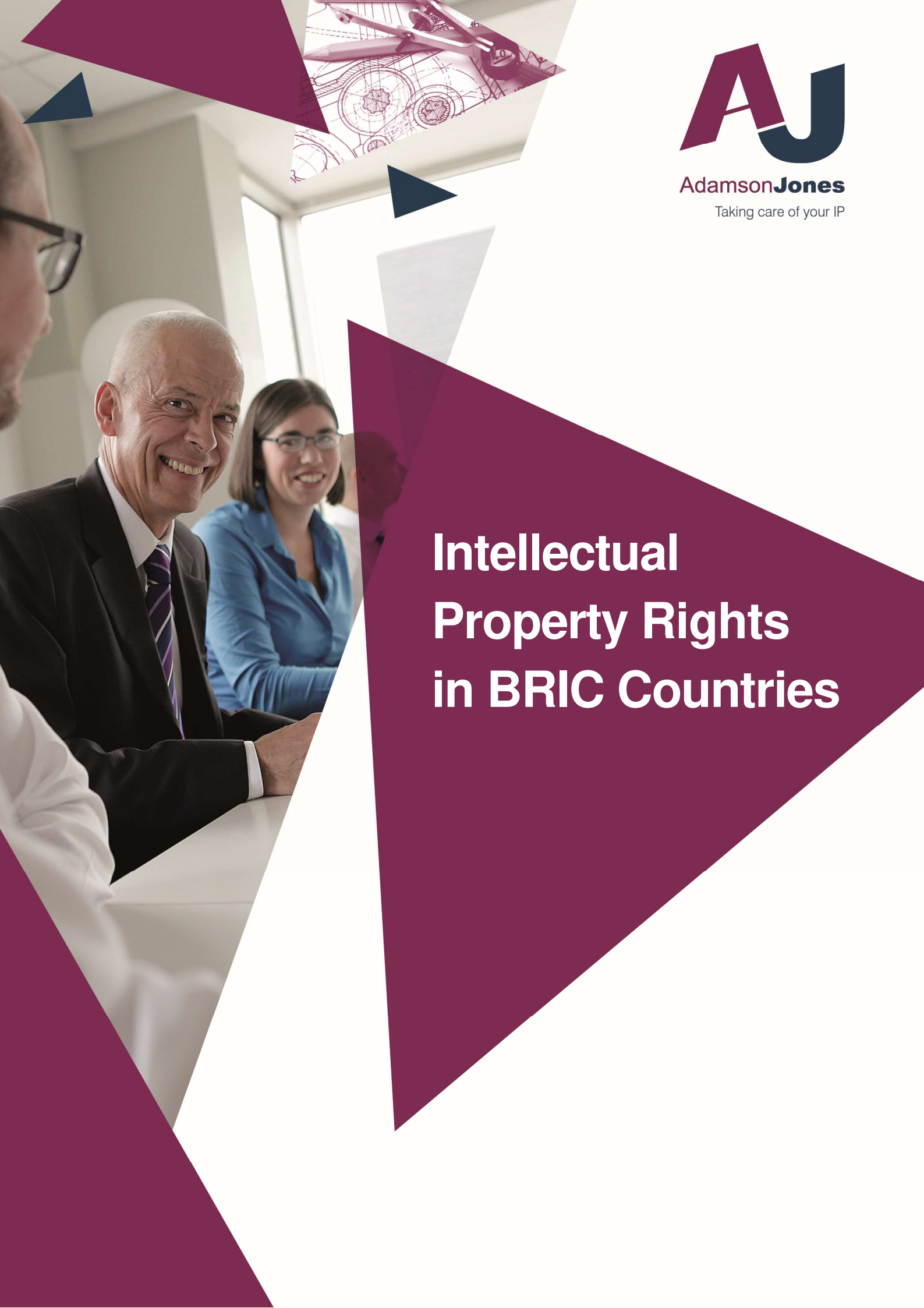




AdamsonJones

Taking care of your IP



Intellectual Property Rights in BRIC Countries

February 2017

Intellectual property rights in BRIC countries

Introduction.....	pages 2-18
Brazil.....	pages 19-24
Russia.....	pages 25-30
India.....	pages 31-34
China.....	pages 35-41

Introduction

Brazil, Russia, India and China each have significant Intellectual Property Rights (IPR) and these countries are generally party to the major international IP conventions. As members of the World Trade Organisation (WTO), they have signed up to the TRIPS¹ Agreement. The BRIC countries have many features in common, being party to international conventions on trade marks, patents, designs and copyright, and have overhauled their IPR systems to improve the protection of IP rights by foreign and local rights holders.

Trade marks

Trade mark registration is available in all BRIC territories at relatively low cost. All BRIC countries follow the “Nice Classification” which provides for the application of trade marks for particular classes of goods and services. Trade mark registration is facilitated in Russia, China and India by their membership of the Madrid System for the International Registration of Marks (“the Madrid Protocol”) which provides that an international application filed in one participating country, such as the UK, will be recognised as an application in the Madrid Protocol countries designated in the application. Brazil has no plans to do so in the near future. Brazil and China are “first to file” countries, which provides that a trade mark will belong to the first company to apply for that mark and can prevent another party using it. India is ‘first to use’ country, granting common law rights even to unregistered trade marks.

Domain names

Ownership rights may be asserted in the BRIC territories as appropriate under trade mark, copyright and/or passing off laws, although registering domain names can be difficult for foreign companies.

Patents

All BRIC countries provide patent protection for a period of 20 years commencing from the filing date of the application, provided that the formal requisites are met, together with the substantive requirements for novelty, inventive step and industrial application. Each of the BRIC countries is party to the Patent Cooperation Treaty (see relevant BRIC country insert) which provides for the filing of a single application at a designated Receiving Office, followed by entry into the national phase in chosen countries after 18 months. Brazil and India also allow for patents of addition which are tied to the main patent and may provide protection for additional protection connected with the inventive concept of the main patent. In addition,

¹ Trade-Related aspects of Intellectual Property Rights. an international agreement administered by WTO that sets down minimum standards for many forms of [intellectual property](#) (IP) regulation as applied to nationals of other WTO Members. It was negotiated at the end of the [Uruguay Round](#) of the [General Agreement on Tariffs and Trade](#) (GATT) in 1994.

Brazil, Russia and China allow for utility models which can provide useful and effective protection for devices where there is no requirement for an inventive step to be demonstrated before grant. Such protection is more cost effective to obtain and is generally granted more quickly than a patent.

Registered designs

All BRIC countries allow protection for industrial designs which protect the outward physical appearance of the product rather than the operation of a device. Again, registered design protection is generally cheaper and quicker to obtain than a patent.

Copyright

Copyright in literary and artistic works applies to all BRIC countries which are each party to The Berne Convention which provides that copyright does not need to be registered, although it can be advantageous to do so, where possible, to reduce the risk of a dispute as to ownership.

Other laws, such as UNFAIR COMPETITION, may facilitate enforcement of IP and include remedies for imitating another party's advertising, undue use of another party's trade name, using fraudulent means to divert another's clientele, including reproduction of products without IP protection and misuse of confidential information. Customs enforcement may also be a useful means of preventing unlawful activities by third parties.

ENFORCEMENT OF IP is generally determined by the type of IP held and the location and nature of the infringing activity.

Each of these forms of IP is considered in more detail below.

Trade Marks

What is a trade mark?

