

INTELLECTUAL PROPERTY 2023 VIRTUAL ROUND TABLE

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Introduction & Contents

In this roundtable our chosen experts outline the latest regulatory changes and noteworthy case studies, identify best practice procedures for managing large IP portfolios and implementing intellectual property rights cross-border, and discuss the importance of due diligence, prior art searches, and the IP challenges in an increasingly digitalised environment. Featured countries include: Ecuador, Indonesia, Ireland, Nigeria, United States and South Africa.



James Drakeford
Editor In Chief



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Meet The Experts



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Herman van Schalkwyk is a Patent Attorney. He has BEng (Mech), LLB (cum laude) and MBA (cum laude) degrees, and is an Attorney of the High Court of South Africa.

Herman has covered domestic and international patent and design matters, with a particular focus on the preparation and prosecution of patent and design applications within the mechanical, civil and general engineering fields. His experience also includes commercial transactions relating to IP, due diligence investigations, landscape analyses, and patentability and freedom to operate analyses.

Outside of his professional responsibilities, Herman has a keen interest in the management of organisations, particularly in leadership and strategy. He enjoys serving within the management structures of Spoor & Fisher.



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Ms. Tian-ying Zhao has practised in the area of intellectual property law since 2006. She works both on contentious and non-contentious matters, and her practice has a particular focus on trademark portfolio development, trademark oppositions/invalidations, enforcement of trademark rights and copyrights, and alternative dispute resolutions. She also works with foreign associates to help clients filing patent applications in China. Ms. Zhao counsels mostly overseas clients, including many multi-national corporations, and impresses her clients with her insightful analysis of the situation and thoughtful advices on legal strategies. Ms. Zhao is currently a partner at IntellecPro.



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Originally from Malaysia, Sumi qualified as a Barrister and subsequently a Solicitor in the UK, before moving to Ireland, where she has spent the last 15 years working in FRKelly's Dublin offices. Sumi counsels foreign and domestic clients in the selection, clearance, prosecution, monitoring and enforcement of Irish, UK and EU Trade Marks. She also coordinates the global IP portfolios of a number of leading Irish companies and represents the trade mark interests of a broad range of SMEs and private individuals, specialising in the food and beverage, FMCG and packaging sectors.



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Santiago Mosquera is partner of Falconi Puig Abogados in Quito. He has over 15 years of extensive experience providing timely and practical advice regarding corporate and Intellectual Property matters. Santiago also advises on topics regarding marketing and advertising law.

Santiago works with national and foreign clients on structuring their trademark portfolio, intellectual property-related strategy, planning and representation in administrative and judicial proceedings. He also provides consultancy on advertisements, publicity, and promotional campaigns for different sectors of the industry.

Santiago's continuing professional development and training, his years in practice, wide variety of consultancies and university teaching attest to his ability as a persuasive professional.

Meet The Experts



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Chinyere is a Partner in the Law Firm of JACKSON, ETTI & EDU, Lagos–Nigeria and has over 30 year’s practical experience, covering all aspects of Intellectual Property(IP) law, where she is considered an authority and an expert. At present, she is responsible for the client relationship management of some of the firms key clients.

She is the current chairperson , NBA, Women Forum, Past Vice Chairperson, past Council Member & Treasurer, NBA-SBL - is a past Chairperson of the IP Committee of the Nigerian Bar Association, Section on Business Law; a Patron of The Law Society, Faculty of Law, University of Lagos, a member of the IP Law Association of Nigeria (IPLAN) Stakeholders Committee and a member of the Dispute Resolution Panel of the Nigerian Copyright Commission (NCC).

Chinyere was nominated as one of Managing Intellectual Property’s (MIP’s) Top 250 Women in IP, 2021/22, Nigeria’s top 20 women in Business Law 2020 and one of the 50 most influential women in the Legal Profession (Business Day Newspaper, April 2011), and has featured in the Trademark Law Practitioners Expert Guides 2012 – 2022, Euromoney, UK; and as an “IP Star” in Managing IP’s definitive guide to Leading IP Lawyers 2014-2022, UK. She is Ranked in Chambers Global 2016 - 2022, as a Leading Individual in IP in Nigeria as well as is recognised as an expert in Who Is Who Legal Nigeria, 2017 - 2022, to mention a few.

Chinyere has over the years successfully organized/ facilitated various seminars and workshops, on IP, both locally and internationally. She also belongs to many professional organizations and advises varied government agencies on IP related issues, particularly Law reform. Chinyere regularly Speaks at workshops, seminars and conferences (locally and internationally) and has recently been approached to develop a course content for an Intellectual Property Training School for young lawyers. She has also written many published and unpublished articles, both locally and internationally.

She is on the Advisory Board of a number of NGOs and speaks regularly at workshops, seminars and conferences (locally and internationally) on varied topics of interest.



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Risti is the co-founding partner of K&K Advocates. Risti has built extensive expertise in IP over 20 years and has been actively involved in providing assistance for both Indonesian and foreign clients in a variety of IP projects. She leads the firm’s IP Prosecution team and also co-lead the Corporate Technology & Commercial IP team. Her expertise includes IP Prosecution and IP Commercial works in such areas as franchising, licensing, distributorship, anti monopoly, telecommunication and data protection/privacy.

Risti holds a Bachelor of Law degree from the Faculty of Law, Trisakti University, Jakarta, majoring in Business Law and Master of Law degree at University of Pelita Harapan, Jakarta. Risti is a licensed Advocate and was also admitted to practice as an IP Consultant in 2006. She is also a member of the Indonesian Advocates Association (Peradi), a member of INTA and was an active committee member of AKHKI (2010-2013). She currently serves as the Anti-Counterfeiting Committee for the Indonesian Chapter of the Asian Patent Attorneys Association.

Risti was mentioned as the Up and Coming Lawyer in the IP area for 2015 and Leading Individual for IP practice for 2016 by Chambers and Partners. She has been featured on the Who’s Who Legal for Franchise 2017, 2018, 2019, 2021 and 2022 for Indonesia and included as one of The World’s Leading Trademark Professionals by Word Trademark Review for 2019.

Risti is also listed in as a Recommended Individual in prosecution and strategy by WTR1000 for 2020 and has recently been recognized as Recommended Individual by Legal 500 for 2021 and also listed in as a Leading Litigation Lawyer and Leading Non-Litigation Lawyer by Hukumonline for 2021.

Meet The Experts



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FRANCO ORITI, born in Australia, lived in Sydney and has worked in safeguarding, filing and maintaining Intellectual Property (I. P.) since 1991.

University degree in International Political Science obtained at University of Milan, Italy.

He is currently working in this capacity in Lugano (CH) after having done so in Milan in Montedison Group and in Notarbartolo & Gervasi and in Lugano, Switzerland, in N&G Patent Services.

He has many years' experience, throughout the World, in the Renewal of Patents of Invention, Designs, Utility Models, Supplementary Protection of Certificates, Textile Designs, Plant Varieties and Trademarks.

Since 1999 Franco takes also care of filings till the grant of Patents, Trademarks and Designs in Switzerland.

