "Parmesan" is not a translation of "Parmigiano Reggiano". The respondent, Consorzio, is a voluntary consortium of Parmigiano Reggiano cheese producers and holder of "Parmigiano Reggiano" as a protected designation of origin under European Union law.

Background

Consorzio registered GI No. 50201900057U for "Parmigiano Reggiano" in Singapore. Subsequently, Fonterra Brands filed a request to qualify the rights conferred in respect of the GI, on the basis that "Parmesan" is not a translation of "Parmigiano Reggiano" (the request). Fonterra Brands' justification for the

request was that "Parmigiano Reggiano" cheese originates from specific Italian provinces unlike "Parmesan" cheese which can be made anywhere, and that the two cheeses differ in milk content, regulations, taste, colour and texture. Consorzio opposed the request.

Amazon Technologies Inc (the opponent) is widely known as one of the world's largest companies operating an ecommerce website (www.amazon.com), accessible to consumers worldwide and in Singapore. As part of their offerings, the opponent founded Amazon Game Studios to develop and publish video games. These video games are available on major gaming platforms, the Amazon app store, and both the Apple App Store and Google Play Store, under the "Amazon Games" mark and brand.

The principal Assistant Registrar (PAR) allowed Consorzio's opposition and rejected Fonterra Brands' request. The PAR held, *inter alia*, that only *a* translation of the GI is required and that the possible translation need not be the only one.

On appeal, the judge of the General Division of the High Court held that "Parmesan" is a translation of "Parmigiano Reggiano" after considering the probative value of three dictionary extracts tendered by Consorzio. The judge also ruled that a *faithful* translation which captures the meaning of the words in question should be adopted for the GIA's purposes, rather than a strict translation.

Fonterra Brands appealed against the judge's decision.

Meaning of a "translation" under the GIA

The court held that a "translation" under the GIA refers to a faithful translation of the registered GI, as a *whole*, which captures the term's essence at the time the request for the qualification is filed. Such translation must be *known* to the average consumer (*i.e.* Singapore citizens and residents) since a GI's function is to indicate to consumers that the product originates from a specific region. In the present context, the average consumer would lack specialist knowledge of cheese.

While the meaning of words in the dictionary may bear some relevance, the court emphasized that such meanings should not be taken to be the *definitive* authority and had to be contextualized. To this end, the court observed that consumer surveys may provide evidence of the term's general usage.

Whether "Parmesan" is a translation of "Parmigiano Reggiano"

The court highlighted that of the three dictionary extracts, the one which defined the Italian term "Parmigiano" as "Parmesan m" in French would require evidence to substantiate the assumption that the average Singaporean consumer is proficient in French or familiar with the meaning of "Parmesan m". However, no such evidence was before the court. The court further ruled that the other two dictionary extracts which defined "Parmigiano" as "Parmesan Cheese" in (British) English were meanings compiled by foreign publishers who may not have been informed of the word's usage in Singapore.

Instead, the court found that Fonterra Brands had adduced sufficient evidence to show that Singapore consumers regard "Parmesan" and "Parmigiano Reggiano" as referring to two different cheese products. Such evidence took the forms of product packaging and listings which showed that cheese sold as "Parmigiano Reggiano" (which had to originate from specified Italian provinces) was marketed differently from cheese sold as "Parmesan" (which were produced in other countries including New Zealand, Australia, Germany, South Korea and Japan); and online catalogues of Singapore groceries and cheese stores as well as Amazon Singapore which categorized "Parmigiano Reggiano" cheese *separately* from "Parmesan" cheese.

Conclusion

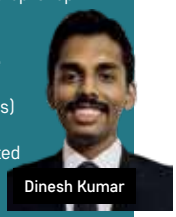
In light of its finding, the court held that the qualification that the protection of the GI "Parmigiano Reggiano" should not extend to the use of the term "Parmesan" should be entered into the Register.

The court's verdict in *Fonterra* aptly encapsulates its pronouncement that while the protection of GIs "safeguards the interests of Singapore's consumers by providing greater assurance that food products *truly* carry the characteristic that they are known for, and which are attributable to their geographic origin", the registration of GIs should not "prevent fair and established competition from products of a similar nature which have their origins outside of the registered geographical area".

ABOUT THE AUTHORS


Denise Mirandah

Denise Mirandah is 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.


Dinesh Kumar

Dinesh Kumar is an associate at Mirandah Law in Singapore. He graduated with an LLB (Hons) from the National University of Singapore in 2021. He is admitted as an advocate and solicitor to the Singapore Bar. Prior to joining Mirandah Law, Kumar worked at a mid-sized boutique litigation firm. His practice focused primarily on civil and commercial litigation. He was involved in matrimonial and commercial tenancy disputes, arbitration proceedings related to construction and maritime claims; and advised and represented banks in the recovery of outstanding sums under commercial and personal loan facilities.

mirandah asia (singapore) pte ltd
1 Coleman Street
#07-08 The Adelphi
Singapore 179803
T: +65 6336 9696
F: +65 6338 3739
E: singapore@mirandah.com
W: mirandah.com

INDIA

A year of milestones: Key trademark decisions shaping India's IP landscape in 2024

In 2024, India's trademark law experienced significant transformations, influencing the protection of both traditional intellectual property and emerging legal concerns. As we enter 2025, it's important to reflect on the most impactful trademark rulings over the past year, as these decisions have set important precedents and will likely guide future legal interpretations. From the protection of long-standing trademarks to addressing new challenges in the age of AI, 2024 has been a transformative year for India's intellectual property laws.

