



**DATE : December 3, 2006**

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**MEETING :** EXCO Meeting in Santiago de Chile, Chile

**MEETING DATE :** December 3-7, 2006

**DRAWN UP BY :** ExCo Delegates

**SUBJECT :** Activity Reports of national groups :  
Mexico, Spain, France, Belgium, Colombia,  
Finland, Norway, Greece, Sweden, Canada,  
United States, Argentina, Czech Republic,  
Singapore, Portugal, China, Switzerland, Italy,  
Hungary, Denmark, Australia, UK, Austria

**PURPOSE:** For information

**TABLED TO:** All attendees

## **Report presented by the Mexican Section of FICPI**

2 October 2006.

The Mexican Section is currently formed of nine members. Currently two more applications will be sent to the Admission Commission.

In the legislative area, we can mention that the Intellectual Property Law will establish further requirements that the parties should meet when entering a franchise agreement.

The omission of the requirements may be considered as an infringement to the law.

Also, the Mexican President signed the Trademark Law Treaty (TLT), on March 2006. At the present time, the treaty is being reviewed by the Senate for its ratification.

On 1 December 2006, President Felipe Calderon will start his new Administration, and changes in all the Mexican Agencies are expected, particularly in the Mexican Institute of Industrial Property and the Copyright National Institute.

Mariano Soní  
Delegate

EXCO/CL06/BUR/005-MX



**Report by the**  
**Spanish Section of FICPI**

**1. Transposition of the Directive on the Enforcement of Intellectual and Industrial Property Rights in Spain**

Law No. 19/2006 of 5 June 2006, the act transposing Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual and industrial property rights into Spanish law, took effect in Spain on 7 June. Amendments have been made to the Law on Civil Procedure, as well as to specific legislation namely: the Intellectual Property act, the Patent Act, the Trademark Act and the Industrial Design Protection Act.

The Act's repeal provision is extremely important, doing away with the report by the Spanish Patent and Trademark Office that had hitherto subsisted as a special procedural stage in patent nullity actions. The role of technical experts will therefore now become even more crucial.

**2. Amendment of the Copyright Act to bring it into line with the Directive on Copyright in the Information Society**

On 8 July the Official State Gazette published the Act amending the Copyright Act so as to comply with Directive 2001/29/EC on copyright and related rights in the information society. Like the Directive itself, this revision has proven to be quite controversial, and the final version does not totally satisfy any of the sectors it most closely concerns.

**3. Counterfeiting: approval of the regulations for applying Regulation no. 1383/2003 concerning customs action in Spain**

The *Official State Gazette* of 19 July 2006 published Ministerial Order No. EHA/2343/2006 of 3 July 2006, implementing Regulation No. 1383/2003 concerning customs action against goods suspected of infringing intellectual property rights.

**4. Transposition of Directive 2004/27/EC of 31 March 2004 amending Directive 2001/83/EC thereby establishing a Community code for medicaments for human use**

Law No. 29/2006 of 26 July 2006 for guarantees and the rational use of medicaments and health products transposes said European Directive and repeals Medicaments Law 25/1990 of 20 December.

This Law contains the so-called "*Bolar Clause*" inasmuch as its second last provision amends current Art. 52.1 of Patent Law 11/1986 of 20 March so that the carrying out of studies and assays for experimental purposes, necessary in order to obtain authorization for generic medicaments, shall not be considered violation of patent right.

Enrique Armijo



Paris, le 5 octobre 2006

## RAPPORT NATIONAL / FRANCE

## COUNTRY REPORT / FRANCE

### Accès à la profession de Conseil en Propriété Industrielle

Le titre de Conseil en Propriété Industrielle, sous lequel les membres de l'association nationale française de la FICPI (ACPI) exercent leur profession, est réglementé. Les pouvoirs publics envisagent de modifier les règles d'accès à ce titre.

Actuellement, cet accès est subordonné au passage d'un examen d'aptitude.

Le projet en cours prévoit que, sous certaines conditions, des personnes ayant au moins huit années de pratique professionnelle en rapport avec la propriété industrielle pourraient accéder au titre de Conseil en Propriété Industrielle en étant dispensées de l'examen d'aptitude.

L'ACPI a fait connaître aux pouvoirs publics sa position critique sur ce projet de réforme.

### Protocole de Londres relatif à la traduction des brevets européens

Le Conseil Constitutionnel a rendu le 28 septembre une décision déclarant le Protocole de Londres non contraire à la Constitution française.

Les suites qui seront données à cette décision restent incertaines quant à leur forme et à leur délai.

### Access to the profession of Industrial Property Counsel

The official title of Industrial Property Counsel, under which the members of the French national association of FICPI (ACPI) are engaged in their profession, is regulated. The authorities plan to modify the access rules to this official title.

Currently, this access is subordinated to passing an examination of aptitude.

The current project foresees that, under certain conditions, people having at least eight years of professional practice in connection with industrial property could obtain the official title of Industrial Property Counsel whilst being exempted from the obligation to take the examination of aptitude.

The ACPI informed the authorities of its critical position on this project of reform.

### London Protocol relating to the translation of the European patents

The Constitutional Council rendered on September 28 a decision declaring the London Protocol not contrary to the French Constitution.

The consequences that this decision will have remain uncertain as to their form and schedule.

# FICPI

**ExCo Meeting - SANTIAGO DE CHILE, 3-7 December 2006**

NATIONAL BELGIAN SECTION OF FICPI

## ACTIVITY REPORT

by Philippe Overath, Belgian Delegate

### 1. Implementation of the EC Directive on Enforcement of IP rights in Belgium:

EU Directive 2004/48/EC - BELGIUM

The implementation of the Directive 2004/48/EC requires amendments to a large number of regulations. In Belgium this represents an amendment to 6 laws with respect to several Intellectual Property rights, adaptation of the law relating to Trade practices and protection of the consumers and an amendment to the Juridical Code.

The implementation also requires the adaptation of Regulations on the Benelux level (Trademarks and Designs are governed by a Benelux Treaty on Intellectual Property).

The Council for Intellectual Property in Belgium has provided a substantive report on the first draft of regulations. It is the task of said Council, to provide advice, with respect to problems in relation with IP matters, to the Ministers in charge of the Intellectual Property. The Council has provided an extensive report on the 5th May 2006 about the first draft of regulation and the final draft has been elaborated taking into account said advisory report.

The working out of an Act and an explanatory memorandum relating to the implementation of the Directive 2004/48/EG is now being finalised and it is the clear aim of the Belgian Authorities to handle this matter with priority.

The situation in Belgium is followed up with the Authorities and developments will be reported as soon as available.

### 2. BENELUX CONVENTION ON IP (Trademarks and Designs)

A new Benelux Convention became in force as of the 1 September 2006.

The new Convention merely takes over the former Benelux Trademarks and Design Laws and all existing rights will be maintained as such.

However, some changes has been made to the former law such as:

- abolition of the compulsory preliminary search for Trademarks and subsequent requirement to file a request for maintaining the application,
- introduction of new "other types of trademark" category,
- abolition of the requirement to submit original documents in case of amendments.

Complete information on this new Convention can be obtained at the newly named "Benelux Office for Intellectual Property" (BOIP) at their new website [www.boip.int](http://www.boip.int).

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**From:** Castellanos y Co. [mailto:info@castellanosyco.com]

**Sent:** Thursday, October 19, 2006 11:55 PM

**To:** 'Alexandra Louage'

**Subject:** activity reports from the local groups

Dear Alexandra:

With reference to your e-mail of September 22 2006; please be advised that our local group have not had any activities.

Very truly yours,

Ximena Castellanos

FICPI Colombian Delegate

## **FICPI EXCO Meeting in Santiago, Chile 3-7 December 2006**

### **COUNTRY REPORT: FINLAND**

#### **1. MEMBERSHIP**

The number of ordinary members in the association was 107, and the number of junior members was 47 (status 20 October 2006).

The present board members elected as from 1 January 2006 are:

President: Torbjörn Lydman  
Vice-President Mirja Matilainen  
Secretary: Laura Roselius  
Treasurer: Kristiina Kaislisto  
Member: Annika Hakkila

#### **2. INTERNAL MEETINGS**

The association has held regular meetings on a monthly bases.