He is registered as a Trademark, Patent and Design Representative before the Swiss Federal Patent Office, also as a European (n.4688) and Italian (n.793M) Trademark and Design Attorney and also as a San Marino Trademark Attorney (n.USBM-078R M).

He has very good skills for creating "ad hoc" I. P. Databases for handling Due Dates and Reports (see www.ipduedates.com). See also www.epvalidation.ch, www.tmrenewal.ch, www.patentannuities.ch and www.iprecords.ch

He has an ability to establish plans, for the internal IP Departments of Companies and Patent Firms, to manage costs and reduce expenses for all I. P. maintenance fees and renewals, Worldwide.

From March 2015 he is an "IPMA Certified Project Manager", re-certified 2020 Level D, n. IPMA-D-2015-8025/1 (www.vzpm.ch).

From May 2016 "Business Partner for I. P." of Qualicon, Camorino (www.qualiconsulenze.ch).

He was an I. P. Coach for StartCup Ticino 2017 (www.startcup-ticino.ch)

Languages: English (mother-tongue), Italian (mother-tongue), French (good), German (scholastic) and Russian (scholastic).



Q1. Have there been any recent regulatory changes or interesting developments in your jurisdiction?



Chinyere Okorocho

Okorocho: There have certainly been some interesting developments and recent regulatory changes in the Nigerian intellectual property space. Some of the highlights are listed below:

The Business Facilitation (Miscellaneous Provisions) Act 2022

This Act is a comprehensive legislation that was signed into law by the President of the Federal Republic of Nigeria, on 10 February 2023. The Act aims at improving the business environment, by making amendments to existing legislation. One of the key legislations modified by this act is the Trademarks Act.

Under the Act, amendments were made to the Trademarks Act to enhance its scope. Firstly, the definition of goods was expanded to include services. This means that trademarks now cover not only physical products, but also various services offered by businesses. Although service marks were registrable in Nigeria prior to the enactment of the Act, it was not formally recognised under the Trademarks Act.

The Act also broadened the definition of a trademark to encompass trade dress. This means that in addition to protecting traditional trademarks like words, logos, and symbols, trademark protection now extends to the overall appearance and design elements of a product or service. This includes the shape of a mark and combinations of colours used in branding.

The Copyright Act of 2022

This Act repealed the Copyright Act of 2004. The new legislation brings improvements to Nigerian copyright law by updating it to reflect developments in the field – particularly related to the internet and technological advancements, and the disruptions in the creator economy worldwide.

Key amendments include expanding the scope of copyright to cover audiovisual works and recognising the distribution of music through wireless and online platforms, encompassing various forms of streaming.

To strengthen enforcement, the Act introduces stricter penalties and additional offences. Those who commercially communicate or make copyrighted works available to the public without consent – through wire, wireless, or online means – can face a minimum fine of N1,000,000, a minimum prison term of five years, or both. Refusal to pay royalties agreed upon or determined by the Commission can result in a minimum fine of N2,000,000, a minimum prison term of 12 months, or both.

The Act also implements measures to combat online piracy, making it an offence to sell, rent, hire, or offer for sale or rent any work in violation of regulations. Offenders can face a fine of not less than N500,000, a minimum prison term of three years, or both.

Overall, the Copyright Act of 2022 brings significant changes to Nigerian copyright law, addressing current challenges and providing stronger protection for creators and their works.

The Nigerian Copyright Commission (NCC) E-Registration System

The NCC is the primary regulatory agency in charge of enforcing the Copyright Act and dealing with piracy concerns.

Q1. Have there been any recent regulatory changes or interesting developments in your jurisdiction?



Chinyere Okorocha

Prior to 1 October 2022, the NCC's practice is to issue paper certificates to successful applicants. The NCC has now established a virtual e-registration (online) registration facility for copyright works in Nigeria, which rolled out on the 1 October 2022.

The Commission has informed the public that with effect from 1 October 2022, the Commission will discontinue the issuance of paper-based certificates and commence issuance of e-certificates in respect of applications under the e-registration scheme. This system will allow artists to register their works and acquire an e-registration certificate, which will serve as proof of ownership under the e-registration scheme to enhance service delivery.



Herman van Schalkwyk

Schalkwyk: The South African Patent Office issued Practice Note 21 of 2023 on 7 April 2023 to curb the abuse of its non-examination system. In a bid to promote innovation, the governments of some countries offer financial incentives and rebates based on the number of granted patents obtained by their nationals. This opens the non-examining patent system in South Africa to abuse by applicants who request expedited acceptance and grant of South African patents to leverage these incentives and rebates. As a result, South Africa has seen a significant increase in the number of applications filed by foreign applicants, especially from China or India.

These applications are often non-convention applications that do not claim priority from an earlier application and are accompanied by a request for expedited acceptance and grant. The Patent Office has limited capacity to identify patent applications that clearly do not meet the patentability requirements. The patent system is left vulnerable to abuse by applicants who apply for and obtain patents for subject matter that they know to be lacking in novelty or inventiveness, for example. Applicants of legitimate applications are prejudiced through significant delays in getting their applications accepted and granted.

The Practice Note requires that supporting documents must be submitted with any request for expedited acceptance of a patent application made within the first 12 months of filing in the case of a PCT national phase application or within the first 18 months of filing of all other applications. Acceptable supporting documents include the Written Opinion of the International Searching Authority (WO-ISA) or International Preliminary Report on Patentability (IPRP) issued on the underlying PCT application. Where the WO-ISA or IPRP indicates that at least one claim is both novel and inventive, a search and/or examination report of a corresponding foreign patent application where an examining patent office has considered the subject matter of at least one claim to be both novel and inventive, and an affidavit from the applicant setting out the reasons that expedited acceptance is required.

The Practice Note is a welcomed step to safeguard the integrity of the patent system until substantive search and examination (SSE) is introduced, which could still take a number of years.



Risti Wulansari

Wulansari: The Indonesian government recently enacted Government Regulation No. 24 of 2022 on Creative Economy ("GR 24/22") which enables individuals and entities to use their intellectual property rights (IPR) as collateral for funding (IP-based financing).

Through GR 24/2022, creative economy entrepreneurs can get IP-based financing from financial institutions. The entrepreneurs must apply to a bank or financial institution to obtain such funding. Although Indonesian financial institutions are still preparing themselves in actualising the practice of IP-based financing, GR 24/22 has surely brought a breath of fresh air to IP owners.

Q1. Have there been any recent regulatory changes or interesting developments in your jurisdiction?



Risti Wulansari

Further, following the successful implementation of the automated approval system on copyright records (known as “POP Hak Cipta”), the Directorate General Intellectual Property has also launched an automated approval system for filing trademark renewal application (known as “POP Merek”) in Q4-2022.

This system facilitates one day services for trademark renewal process, providing the all formalities have been completed and no pending recordal of change thereof, which consequently makes the process much simpler and faster.



Tian-ying Zhao

Zhao: On 12 January 2023, the China National Intellectual Property Administration (CNIPA) issued a draft amendment to the Trademark Law for public comment. The newly-released draft introduced tremendous changes to the current law. One of the most notable changes is the strengthened obligation on trademark use.

