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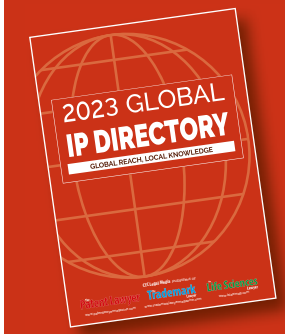

2023 GLOBAL IP DIRECTORY

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CTC Legal Media

Editor's welcome

After another year of extensive research into the world's leading IP firms, we are proud to bring you our latest extensive compilation with the 2023 Global IP Directory.

This up-to-date and exclusive directory lists a host of intellectual property firms from across the globe and does so in alphabetical country order to make the process of searching as streamlined as possible.

CTC Legal Media continues to create this publication to support and encourage intellectual property companies who want to actively promote their expertise with international clients and gain new business around the world. The publication is solely made up of listings, advertisements, and editorials from those firms actively seeking new business, in order to make your process of choosing a suitable law firm as efficient as possible.

Don't forget - all the information in this hard-copy publication is also listed on our websites. To view the full comprehensive list or conduct a concise interactive search by country or company, visit www.patentlawyermagazine.com & www.trademarklawyermagazine.com. All listings on our website will have direct links to the required company's email address, phone number, and website.

From all of us here at CTC Legal Media, we would like to thank the entrants for the information they submitted to us, our readers for their continued support, and all our clients for helping to compile this extensive intellectual property directory. We hope you find it to be an invaluable guide to the world's IP firms, and we look forward to working closely with you all in the future.

Best wishes for 2023 and beyond.

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CTC Legal Media's publications educate and inform professionals working in the industry by disseminating and expanding knowledge globally. They feature articles written by people at the top of their fields of expertise, which contain not just the facts but analysis and opinion. Important judgments are examined in case studies and topical issues are reviewed in longer feature articles. All of this and the top news stories are brought to your desk via the printed magazine or the website www.patentlawyermagazine.com and www.trademarklawyermagazine.com

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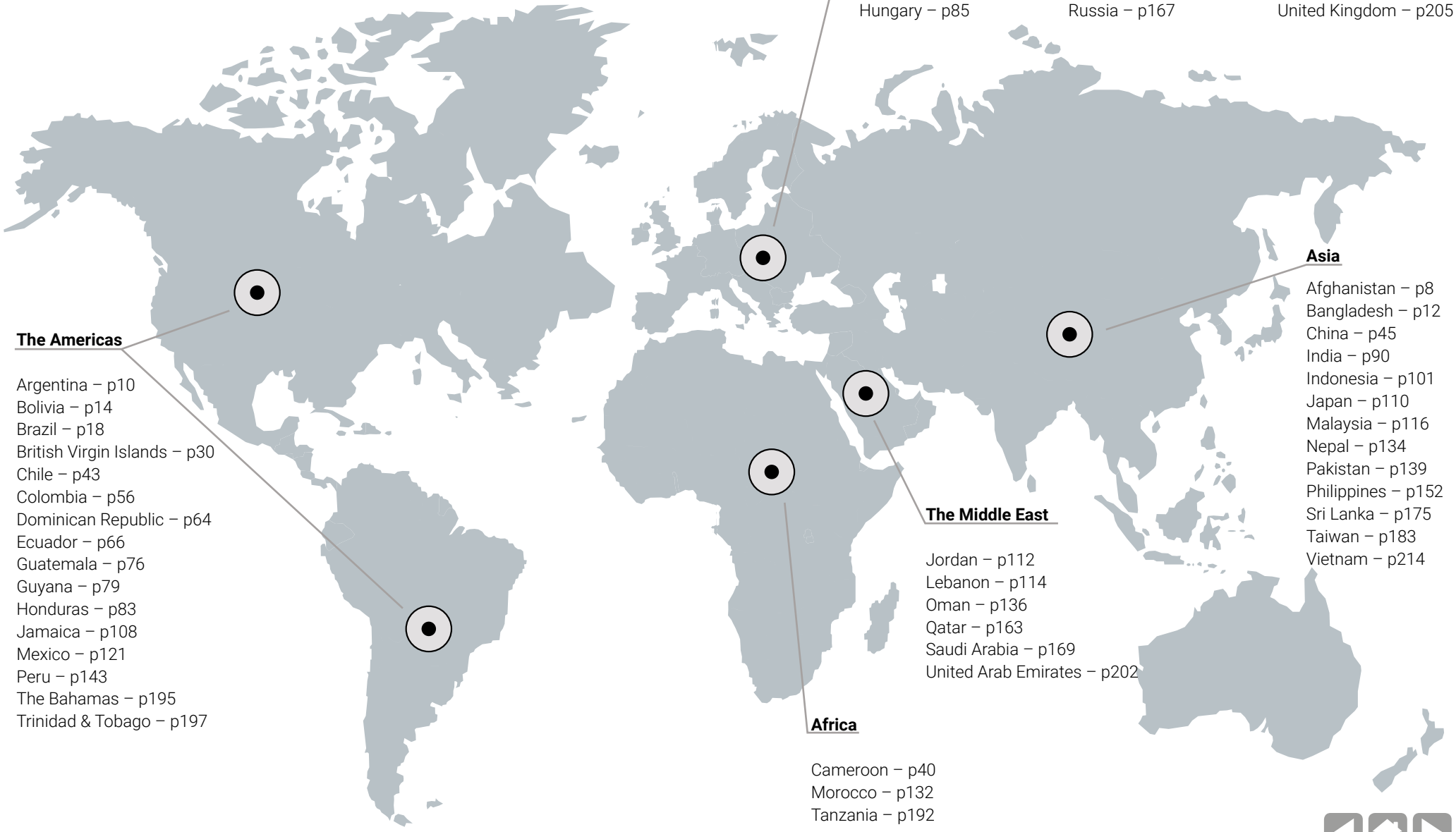

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Brazil

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Brazilian IP novelties for 2023: new and flexible rules for foreign licensors and investors in Brazil

Vaz e Dias Advogados & Associados details the changes in Brazilian IP law that are affecting remittance for royalties overseas, parent-subsidiary remuneration, know-how licensing, and recordation formalities.

The end of 2022 came up with relevant changes and good surprises that made the technology transfer environment more flexible and less dependent on state authorizations. On 30 December 2022, Federal Law no. 14,286/2021 came into force one year after its publication and introduced fundamental changes to the Brazilian technology transfer environment. One example of it is the revocation of the prior registration of technology transfer and licensing agreements at the Brazilian Central Bank (BACEN) for remittance purposes.

In addition, Provisional Measure 1,152 of 28 December 2022 was published by the President of Brazil, altering the applicable rules for withholding tax and implementing the price transfer mechanism in Brazil.

Last but not the least, the Brazilian Patent and Trademark Office (BPTO) published on 30 December 2022, the Minutes of an Internal Meeting held on 28 December with resolutions to improve the recordation procedure for technology transfer agreements.

This article aims to address such changes as they have updated the legal framework for technology transfer and have made Brazil a much more competitive market for the exploitation of technology and business transactions on intangibles.

> **Law 14,286/2021 revoked the requirement for registration of licensing and technology transfer agreements at BACEN for overseas remittance purposes.**

Remittance of royalties overseas

Firstly, Law 14,286/2021 revoked the requirement for registration of licensing and technology transfer agreements at BACEN for overseas remittance purposes and further established that the remittances in the form of royalties for technical, scientific, and administrative assistance will only depend on the evidence of payment of the income tax.

Consequently, the remittance of payments and royalties established in technology transfer agreements is now permitted by means of payment through any commercial bank without any state authorization, apart from the prior recordation at the BPTO. This new procedure significantly speeds up the operationalization and timeframe for remittance and receipt of payments abroad since a registration layer at the authorities has been eliminated.

The recordation of the licensing agreement at the BPTO is still required under the foreign exchange control laws for royalty remittances and to produce effects before third parties

> **Among them are changes that directly impact the deductibility of royalties and grant greater autonomy for related parties to negotiate.**

2023 GLOBAL IP DIRECTORY

as well as a condition for the payment to be considered an operational expense of the Brazilian licensee and, therefore, be calculated for tax deductibility purposes.

Under Law 14,286/2021, royalty remittances derived from patent and trademark applications are now accepted, since the BPTO recognized that a trademark application incorporates the ownership of the application into the holder's equity and therefore it may be an adequate subject matter for licensing to third parties. The exclusion for this restriction was followed by the BPTO's statement that it will not create obstacles for recording licensing and technology transfer agreements comprising Brazilian patent and trademark applications. This reinforces the freedom to negotiate between the contracting parties, in the sense that they can now expand and stipulate the calculation of royalties from the moment of filing the trademark.

The licensor does not have to await the conclusion of trademark and/or patent prosecution to receive royalties from the exploitation of its intangible in Brazil.

No more limitations on parent-subsidiary remuneration

Another relevant change in the technology transfer scenario has been the freedom for the contracting parties to set the limit of royalties when a foreign licensor and the local licensee are parent-subsidiary companies or hold a controlled-controlling relationship.

This freedom takes the lead due to the revocation of the sole paragraph of Article 50 of Law 8,383/1991 and Article 14 of Law 4,131/1962 which limited the payable royalties to a foreign licensor to the fiscal deductibility values set out by Law 3,470/1958 and Ministerial Ordinance 436/1958. According to the revoked rules, royalties would need to be within the limits of the fiscal deductibility, which range from 1% to 5% of the net revenue obtained from the sales of the licensed product depending upon the activity field in question for patents and a cap of 1% for trademarks. This was an unjustifiable hindrance to licensing and technology transfer, and its elimination was of great benefit to the parties, especially the licensor.

Therefore, according to the new ruling, the remuneration to a foreign licensor will no longer be limited by the fiscal deductibility limits and can be set by the rule of thumb, known as the *'arm's length principle'* or the prices commonly practiced in the international market. However, limitations imposed by the fiscal laws concerning fiscal deductibilities of royalties paid oversees to a licensor will be subject to the Transfer Pricing rules established by Provisional Measure 1.152 of December 28, 2022, as detailed below:

New transfer pricing rules

Regarding tax legislation, Provisional Measure no. 1,152/2022 was signed by the President of Brazil unilaterally, as he can implement laws in specific cases, such as urgency and importance to the economy and society. This Provisional Measure provided amendments to the Brazilian tax legislation and implemented the transfer pricing for companies that carry out transactions with related parties abroad (such as parent-subsidiary). Such legislation has brought several consequences for the Brazilian tax system. Among them are changes that directly impact the deductibility of royalties and grant greater autonomy for related parties to negotiate.

Before the amendments brought by the new rules of the Provisional Measure, the parties had to follow very restrictive and outdated deductibility limits determined by Normative Act 436 of 1958, which were based on a classification of the degree of essentiality of the products and activities for the Brazilian industry. The new Measure established that transactions between related parties for technology transfer agreements must follow the general rule of the *arm's length principle* and the analysis of economically relevant characteristics, such as the commercial terms and conditions of comparable transactions between unrelated parties.

It is important to note that payments due to entities established in a country with favored taxation or that benefit from a privileged tax regime are no longer deductible when the deduction of amounts results in double non-taxation.

This new legal framework aligns itself with regulations adopted by countries that are members of the Organization for Economic Cooperation and Development (OECD) and, thus, reduces the barriers that hinder Brazil's entry into said organization.

Also, for "intangibles that are difficult to value", the Provisional Measure provides for the need on a case-by-case situation for the taxpayer to adjust transfer prices "by determining annual contingent payments that reflect the uncertainties arising from the pricing or evaluation of the intangible".

Provisional Measure is under effect as of January 1, 2023, for Brazilian companies that chose to apply the new transfer pricing rules, but it still needs to be approved by members of the Brazilian Parliament to be converted into federal law. We remind you in this matter that Provisional Measure is a mechanism used by the President of Brazil to tackle urgent matters and address relevant issues affecting society and the economy. Therefore, few companies are recognized to be using the transfer price rules, as they are expecting the ratification by the Parliament and specific regulation that will address issues to the applicability of the transfer price mechanism applicable to royalty remittances between related companies.

