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E N I S H I

IP Friends Connections

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This Magazine is published as part of the Intellectual Property Cooperation in Human Resource Development Program of the Japan Patent Office. The aim of this Magazine is to follow up on training programs through the dissemination of information to IP Friends, those who have completed training courses of the above program. We very much hope that the information in this publication related to intellectual property, and the comments from either IP Friends or lectures, will prove beneficial to you in your work.

【The meaning of 縁 (Enishi)】

“Enishi” refers to the bond created between people when encountering someone they were destined to meet. We have chosen this term as the title for our publication because we are all members of the Intellectual Property community, and the bonds created between us extend beyond national borders. We hope that you will use this informative publication to deepen the “Enishi” you have created with your IP Friends.

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FY2019 Follow-up Seminars

The JPO is continuing to hold follow-up seminars in FY 2019 as follows:

No.	Country	Term of Course	Theme
1	Viet Nam (Ha Noi, Ho Chi Minh City)	October 8 and 10	IPRs Protection and Enforcement in Industry 4.0
2	Brazil (Rio de Janeiro)	November 28 and 29	Day 1: Intellectual Property in Latest Technical Trends - Artificial Intelligence and Pharmaceutical Industry - Day 2: Latest Technical Trends in Pharmaceutical Fields
3	Lao PDR (Vientiane)	December 12	Utilization of the intellectual Property System for Economic Development
4	Malaysia (Kuala Lumpur)	February 17 2020	TBA

We will report details of the upcoming follow-up seminars in the next issue.

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Contributions from the former counterparts for the follow-up seminars



Essence of JPO Follow-up Program in Thailand



Chayatawatch Atibaedya (Thailand)

LL.B, Barrister-at-law, MIBA

President, Intellectual Property Promotion Association of Thailand

In 2001, the Intellectual Property Promotion Association of Thailand (“IPPAT”), formerly known as the Intellectual Property Alumni Association (“IPAA”), was established with official support from the Japan Patent Office (JPO). Consecutively, IPPAT engaged in necessary activities to meet the association’s two major objectives: (i) to promote and support activities related to intellectual property (“IP”) for its members, while sharing the information with people and leveraging the nation’s economy; and (ii) to promote technology-related education while developing human resources via seminars and training, and forming academic institutes related to such technology, along with innovation, inventions and intellectual property. In order to promote these objectives in Thailand, IPPAT has successfully introduced awareness to the nation over the past several years through several types of programs, such as attending public hearings on drafting IP laws, visiting schools around the country to explore IP knowledge, educating IP Juvenile Ambassadors, and sharing knowledge on IP laws/management with government and private sectors via seminars and training. Among these activities, holding follow-up seminars under the JPO’s supervision is one of the most essential initiatives for promoting IP law and management as a whole.

To arrange the follow-up seminars, JPO shall directly discuss with our association the possible suitable themes and subject titles to be offered to local participants each year. Major themes and titles were selected under the existing situation and IP system in Thailand at the time. The following themes are those presented in Thailand during past years:

- Recent Development in the Protection and Enforcement of IPRs in Thailand (2006)
- Recent Development in Awareness and Management of Intellectual Property Rights in Thailand (2007)
- Leveraging IP Management of Thailand Through the Force of Global Competition (2011)
- Success of Intellectual Property Management Among Asian Emerging Countries (2013)
- IP Management Within the Global Economy (2015)
- Role of Human Resource Development for the Intellectual Property Sector (2016)

- Intellectual Property Rights Management for Start-up Businesses Under Thailand 4.0 (2018)

For almost two decades of our association's services to the nation, a number of Thai scholars have achieved IP knowledge and awareness via JPO-supported seminars, including both officers and individuals. As the result, our lawmakers have recently agreed to the government promulgating an important law establishing the Ministry of Higher Education, Science, Research, and Innovation, or MHESRI. The major task of MHESRI is to support the nation with higher education necessary to make the country ready for global competition in all aspects, driven by a knowledge-based economy via R&D in order to provide a value-added chain in the form of intellectual property and innovation.

There are a lot of tools through which the new ministry is capable of driving such tasks influentially, for example: a measure allowing private-sector entities who engage in joint R&D with the government to obtain exclusive ownership of IP derived from such R&D; as well as a method to recall the ownership back to the nation if such private entities shall not put forth their utmost attempts to manage such IP properly. Our association learned that those participants who had attended the JPO follow-up seminar in Thailand recently became high-ranking government officers, academic scholars, top-level IP officials, and innovation managers who have helped to drive such a new era of ecosystem to promote IP in Thailand. We therefore believe that JPO follow-up seminars are vital for developing the nation in order to achieve national wealth by creating social awareness regarding IP rights, as well as how to manage them successfully.

Thank you to the JPO management and its personnel who provide such continuing meaningful support to Thailand.



FY2007



FY2011



FY2013



FY2014



FY2016



FY2018

VIET NAM - JAPAN INTELLECTUAL PROPERTY SEMINAR - BENEFITS AND POSITIVE EFFECTS ON THE IP SYSTEM OF VIET NAM



Ms. Nguyen Thi Hoang Hanh (Viet Nam)

Doctor of Law, Official of the IP Training and Consultation Center, IP Viet Nam

Japan is among the world biggest economies, and is a leading country in R&D, innovation, utilization and successful commercialization of research outcomes. Each year, hundreds of thousands of domestic patent filings are acquired for protection in Japan. This fact results from the development and implementation of the country's national IP strategy, and the enhancement of the innovative capacity of relevant stakeholders. The government of Japan has always paid special attention to the protection and enforcement of IP rights.

The IP system of Viet Nam is almost 100 years younger than that of Japan. The best practices and failure lessons from Japan's IP activities always hold precious lessons for Viet Nam, and Japan has been one of our important partners during the long history of developing the IP system in Viet Nam. The Japan Patent Office has supported IP Viet Nam in implementing several technical cooperation projects that aimed at strengthening the capacity of the entire IP system, particularly since 2010¹. Under this bilateral cooperation, the two offices have mapped out an annual workplan with various activities targeting various IP stakeholders. Apart from technical assistance and IP training for Vietnamese IP professionals, the follow-up seminar that has been held in Viet Nam every two years since 2005 is considered to be effective and accessible to many local target groups.

The seminar theme is often proposed by IP Viet Nam based on the prioritized issues of interest that our country is most concerned with, and wishes to learn about from the experiences and strengths of Japan. The theme is subsequently discussed and carefully considered by the Japanese side. Based on the proposal of issues raised by Viet Nam, Japan then invites experienced speakers to share the most useful information to Viet Nam. There have been eight follow-up seminars successfully organized in Ha Noi and Ho Chi Minh City since 2005, with the total participation of almost 1,500 attendees selected from relevant agencies and organizations. The seminars have not only become opportunities for alumni who once participated in training courses in Japan,² but have also become an open forum for all participants to

1 Project on Modernization of Industrial Property Administration System (IPAS) from 2000 – 2004, Project on Utilization of Industrial Property Information in Viet Nam (UTIPINFO) from 2005 – 2009, and Project on Strengthening the Enforcement of Intellectual Property Rights in Viet Nam from 2012 – 2017.

2 Over the past 20 years, thousands of trainees from the Asia-Pacific region, including 700 Vietnamese, have been trained on IP in Japan. Most of the Vietnamese officials trained in Japan have now become core staff working in the IP system of Viet Nam.

share the practical experiences and knowledge that they acquired from the training courses in Japan.

The first seminar was organized in 2005 under the theme “Enforcement of intellectual property rights”. The Japanese speakers gave presentations on the enforcement of intellectual property rights from the perspective of businesses and enforcement agencies—particularly the role of police in the raid against infringement of IP rights, which is a field wherein Viet Nam faces many difficulties.

The second follow-up seminar was organized in 2007 under the theme of a well-known marks and brands strategy. The issues concerning well-known marks were paid special attention by various countries, with differences in legislation and practice. Though Viet Nam owned a big variety of reputable products, particularly local specialties, not many famous marks were known to the world. One of the main reasons was that businesses did not know how to further promote their brands and effectively protect their famous marks. Japanese speakers provided Vietnamese enterprises and authorities with information regarding their experiences in strategically branding and utilizing well-known marks for national economic development.

In 2009, the theme for the third follow-up seminar was decided as “Intellectual Property Rights: Academia - Industry Collaboration in Protection and Utilization of Intellectual Property Rights”. The topics that drew the most attention from the audience were how to foster intellectual property as an important tool to promote R&D activities, commercialization and samples of effective collaboration between academia and industry. Viet Nam has recently adapted the precious experiences from Japan and other countries—particularly the implementation of IP-Hub and Technology and Innovation Support Centers, with support from the World Intellectual Property Organization. The TISCs Network has now been further broadened in term of the quantity and quality of activities.

With an aim to exchanging views on how to utilize IP as a powerful tool for business activities, as well as how to propose appropriate solutions to difficulties in IP acquisition, the fourth follow-up seminar in 2011 was named “Relationship between IP Office, IP Agents and Applicants in Improving the Effectiveness of IP Acquisition”. The seminar discussed difficulties faced by IP Agents and applicants during their acquisition of IP rights. At the same time, Japanese speakers also shared practical experiences concerning the seminar theme. Feedback gained from the seminar has been a valuable source of reference for IP Viet Nam to improve its service in order to satisfy applicant needs.

The establishment of IP rights is an initial crucial step in the intellectual property cycle, as it helps formulate a legal status for IP rights. The next step, which is of no less importance, is the utilization of IP rights. Such rights will become meaningless if they are not utilized in an effective and timely manner. There is a lack of due attention and capacity in the management and commercialization of IP rights in Viet Nam—particularly in research institutions. Meanwhile, in Japan, this is a strength. With a desire for studies on IP supporting policies, as well as best practices in the management and commercialization of IP rights by Japanese research institutions, the fifth follow-up seminar in 2013 was held under the theme management and commercialization of IP assets in universities and research institutions. Participants were interested in IP commercialization experiences and Japanese government efforts to encourage the utilization of innovative research outcomes for manufacturing activities.

Against the background of globalization and the recent advancement of science and technology, the enforcement of IP rights faces new challenges. The theme strengthening the enforcement of IP rights in Viet Nam was once again proposed for the sixth follow-up seminar in 2015. The seminar discussed the challenges posed for the enforcement of IP rights in the context of international integration, as well as measures to overcome such challenges. Typical infringement cases in Japan that were introduced at the seminar in the fields of patents, industrial design and trademarks provided interesting lessons for enforcement authorities in Viet Nam, and speakers from both sides enthusiastically discussed possible measures

to improve Viet Nam's IP rights enforcement.

The improvement of the investment and business environment in Viet Nam has resulted in vibrant foreign direct investment inflows into the country from foreign businesses, including those in Japan—one of the top countries for patent and design filings with IP Viet Nam. This shows a big potential for Japanese patents and industrial designs to be commercialized in Viet Nam. To help patent examiners, IP agents and businesses understand new technologies of Japan—as well as to help facilitate business collaboration opportunities—the seventh follow-up seminar was organized with the theme developing trends and commercialization of patented Japanese technologies in the early 21st century. Although many IP dissemination and awareness activities have been conducted, knowledge of IP on the part of the Vietnamese business community is still limited. Even universities and research institutions where there is a high innovative potential and strong research capacity are still not proactive enough in utilizing the advantages of IP, nor IP-related information and databases, toward R&D activities. Japanese speakers from big corporations that have successfully utilized IP for business activities, such as Honda and Canon, were invited to the seminar to share experiences with Vietnamese companies.

Following the successes of the previous seminars, the eighth seminar will be held in October 2019 in Ha Noi and Ho Chi Minh City. In the context of the Industrial Revolution 4.0 that has been affecting every aspect of life, intellectual property should go in tandem with the pace of development of new technologies born from the Industry 4.0. Given this fact, the theme for this year seminar has been decided as IPR Protection and Enforcement in Industry 4.0. The seminar is expected to bring experts' insights regarding the effects of Industry 4.0 on socio-economic development in general, and the IP system in particular. Experiences in dealing with newly arisen matters resulting from artificial intelligence—i.e., new IP subject matters, IP rights holders, enforcement of IP rights on the internet, etc.—promise to be greatly interesting to the audience.

Apart from other cooperative activities, IP Viet Nam always highly values the bi-annual follow-up seminar, as it helps spread and disseminate IP information to almost all concerned IP stakeholders in Viet Nam's IP system. The seminar has become an open forum to regularly update new knowledge and practices in IP protection, and above all, the experiences of Japan are always valuable and useful for Viet Nam to further enhance the capacity of the entire IP system. It is sure that the follow-up seminar will continue to be held in Viet Nam in the years ahead.

Some images from the follow-up seminars over the years:



FY2009



FY2011



FY2013



FY2015



FY2017

3

Contributions from the former long-term fellowship researchers



My Personal Impression on JPO/IPR Training Course for Cambodia



Mr. Ly Sonabend (Cambodia)

Chief of Automation and Information Technology Division,
Department of Intellectual Property, Ministry of Commerce

(April 10 - September 28, 2012)



It has been more than 12 years since I joined my office, the Department of Intellectual Property, Ministry of Commerce. At that time, 2008, Japan was the first country in which I took a mission abroad, everything was new to me, especially Intellectual Property. The course which I participated in during that time was “Training course on the Use of Information Technology in Industrial Property Administration”, the objective of the training course was to familiarize the participants with the implications of recent developments in information technology in relation to industrial property administration; impart practical knowledge of the use of information technology through interactive sessions using networked personal computers as well as through visits to the relevant private entities; provide an opportunity to exchange views and concerns among participants on topical related issues, and thereby enhance the participants’ professional capacities in planning and managing the use of information technology in industrial property administration. The course was very interesting and finished with fruitful results.

In 2012, I had an opportunity to participate in another JPO/IPR training course “Six-Month study-cum-research fellowship” in Tokyo, Japan from April 10 to September 28, 2012. The objective of the fellowship program was to enhance the knowledge and understanding of the fellows on topical issues in the field of industrial property, by providing them with an opportunity for independent research on subjects of their choosing, such as: significance of human resource development in the field of industrial property for economic development; industrial property policies implemented by the Japanese Government; implication of information technology in the industrial property field; current trends in strategic utilization of industrial property in the private sector; comparative study of industrial property laws and practices; and other subjects of significance related to industrial property.

Allow me to talk a little bit about JPO/IPR training course called “Six Month Study-Cum-Research”, “*The long term trainees are provided an environment in which they are able to conduct independent studies such as receiving guidance from professors, visits to related institutions necessary for the studies, etc.*” which was sponsored by WIPO in collaboration with the JPO. That mission was my first and longest stay abroad that I have ever taken. I arrived in Tokyo, Japan on April 9, 2012 around 5 pm and the next morning I needed to wake up early (since Japan’s time is 2 hours ahead of Cambodian time) to meet my two coordinators, who we used to contact via email before my arrival in Japan and also to meet my new friend who also attended the six month study-cum-research from Thailand “Ms. Pattarawan Charumilin”. After having a very short introduction we all went to request the issuance of “Certificate of Alien Registration”, since when I was going to stay in Japan for more than one month, I needed to get that permission to stay in Japan. Thereafter, we had our first lunch together at “OIOI Department Store” located near “Kita-Senju Station”. After finishing the delicious lunch, we went to APIC where I needed to go every working day. APIC stands for Asia-Pacific Industrial Property Center, it provides a working space, laptop and printer, and other office facilities, such as a library. The room was so nice and quiet, it suited researchers to do their work. A few weeks later, I met with my professor of my research “Mr. Hatori Kenichi” from KEIO University. My professor used to be the lecturer of the short course that I attended in 2008 and the good thing was we still remembered each other, so it made our relationship closer and friendly.