#### **3. MEETINGS WITH AUTHORITIES**

Two meetings with the Finnish Patent Office and a meeting with the Ministry of Trade and Industry were held.

#### **4. VARIOUS ACTIVITY**

A completed questionnaire on Protection of Industrial Designs and a questionnaire (EXCO/FR06/CET/1603) on Patent Infringement in Finland was submitted with FICPI.

FICPI resolutions 'Paris 2006' were submitted with the Ministry of Communication (Finland's 'GAC representative).

A meeting between the members of the association and the examiners of the Patent Office is scheduled to take place 9 November 2006.

#### **5. LEGISLATION**

No major changes in the IPR legislation.

23 October 2006  
Klaus Roitto, Delegate  
Hannu Halmetoja, Sub-delegate

EXCO/CL06/BUR/005-FI

**Activities of the Association of Norwegian Patent Agents  
spring / autumn 2006.**

**1. Trustees**

**a) Members of the Board:**

Jens Fr. C. Langfeldt (president)  
Turid Tronbøl  
Morten Balle  
Jan-Olav Ormberg  
Per Berg

**b) FICPI ExCo delegates:**

Kate I. Løhren (delegate)  
Jon D. Heggstad (sub-delegate)

**d) Representatives of CONOPA (Committee of Nordic Patent Agent Associations):**

Per A. Martinsen  
Knut Byklum  
Brit Alstad

**e) Committee for considering applications for FICPI membership from individual applicants:**

Lorentz Selmer  
Arild Tofting

**f) Committee for drafting preliminary opinions and responses to hearings:**

Per A. Martinsen  
Arild Tofting  
Kate Løhren  
Liv Turid Myrstad  
Anne Sønstevoll  
Per Roald Fluge

**g) Committee for Revision of the statutes of the association:**

Jette Robsahm  
Sverre Stuedahl  
Tone Omdal

## **2. Norway and EPC.**

The Norwegian government has expressed that the last time limit for ratification of EPC is January 1, 2008. An earlier date is also possible to conceive, but probably not before July 1, 2007. The system is expected to be implemented for users in Norway 2-3 months later.

The Association of Norwegian Patent Agents was represented on an EPC conference discussing Norwegian ratification of EPC, March 14 and the Association has also submitted an opinion to the drafted proposal from the Ministry of Trade and Industry and to the suggested amendments in the Patent Act.

## **3. Meetings:**

### **a. Members Meetings:**

Annual meeting April 24 (a presentation of FICPI by Julian Crump and Arild Tofting) , ordinary meeting October 5, (about effects of accessing the EPC), Christmas meeting November 30.

### **b. Board Meetings:**

Monthly Board Meetings have been arranged during the period.

## **4. Meetings with authorities:**

The last contact meeting with the Patent Office took place 21 June 2006.

<b>5. Number of members:</b>	<b>January 2005</b>	<b>October 2006</b>
Ordinary members:	92	94

20. October 2006  
Jon D. Heggstad



## **Report on the activities of the Greek section of FICPI**

### Law Update

A new specialized department for the hearing of IP-related cases has been created in the First Instance Court of Athens by decision no. 50726/20.06.2006 of the Minister of Justice. This department will be responsible for all cases relating to Community and national trademarks, patents, utility models, technology transfer, topographies of semiconductor products, designs and all invention-related cases which are heard before the civil courts. This is the first time specialized IP courts are introduced in Greece.

### Meetings with officials

The 13th Symposium of European Patent Judges, organized by the European Patent Office and the Greek patent office took place in Thessaloniki between 12-16 September 2006. Most of the members of the Greek FICPI group attended the symposium and had the chance to discuss not only legal matters of common interest but also practical matters concerning the operation of IP courts both with Greek and foreign judges. Members of the local group also met with the General Director of the Greek patent Office requesting the organisation of seminars on IP legislation from the patent office for the better training of the Greek judges who will be appointed to the new court department.

October 24, 2006

EXCO/CL06/BUR/005-GR

## Country Report - Sweden

After the Paris congress the Swedish association has only had one meeting, in which representatives from the Swedish Customs Service informing us of how they work to find counterfeit goods. We have also had a social meeting together with the Association of Patent Attorneys in Swedish Industry and the Swedish Patent Office, this type of meeting we have every second year.

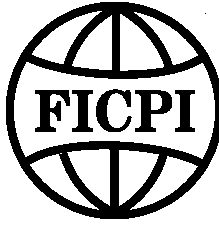
In September we had general elections, and got a new, conservative majority in the Parliament, and thus recently also a brand new Government. However, we don't expect any substantial changes in our field of practise, but a more general support for small businesses.

In the election a number of new parties also appeared. One of them, the Piracy Party, had as their main interest free downloading of anything from the Internet. Another of their main subjects was the abolition of all patent rights. One specific issue was that patent attorneys who filed patent applications including claims that fall outside what can be patented, especially claims relating to computer programs, should be prosecuted for contempt of court.

The Piracy Party got 0.64 percent of the voters support, but as we have a limit for representation in the Parliament they are not represented. If not they would have got 2 seats in the Parliament.

24 October 2006

Lennart Karlström



## FICPI CANADA

### Country Report – Canada

The Canadian members of FICPI form an association that is represented at the EXCO by a delegate and a sub-delegate who are members of council. The members of council are determined every three years, during a year when FICPI has a Congress. At the Paris Congress in May 2006, the following members were elected: Doug Deeth (Past President), Ingrid Schmidt (President), Bob Storey (Vice President), Alain Leclerc (Secretary), Michael Stewart (Treasurer), John Knox (Councillor), and Coleen Morrison (Councillor).

The Canadian association is cooperating with our FICPI colleagues from America and Britain to have a joint “ABC meeting” at the end of May 2007.

Meanwhile, we have made preparations to conduct our annual salary survey and to host a sixth annual FICPI Claim Drafting Clinic on November 4 and 5, 2006. Plans are also underway to host a FICPI Opinion drafting clinic in the new year.

The council members are meeting with the Commissioner of Patents and Registrar of Trademarks to discuss national and international matters of mutual concern in Ottawa on November 14, 2006. Regrettably, at the time of writing, there is nothing further to report.

Ingrid Schmidt  
President  
FICPI Canada  
October 24, 2006

## **Activity Report of U.S. Section October 2006**

### Activities of the Section

Since the Paris Congress, the U.S. Section has undertaken the following:

- The 2008 ABC meeting has tentatively been scheduled for Tuesday, June 3, through Friday, June 6, 2008 in Charleston, South Carolina.
- We responded to a questionnaire from CET #6 regarding claim construction principles in the U.S.
- Robert Katz of our section is in the process of preparing a response to a questionnaire from CET regarding the protection of industrial designs.
- We have been asked to comment on the bill recently introduced in Congress by Representative Issa, which would create a "Patent Specialists Pilot Program" in the federal district courts, wherein district judges from five different districts could designate themselves as interested in hearing patent cases.

### Patent Reform Legislation

A number of bills have been introduced in Congress dealing with patent reform, and three hearings have been held by the House IP subcommittee. The Senate has yet to conduct hearings, but it appears the legislation is moving forward for possible action in the next Congress. The provisions which are common in the primary House and Senate bills include converting to a first to file system, adding some form of post grant opposition, assignee filing, apportionment of damages, willful infringement, and prior user rights.

Differences exist however with respect to the treatment of inequitable conduct, the elimination of the best mode requirement, attorney fee shifting, and repeal of § 271(f).

### PTO Proposed Rule Changes

The PTO has proposed several rather dramatic and complex changes to the rules of practice, which are briefly summarized as follows:

1. Claims Practice – The proposed rule requires applicants to identify 10 claims which will be examined, and in order to prosecute more than 10 claims, the applicant will be required to submit an examination support document which covers all of the claims designated for examination.
2. Continuing Application Practice – Under the proposed rule, the applicant would be entitled to file only one continuing application or Request for Continued Examination (RCE) as a matter of right. Further continuations or RCE's must be supported by a showing as to why the amendment, argument, or evidence presented could not have been previously submitted.
3. Information Disclosure Statement (IDS) Practice – The proposed rule identifies four time periods during the application process, and specifies the requirements for submitting an IDS within each period. The first period (between filing and first office action) requires no additional disclosure requirements. The later periods require the submission of increasingly more detailed "explanations" and "descriptions". Also, applicants would be required to submit additional disclosure for English language documents over 25 pages, for any foreign language document, or if more than 20 documents are submitted.

