

CorporateLiveWire

# INTELLECTUAL PROPERTY 2019

## VIRTUAL ROUND TABLE

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### Introduction & Contents

A recurring theme throughout this roundtable is the iteration that intellectual property is one of the most important strategic assets in a company's arsenal. The 10 experts outline the various strategies that can be implemented to defend IP rights, highlight the steps to be taken if you believe your IPR has been breached, and address the biggest mistakes companies often make. Featured countries are Ireland, Malaysia, Malta, Nigeria, Singapore, Taiwan, Tanzania, United Kingdom and the United States.



*James Drakeford*  
Editor In Chief



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## Meet The Experts



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Patricia McGovern is the Chairman and Head of the Intellectual Property Department at DFMG Solicitors in Dublin, Ireland. She is a Solicitor, Irish Trade Mark Agent and a European Trade Mark and Design Attorney.

She has practised in almost all areas of intellectual property law and advises on both contentious and non contentious matters involving trade marks, patents, copyrights and designs. She also advises on data protection, e-commerce and the internet, technology agreements, media contracts, advertising and sales promotions.

Patricia is a current member and former Chairman of both the Business Law Committee and the IP Committee of the Law Society of Ireland.

She was one of the three Government appointed members of the Copyright Review Group in Ireland which carried out an extensive review of copyright law and reported in 2013.



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Andrew Sherman is a Partner in the Corporate Department of Seyfarth Shaw LLP. He focuses his practice on issues affecting business growth for companies at all stages, including developing strategies for licensing and leveraging intellectual property and technology assets, intellectual asset management and harvesting, as well as international corporate transactional and franchising matters.

He has served as a legal and strategic advisor to dozens of Fortune 500 companies and hundreds of emerging growth companies. He has represented U.S. and international clients from early stage, rapidly growing start-ups, to closely held franchisors and middle market companies, to multibillion dollar international conglomerates. He also counsels on issues such as franchising, licensing, joint ventures, strategic alliances, capital formation, distribution channels, technology development, and mergers and acquisitions.

Mr. Sherman has written nearly 30 books on the legal and strategic aspects of business growth, franchising, capital formation, and the leveraging of intellectual property, most of which can be found on Amazon. He also has published many articles on similar topics and is a frequent keynote speaker at business conferences, seminars, and webinars. He has appeared as a guest commentator on CNN, NPR, and CBS News Radio, among others, and has been interviewed on legal topics by The Wall Street Journal, USA Today, Forbes, U.S. News & World Report, and other publications.



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David Halberstadter counsels motion picture and television studios who ask, "Can we do this without getting sued?" Mr. Halberstadter applies his in-depth knowledge of the law and the entertainment industry and common sense judgment to the myriad claims his clients face. When necessary, he's an efficient litigator of every type of claim that arises in the entertainment industry. A Georgetown University Law Center graduate, Mr. Halberstadter is recognized by Chambers USA as a Leading Individual in Media & Entertainment Litigation. He was named one of California's Top 75 Intellectual Property Litigators by the Los Angeles Daily Journal, profiled in Variety's Legal Impact Report and recognized by Best Lawyers in the area of Media & Entertainment.

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Silvana is a gaming law specialist advising on regulatory aspects, taxation & general matters relating to the gaming and intellectual property industries. Silvana is an active member of the Malta Remote Gaming Council & the Chamber of Advocates. Silvana also heads our Transport Practise Group which services clients in the maritime, aviation and general transport industries.

Silvana's practice mainly focuses on assisting clients with business start-ups requiring a license for their operation. In fact, Silvana has in-depth experience in licensing processes, especially those relating to online gaming, banking and other credit institutions, insurance and investment services. Working closely with the regulatory authorities in Malta, Silvana provides tailor-made advice for the obtainment and maintenance of licenses referring to the specific operations of the client. On the attainment of a license, Silvana provides ongoing legal support to clients in making sure that all requirements relating to their licensed operations are adhered to.

Understanding the importance of protecting one's assets, Silvana also provides services relating to Intellectual Property law. Within this field, Silvana has acquired knowledge on all matters concerning patenting, as well as the protection of copyright and trademarks. Her approach is based on the aim of obtaining optimal results, according to the client's business demands.



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Emmanuel Ekpenyong was called to the Nigerian Bar in 2007 and established Fred-young & Evans LP, a full service commercial law firm and Fred-young Recoveries, an international debt collection firm in 2014.

Emmanuel has been engaged in prominent commercial litigations and international commercial arbitrations. He is experienced in corporate and intellectual property practice, bankruptcy and insolvency, enforcement of foreign judgments and awards, foreign investments and real estate.

Emmanuel is a Member of International Credit Exchange, ADVOC, IR Global and Chartered Institute of Arbitration, United Kingdom. He is a postgraduate student of International Business Law at the University of Liverpool.



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Kenneth Leon Kolowa is a partner and head of Intellectual Property Department at Abenry & Company for virtually 10 years. He specializes in trademark prosecution and litigation to enforce intellectual property rights. In his trademark practice, Mr. Kolowa handles all aspects of the trademark registration process, including application filing, office action responses, and oppositions and cancellations. He also handles disputes involving intellectual property matters and business transactions. He has represented clients in patent and trademark lawsuits.

His practice encompasses all aspects of IP law specializing in domestic and international intellectual property, trade secrets, competition and customs matters. His emphasis is on patent, trademark, and copyright prosecution, along with infringement litigation, licensing negotiation and trade secrets protection in Tanzania (Mainland) and the Isles of Zanzibar.

He has also attended various seminars organized by ARIPO and WIPO in cooperation with the Government of the United Republic of Tanzania. He has been a member of ITMA and INTA for many.

### Meet The Experts



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Mr. Yu-Li Tsai, a patent attorney graduated from Department of Electrical Engineering of National Taiwan University (NTUEE), which is the best engineering school in Taiwan. Because of interest in communication system, he then attended in the Graduate Institute of Communication Engineering (GICE) of NTU. During his research life in GICE, he also started to get involved in knowledge and skills of patent-related matters for taking and receiving the qualification of patent attorney. Mr. Tsai also attended to receive an IP master from Law School of University of New Hampshire, also known as Franklin Pierce Center for Intellectual Property, had an internship with InterDigital, Inc., and passed the U.S. Patent Bar Examination. Currently, Mr. Tsai is working for Deep & Far Attorneys-at-Law as a patent attorney.



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LL.B (Hons), Multimedia University, Malaysia  
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Nina Moshynska is Ukrainian patent and trademark attorney and a managing partner at Gorodissky&Partners (Ukraine). She has experience in all areas of intellectual property law.

Ms. Moshynska counsels clients in all matters relating to the protection of intellectual property rights, including patent matters, utility models, designs, trademarks and has successful legal history related to protection clients' rights in courts of law.

Ms. Moshynska is a co-founder, the first President and a member of the Ukrainian Patent Attorney Association, as well as a member of AIPPI, INTA, LESI and MARQUES.



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Kevin is an advocate and solicitor in Singapore, and is admitted as a solicitor in England and Wales.

A graduate of the National University of Singapore, Kevin is an experienced attorney in the fields of IP management and transactional work. He has advised a wide range of local and foreign clients on their intellectual property (IP) rights and portfolios around the world, including companies in the aerospace, retail, environmental solutions, marketing communications, beauty, and sports and lifestyle industries.

His scope of work includes trade mark clearance and strategy, trade mark filing and prosecution, international registration under the Madrid Protocol, information technology (domain names) and enforcement/disputes, including trade mark oppositions, invalidations and revocations. Kevin is a regular participant and speaker at local and international IP events, and has contributed as a consultant and tutor at local IP clinics and courses. He also has many years of editorial experience and has contributed articles and commentaries to various IP publications with an international audience, including World Trademark Review (WTR), Asia IP and the IPKat's blog. He also co-authored the Singapore chapter of the book "Getting the Deal Through: Trademarks" published in 2015.

## Q1. How can intellectual property (“IP”) be utilised to drive economic growth and business success?

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**Raghuram  
Supramaniam**

**Supramaniam:** IP is an intangible asset that can be exploited to drive the growth and financial returns of the company. A successful company is one that manages to harness and exploit its IP, be it for local or international expansion plans.

The more recognition a brand or a business receives from its consumers, the more goodwill and reputation it will acquire, of which will become the asset of the company. A long and well established business may, in time, acquire goodwill and reputation by virtue of the use of its brand, and may ride upon such goodwill and reputation to drive in more customer recognition and loyalty, directly and indirectly affecting the performance of the business.

A brand is what a business uses as a tool to differentiate itself from its competitors and effectively market. The creation and use of IP such as trademarks, trade dress or get-up could assist in promoting the unique recognition of a business to stand out or be distinguished in the competitive market in Malaysia.

Further, IP also serves as a form of financial support to the owner when such trademarks could these days be traded as assets or collateral for obtaining financial support from financial institutions.

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**Andrew Sherman**

**Sherman:** The global economy is now powered by data, relationship channels, brands, technology and other forms of intangible assets and intellectual property. The key to harnessing these assets to drive economic growth, productivity and profitability is for both boards of directors and company leaders to commit time and resources to the proper management and commercialisation of these assets, both within their core industry focus and outside their market segments.

The challenge for global leaders and the biggest barrier to economic growth are either companies that suffer from “horse blinder” syndrome or “ostrich with its head in the sand” syndrome, meaning that leaders are either unable to focus the deployment of IP outside their core industry, or refuse to see the opportunities that their intangible assets can generate for the enterprise and its stakeholders.

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**David  
Halberstadter**

**Halberstadter:** In recognition of World Intellectual Property Day in April 2016, President Barack Obama observed: “Whether through the music or movies that inspire us, the literature that moves us, or the technologies we rely on each day, ingenuity and innovation serve as the foundation upon which we will continue to grow our economies and bridge our cultural identities.”