During my study and research, I learned many things which are related to Intellectual Property as well as Information Technology in the field of IP. The intellectual property System in Japan showed me the big differences from these two countries. It seems like my office needs a lot more time to catch up with the current IP situation in Japan. IT for IP in Japan is much more advanced than 20 years ago. It has a unique section for each field and is very well organized, so it makes the process from receiving the application until granting the certificate and protection of the rights “EXCELLENT!”. Moreover, beside the study and research relating to my topic, I also joined the interview with my friend from Thailand to some research institutes in Japan to understand more about IP policy and commercialization. Another benefit was, I could join any JPO/IPR training courses which were conducted in APIC during my six-month study-cum-research.

I believe, I participated in all of the 3 programs but not the Medium-Term yet:

1- Short-term and medium-term training programs

Normally the short-term takes 1-3 weeks. To make the classes are more interactive, the curriculum was designed such as:

- Country report presentation, which covered the general IP situation of each participant’s country
- Exercises, the lecturer shows some case study so in the training room there was a laboratory room which had some PCs available for every participant to use during the lecture with some tools and the participant can follow the lecture. E.g. the show case of FI and F-term (FI [File Index] and F-term [File forming term] are Japanese patent classification systems consisting of approx. 190,000 and 360,000 entries respectively, which enable the efficient search of patent documents.)
- On the job training, which allows the participants to meet with JPO official to see real cases of their work
- Tour visit, which allows participants to visit big companies in Japan to understand their IP systems

- Feedback and Comment, each participant needs to deliver personal speech on their own opinion on Feedback and giving comment on the JPO/IPR training course
- Certificate presented to each participant for their effort and interactive participation

2- Long-Term Research Program

In the long-term research program trainees visit Japan to research themes on Intellectual Property systems and prepare reports on their results. These research results are aimed at supporting Intellectual Property systems in their home countries. In addition, the Long-Term Researchers are expected to serve as intermediaries between Japan and their countries.

For the long-term research program course, Cambodia had 4 participants already benefitting from this course, including myself and the current Director of Department of Intellectual Property, Ministry of Commerce, Cambodia who was the first candidate for this course.

3- Seminars on Intellectual Property Rights (Follow-up seminars), held outside Japan every year, to provide ongoing support to former trainees and to develop awareness of IP in their own countries. Since I joined my office, the follow-up seminars in Cambodia has occurred 2 times, and the seminar invited all the participants who have participated with JPO/IPR training courses.

Overall, the JPO/IPR training course is extremely useful for Cambodia, I believed that almost 95 percent of my colleagues in my office have participated in the JPO/IPR training courses. Not only Intellectual Property officers but also some sections like Custom Officers, Lawyers, Intellectual Property Law Firms, Lecturers also gained the benefit from JPO/IPR training courses.

In the last two years, the JPO conducted a special course only for Cambodia Madrid team of my office, at that time 10 participants from Madrid Division joined the training course in Japan for 2 weeks. APIC provided a Japanese / Khmer language interpreter which was very convenient for colleagues who joined the training course and made the training course more interactive.

To promote communication among trainees, and to disseminate information on Intellectual Property rights, a Facebook page “The Japan Patent Office Cooperation in Human Resource Development”, other sources of information include, online magazine “Enishi” which consists of posts from former trainees and articles on intellectual property. To help trainees continues networking, a CD containing a directory and contact information of trainees and lecturers is available to all trainees.

At last, I would like to take this opportunity to extend my sincere thanks to JPO/IPR training course, APIC-JIPII and the government of Japan for the remarkable progress that has been made and providing further kind assistance to Cambodia.



FY2008



FY2008



FY2012

4

Introduction of 2019 long-term fellowship researcher



Yoroshiku Onegaishimasu (Nice to meet you all)



Anthea Kristine Y. Paculan (the Philippines)
The Intellectual Property Office of the Philippines (IPOP HL)

Mabuhay! I am Anthea Kristine Y. Paculan from the Philippines. I joined the Intellectual Property Office of the Philippines (IPOP HL) in 2011 as a patent examiner in the Chemical Technology Examining Division of the Bureau of Patents. Prior to IPOP HL, I was a research engineer at the only national university in my country, the University of the Philippines. At present, my duties include patent searches and examinations, training of new and senior examiners, lecturing to organizations in my country and to foreign guests, and conducting a variety of research as assigned by IPOP HL.

IPOP HL is the government agency mandated to administer and implement state policies on intellectual property (IP) to promote innovation, and to encourage the creation, utilization, protection of and respect for IP. One of its main functions is to examine applications for granting letters patent for invention. In line with IPOP HL's commitment to deliver high quality and efficient services, the office is continuously working on standardizing and improving the patent examination procedures and practices across all divisions in different fields of technology, especially in the chemical field. This field contributes to the greatest number of patent filings in the Philippines, and encompasses a diverse number of subject matters. Thus, evaluating the patentability of inventions in this area is a challenge at times. This is especially true when it comes to assessing the patent eligibility and/or industrial applicability of several cases.

As the IPOP HL was designated as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA), it is continuing to innovate and upgrade its systems and procedures by adapting worldwide standards. The Japan Patent Office (JPO), an established ISA/IPEA, has provided comprehensive guidelines addressing various patentability issues, especially that of patent eligibility and industrial applicability of subject matters in the chemical field. Therefore, an enhanced knowledge and understanding of the patent examination practices and perspective of JPO, in the context of existing Philippine laws on patents, will be beneficial.

I am grateful to the JPO and the Asia-Pacific Industrial Property Center of Japan Institute for Promoting Invention and Innovation (APIC-JIPII) for supporting my study and my stay in Japan, for allowing me to be part of the JPO Long Term Study-cum-Research Fellowship Program (FY2019), where

I can make a contribution towards IPOPHL's initiatives to enhance the quality of patent examination to be at par with the established ISAs/IPEAs. My proposed research theme will look into Japan's approach regarding the patentability of chemical technology inventions, with a focus on their patent eligibility and industrial applicability. Japan's practices, policies, and experience on patent examination in the chemical field will provide a new perspective on how we can handle the same matters in the Philippines. Ultimately, this study will be helpful in understanding each IP office's examination standards, and will aid in improving the work-sharing between the two offices.

I am aware that this four-month period will be filled with numerous challenges. However, I will have the guidance and support of Japan's experienced researchers and professionals along the way, and knowing this has made me feel more confident in facing the journey ahead. Besides, if it gets too tough, there's always ramen, sushi, gyozu, gyudon, takoyaki, teppanyaki, okonomiyaki, mochi, and matcha parfait to get me through the hard times!



Xin chào!

Duong Thanh Long (Vietnam)
IP Attorney
Managing Partner
ALIAT LEGAL



My name is Duong Thanh Long. I am an IP Attorney from ALIAT LEGAL, an intellectual property and business law firm in Vietnam. I have been working in the field of intellectual property practice for almost 19 years with great passion and aspiration. I have been involved in various types of intellectual matters ranging from prosecution, enforcement, and litigation in intellectual property to exploitation and commercialization of intellectual property rights, as well as promotion of public awareness about intellectual property in my country, Vietnam.

Vietnam has transformed itself, joining the group of lower middle-income countries, and is now one of the most dynamic emerging economies in the East Asian region. Our country was ranked 45th in the 2018 Global Innovation Index (GII) Rankings and moved up to 42nd in 2019. The GII 2019 looks at the medical innovation landscape, exploring the role and dynamics of medical innovation as it shapes the future of healthcare, and analyzing the potential influence this may have on economic growth.

In the healthcare sector, the pharmaceutical industry plays a critical role that exerts critical impacts on the economy and lives of the people in our country, with a population of nearly 100 million. Vietnam's pharmaceutical market has been growing significantly of late, with a market size of US\$4.6 billion in 2017 and US\$5.2 billion in 2018, and is projected to reach US\$6.6 billion by 2020.

However, in reviewing patent data in the pharmaceutical industry, it is worth noting that 90% of pharmaceutical patents filed and granted by the Intellectual Property Office of Vietnam to date are of foreign applicants, with only just about 10% coming from Vietnamese applicants. Domestic pharmaceutical manufacturers are now capable of producing almost all types of formulations, but most of them are generics and not originals or high-value drugs. This is due to a very low investment in R&D activities, especially in patent activities. In fact, Vietnamese pharmaceutical companies are seemingly not very interested in R&D, and corporate management seems to lack confidence in R&D, especially when it comes to investment into patent activities.

Japan has the third largest pharmaceutical industry in the world. According to the CPhI Pharma Insights Report 2018, Japan has enjoyed its longest sustained period of growth over a decade as a bastion of patented drug consumption. It is also noted that 14.4% of the new drugs (New Chemical and Biological Entities) launched worldwide between 1998 and 2012 were developed by Japanese companies, as announced by the European Federation of Pharmaceutical Industries and Associations. National intellectual property strategy and policy is one of the important factors contributing to such achievement in the pharmaceutical industry. Accordingly, learning from the experiences and lessons of Japan would be practical and useful for Vietnam.

With this approach, I chose the research theme "Impact of national patent strategy and policy on corporate attitudes and investment in patents of the pharmaceutical industry - experience from Japan" with the

expectation of attaining informative, knowledgeable and useful experience from Japan.

It took just two months from the date of receiving the acceptance notice from the Japan Patent Office (JPO) and Asia Pacific Industrial Property Center (APIC) to my arrival in Tokyo to start my four-month research cum study period as one of the very first private IP practitioner researchers under this fellowship program to date. I am really proud of this and would like to express my sincere thanks to the Japan Patent Office and the Vietnam IP Office for giving me this opportunity.

I love Japan and its people, and I am ready for my four-month adventure that will obviously help me to acquire more knowledge, understand more about Japan, get to know more friends and colleagues and enjoy real local food and drink.



5

Training course experience in Japan



My experience in Japan: To the other side of the world for a great reason



Ms. Ana Cristina da Rocha Monteiro (Brazil)
Trademark Examiner/Head of VIII Trademark Examination Division, Trademarks Department
National Institute of Industrial Property (INPI)

FY2018 JPO/IPR Training Course on Substantive Examination of Trademarks
(21 November - 4 December, 2018)



Professional Experience

This was an opportunity that I had been longing for. Being a trademark examiner for 16 years, my happiness at being chosen to participate in the FY 2018 JPO/IPR Training Course on Substantive Examination of Trademarks in Japan was hard to describe. I have always liked traveling for professional reasons, so the opportunity to mix travel, learning, and exchanging experiences was something special, to say the least.

I arrived on the 20th of November, 2018 with another colleague from INPI, Mr. Felipe Bernardes. At Narita Airport we met also our Argentinian and Egyptian friends, and a representative from AOTS who helped us to find the right way out and the train toward Tokyo Kenshu Centre.

The course took place in a decisive moment for the INPI's Trademark Section. We had been fighting against a long delay in granting registration – what we call a *backlog* – and statistics from last year predicted the solution of this problem in one year or two. Thus, having an examiner out of the office for two or three weeks would no longer have such a negative impact on the number of applications to be examined per day. Clearly, it was time to exchange experiences and learn about best practices from other offices in the world.

I found similarities between the procedures of Japan and Brazil, such as the allotted number of applications to be examined per officer per day (ours is an average of 17 applications), and a very similar understanding of what a prior trademark is. Among all the interesting and useful lectures we attended, a certain event caught my attention – the one about Classification of Goods and Services.

I served as the head of the INPI Committee of Nice Classification of Goods and Services from 2007 to 2017. I was initially a member of the *ad hoc* group that provided the changes for the 9th Edition of NCL and a subsidiary list of goods and services starting in 2006, and I became coordinator the following year. This was a subject that had always interested me, and in addition to learning by heart the particular class in which certain items belonged, I also began to research and learn the rationale behind the classification and the proposals presented by the Nice Agreement contracting parties.¹

I had a special interest in these subjects, and was very impressed by the similarity group code system developed by the JPO. Although our Brazilian office also provides guidelines for examiners about what should be considered as a similar product or service, we do not have a tool that allocates items in groups and also evaluates the degree of similarity among them. This would definitely be a source of inspiration for our office, as we constantly face difficulties in determining the level of similarity between two or more fields of activities when evaluating a prior trademark conflict. It is also not easy for applicants—particularly those who apply without the assistance of an IP specialist—to indicate items that are not in the classification list. When asked during the training course’s closing ceremony if it would be interesting for students to deepen our knowledge about this specific subject (maybe with a course on it), the large majority of us – if not all of us – answered the question with an enthusiastic “Yes”!

Challenging parts of the program for me were presenting the Country Report with updated facts and statistics from the Brazilian office, and the lecture on distinctiveness—both done jointly with Mr. Felipe Bernardes, the member of INPI’s Board of Appeal mentioned earlier. It was not about the level of difficulty, but a personal challenge wherein I was constantly thinking “I must be clear and precise in English, which is not my mother language. Will I be able to make people understand my speech?” I have some previous experience giving lectures in Portuguese, but since this one would be in a different language, I had to choose examples that could be properly understood both in my language and in English that could fit the time allowance of 20 minutes. Fortunately, I ended up with the feeling that it went well, with positive feedback from Ms. Hiroko Oriyama at the end of the second presentation.

I believe that the course will have a very positive impact on my professional life. Being in charge of one of the ten Trademark Examination Divisions, one of my duties is to apply as much as possible what I learn in my daily tasks, sharing knowledge with the examiners, broadening my vision of examinations, and even being able to propose improvements on it.



¹ At the present time, Brazil is not a contracting party of the Nice Agreement, only adopting the classification system in 2000, and holding the status of observer in the Committee of Experts meetings.

Personal experience

Japan is definitely one of the most welcoming countries I have ever been to – and I can tell you that I have visited around 30. Every time I needed some kind of help (asking for directions on the street or how to find an item in a supermarket, for instance), people were willing to help—most of the time with politeness and a smile. The level of organization and sense of responsibility for keeping public spaces clean is amazing! This is unforgettable and an example to all of us. The Kenshu Centre has extraordinary service at the reception desk, as well as a great restaurant and cleaning service. As we students come from every corner of the world, with different backgrounds and cultures, the management is oriented to fulfill our needs and give us every hint to our daily life in the country, such as guides with transport directions and behaviour tips. By the end of the first week at the Kenshu Centre, I was able to greet the receptionists and ask for my room key in Japanese!