These proposed rule changes have met with near uniform disapproval from the patent bar, and it appears that the rules will be significantly revised before being finally issued or perhaps entirely dropped.

## Accelerated Examination Rule Change

This rule changes the practice to petition to seek an accelerated examination of a pending application. The new rule became effective August 25, 2006, and is intended to lead to a final decision by the Examiner within 12 months. The rule requires, *inter alia*, that the application be filed electronically along with the results of a required pre-examination search. In addition, the applicant must explicitly state how their invention is useful and must show how the written description supports the claimed invention. The number of claims must also be limited.

## Recent Supreme Court Cases

The Supreme Court has undertaken review of and decided a surprising number of IP related cases in recent years.

The question in *KSR v. Teleflex*, which is now pending, is whether proof of obviousness for a combination patent should require evidence that there was a reason, i.e., a teaching, suggestion or motivation, for combining the prior art. The sense of the commentators is that this case may well signal the death of the "motivation to combine" requirement, thus liberalizing the ability to reject patent claims by combining disparate prior teachings.

*Lab Corp. v. Metabolite* deals with the basic principle that "laws of nature, natural phenomena, and abstract ideas" are not patentable subject matter under § 101 of the patent statute. After conducting oral argument, the Supreme Court remanded the decision to the Federal Circuit, for the reason that the issue was not considered by the lower courts. However, there were three strong dissents in the case, which may signal a desire in the Court to consider § 101 issues.

The Supreme Court may have another opportunity to revisit § 101 in *In re Nuijten*. The issue in this case is whether an electrical signal is a patentable "manufacture" under § 101, and whether it is tangible as articulated in the *State Street Bank* case.

The decision in *eBay v. Merc Exchange* set the standard for injunctive relief in patent cases. It was held that the granting of a permanent injunction is not automatic and is subject to equitable discretion. This will no doubt be a blow to patent "trolls," who will have difficulty meeting the equitable standard without a business to protect.

In *Illinois Tool Works v. Independent Ink*, the Supreme Court rejected the notion that patents carry a presumption of market power under the antitrust law. The decision thus affords patent owners greater flexibility in structuring licensing transactions, without risking a per se violation of the antitrust law.

## Federal Circuit Cases

*NTP v. Research in Motion* draws an arbitrary distinction between method claims and system claims where an essential part of the system is outside the U.S. The history of the decision is as follows:

- NTP District Court: Held that if sale and beneficial use are in U.S., there is infringement under § 271(a), (f), and (g) of both system and method claims, even if part of the system or some method steps are outside the U.S.
- CAFC in NTP I, 392 F.3d 1336 (2004) agreed.
- CAFC in NTP II (reconsideration), 418 F.3d 1282 (2005) agreed re system claims under 271(a) but disagreed re method claims under 271(a), (f) and (g).



**FICPI EXCO Chile – Dec. 2006**  
**Country Reports**

**Report from Argentina**

By Miguel B. O'Farrell

Members Meeting:

There have been no meetings of members since the last EXCO Meeting.

Meetings with Officials:

Meetings were held with the Director General of Customs Ricardo Echegaray and other government officials to discuss our REMA project for the creation of a Register of Trademark Rights with Customs.

Legislation

There has been no significant legislation regarding IP rights since the last EXCO Meeting.

Border measures

Customs has prepared a draft presidential decree to regulate section 46 of Law 25.986 on Border Measures, which includes the basic concept of our REMA project for the creation of a Voluntary Registry of Trademark Rights with Customs. We are currently communicating with the Secretary of Industry Mr. Miguel Peirano to follow up on this and attach copy of an English translation of an article published by the writer in newspaper "La Nación" of October 22, 2006 which was also sent to Secretary Peirano.

Co-sponsorship of IP Workshops

The Section co-sponsored the IP Workshops organized by the Asociación Argentina de Agentes de la Propiedad Industrial on August 23, 24 and 25 at the Hotel Four Seasons in Buenos Aires; which had about 280 attendees from Argentina and other Latinamerican countries, including federal judges and officials from the Trademark Office.



Creation of New Sections

We have made contact with Hugo Berkemeyer of Paraguay and María Rosa Fabara Vera of Ecuador regarding the possible formation of FICPI Sections in their countries, which up to now have not shown great interest. The next target country will be Uruguay.

Election of Office Bearers:

There have been no changes since the last EXCO Meeting in Paris.

The Main Matters of Concern to the Section are the following:

(i) the adequate regulation of art 46 of Law No. 25.986 to implement border measures and create the Register of Trademark Rights with Customs: (ii) the protection of multiple use inventions and (iii) the improvement of the PTO work regarding patents and utility models.

# Border Measures

## Meeting at the World Customs Organization (WCO) – Argentine Situation

On September 14, 2006, the 24<sup>th</sup> meeting of the WCO's Intellectual Property Rights Strategic Group was held in the offices of the World Customs Organization (WCO), in Brussels. The meeting was jointly chaired by Christophe Zimmerman (WCO) and James Kennedy (Procter & Gamble). Forty customs representatives from different countries attended the meeting as well as other forty representatives of private companies and eight guests – among which I was included – invited as observers.

As a summary of the discussions held at the meeting, it should be mentioned that although the number of detentions and destruction of goods in breach of intellectual and industrial property rights in different countries is significant, the reports on the number of counterfeit goods that enter several nations and spread throughout their territories is even more serious, with the consequent damage to bona fide consumers, industrial entrepreneurs and merchants, loss of jobs and revenues and eventually generating resources used to fund international terrorism.

Pursuant to section 46 of Law number 25,986, passed on December 29, 2004, as regards legislation, Argentina probably has the highest level of protection as to cross border actions. This law prohibits the import or export of goods when, upon a simple verification, it can be seen that they infringe the intellectual and industrial property rights granted by the national laws to the holders thereof.

The mentioned regulation, (section 46) clearly exceeds the provisions of the ADPIC/TRIPS treaty (Law number 24,425). Section 51 of said treaty provides for the implementation of mandatory cross border actions entitling the holders of trademarks or copyrights to request the administrative or judicial competent authorities to suspend clearance of goods if they reasonably suspect that they are infringing goods.

In fact, said section 51 of the ADPIC/TRIPS sets forth that “the Members *may* authorize right holders to file claims in respect of goods otherwise in breach of the intellectual property rights” (such as patents, utility models and industrial models and designs), as well as to implement similar procedures for customs authorities to suspend clearance of infringing goods for *export*.

However, while section 46 *in fine* sets forth that the provisions thereof "shall comply with the conditions and procedures established by the pertinent regulations ", the current situation as regards measures at the Argentine border is still not defined and determined since such regulation has not been passed yet.

Some time ago we said that the best action that could be taken to prevent the import of counterfeit goods in breach of trademarks, was to implement an information system allowing the holders of said trademarks to be informed of the goods intended to be imported in breach of their rights before the entering of such goods into the market so as to prevent such breach instead of trying to track the goods once they enter the country.

To such end, a draft decree was prepared aiming at the creation of a Voluntary Registry of Trademarks in the Customs Administration, originally called RIVODEMA and later REMA. Under this regulation those who registered their trademarks with

Customs would automatically receive an e-mail informing them on the imports of products bearing their trademark or a similar trademark so as to contact the importer and verify compliance with the applicable regulations. Otherwise, they would be able to file an action in a federal court for the detention of the goods up to the verification thereof by the holder of the trademark.

Under the federal courts case law, the proposed information system did not affect the possibility of making parallel imports of genuine products but bound the importers thereof to inform the products they intend to import so that the holder of the trademark registered with Customs could be informed before completion of the import. This is similar to the right trademark holders have to demand full explanations to third parties about the origin of the goods identified with their trademark (section 39 of Law number 22,362).

The proposed information system did not affect or restrict the powers of the Customs Administration to act *ex officio*; now made mandatory by section 46 in the cases mentioned therein.

Possibly based on the foregoing, the Customs Administration prepared a draft decree aiming at regulating said section 46. Such draft establishes that, in the first place, imports would be controlled in respect of trademarks and copyrights. Then, these controls would be extended to the other intellectual and industrial property rights and to exports. An alarm system is also established for the holders of rights registered with Customs to take timely measures to prevent the entrance of infringing goods.