President Obama’s comments were spot-on: When a business is establishing its presence in the marketplace, protecting and managing its IP is critical, as it can mean the difference between success or failure. IP is the primary means by which a company can own and protect its business identity, its critical technology, works of authorship, logos, slogans, trade dress, and any other practical expression of the ideas that drive the business.

IP protection affects commerce throughout the economy by providing incentives to invent and create; protecting innovators from unauthorised copying; facilitating vertical specialisation in technology markets; creating a platform for financial investments in innovation; supporting entrepreneurial liquidity through mergers, acquisitions, and IPOs; supporting licensing-based technology business models; and enabling a more efficient market for trading in technology and know-how.

## Q1. How can intellectual property (“IP”) be utilised to drive economic growth and business success?



**David Halberstadter**

According to a 2016 report published by the United States Department of Commerce, U.S. IP is worth more than \$5 trillion per year and comprises 35% of the total U.S. gross domestic product. In fact, IP and other intangible assets represent 80% of the market value of U.S. public companies today. By comparison, 40 years ago it was tangible corporate assets like plants, equipment, raw materials, and real property that represented 80% of the market value of U.S. public companies.

Moreover, industries that rely heavily upon IP are huge contributors to the overall economy, including the job market. According to the same Department of Commerce report, trademark-intensive industries were the largest in number and contributed 23.7 million jobs in 2014. Copyright-intensive industries supplied 5.6 million jobs, and patent-intensive industries contributed 3.9 million jobs.

The majority of my clients are motion picture studios, television networks and production companies, and Internet and other new media platforms. Their products are entertainment content, including copyright-protected films, television programs and other audiovisual works; and they are marketed with trademark-protected brands, logos and marks. So it is easy to see how IP drives economic growth and business success in this industry.



**Nina Moshynska**

**Moshynska:** As a result of creative and business activity, intellectual property has existed since man first begun to adjust the environment to his needs. IP has always been an engine of innovation and in modern times is the most valuable source of economic growth and business success.

The UK was the first to establish the legal protection of IP. Further developments on IP protection in other countries were closely related to the Industrial Revolution. After such a great influence on both technology and art, the idea of IP law has been supported worldwide via the adoption of Paris and Bern Conventions.

The simple principle of IP law – create, share, benefit – is essential for modern generation of e-communication and information technologies. Economic growth and business success of each country depends on the creation and protection of something special, something new, something which really make a difference.

Not only does IP rights provide an advantage for economic growth and business success but it also provides a fair reward for creators and owners. In other words, legal means for IP protection in the right and experienced hands can provide both the unlimited growth from one innovation to another and financial gain.



### Q1. How can intellectual property (“IP”) be utilised to drive economic growth and business success?

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**Emmanuel Ekpenyong**

**Ekpenyong:** IP rewards unique innovations and new businesses, products and services. It encourages new discoveries towards a better living. Persons who want to use the IP of others must first of all negotiate with their owners (“the Owners”) to get a licence to use it. Persons who infringe the IP of others are liable to pay compensation to the owner of the IP. This has inevitably created secured wealth for the Owners which can engineer economic growth. In Nigeria, the government generates huge revenue from the filing and transfer of both local and foreign IP.

There is a greater consciousness amongst Nigerians that they can create employment for themselves and others from their IP rather than wait for the government to create employment for them. This is evident in the enormous wealth being created on a daily basis in Nigeria’s music, comedy, movies, entertainment, literary and telecommunication sector. This is the reason for the increased and consistent fight to curb the activities of pirates and litigations by the Owners to get what is due to them for their work.

IP boosts foreign investment, especially in the private sector. In Nigeria, IP attracts foreign currency of other countries whose products and services are targeted to enter the enormous Nigerian market. IP treaties amongst Countries encourage international trade because the IP of persons from member countries is not only protected in their country of origin but also across borders. This means wealth can be created by Owners in their home state and in as many foreign countries as possible.

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**Kevin Wong**

**Wong:** The Intellectual Property Office of Singapore (“IPOS”) is a government agency under the Ministry of Law (the “Ministry”) and oversees the nation’s IP landscape. While the Ministry is in charge of enacting legislation, IPOS serves as the national registry for all trade marks, designs, patents, geographical indications and plant varieties. Apart from handling registrations for these sectors, it also provides search and examination services to help companies with their prosecution needs.

In addition, IPOS and its subsidiaries plays a key role in developing the nation’s innovation ecosystem, as it leverages on its expertise in IP to help grow businesses in Singapore. For example, IP ValueLab conducts intangible asset audit and consultation for local businesses, and the IP Academy provides executive training programmes on IP and innovation management.

As part of the Singapore government’s 10-year plan to guide the country towards becoming a global IP hub in Asia, IPOS is constantly looking to innovation as a driving force in the global economy. IPOS has already introduced various methods to boost innovation here, including the Accelerated Initiative for Artificial Intelligence (AI2) and the FinTech Fast Track Initiative (FTFT). Recently, IPOS was ranked second on the World Trademark Review’s (WTR) annual IP Office Innovation Ranking study.

Furthermore, IPOS serves as a destination for IP dispute resolution. Certain types of disputes, such as trade mark opposition or patent revocation, are first heard at its tribunal, the Hearings and Mediation Group (HMG), which also assists with mediation and other alternative dispute resolution options. If parties are not satisfied with the result, they may then appeal to the local courts for further resolution. However, certain disputes (e.g. infringement proceedings) can only be heard at the local courts.

## Q1. How can intellectual property (“IP”) be utilised to drive economic growth and business success?



Patricia McGovern

**McGovern:** IP can be utilised to drive economic growth and business success at two levels. Firstly, at a national level, it is important that jurisdictions have cost effective mechanisms to permit the registration of such IP rights as are capable of registration. Allied to this however should be an enforcement system for the enforcement of IP rights that is cost effective and timely. I think it is fair to say that most countries aspire to this but invariably it is a work in progress.

For businesses, the key is to identify their IP, protect it by whatever means are available to them and enforce it when they discover it has been infringed. This will enable businesses to capitalise on the “monopoly” or exclusive rights that they gain from IP. It should also be remembered that IP rights may not only be used but may also be assigned or licensed and thus generate income in that way. IP is an asset which can be utilised to attract investment and to raise funds.



Dr Silvana Zammit

**Zammit:** Businesses are faced with an on-going quest to remain ahead of competitors in the ever- converging global market. To differentiate their products/services and establish market superiority, businesses invest a substantial amount of capital in innovation that provides new products/services, reduces their production costs and improves product/service quality. In this context, IP protection is a tool that assists the intellectual property holder to defend the business’ goodwill and maintain the market leadership created through the costly innovation and marketing efforts. Enforcement of IP rights prevents or rectifies any unfair advantage competitors may take or attempt to take of the legitimate investment undertaken by the intellectual property holder. IP protection, therefore, protects and nurtures economic growth. Our practice at Chetcuti Cauchi Advocates, assists clients with setting up and implementing an IP protection strategy ensuring the benefits of intellectual property rights are fully exploited.

Additionally, the current knowledge-driven markets highlight the importance of diversifying the business’ assets by increasing investment in intangible assets, with a predominant focus on the development and effective use of one or more types of IP. Intellectual property encompasses a myriad of rights ranging from trade secrets protection, copyright and design rights, to trademark and patent protection. It follows that investment in IP allows businesses to create tradable assets contributing to business success through innovative product development and business models.



Kenneth Leon Kolowa

**Kolowa:** IP can be utilised to drive economic growth and business success if the enforcement regime of the intellectual property rights is effective.

The effective use of IP plays a very key role in facilitating the process of taking innovative technology to the market place. At the same time, it also plays a major role in enhancing competitiveness of technology-based enterprises, whether such enterprises are commercialising new or improved products or providing service based on a new or improved technology. For most tech-based companies, a successful invention results in a more efficient way of doing things or in a new commercially viable product – the improved profitability of the company is the outcome of added value that supports a bigger stream of revenue or higher productivity.

*“IP can be utilised to drive economic growth and business success if the enforcement regime of the intellectual property rights is effective.”*

*- Kenneth Leon Kolowa -*

### Q2. Can you outline the current intellectual property landscape with specific reference to the main regulators and key legislators that apply in your jurisdiction?

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**Raghuram  
Supramaniam**

**Supramaniam:** In Malaysia, Parliament plays the role as the key legislator in the enactment of legislations and other by-laws for the implementation and administration of IP laws.

Amongst others, the key legislations include the Trade Marks Act 1976, Patent Act 1983, Industrial Designs Act 1996, Copyright Act 1987 and Trade Descriptions Act 2011.

The statutory body entrusted with the protection of IP rights is the Malaysian Intellectual Property Office (MyIPO), where the individual registers for trade marks, copyright, patents and industrial designs are kept and maintained.

For the benefit of the public at large, these registers are open to public and members of the public are allowed to conduct searches to monitor the status of their IPRs and pre-empt any issues of conflicting registrations.

The Director General of MyIPO (who functions as the registrar of trade marks, copyright, patents and industrial designs) is supported by a number of deputy registrars, assistant registrars and other officers as may be necessary for the proper administration of the respective IP legislations.

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**Nina Moshynska**

**Moshynska:** The current intellectual property landscape in Ukraine include patents, utility models, trademarks, industrial designs, geographical designations, topography of integrated circuits, plant varieties, trade secrets, copyright and related rights, and unfair competition issues.

The percentage of filed applications for industrial property object registration was notably higher in 2018 compared to the previous year. According to statistical data of the UA PTO, there were 54,785 applications filed in 2018 compared with 53,458 in 2017.

The Ukrainian Ministry of Economic Development and Trade governs state policy on IP protection. Ukraine has started to implement provisions of an Association Agreement between Ukraine and the European Union in order to establish harmonisation of Ukrainian laws with the laws of the European Union.

A Custom Service has been established for IP protection on customs. The formation of a High Court on Intellectual Property is also expected.