A trade mark is any sign or symbol that can distinguish the goods and/or services of one trader from those of another. Essentially, a trade mark is a badge of origin, and is used so that customers can recognise the goods or services of a particular trader. Hence, the trade mark contributes to the commercial value of the goods or services to which it is applied, and increases marketability. There are slight differences in what can be registered in each of the BRIC countries (see relevant country insert).

A trade mark may be a word (e.g. Nike), a group of words (e.g. Marks & Spencer), a logo (e.g. the Adidas stripes), a phrase or slogan (e.g. I can't believe it's not butter!), pictures, or any combination of these.

Once your trade mark is registered, you can then use the registered symbol, ®. We also recommend that you do this, as it notifies third parties that your mark is registered, and may therefore act as a deterrent.

For example, you could mark your registered trade mark as follows:-

Trade Mark® is a registered trade mark of [Your name].

Please note that it is an offence to use the ® symbol if your trade mark is not registered.

What protection does a registered trade mark offer in the BRIC countries?

A registered trade mark provides the owner with powerful protection for their trade mark. Once accepted by the Trade Marks Registry of the relevant national Intellectual Property Office, a trade mark is registered for an initial period of ten years. However, the protection may be extended for an unlimited period, provided that renewal fees are paid every ten years.

It is important to note that if a registered trade mark is not used commercially for a continuous period of three (Russia, China) or five years (Brazil, India), then it may be attacked and invalidated by a competitor, and removed from the register. Therefore, there is a strong incentive for owners to use their trade marks.

What rights does a trade mark owner have in the BRIC countries?

The owner of a registered trade mark has the legal right to stop a third party from commercially using the identical mark for goods or services that are identical, or similar, to

those in respect of which the trade mark has been registered. In addition, it is possible to stop a third party from using a confusingly similar trade mark for similar goods/services.

The owner can prevent the third party from affixing the registered trade mark to goods or packaging; selling or offering to sell goods or services using the registered trade mark; importing or exporting goods using the trade mark; or using the trade mark on business papers, or in advertising. Any of these actions constitutes registered trade mark infringement. Trade mark rights may be enforced in the BRIC countries under Administrative proceedings, Civil (Court) proceedings, and, in some cases, criminal proceedings, in order to stop trade mark infringement.

A registered trade mark may be **licensed** to third parties on mutually agreed terms. The trade mark owner may also sell the registered trade mark to someone else, who will then become the new owner of the registration. This is called **assigning** the trade mark.

What are the requirements for a trade mark to be registered in the BRIC countries?

In order to be registerable, your trade mark must be: (i) distinctive (i.e. not descriptive) for the goods or services which you are applying to register it for; (ii) not deceptive, or contrary to law or morality; and (iii) not confusingly similar or identical to an earlier mark for the same or similar goods or services. Particular details are provided for each country (see relevant BRIC country insert).

When should I consider registering my trade mark?

There are two key considerations that should be borne in mind when wishing to use and register a trade mark. The first is whether anyone else has already registered either the identical, or a confusingly similar, trade mark at the relevant national Trade Marks Registry, in respect of identical or confusingly similar goods/services. If they have, then your trade mark application may not be accepted for registration by the Trade Marks Registry.

The second consideration is whether anyone else has already registered, or applied to register, an earlier trade mark that may present you with a risk of infringement if you use your trade mark in the relevant territory. Therefore, before adopting or using any trade mark, we recommend that a detailed infringement clearance search is carried out before proceeding, in order to highlight any potential problems.

Unlike patent and design protection, there is no strict requirement for a trade mark to be confidential when filing a trade mark application. Indeed, many trade mark applications are

filed after many years of commercial use. However, by filing a foreign trade mark application within 6 months from the UK filing date, it is possible to back-date the foreign application to this so-called priority date, and this can provide some advantages, especially in Brazil and China where rights belong to the first to file the trade mark.

How do I register a trade mark in the BRIC countries?

The first step in registering a trade mark is to prepare a list of all of the goods and/or services in connection with which the mark is to be used. The trade mark system includes a detailed classification system, each covering different groups of goods and services.

In many cases, a trade mark application will include goods or services that fall into more than one class, and often many classes. We recommend that the initial trade mark application should include any goods/services that you think the mark may eventually be applied to, at least in the short-term future. However, it should be borne in mind that the mark may be attacked by a competitor, and may be invalidated either in full or in part, if not used for all of the goods/services for which it is registered.

The next stage of the application procedure is for the trade mark to be examined by the relevant national Trade Marks Registry. The Registry assesses whether the mark is sufficiently distinctive to be registered, and checks whether there are any conflicting earlier registrations or pending applications on the register. In India, the application may also be advertised before acceptance. If the mark is accepted, details of the accepted trade mark application are published for opposition in Brazil, India and China. In these countries, any person with conflicting earlier marks may file an opposition against the application. At the end of any opposition proceedings, the mark will be maintained or rejected, either in full or in part, in which case the mark may be registered in respect of a limited range of goods/services. Russia provides for a formal opposition only after registration of a trade mark.

If no opposition is filed, at the end of the opposition period, the mark proceeds to registration. The trade mark is registered for an initial period of ten years. Provided that renewal fees are paid to the Trade Marks Registry every ten years, the trade mark will remain registered indefinitely in each of the BRIC countries.

Do I have to file separate national trade mark applications in each country?

There are two main ways in which trade mark protection may be obtained. These are:-

- a) Separate national trade mark applications in each country required under the procedure outlined above; and
- b) Russia, China and India allow a filing under the Madrid Protocol in which an international trade mark application may be filed, based on an existing application or registration in a participating state. The "international registration" serves as a means for seeking protection in member countries, each of which apply their own rules and laws to determine whether or not the mark may be protected in their jurisdiction. Brazil is not party to the Madrid Protocol.

What are unregistered trade mark rights?

A registered trade mark provides a strong tool to prevent people from using your mark without your permission. However, in cases where a trade mark has been actively used for a considerable period of time (normally, at least 5 years), it is possible that the mark may also have accrued unregistered trade mark rights under the law of "Passing off" or Unfair Competition (depending on the circumstances and on the territory in question).

To demonstrate unregistered passing off rights, it is necessary to provide extensive evidence to show the goodwill in your mark, and this can be difficult. Unregistered rights are therefore not as strong as registered rights, and we would always recommend that you seek to register to your mark whenever possible.

How do I enforce my registered and unregistered trade mark rights?

If someone infringes your registered or unregistered trade mark rights, you may request the relevant national administrator or Court to grant an injunction to stop the infringer from using your trade mark. Additionally, depending on the forum, an award of damages in respect of financial losses resulting from the infringing activity; and/or an order for the infringer to pay a proportion of the legal costs incurred.

There is generally no need to prove that your trade mark has a reputation or "goodwill", and there is frequently no need, in a Court action, to present any evidence that you have used the mark. This is in stark contrast to enforcing unregistered trade mark or passing off rights.

How can I enforce my domain name?

Domain names may be registered in each BRIC country, subject to certain conditions, although significant difficulties may exist for foreign companies to register. Domain names may be enforced according to national practice.

Patents

What is a patent?

A granted patent provides a monopoly or **exclusive** right that is granted for an **invention**. The invention may be a **product** or a **process** that provides a new way of doing something, or offers a new technical solution to a problem. A patent is granted by a **national patent office**. The protection is granted for a limited period, which in the UK and most other countries, including the BRIC countries, is 20 years, provided that annual renewal fees are paid. If the renewal fees are not paid, the patent lapses and third parties may exploit the invention without infringing the patent.

What protection does a patent offer in the BRIC countries?