1. *Kabushiki Kaisha Toshiba v. Tosiba Appliances*: A landmark decision in trademark seniority

A standout case in 2024 was *Kabushiki Kaisha Toshiba v. Tosiba Appliances*, which centred on the Japanese electronics giant Toshiba's long-standing trademark. This case, which had been in the making for nearly 50 years, concerned the use of the deceptively similar mark "Tosiba" on electrical appliances by a local Indian player.

Toshiba, with a registered trademark in India since 1953, argued that its seniority over the mark should prevent any other business from using a confusingly similar name. The court upheld this argument, affirming that a trademark's registration is valid even if the mark is not used immediately, strengthening the concept of trademark seniority. This ruling emphasized the importance of honest adoption of trademarks and highlighted the difficulty in proving transborder reputation, setting a critical precedent in trademark law.

2. *Vishesh Films v. Super Cassettes*: Trademarking film titles

The case of *Vishesh Films v. Super Cassettes* in the Delhi High Court marked a significant step in the protection of film titles as intellectual property. Vishesh Films sought to prevent the release of the film *Tu Hi Aashiqui*, claiming it bore too close a resemblance to their earlier successful movie *Aashiqui*.

In a notable decision, the court ruled that the title of a film can be protected as a trademark, particularly when it has garnered significant emotional investment from audiences and

has become an established brand. The decision opened the door for future legal protections of film titles, recognizing them as standalone entities that deserve trademark protection in the same way as other commercial goods.

3. Reverse passing off in refurbished goods: *Western Digital and Seagate v. Daichi et al.*

In a case that brought attention to the complexities of the secondary market, *Western Digital and Seagate v. Daichi, Consistent, and Genonix* dealt with reverse passing off in the sale of refurbished goods. The plaintiffs, two major manufacturers of hard disk drives (HDDs), filed an injunction against refurbishers who were selling their products with the original trademarks removed.

The court ruled that refurbishers must retain the original trademarks on products and provide clear disclaimers that the products were refurbished and not covered by the original manufacturer's warranty. This case underscored the need for honest marketing practices and consumer protection, reinforcing the principle that consumer deception is a serious concern, even in the resale market.

4. *Wipro Enterprises v. Himalaya*: A case of trademark confusion in personal care

The legal battle between Wipro Enterprises and Himalaya over the trademark *EVECARE* highlighted the complexity of determining trademark confusion. Both companies were selling personal healthcare products under the same mark, leading to confusion among consumers.

This case reaffirmed the legal principle that the likelihood of confusion isn't determined solely by the products' class but also by their relatedness and overlap in consumer bases. The ruling clarified how courts would evaluate cases where two brands market similar products to the same target demographic, ensuring stronger protections against marketplace confusion.

5. *Jackie Shroff v. The Peppy Store*: Protecting personality rights in the AI age

A case that highlighted the intersection of celebrity rights and modern technology was *Jackie Shroff v. The Peppy Store and Ors.* In this case, Bollywood actor Jackie Shroff successfully sought an injunction against multiple defendants using his likeness, name, and slogans to sell merchandise. Additionally, AI chatbots impersonating Shroff were also involved, highlighting the growing issue of personality rights in the digital era.

This case is part of a broader trend where courts are increasingly protecting personality rights, particularly against unauthorized commercial exploitation in the age of artificial intelligence. Similar cases, such as *Arijit Singh v. CodibleVentures* and *Mohan Babu v. Phanumantu*, have further solidified this protection, paving the way for future legal battles involving AI misuse and personality rights.

6. Hot Cases to Watch in 2025

As we look ahead to 2025, several high-profile trademark cases are set to make waves in the Indian legal landscape.

- **Olfactory mark for rose-scented tyres:** A groundbreaking case involving a pending application to register a rose-scented tire as a trademark could set a precedent for scent-based trademarks in India. This case will test the challenges of defining and graphically representing scents under trademark law.
- ***ANI v. OpenAI*:** In a case with significant implications for AI and copyright, ANI will challenge OpenAI regarding the use of news agency data to train AI models. The ruling could reshape how AI interacts with traditional copyright principles.
- **The Butter Chicken Case:** In the ongoing dispute between Moti Mahal and Daryaganj over the origin of butter chicken, the legal implications could influence how food items and restaurant brands are protected, even though recipes themselves can't be trademarked in India. This case will highlight challenges in protecting culinary heritage and preventing unfair competition in the food industry.

Conclusion

The landmark decisions of 2024 have set new standards in India's trademark law, addressing emerging issues in AI, film, and secondary markets. These cases have reshaped the understanding of trademark protection and are likely to have a lasting impact on future disputes. As India's intellectual property laws continue to evolve, these decisions will undoubtedly influence the way businesses, consumers, and legal experts approach trademark protection in the years to come.