Know-how licensing

Historically, the BPTO did not allow the licensing of know-how, but only its effective transfer to the Brazilian licensee, which often represented a hindrance in the agreements involving this type of technology in Brazil. Know-how licensing is now accepted for recordation purposes under the BPTO's publication of the Minutes of the Internal Meeting of 28 December 2022.

The practical impact of this alteration is that the BPTO no longer understands that the licensed know-how was transferred on a definitive basis to the licensee, which means that clauses addressing the cease of the know-how use or the return of the technology to the licensor with the termination of the agreement are now accepted by the BPTO's examiners.

This is indeed a comfort to a foreign know-how owners since there is a guarantee that once the agreement ends, the Brazilian licensee will no longer be allowed to use the know-how.

Further to that, it is understood that clauses stipulating confidentiality rules should be maintained for more than five years from the execution of the know-how licensing or the contractual termination. They are now fully enforceable under local laws.

Lesser formalities for the recordation of agreements

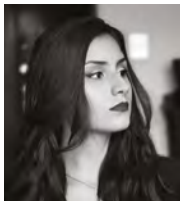
With regards specifically to the BPTO's minutes of the Internal Meeting held on 28 December, the main changes have been to the formalities to the recordation of licensing and technology transfer, as follows:

- Acceptance of digital signatures of the contracting parties without an ICP-Brasil certificate. Digital signatures are therefore accepted by other means of proving the authorship and integrity of electronic documents.
- Elimination of the notarization and Apostille requirements for the digital signature of the foreign party. Nevertheless, notarization and apostille are required when the signature is handwritten.
- Deletion of the requirements that set the need for the contracting parties and witnesses to place their initials on each page of the agreement. The BPTO may request, however, a statement from the attorney of the party requesting recordation to attest the veracity of the information.
- Suppression of the mandatory insertion of two witnesses in the agreement for recordation purposes when the contract indicated a Brazilian city as the place of signature.
- Elimination of the presentation of the bylaws of the Brazilian licensee, (also franchisee) for recordation purposes.

Final remarks

The new laws and regulations have eliminated unnecessary bureaucracies caused by legal and governmental interference set out since the 1950s. This means the contracting parties have more room to negotiate the rights and conditions for the exploitation of technologies, including those of a financial nature, and independently of the corporate relationship between the contracting parties.

This new business environment aligns itself with international practices for promoting technological innovation and economic development, making it possible to explore the full potential of the Brazilian market.



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Bruna Valois is an attorney-at-law and has specialized in international business transactions since 2014. She conducts the preparation and negotiations for commercial agreements in the technology sphere, in relation to matters such as technology transfer, licensing of intellectual property rights, copyright agreements, merchandising, research and development, franchising, distribution, confidentiality agreements and other contracts involving the exploitation of intellectual property rights.

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British Virgin Islands

The licensing of trademarks in the British Virgin Islands

Jamal S. Smith of Thornton Smith details the types of trademark licenses and the use cases for each in the jurisdiction.

A trademark that is registered in the British Overseas Territory of the Virgin Islands (the **"British Virgin Islands"**) may be licensed for use by the trademark owner, or sub-licensed by a licensee (both cases herein referred to as the **"licensor"**). The license to use a trademark may be either in connection with the goodwill of a business or independently, or in relation to some or all of the goods or services for which it is registered or limited to a particular length of time, a particular manner of use or a particular geographical area, and in this case specifically the British Virgin Islands.

Although registration of licenses is not mandatory in the British Virgin Islands, they provide adequate notice to third parties, especially to assignees or other successors in title to the licensor who are bound by the license in the same manner as the licensor. This is mandatory for an exclusive license but any other type of license may provide for the means by which a successor in title becomes bound by the license. Therefore, it becomes important for the proper administration of the trademark rights to register licenses for their use in the British Virgin Islands, especially since unregistered licenses are vulnerable to later dealings or other persons claiming a similar right.

> **"Whether or not the license is registered, a license is not effective unless it is in writing and signed by or on behalf of the licensor."**

Whether or not the license is registered, a license is not effective unless it is in writing and signed by or on behalf of the licensor. The effect of having a license is that it could counter allegations of non-use in the British Virgin Islands. A trademark owner may register a trademark in several classes, without relying on a defensive trademark application, for the sole purpose of entering into merchandising, franchising or distributorship agreements with a person who holds a trade license in the British Virgin Islands or conducts international business through the internet where the currency used for conducting the online transaction is the United States dollars, which is the legal currency of the British Virgin Islands, and they provide for shipping any goods directly to the British Virgin Islands.

With certain exceptions, a license (whether registered or not) also attracts stamp duty of $5.00. There are no other applicable taxes, and the royalties would be treated as ordinary income or ordinary expense to the extent that they are monies actually or constructively received from the licensee or paid to the licensor.

> **"Most significantly is that an exclusive licensee can sue infringers without having to persuade the trademark owner to take action on their behalf."**

(a) Exclusive licenses

The most consequential type of license is the exclusive license by which the trademark owner also promises that they will not grant any other licenses and that they will not exploit the trademark themselves in the British Virgin Islands. In effect, an exclusive license confers a right in the trademark to the exclusion of all other persons, including the trademark owner or any successor in title, as if the exclusive license had been an assignment with all the rights and remedies to the extent provided in the license.

Most significantly is that an exclusive licensee can sue infringers without having to persuade the trademark owner to take action on their behalf.

(b) Merchandise agreements

A trademark may be licensed to a manufacturer in the British Virgin Islands to make a product and apply the trademark to that product, for example, in personality and character merchandising. The protection of celebrity names and images as well as those of fictional characters is possible in the British Virgin Islands. Therefore, where celebrities and fictional characters are used to endorse and associate themselves with products and services, it is possible to manage their trademarks from abuse. Also, if a souvenir shop in the British Virgin Islands sold articles of clothing using the name or image of a celebrity or fictional character to a tourist the trademark owner, or the exclusive licensee, can initiate infringement proceedings once the trademark is registered since the British Virgin Islands is a major high-end tourist destination in the Caribbean and the sale may impact the international brand.

It is incumbent on the licensee to ensure, before executing the merchandise agreement, that the trademarks are registered with respect to the licensed products, which are clearly identified. The licensor should seek to retain control over the licensed products with a right to approve any changes or otherwise setting restrictions on changes to the licensed products even where it is to comply with local laws. There should be a clear determination as to when a sale has taken place and when and how often statements and payments are to be made, as well as auditing requirements usually tied to one of the Big Four accounting firms which each have a presence in the British Virgin Islands.

(c) Franchise agreements

There are no franchise-specific laws in the British Virgin Islands and contracts are governed by the common law, although government policy may prohibit franchises in certain fields of economic activities, such as fast-food restaurants. A franchise agreement will provide the framework for the contractual obligations between the franchisor and franchisee and would regulate advertising, training, premises, know-how, and provide support services.

(d) Distribution agreements

The most common form of a license in the British Virgin Islands would be through distribution agreements. A distribution agreement creates the channel through which a manufacturer regulates how its goods enters the British Virgin Islands market, and may also be referred to as a dealership agreement, especially in the automotive industry. All the considerations relevant to a merchandise agreement would similarly be relevant in a distribution agreement. For example, there are specific packaging requirements imposed by the BVI's Tobacco Products Control Act, 2006 to distribute tobacco products in the British Virgin Islands market, and so it is important to understand the legal framework that regulate specific goods.

(e) Parallel imports

A licensor has the right to prevent the importation of goods bearing the registered mark into the British Virgin Islands only where the license grants rights in the British Virgin Islands. A licensor may wish to segment the market for a particular product and prevent parallel importation. For example, a licensor that manufactures and sells televisions under a particular registered trademark through a distributor in French St. Martin which uses European electrical sockets, may wish to prevent someone else from exporting the television from French St. Martin to the British Virgin Islands, opening the packaging, adding adaptors to enable the television to work in the British Virgin islands which uses U.S. electrical sockets, and selling the repackaged television in the British Virgin Islands. The trademark owner can object to the resale of the television where the adaptor is of a different standard to that which would be sold with a television in the British Virgin Islands, at least if the repackaged television does not clearly indicate the origin of the new adaptors, and thereby undermining the ability of the trademark owner to control the quality of products placed on the market under its trademark.

“The most common form of a license in the British Virgin Islands would be through distribution agreements.”

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Carlton is a founding member and the Senior Managing Partner of the firm with 23 years of hands-on experience as a legal practitioner. He has amassed quite a great deal of finesse in the legal practice and advised on several complex and cutting-edge transactions in the areas of Intellectual Property Rights, corporate restructurings like mergers and acquisitions, capital markets, corporate governance, due diligence and corporate finance, real estate, regulatory advisory services, labor and employment, competition and commercial litigation.

Carlton provides legal advisory services to clients within the upstream, midstream and downstream sectors relating to oil and gas and is currently advising two American multi-national Petroleum Corporations on a wide range of matters in the sector

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The prospect of a revision draft for Chinese Trademark Law

Ray Zhao of Unitalen Attorneys at Law explains the changes proposed in the trademark law revision draft that defend against malicious trademarks, express the importance of trademark use, and introduce a transfer mechanism.

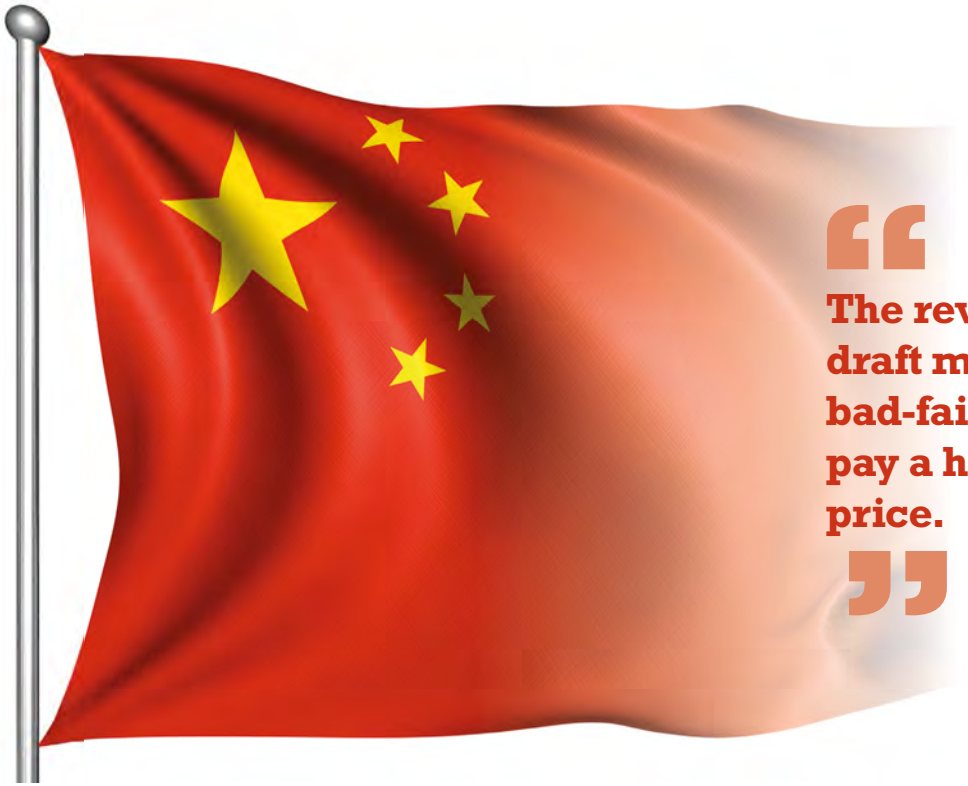
On January 13, 2023, the China National Intellectual Property Administration issued the revision draft of the Chinese Trademark Law. Although the Chinese Trademark Law has already experienced four changes in 1993, 2001, 2013, and 2019, the current Trademark Law cannot meet the new needs of trademark practice development. Problems such as malicious application, trademark hoarding, and registration without use, repetitive application and malicious litigation are prominent. In practice, it is difficult for enterprises to obtain trademark rights, and the number of trademark applications and registrations is large but the quality needs to be improved.