As I would have two weekends ahead of me (the first one being longer, as Friday 23rd november was a public holiday), I took time to visit Kyoto and Kamakura. For the first I took the Shinkansen, which is an experience by itself, and to the second, a regular train. I loved both cities! In Kamakura I made wishes in a temple (you write down your wishes on a small board and hang or tie it on a place designated for it) and visited the Giant Buddha. About Kyoto... I am sure that it is worthy of a longer visit to calmly enjoy the main temples and the Emperor's castle, so I will definitely return!

Tokyo itself was amazing. Every day after the course, I took time to visit a district. One evening in Shinjuku, another in Shibuya, a third one in Ginza, and so on, always mesmerized by the lights and colours and the different foods I tasted. A nice surprise was to see the colourful parks. As it was still autumn, the tree leaves had colours from light yellow to dark red, and the sunsets made the landscape incredibly beautiful.

If I could define in two words (because one is not enough) how I see my experience during those 16 days, I would say honor and gratitude. Honor due to the fact of being chosen among others to take part in such an event, and gratitude for all of the opportunities I had to learn for the sake of self-improvement, both in my professional and private life.

ありがとうございました日本!! Thank you very much, Japan!



Short notes taken by a Brazilian lost in translation*



Mr. Eduardo Rodrigues Rio (Brazil)
Technologist, Designs Examiner, Directorship of Trademarks
National Institute of Industrial Property (INPI)

FY2018 JPO/IPR Training Course on Substantive Examination of Design
(3 - 14 September, 2018)



The course of practices related to the substantive examination of industrial designs was held from 3 to 14 September 2018, organized by the Japan Institute for Promoting Invention & Innovation (JIPII) and The Association of Overseas Technical Cooperation and Sustainable Partnerships (AOTS), with the support of the Asia Pacific Industrial Property Center (APIC). The course was attended by representatives from the Industrial Property offices of Brazil, Cambodia, Egypt, India, Indonesia, Laos, Malaysia, Myanmar, Peru, Philippines, Singapore, Thailand and Vietnam, totaling 25 participants. Their objective was to engage in exchanges about their practices and substantive exam guidelines for registration of design applications.

One of the first activities of the course was a presentation by the participants, including information about their respective countries. During our presentation, we commented on the Brazilian IP Institute, as well as our legislation, statistics, criteria and substantive examination procedures, among other topics. We were also able to learn more about the particularities of legislation and systems to protect designs in other countries. Here are some of the information that (in my opinion) deserves attention for its relevance with the subject:

- Cambodia: The country signed the Hague Agreement in February 2017. It has three design examiners for a total of about 300 applications per year. Registration is allowed for product crafts and partial designs, and multiple designs are accepted in one order. The register is valid for five years from the deposit, which is renewable for up to two periods of five years each.

- Egypt: The design division has 28 employees, including administrative, legal and technical, for about 2,500 annual applications. They are implementing an electronic system for examination of these applications; its legislation permits partial designs, but does not accept manufactured ones. The country admits a total of 50 variations per application, provided that they are homogeneous with each other. Egypt has been a signatory to the Hague Agreement since 1952.



- India: The country has six design examiners for about 10,000 annual applications. It does not allow a partial design system, but accepts applications that include sets of articles with the same visual identity. India is not yet a signatory to the Hague Agreement. It has a control system of design quality, as well as an ISO 9001-2008 certification in relation to these activities.

- Indonesia: There are 57 officers in the copyright and industrial design directorship, with 24 design examiners for about 3,600 annual applications. The registration of craftsmanship is allowed, with only one item being admitted per application; although partial designs or sets of articles may be covered. The registration is valid for ten years from the date of application, and the country is implementing changes in its legislation that may allow automatic protection of three years for short-term unregistered products, and a further five years of register.

- Laos: The country has three employees in the industrial design unit for about 50 annual applications. After a substantive examination, the registration granted shall be valid for 15 years from the application date, which is renewable every five years. (It was not specified if there is a renewal limit).

- Malaysia: Around 1,800 design applications are received per year, whose registration is valid for five years from the date of application, renewable for an equal period up to a maximum of 25 years of validity. The country's legislation is undergoing discussions to expand the scope of protection of designs, to develop a new system that is totally paperless and to accept requesting interfaces and presenting 3D objects. They do not accept partial design requests, and surface patterns must be applied to the object. Those objects that comply with strictly technical functions are not registrable unless they have a "degree of creativity", even if minimal. The country plans to sign the Hague Agreement in 2020.

- Myanmar: IP legislation is still under discussion by parliament. Although the department already has 37 employees, it is not yet established physically. No one has practical training in examinations, and there is still no request involving any of the IP assets. An outline of the design protection legislation industry, currently under discussion, defines design as the appearance of the whole or part of an object, be it hand-crafted or capable of industrial production, or the pattern of lines and colors applied to an object, allowing a multiplicity of records in a single application, provided they are in the same class or subclass. The country provides for a third-party pre-registration opposition system within 60 days of its publication. (If there is opposition, it will undergo a substantive examination before being registered; otherwise, it will be granted without examination.) The term of registry protection shall be 15 years from the date of application, renewable every five years (maximum time not specified).

- Peru: Approximately 14 examiners work for a total of about 350 annual applications in the division of industrial designs under the Board of Inventions and New Technologies. There is a pre-registration third-party opposition period within the term of 30 days from the publication of the request (if it occurs, the substantive examination is carried out). Partial designs are accepted and protected as part of a whole. The country is not a member of the Hague Agreement, as there is discussion regarding whether accession would violate certain legislative agreements. The register is valid for ten years from the date of application.

- Philippines: The country has eight design examiners, for about 1,500 annual applications. There is a single object per application, although in some cases more than one object is allowed. The country has a

register system based only on a formal examination of the documentation submitted, without a substantive examination, which may be requested by its holder. A continual revision of regulations has been implemented to cover “emerging designs” such as 3D prints, interfaces and icons, as well as to offer the opportunity for third interested parties to provide subsidies for the review of registrability criteria. Partial designs are accepted, and the country is considering joining the Hague Agreement.

- Singapore: The Singapore office is part of an ecosystem covering interconnections with other government agencies, schools, universities, institutes and associations of design, having won several awards for performance. The country receives an average of 4,500 annual applications that are granted an initial protection of five years, and are able to be renewed up to a maximum of 15 years. There is no substantive examination prior to granting and accepting requests with partial designs; after a legal review, they began accepting applications presenting handicraft products to protect colors, with a new classification category of “non-physical products” having been created as an integral part of the design for the protection of virtual objects. (These do not have a physical form, but are “produced” from a projection on a surface or some medium, including air, that has an intrinsic utility function and does not simply reproduce the form of an object.) The grace period has been extended to 12 months prior to filing, and multiple objects are accepted in the same application, since all are inserted in the same class.

- Thailand: The division has a total of 54 employees, with 21 examiners divided into three sectors—each with a specific range of applications for examination, according to the classification of the objects therein. There is a total of about 2,500 applications per year. Designs are considered patents, being regulated by the same law that protects inventions; while protection over the partial design of an object is not accepted. Substantive examinations are performed only to verify novelty, and registration has a validity of 10 years (counted from the date of application).

- Vietnam: With 11 people in the industrial design division, the office gets about 2,800 annual deposits, each with only a single object. Sets of articles or those with one or more variants in each application are allowed to be presented, provided that the same characteristics are maintained. The system does not allow the protection of partial designs, and the applicant must choose to represent the object in lines or in photographs. Substantive examination, carried out prior to registration, verifies the novelty criteria, along with the concept of “creative difficult” inherited from Japanese law. Design registration is valid for five years from the date of application, renewable for two more equal periods.

The course continued with several presentations by attorneys and IP attorney office members—almost all of whom were former JPO examiners and staff. This fact attracted a lot of attention, since in a course offered and promoted by the organism responsible to receive, analyze and grant (or deny) the exclusive rights to exploit a industrial property, there was virtually no speaker from the Japanese office. In presentations that dealt with topics such as Japanese design protection legislation, product development and design management, the Japanese classification system for registration applications, criteria used in the substantive examination, practical notions of the examination of applications - novelty, originality, “creative difficulty”, division of applications and formulation of requirements - process and requisites necessary to make the filing of the applications and violations of rights related to the protection conferred by the design, the subjects were presented not by those who carry out their examinations, but by professionals who use the system advising their customers, the applicants of the requests, and who, by virtue of the profession, are in tune with the desires and expectations of the consumers and the productive means.

Unfortunately, this gave me the impression that we live here in Brazil in isolated “bubbles”, without a dialogue that could be very productive with other actors interested in the subject.

In addition to the lectures offered, another point of special relevance was the the different legislations and procedures for examining design applications among the varioius participants, on subjects of extreme and current importance to us at a time when we find ourselves discussing improvements in examination procedures. During exchanges of information mainly regarding the acceptance (or not) of partial designs claims and what kind of treatment should be given to interfaces, the real importance was reaffirmed of discussing these subjects with respect to our examinations guidelines. Virtually all participating countries have specific legislation for industrial design and substantive examination as a requirement for the granting of registration.. The partial design system is accepted by a majority, but legislation is based on the Japanese model (not surprisingly, Japan is the largest applicant country of designs in these countries, except in India, Peru and Singapore). With respect to the registration of interfaces, animation and virtual reality systems, this is still an obscure subject; and without a clear positioning by the majority of participants (with the notable exception of Singapore, which gives the same treatment to a virtual object that it would give its respective real counterpart). In addition, several legislations allow the registration of hand-crafted and manufactured products as design.



I would like to finish by giving thanks for the opportunity to have taken part in this course and to learn a little about the culture and landscape of this wonderful country that is Japan (despite the risks of a tornado that passed to the north of the country, while discussing legislation and practices in industrial property). We received a cordial welcome from the organizers and the integration of the other participants, which made it possible to hold an event where it was permitted to learn, discuss and exchange on topics related to industrial property, especially with regard to the criteria for granting industrial design rights, which have become very important in our current (and future) discussions in order to improve legislation and the design of examination procedure manuals, and seek ways to listen to the demands of other actors in society and achieve greater legal security for our decisions.

* “Lost in Translation” is an American term that represents the cultural part of phrases that are lost when translated into another language, even if the translation is done correctly. Is also the name of a movie released in 2003, whose plot takes place in Tokyo.

Great experience, new friends



Mr. Francisco Puebla (Chile)
IT Project Manager
National Institute of Industrial Property

FY 2018 JPO/IPR Training Course on Information Technology (December 17- December 20, 2018)



It was a journey of more than 21.800 km to get to Japan, and although my trip was short, it was an unforgettable experience.

My name is Francisco Puebla Casanova, and I am currently IT Project Manager of the INAPI (National Institute of Industrial Property) in Chile. I am honored to write about my experience in the “Training Course on Information Technology” for all IP friends.

Arriving in Narita, I immediately realized how orderly the Japanese are—and their culture and respect for others is wonderful. This is evident when you reach the escalators and see how they stand aside to let those people pass who are moving faster, and in the rows they make to get on the train, not losing their calm despite hearing the notice of the closing doors. I was very impressed by the cleanliness in all places despite the large number of people who travel in Tokyo, and the lack of garbage dumps in the streets, as everyone returns home with their garbage and recycles what they can.

I took the train to Keisei-Sekiya, and after about 38 hours of travel, I arrived at the Tokyo Kansu Center (TKC). The facilities were excellent, very clean and with everything necessary to make the stay very pleasant. I want to thank the TKC staff, since all the time they were very kind.

After unpacking and settling in the room, I took advantage of the afternoon to get to know the Tokyo Tower. I am lucky to have visited some countries in South America, but to be honest, I was a little afraid of going out alone and losing myself in this big city. To my good fortune I did not get lost, because everything is well signposted and the best is that Tokyo is a city that inspires a lot of security.

The first day of the course I was very nervous. At breakfast I met Mr. Pablo Gavarini from Argentina, who was attending the same course. He introduced me to Mr. Celso De Souza Tchao from Brazil, whom he met at the airport (they came on the same flight, and they did not know it!). Later, while we were walking toward the train, we met Ms. Jessica Sánchez from Mexico. Once at the Kitasenju metro station, we met Ms. Milagros Manrique and Mr. Cesar Polanco from Peru, and that is how we spontaneously formed our group, “the Latin people”.

When I traveled to Japan, I had recently assumed a new role in my work as IT Project Manager, so the course was a real godsend, and really motivating to get more involved with topics related to IP.

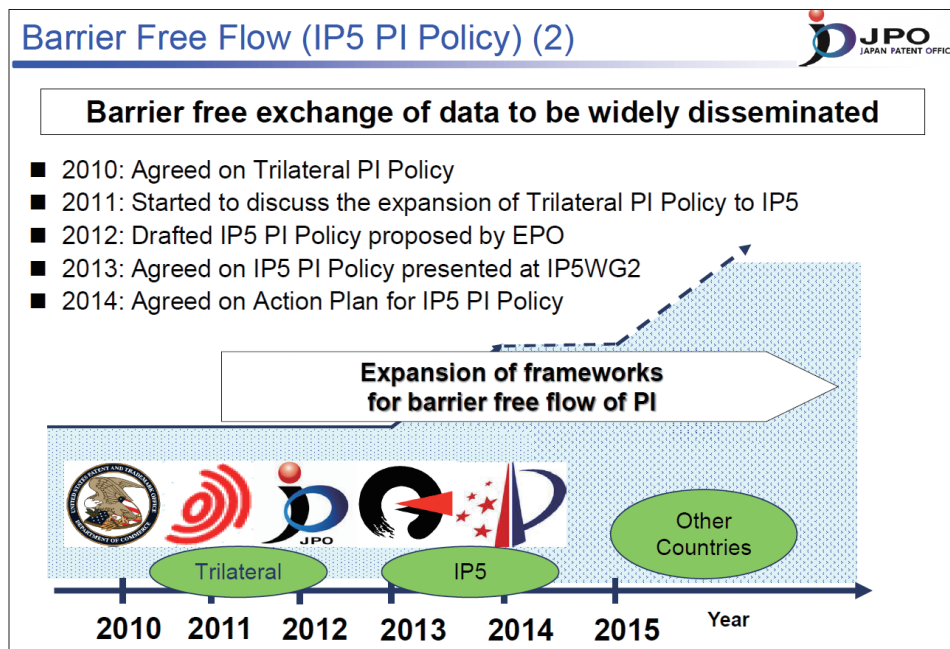
A couple of months ago, INAPI undertook an in-depth process to update its IT systems and restructure



“The Latin people”

its strategies to face new IT challenges. I actively participated in this process, and my vision of what we should achieve in INAPI was undoubtedly broadened by the opportunity to learn how JPO organizes its work, as well as the strict security controls of the information they have implemented, and each system that they have for the different stages of processing a patent.

I cannot fail to mention the presentation by Mr. Juneho Jang, Regional Director of WIPO, who explained the software provided by WIPO for the processing of trademarks and patents at regional offices. Personally, it was one of the presentations that most caught my attention.