ABOUT THE AUTHOR


Vaishali R. Mittal

Vaishali R. Mittal is a litigation partner and strategist at Anand and Anand. Mittal has been engaged as a lead in many firsts and also some of India's most ground-breaking IP matters, including a case protecting personality rights of Bollywood actor Anil Kapoor against any misuse including by use of generative AI and dark patterns (*Anil Kapoor v. Simply Life*); India's first judgment on product-by-process patent claims (*Vifor International v. MSN Labs & Ors*); India's first *pro tem* security order (*Nokia v. Oppo*); the Aaradhya Bachchan fake news matter; India's first anti-anti suit injunction; India's first final judgment on standard essential patents; and an order directing an implementer to deposit *pro tem* security in favour of an owner of standard essential patent(s), before determination of infringement, validity etc. (*InterDigital v. Oppo* (2022-24); *Nokia v. Oppo* (2022)). Mittal has been consistently recognized as a leader in intellectual property by some of the most prestigious bench-marking tables.

Anand and Anand
Plot No. 17 A
First Channel Building,
Film City, Sector 16A,
Noida, Uttar Pradesh 201301
T: +91-120-4059300
F: +91-120-4243056
E: pravin@anandandanand.com
W: anandandanand.com

INDIA

PhD theses liable to be disclosed under the Right to Information Act, 2005

A PhD thesis is a work of original research that a student must submit to the university to complete their doctoral program successfully. Universities serve as custodians of PhD theses, entrusted with preserving and disseminating scholarly work to foster academic progress.

However, should this role of the university extend to locking away the theses, barring researchers and hindering the pursuit of knowledge? This question arose when Jamia Millia Islamia University (JMIU) in New Delhi withheld access to a PhD thesis, attaching commercial value to it. This practice not only contradicts the principles of knowledge sharing, a cornerstone of scientific and social advancement, but also deepens the divide between institutions and researchers lacking access to proprietary academic resources.

The controversy culminated in a legal battle after JMIU restricted access to a thesis titled *Studies on Some Nitrogen Fixing Genes of Azotobacter Vinelandi*. Once it was removed from JMIU's portal and library, access to it was not even granted to those scholars who were working in the same field and needed this thesis for their own research. When all doors were closed by JMIU, a request was made under the Right to Information Act, 2005 (RTI) to provide a copy of said thesis in 2019, but as expected, JMIU refused that request, too.

The Right to Information Act is one of the most accessible tools for people to obtain information under the control of public authorities. However, not all information can be disclosed. Section 8 of the act lists certain exceptions to the disclosure of information, such as information that is prejudicial to the sovereignty and integrity of India or that which is expressly forbidden by any court of law, etc.

While refusing the request to provide the aforesaid PhD thesis, JMIU resorted to one of these exceptions. The request was specifically refused under Section 8(1)(d) of the act, which prohibits disclosure of any information which is commercial confidence, trade secrets or intellectual property, the disclosure of which would harm the competitive position of a third party unless larger public interest warrants the disclosure of such information. This decision was then appealed before the Central Information Commissioner (CIC), who also dismissed the case on the grounds that the PhD thesis has gained immense commercial importance and that its disclosure would harm the competitive position of the stakeholders.

It is against this decision of the Central Information

Commissioner that a writ petition was filed before the High Court of Delhi titled *Rajeev Kumar v. Central Information Commission (CIC) Through CPIO & Ors.* [W.P. (C) 10118/2021], in which the court decided on the question of a PhD thesis qualifying as "information" under the Right to Information Act and whether it can be withheld under the exemption provided in Section 8(1)(d) of the same. LexOrbis represented the appellant before the court.

The court established a dual test for invoking Section 8(1)(d) – first, the information must fall under the categories of commercial confidence, trade secrets or intellectual property; and second, its disclosure must demonstrably harm the competitive position of a third party. Mere claims of intellectual property or commercial value without substantive evidence are insufficient grounds for exemption.

Attributing exclusive copyright to the author of the PhD thesis, the court also addressed the intersection of the author's exclusive rights vested in copyrighted work or right to apply for a patent and the disclosure of information held by the public authorities related to such works. The court outlined that there must be a balance between public access to information and the protection of authors' intellectual property rights. Section 8(1)(d) of the Right to Information Act protects information that could harm the commercial interests of a third party, such as trade secrets or proprietary information, which may also overlap with copyrighted material and that is at risk of being exploited.

However, the court opined that the mere existence of copyright does not automatically justify invoking Section 8(1)(d) to deny access to the information. Moreover, the court asserted that as soon as the thesis is submitted to a public university, the author relinquishes the right to withhold disclosure. Copyright law is not intended to curtail access to information; rather, it safeguards an author's economic and moral rights. That apart, Section 8(1)(d) of the Right to Information Act requires more than a mere assertion of intellectual property. It mandates evidence that disclosure would materially harm the competitive standing of a third party.

Highlighting the fiduciary role that the universities often play to protect the researcher's interest, the court acknowledged the restricted access to academic documents like PhD theses, which may contain proprietary information with potential for patent protection. In such cases, the disclosure would result in the thesis being treated as a 'prior art,' thereby jeopardizing the patentability of the invention. Section 8(1)(d) of the Right to Information Act may, in such cases, serve as a valid safeguard to prevent competitive harm to the researcher or institution. Similarly, Section 8(1)(e), which exempts disclosure of information held in a fiduciary capacity, could apply where the university holds the thesis as a trustee of the scholar's proprietary rights. However, even in these cases, the exemption is not absolute, as the Right to Information Act clearly states that the larger public interest can override these exemptions.