Under the draft amendment, trademarks should be registered based on use or intent to use. Every trademark registrant is required to file a statement of use every five years explaining how their trademarks have been used on designated goods/services or providing fair reason of non-use. Failing to meet the requirement will result in termination of the registration. The CNIPA will verify the authenticity of the information provided in randomly-selected statements. If one is found to be making a false statement, his/her trademark registration will be revoked.

The above change will shut the door on defensive registrations. The Chinese law does not provide for defensive registration of trademarks. However, since there is no requirement of use or intent to use for registering trademarks, many brand owners have filed trademarks defensively in a wide range of classes to block malicious applications. If the proposed amendment is passed, the brand owners may have to spend more on brand protection as filing oppositions is a lot more costly than filing defensive trademarks, not to mention, in the absence of prior marks on the relevant goods/services, their oppositions may not succeed.

The current trademark system in China pays insufficient attention to the obligation of use, which has resulted in a huge number of unused trademarks sitting in the registry making it difficult for businesses to obtain trademark registrations. The proposed amendment aims to solve the problem. However, what impacts will it bring? Brand owners will stop filing trademarks that they do not have intent to use. The trademark squatters, on the other hand, are not likely to stop filing malicious applications because most of them would not feel uncomfortable with making an untruthful statement of use. Therefore, without effective measures being adopted to curb trademark hoarding, the proposed amendment will harm the interest of legitimate right owners.

Fortunately, the draft amendment also worked on the problem of trademark quartering. Proposed changes include establishing a compulsory mechanism to transfer bad-faith trademarks to their legitimate owners, increased administrative fines against bad-faith trademark filers, and most importantly, allowing right owners to collect compensation for the losses caused by trademark squatters, including the reasonable expenses paid to remove the bad faith trademarks.

“The current trademark system in China pays insufficient attention to the obligation of use, which has resulted in a huge number of unused trademarks sitting in the registry making it difficult for businesses to obtain trademark registrations.”

- Tian-ying Zhao -

Q1. Have there been any recent regulatory changes or interesting developments in your jurisdiction?



Sumi Nadarajah

Nadarajah: The Online Safety and Media Regulation Act 2022 targeted at the protection of online safety was passed in November 2022. It is to be overseen by the newly-established Media Commission. The legislation seeks to implement a number of legislative reforms including the transposition of the revised Audiovisual Media Services Directive and to align the regulation of video on-demand services with traditional broadcasting. The Media Commission in Ireland will take on the role of 'digital services coordinator' under the EU's Digital Services Act (DSA).

Among its DSA duties, the Media Commission will be responsible for assessing requests from 'vetted researchers' for access to data held by VLOPs and VLOSEs; awarding 'trusted flagger' status to third parties engaged in identifying content online platforms may have to remove from their services; issuing orders to take down illegal content; hearing and resolving complaints made concerning infringement of the DSA; and investigating and taking enforcement action under the DSA. The Media Commission's functions and powers under the DSA will begin to apply from 17 February 2024.

The other interesting development is the Unified Patent Court (UPC) which is a common patent court open for participation of EU Member States, and created by the "Agreement on a Unified Patent Court", which will enter into force on 1 June 2023. Ireland must hold a referendum to ratify the Unified Patent Court Agreement, but a date has not yet been set – although the deputy prime minister has hinted that 2024 may be a possible date.



Franco Oriti

Oriti: A change related to the examination procedure for patents of invention will likely happen in 2024.

Q2. Have there been any landmark cases or examples of new case law precedent?



Tian-ying Zhao

Zhao: The 2020 amendment of Chinese Patent Law, which took effect on 1 June 2021, established a pharmaceutical patent linkage system as a mechanism for early resolution of pharmaceutical patent disputes. It is provided that during the marketing approval process of a drug, the relevant patentee or interested party may lodge a patent infringement suit before the court, or alternatively, file an administrative complaint before the China National Intellectual Property Administration (CNIPA) against the applicant of the marketing permit. If the drug is found to infringe upon the patent of others in one of the above proceedings, the pharmaceutical supervisory shall suspend the marketing approval of the drug.

On 5 August 2022, the Supreme Court of China concluded the first patent linkage court case in the country. Chugai Pharmaceutical Co., Ltd. ("Chugai") is the patentee of the invention named "ED-71 Preparation" (Chinese application No. 200580009877.6), as well as the holder of the marketing permit for the drug "Eidcalcitol Soft Capsules". The company registered the aforementioned patent and drug on the China Marketable Drug Patent Information Registration Platform, claiming that said drug was related to claims one to seven of the said patent.

Wenzhou Haihe Pharmaceutical Co., Ltd. ("Haihe") applied for a marketing permit for the generic drug "Idcalcitol Soft Capsules", claiming the drug did not fall within the protection scope of Chugai's patent. Chugai filed a lawsuit requesting the court to confirm that the technology solution of Haihe's generic drug fell within the protection scope of their patent. Although Chugai eventually lost, the case set a precedent for holders of pharmaceutical patents to sue applicants of marketing permits in an attempt to prevent infringing drugs from entering the market.

Q3. What challenges exist for those implementing their intellectual property rights across multiple jurisdictions? Are there any best practice procedures they should follow?



Chinyere Okorochoa

Okorochoa: The challenges that exist for implementing intellectual property rights across multiple jurisdictions are as follows:

Jurisdictional limitations: In Nigeria, Intellectual property rights are territorial in nature, which means that they are only enforceable in the jurisdiction where they are registered or granted. This can create challenges for businesses that operate in multiple jurisdictions and who want to protect their intellectual property rights across all of them. A proprietor is therefore left filing multiple applications to cover each of the jurisdictions where protection is sought, which is obviously a very expensive and time-consuming exercise.

Differences in intellectual property laws: Intellectual property laws vary widely across different jurisdictions, which can create challenges for businesses that want to protect their intellectual property rights across multiple jurisdictions. For example, patent laws may differ in terms of what is patentable, and the level of protection provided.

Different legal systems: Each jurisdiction has its own legal system, which may have different rules and procedures for enforcing intellectual property rights. This can create confusion and uncertainty for businesses that operate in multiple jurisdictions.

In terms of best practices, I would advise that the right research is done, to determine whether or not there are any international filing systems in the jurisdictions of interest, which will enable you obtain multi-jurisdictional protection with a single application. For example, in Africa there are two main international filing systems, to wit OAPI for some French speaking African countries, and ARIPO for some English-speaking countries. In addition, understanding the peculiarities of each jurisdiction, identifying the legal support available there, and reviewing the international needs of each jurisdiction, are all advisable to ensure success.



Santiago Mosquera

Mosquera: Implementing IP rights across multiple jurisdictions can be a complex and challenging task because different countries have different laws and regulations (territoriality principle), which can make it challenging for companies to ensure that their IP rights are protected in each jurisdiction they operate in. As a result, companies may need to engage lawyers who are familiar with the laws and regulations in each country to navigate these differences, adding complexity and costs to the company. In this regard, filing requirements for IP rights can vary significantly from one jurisdiction to another, even in the same region, leading companies to file separate and with very different applications in each country they operate in.