The revision draft upholds the concept of maintaining social fairness and justice, fair competition market order, and serving the high-quality development of the economy and society. Based on the actual needs of China, the revision draft draws on foreign legislative and practical experience, and positively responds to the problems and needs arising from the practice. The current Trademark Law has made significant changes from the system to the content. If the revision draft of the Trademark Law is accepted in whole or in part, it means that enterprises' compliance obligations in trademark layout, trademark application strategy, trademark use and other aspects will be substantially increased.

More prohibitions against malicious applications

Malicious trademark applications have always been one of the most concerning issues in the field of trademark practice. The revision draft makes bad-faith filers pay a higher price and a lot of new approaches will be adopted as follows: increase in the amount of fines against bad application and registration owners, and establishment of a compulsory transfer system against bad application and registration if bad faith is found.

For example, Article 67 and Article 83 of the Draft stipulate the administrative liability and civil compensation liability for malicious registration, that is, the maximum fine of RMB 250,000 and confiscation of illegal gains. Where a malicious application for trademark registration has caused losses to brand owners, brand owners may bring a lawsuit before the court and claim compensation for the losses. The amount of compensation shall at least include the reasonable expenses paid to deter the malicious application for trademark registration.



> **"The revision draft makes bad-faith filers pay a higher price."**

If brand owners encounter bad faith applications, apart from filing oppositions and invalidation according to law, it may also file administrative complaints and civil lawsuits against the acts of bad faith applications and registrations, and demand compensation from the persons involved, especially the attorneys fees and other reasonable expenses to stop the acts of bad faith applications or registrations. This amendment will effectively reduce the cost of rights protection for enterprises and encourage them to actively exercise their rights to prevent trademark registration and approval and malicious litigation. At the same time, this amendment also increases the cost of squatting. That is to say, in addition to the invalidation of the trademarks registered at a very low cost, they may also face the high loss of bearing the cost of protecting the rights of the squatted due to the squatting behavior.

Establish new principle of prohibiting repetitive applications

Article 14 of the Draft first stipulates that "unless otherwise stipulated, the same applicant shall register only one identical trademark for the same goods or services". In recent years, the phenomenon of repetitive application for trademark registration is increasing, to this end, the draft refers to the principle of "one thing, one right" in the property Law.

Article 21 of the Draft further clarifies the scope of the prohibition of duplication, that is, the trademark applied for registration shall not be the same as the prior trademark that the applicant applied for, has already been registered, or has been cancelled, revoked or invalidated by public notice within one year before the date of application. At the same time, Article 21 also provides six exceptions for the

> **The prohibition of repetitive applications in the draft is something that has never been done in previous trademark law.**

> **The revision draft raises the requirements for trademark use, and highlighted the importance of trademark use.**

principle of prohibiting repetitive applications, such as the failure to renew the prior trademark and the cancellation of the prior registered trademark. Article 36 further stipulates that any person who considers an application for a trademark to be a repetitive application, even if he has no prior rights or is not an interested party to the repetitive applications of the trademark, shall have the right to raise an objection within the period of the initial examination announcement to prevent the duplicate registration of the trademark.

The prohibition of repetitive applications in the draft is something that has never been done in previous trademark law. Repetitive applications are currently a "routine operation" of trademark applications in many enterprises for various reasons. The new rule could upend how companies understand trademark applications and force them to refocus their overall layouts and strategies for brand and trademark applications. Before applying for registration, the enterprise shall at least assess whether the application submitted is a repetitive application according to the exceptions in Article 21.

Strengthen the trademark use obligation

By November 2022, China has 42.337 million valid registered trademarks, among which there are a large number of trademarks which occupy a large number of trademark resources. In practice, if the trademark application is rejected, there will usually be the same or similar trademark cited before, and the trademark not actually used in the cited trademark accounts for a very high proportion.

The revision draft raises the requirements for trademark use, and highlighted the importance of trademark use. The revision of several provisions of the Draft reflects the requirements for the use of trademarks when applying for trademarks and after the approval of registration. For example, according to the amendment of Article 5, trademark applicants may be required to provide evidence of use or commitment of use in future trademark applications.

Article 61 may have the greatest impact of all the amendments on the Chinese trademark application system and is the most important.

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Article 61 establishes a system of description of the use of trademarks and random inspection of the use of trademarks by the administrative department of intellectual property.

Article 61: "A trademark registrant shall, within 12 months after the expiration of every five years from the date of approval of the trademark registration, explain to the intellectual property administrative department under The State Council the status of the use of the trademark on the approved commodities or the valid reasons for its non-use. A trademark registrant may explain the use of multiple trademarks within the above-mentioned time limit."

Where no explanation has been given at the time limit, the intellectual property administrative department under The State Council shall notify the trademark registrant. If the trademark registrant fails to do so within six months from the date of receipt of the notification, it shall be deemed to have abandoned the registered trademark, and the intellectual property administrative department under The State Council shall cancel the registered trademark.

The intellectual property administrative department under The State Council shall conduct random inspection of the authenticity of the description and may, when necessary, require the trademark registrant to supplement relevant evidence or entrust the local intellectual property administrative department to conduct verification. If it is proven to be untrue through random inspection, the intellectual property administrative department under The State Council shall cancel the registered trademark.

New compulsory trademark transfer mechanism against bad faith applications and registrations

The system of compulsory trademark transfer only applies to the following three situations: 1. where the registered trademark is a copy, imitation, or translation of another well-known trademark; 2. an agent, a representative, or an interested party registers a trademark in advance; 3. where a trademark that has been used by another person and has exerted certain influence is registered unreasonably, the prior right holder may request that the trademark be transferred to his own name. After the ruling confirming the transfer of a registered trademark has been made, the trademark registrant shall not dispose of the registered trademark.

Before the compulsory transfer of the trademark system, enterprises can only invalidate the registered trademark first, and then apply for a trademark in their own name after the trademark is invalid. However, there is a period of time between trademark application and registration, during which time there are certain restrictions on enterprise rights protection. After the implementation of the compulsory trademark transfer system, enterprises can request trademark authorities to transfer the registered trademarks directly to their own names, saving the time and cost of reapplying and protecting their rights in advance.

It should be noted that the compulsory trademark transfer system is only applicable to the above three situations. Enterprises that lawfully apply for trademarks and operate brands are not affected by the system. However, compliance enterprises can use the system of compulsory transfer of trademark to effectively prevent malicious registration, transfer the registered trademark to their own name as soon as possible, use the trademark that should belong to their own and carry out brand operation as soon as possible.

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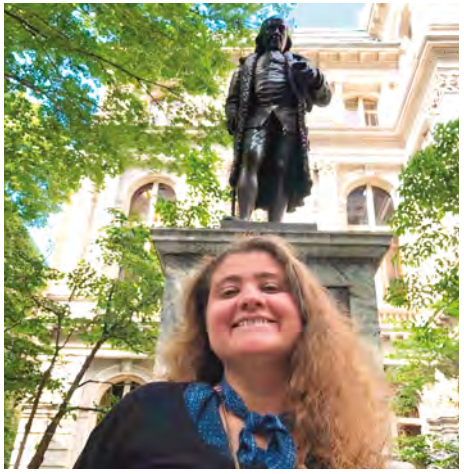
What does intellectual property have to do with food security?

Natalia Vera Matiz of Vera Abogados expresses the need for further review of the food security crisis as the protection available through IPR still fails to protect those in need due to inequitable circumstances.



A couple of years ago, when President Biden began his term in office in the United States, the authors[1] of a blog wrote vehemently about the need for this administration to address the food security crisis that has been accentuated by, among other factors, climate change. This author emphasized the benefits that emerging technologies can bring to mitigate this crisis, and therefore called for companies and leading nations in this field to invest in this specific area, which would bring them the advantage of obtaining the benefits derived from Intellectual Property.

It is here where we must stop to analyze the implications of the protection of intellectual property rights associated with food security, as this brings us to the specific field of agriculture where, for example, through the application of biotechnology, plants, and crops are improved to resist climate change, thus having as a consequence a means to mitigate this crisis. Thus, Intellectual Property has two forms of protection, patents, and plant variety protection, which, although at first glance seems to be an appropriate, equitable, and fair way of rewarding those who invest in innovation that has an impact on a vital field such as food security, it does not always bring favorable consequences for all the actors involved:

> **“It is here where we must stop to analyze the implications of the protection of intellectual property rights.”**

[1] Gordon M. Goldstein, Erik R. Oken: “America’s New Challenge: “Confronting the Crisis in Food Security” https://www.cfr.org/blog/americas-new-challenge-confronting-crisis-food-security.

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> **The flexibilities brought by the international treaties that address the subject, either superficially or in-depth, are not enough.**

Firstly, in developing countries where farmers, or at least some of them, are used to the exchange of seeds and knowledge without barriers, this could have a significant impact, since they will have to pay the prices set by breeders and owners, who in most cases are from developed countries.

Secondly, research and development progress for the improvement of proprietary crops will be affected by intellectual property rights, because it will be difficult to find an exception that allows such research.

Thirdly, the application of this technology in developing nations may not be correct, due to a lack of training.

However, the flexibilities brought by the international treaties that address the subject, either superficially or in-depth, are not enough, since, for example, the TRIPS have been affected by the free trade agreements where the technology leader imposes its own conditions, or those international instruments that allow the use of plant varieties that are already in the public domain does not make much sense.

Thus, in order to face the food crisis, I consider it necessary to take into account the inequalities that exist between nations, because although it is true that remuneration through intellectual property rights becomes not only a reward but a necessary stimulus to advance technologically in any field, it is necessary to take into account all the actors that are part of this balance to be able to conclude that the food crisis is truly and effectively being faced.

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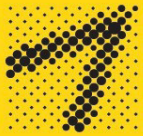

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Our team is a pioneer in IP services with almost three decades of experience in Ecuador. We are well known for our comprehensive service that centralizes IP advice for our clients throughout the Andean and Latin American region, which makes clients work with us to solve all their IP concerns.

Tobar ZVS's IP department has extensive experience in the protection of patents, trademarks, designs, copyrights, plant varieties and related rights. The Leaders League legal directory only ranks Tobar ZVS as a leading firm for our work in plant varieties and recognizes partners Alvaro Sevilla and Oscar Vela in this area.

Chambers & Partners Latin America and Global editions note: "Alfonso Rivera is a very responsive lawyer and provides his clients with very well-informed, business-oriented advice."

As of 2022 Partner Alvaro Sevilla leads the Intellectual Property Department.

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Trademarks in Greece

Vardikos & Vardikos provide an update on trademark law in Greece following on from the enforcement of Directive 2015/2436/EC and 2004/48/C in relation to Greek Trademarks Law 4679/2020.

The Greek Trademarks Law 4679/2020 implemented the Directive 2015/2436/EC (approximation of the laws of the Member States relating to trademarks) and the Directive 2004/48/C (enforcement of intellectual property rights), replacing the previous Greek Trademark Law 4072/2012.

1. Types of Trademarks

Any sign, even one with no graphical representation, can be considered registrable as a trademark. It can be words, names, illustrations, designs, letters, numbers, colors, position, sound, shape, pattern, motion, multimedia and hologram, on the premises that: i. it distinguishes the goods of one undertaking from those of other undertakings ii. it is represented in the registry in a manner enabling the competent authorities and the public to determine precisely the protection afforded to its proprietor.

The law provides also for guarantee and certification trademarks.