The court found that Jamia Millia Islamia University had failed to substantiate its claims of "commercial importance" or "competitive harm." The thesis, intended for public dissemination to advance research, was once publicly accessible and arbitrarily restricted without adequate justification. Consequently, the court held that the denial of access was unjustified and arbitrary, allowing the petitioner's writ.

This landmark judgment reaffirms the Right to Information Act's commitment to transparency while balancing intellectual property rights and public interest. It underscores the necessity for public authorities to present substantive evidence when invoking exemptions under Section 8. The decision also reinforces the principle that information held by public universities, especially academic works intended for public benefit, should not be shielded without compelling reasons.

By addressing the conflict between intellectual property and public access, the Delhi High Court has set a significant precedent that will shape future disputes under the Right to Information Act, commercial interest in a work and intellectual property rights associated therewith.

ABOUT THE AUTHORS


Manisha Singh

Manisha Singh is a seasoned IP professional holding a decorated career spanning over two decades and is reputed as one of the most distinguished lawyers in the domain. She started her career at a time when Indian IP laws and practices were undergoing substantial changes pursuant to India's obligations to comply with the TRIPS agreement. Through the years, she has been consistently involved in the betterment of the country's IP regime and has been engaged in advising Indian policymakers, implementers, and IP owners on global IP standards and enforcement systems. She is a true strategist and has led some of the most prominent and complex cases for large multinational and domestic corporations.


Anju Agrawal

Anju Agrawal is a partner at LexOrbis in New Delhi. She began her career as a litigator in 1996 and handled a diverse range of court cases for more than 11 years. In April 2007, she entered the field of intellectual property rights laws; she has since obtained several ex parte injunctions orders, John Doe orders, successful decrees through summary trials, awards in domain complaints representing various International and national entities before the Delhi High Court, the Bombay High Court, the Kolkata High Court and Delhi District Courts. She has also delivered lectures on trademarks and copyright in IPR seminars conducted by National Research Development Corporation (N.R.D.C.) & Bharat Heavy Electrical Limited (BHEL).

LexOrbis
709/710 Tolstoy House
15-17 Tolstoy Marg
New Delhi 110001 India
T: +91 11 2371 6565
F: +91 11 2371 6556
E: manisha@lexorbis.com
W: lexorbis.com

PHILIPPINES

Application of the dominancy test

On November 26, 2024, the Office of the Director General (ODG) of the Intellectual Property Office of the Philippines (IPOPHL) in the appealed case entitled *Suyen Corporation v. Otsumo Co., Ltd.* (Appeal No. 14-2023-0009), ruling in favour of Otsumo with a finding of no confusing similarity in the marks of the parties, shown below:

Suyen Corporation is a Philippine conglomerate most known for its clothing brand Bench, its flagship, and other clothing brands like Human and Kashieca. Otsumo Co., Ltd. is a Japanese company established in 2016 behind the lifestyle brand Human Made and changed its name to Human Made, Inc. on May 5, 2024.

Are the marks Human and Human Made confusingly similar? At the first level of the opposition proceedings, the adjudication officer (AO) ruled that the "use of the word 'human' compounded with another word 'made' enclosed in a heart logo with three slanted lines does not make Otsumo's mark distinctive as a purchaser may perceive it as 'made by human.'" On appeal, the director of the Bureau of Legal Affairs (BLA) reversed the AO's decision and held that "while there is use of the common element 'human,' such common element

SUYEN CORPORATION	OTSUMO CO., LTD.
HUMAN HUMAN human human HUMAN BRIGHT FUTURE HUMAN ETERNAL SHINE HUMAN NO REGRETS	HUMAN MADE

does not automatically lead to a finding of confusing similarity since there is considerable difference as to how the marks are depicted." He also said that the trademark registry shows that there are other registered marks using the word "human."

Dissatisfied with the BLA's decision, Suyen appealed to the ODG, claiming that the dominant element "Human" of Otsumo's mark cannot be ignored and that the addition of the word "Made" does not provide sufficient distinction and creates more confusion as to the source or origin of the goods. Otsumo countered that the BLA director correctly applied the dominancy test in the determination of confusing similarity, alleging that the dominant element is the whole word mark Human Made since it is the first prominent feature that captures the attention of the relevant consumer; that there is a wide disparity in the prices of the goods; that the target markets are different; and that Suyen cannot exclusively claim the word human.

The ODG decision: The ODG affirmed the decision of the BLA director and ruled that the main or dominant element of Otsumo's mark is Human Made and not merely the single element "human." The ODG emphasized, quoting the decision in the *Mighty Corporation v. E. J. Gallo Winery* case, that a very important circumstance is the likelihood that "an appreciable number of ordinarily prudent purchasers will be misled or simply confused as to the source of the goods…" Accepting the argument of Otsumo, the ODG stated that the wide disparity in the prices of the goods bearing the contending marks would make it unlikely for the consumers who are more "selective and discriminating in purchasing a piece of clothing, bag or accessory costing thousands of pesos and is therefore unlikely to be confused with another brand," and that "the big price difference is a sufficient indicator that they are in fact unconnected." The ODG also stated that Otsumo's merchandise can only be purchased through two local retailers, Hoodwink and Commonwealth, while Suyen's goods can be purchased through multiple chains of Human clothing stores and are available nationwide.