Even if a company's IP rights are recognised and protected in multiple jurisdictions, enforcing these rights can be difficult because – in the same sense as the laws – enforcement mechanisms differ from one country to another. The legal process for enforcing IP rights can be slow, costly, and complex in a country but, in another, the same process can be quick and easy, which can impede companies' efforts to take legal action or give effective and uniform instructions against infringers.

“Even if a company's IP rights are recognised and protected in multiple jurisdictions, enforcing these rights can be difficult because – in the same sense as the laws – enforcement mechanisms differ from one country to another.”
- Santiago Mosquera -

Q3. What challenges exist for those implementing their intellectual property rights across multiple jurisdictions? Are there any best practice procedures they should follow?



Santiago Mosquera

In addition, language barriers are a major challenge for companies because they make it harder to communicate effectively with government agencies, legal professionals, and other stakeholders in different jurisdictions.

In general, enforcing intellectual property rights in multiple jurisdictions requires careful planning, investment, and expertise because implementing IP rights across multiple jurisdictions is expensive and resource-intensive, companies may need to invest in legal services, technology, and personnel to ensure that their IP rights are protected effectively in each jurisdiction.

However, these obstacles can be lessened if the company is supported by a reliable law firm with specialised connections and alliances in each country. Utilising this network, these professionals can efficiently draw up strategies for the defence and implementation of IP rights in multiple jurisdictions of interest with minimal impact for the client in terms of time, cost and concern.



Herman van Schalkwyk

Schalkwyk: A one-size-fits-all approach across multiple jurisdictions seldom works. IP owners need to understand the markets they are entering and align their IP strategies with their commercialisation strategies in the different markets. Few companies are able to expand into multiple jurisdictions simultaneously and a focused strategy is key. IP owners also often set ambitious goals to enter foreign jurisdictions and, as a result, pursue large IP portfolios that generate significant costs over their lifetime. A well-executed IP strategy that results in a smaller but fully utilised IP portfolio is likely to lead to better returns than an extensive but dormant portfolio. IP owners need to analyse their strategies critically to ensure that their portfolio supports the anticipated avenues of commercialisation given the nature of the business. IP owners should strengthen the relationship with their IP attorneys so that the registration of IP is not isolated from the rest of the business.



Risti Wulansari

Wulansari: IP owners who implement their IP right across multiple jurisdictions have to carefully consider conflicting views related to the regulation and laws applicable in each country. For example, parallel importation is considered legal in the U.S., while it is generally prohibited in Indonesia. Thus, it is essential for IP owners to have a proper understanding on the nature of the IP regulations and laws in each of the countries of interest.

The best procedure to mitigate this challenge (which most of the time is what we would suggest to our clients) is by engaging local intellectual property consultants, so they can guide the IP owners through the intricacies of each jurisdiction and help to develop a comprehensive strategy on IP protection and enforcement.



Sumi Nadarajah

Nadarajah: The differences in legislation concerning intellectual property rights, how they are recognised, and how they are enforced in different jurisdictions create challenges for IP rights holders.

For example, the first-to-file and first-to-use trademark registration systems can cause difficulties. In the first-to-file system, the first party to file the trademark application owns the superior right – even if the Mark has previously been used by another party (the only exception being well-known trademarks which are treated differently). Jurisdictions such as China, Japan and the EU, among others, use the first-to-file registration system. The first-to-use system confers rights on the first party to actually use the trademark even if it has not been registered. This is recognised in jurisdictions such as the U.S., Canada, Australia, the UK and Ireland.

Q3. What challenges exist for those implementing their intellectual property rights across multiple jurisdictions? Are there any best practice procedures they should follow?



Sumi Nadarajah

Similarly, there are differences regarding the concept of series trademarks. These are multiple trademarks with similarities such as different versions of a logo with features that are very much alike. In the EU, for instance, a brand comprising different colours would have to be filed via separate applications to cover the different colours involved. Meanwhile, in Ireland, applications for series trademarks are accepted.

Additionally, the examination process varies among jurisdictions. To illustrate, the Intellectual Property Office of Ireland (IPOI) examines trademark applications on both relative and absolute grounds. On the other hand, the European Union Intellectual Property Office (EUIPO) examines trademark applications only on absolute grounds. This means prior trademark owners must oppose third parties' potentially conflicting applications to protect their prior rights.

Moreover, trademarks considered inherently distinctive and registered in one country may be refused in another for being "descriptive".

The above can result in a brand owner having different levels of protection for their trade marks in different jurisdictions – which often leads to difficulties when it comes to enforcement against trademark infringement in the different countries.

Best practice for trade mark owners would be to file the word mark in as many jurisdictions of interest as possible. This generally provides the broadest form of protection against infringement irrespective of any logos or stylisation of the mark.



Franco Oriti

Oriti: Patents of invention filed in Switzerland also automatically cover the territory of Liechtenstein and vice versa. This is not valid for trademarks and designs, which must be filed separately in Switzerland and Liechtenstein.

Q4. How can companies better manage their IP in an increasingly digitalised environment?



Chinyere Okorocho

Okorocho: Invest in an effective intellectual property management software system. There are many options in the marketplace today and they are invaluable in the sense that they assist in the management and centralisation of databases of trademarks, patents etc., as well as for up-to-date client or product information, ownership, licenses etc. They can also be used to automate forms and correspondence for new and on-going intellectual property ownership, and even assist with the tracking of potential infractions of IP rights for prosecution. Most software utilise a case management system which enables you track the lifecycle of the IP asset.

In addition to the above, outsourcing your intellectual property portfolio management to a competent third party is always an option that should be considered. Most IP firms invest in this software, and this improves efficiency.

Q4. How can companies better manage their IP in an increasingly digitalised environment?



Santiago Mosquera

Mosquera: Companies can establish an IP management system to manage their assets. This can help them to identify their IP assets, monitor their use, and track their value.

To fulfil this task, it is possible to use online monitoring tools to track their digital assets and identify any unauthorised use or infringement. Furthermore, these tools can monitor social media, e-commerce platforms, and file-sharing networks. With the development of technology, it is now possible for companies to use digital technologies such as encryption, digital watermarking, and digital rights management to protect their digital assets and mitigate the risks of unauthorised use and distribution of their IP assets.

Additionally, companies can conduct regular audits to identify any gaps in their IP portfolio and assess the risks and opportunities associated with their assets to detect possible infringements, take the necessary measures of protection, as well as to generate a new IP asset protection strategy. In fact, most IP law firms usually maintain local, multi-jurisdictional and worldwide IP watching services available for the proper care of their clients' assets. In this regard, the use of technological tools that facilitate the monitoring of applications filed before trademark offices is increasing, as well as market and social media monitoring services where more accurate results are evidenced every day.



Herman van Schalkwyk

Schalkwyk: As a first step, a company needs to understand what constitutes IP and the risks within their organisations that could devalue their IP. Many companies are not aware of the different forms of IP and their value to the organisation outside of the well-known forms like trade marks, patents and copyright. Although data has always been valued by organisations, the rise of AI is elevating discussions around data to the boardroom level as organisation become more data centric. It is therefore important to understand the distinction between the output of data processing in the form of material embodiments, like compiled databases, and the underlying data.