They can't be registered as trademarks signs that:

i. cannot constitute a trademark;

ii. are devoid of distinctive character;

iii. consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, destination, value, geographical origin or the time of the goods production or of the service rendering or other characteristics of the goods or service;

iv. consist exclusively of signs or indications which have become customary in the everyday language or in the established practices of the trade;

v. consist exclusively of the shape imposed by the nature of the product or it is necessary to obtain a technical result or gives substantial value to the product;

vi. are contrary to public order or to principles of morality;

vii. are deceiving;

viii. are contrary to applicable legislation.

> **The Law introduces a special provision that empowers the proprietor to prevent third parties from bringing goods in the course of trade into Greece.**

2. Scope of protection

The registration of a trademark confers on its proprietor the exclusive right to use it, to affix it to the products intended to distinguish, to use it for characterization of the provided services, to affix it to covers and packaging of goods and to any other printed material and to use it in electronic or audiovisual media.

The proprietor is entitled to prohibit any third party from using;

i. A sign identical to the registered trademark for goods or services identical to those for which the trademark has been registered;

ii. A sign identical with or similar to the registered trademark, when due to the simultaneous identity or similarity of the goods or services there is a likelihood of confusion, including the likelihood of association;

iii. A sign which is identical or similar to a trademark with a reputation, where use of that sign without due cause would take unfair advantage of, or would be detrimental to the distinctive character or its reputation, regardless whether the sign is intended to distinguish goods or services that are similar to products or services of the earlier trademark.

The Law introduces a special provision that empowers the proprietor to prevent third parties from bringing goods in the course of trade into Greece, when such goods, packaging included, come from third countries and bear without authorization a trademark which is identical to the trademark registered for such goods or which cannot be distinguished in its essential aspects from that trademark. This applies regardless of the Customs status of the infringing products.

The proprietor can request that the reproduction of the trademark in a dictionary, encyclopedia or similar reference work is accompanied by an indication that it is a registered trademark.

The right to a trademark can be transferred, in life or after death, for all or part of the goods or services for which an application for a trademark has been filed or registered, regardless of the transfer of the undertaking.

The proprietor can grant a license, exclusive or not, for the use of a national or international trademark or trademark declaration valid in Greece, for part or all of the products or services and for all or part of the Greek Territory. The trademark license agreement must be in writing.

The protection of the trademark is dependent on its use: if the proprietor fails to continuously use the trademark within five years from the date of its initial registration ("grace period"),

they may be faced with an application for cancellation or proof of use of their mark filed by a new applicant. The proof of use by the proprietor must include all the goods and services for which it is registered, otherwise the protection of the trademark will be limited to those which actually make use of the trademark.

3. Registration

The trademark application is filed before the competent Greek Trademarks Authority. By virtue of the Joint Ministerial Decision No 48793/2022, the competent Authority from May 2022 is the Greek Patent Office.

The examiner reviews the application on procedural and substantive grounds. The *ex officio* examination of relative grounds for refusal is abolished; the publication of the approval decision to the designated website serves as notification for third parties which could have an interest to oppose the application.

The examiner's decision accepting the registration of a trademark's application can be opposed within a three-month deadline commencing from the day after its publication on the designated website.

The proprietor of the trademark may divide the trademark application or registration, stating that part of the products or services contained in the original declaration or registration will be the subject of one or more partial declarations or registrations.

4. Enforcement

Administrative Courts

The Administrative Courts are competent to adjudicate appeals against the Trademark Committee's decisions that rule on the decisions of the examiners regarding objections or applications for dispute resolution.

Appeals are required to be filed within sixty days from the day of the publication of the decision.

Civil Courts

The Civil Courts are competent to adjudicate the following;

i. Disputes regarding the trademark infringement;

ii. Oppositions of article 583 of Civil Procedure Code against the Trademark Committee's decisions on the applications of trademark's revocation or invalidity;

iii. Claims and counterclaims of restraining orders on trademark's revocation or invalidity;

iv. Claims related to trademark assignments;

v. Actions on the right to information.

The new law abolishes the provision according to which civil courts were bound by the final decisions of the Trademarks Committee and the Administrative Courts i.e., they have the jurisdiction to adjudicate on the validity of the registered national and European Union trademarks, provided that the proprietor of the trademark is entitled to counterclaim for the declaration of invalidity of the trademark or revocation.

The claim for revocation or invalidity can only be brought as a counterclaim and the defendant has to notify the Trademarks Registry by the latest by the date of the court hearing, otherwise the action is inadmissible. Additionally, once the infringement action has been filed by the claimant, the defendant can no longer challenge the validity of the trademark by filing a separate action before the Trademarks Registry. If the action has been filed before the filing of the civil claim, the court has the discretion to suspend the proceedings brought before it, ordering provisional measures. The defendant has the same right in interim injunction proceedings.

The objection of the proof of use has to be raised at the hearing of the opposition otherwise it will be inadmissible. The claimant is granted at least 30 calendar days to submit material proving the use of the earlier mark along with a supporting writ. The defendant is granted at least 25 calendar days, starting on the day after the aforementioned deadline expired, to evaluate the proof material and submit a writ. Within three calendar days following the expiration of the second deadline, both parties submit their rebuttals. The Administrative Trademark Committee can rely on facts that are so well known, that no doubt remains that they are true.

The burden of proof in revocation proceedings is put on the proprietor of the contested trademark.

The proprietor can request to have the full court decision or parts thereof published on social media.

Interim measures are filed by the individual who has the trademark registered in their name.

The intervening right defense in infringement proceedings in favor of the proprietor of a later mark is introduced; the proprietor of the earlier trademark cannot prohibit the use of a later mark if that later one is not declared invalid.

Penal Proceedings

The Greek Law provides for criminal offenses, such as imprisonment and fine, in case of trademarks infringement for those who:

i. use a trademark without having such right;

ii. launch, possess, import or export products or offers services using another's trademark;

iii. intentionally use a reputation mark to exploit or damage its reputation;

iv. intentionally use symbols and signs of public interest.

Mediation

In light of the Mediation Law 4640/2019, the trademark disputes can be submitted to mediation.

About Vardikos & Vardikos

Vardikos & Vardikos is a fully-fledged Athens headquartered law firm, with offices in Cyprus, the Caribbean Islands of Dominica, and St Lucia, providing *inter alia* Intellectual Property services, ship/yacht registration and is a Government-approved service provider for the respective Citizenship by Investment programs of both islands.

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ABOUT HUGHES, FIELDS & STOBY

Established in 1972, Hughes, Fields & Stoby is a leading provider of superior, professional intellectual property services to corporate and individual clients, both local and international. It is one of the core areas on which the reputation of our chambers has been built.

Whilst we are registered trade mark and patent agents with decades of experience in filing applications for trade marks, patents and designs, we also provide legal advice and intellectual property enforcement services at standards which are second to none.

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Our vision embraces the motto "We strive to provide our clients, local or international, corporate, or individual with the highest quality services available. We focus on the unique needs of each client, which is the driving force behind our long-term success."

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In June, 2019, Hughes, Fields and Stoby distinguished itself as Guyana's leading chambers when the firm was admitted as the sole member of the global network of Law Firms, Lex Mundi.

The firm is a member of the International Trademark Association (INTA) and a founding member of the Intellectual Property Caribbean Association (IPCA).

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Our firm offers several services as set out below:

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SBGK's attorneys at law are qualified to represent clients before the EU Intellectual Property Office (EUIPO), the EU General Court and the Court of Justice of the European Union. Similarly, SBGK's patent attorneys are all registered as European patent attorneys and can represent clients before the European Patent Office and the EUIPO.

For example, SBGK has represented UNILEVER NV before the Court of Justice of the European Union (CJEU) in the first preliminary ruling referral to the CJEU from a Hungarian court in a trademark matter. Similarly, our firm also represents Rubik's Ltd, one of the most well-known brands in the toy industry, before the General Court and the European Court of Justice in a landmark trademark case which received high media and press publicity. Furthermore, SBGK provided legal advice in a case which was referred to the CJEU in relation to the interpretation of Article 9 (7) of the Enforcement Directive. The interpretation of the article has an important effect on patent litigation and in particular on compensation claims resulting from unjustified preliminary injunctions.

In addition to SBGK's strong IP practice, it helps foreign investors set up their business in Europe and provides them with all the necessary legal services in company establishment, mergers and acquisitions, competition law, employment law matters and various other commercial transactions.

Network

SBGK, as the leading IP law firm in Hungary, offers not only professional services, but also a broad network of international contacts, which includes well-known national and international firms of attorneys at law and patent attorneys, guaranteeing high-quality services. SBGK's attorneys at law and patent attorneys are members of and hold various positions in international IP organizations such as the International Association for the Protection of Intellectual Property, the International Trademark Association, the International Federation of Intellectual Property Attorneys, the European Communities Trademark Association, MARQUES, UNION, the Pharmaceutical Trademarks Group, the Licensing Executives Society International and the Institute of Professional Representatives before the EPO.

Gateway to Europe

SBGK is looking to broaden its professional network and form partnerships with foreign patent and trademark attorneys, to represent clients from Europe and further afield in international IP matters. SBGK can provide a one-stop shop for European patent, Patent Cooperation Treaty, EU trademark and registered Community design applications.

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Practice areas: advising and contract drafting in technology transfer matters, strong focus on contentious patent, trademark, industrial design and copyright-related matters, representation before the Court of Justice of the European Union, arbitration in domain disputes, mediation and advising on consumer protection and antitrust matters.

Dr. Péter Lukácsi

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Practice areas: advising, prosecution and litigation in various fields of IP law, strong focus on trademarks, copyrights and designs, and advising and litigation in the field of competition and antitrust law, negotiating and drafting distribution, franchising, licencing agreements.

Dr. Ádám György

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Practice areas: providing full scope of IP legal advice, with special focus on designs and trademarks, as well as providing legal representation before HIPO, EUIPO and litigation in the field of IP; also providing mentoring activity for the Hungarian Fashion and Design Agency and for national start-ups.

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Zsolt Szentpéteri

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Practice areas: preparing national, European and PCT patent applications covering the automotive, construction and toy industries; as well as representation in trademark and industrial design prosecution matters before the Hungarian Intellectual Property Office and the EU Intellectual Property Office.

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Practice areas: innovation and IP counselling, with a special focus on chemical and biotech IP solutions and R&D projects, preparing national, European and PCT patent applications covering biotech, chemical and biomedical device solutions, representation in plant variety protection and utility model prosecution matters before the Hungarian Intellectual Property Office.

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Exclusivity over "Sub" in *Subway v Suberb:* timeline

Manisha Singh and Anvita Sharma of LexOrbis review a recent case that called into question deceptive similarity in a dispute over name and logo between two rival brands.

Manisha Singh

Anvita Sharma

Abstract:
One of the world's largest restaurant brands serving customizable and signature sandwiches, wraps and salads – "Subway", recently filed an infringement suit against Delhi-based fast-food shop "Suberb". The suit alleged that the Defendant's brand name and logo "Suberb", which is represented in the color scheme of yellow and green is identical to their mark "Subway". It was also alleged that many of the names of Suberb's sandwiches, signage, décor, menu cards, napkins, staff uniforms, photographs and wall art in the outlets were identical to that of the Plaintiff. While the Defendant has made the effort to change the color combination, names of its sandwiches, and modify their outlets, the Plaintiff filed for an interim injunction again.

The single bench of the Delhi High Court rejected Subway's prayer for seeking an interim injunction for its mark "Subway." by way of an order passed on January 12, 2023.

On February 15 2023, the division bench of the Delhi High Court set aside the order passed by the Single bench, citing that the impugned order has not given due weightage to the aspect of 'bad faith', considering that some of the respondents were operating as a Franchisee of the Plaintiff when they started the new restaurant under the mark SUBERB. The article aims to deep dive into the analysis that reached the said conclusion.

