



Introduction to Asian Intellectual Property

Welcoming remarks will begin at
11:55 a.m. Eastern Time.

The formal presentation will begin at noon.

For audio, dial in by phone:

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Access code 5627649



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Learning Objectives:

- Watchouts for U.S. practitioners when drafting patents for Asia
- Strategies for reporting data in the specification
- Asian prosecution overview
- Asian prosecution strategies

Introduction to Asian Intellectual Property

Presented by:

Michael Lin
Marks & Clerk Hong Kong

Questions?

**We will be taking questions during a
designated question and answer period at
the conclusion of the presentation. Please
hold all questions until this designated
period.**



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Thank You!

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Introduction to Asian Intellectual Property

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AUTM Webinar
April 19, 2012
noon-1:30 PM EDT

Agenda:

- Michael Lin Introduction
- Asia Introduction
- Asian Intellectual Property
- China, India, Japan, Philippines tips
- Asia Patent Drafting tips...Data, Data, Data
- Enforcement

Michael Lin: Who is this guy?

- ABC (American Born Chinese)
- UC Berkeley (Biochemistry)
- Really, really terrible scientist
- Boston University Law
- Procter & Gamble Japan 10 years
- Procter & Gamble China 3.5 years
- Marks & Clerk HK 1.5 years

Asia's 40+ countries include:



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Population: (2010 estimates)

- China: 1.33 Billion
- India: 1.17 Billion
- (cf. US: 300 Million)
- Indonesia: 240 Million
- Pakistan: 184 Million
- Bangladesh: 156 Million
- Japan: 126 Million
- Philippines: 99 Million
- Vietnam: 90 Million
- Thailand: 67 Million
- S. Korea: 48 Million
- Malaysia: 28 Million
- Taiwan: 24 Million
- ...etc.



Total: ~ 3.7 Billion



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Economies (2011 est., GDP):

China: 2nd largest economy

India: 3rd largest economy

Japan: 4th largest economy

Philippines: 33rd largest economy

China = largest English-speaking population

Asian Intellectual Property:

Patents: 20y (PPHs!)

Designs: CN: 10y, IN: 10+5y, JP: 20y, PH: 5+5+5y

Utility Models: CN: 10y, JP: 10y, PH: 7y

TMs: Unlimited, subject to cancellation

(generic, non-use); 3D TMs possible but rare

Asia is always First-to-file, 18 m pub for patents,

China-specific points:

TM & Domain names: squatters rampant, very difficult

Sup. Ct. strengthening TM (Dec. '11):

- SAIC consider bad-faith, actual intent when granting TM applications
- Breadth depends on brand reputation, distinctiveness
- Prior use defence vs. bad-faith registrations

China-specific points #2:

Patent, Design & UM: Typically can't amend after filing

Patent: Chemical cases will need data at filing

Patent ↔ UM conversion **not** possible

Patent: Support, Clarity = most problematic

"Made in China": patents need FFL

Co-Pending UM & Patent possible

UM & Design: no substantive exam

India-specific points:

SLOW, Opaque prosecution, understaffed offices,
inconsistent courts, Kurian's legacy?

©: Rising in awareness (Bollywood)

TM: weak, geographic designations limited, token use

Patents: express exam; conform to granted US/EP/JP

Patents: 1 y from 1st OA for "allowable" condition

Patents: pre- & post-grant oppositions possible

Patents: 1st compulsory lic. (Bayer → Natco) Mar. '12

Japan-specific points:

UM: No substantive exam

Patent ↔ UM conversion possible

Patent: OK to file in English follow w/ translation

Patent: Chemical cases need data at filing

TMs: English, Kanji, Hiragana, Katagana, icons, etc.

Philippine-specific points:

UM: Available for processes, compositions

UM: Novelty & Industrially applicable, no subst. exam

Patent: Conform to granted US/EP/JP claims

Patent ↔ UM conversion possible

No co-pending UM & Patent is possible

Enforcement = virtually nonexistent

Asia Patent Drafting tips...Data, Data, Data:

- Chemical cases: include Data showing efficacy and classes of molecules that work
- Include surprising benefit Data at filing
- Why? Strict New Matter Rules
- How?

• Kao's JP 2002-255736 A; JP 3717412 B2

一トの重量の7.5%以下の場合を○、7.5%超の場合を【0069】
×とした。【表1】

	高純物						比較例	
	1	2	3	4	5	6	7	8
基材シート	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系
組成(%)	PET 100	P.T. 100	PEI 100	PEI/PE 100	PEI/PE 100	PET 100	P.T. 100	PEI 100
組成(%)	1.44g/30% 0.84g/70%	1.44g/30% 0.84g/70%	1.5	10	-	1.44g/30% 0.84g/70%	2.1	1.8
密度(g/cm³)	0.08	0.06	0.07	0.02	0.02	0.06	0.08	0.14
繊維長(μm)	125	125	125	110	100	175	130	9
繊維断面積(μm²)	28	28	55	270	-	28	60	40
径長(g/m²)	38	38	45	50	38	38	20	80
透水性透過シート	744777	744777	577777	744777	744777	744777	744777	744777
径長(g/m²)	33	33	40	33	33	33	40	40
基材シート	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系	スルホン系
組成(%)	PET 100	PET 100	PEI 100	PET 100	PEI 100	-	P.T. 100	PET 100
径長(g/m²)	38	38	38	38	38	-	38	38
高純物(%)	330	690	1450	29000	330	340	40000	0.5
純性(%)	0.98	0.25	0.7	80	0.9	1.0	150	0.08
高純物濃度(g/m²)	200	220	203	183	210	220	187	233
高純物存在率(%)	57	85	95	83	63	81	75	77
使用感	○	○	○	○	○	○	○	○
メンテナンス	○	○	○	○	○	○	○	○
高純物	○	○	○	○	○	○	○	○
保存安定性	○	○	○	○	○	○	○	○
経年劣化	○	○	○	○	○	○	○	○
操作性	○	○	○	○	○	○	○	○

Asia patent drafting tips:

- Amendments very difficult/impossible later
- No CIPs - new matter is viewed very strictly
- No open-ended ranges
- Write spec in problem-solution format
- Include a technical understanding of the invention, and why preferred ranges are preferred

Enforcement:

- Limited/no discovery
- Australia, HK, Japan, Korea, Taiwan, Singapore, NZ: Relatively Predictable
- Elsewhere: Variable, low damages
- China: variable, but getting better
- China TM: AIC enforcement very effective (www.qbpc.org.cn), trade shows, customs

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- China, India, Japan, Philippines tips
- Asia Patent Drafting tips...Data, Data, Data
- Enforcement

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Apple v. Proview



iPad TM

Moral obligation vs. Legal obligation?

Q&As?

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Official Links:

CN SIPO: <http://english.sipo.gov.cn/>

CN SAIC: <http://www.saic.gov.cn/sbjEnglish/>

India IPO: <http://ipindia.nic.in/>

JPO: <http://www.jpo.go.jp/>

PH IPO: <http://www.ipophil.gov.ph/index.php>



Discussion and Q&A

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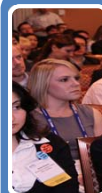
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**Save the
Date!**