The dominancy test: The above decision of the ODG brings another dimension to the application of the dominancy test in finding confusing similarities between competing marks. Before 2021, there were two tests for determining confusing similarity: the dominancy test and the holistic test. While the dominancy test is expressly provided in the IP Code, practitioners and the courts applied both tests. However, the Supreme Court in the case of *Kolin Electronics v. Kolin Philippines International, Inc.* (G.R. No. 228165. February 9, 2021) made it crystal clear that in determining the resemblance of marks, it is the dominancy test which is prescribed by law that is the sole test and made it clear that the holistic test has been abandoned.

While there are no set rules as to what constitutes a dominant feature with respect to trademarks applied for registration, usually, what is taken into account are signs, colour, design, peculiar shape or name, or some easily remembered earmarks of the brand that readily attract and catch the attention of the ordinary consumer. What is considered the dominant feature of the mark is the first word or figure that catches the eyes or that part which appears prominently to the eyes and ears *(Seri Somboonsakdikul v. Orlane, SA, G.R. 188996, February 1, 2017).*

The dominancy test focuses on the prevalent features of the competing trademarks that might

UFC Philippines, Inc.	OTSUMO CO., LTD.
PAPA plus IRON & Vitamin A	Papa boy LECHON SAUCE
Citigroup Inc.	**CityState Savings Bank, Inc.**
citi CITIBANK CITIGOLD Citicard CITIFINANCIAL	

cause confusion. Courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences. Courts will consider more the aural and visual impressions created by the marks in the mind of the public, giving little weight to factors like prices, quality, sales outlets and market segments. *(McDonald's Corporation v. L.C. Big Mac Burger, Inc.,* G.R. No. 143993, August 18, 2004; *Dermaline Inc. v. Myra Pharmaceuticals Inc.*, G.R. No. 190065, August 16, 2010).

Word mark v. device: In the case of *UFC Philippines, Inc. v. Barrio Fiesta Manufacturing Corporation* (G.R. No. 198889, January 20, 2016) the court agreed with the IPOPHL that the word "Papa" (trademark of UFC for banana ketchup) is the dominant feature of respondent Barrio Fiesta Corporation's mark Papa Boy & Device (for "lechon" sauce), and that it is said a word which a purchaser recalls and not the smiling hog. The word "Papa" is written on top of and before the other words such that it is the first word or figure that catches the eyes, and the goods are closely related.

Device v. word mark: In the case of *Citigroup, Inc. v. CityState Savings Bank, Inc.* (G.R. No. 205409, June 13, 2018), the Supreme Court agreed with the IPOPHL that the Lion device of CityState's trademark "Citicash with Golden Lion's Head" is the dominant element of the latter's trademark, to wit:

The services covered by both marks include ATM services. CityState adopted the national symbol of Singapore, the merlion which made it unlikely for the ordinary purchaser to be confused. The IPOPHL noted that availing of the products and services related to the parties' marks would entail very detailed procedures, like sales representatives explaining the products and clients filling up and submitting application forms, such that customers would necessarily be well informed and not confused.

Conclusion: The dominancy test is the test to be applied in determining the confusing similarity of marks. Central to the application of this test is the determination of what catches the attention of the ordinary consumer, and unless the parties could submit some kind of top-of-the-mind trademark survey, which could be expensive to secure, it is the practitioner's research and argumentation that could save the day for either party.

ABOUT THE AUTHOR

Editha R. Hechanova

Editha R. Hechanova leads the HECHANOVA Group's intellectual property law practice. The HECHANOVA Group is made up of Hechanova & Co., Inc., an intellectual property consulting firm handling trademark and patent prosecution, copyright and domain name registrations, product registration, management, valuation, searches, and other non-contentious aspect of intellectual property, where she is President/CEO. The contentious IP practice is handled by the other member firm, Hechanova Bugay Vilchez & Andaya-Racadio law offices, which specializes in enforcement, litigation, alternative dispute resolution, licensing, corporate, immigration law and taxation. Hechanova graduated from the University of the East with a business degree, majoring in accounting, magna cum laude. She is also a Certified Public Accountant. She is a Certified Patent Agent having passed the Patent Agent Qualifying Examination (PAQE) conducted by the IPOPHL in 2008.

Hechanova Group
Ground Floor, Salustiana D. Ty Tower
Paseo de Roxas corner Perea Street
Legaspi Village, Makati City
Philippines 1229
T: (63 2) 812-5445
F: (63 2) 888-4290
E: mail@hechanova.com.ph
W: hechanova.com.ph

RUSSIA

Trust everybody, but cut the cards

It happens again and again with disturbing regularity. Russian companies are eager to collaborate with foreign partners and, usually, the collaboration is mutually beneficial. Sometimes, however, foreign companies are naïve with all their experience in business.

Intellectual property should be protected before a company goes to the Russian market. It is a truth universally acknowledged. Negligence to do that may be fraught with unpleasant consequences.