Brief facts of the case

The Plaintiff, Subway IP LLC, had filed an infringement suit alleging that the defendant, Infinity Food & Ors' brand name and logo "Suberb", under which two restaurants are run in Delhi, used an identical mark with the scheme of green and yellow, just as the Plaintiff "Subway". The Defendant also used the marks "Veggie Delicious" and "Sub on a club" which were deceptively similar to Plaintiff's registered marks "Veggie Delite" and "Subway Club". The signage, décor, menu cards, napkins, staff uniforms, photographs and wall art in the outlets were also identical to that of the Plaintiff, and the food preparation procedures recipes, formulae, and placement of the service counters were also alleged to be identical. Additionally, it was alleged by the Plaintiff that the verbatim and the layout of the headings were also similar on the Defendant's website.

An Interlocutory Application was earlier filed by the Plaintiff to seek an interim injunction to prevent the Defendant from using the mark "Suberb". At the request of defendant, court adjourned so that the Defendant could carry out the modifications that would satisfy the Plaintiff that they were no longer infringing the Plaintiff's rights. Plaintiff was unsatisfied with these changes which prompted them to again file for an interim injunction against Defendant.

> **"It was further stated that "Subway" and "Suberb" are deceptively similar to each other as word marks even if the color scheme of both the marks is changed.**

Arguments submitted

The Plaintiff claimed that they already hold registrations for the word mark and logos under "Subway" in Classes 29, 30, 32, 35, 42 and 43. They also submitted that the efforts made by the Defendant to make such modifications to differentiate themselves from the Plaintiff, were blatant. It was further stated that "Subway" and "Suberb" are deceptively similar to each other as word marks even if the color scheme of both the marks is changed. The Plaintiff stated that the matter is of rank dishonesty, with the defendant being a franchisee holder of the Plaintiff.

On the other hand, the Defendant denied the allegations of infringement and passing off, and submitted that they had incorporated the changes in both of their outlets in Delhi and Gurgaon - which included changes in wall décor, menu card and staff uniforms. They had also made changes in the colour scheme, with the logo no longer resembling the logo of the Plaintiff. They also submitted that the Plaintiff cannot claim exclusivity of the "Sub" part of the "Subway" mark, as "Sub" was generic in respect of the products to which it is used

Court's analysis and decision on January 12 and February 15, 2023

In an order dated January 12, 2023, the Single Bench of the **Delhi High Court** rejected Subway IP

[1] *"Publici juris" is a Latin word, which means, "of public right' or 'belonging to the public'. It signifies a thing or a right that is open and exercisable by all persons. In general, it designates things that belong to an entire community, and not to any private party.*

LLC's application seeking for injunction for its mark "Subway" against Infinity Food's mark "Suberb".

The Single Bench held firstly that the Defendant's mark "Suberb" was not phonetically similar to the Plaintiff's mark "Subway". Secondly, the court stated that the common syllable "Sub" is known to represent Submarine Sandwiches which has an identity of its own and could not be monopolized by the plaintiff, particularly when used for sandwiches. It was stated that the word "Sub" is *publici juris* [1], common knowledge under Sections 56 and 57 of the Indian Evidence Act, 1872 and common to trade.

It was also ruled that the terms "Veg" and "Club" were also *publici juris*, which, when used in the context of club sandwiches, were commonly used.

Since the logo of the Plaintiff held no Indian or WIPO Registration, no infringement could be alleged in that regard. Otherwise as well, the court observed that both the logos of the parties stood dissimilar. The one point of similarity between the logos, the green-yellow color scheme, as pointed out by the Plaintiff before, has been removed post modifications.

It was also analyzed the "Anti-dissection rule" and the "Rule of dominant feature" to examine whether any part of the Plaintiff's registered trademarks constitutes a "dominant part" which stands infringed by the defendant or has acquired any secondary meaning by a long usage.

With respect to the rule of passing off, the Court stated that there is no likelihood that a person of average intelligence who desires to visit the Plaintiff's restaurants would walk into the outlet of Defendant. Accordingly, the court refused to grant an interim injunction in favor of Plaintiff.

Lastly, it was also rejected the arguments of similarity based on the layout, décor or appearance of both restaurants. The Plaintiff had cited decisions of the High Court of Canada which were not taken into consideration, citing that the Indian Law does not allow a claim of exclusivity as of yet. Nonetheless, the Defendants have modified their outlets so as to differentiate themselves from the Plaintiff in this regard.

The said conclusion and order of the Single Bench was set aside by the Division Bench of the Delhi High Court on February 15, 2023, after the respondent submitted that the website SUBERB/www.suberb.in by the name SUBERB has been pulled down and deleted, has changed the name to HUBERB on the social media website Instagram and written letters to food delivery applications Swiggy and Zomato to change their name to HUBERB in their display. The Respondent also assured that they also aim to change the name to HUBERB, shall change the logo to 'H' and shall use the color combination of red and white on the logo 'H' on display everywhere.

The principle of 'bad faith' was also considered, which was earlier not analyzed by the Single Bench. Considering that some of the respondents were operating as a Franchisee of the Plaintiff when they started the new restaurant under the mark SUBERB and copied many aspects of the Plaintiff including Trade/Service marks, artworks, literary works, menu cards, website content, trade dress/color scheme/getup/interior/layout of the Plaintiff under the trademark SUBWAY, the court decided to set aside the impugned order.

Conclusion

The Single Bench had passed the order based on principles of 'anti-dissection' with reference to the 'dominant feature' rule, descriptiveness of 'Sub', 'Veg' and 'Club' and considered these being *publici juris*. The court however, did not take into account the earlier connection between the parties where the Respondent was a Franchisee of the plaintiff, an argument which was also raised by the Plaintiff earlier.

The division bench then took into consideration the earlier arrangement of the parties and calculated it to be of bad faith.

Subway IP LLC vs. Infinity Food & ors., CS (COMM) 843/2022 Order [2].

Subway IP LLC vs. Infinity Food & ors., CS (COMM) 26/2023 Order [3].

[2] *http://164.100.60.183/writereaddata/OrderSAN_PDF/chs/203/16733454666616_48589_2023.pdf*

[3] *http://164.100.60.183/dhcqrydisp_o.asp?*

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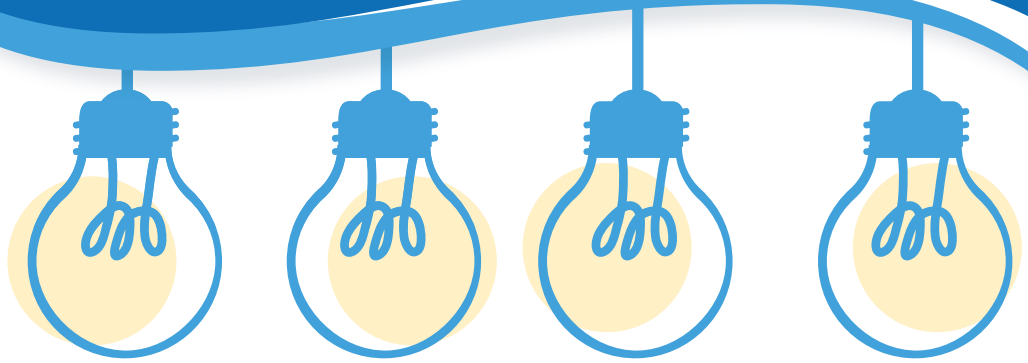

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Patentability of mobile applications in Mexico

Santamarina + Steta experts explain the available methods for protecting software innovations in the mobile applications.

A patent is an exclusive right granted on an invention that has the following properties: (i) Novelty, which, according to Mexican legislation, anything that is not considered to be "prior art", i.e., that is information in the public domain; (ii) Industrial Application, which implies that the invention must have a practical utility that results in a benefit to society, being susceptible to its production and use in any branch of economic activity, for determined purposes; and (iii) Inventive Activity, which represents the technical development, consisting in the creative process whose results should not be deduced from the prior art in an obvious or evident way for a technician in the field.

This exclusive right empowers its owner to decide whether the invention may be used by third parties and, if so, in which manner, since patent protection means that an invention may not be produced, used, distributed for commercial purposes, or sold without the owner's consent.

Now, mobile applications have become an indispensable part of daily life in the digital world. Their economy has grown exponentially, driven by a vast community of software developers. In order to understand the figure for its protection, it is necessary to understand the difference between a computer program, software, and a mobile application.

First of all, a **computer program** is an original expression in any form, language, or code, of a set of instructions that, with a specific sequence, structure, and organization, is intended for a computer or device to perform a specific task or function. On the other hand, the **software** is a set of computer programs, instructions and computer rules that allow the execution of different tasks, that is, a computer program is the foundation of software since several programs are needed to create it.

Now then, **mobile applications** are usually small software units with different functions that provide users with quality services and experiences, designed to run on a mobile device.

There is no doubt that mobile applications come from human invention and therefore should find protection in Intellectual Property; however, the mechanisms for their protection depend on the jurisdiction in which protection is sought.

> **It would be possible to patent a mobile application as long as it has a technical nature and meets the requirements of novelty, inventive activity, and industrial application.**

The idea of patenting a mobile application under industrial property rights is common in other jurisdictions; however, the Federal Law for the Protection of Industrial Property applicable in Mexico, in its article 47 stipulates that computer programs cannot be considered inventions by themselves. In the same sense, the last paragraph of the aforementioned article establishes the possibility of patenting a computer program, as long as it is not only claimed as part of the invention but is composed of additional inventive elements.

Consequently, although the existing computer programs and software on the market cannot be protected by the patent figure, it would be possible to patent a mobile application as long as it has a technical nature and meets the requirements of novelty, inventive activity, and industrial application. In order to achieve this, the mobile application should satisfy different requirements such as interacting autonomously with its environment, gathering information, and returning results based on data collection, or being part of a medical device, for example.

It should not be forgotten that a patent is granted for a unique invention that is developed to provide a technical solution to a certain problem and the solution to this problem cannot replace other existing technical or physical solutions.

On the other hand, it is important to point out that computer programs (source code or object) are protected by copyright in Mexico, thus, according to our legislation, the protection of works is granted from the moment they have been fixed in a material medium, regardless of their merit, destination or mode of expression.

In this regard, it is important to note that the moral rights of the work will always belong to its author. On the other side, the patrimonial rights of the work will be in force during the life of the author, plus one hundred additional years counted from his death or one hundred years after having been disclosed.

Likewise, according to our legislation, it is possible to assign the patrimonial rights of a work, but unlike trademark rights, this assignment is not indefinite or perpetual, since after a certain term the patrimonial rights must return to their original owner. Our Law stipulates that, in the event that the parties do not expressly establish an agreement, this term will be five years and that the term may only be longer than 15 years when the investment or the magnitude of the project demands.

Fortunately, with respect to computer programs, Article 103 of the Federal Copyright Law establishes an exception, which allows the assignment of rights of these works to be not limited to a defined term. On the other hand, it is also important to note that the Law provides that the ownership of computer works that have been entrusted by employers to their employees, as a function of their work, will belong to the employer.

Notwithstanding the foregoing, it is always advisable that in those cases where the creation of the computer program is entrusted to third parties, without any employment relationship between the parties involved, a "work for hire" contract is executed, which will allow that from the moment of the creation of the computer program, the ownership of the economic rights is recognized to the person who entrusted the creation of the work.

In this sense, the economic rights of a computer work entitle its owner to authorize or prohibit: i) the permanent or provisional reproduction of the program, ii) the translation, adaptation, arrangement or any modification to the program, as well as the reproduction of the resulting program, iii) any form of distribution of the program or any copy thereof, iv) the decompilation, reverse engineering, and disassembly and, v) the public communication of the program.

Consequently, seeking the protection of mobile applications, in addition to allowing their owners to take the previously mentioned actions with respect to the work, also allows an adequate defense of the same against third parties who make unauthorized use or reproduction of the same. This allows that at a commercial level exists legal actions against those competitors who reproduce the work or use it, either to market it under another name or to manage their business.

An important element to take into consideration is that, although computer programs are protected by the Federal Copyright Law *per se*, the fact is that the knowledge of infringement proceedings in the field of commerce is taken before the Mexican Institute of Industrial Property, which at the request of the owner may initiate actions consisting in the seizure of merchandise, prohibition of commercialization, closing of the establishment, among other precautionary measures.