I learned a little about ASEAN and the cooperation that exists between its member countries during this course, and I immediately made a relationship with PROSUR. At this time, I managed to understand the importance of the shared work between the different IP offices. Mr. Yoshiyuki OSABE explained the roles of IP Offices for dissemination and utilization of patent information, so I learned where IP is going in terms of international cooperation with the “Barrier Free Flow” presentation sheet that remained in my memory.



Every day after working with “the Latin people”, we ventured to know the city. This is how we covered several important points of the city during the four days of the course: for example, the technological neighborhood of Akihabara, the crossing and the Hachiko statue of Shibuya, the replica of the Statue of Liberty and the wheel of fortune in the island of Odaiba, Tokyo Skytree, and the surroundings of Ueno. We also organized ourselves to go to Disneyland. I think we were all very excited to be in Tokyo, and although sometimes tiredness won, it was well worth it.

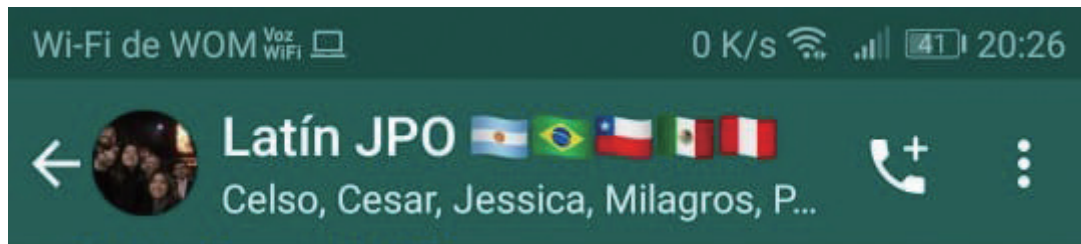
The kindness of the Japanese people is also worth noting. When we went through Shibuya, we were looking for a store and asked a group of teenagers who were passing through. They took the time and accompanied us about two blocks to tell us where it was. The store was closed, and they once again helped us by searching their phones and explaining the store's hours with the help of Google Translate.



The time passed very quickly, and my days in Japan came to an end. I want to thank everyone who made this course possible, especially Ms. Atsue Yoshimura, Ms. Etsuko Nozawa, and Ms. Mayuko Kitamura, with whom I had contact from the beginning. They were always very helpful in guiding me through the process.

When I returned to my country, I shared my experience with my colleagues and told them about some initiatives that I developed while I was in Japan. We are currently working on some of them, and we hope that they will contribute to the work of INAPI and that we can improve our processing work.

I feel completely happy and honored to have been able to participate in this course, which undoubtedly improved my skills and broadened my horizon of knowledge. I brought home a group of friends from Japan and a little bit of their culture, and I hope to return someday to this wonderful country.



JPO / IPR COURSE FOR PATENT EXAMINERS 2018

Mr. Sandro Manuel De La Cruz Prado (Peru)
Patent Examiner
National Institute for the Defense of Competition and
Protection of Intellectual Property (INDECOPI)



FY2018 JPO/IPR Training Course on Patent Examination in Specific Technical Fields (Electrical and Electronic Engineering, Chemistry) for Latin American Countries
(July 5 – July 13, 2018)



Reaching one of the most important cities in the world, Tokyo - Japan, is perhaps one of the most important gifts God gave me during the month of July 2018 that I will never forget and will always keep in my memory. It is important for many reasons, among them its culture and technology, which are themes that personally and professionally I admire. Arriving in a developed country like Japan seemed like a dream, because since I was a child I already knew a lot about this country through the Japanese television series I used to see after school classes, like Ultra-seven, where I was taught to share with my friends moments of happiness that I still keep in my memory with a lot of love, I could mention comics that in the 80's were very popular in Peru and made me live a childhood far from reality, with much magic and fantasy. Arriving in the country of Godzilla (Gojira) was to return to my childhood, remembering that huge and gigantic monster walking on the city of Tokyo. In truth knowing that I was going to travel to Tokyo-Japan is a sign that dreams exist because for me there were many feelings that I could not describe with words alone.



Currently I work as a patent examiner in the area of engineering, responsible for the management of inventions and new technologies of indecopi of Peru. Indecopi is an agency in charge of the application of legal norms designed to protect the market from monopolistic practices as well as practices that generate unfair competition, intellectual property rights such as distinctive signs, patent rights, and biotechnology. Indecopi is one of the most recognized institutions in Peru for its high performance, and I feel very proud to work in this institution, where every day I learn more about the subject of intellectual property and patents. Many countries are concerned with protecting intellectual property, because it is a valuable asset for many people and companies. As a patent examiner, I analyze each application that is in my charge. It is my responsibility but at the same time a great satisfaction to solve and grant a patent since both the Peruvian and foreign inventors demonstrate a lot of ingenuity in their different inventions, which motivates me to analyze more carefully every application proposal submitted to the patent office of Peru.

Knowing that I was going to travel to Japan was amazing for me. Participating in the course for patent

examiners for Latin American countries was going to be a pleasant experience. This time I was going to be accompanied by my engineering coordinator, Ms. Sofia Miñano, and the engineer, Erika Livia, colleagues who have a lot of experience in the subject of patents. I learn a lot from them every day. Starting from Lima was something I was not so prepared for, because it was the first time I was going so far away from my family. I had previously talked with my wife about the course, but my daughter did not understand the reasons and wanted me to stay home. A week before the trip I prepared my bags trying to be ready and to avoid worries. Before leaving for the airport, the three Peruvian members agreed to meet at our coordinator's house hours before, to arrive early. We entered the plane without problems and we settled in our respective seats to make a first flight from Lima-Amsterdam, then a second flight Amsterdam - Paris, and finally Paris -Tokyo, and the return was by the same route in reverse. The trip from Lima to Tokyo lasted 23 hours. We left Lima on July 2, 2018 and returned on July 15, 2018. The airline that transported us was very attentive and comfortable. I still remember when we arrived in Tokyo, on July 4, it was practically nighttime I could only see lights through the window and I was able to catch a glimpse of their modern airport. On July 5 we had an orientation talk at AOTS (The Association of Technical Corporations for foreign and sustainable associations) residence. They assisted us in the best way with an excellent service, such as the accommodation with modern rooms, with a varied breakfast and very good orientation, especially, since being in Tokyo for a foreigner is not easy, especially using public transportation.



Personally, I had never seen so many trains in a city and many stations where I could recharge the card. The first few times it was not very easy to learn the route to go from the AOTS residence to the facilities of the JPO (Japanese patent office) but little by little we got used to it, although in some cases it was inevitable that we'd make a mistake and take a different train route, but Thank God we always reached our destination. As it was a course for Latin Americans, we participated with Peruvians, Argentines, Brazilians, Chileans and Mexicans, countries of the region that have in common the language, customs, and issues regarding intellectual property. Seeing us far from our countries, fraternity became stronger among us, perhaps we are not so different, but each Latin American region has its own personality and customs, which makes each country more interesting.

On July 6, we visited the Japanese patent office, and on July 9 and 10 we had the training by Mr. Shuichi SAKAI and Mr. Ryusuke OKADA. For this, we formed 02 study groups and the tutors presented us cases where we would have to analyze the requirements that a patent application must have, that is, as a basic procedure to determine the novelty, that is, as a first step: determine the claims of the invention, determine the prior art, compare the Claiming the invention with the previous art, later, it is analyzed if the request presents some essential characteristic that will give it novelty. Subsequently, some exercises were analyzed in the different fields of the invention.



In order to be able to evaluate the inventive level, it is required that it be evaluated by a person skilled in the prior art who determines whether the invention has an inventive level or not. To analyze the inventive level the factors that must be taken into account are determined such as: the relationship of the tech-



nical field, similar problem to be solved, similar operations or functions, the effects of the claim on the previous art, and in this way recognize if the presented claims possess inventive level. On July 11 and 12 we were in the JPO doing background searches, as well as their search strategies, the different search tools, the use of J-PlatPat, Patenscope, patent classification (FI and F-terms), I could honestly say that each country has its own search system and Japan was no exception. it was surprising to see how it works and also how many examiners work in the Japanese office.

After classes, which culminated at approximately 6:00 p.m., we took advantage of learning a bit about Tokyo-Japan, I liked the Tokyo tower, I also learned about places like Asakusa, Shibuya, Akihabara, Ginza, and Odaiba. I would have liked to know even more but it was a very short the time we had after school.



On July 13 the topic of patent infringement was carried out by Mr. Kazuhiro Matsuda, I present the subject with respect to the types of infractions: direct and indirect, doctrines of equivalences, as well as

the differences in which it comprises in an open claim and consists of a closed claim. I remember that there was an evaluation to all the participants in person and also virtually through surveys. The course committee gave us a group interview with respect to all the participants regarding the course, such as what new knowledge we have acquired, how we could implement this knowledge in our place of origin, what differences they find with respect to the form of evaluate patents, questions that served as feedback. On the same day a closing ceremony with all participants and staff of the course in charge. In addition, abundant local food was offered with some drinks. It was the first time I had Sake.

All the training was in the English language, because it is known to be a universal language that almost everyone speaks and was a requirement to be admitted to the course. I also admire the good performance of the tutors in explaining the topics with a lot of teaching for the teaching of the patent issue.

Personally, I am very grateful to JPO, AOTS to INDECOPI, and to all the people who were personally involved in Michiko Hiyama, who proved to be an excellent person to guide this type of courses in the best way, which is aimed at many professionals of the world. I would also like to thank the country of Japan, for being able to acquire the knowledge, not only of the subject of patents and intellectual property, but also of transmitting the Asian culture that many in the world admire. For me the course offered is more than a course, I could say that it was an excellent life experience that I will transmit to the people around me and to the other generations for a long time.



6

Articles from the former trainees



Overview of Brazilian Patent Prosecution



Mr. Luis Felipe Maciel da Silva (Brazil)
Patent Specialist, Chemical and Life Sciences Group, Patent Department
Daniel Legal & IP Strategy (Daniel Advogados)

FY2018 JPO/IPR Training Course for IP Protection Lawyers (26 November - 12 December, 2018)



There are several different patent prosecution systems throughout the world, and every country or region has its particularities. In Brazil it is no different. Therefore, the main goal of this article is to provide a simple overview of the Brazilian patent prosecution, whilst approaching important particularities thereof.

As expected, patent prosecution in Brazil begins with the filing of an application. This can result from the CUP or PCT route, and may also of course be first-filed in Brazil. According to Article 30¹ of the current Brazilian IP Law #9,279/1996 (BIPL), an application must remain in secret for 18 months, counted from the filing date or the oldest priority. After this term, the application is published for public appreciation. It should be noted that according to Article 31² of the BIPL, any interested party may submit arguments or documents to aid the examination of an application until the end of the examination.³ It is also important to note that the end of the examination also sets the date limit for the filing of

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- 1 Article 30 of the BIPL: A patent application will be kept secret for 18 (eighteen) months counted from the date of filing or of the earliest priority, if any, after which it will be published, with the exception of the case provided for in Article 75.
§ 1 - Publication of the application may be anticipated by applicant request.
§ 2 - The publication must include data identifying the patent application. A copy of the specification, claims, abstract and drawings will be made available to the public at INPI.
§ 3 - In the case provided for in the Sole Paragraph of Article 24, the biological material will be made available to the public at the time of the publication to which this article refers.
 - 2 Article 31 of the BIPL: Documents and information for aiding examination may be filed by interested parties between the publication of the application and the termination of examination.
Sole Paragraph - Examination will not be initiated prior to 60 (sixty) days from publication of the application.
 - 3 According to current practice, the end of examination is deemed by the Brazilian PTO to be the date stated on the examiner's conclusive report on patentability (decision of allowance, rejection or final dismissal of the parent application), or the thirtieth day preceding the publication of such report in the Brazilian Industrial Property Journal--whichever occurs last.

divisional applications.

As provided by Article 33⁴ of the BIPL, the ordinary term for requesting examination of patent applications in Brazil is 36 months, counted from the filing date. The moment when examination is requested in Brazil is crucial in view of the current strict position adopted by the Brazilian PTO regarding amendments performed after the examination request.

According to current understanding and practice, only amendments aiming to limit the scope of protection and/or to correct evident typographical errors are acceptable after the request for examination. Therefore, amendments that may result in the broadening or substantial modification of the scope of protection, such as the insertion of new categories that were not present in the claim set on which the examination was requested (even if said categories were present on the originally filed claim set), are currently not acceptable by the Brazilian PTO and results in the rejection of the entire amended claim set.

In view of this strict position currently being adopted, it is important to emphasize that in Brazil, every claim shall be drafted in two parts: the preamble, and a characterizing section which must be connected by a characterizing expression, i.e. “*characterized...*”. The preamble shall comprise any technical features that are already known from the prior art, whilst the characterizing section shall comprise the particularities of the invention. Thus, after the examination request, moving features from the preamble to the characterizing part is usually not acceptable—although features present on the characterizing part can be moved to the preamble.

After the request for examination is filed, applications related to the pharmaceutical or biotechnological fields are forwarded to the Brazilian National Agency for Sanitary Surveillance (ANVISA) for prior approval instead of being exclusively prosecuted at the Brazilian PTO. According to Joint Ordinance # 1/2017 of April 12, 2017, ANVISA’s attribution is to analyze whether the subject matter of a patent application represents risk to health, whereas the Brazilian PTO’s attribution is to analyze the patentability requirements of the subject matter. In this context, the risk to health is understood as a pharmaceutical product comprising—or a pharmaceutical process resulting in—a substance whose use is prohibited in Brazil. Therefore, if the claimed subject matter of the patent application is related to substances prohibited in Brazil, ANVISA will deny the prior approval thereof. For the remaining applications, prior approval is expected.

After receiving ANVISA’s prior approval (for pharmaceutical/biotechnology applications), or immediately following the examination request (for applications unrelated to the pharmaceutical/biotechnological field), the application is placed on the waiting list for the Brazilian PTO’s technical examination.

As is well known, however, the Brazilian patent system suffers from a huge backlog—and the examination of patent applications can take about a decade. In order to mitigate this issue, therefore, the Brazilian PTO is heavily increasing its efforts by taking certain measures in this regard, including the implementation of a pre-examination.

This consists of a formal opinion that aims to speed up the examination and decision of Brazilian

4 Article 32 of the BIPL: In order to better clarify or define a patent application, the applicant may effect alterations up to the request of examination, provided that they are limited to the subject matter initially disclosed in the application.

patent applications by requesting the applicant to submit amendments in the claim set, adapting it to the cited prior art documents cited in this opinion, and/or submitting arguments regarding the non-relevance of the said cited prior art documents, if there are objections on patentability requirements in relation to such documents. The prior art documents cited therein are those already being considered during the prosecution of equivalent cases abroad, or cited during the international phase of a PCT application. Such pre-examination opinions began to be published in 2018, so it is important to note that due to various parameters (such as the filing date), not every patent application receives a pre-examination opinion.

The Brazilian PTO's substantial technical examination takes place after ANVISA's prior approval and/or the pre-examination opinion (when applicable). Such examination can have four different outcomes: a decision of allowance, an office action, an unfavorable technical decision, or a rejection decision.