The owner of the patent has the legal right to stop a third party from commercially **making, using, distributing, selling** or **importing** the patented invention in that country. Any of these actions are called **patent infringement**. Patent rights are usually enforced under administrative proceedings or in a Court, both of which have the authority to stop patent infringement. Patent rights may be enforced should a third party directly copy the invention, or even if they arrive at the invention independently.

However, a patent is a negative right. This means that simply having a patent does not necessarily mean that you can exploit your own invention yourself, but rather that you can stop others using the invention. If your invention requires the use of an earlier patented invention, and the patent for that invention is still in force, permission from the earlier patent owner must be obtained before you can use your invention in any particular country.

What rights does a patent owner have in the BRIC countries?

A patent owner has the right to decide who may, or may not, use the patented invention for the period in which the invention is protected. The patent owner may give permission to third parties to use the invention on mutually agreed terms. This is called **licensing** the patent, and may be used to generate revenue via licensing fees. The patent owner may also sell the right to the invention to someone else, who will then become the new owner of the patent. This is called **assigning** the patent. Once a patent expires, the protection ends, and an invention enters the **public domain**. Once this occurs, the owner no longer holds exclusive rights to the invention, which then becomes available for commercial exploitation by others.

What are the requirements for an invention to be patented in the BRIC countries?

An invention must, in general, fulfil a number of conditions to be protected by an invention patent. It must have an element of **novelty**, i.e. some new characteristic or feature, which is not known in the body of existing knowledge in its technical field. This body of existing knowledge is called "**prior art**". The invention must also involve an **inventive step**, i.e. it must not merely be a minor, obvious development of existing technology, which would have been routinely deduced by a person with average knowledge of the relevant technical field. The invention must also have a **practical use**, and not merely be an abstract idea. Finally, the subject matter of the invention must be accepted as being "patentable" under relevant national law. For example, in the BRIC countries, scientific theories, mathematical methods, plant or animal varieties or essentially biological processes for the production of plant and animals other than microbiological processes and the products of such processes, discoveries of natural substances, commercial methods, or methods for medical treatment (as opposed to medical products) are generally not patentable. Precise exclusions vary from country to country.

When should I file my patent application?

It is recommended that a patent application is filed while the invention is still **confidential**. While it may be generally permissible to discuss the invention with third parties before a patent application has been filed, such discussions should be in strict confidence, and all parties to the discussion should have signed a **Confidentiality Agreement** (also called a **Confidential Disclosure Agreement** (CDA) or **Non-Disclosure Agreement** (NDA)).

If there is a disclosure by the inventor or his assignee, each of the BRIC countries allows a period of grace allowing the inventor to file the application after public disclosure of the invention without invalidating a subsequently filed patent. However, it is generally preferable to file before any such disclosure.

What are the procedures involved in obtaining a patent in the BRIC countries?

The first step in securing a patent for your invention is to prepare a patent **specification**. The specification must also include a **detailed description** of the invention, in clear language and sufficient detail that an individual with an average understanding of the field could use or reproduce the invention. Such descriptions are often accompanied by drawings, plans or diagrams to better describe the invention. The application also contains a set of "**statements of invention**", which define the invention, and determine the extent of protection sought by the eventual patent, if granted. The specific wording of these

statements is critical as they will be examined by the relevant national patent office during examination of the patent application, and by a Court if the patent is ever litigated.

Approximately 18 months after the priority date, the patent application is officially **published**. When this happens, the abstract, description, claims (which may now include any amendments) and drawings are made available to the public. Although it is not possible to enforce a patent until it has been granted, once the patent application has been published it does confer some rights on the applicant. The Patent Office conducts a substantive examination of the application, considering whether the invention defined in the claims meet the requirements of novelty and inventive step. If no objections are raised, and the Office is happy that the claims are acceptable, a Patent is granted. Almost always, however, the Office raises objections against at least some of the claims, and these objections are detailed in a **substantive examination report** issued with a period in which to respond. This process may be repeated if necessary until the patent office is able to make a decision to grant or refuse the application.

It is important to note that the **validity** of the patent may be challenged throughout its life by anyone who may be able to demonstrate that the patent should not have been granted, perhaps because the invention was not new or was obvious.

Do I have to file separate national patent applications in each BRIC country?

Most countries, including all BRIC countries, are party to **The Paris Convention**, an international treaty which enables patent protection to be obtained overseas, provided that foreign patent applications are filed within 12 months from the UK priority date. The foreign patent applications are effectively back-dated to the priority date of the first UK patent application. Hence, filing a UK patent application effectively gives you the option of obtaining patent protection in most countries of the world, so long as foreign patent protection is sought within 12 months from the priority date.

Individual national patent applications may be filed in each country in which protection is required. However, an international system exists that avoids the need to file a large number of applications immediately which is The **Patent Cooperation Treaty (PCT)**, to which a large number of countries, including the BRIC countries, are party. The PCT provides a system under which an International Patent Application can be filed at a Receiving Office under the PCT, e.g. the UKIPO. The application may designate all states (currently there are 151 PCT-contracting states), including Brazil, Russia, India and China. Each designated countries allows the International Patent Application to be transformed from the International

phase into the national phase if certain requirements are satisfied within 30 months (China, Brazil) or 31 months (Russia, India) of the filing of the initial patent application for the invention (the priority date).

Under the PCT procedure, after filing the International patent application, a search is conducted and a preliminary opinion on patentability issued. If desired by the applicant, the patent application may also be subject to a non-binding International Preliminary examination as to patentability which may be helpful in the national phase of the application. At the end of the International phase (30/31 months from the priority date), the applicant is able to assess the likelihood of patentability of the invention and is able to elect the countries in which protection is desired. In each separate national phase, the application is subjected to a further substantive examination, including an assessment of the patentability of the subject matter, before a final decision on the scope of protection allowed or refused.

Utility models

What is a utility model?

A utility model relates to an object of practical use, or part thereof, susceptible of industrial application, presenting a new shape or arrangement and involving an inventive step, resulting in functional improvement in its use or manufacture. The inventive step bar is lower than for patents, however, generally the protection afforded is less broad than that provided by a patent.

Utility models may be obtained in **Brazil** and **China** (see relevant country Insert) and offer a term of 15 and 10 years, respectively, from the filing date.

What kind of protection does a utility model offer?

A utility model offers similar protection as that granted by patents. Although it is not required that the utility models granted in Brazil and China include an inventive step over the prior art to be granted, a valid registration must satisfy all the prescribed requirements, and generally the protection afforded is less broad than that provided by a patent.

It can be a useful and cheaper means of protecting an invention relating to devices and should be considered when seeking protection in Brazil and China.

How do I obtain a utility model?

The procedure is very similar to obtaining patent protection. An application describing the invention including drawings and claims which define the scope of protection sought is filed. The application is subjected to a formalities examination. If the application is deemed to satisfy all requirements, a utility model is granted. A certificate is issued and the utility model published.

Further details may be found in the relevant country insert.

Patent/Certificates of Addition

What is a patent or Certificate of Addition?

A Patent or Certificate of Addition relates to an improvement or development of the invention to which the patent application or patent relates; the subject matter does not have to involve an inventive step over the parent patent or application, but must share the same inventive concept.

A Patent or Certificate of Addition may be obtained in **Brazil** and **India** (see relevant country Insert). It expires at the same time as the main patent. This protection should be considered, e.g. for minor improvements to devices which embody the same inventive concept as the original patent, particularly if such changes are embodied in a commercial product.

How do I obtain a Patent or Certificate of Addition?

The procedure is very similar to obtaining patent protection. An application describing the invention including drawings and claims which define the scope of protection sought is filed. The application is subjected to a formalities examination. If the application is deemed to satisfy all requirements, a Patent/Certificate of Addition is granted.