Data is a protectable interest but South African case law seems to suggest that it may not be capable of being owned. This is different to material embodiments of data, which are generally protected by copyright law. Most companies are probably already integrating their information technology systems with those of suppliers and service providers through APIs, for example. It is critical that entering into agreements protect the inherent value of the data and deals with any potential ownership issues that may arise from processing the data. Companies should also be mindful where external service providers – such as data engineers, data analysts, machine learning engineers and designers – are used, to ensure that they take written assignment of the copyright. It is best to regulate the ownership of IP contractually upfront before any development takes place. The contact should also address issues such as licensing, business continuity, restraints, and confidentiality, to name a few.



Risti Wulansari

Wulansari: Companies can better manage their IP in a digitalised environment by developing a management strategy that should include guidelines for protecting, enforcing, and monetising IP assets. Besides that, they need to develop monitoring systems to detect and respond to online infringements of their IP.

Further, they also have to continuously review and update their IP portfolio to reflect changes in the digital landscape. Lastly, they need to regularly assess the relevance and value of their digital IP assets and consider filing new applications or abandoning out-dated assets if necessary. Maintaining accurate records of registrations, renewals, and licenses, as well as keeping abreast of changing regulations and laws for IP rights to ensure compliance with relevant regulations are also important.

By implementing these strategies, companies can better manage their IP in the digitalised environment, protect their digital assets, and maximise the value of their portfolio.

Q4. How can companies better manage their IP in an increasingly digitalised environment?



Tian-ying Zhao

Zhao: The increasingly digitalised environment is both a blessing and a curse for IP management. It has provided companies with better access to records of IP registrations of their own and others. At the same time, as the market-place is increasingly digitalised, it is a lot easier for companies to learn about the activities of other market players, both competitors and infringers. Overall, the digital world exposes companies to higher transparency and a great amount data, offering them an opportunity to gain a better understanding of their IP and market positions. To grasp this opportunity, companies are advised to set up a system to gather, analyse and utilise IP intelligence, so that decision makers can develop effective IP strategies.

The ever expanding digital world also causes problems, as it has benefitted the counterfeiting business as well. Take the example of China, the country has emerged as the largest logistics market in the world. An extensive network of warehouses and storage facilities, advanced IT services, and labour at extremely low-cost, all give rise to a booming e-commerce business, both domestic and cross-border. Counterfeiters have relocated themselves from roadside stalls and retail & wholesale markets to the virtual space. The operating costs are lower than ever, and counterfeits are quickly delivered to every corner of the world. This has created new challenges for IP management. Companies are suggested to establish a programme to monitor the online environment, which may cover websites, e-commerce platforms, social media, mobile apps, etc., to detect infringing activities, and take suitable actions accordingly.



Sumi Nadarajah

Nadarajah: While trade has become more international, and regional economic integration has led to the dismantling of borders in order to ease trade flow, efforts to combat piracy and counterfeiting have been lagging behind. Advancements in technology can facilitate piracy, counterfeiting and other IP infringements. At the same time, as digital consumers, we are constantly faced with the phenomena of user-created content online, mash-ups and access to digital culture. There are also challenges of piracy and the emergence of disruptive technologies. In the digital age, the issue of piracy and counterfeiting is particularly important. Unauthorised data sharing, integration, utilisation and public disclosure are the biggest areas of concern.

The continuing development of technology and the global expansion of the internet have made it easier to obtain information about products, including high-tech goods, like pharmaceuticals, computer chips, software, etc. Unfortunately, new manufacturing technologies, such as 3D-printing, make the production of pirated goods easier than ever. However, the internet's anonymity and lack of borders create an ideal environment for IP infringement. Worryingly, infringements are increasingly committed by cross-border criminal groups, which use the internet for organisation, distribution, customer care and online payment, thus making it very difficult for rights owners to enforce their rights by turning to courts of law and initiating civil proceedings against infringers.

IP protection in the digital economy involves knowledge of how to effectively manage intangible assets and combat infringement. Right holders should ensure that all their relevant IP is registered. In addition, they should invest in Digital Rights Management (DRM) software for copyrighted works which assist right holders to limit or bar the copying, editing, saving, sharing, printing, and even screenshotting of digital content. Essentially, right holders should actively assert their rights against infringement.



Franco Oriti

Oriti: Always try to be recognised for the IP services provided by filing at least a trademark and protecting a corresponding domain name.

Q5. What risks do digital IP portfolios, such as those filed for virtual environments, present to their owners?



Chinyere Okorocha

Okorocha: Digital IP portfolios, particularly those filed for virtual settings, expose their owners to several hazards. For starters, the ease of unlawful usage and infringement in virtual settings is increased since digital assets, when not properly protected, may be easier to reproduce and distribute without sufficient authority. This makes it difficult for owners to defend their intellectual property rights and prohibit unlawful copying or dissemination.

Secondly, piracy and counterfeiting are significant threats to digital IP portfolios. Digital assets are readily replicated and disseminated, resulting in income loss, reputation harm, and a decrease in the value of IP assets.

Another challenge in virtual settings is complex ownership and licensing concerns. Multiple contributors and ambiguous agreements can lead to ownership and usage rights issues, posing legal problems for IP owners.

Finally, the legal and regulatory environment for digital IP is always changing and ensuring compliance across multiple jurisdictions can take a lot of time. Keeping up with changing copyright, trademark, and patent rules in virtual settings may be difficult. Failure to comply may result in lost opportunities, legal dangers, or restrictions on the enforcement of intellectual property rights.



Risti Wulansari

Wulansari: The risk of digital IP portfolios which are filed for virtual environments to their owners are:

- Digital IP assets can be infringed and misused without authorisation in virtual environments. This includes unauthorised copying, distribution, or modification of virtual items, or other digital content.
 - Digital IP assets may be copied and imitated due to the ease of digital reproduction and distribution in virtual environments without the owner's consent.
 - The ownership and control of digital IP assets may be governed by platform or service providers' terms of service or end-user license agreements. This can limit the owner's control over their IP assets and may introduce the risk of unexpected restrictions or limitations on usage and monetisation.
 - Virtual environments are subject to rapid technological advancements, and platforms or technologies may become obsolete over time. This poses a risk to the longevity and accessibility of digital IP assets, potentially rendering them unusable or incompatible with future technologies or platforms.
 - Virtual environments often cross-national boundaries in which the complex navigation of the legal frameworks and enforcement of IP rights across different jurisdictions can complicate the protection and enforcement of digital IP portfolios.
 - Standardised mechanisms for protecting digital IP assets in virtual environments may be lacking or still evolving in some jurisdictions. This leads to legal uncertainties and gaps in protection.
 - Virtual environments often involve the collection and processing of user data. Data breaches or unauthorised access to user data can result in legal and reputational consequences for IP owners.
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Franco Oriti

Oriti: You may have increased risks if you have just one backup and do not have a disaster-recovery procedure tested at least every three months.

Q6. What are the best practice procedures for managing large IP portfolios?