As can be inferred, the decision of allowance represents the Brazilian PTO's willingness to grant a patent. The applicant has a 60-day ordinary term from the publication of said decision to pay the final fees, which will result in the granting of the application.

An office action is a kind of favorable opinion issued by the Brazilian PTO. Usually, the Brazilian PTO acknowledges in this opinion that the application is endowed with novelty and inventiveness, although it may require that certain amendments be performed. Failure to submit a reply to an office action results in the final rejection of the application.

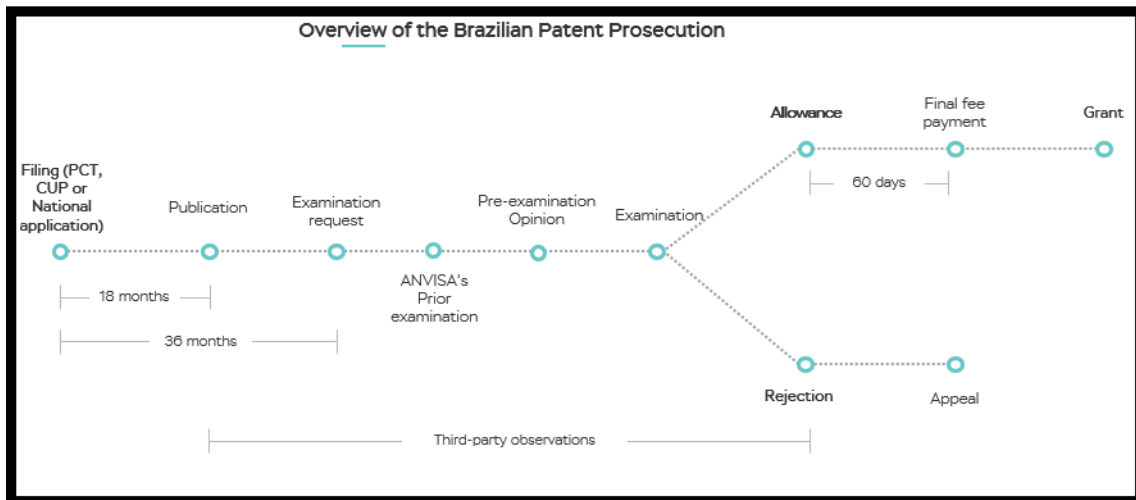
Unfavorable technical opinions are usually issued by the Brazilian PTO when the examiners understand that an application lacks novelty and/or inventive activity. Such unfavorable opinions may also be published due to other reasons, e.g., the rejection of a claim set due to a broadening of the scope of protection or a lack of unity of invention. Moreover, it is important to note that objections to the lack of accuracy and sufficiency of disclosure may also be raised in this opinion. Failure to submit a reply to this unfavorable opinion results in the rejection of the application with the right to appeal.

A rejection decision can also be issued during the examination, however, a rejection decision cannot be published without the issuance of a previous written opinion (office action or unfavorable technical opinion). Said decisions are usually issued in case the examiners understand that the arguments and amendments previously submitted were not sufficient to overcome the previous objections, and the said objections are maintained.

The applicants have the right to submit an appeal regarding a rejection decision. After the appeal is filed, it is then notified by the Brazilian PTO so that third parties can take knowledge thereof and submit any comments within 60 days from the appeal notification date. The appeal is subsequently examined, and if the examiners are convinced, the previous rejection decision is overruled and the application is granted. However, if the examiners are not convinced by the arguments and/or amendments (if any) that were submitted along with the appeal, they can issue a written opinion during the appeal phase (intermediate opinion) before the publication of any final and definitive decision. However, the issuance of such intermediate written opinion is not guaranteed, and a final decision can be issued based on the arguments and/or amendments filed along with the initial appeal petition.

A final rejection decision closes the administrative phase of an application within the Brazilian PTO,

and can only be overruled in the Federal Courts.



Trademark Dispute Resolutions in Cambodia



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Introduction:

In Cambodia, there are two main kinds of trademark dispute resolutions: those taking place outside the court, and others taking place inside of it.

I. Trademark Dispute Resolutions Outside the Court:

There are many types of resolutions within this category, including those that are optional, non-binding and binding. The four types are as follows: party-level resolutions, those of the Ministry of Commerce's Department of Intellectual Property (DIP), Border Measures by Customs or Competent Authorities, and the National Commercial Arbitration Center (NCAC).

1. Party-level

Trademark dispute resolutions at the party level are optional. When trademark disputes are raised, some claimants may decide to solve them on their own. The claimants may serve written notice(s) to the respondent, or have a few meetings to negotiate and find a better solution for them. Some disputes may be resolved and closed at this level. If the disputes cannot be solved, however, the claimants or respondents may go to the DIP or competent court of the Kingdom of Cambodia. This dispute is optional and non-binding.

2. Department of Intellectual Property-Level (Ministry of Commerce)

Some claimants or respondents may go to the Ministry of Commerce's Department of Intellectual Property (DIP) to solve the disputes. This step is also optional and non-binding.

2.1 Required information¹ in applications to solve disputes

To file a complaint with the DIP, the below information is required in the application to solve disputes:
- Applicant's name

¹ Article 25 and 26 of Sub-degree no. 64 on the implementation of the trademark law issued on 12th July 2006

- Applicant's address, phone number, and fax number, if any. If the applicant residence is not in Cambodia, the applicant is required to have a licensed trademark agent in the country.
- Applicant's nationality and country
- Applicant's signature for sole proprietorship
- Applicant's signature and company seal
- Power of Attorney, if the applicant needs a representative

2.2 Public Service Fee²

To file the complaint with the DIP, the applicant is required to pay a public service fee of KHR 200,000 (around USD49.26 or ¥5,387.74)³.

2.3 Dispute-solving Procedure

After receiving the written application (complaint), the registrar(s) shall arrange the hearing within one month after receiving the application and/or receiving the supporting documents (evidence). However, the registrar(s) shall serve a prior written notice to the related parties seven working days before the hearing⁴. If necessary, the registrar may interview the witnesses to get more information or evidence. After this, the registrar shall have a hearing and make a decision.

If either party does not accept the decision made by the DIP of the Ministry of Commerce, the parties may go to the competent court within three months⁵ from the decision date. If not, the decision will be binding.

3. Border Measures by Customs or Competent Authorities

The claimants may seek "border measures"⁶ to prevent the importing or exporting of products using the disputed trademark.

3.1 Required Information⁷ in the Application to Seek Customs Measures

The application (complaint) shall contain the following information:

- a. an extract from the register of marks;
- b. a statement of the grounds for the application, in particular the prima facie evidence showing that such trademark goods are counterfeit;
- c. a complete description of the goods on or in connection with which the trademark is used, together, where appropriate (or requested), with a sample of the bona fide product;
- d. the name and address of the applicant and of the applicant's representative (alternatively, full details of the applicant, as prescribed);
- e. an authorization from the owner of the registered trademark, where the application is filed by an

2 Joint Prakas No. 1217 on Public Service Fee at Ministry of Commerce issued on the 27th November 2017

3 Exchange rate on 31st May 2019.

4 Article 32 of Sub-degree no. 64 on the implementation of trademark law issued on the 12th July 2006.

5 Article 62 of Law concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia issued on the 07th December 2002

6 Article 35 of Law concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia issued on the 07th December 2002

7 Article 36 of Law concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia issued on the 07th December 2002

- authorized representative, and
- f. the prescribed fee in accordance with the determination of the Ministry of Economy and Finance.

3.2 Public Service Fee

The claimant is required to provide a security⁸ to cover the damages of the importers, consignees, exporters or product owners.

3.3 Dispute Solving Procedure

10 (ten) days after receiving the complaint, the customs office shall notify the applicant whether the application is accepted, rejected, or reserved for further consideration⁹. If customs accept the application, they shall suspend the clearance of goods for not more than 10 working days. Also, the customs office shall serve notice to the importers, exporters, consignees, and/or owners of the products¹⁰. Within 10 (ten) working days after the applicant has been informed about the suspension, customs will release the suspended goods if there is no any action taken at the court. However, the suspension period may be extended for another 10 days if there is a valid reason. If the suspension asked by the claimant is not valid, and if it leads to damage for the respondents (importers, exporters, consignees, and/or product owners), the claimant shall be responsible. The security shall become the respondents' interest.

The customs and competent authorities are not the decision makers. They are simply in charge of controlling and preventing the flow of goods. They may destroy the infringing goods through the decision of the court.

4. National Commercial Arbitration Center (NCAC)

Even if it is not defined in the Law concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia (dated 7 December 2002) or sub-degree no. 64 on the implementation of trademark law dated 12 July 2006, NCAC is another mechanism that can be used to solve trademark disputes in Cambodia. The claimants may seek a dispute resolution from NCAC by following its procedure and paying service fees.

4.1 Service Fees¹¹

There are various types of payments as below:

- a/ Case (Claim and Counter-Claim) Registration Fee
- b/ Arbitration Administration Fee
- c/ Arbitrator Appointment/Challenge Fee
- d/ Arbitrator Fees
- e/ Other relevant costs and expenses
 - Meeting room and facilities rental
 - Translation service, if any

8 Article 37 of Law concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia issued on the 07th December 2002

9 Article 38 of Law concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia issued on the 07th December 2002

10 Article 39 of Law concerning Marks, Trade Names and Acts of Unfair Competition of the Kingdom of Cambodia issued on the 07th December 2002

11 <http://www.ncac.org.kh/www.ncac.org.kh/indexa912.html?page=detail&menu1=290&ctype=article&id=290&menu1=215&menu2=384&lg=en>

- Accommodation and transport services
- Telephone, facsimile, postal and internet services
- Arbitrator's reasonable out-of-pocket expenses
- Other associated costs and expenses

4.2 Dispute Solving Procedure¹²

The flow of solving disputes via commercial arbitration is described as below:

- a/ Case Registration
- b/ Arbitrator(s) Appointment
- c/ Notice of Commencement of Arbitration and Tribunal Constitution
- d/ Final and Binding Decision on Challenge of Arbitrator(s)
- e/ Support of Arbitration Tribunal and Parties throughout the Arbitral Proceedings
- f/ Arbitral Award Notification and Certification
- a/ Facilitation for Additional Award Issuance, Correction, Clarification or/and Interpretation

The award can be binding or nonbinding based on the choice of the claimant and/or the respondent at the beginning of the procedure. If the award is non-binding, either may take the case to the competent court. This will become a new case and needs to follow all court procedures such as the oral argument, hearing, etc. However, if it is a binding award, the winner may take the case to the court to enforce the award without following the court case procedure again.

II. Trademark Dispute Resolution at the Court:

If the claimants do not want to undergo long procedures as mentioned above, the claimants may file a lawsuit with the competent court. There are three level of courts in Cambodia. They are First Instance Court, Appeal Court, and Supreme Court. There is no specialized court for IP or trademark disputes. The courts are in charge of all kinds of lawsuits.

1. First Instance Courts

First Instance Courts are located in each province of the Kingdom of Cambodia, and they are the first court level to which the claimant shall go. The courts are in charge of all kinds of lawsuits including IP cases. In Cambodia, it is hard to have a specific schedule or timeline to complete a case, because there are so many cases and the number of judges is limited. After the decision of the first instance court is made and handed to the concerned parties, either party may go to the appeal court if they do not accept the decision.

The binding decision from NCAC shall be requested to be enforced at the level of the first instance court.

2. Appeal Court

Nowadays, there is only one appeal court in Cambodia. It is located in Phnom Penh City, the Capital of the Kingdom of Cambodia. Soon, there will be several more Appeal Courts in certain provinces.

¹² <http://www.ncac.org.kh/www.ncac.org.kh/indexa912.html?page=detail&menu1=290&ctype=article&id=290&menu1=215&menu2=384&lg=en>

If either party does not accept the First Instance Court's decision, that party may go to appeal court within 30 days. The Appeal Court will take action like the First Instance Court and will issue a decision. After the decision of the Appeal Court is made and handed to the parties, either party may go to the Supreme Court if they do not accept the decision.

3. Supreme Court

There is only one Supreme Court in Cambodia. It is located in Phnom Penh City. This is the highest court level. The decision from this court cannot be appealed.

III. Conclusion

There are two main ways to resolve trademark disputes in Cambodia: trademark dispute resolution either outside the court, or through the court system. Trademark dispute resolution outside the court is optional; claimants may take it or go to the court directly. No matter what kind of dispute resolution it is, all information regarding the case is not disclosed for public use.

Table no. 1: Summary of Trademark Dispute Resolutions

Trademark Dispute Resolutions	Dispute Resolution Level	Binding?		Remarks
		Not binding	Binding	
Outside the Court	Party Level	√		
	Department of Intellectual Property Level	√	√	If either party accepts the DIP's decision or does not go to the competent court within 90 days, it will be binding. if either party go to the court within 90 days, however, the decision will not be binding.
	Border Measures by Customs			
	NCAC	√	√	If both parties have agreed before the start of NCAC's procedures that the award will be binding, it can be enforced at the court. If there is no agreement, however, the award will not be binding. Either party may go to the court and begin case procedures.
at the Court	First Instance Court	√	√	If either party accepts the First Instance Court's decision, it will be binding. If either party goes to appeal court, however, the First Instance Court's decision will not be binding and the Appeal Court's decision will be awaited.
	Appeal Court	√	√	If either party accepts the Appeal Court's decision, it will be binding. If either party goes to the Supreme Court, however, the Appeal Court's decision will not be binding and the Supreme Court's decision will be awaited.
	Supreme Court		√	This is the final and binding decision.

A Break from the Norm: Unconventional Trade Marks and the Indian Legal Framework



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Trade marks have long been used as indications of origin to distinguish the goods of one manufacturer from another. The earliest known marks are those that were found on some Transylvanian pottery pieces dating back to circa. 5000 BC. The use of marks in India can be traced back to the Mohenjodaro and Harappan civilizations, which date back to almost 3500-2500 BC. In fact, more than 2000 traders' seals were found during excavation in the Indus cities.

Trade marks in modern times have continued to perform their basic function, which is to identify products and their origin, distinguishing them from the goods of others; indicating persistent and unchanged quality; advertising the goods; and creating images for products so that consumers can mentally associate them with their trade marks—thereby creating goodwill. The Parliament of England was the first to pass a trade mark legislation in 1266, requiring bakers to use a distinctive mark for their bread. Such statutes led to documentation of trade mark ownership by way of registration, which established marks as trade marks and identified who owned them, granting the owners exclusive rights to use the marks and to take action for infringement against any unauthorised use by third parties.

While proprietary rights in trade marks have received recognition in India for several millennia, the Indian Trade Marks Act was passed in 1940. This was succeeded by the Trade Mark and Merchandise Act 1958, which was repealed by the Trade Marks Act 1999 that was enacted to comply with the provisions of the TRIPS Agreement. The rules of this act are known as Trade Mark Rules 2002. The said act, along with the rules, currently govern trade mark laws in India.