On October 12, 2006, the Customs General Director, Dr. Ricardo Echegaray, instructed the operative and control areas of all the Customs of the country to implement the provision of the above-mentioned art.46 “to avoid it becoming dead wording” (see AFIP Nota Externa N° 53/2006, Law N° 25986 – Procedimiento operativo y de control; Boletín Oficial 31.010 of 12.10.2006).

Currently, the application for approval of the draft decree prepared by Customs bears number 9238/2005, and it was filed under number 0259096/2005 with the Under-Secretariat of Industry where it has been subject to analysis for several months. It is expected that, after making all the necessary amendments, it will be submitted to the Ministry of Economy and then to the President for its implementation.

In term, the Trademark Fraud Division of the National Customs Administration is receiving all the information available for an easier identification of trademark infringing goods. This is undoubtedly convenient and may have positive effects but only upon the arrival of the suspicious goods, their detection, detention and information to the holder of the trademark by the customs administration.

On the other hand, the implementation of the above mentioned automatic information system, with virtually no costs to the State, would allow the timely participation of the right holders; i.e., those most interested and in a better position to determine whether they are infringing goods – even before the arrival thereof. To sum up, they would have the possibility to effectively contribute with the authorities to prevent the entrance into the country of counterfeit goods bearing false trademarks thus mitigating this serious problem that affects us all.

Miguel B. O’Farrell

## **Country Report - Czech Republic - for the ExCo in Chile 2006**

- 1) At present the Czech Section has 12 members.
- 2) As usual we have translated resolutions of Paris ExCo and World Congress into Czech language and sent them to the Ministry of Industry and Commerce, to the Foreign Ministry, to the Czech Patent and Trademark Office, to the Czech Patent Attorneys Chamber, as well as to some sister organizations. The resolutions were also placed onto a web site of the Czech Section of FICPI.
- 3) The Czech section had a plenary meeting on June 15, 2006. At this meeting basic rules of our section have been slightly amended. The main objective of the amendments is to enable election of - in addition to a board - more possible representatives at ExCo meetings also due to costs grounds. The amended basic rules were accepted by the Bureau of FICPI.

At this meeting a board has been elected:

President: Josef SMOLA  
Vice-president: Michal GUTTMANN  
Board member: Dobroslav MUSIL

Following representatives at the ExCo meetings have been elected:

Delegate: Michal GUTTMANN  
Sub-delegate: Josef PLICKA


Additional sub-delegates: Michael FISCHER  
Josef SMOLA

26 October 2006

Josef Smola, President of the Czech Section

## SINGAPORE

During the year under review, the Singapore Section is pleased to welcome the admission of Timothy Watkin into the international fraternity of FICPI and to contribute its comments on a number of applications for membership submitted to it by the Admissions Commission. The section also contributed to the recent survey relating to the protection of industrial designs.



Tan Tee Jim, S.C.  
Delegate

October 2006



CHILE – November 2006

Summary report of activities  
Portuguese National Association of FICPI

Since the Exco meeting in Paris, on May 2006, this is the report of activities of the Portuguese National Association of FICPI.

i –The Board of the Association continues its regular meetings.

ii - After the Exco Meeting in Paris all the members of the Portuguese Association were informed of the Resolutions that were approved during said meeting as well as the Board of Directors of the Portuguese Industrial Property Institute

iii - Periodically, mailings are sent to the members of the Association regarding different matters of interest to the profession and the Association.

iv – The Board continues the regular contacts with the Portuguese Industrial Property Institute regarding the implementation and improvement of rules in relation with the Industrial Property Law.

v – On July 18, 2006, a round table was organized regarding a new Governmental project named “Marca na hora” (“mark on the hour”), which has been very criticized by the Association.

vi – In association with the OHMI office it was organized, on July 27, 2006, the “Portuguese Day” at Alicante. This was an opportunity for members of the Association to meet face-to-face with a significant number of people, from the Board to the Examiners, giving the possibility of exchanging views and opinions in different matters.

Lisbon, November 2006

# REPORT OF FICPI CHINA SECTION

GE BO

Chief FICPI China Section

December, 2006



# I. Establishment of FICPI China Section

- Inaugural meeting was held in Beijing on April 17, 2006
- Attendees: 18 individual members
- Council of FICPI China

Chief: Dr. GE Bo

Deputy Chief: Mr. Cheng Tai Keung

Mrs. Wang Jianying

Mr. Yang Wu

Mr. Yang Xiaoguang

- Secretariat:
- The Secretariat of ACPAA is functioning as Secretariat as FICPI China Section
- Secretary General: Mr. Yuan De
- Executive Secretary: Mr. David W. Cheng
  
- Approval of the establishment of FICPI China Section:  
At the Centenary of FICPI  
Delegates from 36 countries unanimously approved.

- II. First Plenary of FICPI China Section  
From August 25 to 26 the First Plenary was held in Beijing. Attendees: 18.

### Agenda:

1. Reporting the status of FICPI Paris Congress, ExCo meetings and NGO Coordination Meeting to all members.
2. Dr. GE Bo was elected as Delegate Mr. T.K.Cheng was elected as alternate delegate of China Section to participate in FICPI ExCo meetings.

3. Discussed and adopted following documents:
  - 1) Qualification for membership of FICPI China Section;
  - 2) Application procedure for admitting FICPI;
  - 3) Regulations on payment of membership fee of FICPI China Section;
  - 4) regulations on participation in CET groups.
4. Adopted the applications of Mr. Cui Xiaoguang and Mr. Zhang Shengao for their participation in FICPI and refused two other applications.

### III. Establishment of website and E-mail box

1. FICPI Special Column on the website of ACPAA.
2. E-mail box of FICPI China Section:  
[ficpi@acpaa.cn](mailto:ficpi@acpaa.cn)

# IV. Meeting Between FICPI French Association and China Section

- Time: November 11, 2006.
- Venue: Beijing
- Agenda:
  1. Legal organization of the IP professions;
  2. Relation between the IP professions and the state administrations;
  3. Activities of each section;
  4. The relationship between FICPI section and national patent attorneys' association.

The meeting was informative and constructive, two sections will maintain close cooperation in the future.

# V. Possible Seminar in China in 2007

- Discussion with Mr. Huntington in Gothenburg
- Discussion Between Mr. Modin and China Section in Beijing:
  1. Participants: IP professionals in private practice in China and other countries.
  2. Topics: should be of interest to the target attendees .
    - a. Comparison of prosecution of IP rights in various jurisdiction (for example: drafting, amending and enforcing patent claims).
    - b. Possible revision on IP laws in various jurisdiction.
  3. Proposed venue: Beijing
  4. Proposed date: two days early September, 2007.  
Excursion and other social event will be organized.

# VI. The Status of IP Protection in China

1. China will enhance the protection of IP rights.  
To create an Innovation-oriented country, china will strengthen the protection of IP rights not only for the international demand but also for its internal needs
2. Establishment of 50 IP service centers.  
receiving complaints, providing consultation, forwarding information to police departments and courts.
3. Drafting IP strategy under the guidance of the State Council.
4. The Chinese Patent Law is under revision to adapt the criteria of international IP protection system.
5. Published the revised Patent Examination Guideline.

- FICPI China Section would like to establish professional relationship with other national associations and sections.

**Thank you!**

# **Report of FICPI China Section, 2006**

*By GE Bo*

I am pleasure to join Santiago ExCo as delegate of FICPI China Section, and deliver such a report on the development of newly founded FICPI China Section and the trends of intellectual property development in China.

## **Development of FICPI China Section**

### **– Inaugural Meeting of Establishment of FICPI China Section**

On April 17, 2006, inaugural meeting of establishment of FICPI China Section was held in Beijing. Following matters has been decided on that meeting:

1. Background and preparation works of joining into FICPI was briefed to all attendees.
2. Statutes of FICPI China Section and the unification of English and Chinese name of FICPI were discussed.
3. Leadership of FICPI China Section – the council board was voted as follow:  
Chief: Mr. GE Bo  
Deputy Chief: Mr. YANG Wu, Ms. WANG Jianying,  
Mr. CHENG TaiKeung, Mr. YANG Xiaoguang.  
Secretary General: Mr. YUAN De
4. The secretariat of All-China Patent Agents Association is also function as the secretariat of FICPI China Section, which is responsible for daily works of FICPI China. Mr. CHENG Wei was designated as Executive Secretary.