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**Emmanuel  
Ekpenyong**

**Ekpenyong:** The Trademark, Patents and Designs Registry, Federal Ministry of Industry, Trade and Investment, Abuja ("the Registry") administers protection of both local and foreign trademarks, patents and designs in Nigeria. Law firms, stakeholders and potential applicants who wish to act as agents are accredited with the Registry upon loading their information on the Registry's portal and payment of the stipulated accreditation fees. The Registry interface allows applicants to filing or transfer IP through their accredited agents.

The main legislations regulating IP in Nigeria include:

- Copyright Act, CAP. C28, Laws of the Federation of Nigeria, 2004;
- National Office for Technology Acquisition and Promotion Act, CAP. N62, Laws of the Federation of Nigeria, 2004;
- Patents and Designs Act, CAP. P2, Laws of the Federation of Nigeria, 2004;
- Trademark Act, CAP T13, Laws of the Federation of Nigeria, 2004.

### Q2. Can you outline the current intellectual property landscape with specific reference to the main regulators and key legislators that apply in your jurisdiction?

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Patricia McGovern

**McGovern:** The Intellectual Property Unit of the Department of Business, Enterprise and Innovation is responsible for Ireland's policy and legislation on IP that reflects developments in intellectual property policy and practice domestically, at EU level and in relation to international obligations for which Ireland is committed through various international agreements.

The Irish Patents Office is responsible for the granting of patents, the registration of trade marks and designs and it also has certain functions in relation to copyright. Customs authorities have a role in border control measures. Our police force is also involved in the enforcement of IP rights where there is a criminal element. Finally, our court system enforces IP rights. Most infringement matters are dealt with by our High Court with its Commercial Division playing a significant role.

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Dr Silvana Zammit

**Zammit:** In Malta, the Industrial Property Registrations Directorate (IPRD) is the sole authority responsible for the registration of trademarks, certification marks, collective marks and designs; patenting of inventions; issuing of supplementary protection certificates in respect of pharmaceutical products and plant protection products as well as the recording of transfers, cancellations, amendments and renewals relating to the aforementioned IP rights.

Malta is a full member of the European Union (EU) and a base for European and international business. This results in it also being a base for EU intellectual property registrations, predominately EU trademarks which, once registered, provide protection throughout all the 28 Member States of the EU.

Additionally, Malta provides for a robust legal framework for patent protection. It is one of the few EU countries to fully embrace the nature of the Bolar provision. Malta joined the European Patent Convention (EPC) and the Patent Cooperation Treaty (PCT) in 2007, the World Intellectual Property Organization (WIPO) Copyright Treaty and the WIPO Performances and Phonograms Treaty in 2009 and is party to the Madrid Protocol through its accession to the EU. Before 2007, very few patents were filed in Malta. Consequently, a considerable number of patents that are active in other countries do not exist in Malta, providing an opportunity for businesses to manufacture and sell products before competitors located in countries covered by active patents.

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Kenneth Leon  
Kolowa

**Kolowa:** The IP regime in Tanzania is regulated by two separate and independent legal systems since IP matters are not Union matters. For Tanzania (Mainland) IP matters are regulated by Copyright and Neighbouring Rights Act No. 1 of 1966; The Trade and Service Marks Act, The Trade and Service Marks Regulations, 1986, the Patents Act, 1987, the Merchandise Marks Act 2008 and its Regulations. The Business Registrations and Licensing Agency (BRELA) is the receiving national office for patent and trademarks in Tanzania (Mainland). The Copyright Society of Tanzania (COSOTA) is the main regulator on matters of copyrights.

In addition, in Tanzania (Mainland) there is the Fair Competition Commission (FCC) which is a Public Institution established by virtue of section 62(1) of the Fair Competition Act, No.8 of 2003 (FCA) with the aim of promoting and protecting effective competition in trade and commerce and protecting consumers from unfair and misleading market conduct. FCC establishes the legal framework for spearheading the fight against trade in counterfeit goods.

On the other hand, the IP regime in Zanzibar is regulated by Zanzibar Industrial Property Act, 2008 and The Zanzibar Industrial Property Regulations. The main regulator of the IP matters in Zanzibar is the Zanzibar Business and Property Registration Agency (ZBPR) established under Act No. 13 of 2012 in order to replace the functions of The Registrar General's Office (RGO).

### Q3. What impact has the EU's General Data Protection Regulation ("GDPR") had on IP practitioners so far?

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Andrew Sherman

**Sherman:** GDPR has had a significant impact on IP lawyers, as well as business professionals whose responsibilities include the management and monetisation of customer data. New restrictions and regulations have had legal and business professionals busy rewriting data collection policies, data usage deployment, consumer marketing activities and e-commerce policies.

We all know that data management and data mining are the keys to driving business growth and new revenue opportunities, however, GDPR has reined in certain upselling, cross-selling and data sharing strategies in a manner that has everyone going back to the drawing board. Many privacy lawyers and business practitioners are now turning their attention to the United States to determine when or if Congress will deliver its own version of the GDPR in 2019 or 2020, and in the interim, states such as California have already been implementing their own sets of new restrictions and regulations.

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Emmanuel Ekpenyong

**Ekpenyong:** In line with GDPR, the Nigerian Information Development Technology Development Agency issued the Nigerian Data Protection Regulation ("the Regulation") in January 2019. The key objectives are to safeguard the rights of natural persons to data privacy, foster safe conduct of transactions involving the exchange of personal data, prevent manipulation of personal data, and ensure Nigerian businesses in international trade are exposed to the legal regulating framework on data protection in line with international best practice.

This is a welcome development because personal data collected for a purpose will only be used for that specific purpose. The Regulation also mandates the collection of personal data which are relevant for a specific purpose. It is suggested that if the Regulation is properly adhered to and enforced, it will be in considerable compliance with the GDPR. This will provide more satisfaction to Nigerian businesses carrying on business in the EU or with EU businesses.

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Patricia McGovern

**McGovern:** Since data protection came to the forefront in the 1980s, it has always been lurking in the background for IP practitioners (e.g. in the context of litigation with infringers making data access requests or using it as a justification to decline to provide certain information). It has also had an impact on the regulation of marketing campaigns.

However, since the introduction of GDPR in May 2018, this interaction has become somewhat more acute particularly now that data protection has more teeth with the significant fines that can be imposed for non-compliance.

Since the introduction of the GDPR we have all found a number of databases that we all relied on in our everyday role, for example, the WHOIS database, are now significantly restricted. Also now when seeking information from infringers, for example, as to the source of the infringing product or to whom it is distributed, we are more likely to be faced with the "defence" that it cannot be revealed due to GDPR without a court order. Those involved in creating marketing campaigns need to be even more conscious that individual privacy rights are not being breached. With data breaches becoming more common and public, there is the concern about the impact on brand value.

One would expect to see a number of these issues being litigated in the coming years and hopefully getting more guidance from data protection commissioners and indeed the European Data Protection Board as to what should be proper practice.

### Q3. What impact has the EU's General Data Protection Regulation ("GDPR") had on IP practitioners so far?

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**Kenneth Leon  
Kolowa**

**Kolowa:** The right to portability is a new right that did not exist before GDPR. It is essentially designed to help data subjects switch from one supplier to another. Data subjects have the right to receive their personal data in a structured, commonly used and machine readable format, which they can then forward to someone else.

The right to portability raises issues for those who may take the view that providing personal data in a "reusable way for potential competitors" would be an infringement of their IP rights or, at the least, a disclosure of their know-how. As with the right of access, GDPR provides that the exercise of this right should not adversely affect the rights and freedoms of others, which include IP rights.

### Q4. Have there been any recent changes or regulatory developments?

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**David  
Halberstadter**

**Halberstadter:** One of the more significant undertakings in the world of U.S. intellectual property is the "Copyright Office Modernization" project that is currently on-going. As readers may know, the United States Copyright Office is part of the Library of Congress, and is the official U.S. government body that maintains records of copyright registration in the United States. Its stated mission is to promote creativity by administering and sustaining an effective national copyright system. The U.S. Copyright Office has the largest collection of copyright records in the world.

Members of the public seek out these records to find copyright owners and to get copies of completed and in-process registration records, recordation documents, and registration deposits. Because many of these records pertain to works under copyright protection, it is vital that the Office provide accurate and timely data.

Unfortunately, in recent years the number of copyright applications and recordation requests has exploded, and the Copyright Office has been struggling to handle the deluge. So it has launched a major overhaul of its recordkeeping and other processes in order to keep up with the pace of business.

For one thing, the Copyright Office is in the process of transforming its historical records. It is converting its extensive, paper-based pre-1978 entries into digital format for improved public access, enhanced online search capabilities, and continued record preservation. Additionally, the Copyright Office is working towards publishing as many additional historical records online as possible, which currently are physically housed in the Copyright Records Public Reading Room.

This modernisation project is a multi-year process that requires extensive collaboration among all Copyright Office divisions, as well as the Library of Congress. One of the project's key components is transforming all of the Office's multiple information technology systems, including those that support registration, recordation, access to public records, information services, and other public services, into a single improved and integrated IT enterprise system.

Another key objective is to "re-engineer" the Copyright Office's business process, in order to reduce operational costs and improve efficiencies. The hope is to reduce the current processing time for a copyright application to be reviewed and a registration issued, which currently can take as long as eight months unless the applicant pays a significant additional fee for expedited processing.