Further details may be found in the relevant country insert.

Industrial designs

All BRIC countries allow protection for Industrial designs.

What is a design?

The design of a product refers to the outward physical appearance of the product, and is what makes it attractive and therefore appealing to customers. Hence, the design contributes to the commercial value of the product, and increases its marketability.

The definition of a registerable design includes both the 2-dimensional pattern, decoration and ornamentation on the surface of the product, and also the 3-dimensional shape and configuration of the product. The 2D and 3D design of a single product may be simultaneously protected. For example, a chair having an unusual shape, and also having an unusual surface decoration, may be protected by both a 3D and a 2D registered design simultaneously.

A “product”, which may bear a registerable design, refers to any industrial or handicraft item. Examples include medical devices, office tools, household appliances, furniture, vehicles, leisure goods, and luxury items, such as jewellery, and so on.

A product may also include packaging, get-up and component parts intended to be assembled into a complex product.

What protection does a registered design provide in the BRIC countries?

The owner of the registered design has the legal right to prevent a third party from making, using, stocking, distributing, selling or importing any product in which the registered design is incorporated, or to which the design has been applied. Any of these actions is called registered design infringement.

Registered designs are usually enforced by an Administrator or in a Court, both of which has the authority to stop design infringement. The benefit of protecting your design with a registered design is that you can prevent third parties from reproducing your design directly, even if they arrive at your design completely independently, i.e. by accident. Hence, design registration is a true monopoly right, providing much stronger protection than copyright (discussed below), and being much easier to enforce as there is no need to prove that copying has taken place.

What are the requirements for a design to be registered in the BRIC countries?

In order to be validly registered, the design must be new and satisfy certain features of shape/configuration (see individual BRIC country inserts).

A design is considered to be new if it has not been disclosed anywhere in the world before the filing date of a registered design application. However, a grace period is available in all BRIC countries under certain conditions, which enables a valid registration to be obtained provided that a registered design application is filed within 6 months of the earliest disclosure of the design.

Component parts of a “complex” product may be independently registerable. For example, a tea pot and its corresponding lid may be protected with two different registered designs provided that they are new and have individual character. Hence, a number of designs may be registered for any single product.

When should I file my design application?

As with patents, it is recommended that a design application is filed while the design features are still **confidential**. While it may be generally permissible to discuss the design with third parties before an application has been filed, such discussions should be in strict confidence, and all parties to the discussion should have signed a **Confidentiality Agreement**.

If there is a disclosure by the inventor or his assignee, each of the BRIC countries allows a period of grace allowing the designer to file the application after public disclosure of the design without invalidating a subsequently filed design registration. However, it is generally preferable to file before any such disclosure.

What are the procedures involved in obtaining a registered design in the BRIC countries?

In order to file an application for a registered design, a set of representations for each design included in the application is required. This may either be in the form of a set of drawings or, in some cases, digital photographs of the product bearing the design are acceptable.

Whereas all BRIC countries carry out an examination for formal requirements, only Russia conducts an examination as to the novelty of the design. Generally, a design application will proceed to registration without substantial delay.

Generally an application must relate to a single article but, in some cases, can contain up to 20 variations.

The periods of protection for a registered design in the BRIC countries vary (see relevant country insert).

Do I have to file separate national registered design applications in each country?

Yes. The BRIC countries are not party to the International Convention associated with design rights (The Hague Convention).

Copyright

What is copyright?

Copyright is a form of Intellectual Property Right (IPR) covering works that fall into three main classes:-

- i) original literary, dramatic, musical and artistic works;
- ii) sound recordings, films, broadcasts or cable programs; and
- iii) the typographical arrangement of a published edition.

Other forms of copyright also exist, but are outside the present scope.

It is important to note that copyright protection does not depend on the artistic or literary merit or quality of the work. However, in order to attract copyright, the work must be original (i.e. not a copy of an existing work), and the author must have demonstrated sufficient skill, labour and effort to produce the work to justify copyright protection.

How is copyright obtained?

Unlike other forms of Intellectual Property, copyright does not generally have to be actively applied for. Copyright is therefore free to acquire. Copyright arises automatically as soon as a work is created. Nevertheless, in spite of this, it is prudent to register a copyrighted work, for example, with an attorney or with the relevant national copyright registration authority, as it may make it easier to prove that copyright existed in the work on a particular date. This could be important should infringement occur, as you will need to establish, possibly in a Court of law, that copyright does subsist in the work.

In addition, we recommend that copyright owners safely store at least the first original copy of any copyrighted work. Such copies should ideally be dated, signed by the author and also witnessed by an independent witness (such as a Notary Public).

Most countries, including the BRIC territories, are party to various international Treaties, such as The Berne Convention, which enable copyrighted works to be recognized overseas,

How long does copyright last in the BRIC territories?

In general, for literary, dramatic, musical, and artistic works, the term of protection expires at the end of 50 (China), 60 (India) or 70 years (Brazil, Russia) from the end of the year in which the author of the copyrighted work dies. Other forms of copyright protection may have

different terms, for example Software IP is treated as a separate category in Brazil providing protection for 50 years.

What kind of protection does copyright offer in the BRIC territories?

Copyright is usually enforced in a Court, which has the authority to stop copyright infringement. Copying must be demonstrated by the copyright owner for infringement to be found. Therefore, copyright cannot be enforced should a third party coincidentally produce the copyrighted work completely independently.

Infringement may occur when the whole or a substantial part of the work is copied, and this is judged in qualitative (i.e. the substance of the work that has been copied) rather than quantitative (i.e. the amount of the work that has been copied) terms.

Furthermore, infringement can occur if the copyrighted work is copied in any form, i.e. either in 2D or 3D. For example, if the copyrighted work is a 2D drawing of a character, then infringement would be found if the character was copied in 2D or reproduced in 3D, e.g. as a doll or puppet.

When do I use the copyright symbol, ©?

We recommend copyright owners include a copyright notice, which clearly indicated that the work is protected by copyright. The notice should include the copyright symbol, ©, the date (usually just the year) the work was produced, and the name of the copyright owner, although the precise order is not important.

Intellectual property rights in Brazil

Conducted in association with: Daniel Advogados, Rio de Janeiro, Brazil

General

It is possible to obtain a variety of IP rights in Brazil which afford different degrees of protection, ranging from the aesthetic appearance of a device (industrial designs) and product enhancement features (utility models and certificates of addition) through to the protection of inventive features by one or more patents. In addition, protection is also afforded to registered trademarks on a first-to-file, first-served system (a few exceptions to this system are also provided by the Brazilian IP Law, on specific cases).

The Brazilian Patent and Trademark Office (BPTO) is the government authority responsible for examining and granting protection to industrial designs, patents, utility models, geographical indications and trademarks in the country. During recent years, Brazil's booming economy had great impact on the BPTO, which has been facing since then a continuously growing demand for its services. The Office has improved its systems and hired more examiners to cope with the robust demand, especially in the number of patent and trademark filings from throughout the world.

Despite recent investments, the BPTO still faces a considerable backlog of work and is taking, on average, 5 years to grant a non-chemical patent and 3 to 5 years to issue a trademark registration, provided the trademark proceeds towards to registration and no oppositions are filed. In the long term, the BPTO is expecting to reduce this backlog and, consequently, the average term for granting IPRs to 1 to 2 years in order to be in line with US practice.

The economic growth experienced in Brazil over the past decades has turned the country into a major economic market for infringers as well. The enforcement of IPRs is grounded not only on the Brazilian IP Law but also in other relevant statutes such as the Copyright act and antitrust laws, which provides consistent protection for IP owners.