### **– Chinese Members Participated in FICPI ExCo Meeting, World Congress and NGO Coordination Meeting.**

Mr. GE Bo, the chief of FICPI China Section and Mr. YUAN De, the secretary general of FICPI China Section and All-China Patent Agents Association attended the ExCo meeting, world congress and NGO coordination meeting from May 22<sup>nd</sup> to May 26<sup>th</sup>, 2006 in Paris. On May 22<sup>nd</sup> ExCo meeting, the delegates of 36 nations unanimously accepted FICPI China Section as one of national sections of FICPI and members of Executive Committee.

### **– 2006 Plenary Meeting of FICPI China Section**

Since FICPI China Section was approved by ExCo in May, we start to operate the section actively so as to make China Section more influential in China. Through the communications between secretariats of FICPI China Section and FICPI International, many issues such as membership fee, qualification for new members, procedure and admission of applicants were clear and settled by FICPI International, which laid a solid foundation for future collaborations.

On August 25 – 26, 2006, the 2006 Plenary Meeting of FICPI China Section was held in Beijing. This is the first meeting since the establishment of China Section. The success of

this meeting has significant meanings in the history of FICPI China Section. No matter the preparation or format of the meeting, or newly adopted democratic way of voting and discussion, has created a new chapter in Chinese IP commissioning cause.

Programme of the meeting is as follow:

1. Brief to all the Chinese members about participation of FICPI Paris ExCo, world congress, and NGO coordination meeting; about recent works of secretariat of FICPI China Section.
2. Vote for series of key documents, such as :< Regulations on Participation in FICPI ExCo Meeting>, <Regulations on Payment of Membership Fee of FICPI China Section>, <Qualification for Membership of FICPI China Section>, <Application Procedure to Join FICPI>, <Regulations on Participation in CET> etc.
3. Discussed 4 candidate members who had applied to join FICPI China Section. Unanimously agreed to accept Mr. ZHANG Shegao from Kangxin Partners, and Mr. CUI Xiaoguang from Beijing Sanyou IP Agency to be new FICPI members.
4. Discussed the selection of Chinese representatives in CET. Due to some changes were made on the meeting, the final selection would be confirmed by council board before the end of this year.

#### **– Recruitment of New Members**

On October 4, 2006, FICPI China Section received a letter from FICPI International that Mr. ZHANG Shegao and Mr. CUI Xiaoguang were officially approved to join FICPI. By then, there are 20 members in China Section.

#### **– Others**

1. Established a FICPI special column on the official website of All-China Patent Agents Association for the purpose of publicizing FICPI, promoting activities of FICPI China, providing information such as qualification and procedure to applicants.
2. Established a special mailbox for FICPI China Section ([ficpi@acpaa.cn](mailto:ficpi@acpaa.cn))
3. Established relevant managing and financial systems in Secretariat, and undertook lots of operational works.

## **Trends of Intellectual Property Development in China**

#### **– Chinese Intellectual Property Cause is Developing in a High Speed**

1. Increase of Patent Applications

1985 – end of 2005	total amount of 3 types of patent applications: 2,761,000
	Domestic applications: 2,257,000, account for 81.8%
	Foreign applications: 503,000, account for 18.2%

### 2003-2005 Increase of Patent Applications

Year	Total Amount of Applications	Invention	Utility Mode	Design
2003	308,487	105,318	109,115	94,054
2004	353,807	130,133	112,852	110,849
2005	476,624	173,327	139,566	163,371
From 2004 to 2005, the total amount of applications is increased 34.6%.				

### 2. Increase of Foreign Patent Application in China

Table 1 Status of Foreign Patent Application in China

Year	Patent Applications
2003	57,249
2004	74,864
2005	93,107
Annual increase rate is more than 24%	

Table 2 Patent Application of Japan, U.S. and Germany (their applications rank top 3 in China)

Nation	Total	1985-1999	2000	2001	2002	2003	2004	2005
Japan	18,5697	52,892	9,888	13,736	18,275	24,241	30,444	36,221
U.S.	111,254	44,027	8,418	8,994	10,012	12,221	16,187	20395
Germany	43,678	15,481	2,787	3,454	4,015	4,522	5,917	7,502

### 3. Patent Application in China

First 1 million applications, was taken 15 years from 1985 to 1999  
 Second 1 million applications, was taken 4 years from 2000 to 2003  
 Third 1 million applications, was taken 2.5 years from 2004 to 2006

### 4. Patent Application Granted

From 1985 to the end of 2005

Total Granted Amount	Domestic Granted Amount	Foreign Granted Amount
1,469,502	1,264,887	204,615
Proportion to total amount	86.1%	13.9%

#### 5. General Status of Trademark application and registration in China

##### Trademark Registration and Accreditation of Registered Trademark In 2003-2005

Year	Application				Accreditation of Registered Trademark			
	Domestic	Foreign		Total	Domestic	Foreign		Total
		National Application	Madrid Application			National Registration	Madrid Registration	
2003	405,620	33,912	12,563	452,095	206,070	21,188	15,253	242,511
2004	527,591	44,938	15,396	587,925	225,394	25,069	16,156	266,619
2005	593,382	52,166	18,469	664,017	218,731	23,792	16,009	258,532

#### – Chinese Government Strengthening the Protection of Intellectual Property

Mr. ZENG Peiyan, the vice-premier of State Council used to mention the Chinese government's attitude towards protection of intellectual property. He has explained the basic stand of Chinese government on protection of intellectual property: China's willingness on intellectual property protection is clear, and the action is resolute. This is not only to keep our promises on international stage, but also to meet internal needs for creating an innovation-oriented country. In recent 20 years, China has a relatively improved legal system for IP protection, and effectively fights against infringements. China will enhance the visibility all around the society so as to bring the social awareness to a higher level. China will continue to improve legal system for IP protection, severely strike against infringement activities, and broaden exchanges with other countries and international organizations so as to resolve foreign-related IP disputes in a more appropriate way. At the same time, we will establish and further improve bilateral and multilateral cooperation with other countries to jointly improve the skill and ability of protecting intellectual property.

#### – Founding of 50 Intellectual Property Services Centers for Informing and Complaint

The founding of 50 intellectual property services center is a reflection of Chinese

government's determination for IP protection enhancement. The multifunctional IP services center can receive reports and complaints regarding violation of intellectual property rights, such as trademark, patent, and copyright etc, provide consultancy on IPR protection to right owners and public. The services center will undertake preliminary examination to the reports and complaints received, then forward relevant information to corresponding enforcement organs, police departments, and legal institutions. The feedback and result will also be returned to accuser.

## – **Intellectual Property Policy Becomes One of Core Policies in China**

### 1. 1984-1985

Draft and implementation of Patent Law in China – marks the establishment of Chinese patent system, which is the first stage of Chinese patent system's development.

### 2. 2000

Revision of Patent Law of China in accordance with WTO and TRIPS – marks China melting into world IP protection system, which is the second stage of Chinese patent system's development.

### 3. 2006

China claims to create an "innovation-oriented country", "use technology innovation, self-dominated intellectual property as major policy measures to change economy growth method" – marks intellectual property becomes a main factor in national economy of China, and one of national policies, which is the third stage of Chinese patent system's development.

## – **China is Drafting National Intellectual Property Stratagem**

The State Intellectual Property Office of China is drafting national intellectual property stratagem. It's part of general national developing stratagem, together with other stratagems like stratagem of invigorating the country through science, technology and education, stratagem of sustainable development, stratagem of human resources development.

The purpose of drafting national intellectual property stratagem is to enhance the ability of self-dominated innovation, improve IPR protection system, and reinforce the protection of IPR, so as to push forward the formation of self-dominated IP, promote the change of economy method and make China an innovation-oriented country.

## – **Legislation**

In 2006, members of FICPI China Section actively participated in revision of *Chinese Patent Examination Guideline* and *Patent Law*, and proposed many constructive

suggestions.