Lianyungang Forward Heavy Machinery Co. Ltd. is a well-known manufacturer of underground drill rigs and, as any company, wanted to expand its business activities elsewhere. Russia is a country where drill rigs are in high demand. There are a number of Russian companies operating in this field. One of them is TechService GNB Ltd. The history is silent about when and how the Russian company made acquaintance with the Chinese company, but their collaboration became very tight. So much so that the Russian company was not simply buying the products from the Chinese manufacturer and selling them in Russia but also was taking part in planning the

manufacture of the goods under the Chinese trademark. Even a joint venture was organized, which was later sold to the Chinese company in 2019.

A couple of years later, the Russian company filed a trademark application in 2021 and obtained registration No. 907180 for FORWARD in Class 07 reproducing the word "FORWARD", which is included in the trademarks owned by the Chinese company for more than 10 years and which is part of the name of the Chinese company.

The Chinese company sells its equipment in Russia not only to TechService GNB but to other buyers too.

In the meantime, the Russian trademark owner, after obtaining his unlawful registration began sending out warning letters and sued other businesses on the market who were buying the rigs from the Chinese manufacturer labeled with the designation "FORWARD". The lawful buyers experienced difficulties when they cleared the goods at customs and when they were selling the rigs on the market.

The trademark confused consumers with regard to the manufacturer of the products, so the Chinese manufacturer appealed against the registration. Information on the Chinese manufacturer of the drill rigs was accessible on the internet before the date of priority of the disputed trademark as well as currently.

The Chinese manufacturer sells his products to many countries to different buyers. Accordingly, those products may come to Russia from different countries and Russian consumers may buy the rigs from any Russian intermediaries being sure of the quality ensured by the Chinese manufacturer. Registration of the trademark in the name of the Russian company which is not the manufacturer misleads the consumers and brings chaos to the market, so much so that consumers aware that the owner of the disputed trademark was active in promoting the trademark on the market believed, indeed, that he was the real owner.

During the examination of the appeal, the Chinese company stated that the trademark owner did not have manufacturing facilities and did not manufacture the equipment in Russia but was only selling the drill rigs imported from China. At the same time, the owner of the trademark was in the process of establishing contacts with another manufacturing facility for the purpose of manufacturing the equipment under the same trademark, which once again confirmed his unfair behavior.

To support its position the Chinese company submitted documents galore and asked the Chamber of Patent Disputes to cancel disputed trademark No. 907180 in full.

The Chamber of Patent Disputes carefully examined arguments put forward by both parties. It emphasized that the law (Article 1483 of the Civil Code) does not allow registration of designations being false or capable of misleading consumers with regard to the goods or their manufacturer. False or misleading designations are such that engender impression in the minds of the consumers of the quality of the product and of its manufacturer.

The Chamber recalled the Paris Convention, according to which (Article 6-septies) *if the agent or representative of the person who is the proprietor of the mark ... applies without such proprietor's authorization, for the registration of the mark in his own name ... the proprietor shall be entitled to ... demand its cancellation ...* Also, according to the same Article, the owner of the trademark may prevent the use of the trademark if he did not approve that use. The Russian Civil Code has a corresponding provision in its Article 1512(2).

The appeal against the registration may be filed by an interested person. The term "interested person" is not defined in the law but in view of the circumstances described above it is clear that the Chinese company was more than interested. By the time of the priority of the disputed trademark the Chinese company had registrations 7 and FORWARD in China in the same Class 07, and the collaborating Russian company had full knowledge about those trademarks all the more that the rigs bought by it carried that designation.

The owner of the trademark went out of his way to prove that he was the lawful owner of the trademark, the details are omitted for the brevity of exposition. Notwithstanding, the Chamber of Patent Disputes canceled the registration in full by its decision of October 25, 2024.

The takeaway point of this case is that before taking any action aimed at collaboration with a person or company one should take stock of his intellectual property and protect it in the country with which the business is going to be developed. The rule is simple but, unfortunately, is not followed sometimes.

ABOUT THE AUTHOR


Vladimir Biriulin

Vladimir Biriulin is a partner at Gorodissky, where he is head of special projects. He specializes in IP rights protection, legal proceedings, technology transfer and the disposal of IP rights, including licensing, franchising and assignment agreements. He has represented a well-known American playwright in a case of copyright protection against several Russian theatres, resulting in licensing agreements with the author for using her plays, provided litigation support for a large European jewelry manufacturer in a criminal case in which the infringer mixed counterfeit with original products and sold them as originals, and provided transactional support for a large U.S.-based medical company on a range of licenses and sublicenses in several CIS countries.

GORODISSKY
INTELLECTUAL PROPERTY TMT

Gordissky & Partners
B.Spasskaya Str., 25, Bldg. 3,
Moscow 129090 Russia
T: +7 (495) 937-6116
F: ++7 (495) 937-6104
W: www.gorodissky.com

RUSSIA

Unregistered industrial designs as a subject of legal protection in the EU

Intellectual property is a broad category that includes many different objects of legal protection. Some of these objects are more popular and are reflected in the legislation of most countries. However, there are also those that are characteristic only of some legal systems. Among such objects is an unregistered industrial design, which, for example, is reflected in the legislation of the European Union.