Today, trade marks can broadly be classified as conventional and non-conventional. Conventional marks include words, pictorial representations and labels. Non-conventional marks encompass a full spectrum of sensory perception beyond the usual signs, and include smells, sounds, colours, shapes, tastes and textures. These marks have greater potential economic impact, and leave consumers with a stronger commercial impression on account of their unique characteristics.

As is the case with conventional trade marks, non-conventional trade marks must also meet the basic pre-requisites of distinctiveness, visual perception/graphical representation, and being non-functional. Given that trade mark registration systems worldwide are built around the notion of representative registration, however, the recognition of rights with respect to non-conventional marks has been a matter of concern. The question is how marks that cannot be perceived visually are able to be graphically represented.

Interestingly, while The Trade Marks Act 1999 is silent and does not have any explicit provision as to the registrability of non-conventional trade marks, a mark¹ is defined to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or combination of colours or any combination thereof. Therefore, non-conventional marks can be considered to be a part of the Indian trade mark system as well. Infact, the Draft Manual of the Trade Marks Registry² specifically provides procedures and requirements for the registration of such non-conventional marks.

It is worthwhile to briefly consider each of the non-conventional marks separately.

Olfactory marks

Smell is one of the foremost senses that humans experience. However, there have not been many claims for trade marks on smell throughout the world. The earliest registration of an olfactory mark was for the scent of freshly cut grass associated with tennis balls³ in the European Union. To date, there has been no registration for an olfactory mark in India—although this does not imply that such registration cannot be granted at all.

Olfactory marks can be afforded protection in India if the applicant proves that (a) the smell is used as a trade mark; (b) the smell is not an inherent characteristic of the good, but serves to identify the applicant's goods; (c) consumers regard the smell as a mark that identifies the applicant's goods; and (d) the mark is capable of being represented graphically.

While olfactory marks provide a wonderful opportunity for businesses to uniquely identify their goods from competitors, the registration of such marks may pose challenges in some jurisdictions. The requirement for filing a graphical representation or verbal description of a smell is subjective, dependent on human perception, and open to interpretation. Consequently, keeping consistency in terms of description may pose a challenge. The European Court of First Instance, while refusing the registration of a mark for the smell of ripe strawberries,⁴ noted that one of the grounds for refusal was the unavailability of a generally accepted international classification.

Sound marks

Sound marks may consist of songs, strings of notes, unusual sounds, known sounds occurring in nature, or sounds not occurring in nature. Several sound mark registrations have been granted in India,

1 Section 2(1)(m) of The Trade Marks Act, 1999

2 Manual of Trade Marks, Practice & Procedure, March 2015

3 Venootschap Firma Senta Aromatic Marketing's Application, (1999) E.T.M.R 429 OHIM BoA R 156/1998/2

4 Eden SARL v. Office for Harmonization in the Internal Market, Case T-305/04

with the first being in favour of Yahoo! Inc. for its Yahoo yodel in the year 2008.

The Trade Mark Rules, 2017⁵ in India have further eased the process of registering sound marks by providing an express provision for the submission of sound marks in MP3 format, along with the graphical representation of sound notations. A clear and precise definition of 'notations', along with a set of standards, is required to be satisfied in order for a sound to be granted trade mark protection.

The challenge, however, lies when one wishes to register constituents of an audio represented in onomatopoeic descriptions. These descriptions lack distinctiveness, and do not qualify for trade mark registration as they lack precision to explain the exact sound.

Gustatory marks

The flavour or taste of a good/product is the basis for registration of gustatory marks. As with other non-conventional marks, the basis for registration of such marks is that they should be in a position to identify the goods of the applicant, and distinguish them from those of competitors. Taste marks are unlikely to be held inherently distinctive without strong proof of acquired distinctiveness.

It has also been widely debated if taste can actually act as a trade mark, since consumers generally do not get an opportunity to select their goods according to taste. Further, the aspect of the flavor of food being a functional element of the goods also poses a significant hurdle to a party wanting to register such a mark. The general perception is that it is unlikely that flavours can ever be inherently distinctive, because they do not automatically connect the goods to the source.

Shape marks

Shapes, on the other hand, have been considered eligible for protection under the trade marks law for a long time and in almost all jurisdictions. The Trade Marks Act 1994 in the United Kingdom and The Trade Marks Act 1999 in India specifically include shapes within the definition of a trade mark. Indian Courts have afforded protection to shape of goods such as the vodka bottle⁶ and the lighter⁷.

For the shape of a product to be considered eligible for registration as a trade mark, it must have acquired secondary meaning both conceptually and functionally. Shapes with bare functional features are not entitled to registration. This means that a mark is ineligible for registration as a trade mark if it consists exclusively of (a) the shape of goods resulting from the nature of the goods themselves; or (b) the shape of goods necessary to obtain a technical result; or (c) the shape that gives substantial value to the goods.

Apart from traditional shape marks, the use of three-dimensional shapes in business has gained prominence in modern times. Three-dimensional marks confer a business advantage, since the majority of

5 Vide G.S.R. 199(E), dated 6th March, 2017, published in the Gazette of India, Extra., Pt.II, Sec 3(i), No. 159, dated 6th March, 2017.

6 Gorbatschow Wodka Kg vs. John Distilleries Limited, Notice of Motion No. 3463/2010 in Suit No.3046 of 2010, High Court of Bombay

7 Zippo Manufacturing Company. vs. Anil Moolchandani and Ors.,185(2011)DLT51

consumers are guided by the external appearance of the article they need when they choose a product without actually analyzing its features.

Insofar as registration of three-dimensional trade marks is concerned, these can be protected if they are inherently distinctive of the source of the goods or have acquired distinctiveness through use.

Colour marks

A purchaser is attracted by the visual image of a good, and its colour component may be a dominant factor for attracting customers to that particular good over the goods of the competitor. It is generally agreed that the combination of colours, or even a single colour in combination with a word or device, is statutorily registrable.

Registration of single colours, however, may require the applicant to prove that s/he has used the mark and that it has acquired distinctiveness. Even if so, a colour may not succeed registration if the colour is required generally in the trade. The most prominent objection to registration of a single colour as a trade mark is based on the colour depletion theory, which includes the concern that since the number of colors is limited, to grant exclusive rights in colors would soon deplete the available stock—and would therefore go against competition. This concern loses significance, however, in view of the technological advances that have led to the ability to create innumerable different shades of colours.

As far as India is concerned, while the act does not specifically provide for the registration of a single colour, it does not expressly exclude it either. The Draft Manual of the Trade Marks Registry recognizes the potential of a colour by stating that *“in order to constitute a trade mark, a colour or combination of colours must be capable of distinguishing the goods or services of one trader from those of other traders. If a particular colour of packaging has become distinctive in fact as indicating the goods of a particular trader, there is no reason why it should not be protected by registration.”* Registrations for the brown colour and the magenta colour label in favour of Victorinox AG and Deutsche Telekom AG, respectively, go on to highlight that single colour registrations can be secured in India.

Tactile marks

Tactile marks are colloquially referred to as touch/texture marks. Like other non-conventional trade marks, tactile marks should be non-functional. If touch is essential to the use and purpose of the goods or inherently affects cost or quality, then it will not be eligible for legal protection. Rights over tactile marks are generally garnered by the established use of the same over a period of time.

Louis Vuitton has been at the forefront of seeking registration and protection of such marks. In 1996, it sought trade mark protection for its ‘distinctive man-made textured pattern utilized as a surface feature’ on its luxury luggage and leather products in the USA. In addition, it has been afforded protection for the EPI Style texture by the court in India⁸.

With the expansion of International business and the development of technology, it cannot be denied

8 Louis Vuitton v. S.Malik and Ors, CS(OS) 1825/2003 before High Court of Delhi

that the use of such marks is set to overshadow conventional marks in future. It is without doubt that such protection may pose certain difficulties in terms of the understanding and application of conventional principles of trade marks to non-conventional marks. Harmonisation of the application and examination procedures is the need of the hour. The development of common approaches and sufficient benchmarks with respect to non-conventional marks worldwide may also go a long way in setting up an effective system for non-conventional marks.

Particularities of the Regulation of Trade Secrets in Mexico



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Trade Secrets constitute valuable assets for the persons and companies that keep them. While it has been contended that their existence and protection may actually have a negative effect with respect to the industrial property system, the effective protection of trade secrets is important for the advancement of markets and economies.

International treaties that regulate intellectual property rights have also focused on providing adequate protection of trade secrets. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) includes a section for the protection of undisclosed information. This section, comprised by Article 39 of the TRIPS Agreement, intends to ensure protection against unfair competition as provided in Article 10bis of the Paris Convention for the Protection of Industrial Property, through the protection against the disclosure of information that is secret, has a commercial value and has been subject to reasonable steps to keep it secret.

Mexico has adopted provisions in its domestic legislation aimed at the protection of trade secrets. Trade secrets were first protected by the Federal Criminal Code, but in 1991 trade secrets were included and defined in the Industrial Property Law (“IPL”). This law also includes criminal offenses against trade secrets.

Trade secrets are defined by the IPL in Article 82 as any information having an industrial or commercial use kept by an individual or company as confidential, which gives them a competitive or economic advantage vis-à-vis third parties in carrying out economic activities and in connection with which they adopted proper means or systems to preserve such confidential nature and restrict access to it. According to the IPL, the information of a trade secret must necessarily relate to the nature, characteristics or purposes of the products; to the production methods or processes; or to the distribution or marketing or service systems or outlets.

The definition of trade secret included in the IPL conforms to the standards set by the TRIPS Agreement (Article 39.2) and was established by the negotiations of the North American Free Trade Agreement. However, the IPL goes beyond this definition and states that the information considered an

industrial secret is to be set forth in documents, electronic or magnetic media, optical disks, microfilms, films or other similar media. This is a positive aspect of the legislation in Mexico, since it provides certainty as to the “proper means or systems” that should be adopted to prove that the information considered a trade secret was kept as such.

The IPL also includes the following relevant aspects in the regulation of trade secrets:

- The keeper of a trade secret may transfer it to or authorize its use by a third party. Authorized users are compelled to refrain from disclosing said trade secret, through any means.
- Agreements in which technical knowledge is transferred, technical assistance is rendered, or basic or detailed engineering is furnished may contain clauses of confidentiality to protect trade secrets, provided that all aspects deemed confidential are precisely determined.
- Anyone who, by virtue of work, employment, office, or post, the exercise of profession, or a business relationship, obtains access to a trade secret of the confidentiality of which he has been duly warned is obligated to refrain from revealing it without justified cause and without the consent of the person keeping said secret or of an authorized user thereof.
- An individual or entity who engages an employee who is working or has worked for, or a professional, advisor or consultant who renders or has rendered services to another person, in order to obtain the industrial secret of said other person, shall be liable for payment of such damages as he may have caused to said person.
- An individual or entity who obtains through any unlawful means any information contemplating an industrial secret shall also be liable for payment of damages.
- In any judicial or administrative proceeding in which any party to the same is required to disclose an industrial secret, the authority hearing the proceeding must take or adopt all the necessary measures to prevent its disclosure to third parties not related to the controversy. No interested party may ever disclose or use any industrial secret to which reference is made in the preceding paragraph.
- If the information is considered or falls in the public domain, or it is obvious for a technician in the field or must be disclosed for legal disposition or for judicial order, it cannot be considered as a trade secret. Notwithstanding the above, if the information is disclosed due to a legal obligation or statement for the purpose of obtaining licenses, authorization, permits, registration or any other similar rights, the information disclosed will not be considered or fall in the public domain, so that it is still possible to protect it as trade secret.

Even when the only legal regulation of trade secrets is contained in the IPL, there are other fields in which this topic is involved.

The relevant issues for contractual aspects are that a confidentiality clause has to be clear in establishing what kind of information or knowledge is a secret and which are the legal (civil and criminal) responsibilities for the breach of that clause.

Co-ownership of trade secrets is not addressed by the Mexican legislation or case-law; nevertheless, it can be adopted by contract. In this case, it is quite recommended to establish rules of use with respect of the trade secret

In the labor field, the employer has control over all information created and handled by any employee who has produced or discovered it under assignment, although it has to be established in the contract between the employer and employee. The contract must include the agreement of non-disclosure and non-use of the commercial and industrial information.

Enforceability of trade secrets

One of the characteristics of the Trade secret protection in Mexico is the fact that it is possible to enforce them not only against the person who illegally obtains the same from the premises of the owner of said trade secret, but also against other persons who would acquire the trade secret from said first person and use it for obtaining economic profits or for damaging the owner of the trade secret.

Article 85 of the IPL states that any person who, by reason of his work, employment, function or post, the practice of his profession or the conduct of business relations, has access to a trade secret the confidentiality of which he has been warned of shall abstain from revealing it without just cause and without the consent of the person keeping said secret or of the authorized user thereof.

Furthermore, Section IV of Article 223 of the IPL, states that revealing to a third party a trade secret that was known by virtue of employment, position, responsibility, the practice of a profession or business relations, or as a result of the grant of a license for its use, without the consent of the person keeping the trade secret, having been advised of its confidentiality, for the purpose of procuring an economic benefit for oneself or for the third party, or for the purpose of doing harm to the person keeping the secret shall constitute a criminal offense. It also establish as a criminal offense the appropriation of a trade secret without the right to do so and without the consent of the person who keeps it or its authorized user, in order to use it or reveal it to a third party for the purpose of procuring an economic benefit for oneself or for the third party, or for the purpose of doing harm to the person keeping the trade secret or to the authorized user thereof.

The IPL also sets as a criminal offense, using information constituting a trade secret that is known by virtue of employment, responsibility or position, the practice of a profession or business relations, without the consent of the person keeping it or the authorized user thereof, or that has been revealed to one by a third party, in the knowledge that said third party was so acting without the consent of the person keeping the trade secret or the authorized user thereof, for the purpose of procuring an economic benefit or doing harm to the person keeping the trade secret or the authorized user.

The IPL also establishes that regardless of the criminal actions, the aggrieved party in any of the offenses referred to trade secrets may demand from the perpetrator or perpetrators thereof compensation and the payment of damages, as provided for in Article 221 bis of this Law, for the harm sustained as a result of said offenses.

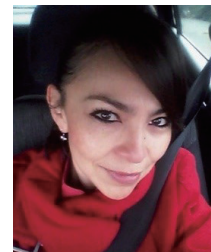
The main problem is that trade secret will only be considered as such when the information is

contained in documents, electronic or magnetic means, optical disks, microfilms, films or other similar instruments. This means that if the trade secret is not contained in a physical or electronic support, in contrariu sensu, it is not possible to enforce such rights against third parties, thus this may represent a disadvantage in case that it is necessary to demonstrate the existence of the trade secret in a litigation proceeding.