1. Aims at adapting to economic and technical changes, promoting technology innovation and trade, further improve patent examination system, the State Intellectual Property Office of China decided to revise *Patent Examination Guideline*, the new *Guideline* has put in effect on July 1, 2006.
2. China starts the third revision on *Patent Law* of China.

The guideline of third revision on *Patent Law* of China is as follow:

- a) Summarize 20 years experiences of implementation of patent system, adapt to changes of international IP rules.
- b) Make the *Patent Law* better suitable with national situation of China, and stimulate the innovation of enterprises and individuals.
- c) Protect IPR in a more effective way, and better balance the interests between patentee and public.
- d) Promote the self-dominated innovation, and construction of an innovation-oriented country.

Draft revision published:

1. 40 of 69 articles were revised in the *Patent Law* (including original existing articles and newly added ones)
2. Eminent changes are
  - a) cancel the designation of foreign-related patent agency
  - b) novelty has changed from relative novelty to absolute novelty
  - c) Put Equivalence principle, Prosecution History Estoppel, and Prior Art Limitations into Patent Law
  - d) Enhance the punishment (counterfeit a patent product or same infringer perpetrate once more will be punished less than 3 times what he/she obtained from his/her illegal behavior; if the compensation is difficult to calculate, the fine could be charged 1 million Yuan maximum)
  - e) Enhance the ability to resolve patent disputes
  - f) Add more articles about patent assignment in patent application

Thank you for your attention.

# **FICPI - ExCo - Chile 2006**

## **Report on the activities of the Swiss Group**

### **1. Covered period of this report**

The present report relates to the period of about May 2006 to November 2006, and constitutes the follow up of the one submitted at the congress in Paris in May 2006. As requested by the Secretariat, it will be brief and concise.

### **2. Members**

The number of members of the Swiss group further increased to 74 which correspond to an increase of more than 20% since the beginning of this year.

### **3. Activities relating to legal developments**

- The Swiss group rendered its opinion on the revision draft of the Swiss unfair competition law to the Swiss Patent Office.
- The Swiss group also submitted the position of FICPI relating to WHOIS/ICANN to the Swiss Federal Commission for Communication.
- The Commission of the European Union sent a questionnaire to the users of the patent system (industry and related circles) relating to the use and valuation of the patent system. The Swiss group answered the questionnaire and submitted it to the Swiss Patent Office as well as to the Commission of the European Union. (Even though Switzerland is not member of the European Union, the patent system of the EU is most relevant to the Swiss Industry.)
- The Swiss group participates the work group dealing with establishing a legal regulation of the profession of Patent Attorneys in Switzerland.

### **4. Internal meetings of the Swiss group**

- 3 May 2006 in Zurich: Two Presentations on "EPC 2000" and on "Defeating trade mark pirates"
- 1 September 2006 in Rapperswil: Presentation by a Judge of the Zurich Court of Trade Affairs relating to the latest decisions of the ECJ on cross-border litigation.
- 10 November 2006 in Pont-la-Ville: Presentation by a US Patent Attorney on major changes in the USPTO.

### **5. Contacts to other organisations**

The President of the Swiss group is continually in good contact with the Swiss Association of the registered European Patent Attorneys (VESPA) and with the Officials of the Swiss Patent Office.

Werner A. Roshardt / 06 November 2006

# COLLEGIO ITALIANO DEI CONSULENTI IN PROPRIETA' INDUSTRIALE

## THE ROLE OF A FICPI DELEGATE Report from Collegio Italiano ITALY

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The results of the activity developed by Collegio during the short period after the Paris Congress can be summarized as follows:

### 1) Memberships

The number of members reached 153 members

### 2) Relationships with the UIBM (=Italian P.O.)

The good relationships established with the Italian Patent Office representatives allowed to develop the cooperation between the two bodies and the IPO required the advise of Collegio in relation to a plurality of arising matters among which:

**EPLA** Collegio supported the maintaining of the First Instance jurisdiction at a national level while is not contrary to a centralized Appeal in view of a possible harmonization among the different National Courts specialized in Intellectual Property Rights

**EPO** called to give its opinion in relation to the future developments of EPO Collegio re-affirmed the need of a centralized Search and Examination procedure (or at least decentralized locations but centralized control by EPO) in order to avoid any loss of quality and reliability of the services.

#### 2.1) Electronic filing

The procedure is now working for the National Patent and Trade Mark applications, even if a continuous monitoring is required before the procedure can be considered acceptable by the end users particularly if Patent Attorneys.

Notwithstanding the utility of the procedure, Collegio highlighted some important points still requiring a deeper evaluation and probably a modification to comply with the required high standards of safety, certification and reliability that an IP application requires.

### 3) National Courts

A discussion about utility of the Technical Experts of the Judge vs Technical Judges started and Collegio will support the role of the technical expert besides the Court for several reasons that we will be able to explain in detail if a debate inside FICPI will be open should the matter be of common interest for several Countries and/or for the Centralized (European) Courts.

### 4) Collegio web site

FORUM OF THE COLLEGIO ITALIANO - available from the Collegio web site [www.ficpi.it](http://www.ficpi.it) - is fully operative and particularly used by the members to exchange information and comments about the profession. Once more I remember to the FICPI members that on the site of Collegio a list of experienced experts of the Judges is available.

### 5) Relationships with FICPI.

Contacts to contribute to the arrangement of the next Forum in Florence has been taken and Collegio is collecting proposals to give support to FICPI .

Milan, 28 October 2006

**Dott. Ing. Paolo Stucovitz**



## REPORT

On the status and activity of the Hungarian Group of FICPI

### Status

The number of FICPI members at present is 17, representing five different IP firms. From the members, retirement of two colleagues may be expected for the next year; most probably, they would also resign of their membership.

Due to the declining environment caused partly by Hungary's accession to the EPC as well as the poor innovative activity of Hungarian SMEs and enterprises, the profession suffered from substantial losses. The total number of Hungarian Patent Attorneys decreased to 130 while the number of free professional colleagues on the list of the Hungarian Chamber of Patent Attorneys is about 70.

Considering that the number of young Patent Attorneys exceeds 15 from the 70 (they cannot be considered as candidates for FICPI membership in the near future), the number of potential new members may not be estimated as 10 for the next five years. At present, two Hungarian Patent Attorneys seem to be interested in joining FICPI, the corresponding requests will be submitted early next year.

Due to the retirement of Mr. Robert Sikos, the Hungarian Group, according to its Funding Regulations, has a Board consisting of two International Delegates:

Mrs. Dr. Éva Somfai and  
Mr. Ádám Szentpéteri (also contact person for FICPI)

### Activity

Dr. Éva Parragh and Ms. Judit Kerény have been working in CET 5. Unfortunately, no other volunteers could be found for other CET groups though two additional candidates expressed their interest to work also for CET 5. The main reason of the possible inactivity is that most of the Hungarian FICPI members have been members of other national groups as well, thus e.g. LES, AIPPI, Union, etc.

Professional work of the Hungarian Group is performed in small informal groups and mostly related to the harmonization of the Hungarian legislation with the European regulations following the accession of Hungary to the EU. Due to the drastic changes

in the procedural legislation, also different Laws in the IP field needed to be amended and the Group and especially members of the Group performed negotiations (incl. lobbying and drafting) with the Ministry of Justice and the Hungarian Patent Office. The targets of consultations are listed below:

- Government Decree No. 61/2006 (III.23) Korm. on the deposit and handling of biological material for the purposes of patent procedure
- Decree No. 18/2006 (IV.12) IM of the Minister of Justice on the detailed rules of the voluntary register of copyright works kept with the Hungarian Patent Office
- Act on amending certain laws with respect to the enforcement of industrial property rights and copyright
- Amendment of Act XXXII of 1995 on Patent Attorneys
- Amendment of Decree on the fees for administrative services in industrial property procedures before the Hungarian Patent Office
- Certain adoption problems of the Trademark Law Treaty of Singapore

Members of the Hungarian Group prepared and published a survey on patent litigation in Hungary, especially in respect of implementation of the European Union Directive 2004/48/EC.

Three members of the Group attended the FICPI 2006 World Congress in Paris.