### Q4. Have there been any recent changes or regulatory developments?

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**Emmanuel Ekpenyong**

**Ekpenyong:** The Federal Competition and Consumer Protection Act, 2019 (“FCCPA”) repeals the Consumer Protection Council Act by dissolving the Consumer Protection Council and establishing the Federal Competition and Consumer Protection Commission (“FCCPC”). The FCCPC oversight functions extends beyond consumer protection issues and covers all entities carrying out commercial activities whether as body corporate or as government agencies. Notably, the FCCPA introduces:

- A Competition and Consumer Protection Tribunal to adjudicate over matters arising from operation of FCCPA.
- Prohibition of restrictive agreements between business entities. Restrictive agreements are arrangements which restrict trade such as prohibition of minimum resale prices (even for patented goods), price fixing, collusive tendering, withholding supply of goods and services from a dealer, exclusionary contractual provisions.
- Declaration of price regulations for the purpose of regulating and facilitating competition by an order published in the Federal Gazette by the President.
- Prohibition of abuse of a dominant position in any industry by any business.
- Prohibition of monopolies by prohibition of acquisition transaction, business breakup, forced publication of price lists etc.
- Gives the power to approve mergers to FCCPC.
- Gives FCCPC oversight powers in every sector.
- Stiff penalties against competition such as price-fixing, conspiracy, bid-rigging, obstruction of investigation or inquiry etc.

Substantial enforcement of the FCCPA will indeed unleash the entrepreneurial potential of Nigeria by prohibiting monopolistic tendencies, market distortions and creating a level playing ground for small and medium businesses to spring up and thrive.

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**Kevin Wong**

**Wong:** Singapore recently introduced a new Registry for Geographical Indications (“GIs”), enabling registered GIs to enjoy a higher level of protection.

Under the previous regime, the repealed Geographical Indications Act 1999 provided automatic protection for GIs under the World Trade Organisation’s Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) as long as a GI’s country of origin is a member of the World Trade Organisation or party to the Paris Convention. A GI cannot be used on goods which do not originate from the geographical origin in question; as such, use may be misleading. For wines and spirits, a greater level of protection is accorded as false labels cannot be used even if they are not misleading. However, under this system, a GI needed to be recognised as such by a court before it could enjoy conclusive protection.

The new Registry, however, provides greater certainty of protection to GIs that are registered in Singapore, and registered GIs are now afforded the same level of protection as wines and spirits. The application process is similar to the process for registering trade marks. It comprises three stages, namely application filing, substantive examination, and publication for opposition by third parties. Like trade marks, GI registrations last for 10 years and can be renewed for further 10-year periods. Therefore, a GI holder can be assured of protection without deference to the courts. Meanwhile, an unregistered GI can still rely on TRIPS for protection.

### Q4. Have there been any recent changes or regulatory developments?

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Kevin Wong

Additionally, the new Geographical Indications Act 2014 (the “Act”), when fully implemented, will also provide for improved border enforcement measures for GIs here. The Act will allow GI holders to request for Singapore Customs to detain or seize infringing goods which are imported into or exported from Singapore. This will bring the Act in line with similar provisions outlining the protection of trade marks in Singapore, including the right to seek relief for groundless threat of proceedings.

As the new GI regime evolves into concrete form, with the first salvo of the GI Registry effective as of 1 April 2019, it is recommended that existing GI holders make preparations to file their GI applications at the earliest in order to secure effective protection in Singapore.

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Patricia McGovern

**McGovern:** An overhaul of Irish trade mark law came into effect on 14 January 2019, namely the European Union (Trade Marks) Regulations 2018, which implemented the EU Trade Mark Directive 2015/2436. These Regulations amended our existing Trade Marks Act 1996 (as amended) and Trade Mark Rules 1996 (as amended). Some key changes to note are:

- Trade marks no longer need to be graphically represented. It is now possible to present a mark in a wider range of formats provided the marks are capable of being represented on the register in a manner which enables the Controller and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.
  - An opponent raising relative grounds in proceedings against a later mark must prove genuine use of the earlier mark if the earlier mark was registered before the start of the five-year period ending on the filing date of the application or, if applicable, the priority date.
  - Alleged trade mark infringers can request the trade mark holder accusing them of infringement to provide evidence of use of the mark being relied on.
  - It is now only possible to oppose a mark on relative grounds.
  - There is a presumption that the transfer of a business includes the trade marks.
  - The burden of proof in transiting goods shifts to the importer/holder of the goods.
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Yu-Li Tsai

**Yu-Li Tsai:** On 1 May 2019, the amended Taiwan Patent Act was promulgated, and the key points of the amendment include: (i) to relax the applicability of filing divisional applications after allowance to include invention and utility model patent applications, and both in the preliminary examination and re-examination stages for the invention patent applications. The time limit for filing the divisional applications is changed from one month to three months after receiving notice of allowance; (ii) to improve the efficiency of invalidation examination, such as the invalidation petitioner’s supplementary grounds or evidence after three months from the petition of invalidation will not be considered, the examining period of an invalidation proceeding is specified, and the restriction of correction petitioned by the patentees is stipulated; (iii) to improve the correction system for the utility model patents, and clearly provide that the timing to petition for the correction of a utility model patent is during invalidation proceeding, upon petitioning for a technical report for the utility model patent, or during the pendency of civil litigations, and the correction will undergo a substantive examination. The independent correction petition for a utility model patent will be cancelled; and (iv) to extend the term of design patent protection from 12 to 15 years.

### Q4. Have there been any recent changes or regulatory developments?

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Yu-Li Tsai

On 1 May 1, 2019, the amended Taiwan Copyright Act was promulgated, and the key points of the amendment include: (i) a person will be deemed an infringer of copyright if s/he knows that the works publicly broadcasted or publicly transmitted by others infringes on copyright rights, with the intent to allow the public to access the works by means of the internet, and receives benefits under the following circumstances: (a) providing the public to use the computer program collecting the network addresses of the works; (b) guiding or assisting the public or establishing a path for the public to use the computer program of (a); (c) manufacturing, importing or selling the equipment containing the computer program of (a). (ii) A person who undertakes the actions set out above shall be deemed to have “intent” when the advertising or other active measures employed by the person instigates, solicits, incites, or persuades the public to use the computer program or other technology provided by that person for the purpose of infringing upon the economic rights of others.

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Dr Silvana Zammit

**Zammit:** Considering Malta is a Member State of the EU, any development on intellectual property that occurs at EU level, affects the national sphere. The main developments occurring at EU level mostly concern copyright. The EU is currently undergoing a copyright reform with the aim of modernising its copyright laws to the digital online world. The highly controversial Copyright Directive on the Digital Single Market was approved by the European Parliament in March 2019. The Copyright Directive provides, amongst others, that liability rests on internet platforms for user-uploaded content and that individual words or very short extracts accompanying hyperlinks to news articles can be shared freely.

In so far as trademarks are concerned, the current local definition of a trademark provides that, amongst others, a trademark must be graphically represented. Due to the challenge to graphically represent certain types of trademarks, a major substantive change at European level was the redefinition of a trademark such that it is no longer necessary for a sign or indication to be capable of graphical representation in order to be accepted for registration. The requirement of clarity and precision was instead introduced. This change is soon expected to become effective in Malta and will provide for further flexibility as to what constitutes a registrable trademark.

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Kenneth Leon  
Kolowa

**Kolowa:** Most recently, the Business Registrations and Licencing Agency (BRELA) has introduced Online Registration System (ORS) whereby all applications in relation to IP matters and corporate matters are being operated through an online system.

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### Q5. Are there any noteworthy case studies or recent examples of new case law precedent?

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**Raghuram  
Supramaniam**

**Supramaniam:** For trademarks, the recent case of *Re PT Garudafood Putra Putri Jaya TBK* [2019] would be of interest to many IP owners who intend to enforce their rights against parallel importers of their goods. In this case, the High Court held that parallel import now amounts to trademark infringement. In granting a Trade Description Order (“TDO”), the Court held that the products that were sold in Malaysia contain false trade description and that such products were brought into Malaysia through unauthorised parallel importation.

In respect of patents, the case of *Kingtime International Ltd v Petrofac E&C Sdn Bhd* [2019] held that a patent licensee had no right to sue for patent infringement, as such rights only vests with the patent owner. There are exceptions to this general rule, including (i) the patent owner refused/failed to file a patent infringement after three months from receiving the request of the licensee to do so; and (ii) notwithstanding that the three-month period has not been satisfied, the licensee may apply to the court for a restraining order to prevent patent infringement or prohibit its continuation by proving that immediate action is necessary to avoid substantial damage to the licensee, both of which were not applicable in this case.

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**David  
Halberstadter**

**Halberstadter:** One of the more significant copyright law precedents to have been set recently is the United States Supreme Court’s decision in *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC, Case No. 17-571* (decided 4 March 2019). The high court finally resolved a controversy over what a copyright plaintiff has to do before he or she is entitled to commence an action for copyright infringement.

Section 411(a) of the Copyright Act provides that no civil action for copyright infringement shall be instituted until either “registration of the copyright claim has been made” or an application in proper form has been made but “registration has been refused.” The court rejected the view of the Fifth and Ninth Circuit Courts of Appeals, which had held that a copyright claimant must merely submit an application for registration with the U.S. Copyright Office. Instead, the court agreed with the Tenth and Eleventh Circuits that the plain language of the statute requires that the Copyright Office must either issue a certificate of registration or reject the claimant’s application as a condition precedent to commencing a copyright infringement action.

This ruling will have a significant effect on the commencement of copyright infringement actions. Many creators of copyright-protected works, especially individual authors and smaller businesses, do not routinely register their works upon publication. United States works are automatically protected by copyright law from the moment they are embodied in a tangible medium of expression, whether on paper, on a laptop, or an audio or video recording, so registering a work is only important when it becomes necessary to prevent or halt infringement.

But if a copyright owner waits until he or she becomes aware of infringing activity it may not be possible to obtain a registration quickly enough, especially for injunctive relief, without paying for expedited processing of the application. And since the infringement likely will have commenced before the registration is issued and after the work’s first publication, the author may be ineligible for certain remedies afforded by the Copyright Act, such as statutory damages and attorneys’ fees. So authors will now have to choose between registering their works soon after they are published, and bearing the cost of registration up front whether there is any likelihood of infringement or not, or delaying registration until if and when it becomes critical, and then bearing additional costs and the risk that the infringement cannot be stopped as quickly as necessary.