As far as enforcement measures in Brazil are concerned, the Brazilian Law provides judicial and non-judicial measures in both civil and criminal spheres, including but not limited to cease and desist letters, infringement actions, preliminary injunctions, and search and seizure orders.

Enforcement of IP rights

Arbitration: Dispute resolution via arbitration is provided by the Law, though there are still some controversial issues concerning the scope of arbitration proceedings regarding IPRs in Brazil, especially concerning the validity of patents. Arbitration proceedings are also foreseen regarding domain name disputes.

Civil action: There are no special courts exclusively dealing with IPR cases, although some cities assign certain courts to rule, on a non-exclusive basis, IPR-lawsuits such as Rio de Janeiro and São Paulo. Rights owners must in principle file lawsuits before a Court with seat where the infringer is located, but it is possible to discuss the venue and file the lawsuit before a major city such as Rio de Janeiro or São Paulo in order to increase chances of success in the litigation.

It is possible and rather common for plaintiffs to request ex parte preliminary injunctions based on the urgency of the request and concrete evidence of the rights being infringed. Decisions by the trial judge may be reviewed by the State Court of Appeals.

E-filing systems and electronic files are being implemented throughout Brazil's main cities and as a reflex proceedings are being significantly expedited both at trial courts and courts of appeals.

Criminal prosecution: Actions against the infringement of all types of IPR may be brought under Brazil's Penal Code & specific IP legislation and remedies include detention (which is usually converted into alternative penalties) and fines.

Filing criminal preparatory search and seizure actions may be a good strategy to enforce IP rights in Brazil as the court will appoint two experts who will seize a sample and issue an expert report in which the infringement is confirmed or not. This piece of evidence may be particularly useful when it comes to patent infringement as courts are often reluctant in granting ex parte preliminary injunctions strictly based on the evidence which is partially produced by the plaintiff. Filing a formal criminal complaint based on the expert report is not mandatory so that the evidence may be used only in the civil sphere, depending on the strategy to be adopted on a case-by-case basis.

Choosing between a civil and criminal complaint will depend on the circumstances of each particular case and both venues may be combined.

Customs may play an important part in seizing goods but as there is no central database in Brazil for such purposes it is necessary for IPR owners to provide training and establish a good relationship with custom authorities in order to increase chances of having counterfeit goods seized.

Intellectual Property Office

Instituto Nacional da Propriedade Industrial: www.inpi.gov.br

Trade marks

Term: Once granted, a trade mark is valid for 10 years, renewable for additional 10-year terms (renewal may be requested indefinitely, during the last year of validity of a trademark). Though there is no use requirement, trademarks issued for more than 5 years are susceptible to forfeiture proceedings based on non-use by any legitimate interested party.

Specific requirements in Brazil: Any trademark that distinguishes the products and/or services of a company and is capable of graphic representation can be protected as a trademark.

Priority rights: Brazil follows a first-to-file principle in which the first applicant can expect to secure registration of the trademark. However, a third party who has been using a trademark in good faith at least for 6 months prior to the filing may oppose the mark (and file its own application within 60 days of the opposition, enjoying preferential rights over the registration, which constitutes an exception to the first-to-file system).

Domain names

Domain names may be registered in Brazil. The registration of domain names “.br” in Brazil may be requested by foreign companies directly, upon compliance with certain requisites, including either the submission of a letter of commitment that the foreign owner will establish its business in Brazil within a 12-month period and appoint a local representative, who will be the main contact for the domain name registration, or obtain registration through a local company. As domain name registration in Brazil follow the first-to file principle, ADR proceedings were recently introduced as an important tool to recover domain names registered by third parties.

Patents

Term: 20 years from the filing date, no less than 10 years from the grant date. The patent owner has the right to obtain compensation in case of infringement from the date of the publication of the patent application.

Novelty requirements: Absolute novelty (public disclosure anywhere in the world), although any disclosure within a 12 months grace period by the inventor will not invalidate any subsequently filed patent rights.

Procedure: Publication of the unexamined application occurs at 18 months after filing the application; the applicant must file the request for examination within 36 months from the

filing date. A substantive examination of the application considers novelty, inventive step and industrial application before a final decision is made whether to grant or refuse the application. Typically this process takes 7-10 years.

PCT Procedure: Additionally, Brazilian patent applications may be filed through the PCT which provides for an international search of the application before a decision has to be made by the applicant to enter the Brazilian national phase where the application is examined for formal and patentability requirements by the BPTO.

It is to be noted that for Brazilian national patent applications directed to pharmaceuticals, an extra examination stage is incorporated into the patenting procedure as all applications must be considered by the Brazilian National Agency for Sanitary Surveillance (“ANVISA”) of the Ministry of Health before allowing any application to proceed to grant.

Certificates of Addition

A Certificate of Addition relates to an improvement or development of the invention to which the patent application or patent relates; the subject matter does not have to involve an inventive step over the parent patent or application, but must share the same inventive concept.

Term: The unexpired term of main patent

Novelty requirements: Absolute novelty (public disclosure anywhere in the world), although any disclosure within a 12 months grace period by the inventor will not invalidate any subsequently filed patent rights.

Procedure: Examination follows the same rules for the main application with exception of the analysis of the inventive activity in view of the parent case. Nullity proceedings may be requested at any time during the lifetime of the certificate of addition.

Utility models

A utility model relates to an object of practical use, or part thereof, susceptible of industrial application, presenting a new shape or arrangement and involving an inventive step, resulting in functional improvement in its use or manufacture. The inventive step bar is lower than for patents.

Term: 15 years from the filing date, no less than 10 years from the grant date.

Novelty requirements: Absolute novelty (public disclosure anywhere in the world), although any disclosure within a 12 months grace period by the inventor will not invalidate any subsequently filed utility model rights.

Procedure: Examination for formalities only (novelty/registerability may be requested by applicant during the entire term) after which the application is published and a certificate of registration issued. Nullity proceedings may be requested at any time during the lifetime of the utility model.

The cost of registering a utility model is of the same order as obtaining a patent.

Industrial designs

An industrial design concerns any ornamental 3-D form of an object, or any ornamental arrangement of lines and colours that may be applied to a product, which provides for a new and original visual result in its external configuration and which may serve as a model for industrial manufacture.

Term: 10 years from the filing date, renewable for further 5 year periods up to a maximum of 25 years.

Procedure: Examination for formalities only (novelty/registerability may be requested by applicant during the entire term) after which the application is published and a certificate of registration issued. Nullity proceedings may be requested under certain circumstances.

Copyright

Copyrights are protected in Brazil whether or not registered, as registration is not mandatory under the Copyright Statute. However, registration is usually advisable before an authorized entity in order to secure the term of protection, as well as the ownership over the copyright.

Term: 70 years after author's death for all forms of creative work, including music and literature.

Rights are granted for software innovations in Brazil and treated as a special category, akin to copyright but which is registered with INPI. They have a term of 50 years from filing.

Intellectual property rights in Russia

Prepared in association with: Gorodissky & Partners LLC, Moscow, Russia.

General

It is possible to obtain a variety of IP rights in Russia which afford different aspects of IP protection, particularly patents for inventions, utility models, industrial designs which feature an aesthetic appearance of a device, trademarks, service marks and appellation of origin of goods.

When an application is filed with the Russian Patent Office, be it for an invention patent or a trademark, the Patent Office commences examination of the application within approximately 12 months. A utility model application is examined within approximately two to three months of filing because no substantive examination is conducted. There are no significant backlogs in registration procedures.