Budapest, 2 November 2006



Ádám Szentpéteri

International Delegate

**FICPI EXCO Meeting in Santiago de Chile, Chile  
2 to 7 December 2006**

**COUNTRY REPORT: DENMARK**

At the general assembly in 2006 Mrs. Anne Schouboe of the firm Plougmann & Vingtoft a/s was appointed as President of the Danish Patent Agents' Association for a period of two years. During this period she continues to be Danish delegate to the Executive Committee of FICPI as she was appointed in 2005 for a period of three years. Unfortunately, she will not be able to attend the Chile ExCo meeting. Thus, the Danish Patent Agents' Association will be represented by the subdelegate Mr. Thomas Sundien of the firm Zacco Denmark A/S.

During the last parliamentary session the EU Enforcement Directive has been implemented in all Danish IP laws and a revised Danish Utility Model Act has been passed, but it will not enter into force until 1 January 2007. Proposed amendments of the Rules of the Danish Patent Office relating to utility models have been submitted for hearing to professional and scientific organizations including the association and are expected to be implemented from 1 January 2007.

A bill implementing the parts of EPC 2000 relating to the central limitation procedure was implemented by unanimity in the Parliament on 2 June 2006. A further bill implementing the new Art. 52(5) EPC 2000 and EU directives 2004/27/EC and 2004/28/EC is expected to be presented in January 2007.

A members' meeting on the topic Client Attorney Privilege was held 21 September 2006. Further, in response to a report regarding possible amendment of the Law on the Administration of Justice which was submitted for hearing to professional organizations including the association, the association has advocated that a qualified IPR consultant should be able to represent a client in a court case relating to a patent, a utility model, a trademark or a design together with an attorney and that provisions regarding client attorney privilege should be inserted with respect to European Patent Attorneys.

The use of technical judges in civil court cases where technical expertise is considered to be of value has been strengthened and in the future patent court cases will be dealt with by the Commercial Court of Copenhagen. In view of these amendments and the fact that the association is frequently asked to propose, from its membership, independent qualified experts to assist Danish Courts in IP litigation, a seminar on the role of the patent agent in Danish court cases with a focus on the function as a qualified expert will be held for experienced members on 28 November 2006.

During the period the association has assisted with responses to a FICPI questionnaire on Infringement and another on Protection of Industrial Designs.

20 November 2006

The Association of Danish Patent Agents  
FICPI Contact Committee

# FICPI

## COUNTRY REPORT

### AUSTRALIA

December 2006

#### Membership

FICPI Australia, this Federation, the IP profession generally and, of course, his family suffered a major loss when Malcolm Royal passed away peacefully on 21 October 2006 after his long battle with a brain tumour. Marg and his family were greatly buoyed by the 100 or so messages of condolence and support that were received from Malcolm's FICPI family, as well as by the large number of his FICPI friends who flew to Melbourne for the funeral. Sadly, I was in Europe at the time of the funeral, but I had visited both Malcolm and Marg a couple of times in hospital in the days before his passing. However, Greg Chambers, Noel Brett, and particularly Robert Cross, another FICPI Australia member, provided great support to both Malcolm and Marg during his illness and then to Marg immediately following his death.

#### Meetings

FICPI Australia has had numerous Council meetings since the very successful centennial Paris Congress and ExCo in the lead-up to its 2006 annual meeting, and one since. The most recent Council meeting was held primarily for the initial planning of the 2007 annual meeting, which will be held in Darwin, in the Northern Territory, in July 2007.

The 2006 annual meeting was held in Byron Bay, on the New South Wales northern coast, over the weekend of 2 September – with about 35 of our approximately 100 membership and about 20 accompanying persons attending. These numbers were swelled by the attendance of a few practice managers and 5 external speakers. Travel and accommodation costs for the external speakers were paid by the Association, but once again the conference was a financial success. The theme of the business sessions, held over two days, was IP Communications. Specific sessions were focussed on Information Technology – What Next for IP Management, What Next for System Architecture, Customer Relation Management, Industrial Relations Changes – Are the Rules any Different, and In Sickness and in Health – Protecting Everyone. The last session was particularly apposite given Malcolm's recent early retirement (at the time) on ill health grounds and another member's struggles with motor neurone disease.

Because of the proximity of this meeting to the Paris Congress, no tour day was held this year. However, as usual, there was plenty of socialising amongst members. As 2006 was a Congress year, elections were held for Council membership following the retirement from Council of Jeffrey Ryder and Paul Whenman. Existing Council members Steven Krouzecky (treasurer), Charles Berman, Bill McFarlane and Christian Schieber were re-elected, and new members Caroline Bommer (who attended the 2001 GB ExCo as temporary sub-delegate) and Mark Roberts were welcomed. Greg Chambers and I retained our positions as Secretary and President unopposed, and Noel Brett remains on council as Immediate Past President. As a past president, David Griffith remains an ex-officio member of Council. We all retain our positions for the next 3 years.

There is also progress with the proposed ExCo in Sydney in the northern spring of 2008. This has been booked at the Shangri-La Hotel in the city centre, starting on 6 April 2008. The hotel has 5+ stars and is close to the Sydney Harbour Bridge, with every room having views of the harbour. The Contract for the tour organizer is awaiting signature by Danny Huntington, and the social and other events cannot be organized until this occurs. There are a number of exciting event venues on the possibilities list.

### **Meetings with Officials**

As noted in our Country Report to the Paris ExCo, IP Australia has re-established discussions with FICPI Australia and other local IP organisations, and two meetings have been held so far since August 2006 between IP Australia, FICPI and IPTA (the Institute of Patent & Trade Mark Attorneys of Australia). A third is planned for early December 2006. Discussions have been frank and broad ranging, from PCT changes, to possible changes to IP legislation and regulations, through to possible changes to practice arising from recent court decisions. Two issues of particular note are that IP Australia is planning to substantially increase official fees for excess claims (>20) payable on acceptance of patent applications and for extensions of time for filing evidence in patent oppositions. The stated aims are, respectively, to reduce the number of claims in patent applications and to reduce delays in oppositions.

FICPI Australia recently filed strong responses to IP Australia's Consultation Papers on Changes to the Patent and Trade Marks Attorney Regimes. Last Friday, 24 November 2006, FICPI and IPTA were invited to a meeting with IP Australia and the Professional Standards Board for Registration of Patent and Trade Marks Attorneys (PSB) to discuss IP Australia's proposals and our criticism. The Consultation Papers were intended to propose changes to implement the Government's response to a Report by the PSB that dealt with concerns that patent attorneys were able to register in Australia and immediately practice on their own with insufficient experience. In our view, IP Australia's proposals would not implement the Government's response and do not go far enough to satisfy the original concerns.

### **Other Discussions**

The various IP authorities have been releasing a large number of reports, discussion papers and legislation over the last few months, to the extent that the Council of FICPI Australia has considerable difficulty in commenting on all of the proposals. For example, during November 2006 releases have included the Government Response to the Crown Use Provisions for Patents and Designs and an Overview of Responses to the Public consultation Paper on the ACIP (Australian Council of Intellectual Property) Report on Patents and Experimental Use. These come on top of the Consultation Papers on the profession mentioned already and the recent enactment of substantial changes to legislation under the Intellectual Property Laws Amendment Act 2006 and the Trade Marks Amendment Bill 2006 mentioned below. We are having to be more selective on the issues to which we provide input.

### **Legislation and Recent Court Decisions**

The Intellectual Property Laws Amendment Act 2006 received the Royal Assent on 27 September 2006, and its various provisions come into force at different times on and after that date. For the Patents Act, the changes include clarifying the prior use defence to infringement, adding another ground upon which a compulsory licence may be sought, allowing the award of exemplary damages in infringement proceedings, and increasing the ability to "springboard" on pharmaceutical patents. Springboarding is now permitted at any time during the life of the pharmaceutical patent, where it is for purposes connected with obtaining regulatory approval of a pharmaceutical product in Australia or overseas. For the

Trade Marks Act, the changes include provisions concerning the revocation of trade mark rights and access to documents filed with the Trade Marks Office.

The Trade Marks Amendment Bill 2006 followed a review undertaken by IP Australia (to which FICPI Australia had input) to ensure the TM Act was meeting the needs of Australian businesses and users of the system. It received the Royal Assent on 23 October 2006. Again, its various provisions come into force at different times on and after that date. The provisions are primarily designed to strengthen the rights of trade mark owners, but owners and FICPI members should be aware that the grace period for renewing a trade mark after the renewal date has been reduced from 12 to 6 months.