### Q5. Are there any noteworthy case studies or recent examples of new case law precedent?

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**Emmanuel Ekpenyong**

**Ekpenyong:** There has been greater awareness on IP rights. Interestingly, the Nigerian Courts have been more proactive in recognising and enforcing such matters. Recently, a Lagos State High Court fined the National Food and Drug Administration and Control (“NAFDAC”), the government agency regulating food and drugs in Nigeria, for approving the consumption of Sprite and Fanta products of the Nigerian Bottling Company (“NBC”). The Court refused NBC’s application for stay of execution and ordered NBC to include on its label a warning to consumers against consuming Sprite and Fanta with Vitamin C.

Again, the Federal High Court in Lagos sentenced an accused pirate to one year imprisonment for copyright infringement with an option of fine. The defendant was accused of offering for sale and being in possession of 727 infringing copies of a literary work.

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**Kevin Wong**

**Wong:** The recent Court of Appeal (the “CA”) case of *Burberry Ltd v Megastar Shipping Pte Ltd and another appeal* [2019] SGCA 1 considered the liability of freight forwarders in situations where counterfeit goods are imported into or exported from Singapore, including goods in transit.

The appellants were trade mark proprietors of luxury brands Burberry and Louis Vuitton. The respondent was a freight forwarder company which provided transshipment services in Singapore. The respondent was named as the local consignee for a batch of goods received from China and intended to be forwarded to Indonesia. However, the goods were seized by Singapore Customs before any transshipment could take place.

The appellants commenced trade mark infringement action against the respondent under the Trade Marks Act (the “Act”), claiming that the respondent, by importing and/or exporting the goods, was using a sign in the course of trade which is identical to a trade mark in relation to goods which are identical to those for which the trade mark was registered.

The CA clarified that an importer or exporter was a person who brought, or caused infringing goods to be brought, into or out of Singapore. This also includes goods brought into Singapore for the purposes of transit.

On the requirement of “use” for establishing trade mark infringement, the CA held that any use which occurred in the course of an alleged infringer’s trade was sufficient to fulfil the requirement. Hence, an importer could be held liable for a transshipment of counterfeit goods not meant for consumers in Singapore.

However, in this case, the respondent never saw the goods which were contained in sealed containers. There was also no evidence to suggest that the respondent was aware that it was forwarding counterfeit goods. As it had no knowledge of the signs applied to the goods, it could neither have known nor had reason to believe that it was using a sign under the Act.

The CA’s decision is noteworthy because it clarifies the position of enforcement proceedings in Singapore. Essentially, freight forwarders can still be held liable for their involvement in transshipment of goods, as long as it can be shown that they had knowledge or reason to believe (i.e. the *mens rea* element) that there was a sign on the goods being shipped.

### Q5. Are there any noteworthy case studies or recent examples of new case law precedent?

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Yu-Li Tsai

**Yu-Li Tsai:** On 23 March 2019, the IP Court handed down a Civil-Patent No. 36, 2015 judgment on the *Entegris, Inc. v. Gudeng Precision Industrial Co Ltd.* case and the court held the Defendant shall compensate for the Plaintiff the full amount of NT\$ 978,870,000. The patent involved in this case was Taiwan Invention Patent No. I317967.

It is understood that the case of the IP Court recorded the largest amount of compensation from the infringer in Taiwan semiconductor industry, and the amount is also the second highest record of all the awarded compensation amounts in the history of IP Court's judgement, and will affect the supply reality of wafer (semi-conductor) cassettes supplied to the wafer foundries, such as Taiwan Semiconductor Manufacturing Company (TSMC). It has a sound impact or implication in the wafer supply for the Taiwan semiconductor industry.

### Q6. Can you outline the different strategies and systems that can be utilised to ensure intellectual property rights ("IPRs") are fully protected and effective?

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David Halberstadter

**Halberstadter:** As I mentioned earlier, my clients are predominantly in the entertainment space, so the IPRs that they need to protect and enforce the most are copyrights, and to a lesser extent trademarks. So I will focus on copyright protection.

For major producers and distributors of entertainment content, the most effective strategy for protecting films, television productions and other audiovisual works from infringement is a combination of early, expedited registration of materials created during the development process and "preregistration" of the audiovisual work itself as soon as principal photography has begun.

Even before the filming of a motion picture or television episode has begun, any number of copyright-protected materials has already been created. There likely exist multiple drafts of the screenplay, "story boards" may have been created depicting how key scenes will be filmed, and distinctive costumes and props may have been designed (think about superheroes and their weapons). All of these materials are eligible for copyright protection and applying for expedited registration may enable a studio or network to pursue infringement claims if they, or even rough cuts of the film itself, are leaked to the public.

The U.S. Copyright Act also allows for the "preregistration" of works that are being prepared for commercial distribution and are of the types that have a history of being infringed prior to release. Such works include all forms of commercial audiovisual works, sound recordings, musical compositions, literary works being prepared for publication in book form, and computer programs (including videogames). By following the process set forth in the Copyright Act and the preregistration rules implemented by the Copyright Office, a film studio or television network can obtain preregistration of a qualifying work as soon as filming begins, and thereafter follow up with a formal registration once the work has been completed and is being prepared for commercial release.

*"For major producers and distributors of entertainment content, the most effective strategy for protecting films, television productions and other audiovisual works from infringement is a combination of early, expedited registration of materials created during the development process and "preregistration" of the audiovisual work itself as soon as principal photography has begun."*

*- David Halberstadter -*

### Q6. Can you outline the different strategies and systems that can be utilised to ensure intellectual property rights (“IPRs”) are fully protected and effective?



**Emmanuel Ekpenyong**

**Ekpenyong:** (i) Owners should use their IP immediately after it is created. This is because the Registry gives priority to an Owner who has been using it for a period longer than other applicants of a similar IP. (ii) Owners should take urgent steps to register their IP because in Nigeria, the law does not recognise the equitable right of an applicant over a pending application for filing of IP. (iii) Owners should advertise and publicise with their IP to discourage other persons from using it. (iv) Owners should register all franchise and IP for technology transfer at the National Office for Technology Acquisition and Promotion (“NOTAP”) so that wealth created from them can be easier repatriated to the state of origin of the franchise or IP.



**Kevin Wong**

**Wong:** If a business owner wishes to secure trade mark protection in multiple countries, he can avail himself of the international registration system under the Madrid Protocol. This system involves a single application for international registration based on an existing application or registration in the applicant’s “home” country, and designating those other countries where protection is sought. The “home” and designated countries must all be Madrid Protocol member states.

The international registration is then transmitted to the intellectual property office of each designated member state through the International Bureau of WIPO. Upon such transmission, each national intellectual property office is given a time limit (either 12 or 18 months) to raise objection via issuance of a provisional refusal, failing which (and subject to any third-party oppositions), protection shall be granted in the member state concerned.

In addition, subsequent trade mark maintenance such as renewal, changes of name or address of the owner or change of trade mark ownership can be effected through a single application to the International Bureau.

In the case of countries which are not members of the Madrid Protocol, filing has to take place directly through their respective national intellectual property offices.

In a country where both national and international (Madrid Protocol) filing modes are available, business owners should still consider any factors or peculiarities specific to that country’s trade marks law and practice in determining the appropriate filing strategy for the mark and goods/services concerned.

At the core of any successful trade mark filing strategy is an understanding of when and where to file one’s trade marks.

In terms of the “when”, time is of the essence for first-to-file countries, where trade mark rights are given to whoever is first to file the trade mark. In ASEAN, these countries include Indonesia and Vietnam. This prevents the hoarding of trade mark rights in valuable brands by squatters and counterfeiters. If such hoarding has already taken place, cancellation and invalidation proceedings may have to be taken out against the relevant trade marks.

As for the “where”, business owners would have to ascertain the countries in which commercial activity persists or will take place. Firstly, one would have to understand where custom is being generated. For businesses that operate brick-and-mortar stores, trade mark filings would naturally follow store locations. For online businesses, it may be prudent to target countries that account for a large part of one’s target market. Furthermore, to protect against production of counterfeits, it is imperative that filing is made in countries where distribution and manufacturing takes place.

Understanding the “where” also involves considering the ease of enforcement of one’s trade mark rights across different jurisdictions. This relates to knowing the modes of enforcement, the time taken for enforcement and the costs involved. For the former, enforcement can encompass many forms, including administrative proceedings through administrative bodies, civil proceedings through courts, criminal prosecution by enlisting public authorities and border enforcement involving customs. Each of these modes of enforcement confers an opportunity to obtain different remedies.

### Q6. Can you outline the different strategies and systems that can be utilised to ensure intellectual property rights (“IPRs”) are fully protected and effective?

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Patricia McGovern

**McGovern:** To ensure that your IPRs are fully effective and protected you should consider the following:

- Ensure that any invention you develop is not disclosed to the public, before you have filed for patent protection, without a non-disclosure agreement being put in place.
- Ensure internally you protect your knowhow and trade secrets and that they are restricted to staff on a need to know basis.
- As regards trade marks make sure that you cover all relevant jurisdictions. While budgets are always tight, ultimately this could be money well spent.
- Ensure that you file for trade mark protection for all the goods and services you anticipate that you will use your mark for. While you can rely on unregistered rights, there is no doubt that registered rights put you in a much stronger position if your right is ever challenged.
- Be conscious of the obligations in certain jurisdictions to provide evidence of use or whereby your marks may become vulnerable through non-use.
- Consider design right filings. Design rights can be something of the Cinderella of IP but they can be very useful in particular industries.
- While copyright protection arises automatically, it is helpful to keep records of your works created with timestamps for evidence as to when the creation was made.
- Enforce your rights when the need arises.