Enforcement of IP rights

Russian law has detailed provisions on registration and enforcement of IPR.

Depending on the nature and gravity of the infringement, administrative, civil or criminal remedies are available.

IPR infringement issues are dealt with by the commercial courts and common courts. A specialized IP court within the system of the commercial courts commenced operation in 2013.

Administrative remedies: The Code of Administrative Offences states that unlawful use of IP is punishable by confiscation of the infringing goods and an administrative fine in the amount of several thousand US dollars. The court considers the case within 15 days of receipt of the statement of case. An administrative court case is to be initiated by a government body, such as the police or Customs. This is the basic difference between an administrative case and a civil case in which the IP owner himself initiates a case in court. The IP owner may participate in the administrative case as a third person helping the police (Customs) to prove that infringement took place. His participation improves the chances of success. The administrative case results (if infringement is proved) in fining the infringer in favour of the state and destruction of the counterfeit goods, no damages can be claimed within the administrative procedure. There is also a special administrative procedure at the

Anti-Monopoly Authority on the grounds of unfair competition; the authority issues a directive ordering the infringer to stop the unlawful activities.

Civil remedies: The IP owner may initiate a civil case in court and demand the cessation of infringement and actual damages, lost profits and costs, as well as recovery of the profits received by the infringer. In a case of a trademark, the owner may demand compensation instead of damages. Unlike damages, the IP owner does not have to prove that he sustained losses but may simply demand a certain amount of money (up to \$170,000) which will be examined and possibly moderated by the court. The counterfeit goods shall also be destroyed, as with an administrative case.

Injunctive relief forbidding the defendant to perform actions related to the subject matter of proceedings or ordering the seizure of the defendant's property is available in both civil and administrative proceedings. The court considers the petition for injunctive relief no later than the day after the claimant files such a petition with the court.

Civil proceedings take longer period than administrative proceedings and usually take three to five months to obtain a judgment at the first instance court.

Criminal remedies: The law allows also for criminal prosecution of the infringement. A criminal action may be initiated if the damage caused to the trademark owner is approximately \$50,000 or more. In a case of patent infringement, the threshold for a criminal action is not determined by law and shall be defined by court. The law sets forth only that the damage should be substantial. The outcome of the criminal action is a sentence for the criminal (forced labour or imprisonment up to six years) and destruction of counterfeit goods.

Intellectual Property Office

ROSPATENT: www.rupto.ru

Trade marks

Term: Once granted, a trade mark is valid for 10 years, renewable for further 10 year periods indefinitely. A third party may apply for cancellation of the mark if it is not used in the 3 years preceding the date of the cancellation action being brought.

Specific requirements in Russia: A trademark is defined as a distinctive sign serving for the individualisation of goods and services of legal entities and individual entrepreneurs. Registerable are signs which are capable of distinguishing the goods or services of one person from those of others and may include words, images, 3-D shapes, colours or combinations thereof as well as sound marks, animation marks and position marks.

In addition, collective marks (mark of a union, business association, concern or voluntary organisation of enterprises being capable of distinguishing goods manufactured/commercialised by it having common characteristics as to quality) may also be registered.

Domain names

Domain names may be registered.

There is no requirement of a local presence for obtaining a domain name in Russia.

A corresponding national trademark application is not required because it is the registrant (not the Registrar) who is responsible for possible trademark infringement.

In order to register a domain name, the full name, address, phone, fax and e-mail of the future owner of the domain name is required.

The costs of the domain name registration in .RU and .PФ (RF in Cyrillic) TLD are approximately \$25.

If the domain name owner is interested in having his registered domain name functioning he should provide the names and IP addresses of two DNS servers (primary and secondary) placed in different networks and each of them should contain the corresponding SOA record.

Patents

An invention patent is granted for any technical solution relating to a device, a substance (or their use) or a process.

Term: 20 years from the filing date. Provisional protection is afforded from the date of publication of the application (18 months from filing) to the date of publication of the patent. Unlike the UK, patents in Russia may be directed to methods of treatment of the human or animal body.

Novelty requirements: Absolute novelty (public disclosure anywhere in the world), although any disclosure within a 6 months grace period by the inventor will not invalidate any subsequently filed patent rights.

Procedure: A national application may be filed at the Russian patent Office. If the application documents are complete, publication of the unexamined application occurs at 18 months after filing the application; within 3 years of the filing date, a request for substantive examination must be filed. The examination addresses formality issues and after that, novelty, inventive step and industrial application before a decision is made whether to grant or refuse the application. Typically, this process takes 12 to 18 months. There is no provision for a third party opposition period after grant, but nullity proceedings can be requested throughout the lifetime of the patent.

If an invention is created in Russia by a Russian applicant², a patent application must be filed first in Russia to allow for examination for state secrets.

A patent application may be transformed into a Utility Model application before grant.

PCT Procedure: Additionally, Russian patent applications may be filed through the PCT which provides for an international search of the application before a decision has to be made by the applicant to enter the Russian national phase where the application is examined for formal and patentability requirements by the Russian patent office.

Eurasian Procedure: As a further option, Russian patent applications may be filed through the Eurasian Patent Convention which may be of advantage if protection in other Eurasian member states is required. The Eurasian patent covers Russia, Belarus, Azerbaijan, Armenia, Moldova, Kazakhstan, Kyrgyzstan, Tajikistan and Turkmenistan.

² It is prohibited to classify a patent application as a state secret if the applicant is a foreign citizen or a foreign legal entity.

Utility model patent

A utility model can be granted for a device which is new and industrially applicable. Utility models are not granted for processes, substances etc. which are not considered to be an apparatus or device.

Term: 10 years from the filing date, extendible by up to 3 years.

Novelty requirements: Information published anywhere in the world and public prior use in Russia, although disclosure within a 6 months grace period by the inventor will not preclude filing a utility model application.

Procedure: A formal examination is conducted to verify that the requirements for grant are satisfied, including unity of invention, completeness of the application documents and whether the claimed solution is a technical solution protectable as a utility model. There is no examination of inventive step.

An invention patent application may be transformed into a Utility Model application before grant.

Assignments of the utility model occurring after filing the application must be recorded at the Patent Office.

The cost of registering a utility model is of the same order as obtaining a patent.

Design patent

A design patent is granted for the artistic and design solution of a factory-made or home-made article which determines the appearance of the article. The significant features of the design are those determining the aesthetic and/or ergonomic characteristics of the appearance of the article, including the form, configuration, decoration and colour pattern.

Term: 15 years from the filing date, extendible by up to 10 years.

Novelty requirements: Absolute novelty (public disclosure anywhere in the world), although any disclosure within a 6 months grace period by the inventor will not preclude filing a design application.

Procedure: Examination for formal requirements is followed by a substantive examination as to the registerability of the design after which application is published and a certificate of registration issued.

Copyright

It is not necessary to register copyright in Russia, but depositing with local agents, e.g. Gorodissky & Partners, may help during any dispute as to ownership.

Term: 70 years after author's death for most forms of creative work, including music and literature.

Intellectual property rights in India

Conducted in association with: S. Majumdar & Co., Kolkata, India

General

It is possible to obtain a variety of IP rights in India which afford different degrees of protection, ranging from the aesthetic appearance of a device (industrial designs) and product enhancement features (Patents of Addition) through to the protection of inventive features by one or more patents. Registered trade marks may be used to indicate the origin of goods.