In this regard, it should be noted that contrary to the protection provided by the patent, copyright protection has an extraterritorial scope and is recognized in several jurisdictions as a result of the signing of international treaties on the subject. However, those programs that manage to obtain patent protection will only enjoy an exclusive right in the jurisdiction that grants the registration.

This should be taken into consideration when seeking protection for mobile applications, specifically in Mexico.

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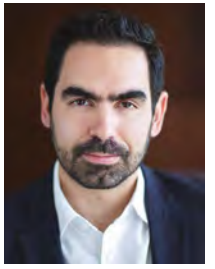

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Should we patent it or keep it a secret?

Ariana Gayoso Echevarria of Estudio Colmenares & Asociados evaluates the protection secured through patents compared to trade secrets and offers examples of when each is beneficial.

"The secret of my influence has always been that it remained secret."

Salvador Dalí

Trade secrets and patents make the difference in a firm's economic success or failure and it is key for a manager to know which intangible assets are valuable to be patented or to be kept private. Taking references from successful businesses can give us insight into what comes into play when deciding on strategies.

For most organizations there is relevance in secrecy. This can encompass all areas of business[1], from publicity strategies, manufacturing processes, new developments, client contacts, etc. that could be protected as copyright. Secrets coming out to the competition are sometimes a threat and managers have to consider how competitors can get that information in bad faith.

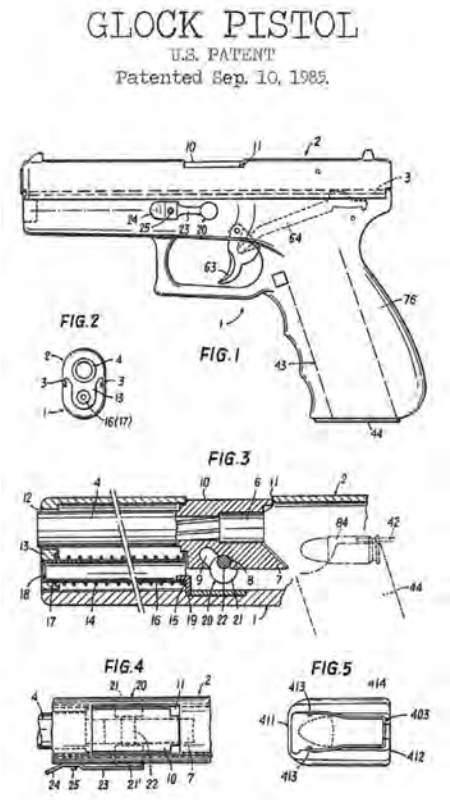
When patenting a formula or invention it is required to publish exactly how it can be reproduced and the specific use behind it. This grants exclusivity rights to the owner of the patented asset for a limited time. Trade secrets have no exclusive rights, the information is kept secret simply because it gives the company significant economic advantage over others[2] and without time constraints. However, these secrets can be broken through independent discovery and accidental or intentional disclosure[3] within the company which drastically affects their image and profit. The main consideration of a patent vs. a trade secret is the cost and the time it takes to be approved.

> **A part of Coca-Cola's marketing success was keeping its formula secret.**

As a first example, we have the Coca-Cola formula, a famous trade secret. Estudio Colmenares has patented several inventions in favor of its client The Coca-Cola Company, but none of those pertain to the specific formula of their popular soda.

Some of Coca-Cola's patent inventions refer to methods that recognize contaminants, specific recipients, refrigerants and other types of sample-taking systems. In a book of "Big Secrets" William Poundstone found some basic components in the formula like vanilla extract, lime juice flavoring and the famous coca leaf that gives it its name[4]. (Coca leaf gives the drink its stimulant properties, it is a plant that derives from South American countries, mainly Peru, and its regular use there is to chew on it to get an energy boost). Nevertheless, the exact composition of the formula is unknown to the public and has gone through many changes over the years.

On the other hand, with today's technological advances, many organizations are able to figure out the exact chemical composition of certain pharmacological drugs, drinks and/or manufacturing processes of products, therefore it makes sense to patent and benefit from the time limit for as long as possible for economic and strategic market success.



> **This particular case refers to an open sourced patent, meaning that the owner controls how others use their invention but it is not maintained as a trade secret.**

As a second example, we have a mechanical patent, the Glock pistol that revolutionized the firearm industry due to its lightweight materials, simple use and other properties that made it unique.

Mr. Gaston Glock filed his first patent in 1953, initially meant for the Austrian military and law enforcement because of its fast performance and at the same time providing safety against accidental discharge[5]. The Glock that later revolutionized the market, the G17, didn't appear

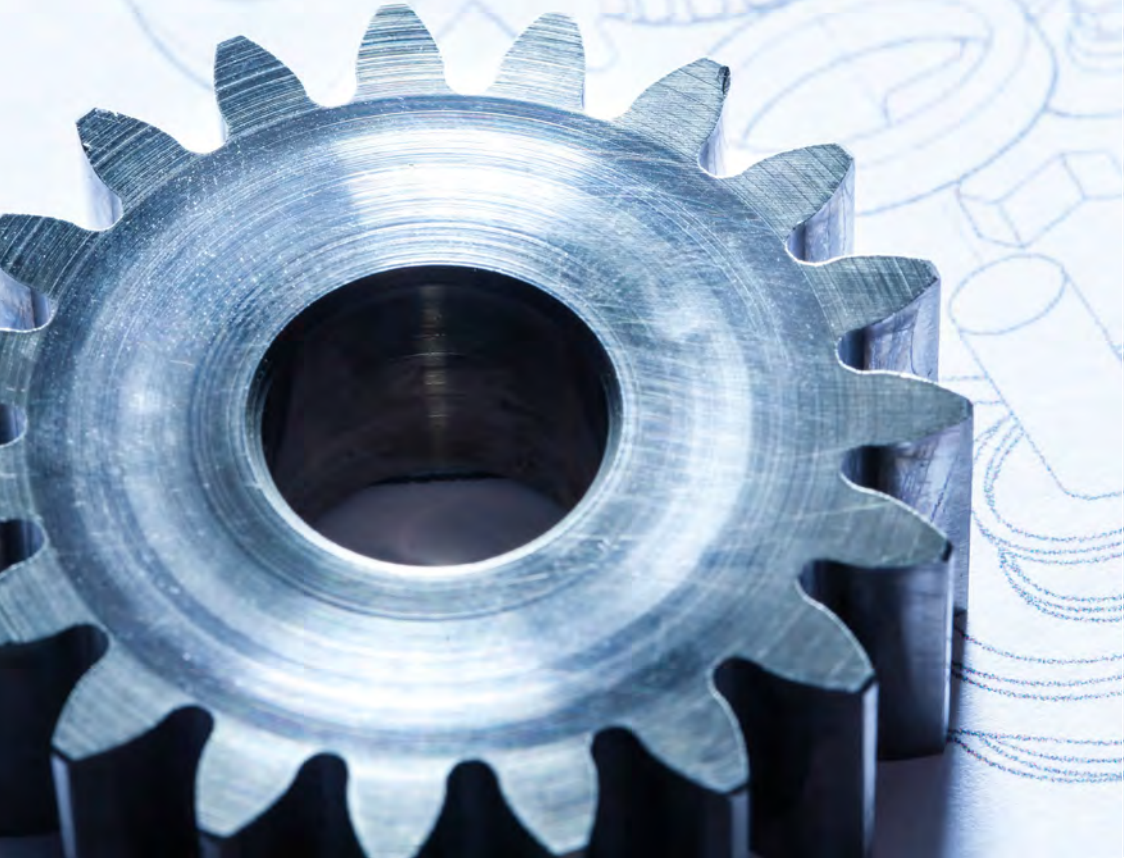
[1] *(William F. Crittenden, 2015)*
[2] *(Justia, 2022)*
[3] *(William F. Crittenden, 2015)*
[4] *(Radford, 2022)*
[5] *(Suciu, 2021)*

until 1985 in the United States (issued Patent Number 4,539,889). The Glock pistol's design was innovative, easy to build and extremely durable.

From a business point of view, it was a smart strategy to patent the Glock design as it could be easily replicated. After the lapsing of the Glock patent, many gun companies have manufactured guns with the same properties that once were unique for The Glock Inc. But having exclusive rights gave the brand recognition and leadership; meaning that a patent can be an investment for businesses to remain top players in the market after it expires.

Returning to the opposite example, if Coca-Cola had filed its formula as a patent their competitors would have already begun selling generic versions of the product that would be almost identical to the original. A part of Coca-Cola's marketing success was keeping its formula secret, not only as information that derives economic value but as a mystery that continues to keep customers interested. People naturally gravitate towards the hidden and mysterious, giving it intrinsic value. This is related to how the customer perceives the brand. Perception, as a psychological concept, is how people picture, interpret or understand the brand in their minds. This has great impact on their behavior, which is what a company is interested in: purchases and loyalty.

On a third but different example, we have Elon Musk's company: Tesla's electric cars have changed how we view the car industry. This particular case refers to an open-sourced patent, meaning that the owner controls how others use



their invention but it is not maintained as a trade secret nor are others legally prevented from using it. In this case, according to Tesla, there is no specific economic plan behind this action but rather an altruistic one. Their enemies are the big gasoline car companies; therefore, they wish to create more competition from other electric car companies for a more sustainable future and address the carbon crisis[6].

Here, we observe a business model that shares their patents because otherwise it would be against their mission. According to their ideals, true competitive advantage comes from innovation instead of preventing competition advancement. They want the future of electric cars to accelerate in order to help the environment and they even made the statement that their goal wasn't to make profit. This business model is completely different from the other two we observed before, Tesla does not patent their cars or use trade secrecy. They believe this system will strengthen Tesla's position instead of weakening it.

To summarize, here are some practical solutions to the question of how to strategize intangible assets in a business. If opting for a patent, having an exclusive register that gives a limited use of time can be an economic advantage when having an easily replicated invention. It can also grant the company status and positioning in the market, forming customer loyalty. When opting for a trade secret a business has to evaluate if they have the resources to maintain the secret as long as it has commercial and economic value, the secret has to be characteristic, and irreplicable. Finally, there are additional innovative options that do not fit into either category, these are outside of regular parameters which give us a new outlook towards new ideas of business and IP protection.

[6] *(Musk, 2014)*

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ChatGPT and intellectual property

Agnieszka Wachowska and Marcin Ręgorowicz of Traple Konarski Podrecki and Partners shed light on the much-debated topic of IP protection, and indeed infringement, for AI-created works.

One of the principal topics in the recent intense debate on the subject of development and use of artificial intelligence (AI), and of the system that is best known as ChatGPT, is the question of intellectual property rights. In fact, examination of this issue and the legislation enacted to address it will have significant implications with respect to the areas into which use of these systems expands, due to its potential – especially for commercial applications.

There are three main legal problems relating to this issue:

1. Possible infringement of third-party intellectual property rights when the system is "learning" and when it is launched;
2. The status of the generated content and how to protect it;
3. Who holds the right to use the generated content.

Machine learning and copyright

The issue of machine learning is a highly emotive one and has already led to specific legal measures being taken in particular lawsuits against AI system suppliers. Training the system concerned requires systemic analysis and processing of huge amounts of data, including data that constitutes works protected under copyright law in various jurisdictions. The debate centers around the right of operators of systems that "learn" to make use of databases that are in the public domain. The main claim against operators of systems of this kind is that they unlawfully extract and process available data in a massive and automatic manner (i.e., so-called "web scraping"), which is then used to create their own content. The parties that raise claims say that this conduct infringes the rights of the original authors or other rightsholders. Importantly, holders of rights to databases on which AI systems "learn" are able to file similar claims.