Dr Silvana Zammit

**Zammit:** Chetcuti Cauchi Advocates’ intellectual property law team assists clients with the planning and implementation of the cycle of acts to be undertaken for IP rights protection and effectivity. The steps to be undertaken to ensure effective IP protection strategies are mainly the following:

1. Identification of the client’s intellectual property right/s: the various IP rights are regulated differently. The proper identification of the client’s IP eligible for protection and the regime regulating such is a necessary and important step. A specific type or a combination of types of IP may need to be registered for optimisation.
2. Identification of the client’s goals and intended achievements: the products/services to which the IP relates, the markets in which the client operates and the prospects of business expansion or takeover are few of the elements that influence the IP strategy planning and implementation, these being crucial considerations for effective protection and enforcement, if necessary.
3. Feasibility of attainment of intellectual property protection: our team undertakes thorough research to ensure that the investment in IP protection that the client intends undertaking will lead to the desired result. This includes the assessment of use of various types of IP protection strategies including use of different jurisdictions to secure priority or prior rights and proper choice of implementation routes that provide higher chances of success.
4. Intellectual property protection application and registration.
5. On-going maintenance, pre-emptive and reactive measures: this part of the strategy is key. Our team provides on-going assistance with maintenance ensuring IP rights are not lost and are protected throughout their use by means of proper contractual arrangements. The firm offers a specialised service of intellectual property watch helping the client locate improper use of its IP rights and therefore ensuring a strong structure of pre-emptive measures. Planned and studied enforcement actions need to be undertaken when necessary to stop improper use of IP rights. Out of court settlements are important and preferred for enhanced efficiency and cost-effectiveness – Chetcuti Cauchi Advocates having 90% of its intellectual property enforcement actions settled amicably.

### Q6. Can you outline the different strategies and systems that can be utilised to ensure intellectual property rights (“IPRs”) are fully protected and effective?

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**Kenneth Leon  
Kolowa**

**Kolowa:** The most important strategies are:

- Having strong IPR protection and enforcement regime especially on protection of counterfeit and pirated goods, online privacy and data privacy.
- Effective IPR system/regulator which will help boost economic growth, promote investment and develop industries that promote creativity and innovation.
- More education to the subject on the importance of protection of their intellectual property rights.

### Q7. How do you determine where to file a trademark or patent?

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**Raghuram  
Supramaniam**

**Supramaniam:** Trademarks and patents are territorial in nature. The business strategy of a particular brand or patent owner will play the most significant role in determining where to file its trademark or patent. For cost reasons, no brand or patent owner will file in every country in the world, however, such owner could always resort to international filing systems such as the Madrid Protocol for trademarks (which Malaysia is acceding to soon) and the PCT for patents if it does not wish to file individual or national applications in the countries of interest.

A company should take into account not only its present business operations but also future plans. South East Asia, for instance, is a significant economy block that contains both developed and emerging markets and should be of serious consideration for companies wishing to extend their business presence.

In relation to South East Asia or at the global level, it is advisable to emphasise on filing trademarks in countries which practice the first-to-file system, at least to pre-empt any bad-faith registration by third parties that intend to usurp the rights of the brand owner in such countries. This is of course, provided that such brand owner intends to actually use the mark in the future, for failing to use the trademark within the prescribed period under the relevant country's trademark laws could result in the trademark falling prey to non-use cancellation actions.

For precautionary reasons, all IPR owners are also advised to conduct searches prior to the actual filing of such IPRs in the countries of interest, in order to gauge the viability of such filing and also pre-empt the possibility of being objected by the Registrar or opposed by an aggrieved third party. The outcome of such searches may be useful in determining the expansion strategy of the business and assess the risk involved, or even identify one's competitors in such markets.



**Nina Moshynska**

**Moshynska:** As soon as the IP object is created, it must be protected or filed for protection. It is rather fair to compare the IP protection with pregnancy as some important arrangements should be completed well before the filing process. Each case is individual and it is one of the greatest features of IP: individual strategy, individual conditions, and individual experience always. Experience in IP does matter.

It is very difficult to determine the filing strategy without important studies such as desirable markets, applicable law, patent or trademark searches, estimation of chances for patent or trademark registration, evaluation of expenses. A choice of jurisdictions lies at the point of a fair balance between interests and potentialities. The choice can be done after studies above. It is very important to admit that filing strategy should be flexible as Paris Convention, Madrid system, and PCT system do not require a certain and final choice. The international law provide for a wide term for making a decision, restoration of rights and changing of initial strategy. Naturally, an IP object without strong protection strategy will unlikely bring the desired results.

## Q7. How do you determine where to file a trademark or patent?



**Emmanuel Ekpenyong**

**Ekpenyong:** A business name, trademark or patent are filed at the Registry by accredited agents. Please see answer to question 2 above.



**Patricia McGovern**

**McGovern:** An applicant should file for trade mark or patent protection at the very least in the jurisdictions where they intend to use the mark or the invention as appropriate. However, if you are considering filing a trade mark as a defensive measure, for example because you consider a third party may use your mark there, make sure that you take appropriate advice in that jurisdiction to ensure there is no requirement to establish use of your trade marks.

It is sometimes the case that you may not be able to obtain trade mark protection in all jurisdictions of interest because of prior rights, in which case you may have to consider different brands for different jurisdictions or reassess the appropriate brand.



**Yu-Li Tsai**

**Yu-Li Tsai:** Regarding patent rights, it is a general rule that the patentee of a patent has an exclusive right to prevent others from exploiting the invention, creation or design without the patentee's consent. If the invention, creation or design is a product, its exploitation means the acts of making, offering for sale, selling, using, or importing that product for the aforementioned purposes. In addition, if the invention is a process, its exploitation means the following acts: (i) using the process; and (ii) using, offering for sale, selling or importing for these purposes the product obtained directly by that process.

Regarding trademark rights, it is a general rule that in the course of trade and without consent of the proprietor of a registered trademark, the following act constitutes infringement of the right of such trademark: using a mark which is identical with/similar to the registered trademark in relation to goods or services identical with/similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers.

From the above-mentioned general rules, we can conclude that to ideally protect the patent and/or trademark rights, the owner should file in the countries where the infringers may infringe the exclusive rights. For patents, this includes the the places of manufacturing, selling, using, or importing the infringing products, or the places of using the process or using, selling or importing the product obtained directly by that process. For trademarks, this includes the places of using a mark which is identical with/similar to the trademark owner's trademark in relation to goods or services identical with/similar to those for which the trademark owner's trademark is designated.

*“Regarding trademark rights, it is a general rule that in the course of trade and without consent of the proprietor of a registered trademark, the following act constitutes infringement of the right of such trademark: using a mark which is identical with/similar to the registered trademark in relation to goods or services identical with/similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers.”*

*- Yu-Li Tsai -*

### Q7. How do you determine where to file a trademark or patent?

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Dr Silvana Zammit

**Zammit:** The jurisdiction of filing is an important pillar when devising the IP protection strategy. Considering that IP rights are generally constrained by territorial borders, the actual location of the owner's client base, business expansion plans, the competitors' location and prior rights need to be analysed and taken into consideration when determining where to file for protection.

Chetcuti Cauchi Advocates has experience in providing specific jurisdictional protection expansion plans. Generally, should the client simply intend to make genuine use of a trademark or a patent in the local sector, then filing for protection with the local Industrial Property Registrations Directorate (IPRD) authority may be enough. However, should the client intend to use a trademark or a patent in more than one jurisdiction, then a trademark or patent application needs to be filed either in every jurisdiction where the client intends making use of the IP, or when available, consider EU or international protection by means of a singular application relying on the treaties/conventions that Malta is signatory to.

### Q8. What are the challenges of managing a large IP portfolio?

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Andrew Sherman

**Sherman:** The challenges of managing a large IP portfolio centre around issues in efficiency, waste, lack of collaboration and gaps in coordination in the protection and commercialisation of these assets to drive stakeholder value. Only a fraction of the world's largest companies purport to have effective and efficient Intangible Asset Management (IAM) systems in place to effectively govern their portfolio. Better tools and systems need to be developed at the risk of billions of dollars in lost opportunities on an annual basis. In addition, leaders of companies need to foster more engaged and collaborative cultures that will be willing and truly able to embrace these systems once they are effectively implemented. Levels of disengagement globally are alarming and are standing in the way of innovation and intrapreneurship.



Nina Moshynska

**Moshynska:** Well, any management starts from a manager. The management must be effective, fast and professional. The large IP portfolio requires a manager to develop a dual management approach based on information technologies (saving, updating, transforming and sharing of information) and core values (goals, means and solutions).

On the one hand, it is important to consider the cost for registering IP objects. Moreover, a large IP portfolio requires regular payments for maintaining registration documents in force. On the other hand, a large IP portfolio offers huge benefits. Searching for an ideal balance between costs and benefits is an essential process for managing any IP portfolio. The main rule for business management is that IP must bring benefits (financial, reputational, promotional, marketing etc.); the strategy must be reconsidered if this rule is not working.



Emmanuel Ekpenyong

**Ekpenyong:** The main challenges of managing large IP portfolio include:

- Since states under an international treaty have different timeline for filing of IP, it may be difficult to track the timelines across all the states in which the IP is to be filed.
- Difficulties in coordination of the filing process of different IP in different classes.
- Translation of IP to a different language may be inaccurate and may defeat the purpose of the IP application.
- Lack of, irregular or dubious progress report from the accredited agents.
- Administrative delays in filing IP in some jurisdictions.

### Q8. What are the challenges of managing a large IP portfolio?

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Patricia McGovern

**McGovern:** The most obvious solution to the challenge of managing a large IP portfolio is to ensure that you have a proper trade mark management system in place and competent people to manage it. This should ensure that any relevant deadlines (e.g. renewal deadlines) are in place with suitable reminders.