Chinyere Okorocho

Okorocho: Managing large IP portfolios effectively requires implementing several best practice procedures. Here are some key practices that I have utilised over the years:

Maintaining centralised IP database management: A crucial aspect of portfolio management is creating a single system or platform to monitor and control the whole IP portfolio of several clients. This makes it possible to organise, retrieve, and analyse IP issues with efficiency, guaranteeing thorough supervision and effective management.

Routine IP portfolio review: It is also important to regularly assess important aspects about each IP asset, such as registration information, renewal dates, licensing arrangements, and related expenses. This aids in keeping track of and proactively managing important deadlines and responsibilities.

Comprehensive IP protection strategy: It is critical to define a clear strategy for prioritising intellectual property protection activities based on corporate objectives, market realities, and the competitive environment. Therefore, businesses have to ensure wide protection across all regions they operate in and also endeavour to register defensive marks in territories they would likely access to avoid issues in the future.

Cross-functional collaboration: This is critical both internally and externally. Internal context focuses on collaboration between the IP owning organisation's legal, R&D, marketing, and business development divisions in creating and commercialising IP assets. It is critical to work with foreign attorneys and agents who can assist with IP prosecution, brand protection, and liaison with local IP enforcement agencies in situations of infringement.



Santiago Mosquera

Mosquera: It starts with the formation of a strictly specialised IP team of professionals, whom should be trained and should have the necessary expertise to manage the various aspects of the specialised portfolio. This includes patent and trademark applications, IP litigation, licensing, and enforcement as they will be in charge of managing and supervising regular audits on the IP assets and cases that are being handled in the company or by a correspondent for the company.

This should be accompanied by a series of policies and procedures that are consistent and effective in the management of IP assets. For this, companies should use technology, such as IP management software, which helps to automate routine tasks, track deadlines, and provide real-time data on the status of IP assets. Finally, companies must always monitor industry trends, competitors, and the market to identify potential infringements, potential clients, and opportunities to maximise the value of their IP portfolio.



Risti Wulansari

Wulansari: The best practice procedures are:

- Conduct portfolio assessment and develop an IP management strategy to remain aligned with the company situation (i.e. acquisition, maintenance, enforcement, and monetisation strategies).
- Establish a centralised system or database to track and manage all IP assets and maintain accurate records of filing dates, registration numbers, renewal deadlines, and other key information for each IP asset.
- Conduct regular reviews of the IP portfolio to evaluate the relevance, value, and potential risks associated with each asset.
- Maintain clear documentation and record keeping for each IP asset.
- Establish a robust system to monitor renewal deadlines and maintenance requirements for all registered IP assets and regularly review the status of the IP assets.

Q6. What are the best practice procedures for managing large IP portfolios?



Risti Wulansari

- Keep abreast of changes in IP laws, regulations, and industry practices that may impact the management and protection of IP assets.
- Monitor competitor IP activity, industry trends, and emerging technologies to identify opportunities or risks for the IP portfolio.



Sumi Nadarajah

Nadarajah: Successful IP portfolio management involves a larger scale of decisions, starting from product research and development, through the patent/trademark application, prosecution, enforcement, and until the end of life of the product or until the patent has expired (or the brand no longer in production). In addition, at each stage of the IP lifecycle (i.e. from filing to payment of post-grant annuities or renewal of TM registrations), the portfolio manager has to interact with clients, attorneys and IP offices. Concerns with respect to receiving timely instructions from clients and prompt responses from foreign attorneys often arise. Moreover, interacting with different foreign IP offices can become challenging due to language and time barriers, which can often add to the difficulties faced. Finally, a key requirement for the effective management of a global IP portfolio is having a network of reliable, knowledgeable and efficient associates in jurisdictions around the world that share the goals and values of the portfolio manager.



Franco Oriti

Oriti: Webtools are always increasing and are always more efficient but it is very difficult to find “one secure and easy webtool” that possesses all IP services in one unique platform.

Q7. Why is effective due diligence across a company's IP a necessity before any potential M&A transaction?



Chinyere Okorocho

Okorocho: We always advise clients to do effective due diligence before an M&A for the following reasons. It aids in determining the genuine worth of a company's intellectual property assets, allowing for informed discussions and decision-making throughout the sale. A detailed IP investigation also aids in the identification of possible risks and liabilities, such as disputes, litigation, and infringement claims, thereby avoiding legal, financial, and reputational concerns.

The purchasing business can also determine if the target company's intellectual property assets conform with applicable laws, regulations, and industry standards. This aids in the identification of any possible non-compliance concerns that may provide risks or obligations to the purchasing entity after the acquisition. They can also assess its ability to generate income and profits. There is also the possibility of identifying possible integration possibilities between the IP portfolios of the buyer and the target firm. This evaluation aids in the development of post-transaction plans to maximise the combined IP assets' value in the merged firm.

These issues are international principles which are useful for both local and international M&A transactions that we deal with.

Q7. Why is effective due diligence across a company's IP a necessity before any potential M&A transaction?



Herman van Schalkwyk

Schalkwyk: Due diligence serves to assist an acquiring company in making informed decisions. It is not only about mitigating risk from the acquiring company's perspective but also about understating the value of the company's IP. The company's IP plays a critical role in protecting the company's unique competing space in the market. Understanding this unique competing space and the strength of its boundaries that keep competitors out is essential for a successful M&A transaction. The acquiring company needs this information in order to devise successful strategies in its efforts to maximise the return on investment.

An effective due diligence also goes beyond the registered and unregistered IP rights in the portfolio of the company and also investigates aspects such as ownership, which is sometimes taken for granted. Insofar as ownership is concerned, it is important to consider how ownership transfers in respect of each of the different forms of IP. The complexities around ownership are often overlooked as it is simply assumed that the company owns what looks like their IP at face value. Although the aspect of ownership of IP is particularly important in early-stage companies where the founders may have recently left their previous employers during which the idea for the new company was born. It is also often neglected in mature companies where external service providers typically create IP in the absence of agreements that adequately cover the complexities around the ownership of IP.



Risti Wulansari

Wulansari: It is important to conduct effective IP due diligence before an M&A transaction takes place because it would allow the acquiring company to identify and evaluate the target company's IP assets and provide a comprehensive understanding of the IP portfolio's size, scope, and value. It would also help to verify the target company's ownership of its IP assets and assess the validity and enforceability of those rights. Moreover, it ensures that the target company has the necessary licenses, permissions, or assignments to use and protect its IP.

Further, IP due diligence is essential to mitigate risks, make informed decisions, and ensure that the acquisition aligns with the acquiring company's strategic goals. It helps protect the acquiring company's interests, enhances the valuation process, and facilitates a smoother integration of IP assets post-transaction.



Tian-ying Zhao

Zhao: IP due diligence is the process to identify and evaluate the IP owned or used by a target company to find out what IP will be involved in the transaction, what value such IP may bring, and what risks are out there. Therefore, IP due diligence is extremely important for the buyer in deciding whether to acquire a company and how. A thorough IP due diligence should investigate into all registered and unregistered rights (e.g. patents, trade secrets, trademarks and copyrights) and their chain of title, IP licenses and any other agreements involving IP clauses, as well as all past, ongoing and potential litigation related to IP. A freedom-to-operate analysis should also be conducted on the products, processes and commercial signs used by the target company.