Legislators in various countries around the world and in the EU have discerned this problem, and in the EU, elements of a regulatory framework addressing the issue were implemented in the DSM Directive. Under the DSM Directive[1], national legislatures are required to pass laws enabling third parties to reproduce databases or works in the meaning of copyright law for the purpose of machine learning. This applies to both academic and commercial use, while a rightsholder can refuse to give consent with respect to commercial use. The respective laws have been passed in some EU countries. In the case of Poland, the legislative process and work on amendments is ongoing (as of the moment this article went to press).

1 Directive (EU) 2019/790 of the European Parliament and of the Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC (OJ L. of 2019, 130, p. 92).

"In most legal systems, one of the essential criteria for an element to be considered a copyrighted work in the meaning of copyright law is that it has to be the product of human creation."

Clearly, this issue is very interesting from a legal point of view, while in the view of the authors, it is crucial primarily for creators and providers of systems of this kind, taking into account the practical aspects of using ChatGPT and similar tools. It is these parties that will firstly face a risk due to the claims being pursued.

Whether or not it is a copyrighted work

The other issue with many more practical implications for users of ChatGPT and similar systems is the status of the generated content. The starting point for considering this issue is the question of whether this content constitutes copyrighted works. The debate among experts has become very important, and resolving the issue has now become a matter of urgency. The concerns stem from the fact that in most legal systems, one of the essential criteria for an element to be considered a copyrighted work in the meaning of copyright law is that it has to be the product of human creation (the Polish legal system is one of such systems). It is a fundamental premise of copyright law that it protects the product of human creativity.

This leads to the view that even if particular content generated by ChatGPT has features that are identical to content created by a human author, it does not constitute a work in the meaning of copyright law, as the legal requirement of human creative output is not met. This approach means that copyright protection does not apply, and therefore it is permitted for example to freely copy, adapt, and make commercial use of content of this kind.

The opposite viewpoint is also taken, that content generated by ChatGPT and similar systems can be considered copyrighted works under current copyright law, because ultimately the creator is human. There are various proposals in this regard, while in this approach the author is identified for instance as the operator of a particular system (or the party that constructed and "trained" it), or also the end-user, as the end-user defines the criteria for the generated content, and thus plays the fundamental creative role in creation of the content.

This issue is currently unresolved. Intervention of the legislature in specific jurisdictions is needed to address these concerns. Of course, the issue could be settled in court rulings on the issues described above. The first cases have now been filed in courts in various countries around the world.

In the authors' view, in the context described, the institution of *computer-generated works* is noteworthy, which has existed for years in certain jurisdictions such as the United Kingdom. Under the UK's 1988 Copyright, Designs and Patents Act, *the work is generated by computer in circumstances such that there is no human author of the work.* These works are protected by copyright, while the copyright to the work is held by the person who performed the essential actions to create it.

The numerous legal concerns regarding the status of content generated by ChatGPT and similar systems also include the issue that if this content is considered to constitute a work, the next debate arises as to the relationship between this content and works used in the "training" of the system in question (such as ChatGPT). The extreme view is that content generated using AI must be considered a derivative work or the equivalent of this institution in other jurisdictions in relation to the works on the basis of which the system did the "learning". According to this concept, use of content generated by the system in question would require, for example, permission of the original authors. In practice, this would mean fulfilling the necessary formalities and making the appropriate payments to them. This would also have serious consequences for ChatGPT end-users, because using content generated by AI in their business activity could infringe the rights of authors of the original works, and result in direct liability, notwithstanding the liability of the system provider.

In our view, this is not a correct position, reached due to not being aware of the "technical" nature of operations of ChatGPT and similar tools. Meanwhile, it is an excellent illustration that fundamental issues regarding use of this revolutionary technology remain unresolved, and of the high level of legal uncertainty surrounding its use. More importantly, the current copyright framework is based on rules formulated at a time when artificial intelligence did not exist, and was talked about in the realm of science-fiction. Clearly, the main copyright institutions are not suited to this new reality. At the moment, it is essential to reflect on elements of law as fundamental as the characteristics of a work. For this reason, ChatGPT users need to follow the ongoing debate closely, as use of generated content could prove to be an infringement of third-party rights at a certain point.

There is no doubt that in the current debate on the legal aspects of AI systems, the most fundamental issues need to be addressed, above all whether content generated by tools of this kind is protected by law, and on what grounds. On the other hand, the benefits of technological systems of this kind are so great that many persons and institutions have begun using them in their business activity or will consider doing so. Clearly, therefore, we can expect an exciting debate on the fundamental concepts of copyright law in the new social and economic reality.

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The examiner's logic for a neural network system patent

Yu-Li Tsai, Partner and Patent Attorney, of DEEP & FAR Attorneys-at-Law raises a practical examination case to help those in the information technology applications field better understand the patent application process for neural network systems.

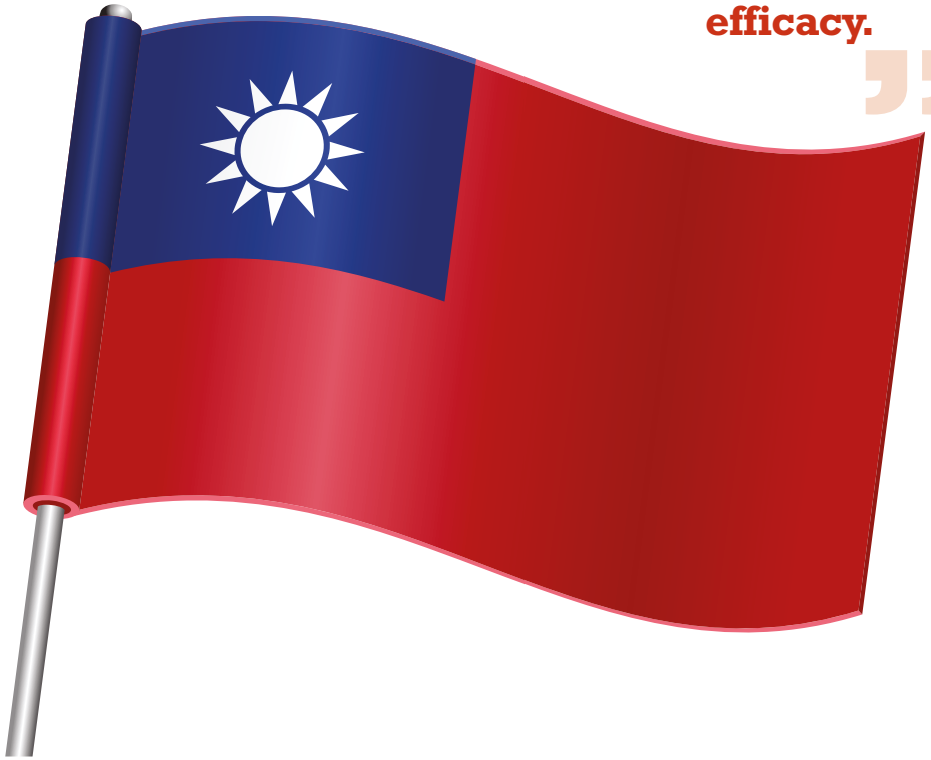
I. Purpose

Five major information technology application fields, including artificial intelligence, big data, blockchain, Internet of Things and cloud applications are becoming increasingly popular in recent years, so it is very important for a player in this field to know how the examiner in Taiwan would examine the patent application related to the innovation in these fields.

Therefore, this article would like to raise a practical examination case related to a neural network system for the reader to have a brief idea what is the examiner's logical thinking during the examination.

II. Facts about a neural network system case

1. [Problem to be solved] The modern neural network system needs to introduce a nonlinear relationship between the output and the input; otherwise the output of the next layer in the system is a linear combination of the input from the previous layer (that is, matrix multiplication), and the output and input are still kept with linear relationships rather than modern neural networks used for nonlinear statistical data modelling.



> **A claim directed to the invention should not merely recite that a processor is used to execute certain unspecific commands to achieve some expected efficacy.**

2. [Technical means] The command is executed by a system with a processor and a memory, and the command uses an activation function to convert the input initial data into linear rectified data.
3. [Efficacy] By converting the initial data into linear rectified data through an activation function (ReLU function), a nonlinear relationship between the output and the input can be introduced into the neural network system.
4. Claim 1:
   A neural network system, comprising: a memory, capable of storing one or more commands; a processor, coupled to the memory, capable of accessing and executing the one or more commands of the memory, for enhancing non-linear data characteristics of a data.
5. Claim 2:
   A neural network system, comprising: a memory, capable of storing one or more commands; a processor, coupled to the memory, capable of accessing and executing the one or more commands of the memory; the one or more commands include: receiving initial data to a first area, the first area includes at least one activation function in the neural network, the activation function is a ramp function, which can convert the initial data into linear rectified data; the linear rectified data is further transmitted to a second area to generate a learning result corresponding to the initial data.
6. [Specification] The neural network system can include computing layers such as convolutional layers, activation layers, pooling layers, and fully connected layers. This system uses a computer system including a processor and memory to execute the neural network model and limits the activation function of the activation layer to be a ramp function, which can perform nonlinear filtering on the output value of the convolutional layer, and endow the neural network system with a nonlinear relationship between the output and the input.

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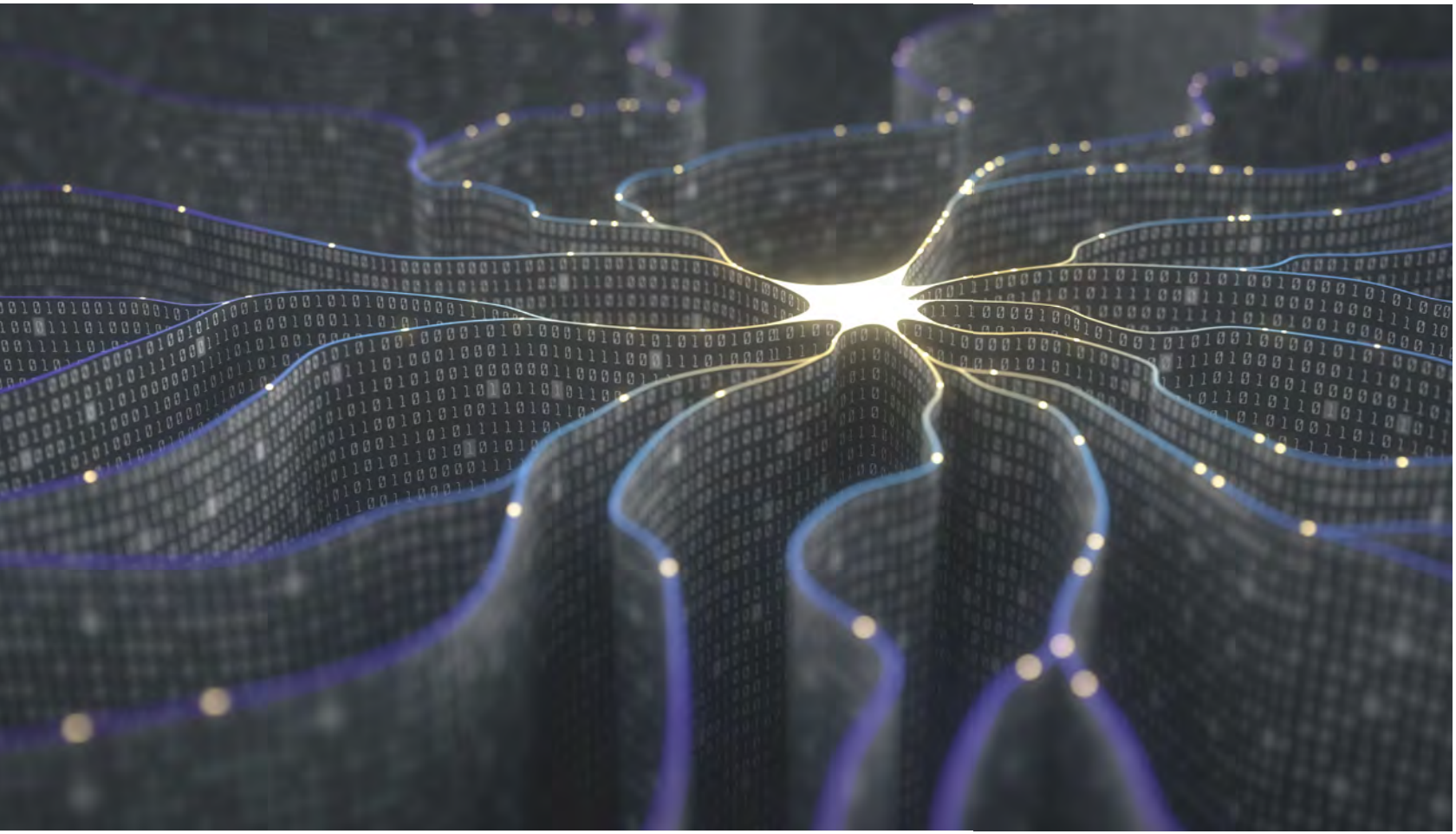

III. Examiner's logic

1. Claim 1 does not meet the definition of invention
2.Claim 2 meets the definition of invention.
3. The steps for judging subject matter eligibility are as follows:

(1)Whether it obviously meets the definition of invention: the inventions of the Claims 1 and 2 do not implement a control of the machine, nor is it a process accompanying the control. In addition, the information processed by the inventions of claims 1 and 2 is data, and there is no limitation on what the data is, so the information processing based on the technical nature of the object is not performed. Therefore, the inventions of claims 1 and 2 did not obviously meet the definition of invention.