Following on from that, the actual portfolio needs to be reviewed constantly to ensure it is adequate. For example, have there been improvements to any inventions such that further patent protection should be sought? Are all trade marks being used in the form in which they are registered or do new filings need to be considered? Has your product line expanded such that you need to re-file to obtain protection for other goods and services? Have you kept adequate records of any coexistence agreements that you may have entered into or any licences of your IP that you may have granted? Do you own rights that are surplus to your requirements that perhaps could be income generating if you licensed them or assigned them?



Yu-Li Tsai

**Yu-Li Tsai:** The interested party should establish a team with members having expertise in IP-related law (e.g. patents, trade secrets, plant varieties, or lay-out designs for integrated circuits). The team should include members with relevant technical backgrounds, and abilities to develop effective strategies, deploy and manage its global IP portfolios, negotiate global IP assignment or licensing, mobilise its resources to periodically conduct global market investigations, and maintain proper cooperation with local counsels.

The team should also undertake general preparations and procedures such as (i) make sure the IP rights are valid with a certain level of invincibility, preferably confirmed by a local counsel; (ii) identify which IP rights are infringed with at least a preponderance of evidence, preferably confirmed by a local counsel again; (iii) collect sufficient evidence before filing a lawsuit; and (iv) maintain effective communication with the local counsel to ensure consistent information.

### Q9. What are the biggest mistakes companies make in pursuit of protecting their intellectual property rights (IPRs)?

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Raghuram  
Supramaniam

**Supramaniam:** Amongst others, many companies do not conduct a review, audit or due diligence over their business to analyse and identify what IP rights they own. Identification of IPRs is probably the most crucial part of IP protection, as it paves the path for the company towards a smooth strategy establishment. Once a company has identified its IPRs, only then it will then be able to protect the relevant IPRs under the available means of protection, for instance by filing trademark applications for its brands and slogans and copyright voluntary notifications for its contents and marketing materials. Once protected, the company will finally be able to harness the full potential of such IPRs by looking at what form of exploitation is possible for each IPR owned by the company. Once an IP strategy or policy is in place, the company's employees, including its marketing personnel, would also be able to consistently make use of the strategy to ensure outreach of the brand and the business amongst the purchasing public.

Secondly, many companies also fail to allocate the necessary budget for IP protection from the outset, as these companies fail to appreciate that their IPRs are essential part of their assets. In the absence of protection, as and when a problem arises, the company would be required to spend more funds in commencing or defending an action against a third party, which of course could have been avoided if the company had the necessary budget allocation for IP from the beginning.

### Q9. What are the biggest mistakes companies make in pursuit of protecting their intellectual property rights (IPRs)?

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Andrew Sherman

**Sherman:** The biggest mistake that companies make in protecting their IPRs is playing too much defence and not enough offence in crafting their playbooks. Many companies focus too heavily on treating their IP solely as a moat around their castle without considering the various revenue streams that the body of water is capable of generating to drive enterprise valuation. Make no mistake, I am not supporting NPU patent trolls, but do fully support a much more robust technology licensing effort and overall commercialisation strategy. There are a wide variety of structures, from joint ventures, strategic alliances, cooperatives, brand-extension licensing and similar strategies which can be implemented to increase deployment.

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Nina Moshynska

**Moshynska:** The biggest mistake is a loss of time: loss of time for drafting of agreements between owners and inventors/authors, loss of time for filing of applications, loss of time for IPRs prosecution and enforcement. Many companies have lost their IPRs because delayed actions for protection.

Other matters such as a lack of experience, lack of familiarity with IP issues, committing strategic mistakes, weak confidentiality policy or the unintentional disclosure of confidential information can be cured when the measures are applied timely. Essentially, not fighting for infringed or lost IPRs is far worse than a loss of time.

In order to avoid a loss of time, anyone who wants to benefit from his IPRs should develop a strong and flexible strategy not only for plan A (mission accomplished) but for plan B (mission failed) as well.

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Emmanuel Ekpenyong

**Ekpenyong:** The biggest mistakes are:

- Where a company employs a designer to design its IP without a work for hire agreement, the designer may claim the IP in the future.
  - Where a company discloses too much business information on its products and services when it wants to enter into a non-disclosure and confidentiality agreement.
  - Where a company fails to reduce its idea to a time-stamped document before a notary public, it may be difficult to prove that it has priority over a similar IP.
  - Where a company stores its IP using an online storage provider with an insecure encryption.
  - Where a company underrates the value of its business's IP by failing to improve its value to attract customers and investors.
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Kevin Wong

**Wong:** Companies may miss out on significant time and cost savings if they choose to file their trade marks separately in each jurisdiction, rather than avail themselves of the Madrid Protocol system where available and appropriate. At the same time, companies should be aware of the concept of “central attack” under this system. In this regard, the validity of an international registration is dependent on the validity of its base application/registration for the mark. Accordingly, companies should place particular emphasis on ensuring the validity of their base applications and registrations. For example, base applications should have undergone pre-filing clearance searches to ascertain the risk of potentially conflicting trade marks jeopardising successful registration.

Companies often fail to appreciate the difference between a ™ and an ® symbol when used in relation to their trade marks. The former merely seeks to inform the general public that the accompanying mark is to be used in a trade mark sense. In first-to-file jurisdictions, steps should be taken to register the accompanying mark in order for it to be protected as a trade mark. On the other hand, the latter “®” symbol is an indicator that the accompanying mark is a registered trade mark and hence, can only be used after registration is granted. In some jurisdictions, using the “®” symbol in relation to unregistered trade marks is an offence.

### Q9. What are the biggest mistakes companies make in pursuit of protecting their intellectual property rights (IPRs)?

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Kevin Wong

After the trade mark is granted, companies should also keep in mind post-grant maintenance. This includes ensuring that their registered trade marks are renewed within their validity period, which is generally 10 years for trade marks filed in ASEAN, and monitoring their registered trade marks to check whether identical or similar marks are being used by someone else. For the latter, companies should take steps to enforce their rights in their registered trade marks to prevent the goodwill and reputation attached to their brands from being abused and usurped by competitors.

Furthermore, given the ubiquity of e-commerce and online advertising, it is important for companies to register any domain names that incorporate their registered trade marks. The more well-known a trade mark is, the more likely there will be cyber squatters who will pre-emptively attempt to register related domain names. In this regard, the process of recovering a domain name is relatively more time-consuming, costly and complex than registering it beforehand. Under the commonly administered Uniform Domain-Name Dispute-Resolution Policy Rules, the ownership of a trade mark which is similar or identical to the registered domain name is but one of the three requirements that have to be fulfilled before recovery of the domain name is possible. The applicant has to further show that the current registrant has no legitimate interests in the domain name and that it is currently being used in bad faith.

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Patricia McGovern

**McGovern:** Probably the biggest mistake that businesses make in pursuit of protecting their IPRs is not taking appropriate legal advice or appropriate legal advice at the correct time. Issues that may flow from this are as follows:

- An invention may be disclosed thus rendering it impossible to obtain patent protection.
  - A mark may be chosen that is simply not protectable, for example, because it is generic or descriptive or may only be capable of protection after significant use leaving the business vulnerable in the meantime.
  - Searches may not have been carried out resulting in a mark having to be abandoned after significant sums may have been spent on developing it and marketing it.
  - A mark may not be registered for all of the goods and services for which protection is necessary.
  - A business may be using the mark not in the form in which it is registered.
  - Probably one of the most significant mistakes is not enforcing rights where appropriate and thus resulting in the rights being lost or restricted.
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Yu-Li Tsai

**Yu-Li Tsai:** The biggest mistakes companies make in pursuit of protecting their IPRs include: (i) failing to make their best effort to gather enough evidence to establish a convincing case, such as whether the sale proof of the infringing product, a credible analysis report of infringement, etc.; and (ii) failing to make sure that their IPRs are strong enough, such as whether the patent can overcome all known prior arts, whether the trademark has enough distinctiveness, whether the copyrighted work is not highly similar to other's famous work, etc.

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*“The more well-known a trade mark is, the more likely there will be cyber squatters who will pre-emptively attempt to register related domain names. In this regard, the process of recovering a domain name is relatively more time-consuming, costly and complex than registering it beforehand.”*

*- Kevin Wong -*

### Q10. What steps should be taken if it is believed that your IP has been breached?

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**Raghuram  
Supramaniam**

**Supramaniam:** If and when the need arises where one's IPR has been breached, the first step in encountering such a situation will be to seek legal opinion from a qualified IP practitioner. A qualified lawyer who is well versed with the IP laws would be able to provide a comprehensive advice over what possible causes of action are available to such aggrieved party and how one may proceed.

An IPR owner may avail himself to civil or criminal remedies after having weighed the available options, or both simultaneously if the relevant laws provides for the same. For instance, a trademark owner may seek assistance from an IP practitioner on the enforcement of its rights under the Trade Marks Act 1996 for civil remedies or under the Trade Descriptions Act 2005 for criminal remedies against an infringer. Similarly, a copyright owner may choose between a civil or criminal action against an infringer under sanctions provided under the Copyright Act 1987, depending on the owner's financial constraints or other relevant factors. Depending also on how well the IPR owner keeps its documentation, the practitioner may be able to advise on the chances of success, as sometimes, documentary evidence may strongly be required to show one's prior rights over the disputed IPR.

The decision to commence civil or criminal action may be determined based on the IPR owner's ultimate objective (i.e. whether he wants to simply put a stop to the infringing activity or also claim compensation). Damages and cost may be recoverable from the infringer through civil actions to cover the losses suffered from such infringement and costs incurred in commencing the action.

If the IPR owner pursues the criminal path, it may commence by lodging a complaint to the Ministry of Domestic Trade and Consumer Affairs under the Trade Description Act 2011 or Copyright Act 1987, following which a search and seizure could be conducted at the infringer's premises and such infringer may then be prosecuted in Court or imposed with compounds.



**Nina Moshynska**

**Moshynska:** Usually the law provides for different measures for enforcement of IPRs, but individual approach should always be applied.