INDUSTRIAL DESIGNS DISCLOSURE VS. RECOGNITION OF A RIGHT

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FY2018 JPO/IPR Training Course on Design Examinations under the Hague System
(January 10-January 17, 2019)



ABSTRACT

Nowadays in Mexico, there is misinformation about the scope of protection offered by the recognition of a right through Industrial Property, and there is noticeable underestimation and skepticism in this regard. Therefore, it is common that independent creators, designers and artisans tend to promote and exploit their designs more through disclosure via different means of communication. With the advantage of immediacy, practicality and economy, such disclosure results are more attractive than the benefit of having the recognition of a right from Industrial Property.

The understanding may exist that “exploitation exclusivity” is in one’s own benefit, and is granted almost automatically at the moment when one disseminates one’s designs as their own—thus appealing to the idea of a linkage between the creators/designers/artisans with their own work. In the practice and in the industry, however, disclosure via communication media per se does not guarantee respect for the authorship of one’s designs; nor does it grant a legal certainty or link the creators, designers or artisans with their works.

INTRODUCTION

It is known that in a certain way, research work forces the dissemination of knowledge to the society, having as its primary objective the idea of informing the results of the said research not only within the academic environment, but also to the public in general. In this sense, both articles and registration/patents are mechanisms that allow such divulgation. However, these two means of dissemination have a very different nature, since the purpose of an article is to communicate to society the results obtained via certain research, while in the case of registrations and patents, the purpose is to grant an exclusive recognition of a right over an industrial creation.

This specific difference in purpose (communication vs. recognition of a right) should be the first indicator that a creator, designer or artisan must consider before all.

BODY

Currently, there are great expectations involved when making public a creation or design via disclosure rather than recognition of a right; this is motivated by three factors: first, making the design known in a practical and immediate way; second, implying less time when preparing the publication; and third, spending a lower amount of money. However, the scope and limitations that are brought by a disclosure of this type are often not measurable in the first instance, neither by the size of penetration of the audience or by the prospective studies, so it could either benefit or harm the owner.

The disadvantage that most creators, designers or independent artisans find in at first, when they are approaching -industrial property-, is a legal platform that they are not used to, and which could seem difficult to deal with. Additionally, the rigid application structure, the waiting time to obtain the corresponding title, and the necessary payment of fees, are all factors that make them opt for other options that do not require legal notions in terms of industrial property, where the presentation of information is more flexible, and information disclosure is immediate and economic, as offered by magazines, newspapers, websites, etc. On first impression, this type of disclosure may seem very attractive, and it is, but only when the prime purpose is merely to -communicate- something, and not to obtain legal security.

In the case of industrial designs, the importance of the product appearance in terms of its first impression on the part of the customer is usually an essential factor in the purchase or acquisition decision. Therefore, the unique appearance of a design gives a great value in terms of the strategy and success of a company or business, since this reinforces its competitiveness and improves its positioning in the market.

When registering an industrial design, there is legal protection against the unauthorized exploitation of the design applied to industrial articles. This means that there is a more controlled commercialization and the economic compensation is more direct, since any person or company interested in the design in question must agree to the owner of the registry to be able to take it to a commercial sphere. Therefore, the industrial design is totally linked to the owner and is recognized as their property.

It is necessary to specify that the rights derived from an industrial creation that are granted to a creator, designer or artisan arise from the legal decision and the recognition of a personal right; and that the Industrial Property Law does not create or grant, but only recognizes a property right. (Pérez, 2002).

It could be said that the less risky road when wanting to exploit an industrial design and claim its exclusivity is through industrial design registration. This is a legal procedure with a strict structure in the presentation of its application, which takes a short time in terms of concession, and involves payment of fees, along with the certainty that—once granted—it will provide legal certainty to the holder by means of a recognition granted by the state.

While it is true that the procedure relies on a legal platform, it does not make it so unattainable for the independent creators, designers or artisans, since a user guide is available on the internet for preparing this type of application. Also, even the Mexican Institute of Industrial Property (known by its initials in Spanish, IMPI) offers free, personalized consultancies by specialized examiners from the Industrial Designs Department. Additionally, should there be difficulties in terms of the time spent to prepare a document of this type, specialized Industrial Property Offices offer their services for their purpose.

In addition to the above, when an industrial design application is submitted, it is at once identified with a unique application number to which the owner can immediately refer, along with the title “registration in progress”, and the design could begin to be commercialized without needing to wait months for it to be published in the Gazette, or to obtain the title. Finally, there is another benefit wherein the fee payment could be reduced if the applicant is an independent creator, designer or artisan, who are eligible for a

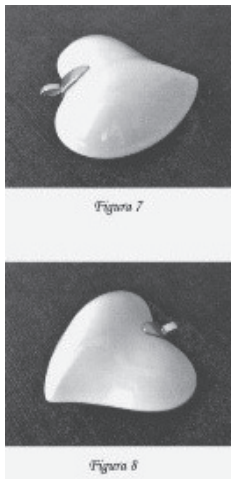
discount of 50% on the normal rates.

The accessibility of industrial design registers is evident, although the scope of the design must be defined by the creator, designer or artisan, who should establish the purpose for disclosure. Finally, the medium must be selected for disseminating the information.

In this digital age, the immediacy, ease and accessibility to different means of communication facilitate the search for information, so it is risky to disclose while leaving in the background the commercial scope that is intended.

Let's see some examples:

- These designers' purpose was recognition of the right to facilitate economic compensation and exclusivity of use through industrial property. See the cases illustrated below.



Industrial Design
Registration 46441



Industrial Design
Registration 47700

- The designers illustrated below have the same objective as above, and additionally made use of the media to publicize their designs. In these cases, the industrial design registration holders first applied for legal certainty and then engaged in disclosure via the internet.



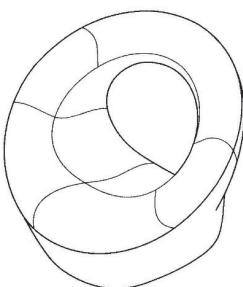
Industrial Design
Registration 29317.

Grant date: 21/09/2009



<https://www.mexico.com/hecho-en-mexico/el-disenador-ariel-rojo-abre-tienda-temporal/>

Disclosure date: 4/10//2018



Industrial Design
Registration 51083.

Grant date 16/10/2017



<https://gatopardo.com/estilo-de-vida/disenador-ariel-rojo/>

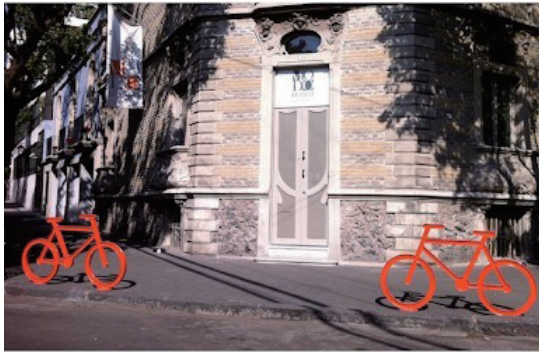
Disclosure date: October 23th 2018

- This designer initially wanted to disclose the design (communicate), but later also sought recognition of the right through industrial property to facilitate economic compensation and exclusive use. However, in the cases illustrated below, the Industrial Design Registry did not proceed since a design must be new in order to receive this designation, and the novelty of the design was lost as it was previously disclosed.



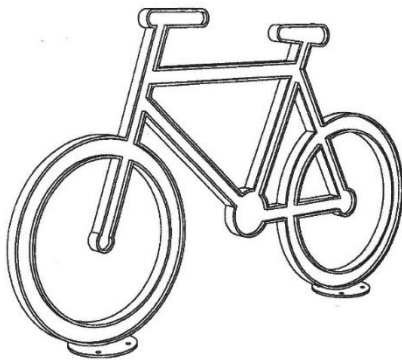
<https://www.arielrojo.com/index.php/es/proyecto/rack-bici>

Disclosure year: 2010



<http://designaholic.mx/diseño/diseño-en-méxico/3-años-de-adición-al-diseño-ariel-rojo/>

Disclosure date:
April 11th 2011



Industrial Model of Bicycle
Parking Bracket

Application number MX/
f/2011/002304
July 12th 2011

First attempt

Industrial Model of Bicycle
Parking Bracket

Application number MX/
f/2014/002571

Second attempt



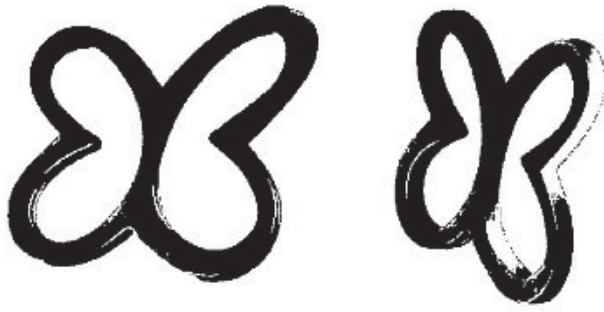
https://www.miguelangelvargascruz.com/50anosdelarevistavanidades_blog_840.html

Disclosure date: May 10th 2010



<https://pinkcarpetmagazine.wordpress.com/2009/06/18/dia-de-papa-con-tanya-moss/dije-mariposa-ninos-en-alegria/>

Disclosure date: June 17th 2009



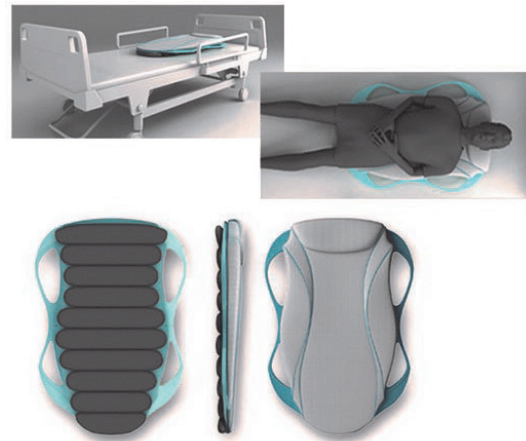
Industrial Model of Butterfly Mold

Application number MX/2011/002448.

- Purpose of the designer: To disclose the designs and obtain publicity. See the cases illustrated below.



<https://www.braunprize.org/img/media/4d1eb0163a0e12157a34d0e0700ef84e.pdf>



<http://www.podiomx.com/2016/09/premio-clara-porset-2016-convoca-las.html>

CONCLUSIONS

The purpose of the disclosure must be analyzed first. If the creator, designer or artisan only plans to publicize the designs, a disclosure could work. If the intention is the legal certainty that facilitates economic compensation and use exclusivity, however, industrial design registration is best.

Therefore, we must be aware that through the disclosure of information—whether visual, descriptive or oral—the knowledge will enter the public domain without any economic compensation or exploitation restriction, allowing free use by any person interested in the topic. When registering, however, there is a legal recognition of an industrial creation, being the property of the registration holder, who is granted exclusive use—thereby facilitating financial compensation.

Disclosure and industrial design registration do not exclude each other, and both represent very powerful sources for the divulgence of knowledge. However, in strict theory, a new design must be registered before being disseminated, since one of the requirements to obtain an industrial design registration is that it must be new—and this novelty is lost with public disclosure. Therefore, it is important to find a balance between disclosure and protection through industrial design registration.

While disclosure of information and industrial design registration are documents that imply a technical-visual type of writing, the architecture and writing style are very different. Although both must be clear, precise and illustrative, the structure of an article in a magazine, for example, is flexible, while the content of each section is relatively free. On the other hand, the structure, form and content of an indus-

trial design registration application is rigid, since the document is not only technical, but also legal.

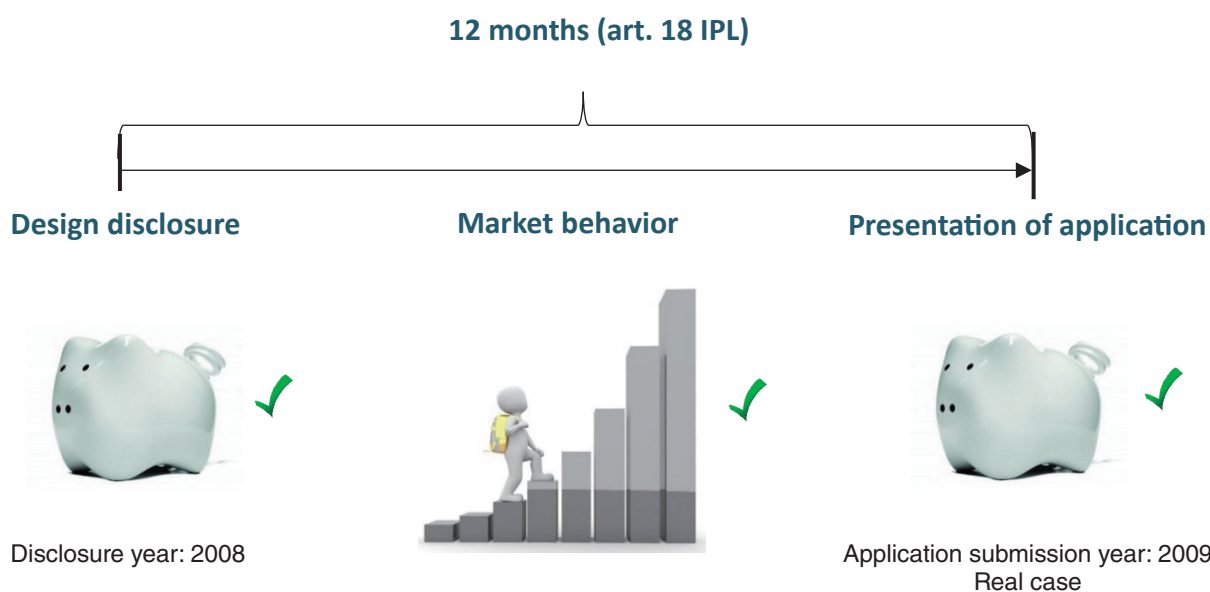
PROPOSAL

According to 18 articles of the Industrial Property Law (in the Mexican framework), the disclosure of a design will not affect its continued considered as being new if the owner discloses the design within 12 months prior to the date of application presentation, and when submitting the corresponding application, include the supporting documentation. The creator, designer or artisan has up to 12 months to disclose the design, then, and at the same time, to evaluate how it behaves in the market. If the design starts to empower or gain sales success, the next recommended step is to protect it through industrial design registration.

The advantages of the proposal are, in a first instance, to make the design known in a practical and immediate way by involving a smaller amount of time and a lower amount of money at the beginning, as well as the possibility of a market evaluation during the first 12 months by analyzing the scope and limitations regarding the design sales and market penetration in order to consider the convenience of applying for an industrial design registration. In a second instance, an industrial design registration guarantees respect for the authorship of the corresponding design. Since legal certainty is granted to the holder, there is a linkage between the creators, designers or artisans and their works. Legal protection is thereby offered against the unauthorized exploitation of the design since there is controlled commercialization, the economic compensation is more direct, and the industrial design is completely linked to the owner and recognized as her or his property.

In this type of practice, the holder receives three chronological benefits: disclosure, market behavior information, and recognition of a right.

Science and technology do not have countries, but they do have developers: in other words—creators, designers and artisans.



