



IP and trade mark news – January 2022

A monthly update on global IP and trade mark news from the member firms of the Legal Network International (LNI).



China

Beijing Intellectual Property Court announced in a press conference on 23 December 2021, that it is taking more effective measures to deal with bad faith trademark registrations and other activities which may negatively impact China trademark registration. These measures include disclosing bad faith trademark applicants and those who handle their applications, as well as establishing a special mechanism whereby the Court could suggest or request the China National Intellectual Property Administration initiate an ex officio, trademark invalidation review in a particular case. These are all welcome developments in the Chinese IP regime.



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France

France saw order n° 2021-1658 entered into force on 15 December 2021. It rules on software creations and inventions by individuals who are neither employees nor agents of the state. This means it mainly concerns creations made by trainees, foreign doctoral students or international corporate volunteers (a specific French status for young professionals sent abroad). The rights of a creation or invention belong to the private or public legal entity employing the individual creator or inventor. For software, no financial reward is due by the legal entity and for inventions, the individual should receive an indemnity of which the amount will depend on the nature of the invention.

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www.jpksenty.com/



India

Tata Sons Private Limited ("Tata Sons") filed a trademark infringement case against two companies which sell cryptocurrencies (TATA Coin and \$TATA) alleging that such coins adversely affected their business and resulted in dilution of goodwill. These two companies are located in the United Kingdom and the United States and their crypto currencies can be purchased by any person in India. The Delhi High Court held that mere accessibility to purchase crypto currencies in India does not give the Court jurisdiction to enforce an Indian trademark over a foreign company. An overt intent to target customers within India, by virtue of their name's semblance to the trademarked "Tata", needs to be established for infringement to be proven. [Learn more here.](#)



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Ireland

The Controller of Intellectual Property in Ireland approved a new practice note on 22 December 2021 in relation to evidence of novelty for patent applications made pursuant to the Patent Cooperation Treaty ("PCT"). The question had previously arisen as to whether an applicant can, under the Patents Act 1992 (as amended), nominate evidence not yet available as part of the applicant's PCT application. The new practice clarifies that such evidence can now be nominated subject to certain conditions. The effect of this practice note is that the Controller will, in lieu of a search report and written opinion, accept a statement that indicates the intention to submit evidence. Such a statement must accompany the PCT application and may not be made thereafter.

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Italy

The Court of Justice of the EU on 28 October 2021 (Case C-123/20) provided clarification on Community designs. According to Article 4, 6 and 11(2) of Regulation no. 6/2002 on Community designs; for a part of a product to be eligible for unregistered design's protection, it must be disclosed to the public, in a way so that it is known by professionals, for example, by the publication of photographs, and must be perceived as a visible part of the product, clearly delimited by lines, contours, colours, shapes or a particular surface structure.

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Mauritius

Mauritius is a member of the World Intellectual Property Organisation ('WIPO'), the global forum for intellectual property (IP) services, policy, information and cooperation. It is also a signatory to the Paris Convention for the Protection of Industrial Property, the Universal Copyright Convention, and the Berne Convention. In the 14th Edition of the Global Innovation Index Report published by WIPO in September 2021, Mauritius and South Africa are the only countries in sub-Saharan Africa to rank in the top 65 countries with Mauritius maintaining its ranking, placing itself 52nd worldwide for the 2nd year in a row and retaining 1st spot in Africa. Moreover, Mauritius has signed several bilateral trade agreements, which include IP aspects, with several African countries allowing Mauritian based businesses preferential access to key African markets.



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Mexico

One of the great IP challenges for Mexican Patents and Trademarks Office in 2022 is to achieve compliance with the General Law for Protection of Cultural Heritage of Indigenous and Afro-Mexican People and Communities. This law seeks to avoid misappropriation and use, exploitation, non-authorised commercialisation or reproduction of the traditional knowledge and cultural expressions of indigenous peoples and communities. Whilst this is undoubtedly a great legal challenge, it should encourage the growth of an industry without the violation of the rights of Mexican native people.



www.sesma.com.mx



Singapore

"IN" is OUT. Weider Global Nutrition has been successful in its invalidation application against Morinaga & Co's "IN" mark. [Learn more here.](#)



www.alphaandomega.com.sg



Sweden

The Swedish Supreme Court has ruled on a national statutory prohibition on certain images in the marketing of alcoholic drinks by the Swedish Mackmyra Whisky. The Court found that the statute in question restricted EU rules on free movement of goods in the union. However, the application of the statute was still found to be compliant with EU law due to overriding reasons, namely the protection of health and life of humans. The interest of protecting children from the negative effects of alcohol was a significant factor in the reasoning. In contrast to the findings of the Patent and Market Court of Appeal, the Supreme Court held that an outright ban did have a direct effect on children's health and did not go beyond the necessary level of protection.

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UK

The UK IPO has updated its patent application examination guidelines in relation to medical inventions. The extensive changes take into account recent UK case law including new guidance around the sufficiency and infringement of second medical use. [Learn more here.](#)

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USA

Regulations implementing the Trademark Modernization Act of 2020 (TMA) came into effect on 18 December 2021. The TMA provides new procedures to challenge trademark registrations based on nonuse – expungement, and reexamination. A new significant requirement is for filers to verify their identity with the [United States Patent and Trademark Office](#) “USPTO”. This is part of the USPTO’s efforts to protect the integrity of the register and combat fraudulent filings, which have been on the uptick. Beginning early 2022, trademark owners and corporate officers, and legal professionals representing trademark owners must verify their identity with the USPTO using one of the verification options that includes an electronic process by [ID.me](#). [Learn more here.](#)

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