(2)Whether it obviously does not meet the definition of invention: the inventions of claims 1 and 2 are "system" inventions, so it is implied that they are jointly completed by software and hardware, so it is not obviously ineligible and should be further judged from the perspective of software.

(3)Judging from the perspective of software:

[Claim 1] Although Claim 1 discloses that a processor is used to execute commands to enhance a data's nonlinear characteristics, it only discloses the execution commands, and does not disclose how to process the data to enhance its nonlinear data characteristics. Therefore, it does not specifically disclose software using hardware resources to achieve specific information processing and does not meet the definition of invention.

[Claim 2]

Claim 2 discloses a processor execution command, which has clearly disclosed that its activation function is a ramp function, and the processed data also specifies the initial data of the first area, which becomes linear rectified data after being processed by the activation function data, and transmits the linear rectified data to the second area to generate a learning result; therefore, the data to be processed becomes linear rectified data after being transmitted, flowed and processed by the activation function between the neural networks, and continues to be computed to generate a learning result, and it is also clearly disclosed that the activation function is a ramp function, so the invention of this claim has disclosed that the specific software and hardware work together to achieve specific information processing, which meets the definition of the invention.

IV. Conclusion and suggestion

In view of the above case study, we would like to conclude and suggest that when an invention is related to software, such as a neural network system, a claim directed to the invention should not merely recite that a processor is used to execute certain unspecific commands to achieve some expected efficacy. If no specific algorithm or operation corresponding to the execution commands for achieving the expected efficacy is disclosed, the claim will be judged as not specifically disclosing the software using hardware resources to achieve specific information processing, which does not meet the definition of invention.

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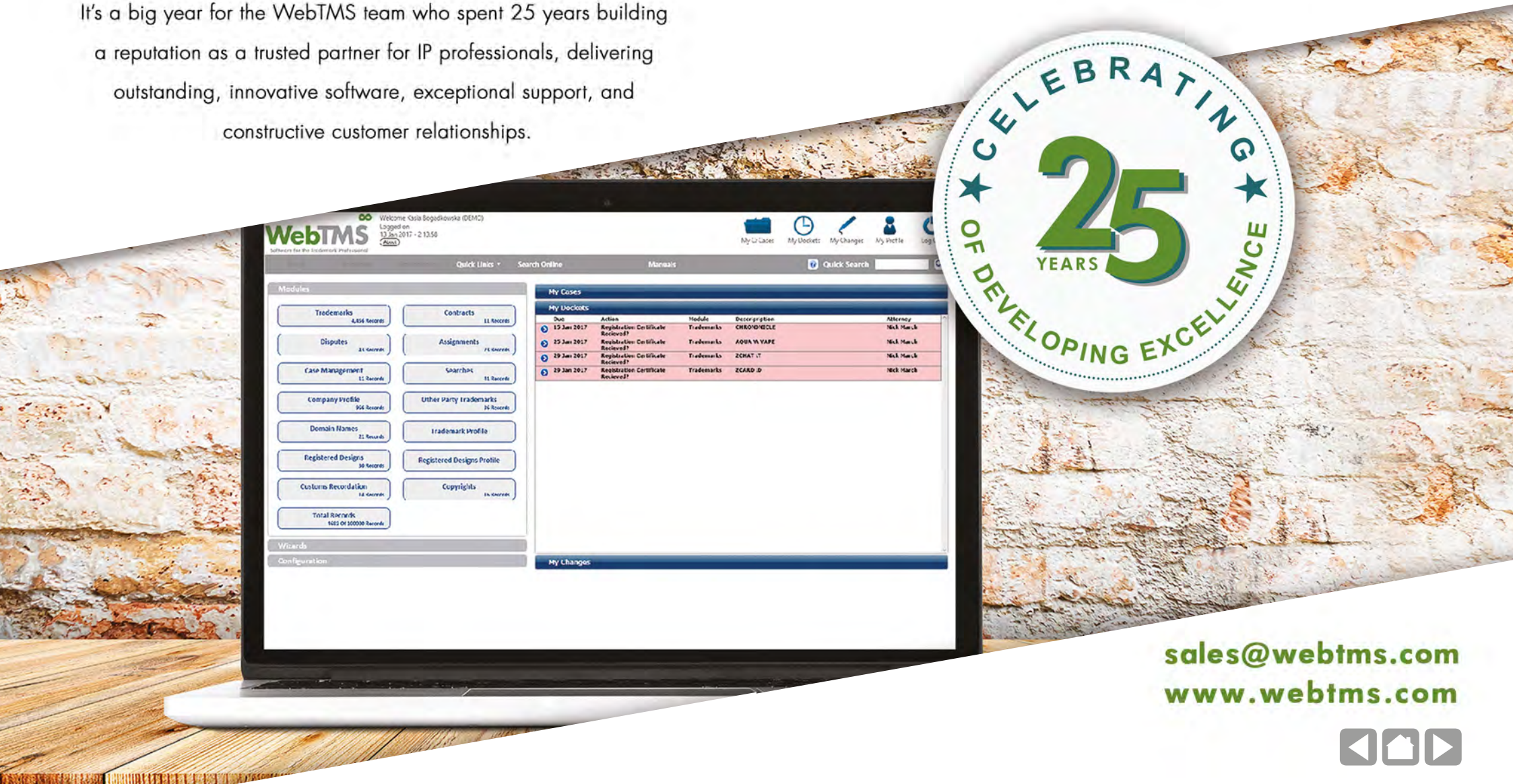

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Celebrating 25 years in IP Software and setting our sights on the future

Rita O'kyere, Brid Madeley and Andrew Partridge of WebTMS reminisce over the developments of the past 25 years and express their excitement for new advancements on the horizon.

It's a big year for the team behind WebTMS. 2023 marks 25 years since we first took our award-winning trademark management software to the market. During that time, we have seen the intellectual property sector grow and change almost beyond recognition. The roles and responsibilities of trademark attorneys and paralegals have evolved, and the volume of filings has soared as globalization has opened new markets and lowered barriers to entry. Awareness of the value of IP has risen, too, leading to a corresponding rise in activities to protect brands and defend them from infringement in a market that now includes virtual, as well as geographical and online spaces

When we first launched WebTMS, we knew that trademark management was crying out for digitization. By digitizing records and adding automatically generated data drawn from national trademark databases across areas such as renewals, filing dates and more, we could help trademark administrators work faster, improve accuracy, and lift the administrative burden.

Over time, we have evolved our software to meet the demands of our industry, always in close consultation with our clients. This means our solution truly complements the expertise

> **"We have evolved our software to meet the demands of our industry, always in close consultation with our clients."**

of IP professionals. As those needs grow more sophisticated, solutions must keep up, so we maintain a close watch on potential applications of new technology. In our experience, the following are key features software needs to get right so it adds value and make users' lives easier:

Intelligent automation for efficiency and accuracy

There's one thing no legal professional has enough of, and that's time. Consequently, a tool that drives efficiency – without compromising on all-important accuracy – will always be attractive.

This is where process automation comes in. Identifying the core processes involved in a task and applying automation lets tech do the heavy lifting, reduces the administrative burden and removes errors that can creep in when humans are asked to undertake repetitive tasks.

Our solutions deploy automation to support IP management processes in various ways. In our increasingly globalized workplace, we recognize that many clients are managing worldwide portfolios, so we looked for a way to use automation to make their lives simpler. Our DataSync feature, for example, allows clients to have their trademark records automatically updated from more than 180 jurisdictions in real time. This eliminates manual updating, ensuring that users' proprietary records always reflect their official status.

Another important feature of any tool that uses automation is control. Users need full visibility over what's being automated and the ability to audit when needed, to ensure outcomes are expected - and are therefore trusted.

Intuitive and user-friendly

It seems like a no-brainer that technology should be easy-to-use, but it's surprising how often this isn't the case. Successful software links intuitively with the process it is designed to assist, and users can see logically how to incorporate it into their workflow. This requires developers to have a strong working understanding of what their users are trying to achieve and how they have gone about this in the past.

> **One such area which is seeing rapid growth and desirability is the use of API technology to easily combine and overlay different data sets together.**

> **There's one thing no legal professional has enough of, and that's time.**

Failure to get this right results in poor adoption and sees technology investment failing to deliver ROI as users continue to do things the same way they've always done.

Support will always be essential

Intuitive software can get you a long way, but there will always be moments when you need to get one-to-one support tailored to the problem you're trying to solve. That's why we believe that the facility to have responsive, informed support available when you need it should be part of any decision to invest in an IPTech solution.

Future roadmap from the team behind WebTMS

The world of intellectual property is constantly changing, which means IPTech needs to keep evolving, too. The team behind WebTMS has spent 25 years building a reputation as a trusted partner for IP professionals, delivering outstanding, innovative software, exceptional support, and constructive customer relationships that have seen client suggestions incorporated into new software features. This is in our DNA and we will be taking it forward as we continue to develop WebTMS using client feedback, market trends, and collaboration.

There are exciting innovations in AI-powered searching and brand protection solutions on the horizon, and advances in robotic process automation that can lift the admin burden even further. One such area which is seeing rapid growth and desirability is the use of API technology to easily combine and overlay different data sets together. This can be very insightful for brand owners as it can help them highlight interesting patterns within their portfolio, or indeed help make important economic business decisions based on the powerful data they're presented with.

The intelligent application of automation and availability of advanced data analysis will free IP professionals to focus on the parts of their role that machines just can't replace, such as designing robust and creative protection strategies and liaising with clients to understand their priorities and ambitions for their brand.

Ultimately, the aim of IPTech must be to make our users' professional lives simpler, make them more effective in their role, and support job satisfaction. That is the goal of everything our team does, and we look forward to sharing the next phase of our journey with the clients who have been with us for 25 years, and those we've yet to meet.

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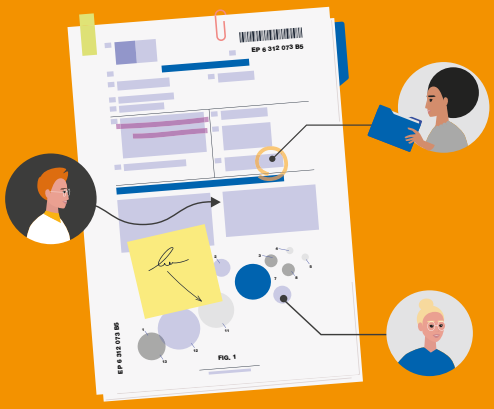

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