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Message from Lecturers



Looking back on my visit to Myanmar



Kenichi Hatori

Secretary General, UNITT

University Network for Innovation and Technology Transfer

Unexpectedly, in late January 2018, APIC gave me the opportunity to participate in a follow-up seminar in Myanmar as one of the speakers.

Before I visited, I heard from a Japanese trading company officer that Myanmar is the last developing country in Asia, and that he has high expectations now, so I was looking forward to the visit very much. When I arrived in the country, people everywhere including Yangon, were energetic and vibrant. There was a local trading company office near the hotel in Nay Pyi Taw, and I felt that the story of this business was quite compelling.

The seminar was sponsored by the JPO and the Ministry of Education of Myanmar, and took place under the supervision of the Institute for Invention Promotion. It took place on January 24 in Nay Pyi Taw, and the main theme was Promoting IP management for research collaboration between universities and industry.

Very passionate speeches were given by representatives from the Ministry of Education and the Ministry of Industry, who said that training and developing SMEs is Myanmar's biggest challenge. Compared to large companies, SMEs tend to lack the ability to solve problems and R&D in the field. Therefore, industry-academia collaboration involving universities, such as receiving technical guidance from a local university or conducting joint research, is considered useful in order to achieve sustainable development among SMEs. In that sense, I thought that the main theme of the seminar was a great match with the national policy of these ministries. In this spirit, I gave a talk on the topic of IP management in universities in the area of cooperative research.

Half of the seminar attendees were women. Participants enthusiastically listened to the lectures and asked many questions, which may be a cultural aspect of the country. There were endless questions in particular after the talk given by APIC's director Ogiya, which extended until 18:00 in the evening.

With the diligent national character of the people of Myanmar, it is hoped that Myanmar will become a leading developing country of Asia in the future.

The rainy season ended in January when we visited Myanmar, and we were able to spend every day comfortably in a very wonderful climate. After we returned home, Japan was attacked by a huge cold

wave that only occurs once in a decade, and the boiler of my home's bath was frozen and unusable. While running around for repairs, I felt like I had traveled from heaven to hell.

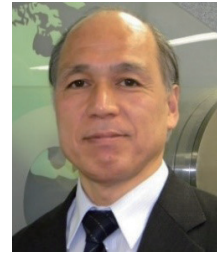
We received a great welcome from local people in Myanmar, and we are indebted to APIC members. I had a very good experience, and I would like to take the opportunity in this journal to express my heartfelt thanks.





8

Column: The New Year



Mr. Takao OGIYA
Director General of APIC



The year-end and New Year holidays are a special period for Japanese people, with many traditions observed.

Many government and municipal offices and private companies in Japan are closed for six days from December 29 to January 3. We first clean the whole house at the end of the year, where we move furniture around, take everything out of the closets and storage, and vacuum all of the places that are usually hidden from sight. We carefully dust the lights and light fittings, wipe grease from the ventilating fan in the kitchen, polish the floors, and so on. In this way, we remove all the dirt, dust and grime that has accumulated over the year, and make the home sparkle. Then, we can welcome the New Year in a clean house.

On the night of December 31, or New Year's Eve, we eat soba (buckwheat noodles). The dish is called "toshikoshi-soba," and most Japanese eat it as the last dish of the year.

In my home, my wife and I exchange greetings right at the moment when the date changes from December 31 to January 1. We say "*akemashite omedeto gozaimasu*" (Happy new year) and "*kotoshimo yoroshiku onegaishimasu*" (I look forward to your continued good will in the coming year).

On January 1, many Japanese visit shrines, temples, churches, etc. to offer prayers. Even those who generally live as atheists dress up and go to shrines and temples for worship on this day. Then, we pray to the gods, hoping for good things to happen during the year. Of course, not all of us visit shrines and temples because we are religious. Many of us visit them in the spirit of wanting to participate in a New Year's custom.

Be that as it may, it is true that the New Year allows us to refresh our minds. Many people set a goal for the coming year, like "I am going to lose five kilograms," "I want to read 20 or more books," "I will acquire a qualification," and so on. Then, we begin making efforts to achieve those goals, such as going to the gym to lose weight and buying a pedometer. In a few months, however, we forget the fact that we

even set such a goal.

We eat special dishes on New Year's Day called *osechi-ryori* and *ozoni*.



osechi-ryori

Osechi-ryori basically consists of three festive foods: roasted fish, a simmered dish of food from the mountains, and a pickled dish made using vinegar.

The contents of the three festive foods vary between the Kanto and Kansai regions. In the Kanto region they are *kuro-mame*, *kazunoko*, and *tazukuri*, while in the Kansai region they are *kuromame*, *kazunoko*, and *tatakigobo* (see the photos). Each of these has a different auspicious meaning. *Kuromame*, cooked black beans, are for longevity and health, reflecting our wish to be able to work energetically until our skin turns dark from the sun. *Kazunoko*, herring roe, is for fertility because of the large number of roe. *Tazukuri*, cooked dried juvenile sardines, is for a good harvest because sardines were used to fertilize rice fields in the past. *Tatakigobo*, a dish of tenderized burdock, is for the firm foundations of a house because burdocks root themselves deeply in the ground.



Kuromame



kazunoko



tazukuri



tatakigobo

Osechi-ryori is prepared and packed in a three-layered food box called *jubako* (see the photo). Most *osechi-ryori* dishes keep for a long time, which also has a meaning. First, it is intended to let us avoid using fire to the extent possible when eating the New Year's feast, which is said to be enjoyed together with the gods. Second, it is intended to release women from doing household chores at the beginning of the year.



jubako

Ozoni is a soup containing mochi (rice cake). In the Kansai region, *ozoni* is typically made with round mochi and soup flavored with miso (a soy bean paste). Meanwhile, in the Kanto region, people usually cook square mochi in a clear base flavored with soy sauce. Ingredients other than mochi also vary by region. Many Japanese people have a strong attachment to the *ozoni* of their native place. Personally speaking, my parents' home is a small merchant house in Osaka, and the New Year's first *ozoni* was always prepared by my father, the head of the family. We also made it a rule in my home to drink tea with seaweed cut into fine strips and small *umeboshi* (pickled plum) before eating *osechi-ryori*. Curiously enough, this tea makes me feel calm still today.

Next, we take a sip of *otoso*, the celebratory drink of the New Year, which includes a wish for sound

health. It is made by steeping a small paper bag containing medicinal powders similar to Chinese medicine in saké. We drink *otoso* with a vermillion-lacquered *choshi* (sake bottle) and *sakazuki* (sake cups), which come in a stack of three (see the photo). Although we are supposed to drink *otoso* three times using the large, medium, and small cups in accordance with the proper custom, we have simplified the ritual in recent years and now just take a sip (for the practical reason that *otoso* is not that good!).



otoso



ume-kobucha

Then, we eat *ozoni*. Although it seems that these New Year's dishes have become less meaningful nowadays, with our lifestyle becoming more enriched and our eating habits diversified, I believe that we should carry on enjoying these dishes as part of the traditional dietary culture of Japan.

I was asked to write a column on the subject of the New Year. As it turns out, I have focused on food from start to finish. Telling myself that “after all, I like eating,” by March I had completely forgotten the goals that I set at the beginning of the year, such as going on a diet and going to the gym on a regular basis.

I am writing this column in the fierce heat of August. Although it is very hot, I am not losing my appetite at all. I want to get a flat stomach, because my belly has begun to stick out slightly—but I don't want to get a flat stomach by going so far as restraining myself from eating delicious food.

So I am going to fully enjoy delicious *osechi-ryori* and *ozoni* again on New Year's Day in 2020.

Introduction of Japan: Festivals



Hello alumni, from your Enishi IP Friends Connections editor! Beginning this year, we are introducing special spots in Japan so that overseas trainees may enjoy the country to the fullest extent possible during their stay.

Edition number two features festivals in Japan. Among the many taking place around the country are Shinto festivals, where portable shrines are paraded around featuring gods that have been enshrined atop floats and carts. The Yama, Hoko and Yatai float festivals were officially recognized in 2016 as a UNESCO intangible cultural heritage.

Omikoshi

These are floats atop which people ride, and which local shrine parishioners shoulder manually in order to transport gods. It is normally explained to overseas residents that omikoshi are essentially portable shrines, and they are, in fact, shaped like actual shrine structures. Due to increasing depopulation and efforts aimed at economic development, omikoshi may now be carried by those other than local



Floats lined up at the Shinjuku Sawara Float Festival, Katori City, Japan
17 October 2007, KATORISHI

shrine parishioners. A special short coat from the local area (known as a hanten) must be worn in order to do so, however, so it is not possible to simply show up at the festival and carry an omikoshi. Instead, local shrine parishioners must be contacted in advance.

Floats and stalls

While omikoshi are shaped like shrines, other floats known as “yama” are decorated with dolls and flowers and are shaped somewhat like mountains; while still others called “yatai” are equipped with roof-like structures. The “yama” take different forms, sometimes being equipped with taiko drums and dolls more than 10 meters in size, as well as various artistic structures.



Stalls

A festival just wouldn't be a festival without food and drink, as well as stalls where games may be played—festival elements that are enjoyed by adults and children alike.



Popular foods include yakisoba (fried noodles), takoyaki (grilled octopus balls) and kakigori (shaved ice). Meanwhile, games include popular modern ones as well as older traditional ones: kingyo-sukui (goldfish scooping), shateki (shooting gallery) and kuji (fortune-telling), for example. These all provide a good chance to learn about Japanese culture.

Yakisoba (fried noodles)

This dish includes meat and vegetable chunks that are fried along with noodles in a spicy-sweet sauce. This is a popular festival food that may be cooked at higher temperatures than at home, and its delicious fragrance attracts customers who enjoy the noodles along with the delicious juices.



Yakisoba (fried noodles)

Takoyaki (grilled octopus balls)

Flour that has been dissolved in water is made into a batter and grilled in round balls along with octopus and vegetable chunks. Enjoyed with a special sauce and mayonnaise, this is a dish whose popularity stems from its delicious taste—as well as its ease of sharing with others.



Takoyaki (grilled octopus balls)

Kakigori (shaved ice)

Ice shaved into small chips is drizzled with different flavored syrups. The typically Japanese matcha (green tea) with anko (red bean paste), which may be quite different than the flavors you are used to eating at home. There many festivals in summer and in the beginning of autumn when it is still warm, where cold, tasty kakigori is enjoyed as a popular treat.



Kakigori (shaved ice)

Kingyo-sukui (goldfish scooping)

This game involves trying to scoop up goldfish using a thin paper ladle known as a “poi”. As the paper loses its strength from being dipped into the water, it is difficult to grab goldfish—making it a joyful moment indeed whenever someone manages to scoop one up.



Kingyo-sukui (goldfish scooping)

Shateki (shooting gallery)

This is a game where targets (prizes) may be won by knocking them over with mostly cork-based bullets.

Kuji (luck of the draw)

This is a game that is impossible to lose. A prize is won either by pulling on a string with something attached, or by drawing a paper with a number corresponding to a specific item. Since there are numerous types of prizes, the fun lies in the anticipation of what will be taken home.

Japanese festivals are fun events that provide opportunities for sacred worship of the gods, as well as enjoying oneself at the various stalls. Perhaps this is an altogether different type of experience from the festivals in your own country?



Shateki (shooting gallery)



Kuji (luck of the draw)

Three Major Festivals in Japan

Gion Matsuri (Yasaka Shrine, Kyoto)

<http://www.yasaka-jinja.or.jp/en/gion.html>

Wiki (https://en.wikipedia.org/wiki/Gion_Matsuri)

Tenjin Matsuri (Osaka Tenmangu Shrine, Osaka)

<http://www.tenjinmatsuri.com/tenjinfestival>

Kanda Matsuri (Kanda Shrine, Tokyo)

<https://www.kandamyoujin.or.jp/what/>

Wiki (https://en.wikipedia.org/wiki/Kanda_Matsuri)

Introduction of Japanese Annual Events (Four-Frame Cartoon)

Foods eaten in Japan for New Years:

Osechi Celebratory foods that are arranged inside a special multi-level box

Ozōni A soup featuring mochi (pounded rice cakes) together with various additional ingredients. One rather superstitious meaning of the dish is associated with up holding one's name or reputation. The flavoring differs depending upon the region.

Items displayed during the New Year in Japan:

Kadomatsu A pine branch that is used to guide the spirits

Shime-nawa A decorative rope made from rice straw or hemp that is used to designate sacred spaces and welcome the spirits

Kagamimochi An item of two pounded rice cake discs offered to the spirits

Toys played with during the New Year holiday in Japan:

Hanetsuki A light wooden racket, similar to that used in badminton, used to pray for girl's healthy growth

Takoage The flying of a paper kite stretched onto a frame that dances in the wind and is used to pray for boys' healthy growth

koma-mawashi A spinning top that stands straight up and is spun to pray for boys' healthy growth

Japanese New Year decorations are not put to waste. January 11th is known as a day when kagamimochi are broken open and used to make oshiruko (a sweet red bean soup) and okaki (rice crackers), which are then eaten as protection from illness and misfortune.

Editor's Note



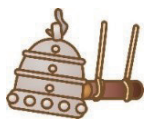
Hello. This is Mitty.

The year will soon change from 2019 to 2020. Are you familiar with “NENGA- JO”? The NENGA-JO is a New Year's greeting postcard sent to family and friends to thank them for the previous year and to wish them a happy new year, usually with a message unique to the Japanese culture. The NENGA-JO are almost always delivered on January 1st by postal workers.

There are also many people that are unable to get together with friends due to distance or other factors that use NENGA-JO to keep everyone up to date with what is going on in their lives. I also send NENGA-JO to friends to wish them a happy new year and to tell them about the growth of my children.

However, recently more and more people are switching from NENGA-JO to email and SNS to send New Year's greetings. Certainly, methods using electronic data are much faster than NENGA-JO, but there is nothing really tangible that you can hold in your hand, and it seems less personal than NENGA-JO. I am therefore reconsidering using NENGA-JO again rather than email or SNS. I am currently thinking about what kind of New Year's message I would like to send to my good friends this year. I hope you will have good memories of 2019, and that you will also have a wonderful 2020.

New Year's Eve



Hi, it's Hiroko again! Right after Christmas in Japan, all decorations are immediately switched to New Year's ones—and we start hastily preparing for the year end and New Year's events. Many of these are based on Japanese tradition, and are deeply related to religion. However, for most Japanese people, this seems to be regarded as a custom rather than a religious act.

On New Year's Eve, we prepare traditional meals that are served during the New Year's holidays for good health and a great harvest. We also eat soba noodles called “toshikoshi soba” (year-crossing-over soba) to wish for longevity.

In addition, a major house cleaning is done by the whole family. This is thought of as a ritual to give a pleasant welcome to the gods on New Year's Day.

At night time, huge bells are hit 108 times at Buddhist temples during midnight to get rid of all evil desires. The tolls of the bell symbolize the casting away of 108 earthly desires, which are believed to cause human suffering. It is said that each bell sound erases one of the 108 earthly desires so that people can begin the new year feeling refreshed. Wishing you a happy 2020!

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