Article 1 of the Paris Convention classifies industrial designs as objects of industrial property, which implies the application of the principle of national legal protection to them.

Industrial designs are also mentioned in Article 2(7) of the Berne Convention: *"The legislation of the countries of the Union may determine the extent to which their laws shall be applied to works of applied art and industrial designs and models, as well as the conditions for the protection of such works, designs and models. In respect of works protected in the country of origin solely as designs and models, only the special protection granted in that country to designs and models may be claimed in other countries of the Union; however, if no such special protection is granted in that country, these works shall be protected as artistic works."*

Depending on the legislation of a particular country, a product design may be protected by copyright, patent law or in the mode *sui generis*.

For example, in the European Union, industrial designs are protected precisely as objects of a "special kind", the provisions of which are reflected in a special regulation – in this case, Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs. Article 3 of the regulation defines an industrial design as *"the appearance of the whole or part of a product resulting from the features of the product, in particular the lines, contours, colours, shape, texture and/or materials of the product itself and/or its decoration."*

The said regulation introduces two forms of protection of industrial designs:

1) Registered, for which protection is obtained by following the relevant procedure with the registering authority;
2) Unregistered, an industrial design whose protection arises as a result of its proper publication.

In both cases, legal protection for industrial designs will be

granted if the industrial design meets the criteria of novelty and individual character (originality). At the same time, the moment of emergence of legal protection for unregistered and registered industrial designs differs.

Article 11 of the regulation establishes that an unregistered industrial design receives legal protection from the moment of publication of the industrial design in the territory of the European Union, including if it was published; exhibited at an exhibition; used in commercial activities; or disclosed in another way that allows specialists in a certain field to become familiar with the industrial design in the course of business activities. The term of protection of an unregistered industrial design in the European Union is three years from the date of its publication.

However, an industrial design cannot be considered as made public if information about it was disclosed to a third party in accordance with express or implied conditions of confidentiality.

At the same time, the date of origin of legal protection of a registered industrial design, according to Article 12 of the regulation, is the date of filing an application with the registration authority, and the term of legal protection itself can reach 25 years from the date of filing the application.

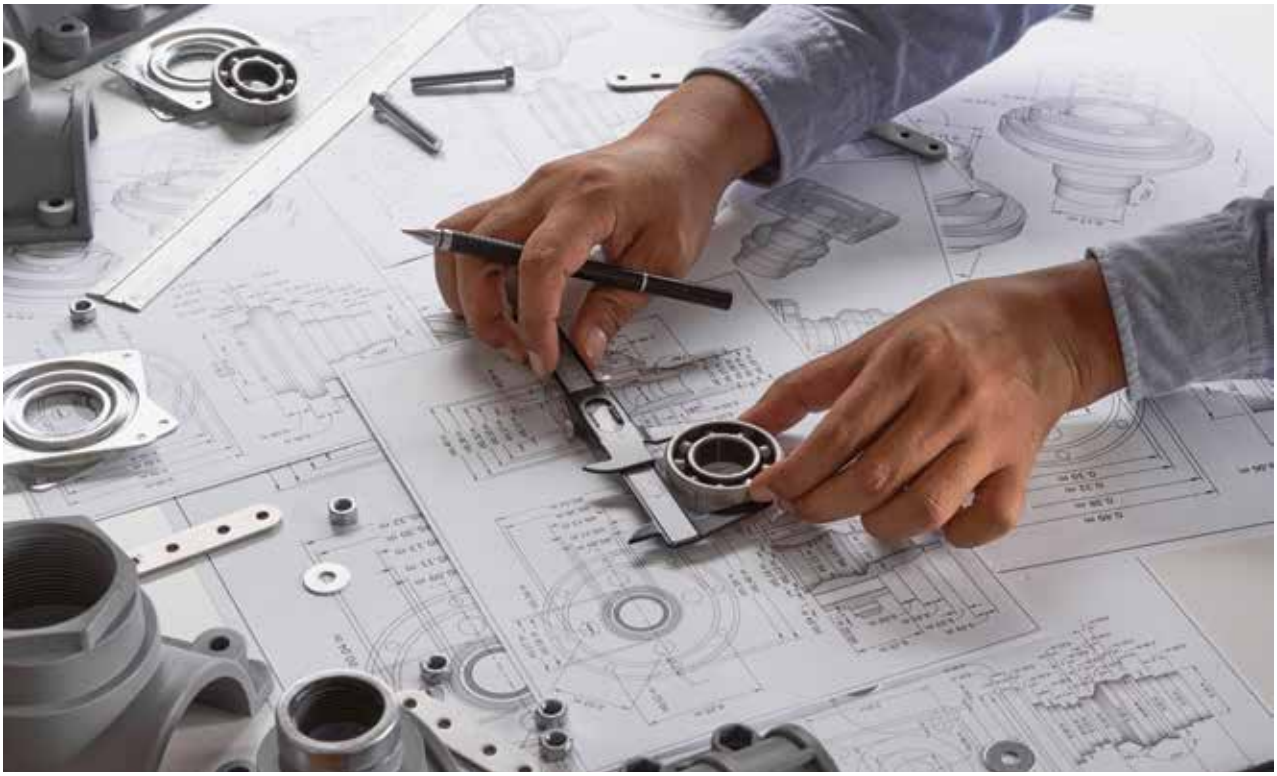
In addition to the moment of origin of legal protection and its term, an important difference between registered and unregistered industrial designs is the set of powers of the right holder, which he acquires in connection with the receipt of legal protection by the industrial design as an unregistered or registered design.