Due to shortage of skilled staff, the Indian Patent Offices are overloaded with severe backlogs. However, in recent times the Patent Office has tried to clear the backlogs by digitization of all records, enabling e-filing and speeding up the issuance of examination reports and grant of Patents within three weeks for recently accepted cases and also trying to grant Patents for applications that were accepted for grant a few years ago but are still pending. The Indian Patent Office is putting in steady efforts to clear the huge backlog of pending patent applications, with a view to protecting the interest of patent applicants. The Intellectual Property Appellate Board (IPAB) which came into effect from 2 April 2007 has been instrumental in speeding up appellate decisions which are filed before it from the decisions of the Controller and the Registrars.

Enforcement of IP Rights

Mediation before litigation is encouraged.

Civil Action: Civil actions may be effective in halting infringing activities, but large awards of damages are uncommon. There is a backlog of cases at both the civil and criminal courts. This means that cases can run for five years or more. The Indian judicial system is balanced and comes down heavily on IPR infringers. In addition, the readiness of the Indian courts to grant interim injunctions usually means an infringement is halted pending the outcome of a case. Having said the above it is not uncommon for attorneys to seek multiple extensions and delay legal proceedings. Other factors which hamper IPR enforcement include a general lack of understanding of IP Laws, failure to formulate summary procedures for IPR matters, for example IPR is treated in the same queue as other civil litigation and fast track systems have not yet been implemented despite specific directions from the Supreme

Court. Additionally, there are no specialised IP Courts other than the IPAB which is also grossly lacking resources and infrastructure.

Criminal Prosecution: Indian law provides that under certain circumstances criminal prosecution may be brought for copyright and trademark infringement with penalties including fines and/or imprisonment. Pursuing criminal action has a few disadvantages, including the fact that the state takes over the prosecution and infringers often receive lenient sentences. Nevertheless, press coverage of a raid, along with word-of-mouth publicity, can heighten awareness of a trader's IP rights, and discomfit defendants sued in civil actions.

The Indian Patent's Act and Designs Act provides only civil remedies against acts of infringement. Criminal Actions against the infringement of trade mark and copyright as well as criminal breach of trust depend on the circumstances of each case, the nature of the goods/services and, under copyright law, conditions under which an accused work is created and used, as well as the provisions of Fair Acts. Remedies in a case of infringement include police action and criminal complaint before the police or a judicial magistrate.

In addition, IPR laws allow a right holder (patent, trade mark, copyright, design, and geographical indication) to apply to Customs to record its rights and prevent the import of infringing goods. Customs is empowered to seize and confiscate goods that are imported or attempted to be imported contrary to any prohibition imposed under the law.

Intellectual Property Office

Controller General of Patents, Designs, and Trade Marks: <http://www.ipindia.nic.in/>

Trade marks

Term: Once granted, a trade mark is valid for 10 years, renewable for further 10 year periods indefinitely.

Specific requirements in India: Trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours. The word “mark” is defined to include a device, brand, heading label, ticket, name, signature, word, letter, numeral, shape of good, packaging or combination of colours or any combination thereof...The word “mark” is to be construed broadly and no type of sign is automatically excluded from registration. Marks which will require special consideration are colours, shape of goods, sound and smells.

Domain names

Domain names may be registered through [accredited .in registrars](#).

In India, domain names can be protected as a trade mark. If an impugned domain name is registered with the .IN registry an arbitration proceedings can be initiated at the .IN Registry.

Use of a trade mark as a domain name also amounts to infringement. Domain names are also treated as trade marks in as much as they are used in trade and commerce. Mala fide use of domain names incorporating trade marks of a proprietor can also be challenged in a Court of Law.

Unfair competition

This law covers unregistered IPRs. Protection against unfair competition has been recognised as one of the main objectives of intellectual property system. India recognizes a separate tort of unfair competition (and unjust enrichment). As far as trade marks are concerned, the law does not expressly define passing off, however section 135 of the Trade Marks Act 1999 provides for relief in suits for infringement or for passing off. Similarly, unregistered copyright is also protected.

Patents

Term: 20 years from the filing date, no less than 10 years from the grant date. Provisional protection is afforded after publication of the patent application at 18 months.

Novelty requirements: Absolute novelty (public disclosure anywhere in the world), although any disclosure within a 12 month grace period by the inventor will not invalidate any subsequently filed patent rights.

Procedure: Publication of the unexamined application occurs at 18 months after filing the application; an examination of the application is conducted for novelty, inventive step and industrial application before a decision is made whether to grant the application. Typically, this process takes 5-8 years. Pre-grant opposition may be filed by any party. A third party (interested party) may file an opposition within 12 months of grant.

The invention must be worked in India. The Controller has the power to call for information such as periodical statements as to the extent to which the patented invention has been commercially worked in India. Every patentee and licensee has to furnish a statement regarding the working of the patented invention on commercial scale in India at regular intervals (not less than six months). Importation does not count towards the working of the invention.

PCT Procedure: Additionally, Indian patent applications may be filed through the PCT which provides for an international search of the application before a decision has to be made by the applicant to enter the Indian national phase where the application is examined for formal and patentability requirements by the Indian patent office.

Patents of Addition

A Patent of Addition relates to an improvement or development of the invention to which the patent application or patent relates; the subject matter does not have to involve an inventive step over the parent patent or application, but must share the same inventive concept.

Term: Unexpired term of main patent.

Novelty requirements: Absolute novelty (public disclosure anywhere in the world), although provision is made for a grace period under special circumstances.

Procedure: Examination for formalities only (novelty/registerability may be requested by the applicant during the entire term), after which an application is published and a certificate of registration issued. Nullity proceedings may be requested at any time during the lifetime of the patent/patent of addition. There is no requirement for examining inventive step but novelty is examined in the same way as an ordinary patent application. No annuity is

payable. A patent of addition may be converted into an independent patent under certain conditions.

Industrial designs

An industrial design concerns any ornamental 3-D form of an object, or any ornamental arrangement of lines and colours that may be applied to a product, which provides for a new and original visual result in its external configuration and which may serve as a model for industrial manufacture.

Term: 10 years from the filing date, renewable for one further 5 year period.

Procedure: Examination for formalities and registerability only. The design is published for the first time after registration and a certificate of registration issued. Nullity proceedings may be requested at any time during the lifetime of the design starting from the date of registration.

Copyright

It is not necessary to register copyright in India, but registering with the Copyright Office may overcome any dispute as to ownership.

The copyright to works created within a business belongs to the employer or the recipient of the service unless there is an agreement to the contrary.

Term: 60 years after author's death for most forms of creative work, including music and literature.

Intellectual property rights in China

Conducted in association with: CCPIT Patent and Trademark Law Office, Beijing, China.

General

It is possible to obtain a variety of IP rights in China which afford different degrees of protection, ranging from the aesthetic appearance of a device (Industrial designs) and product enhancement features (Utility Models) through to the protection of inventive features by one or more patents. In addition, Registered Trade Marks may be used to indicate the origin of goods.

IPRs granted in China do not extend to Hong Kong or Macao which have their own IP laws. However, a granted patent in China can be used as the basis to register a Hong Kong standard patent.

Generally, there are no significant backlogs in IP registration or enforcement procedures. On the trade mark side, it takes about ten months for a new trade mark application to mature as a registration, if everything goes smoothly. There are currently about 50,000 review cases pending at the Trademark Review and Adjudication Board (TRAB), the body which considers appeals from the Trademark Office. However, considering that TRAB adjudicates around 150,000 cases per year, this backlog does not represent a serious problem. On the patent side also, delays in registration/enforcement procedures do not present any significant issues.