Ineffective due diligence may result in adverse consequences of all kinds. To give an example, a client of mine came to me with the assignment papers signed by the seller after completing an acquisition, asking me to file a number of trademark assignment applications in China. One of the assignment applications was rejected by the China National Intellectual Property Administration (CNIPA) on the ground that a similar trademark owned by the assignor was not assigned to the client at the same time. The Chinese Trademark Law requires assignment of trademarks owned by the assignor, which are confusingly similar to each other, all at once, otherwise the assignment will be rejected. Unfortunately, one of the trademarks owned by the seller was missed out in the M&A deal. By the time the CNIPA issued a rejection notice, the seller has dissolved and the client could not find anyone to sign additional documentation.

Q7. Why is effective due diligence across a company's IP a necessity before any potential M&A transaction?



Sumi Nadarajah

Nadarajah: IP due diligence commonly arises in an M&A situation where owners attempt to assert the value in their business, and purchasers are trying to ascertain the value of the deal. It's a crucial step which protects all parties in any commercial deal. Studies of the valuation market have shown that approximately 70% of a typical company's worth lies in intangible assets. With such a huge proportion of a company's value being attributable to intangible assets, it makes sense for both the buyer and the seller to check what's on the table and conduct thorough IP due diligence.

Q8. How important is a prior art search in filing any form patent?



Santiago Mosquera

Mosquera: Prior art refers to any information that has been made available to the public before the date of filing a patent application. This disclosure may be explicit (e.g., in a scientific publication or patent) or implicit (e.g., through the sale or public use of a good incorporating the invention or its process).

It is an essential step in filing any form of patent because it helps to ensure that the invention is novel meaning that it is not already known or publicly available, which makes it more likely to be eligible for protection; patentable; and does not infringe on the rights of others.

For an invention to be considered non-obvious, it must involve a significant advance in the prior art and not be obvious to a person skilled in the art at the time the patent application is filed. The invention must not be something that a person skilled in the art would have considered obvious from what is already known. Therefore, it is necessary to do a thorough search of the prior art to compare the proposed invention with what is already known in the field.

Additionally, it can help to identify any potential patentability issues, giving applicants the opportunity to refine their invention and increase the chances of the patent application being granted. Finally, it can also help to identify any potential infringement risks that may be relevant to their invention minimising the possibilities of the patent owner taking legal action against the company for having manufactured, sold, used, or imported a patented product or process without the patent holder's permission. In summary, patent infringement can have significant legal and financial consequences, which can be minimised through a thorough search of the prior art.



Herman van Schalkwyk

Schalkwyk: Conducting prior art searches prior to filing is advisable but not always feasible for whatever reason, be it time constraints, budgets, or other factors. A pragmatic approach is to consider the expertise of the inventors. Where an invention falls within the core field of expertise of the inventors, they are more likely to have a thorough appreciation of the state of the art in that industry. In contrast, the risk increases where inventors invent outside of their core field of expertise. In such instances, it is highly advisable to conduct prior art searches prior to filing the first patent application or at least before filing a PCT application.

Alternative strategies to get a search and patentability opinion should also be explored. A popular option is to file the priority application in an examining jurisdiction, such as the UK or the Netherlands, which offer the option of receiving a search report and patentability opinion during the initial 12-month period. The search results can then be used to determine whether it is worthwhile proceeding with the filing of the PCT application. Prior art searching also plays an important role in the drafting of the patent specification, which could reduce prosecution costs in getting the patent application to grant.

Q8. How important is a prior art search in filing any form patent?



Risti Wulansari

Wulansari: A prior art search is a crucial step in the patent pre-filing process, as it helps assess the preliminary view on the novelty of the invention, which element is fundamental when it comes to assessing a patentability. Further, a prior art search allows the applicant to compare their invention with existing technologies and determine if it involves an inventive step that is not obvious to a person skilled in the relevant field. Thorough prior art search enables the applicant to draft a stronger and more targeted patent application and it can help anticipate and address potential objections or rejections from patent examiners.

To sum up, prior art search would help to assist the inventor(s)/applicant(s) in foreseeing whether it is worthwhile for them to pursue filing a patent application upon their invention.



Tian-ying Zhao

Zhao: Prior art search helps applicants to identify novel and inventive features in their innovations, and define scope of protection in patent claims smartly, so that the risk of rejection and the number of office actions are both reduced. As a result, the costs for responding to office actions and amending claims will be reduced, and no resources will be wasted on applications that are not likely to be granted.

Yet, the importance of prior art search is a lot more than the above. It informs a company of their position in the landscape of technical development and market competition. By learning what else is out there, the company can better understand the potential value of their invention, as well as the risk of infringement associated with utilisation of same, and then adjust their R&D plans and IP strategies accordingly. For example, if an invention is found to fall with the protection scope of the patented invention of another party, the company may decide to “design around” to avoid infringement, or gain access to the said patent through licensing or cross-licensing.



Sumi Nadarajah

Nadarajah: Every invention must meet three basic criteria for being eligible for patent protection: novelty, utility, and non-obviousness. Out of these three, novelty – which means that the invention is new and has not been published anywhere – is the most important. Innovators must determine the novelty of their inventions before filing patent applications. Prior art searches that show all the existing prior arts related to their inventions need to be carried out.

Besides helping in determining novelty, prior art searches can be used to generate ideas for research and development (R&D). Also, one may avoid duplication of research, reduce R&D investment significantly, and develop new technical solutions to problems. Moreover, they may evaluate a specific technology and plan new products. Furthermore, it helps to find legal status of patent applications, keep abreast of new technological trends, monitor competitor’s research activities. Without a prior art search, you will be operating in an information vacuum and will not be able to form an educated opinion about whether you can patent your invention.



Franco Oriti

Oriti: Considering a prior art is always suggested before filing a patent.

Q9. What strategies can patent holders implement to protect their IP?



Santiago Mosquera

Mosquera: Patent holders should implement employee education and policies to ensure that their workers know and are aware of the importance of patents and their value as an asset for the company. This can prevent accidental disclosure of confidential information and reduce the risk of IP theft. Also, they should regularly monitor the market to identify any potential infringement of their patent rights. This can include monitoring competitor products and services and conducting regular searches of publicly available patent databases such as Patentscope or Google Patents.

The holders can file for international patent protection to protect their rights in multiple jurisdictions. Secondly, if they find that their IP rights have been infringed, the patent holder can enforce their rights through litigation, mediation, or negotiation. They could even license their patent to third parties for a fee – thus generating revenue from the patent and increasing its exposure in the market. They can also use trade secret protection to shield confidential information, such as formulas, algorithms, and processes.



Risti Wulansari

Wulansari: The following are the strategies that patent holders can implement to protect their IP:

- Regularly review new products, technologies, and patent filings in relevant fields. If an infringement is found, take appropriate legal action to enforce the patent rights, such as sending cease and desist letters, initiating patent litigation, or negotiating licensing agreements. The patent holders could always consider engaging professional infringement monitoring service to help tracking the potential infringement against their patented technology.
- When engaging in discussions or collaborations with third parties, use NDAs to protect the confidentiality of your pending patent.
- Seek patent protection in countries where the technology is being used, manufactured, or marketed. This helps extend the patent holders' rights and provides a legal framework for enforcement in multiple jurisdictions.