Thus, in accordance with Article 19 of the regulation, the owner of a registered industrial design has the right to use the registered design (including by manufacturing, offering for sale, importing, exporting products in which the industrial design is embodied), and also to prevent the use of his industrial design by third parties.

Meanwhile, the right of the copyright holder with respect to an unregistered industrial design is limited to its ability to protect its intellectual property from intentional copying. At the same time, an independently developed creative product by a third party will not be considered copying if it can be reasonably assumed that the third party was not familiar with the published industrial design.

With regard to disputes on infringement of rights in an unregistered industrial design, it should be noted that, in accordance with Article 95(2) of the regulation, if the right holder provides evidence of proper disclosure of the industrial design in accordance with Article 11 of the regulation, as well as an indication of how the originality of the industrial design is manifested, it will be presumed that the industrial design is valid (presumption of validity).

In *Karen Millen Fashions Ltd v. Dunnes Stores*, the court confirmed that it is sufficient for the right holder to indicate specific elements of the product's appearance that, in his opinion, give the design an original character. At the same time, the right holder does not have to prove that the industrial



design meets the criterion of originality, since this would contradict, among other things, the presumption established by Article 95 (2) of the regulation regarding unregistered industrial designs.

Meanwhile, it should be noted that there is a certain connection between unregistered and registered industrial designs.

Thus, an unregistered industrial design may represent a kind of "demo version" of a registered design. This means that the author or other owner of an unregistered industrial design may "test" the product in which the industrial design is embodied to determine its demand on the market, and then decide on the need to register it with the department. The regulations provide for a grace period of 12 months from the moment of disclosure of information about the industrial design, during which an application for registration of the industrial design may be filed.

The diversity of forms of legal protection of industrial designs is also due to the fact that some industries, such as the fashion industry, require a faster, unburdened by formal procedures, legal protection of design. This is primarily due to the fact that in certain areas, design solutions quickly lose their relevance due to frequent changes in trends and the need to constantly update the appearance of their products. In this case, the ability to protect a design from copying immediately after its publication is more valuable than obtaining a wide range of powers provided as a result of registering an industrial design.

To summarize the above, it can be noted that the existing order of protection of industrial designs in the European Union implies the possibility of choosing the protection of the design as an unregistered or registered industrial design. At the same time, it must be recognized that the narrower scope of legal protection of an unregistered industrial design compared to registered ones is compensated by the absence of the need to register them to obtain legal protection, which is more attractive for some industries. The envisaged variability of forms of protection of industrial designs allows everyone to choose the appropriate method of protecting the appearance of products that will meet the needs of a specific participant in economic turnover. AIP

ABOUT THE AUTHOR

Dmitriy Ratnikov

Dmitriy Ratnikov is a paralegal at Zuykov and partners. He holds a specialist degree in forensic expertise. His responsibilities include filing for the registration of licenses, sublicenses, and agreements on the transfer of exclusive rights. Currently, Ratnikov is studying for a PhD in civil law at the Russian State Academy of Intellectual Property.

Zuykov and partners

Zukykov and partners
28 Groholsky Street, 2nd floor
Moscow 129090 Russia
T: +7 495 775-16-37
F: +7 495 775-16-37
E: info@zuykov.com
W: zuykov.com

Providing Top-level Services and Developing Trustworthy Client Relationships

Since 1914

TOKYO-JAPAN

NAKAMURA & PARTNERS

中村合同特許法律事務所

PATENT TRADEMARK & LEGAL AFFAIRS

Address:
Shin-Tokyo Bldg., Room#616, 3-1, Marunouchi 3-Chome, Chiyoda-ku, Tokyo Japan
(Zip) 100-8355 (Phone) 81-3-3211-8741 (Main)
Patent Section: (E-mail) pat@nakapat.gr.jp (FAX) 81-3-3214-6358/9
Trade Mark Section (E-mail) tm@nakapat.gr.jp (FAX) 81-3-3213-8694
Legal Section: (E-mail) law@nakapat.gr.jp (FAX) 81-3-3214-6367
http://www.nakapat.gr.jp/

T **Trust**
Reliable and ethical IP services

H **Honesty**
Transparent advice and solutions

E **Enforcement**
Protecting IP rights against infringements

L **Leadership**
Guiding clients with innovative IP strategies

E **Expertise**
Specialized knowledge in IP law

G **Global Reach**
Ensuring IP protection across international jurisdictions

A **Advocacy**
Representing IP interests with dedication

L **Legacy**
Preserving and protecting IP value

ASIA IP

Thailand Copyright Firm of the Year 2024

We are honored to be continued for another year, recognizing our excellence in copyright.

This award highlights our focus and expertise in protecting the rights of copyright owners and also encouraging them to generate revenue from their creative works.

THELEGALTH INFO@THELEGAL.CO.TH
THELEGALTH WWW.THELEGAL.CO.TH

THE LEGAL
LEGAL & TAX ADVISORY SERVICES