IPR legal systems have been developed and enhanced in China since the 1980s in line with belief that IPR is of great importance to the development of the national economy and social culture. China regularly updates its IPR laws in harmony with international developments and to emphasise and improve the mechanism of IPR enforcement. Following significant efforts by the Chinese government over the years, public awareness of IPRs in China has been greatly enhanced and it is accepted in business circles that observation of IPRs is important. In China, developments in IPR have balanced the interests of IPR owners and the public and further measures against IPR abuse have been adopted. For example, the General Rules of Civil Law, the Contract Law and Unfair Competition Law all include some provisions against the IPR abuse which is common against Chinese and foreign businesses. In addition, the Patent Law of China specifically provides for compulsory licences in cases

where the exercise of patent rights has a negative impact on competition which needs to be eliminated or reduced.

Enforcement of IP rights

In cases of infringement, if initial approaches to stop the infringement are unsuccessful, the parties may attempt to resolve the issues through mediation, although success may be limited.

Depending on the nature and gravity of the infringement, **administrative, civil or criminal remedies** are available.

Administrative Enforcement: It is necessary to file a request in writing and evidence with the Authority which includes an identification of the infringer and the location of the infringing goods. Some Administrative Authorities may conduct a seizure raid. If the Administrative Authority considers that there is infringement, it may order the immediate cessation of the infringing acts. It is noted that the potential infringer may appeal to the competent People's Court.

Judicial/Civil Action before the People's Court: The plaintiff can request a cease to the infringing activities and compensation for damages and costs. A preliminary injunction and property preservation may also be requested. This process may bring greater relief against infringing activity but involves a more formal procedure than Administrative Enforcement and is more time consuming, involving higher costs.

Criminal prosecution: The Criminal Code provides that forging of another's patent is a criminal offence if the circumstance is serious. Penalties include a term of imprisonment, detention and/or a fine. Taking criminal action will depend on the circumstances in each particular case.

Urgent measures such as property preservation and interim injunctions to halt infringing activities are also available. Customs may play a part in seizing goods, for example in a case where a patentee discovers that goods suspected of infringement are about to be imported or exported, he may apply to the customs office that certain shipments are detained in customs.

Intellectual Property Office

State Intellectual Property Office of the PRC: www.sipo.gov.cn/sipo

Trade marks

Term: Once granted, a trade mark is valid for 10 years, renewable for further 10 year periods indefinitely.

Specific requirements in China: A trade mark is any visual sign capable of distinguishing the goods or services of a natural person, legal entity or other organisation from those of others and may include words, designs, letters, numerals, 3-D symbols, combinations of colours or any combination thereof. Shapes arising from the technical nature of the goods, sound marks, fragrance marks and taste marks are presently not registerable.

In addition, collective marks (mark of a union, business association, concern or voluntary organisation of enterprises being capable of distinguishing goods manufactured/commercialised by it having common characteristics as to quality) and certification marks may be registered as trade marks.

It is advisable to register marks in Chinese as well as any foreign language.

Domain names

Domain names may be registered. It is necessary to supply details regarding the identity of the applicant and the contact of the domain name registration, together with various other requirements.

However, in practice, as the ID materials of the natural person or organization outside China cannot be verified by most of the Registrars in Mainland China, natural persons or organisations outside China find it difficult to register .cn domain names through most of the Chinese sponsoring registrars.

It is suggested that the .cn domain names and Chinese domain names be registered under the name of Chinese entities for the China branch or office of a foreign entity.

Unfair competition

Protection for Trade Secrets is provided for in the Law against Unfair Competition. A person may be liable for infringement by obtaining, disclosing or using another person's trade secret or enabling others to do so. Remedies include an injunction against further disclosure, return of the media carrying the trade secrets to the owner and a fine.

In particular, in the case of well-known marks, Unfair Competition Law provides remedies against the use of the specific (or similar) name, packaging and decoration of the well-known products, which may confuse consumers in distinguishing the products from well-known products; advertisements or other methods shall not be used to make false claims for the quality, composition, function, use, producer, efficacy or place of production of products; advertising companies shall not be an agent of, or design, or make, or make false advertisements, if it knows or should know the truth and managers shall not provide false facts to damage the business reputation or product fame of the other competitor.

Invention patents

Term: 20 years from the filing date. Provisional protection is afforded after publication of the patent application at 18 months.

Novelty requirements: Absolute novelty (public disclosure anywhere in the world).

Procedure: A national application may be filed at the Chinese Patent Office. If the application documents are complete, publication of unexamined application occurs at 18 months after filing the application (early publication may be requested at the time of the filing); within 3 years of the filing date, a request for substantive examination must be filed. The examination addresses formality issues in addition to assessing novelty, inventive step and industrial application before a decision is made whether to grant or refuse the application. Typically this process takes 2.5-3 years. There is no provision for a third party opposition period after grant, but nullity proceedings can be requested throughout the lifetime of the patent.

If an invention is created in China, a foreign filing license must be obtained before this invention can be filed outside China

PCT procedure: Additionally, Chinese patent applications may be filed through the PCT which provides for an international search of the application before a decision has to be made by the applicant to enter the Chinese national phase where the application is examined for formal and patentability requirements by the Chinese patent office.

Utility model patents

A utility model can be granted for any new technical solution which relates to the shape or structure of a product, or to the combination of the shape or structure, and which is inventive and which is apt to be used in practice. Utility models are not granted for processes,

products without a definite shape, products that have retained the same overall form but use different materials or are produced by different techniques or substances.

Term: 10 years from the filing date.

Novelty requirements: Absolute novelty (information published and public prior use anywhere in the world).

Procedure: A formal examination is conducted to verify that the requirements for grant are satisfied, including unity of invention, completeness of the application documents and whether the claimed solution is a technical solution protectable as a utility model. There is no examination of inventive step.

The cost of registering a utility model is of the order of half that of obtaining an invention patent.

For important inventions that need to be protected immediately, it is advisable to adopt a dual filing strategy by filing both a utility model and an invention patent application at the same time in China, so as to get protection quickly under the earlier granted utility model patent (the pendency of the utility model application is around half a year from the Chinese filing date) and then get a continuous and stable patent protection through the later granted invention patent (the pendency of the invention patent application is around 2.5 to 3 years from the Chinese filing date). Under the dual filing strategy, the utility model patent may be abandoned after the invention patent is granted if there is “double patenting”.

Industrial design patents

A design patent is granted for any new design of shape, pattern or combination thereof or combination of colour with the shape or pattern, of a product, which creates an aesthetic feeling and which is fit for industrial application.

Term: 10 years from the filing date.

Novelty requirements: Absolute novelty (prior publication and public use anywhere in the world).

Procedure: Examination for formal requirements for the design application, after which a patent certificate is issued and the design is published.

Copyright

Unlike the UK, the copyright to works created within a business belongs to the employee³ or service provider unless there is an assignment agreement.

It is not necessary to register copyright in China, but registering with the Copyright Office may overcome any dispute as to ownership. This avoids a common source of delay caused by the authorities and courts establishing ownership of copyright.


Term: 50 years after author's death for most forms of creative work, including music and literature.

February 2017

³ For two years from the creation of the copyright work, the employee cannot licence the work without the consent of the employer.

contact@adamson-jones.co.uk | Nottingham +44 (0)115 947 7977 | Leicester +44 (0)116 478 7100

www.adamson-jones.co.uk

 @AdamsonJones |  adamson-jones

 Nottingham  Leicester  London

© Adamson Jones IP Limited. Company registration number 7188937
Registered Office: BioCity Nottingham, Pennyfoot Street, Nottingham NG1 1GF United Kingdom