Q10. How do you believe IP rights and laws can be strengthened in your jurisdiction?



Chinyere Okorochoa

Okorochoa: A multifaceted strategy comprising legislative changes, institutional capacity development, enforcement mechanisms, and public awareness campaigns is required to strengthen intellectual property rights and enhance legislation in Nigeria. I have highlighted the most important concerns below.

Legislative reforms: Nigeria has made a good start by revising the Copyright Act and enacting new legislation. However, it is critical that all other outstanding laws, which are truly archaic, such as the Patent and Designs Act, the Trademarks Act, and other applicable legislation, are revised to meet developing concerns and offer stronger protection for intellectual property rights.

Enforcement mechanisms: There are no IP-focused judges in Nigeria. There is a need for IP law training for judges to guarantee that judgments are given with the proper understanding of the complexities of IP law. Furthermore, effective coordination between law enforcement agencies, customs officials, and IP rights holders is required to combat counterfeiting, piracy, and other IP infringements.

Institutional capacity building: Strengthening the ability of government entities responsible for IP protection – such as the Nigerian Copyright Commission (NCC), the Trademarks, Patents, and Designs Registry, and others – is another critical step in the right direction. Without enough resources, training, and technology to manage registration, examination, enforcement, and dispute resolution processes, Nigeria's IPR system will never reach its full potential.

Q10. How do you believe IP rights and laws can be strengthened in your jurisdiction?



Chinyere Okorochoa

Other issues to consider: Other essential steps that must be taken to strengthen IP rights and laws in Nigeria include launching public awareness campaigns, working with international partners, supporting technology and innovation, improving border controls, involving industry stakeholders, reviewing international treaties, and putting in place a strong monitoring and evaluation system.



Herman van Schalkwyk

Schalkwyk: The rapid advancement of technology in this digital era is placing significant strain on IP laws globally, and South Africa is no exception. South Africa has strong IP laws, but they require amendment to remain relevant in the modern era. The legal questions around inventorship and ownership of AI generated inventions are but one example of how IP laws that have withstood challenges over decades are suddenly struggling to keep up in some areas of the modern world.

The exclusions from patentability listed in section 25 of the Patents Act probably require reconsideration too. For example, a scheme, rule, or method for performing a mental act, playing a game, or doing business, and a program for a computer are specifically excluded from patentability. The impact of these exclusions is likely very different to what was originally intended in the mid to late 20th century.

The South African Designs Act faces a similar challenge as it arguably struggles for relevance in a digital world. Although there are opposing views on whether the scope of the Designs Act extends beyond tangible articles, an amendment to the definition of an article to move away from the phrase “an article of manufacture” would be welcomed. An amendment to clarify that digital ‘articles’ are covered should ideally also address uncertainties around dynamic designs, such as animations. This may require us to reconsider the manner in which designs are represented and submitted to the Designs Office. An expansion to allow for the registration of multiple designs in a single registration and the removal of the limitation that a registered design is enforceable only in the class in which it is registered would also go a long way in increasing the impact of registered designs in an increasingly digital economy.



Tian-ying Zhao

Zhao: Nowadays, one of the biggest problems faced by businesses when filing trademarks in China is that the country’s trademark registry is so large that it is very difficult to have their trademarks registered. By the end of 2022, there were 42,972,000 valid registrations in the country. It is not uncommon for one to receive a refusal notice, in which five or more prior marks are cited. Certainly, some of the prior marks are not being used and can be overturned through non-use cancellation or purchased assignment, but many others have been either filed recently or used in commerce, and are not easy to overturn.

The trademark registry is huge, but is it too ‘crowded’? My answer is no. The size of the registry is not to be blamed, but rather the trademark examination rules are. China has adopted a Classification of Similar Goods and Services (Classification), in which goods and services in each class are further divided into subclasses, and similarities among them are clearly defined. When processing an application, trademark examiner does not assess the similarity between goods/services, but simply makes a determination based on the Classification. The Classification is crude and unreasonable in many places. For example, “photocopying services” and “search engine optimisation for sales promotion” are classified into the same subclass, and are considered similar services. As a result, similar trademarks being used in totally different industry sectors may not be allowed to co-exist.

Q10. How do you believe IP rights and laws can be strengthened in your jurisdiction?



Tian-ying Zhao

The Chinese Classification system has been developed to increase efficiency and fairness. Examiners do not need to spend time on accessing similarity of goods/services on a case-by-case basis. At the same time, every application will be treated based on the same standards. However, as the size of the registry grows, the system has become increasingly cumbersome. It is time to abandon the Classification, and allow examiners to determine the similarity between goods/services based on market reality, so that more business entities can have their commercial signs protected through trademark registration.



Sumi Nadarajah

Nadarajah: Ireland has in place a strong legal framework and intellectual property system that offers IP right holders the opportunity to be rewarded for their creativity and innovation and enabling society at large and the economy to benefit from their achievements. Formal IP rights include patents, trade marks and industrial designs so called because they can be registered. Copyright is a different type of intellectual property relating to creations of the mind and is seen in everyday life in creative works such as books, films, music, art and software, as well as in more mundane objects such as cars, computers and medicines. Other types of informal IP rights include plant variety rights, geographical indications of origin, trade secrets and topographies of integrated circuits. The Intellectual Property Unit of the Department is responsible for Ireland's policy and legislation on IP that reflects developments in intellectual property policy and practice domestically, at EU level and in terms of international obligations to which Ireland is committed through various international agreements. In addition, the Intellectual Property Office of Ireland is responsible for the granting of patents; the registration of industrial designs and trade marks; and has certain functions in relation to copyright and related rights.

Ireland would benefit from specialised IP courts and certainly would benefit from the ratification of the UPC Agreement. This would incentivise rights holders to enforce their rights more rigorously in this jurisdiction.

Q11. What is the litigation procedure for patent breaches, and what risks are companies exposing themselves to in such an undertaking?



Santiago Mosquera

Mosquera: In Ecuador, according to Article 293 of the Organic Code of the Social Economy of Knowledge, Creativity and Innovation (COESCCI), the owner of a patent has the right to prevent third parties from making, offer for sell, selling, using, importing for these purposes, the patented product without the owner's consent.

The patent holder must initiate an administrative proceeding for infringement of its industrial property rights. The administrative protection action starts with the filing of a lawsuit requesting the inspection of the place where the goods are located or where the process has taken place and, if applicable, the retention of the goods protected by the patent. This action will be admitted for processing upon payment of official fees.

Likewise, if the infringement action relates to a patent whose subject matter is a process for obtaining a product, it shall be for the defendant to prove that the process used to obtain the good is different from the process protected by the patent alleged to have been infringed.

In this sense, the infringement of a nationally registered patent is regulated by Article 208A of the Organic Integral Criminal Code, and may have significant legal consequences if the person with conscience and will has violated IP rights for profit and on a commercial scale. Penalties include:

- Imprisonment from six months to one year.
- Confiscation and fine of up to US\$135,000.

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