Turning to recent court decisions, by a majority the full Federal Court has affirmed a lower court decision in the University of British Columbia and Angiotech Pharmaceuticals, Inc v Conor Medsystems, Inc that in jointly owned patents each patentee must derive title to the invention from a true inventor. Under Section 15 of the Patents Act 1990, *a patent for an invention may only be granted to a person who:*

- a) is the inventor; or*
- b) would, on the grant of a patent for the invention, be entitled to have the patent assigned to the person; or*
- c) derives title to the invention from the inventor or a person mentioned in paragraph b); or*
- d) is the legal representative of a deceased person mentioned in paragraph a), b) or c).*

Lastly, in a decision in Grant v the Commissioner of Patents, the Australian Full Federal Court recently qualified the extent to which business methods can be patented in Australia. A business method is patentable provided it involves a physical effect in the sense of a concrete effect or phenomenon or manifestation or transformation. It cannot be a mere scheme, abstract idea or mere intellectual information. The court also made clear that an invention did not have to be within an area of science or technology to be patentable.

### **Website**

The FICPI Australia website is now up and running, at [www.ficpi.org.au](http://www.ficpi.org.au). A variety of documents of interest to members and prepared by the Council of FICPI Australia have been posted to the site.

**Peter Huntsman  
President  
FICPI AUSTRALIA**

## UK Country Report December 2006

### Meetings

The latest in our regular series of dinner meetings was held at the East India Club on Thursday the 19<sup>th</sup> October. The usual excellent fare was followed by a stimulating debate on topics of interest.

Readers are reminded that next year's ABC meeting has been rescheduled to 28<sup>th</sup> to 31<sup>st</sup> May 2007. The venue is the Cameron House Hotel on Loch Lomond, Scotland. Booking details will be released shortly.

### Changes In Membership

Two new members were acquired, Nick Bassil and Richard Howson.

### Office Bearers

President:	Alastair Neil
Secretary:	Grahame Marshall
Treasurer:	Julian Crump
ExCo Delegate:	Reuben Jacob
ExCo Sub-delegate:	Simon Rees
Past President:	Richard Gallafent

Council Members:	David Bannerman
	David Cannon
	Alan Senior
	Terry Johnson
	Bill Stonehouse
	David Carmichael
	John Dean
	Elizabeth Dawson
	James Fish

### Other Items of Interest

#### A. Patent Office issues Practice Notice on Patentability of Computer Programs and Business Methods

Following the Court of Appeal's judgment in *Aerotel v Telco* and *Macrossan's Application*, issued last Friday, The UK Patent Office has issued a Practice Notice on how it will in future decide if an invention is not patentable because it is a computer program or business method as such.

The Notice notes that the judgment considers all the previous caselaw from the UK courts and the European Patent Office and provides a clear approach as to how the computer program and business method questions should be tackled. The judgment is binding on the High Court and the Patent Office, and from now on the Patent Office will follow this as set out in the Practice Notice.

The approach is in the form proposed to the Court by the UK Patent Office and the Notice concludes that it is unlikely that it will substantially change what innovations are and are not patentable. The Notice refers to a number of worked examples applying the new approach to cases recently decided by the Office under the previous approach and in each case the same decision as to patentability is reached.

#### **The New Test**

The test approved by the Court comprises the following steps:

- (1) properly construe the claim
- (2) identify the actual contribution
- (3) ask whether it falls solely within the excluded subject matter
- (4) check whether the actual or alleged contribution is actually technical in nature.

The Court decided that the new approach provided a structured and more helpful way of applying the statutory test for assessing patentability which was consistent with previous decisions of the Court. This test will be applied by examiners with immediate effect.

#### B. Patent Office Mediation Service judged a success

The Patent Office has won a prestigious award in this year's annual CEDR Excellence in Alternative Dispute Resolution Awards for the introduction of a new mediation service to help companies and individuals involved in intellectual property (IP) disputes.

The award ceremony held on 29 September is an annual event organised by CEDR, The Centre for Effective Dispute Resolution, and was attended by 250 leading figures from the Alternative Dispute Resolution and legal community.

Against tough competition the Patent Office Mediation Service won the Public Sector Award. The independent panel of judges said;

*"That the Patent Office had made an extraordinary achievement in introducing ADR (alternative dispute resolution) into its work in resolving disputes. It showed leadership and innovation, with the ability to impact on how an entire sector will manage its conflicts."*

#### C. Registering designs in the UK is now easier than ever

From 1st October 2006 the registration of designs will be an easier, more streamlined and cost effective process.

Changes in the legal protection of designs throughout Europe led to The Patent Office conducting an extensive review of the design registration system seeking views from customers and the business community.

A modern designs system, more in tune with Europe, will help UK businesses both large and small to meet the urgent demands of today's market place. These changes will be a boost for innovation and competition in the UK.

The benefits to customers will include:

- Simplified application process
- Multiple applications made on one form, which must be by the same applicant, otherwise there are no restrictions on multiple filings for new designs
- Access to official files that document proceedings during the design application process
- Postponement of public disclosure (on request) for up to 12 months

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## ***COUNTRY REPORT: AUSTRIA***

***For the FICPI EXCO Meeting in Santiago, Chile 3-7 December 2006.***

### *Membership:*

*There are currently 32 Austrian members of FICPI. No new members have been registered since the ExCo/Congress in Paris, because no examination for Austrian Patent Attorneys was conducted since then.*

### *Legislation:*

*The Enforcement Directive 2004/48/EG has recently been transformed into national law (June 2006), the practice, however, has not yet brought much information about how the improvements will work in detail.*

### *Other Matter:*

*The “Biopatent Monitoring Committee”:*

*The European Directive on the legal protection of biotechnological inventions 98/44/EC has been transformed into national law on 10 June 2005. The Austrian Parliament has connected the establishment of a special monitoring committee to this transformation. This committee (“Biopatent Monitoring Committee”) had the task to monitor the impact of this transformation into Austrian law on*

- *“human rights, animals, plants and ecological systems”*
- *“monitoring the national granting and decision practice, i.a. on compulsory licenses, the borderline between discoveries and inventions”*
- *“the impact on consumer protection, agriculture and developing countries”*
- *monitoring whether inventions contrary to human rights and morality have been granted and*
- *“the impact on research and economy, especially on SMEs”.*



*This Committee should deliver its first report one year after the transformation of the Biotech-Directive into national law, then each three years such a report has to be delivered. The Biopatent Monitoring Committee consists of a large variety of representatives of interested circles (eg. the Patent Attorney's Chamber, the Lawyer's Chamber, the Ministry of Economy, the Chamber of Commerce, the Chamber of Economy, the Ministry of Health, the Ministry of Science,...), some of which had not been identified as active participants in the patent field before the establishment of the Committee so far (such as the Employee's Chamber, the Union, the Society for ConsumerInformation, ...). The establishment of a report for such a diverse Committee was a considerable challenge and a lot of fruitful discussions for all the participants were necessary in order to deliver a first report to the Parliament.*

*Nevertheless, the Biopatent Monitoring Committee has delivered its report to the parliament in June 2006. The report contained an analysis of the Examination Guidelines of the Austrian Patent Office for biotechnological inventions. These Guidelines were held to be 100% in conformity with the EU Directive. Due to the short monitoring time, no significant changes proven by hard facts could be observed, however, the report showed some positive developments in the economic field. In the biotech sector, investments and number of employees have risen (even in the short monitoring time) and confidence was expressed by the SMEs in this field, especially because of the expectation of legal certainty for their patents. It was also positively observed that the transformation of university research into commercial projects has delivered significantly rising figures. On the other hand, negative consequences, which had often been worried about in the past, were not observed by the committee, not even with respect to publication activity of university scientists also involved in patenting (which was monitored in detail by the committee).*

*The report of the Austrian Biopatent Monitoring Committee is available under [http://www.patentamt.at/Home/rzbio/Monitoring\\_Bericht\\_Juni2006.pdf](http://www.patentamt.at/Home/rzbio/Monitoring_Bericht_Juni2006.pdf). The next report of the committee is due in summer 2009.*

*Daniel Alge*