First of all, it is important to have a reliable IP professional in the relevant jurisdiction who can properly record the infringement, clearly determine what kind of infringement has occurred and why. In addition, sometimes only skilled professionals can timely recognise the breach to an IPR due to the hidden actions of the infringer or lack of special knowledge on unfair competition and case law. The next step is studying the matter, finding possible solutions, evaluating of expenses, etc.

Many disputes can be resolved via amicable settlements, some disputes should be resolved in the court only, and some issues should be taken into consideration for prevention of future infringements. For example, the Ukrainian court has a right to: apply immediate remedies to prevent violation of IPRs; terminate passing through the Ukraine custom borders of goods imported or exported with the violation of IPRs; withdraw from the civil circulation the goods with violation of IPRs; apply a penalty/reimbursement for losses due to unlawful use of the IP object.

*"Many disputes can be resolved via amicable settlements, some disputes should be resolved in the court only, and some issues should be taken into consideration for prevention of future infringements."*

*- Nina Moshynska -*

## Q10. What steps should be taken if it is believed that your IP has been breached?

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**Emmanuel Ekpenyong**

**Ekpenyong:** If you believe your IPR has been breached, you should:

- File opposition at the Registry against published infringing IP.
  - Write cease and desist letters to infringer of their IP and demand for compensation for use of the IP.
  - In appropriate cases, be open to discuss possible assignment of the IP to the infringer or other third parties to use the IP.
  - Commence criminal proceedings against the infringer.
  - Commence civil proceedings against the infringer to enforce IP rights, obtain an injunction and seizure of copies of the infringed work.
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**Kevin Wong**

**Wong:** At the outset, the trade mark owner would have to ascertain the strength of his case for infringement, as informed by the nature and extent of infringement and potential defences raised, and the identity of the suspected infringer. These can be ascertained through private investigations.

After verifying that a sufficiently strong case for infringement exists, a cease and desist letter may be issued to compel the infringer to cease his infringing activity. Broadly speaking, this letter should set out trade mark rights in the infringed mark, the particulars of the alleged infringement, the trade mark owner's demands (which generally relate to ceasing all infringing activity) and the time within which such demands must be complied with, failing which enforcement action will be commenced.

Otherwise, if the infringement is particularly egregious and the case for infringement is strong, the trade mark owner may do away with the cease-and-desist letter and commence enforcement proceedings as quickly as possible.

In terms of methods of enforcement, the time, costs and remedies involved will influence the appropriate method to undertake.

Enforcement proceedings can be commenced before specialised IP administrative bodies which have specialised rules of procedure. This makes proceedings more streamlined than those under courts of law, resulting in substantial savings in time and cost. However, remedies may be limited depending on the jurisdiction and certain ASEAN countries, such as Singapore and Malaysia, do not have such administrative bodies.

Civil litigation proceedings are generally more time and cost-intensive and are therefore best reserved for where the damage claimed for losses are substantial and the infringer has the financial ability to compensate for the same.

Criminal proceedings are generally commenced after a "raid" or any similar enforcement action which requires forceful entry to the premises of the suspected infringer. Thereafter, infringing items found at the premises will be seized and the infringers held liable for the applicable criminal penalties. As criminal actions are instituted in different ways in ASEAN, developing a country-specific strategy will be necessary. Furthermore, criminal proceedings are generally more suitable to deal with large-scale infringing activities as the effort and costs involved are relatively substantial.

Border enforcement refers to the practice of holding imported goods at border control or customs where the goods sought to be transported are determined or suspected to be counterfeit. This involves coordination with customs authorities and depending on the jurisdiction, will involve the registration of marks and goods to be monitored by border control officers.

### Q10. What steps should be taken if it is believed that your IP has been breached?



Patricia McGovern

**McGovern:** If you believe that your IP rights have been breached it is important that you take good legal advice as to whether this is in fact the case or not. Thereafter evidence should be collated of the actual breach and, if advise, you take the appropriate action to stop the breach. Sometimes a cease and desist letter may lead to a resolution but often the issue of legal proceedings may be necessary.



Yu-Li Tsai

**Yu-Li Tsai:** Firstly, start to collect evidence of infringement immediately. For example, for the products publicly sold on the market (preferably through a credible agency) or the product specifications from which an infringement can be directly and unambiguously inferred. The receipt or invoice for buying the infringing product should be carefully kept to firmly prove the facts of infringement.

Secondly, make an infringement identification report. For example, if the patent right is infringed, one should prepare a report, either made by oneself, an outside counsel or professional organisation (i.e. to analyse therein why the patent is infringed), while preferably, a detailed claim chart analysis based on the laws of literal infringement, doctrine of equivalents, file wrapper estoppel, etc. should be presented.

Thirdly, send out a warning letter to the infringer before taking legal actions. One can state the statutory rights to sue, knowledge of infringing conducts, and outline demands, settlement conditions, required royalties, and/or claimed damages.

Fourthly, move for preservation of evidence if it is likely that the evidence may be destroyed or its use in court may be difficult. The important evidence which may need to be preserved include: infringing products, semi-finished product, raw materials, accounting book, etc.

Fifthly, move for an injunction maintaining the temporary status quo before the infringement proceedings. The plaintiff shall explain why it is necessary to prevent material harm or imminent danger or other similar circumstances through such motion. The practical standards may be understood as those implemented in the U.S., i.e., (i) that there is a likelihood of irreparable harm with no adequate remedy at law; (ii) that the balance of harm favours the movant; (iii) that there is a likelihood of success on the merits of the case; and (iv) that the public interest favours the granting of the injunction.

Finally, one can initiate a law suit at the court within the statutory limits if one completes preparing sufficient evidence and infringement identification report. One should file a complaint with the basic contents including: the claims for damages, excluding or preventing infringement, and/or destroying infringing products, raw materials, or manufacturing machines, etc.; the important facts of the case; and the reasons justifying one's claims.

*“If you believe that your IP rights have been breached it is important that you take good legal advice as to whether this is in fact the case or not.”*

*- Patricia McGovern -*

### Q11. Can you detail the importance of getting the right legal strategy in pursuit of litigation?

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**David Halberstadter**

**Halberstadter:** IP litigation can take on a life of its own. For plaintiffs, I have often described litigation as a train that is easy to hop on, but not so simple to hop off. Once a complaint has been answered, a plaintiff typically cannot simply dismiss the action voluntarily if he or she later decides that the costs and risks no longer seem worth the potential reward.

For defendants, an IP lawsuit is the train that one wants to step off at the earliest possible station. The essential defence strategy is to find a legitimate basis for getting claims disposed of at the initial motions stage or by no later than the summary judgment phase. And if it is not possible to obtain summary dismissal of all of the plaintiff's claims, Plan B is to pare the claims down and eliminate named defendants, such as corporate affiliates and key executives who may have been added to beef up the lawsuit.

Selecting the right litigation strategy is therefore important to both sides of the dispute. When representing a copyright plaintiff, it is critical to undertake a dispassionate investigation of the key elements of the claim. Can the plaintiff demonstrate that he is the legitimate copyright owner of the work in issue? Does she have a valid certificate of copyright registration? How persuasive is the evidence that the defendant somehow obtained access to the plaintiff's work in order to copy from it? And how similar is the defendant's work to the plaintiff's in terms of copyright-protectable expression? Are the works similar more in respect to their unprotected core ideas, or do they share unique ways of expressing those ideas?

These are the very questions an attorney for a copyright defendant will explore in determining whether there exist grounds, based on the allegations of the complaint and a comparison of the works at issue, for a court to grant a motion to dismiss even before any discovery is taken? If not, what is the minimum discovery that the defendant will need in order to file a motion for summary judgment?

The more carefully each attorney evaluates these issues, the more likely it is that a copyright infringement lawsuit will be resolved (whether by settlement or summary disposition) without wasteful expenditures of time and money.

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**Emmanuel Ekpenyong**

**Ekpenyong:** The strategy adopted for one infringement matter may not be the same with another one. For instance, the remedy where a former employee maliciously hacks onto the server of the employer and cause it to lose some important data is different from where a pirate reproduces literary work of another for the purpose of gaining illegal wealth from the work. In the former case, a criminal complaint towards criminal prosecution against the employee under the Cybercrimes (Prohibition, Prevention, ETC) Act, 2015, may be an effective remedy. But in the latter case, an injunction to prevent the pirate from selling the literary works may be an appropriate remedy.

It is therefore very important for the IP agent to advise the Owner on the effective strategy to be adopted to put an end to the breach, discourage other persons from the breach in future and get the Owner adequate compensation for the breach.

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**Patricia McGovern**

**McGovern:** The right legal strategy will depend very much on the circumstances but again it is important to take legal advice so that you are aware of your chances of success and you also know any problems you may face or vulnerabilities that you have. Businesses should also be conscious of the commitment, both financial and time, that litigation can involve. You should also try and establish a clear picture of what you want to achieve through litigation. Is it merely cessation of the infringing activity, is obtaining compensation and recovery of costs important to you, are you looking to establish some sort of coexistence arrangement or perhaps a combination of all of the above? Practical considerations also need to be taken into account to make sure that the right company takes the legal action and that it is instituted against the correct defendant. Clearly if cross-border litigation is involved it is important that all of the legal teams liaise so that a strategy is not pursued in one country which may be inconsistent with a strategy in another country.

## Q12. Given the current strength of M&A activity in the technology sector can you outline the importance of due diligence in relation to IP prior to completing an acquisition?



Andrew Sherman

**Sherman:** In 2019, M&A activity in the technology sector has been very strong to date and appears to be on track to finish the year accordingly. However, the technology sector is not the only industry where IP and intangible assets are a critical component of the due diligence process. Industry sectors such as communications, health care, hospitality, energy and specialty retail all may feature significant IP portfolios as part of the assets being conveyed to a buyer. IP due diligence has earned its place alongside human capital and financial matters as a critical component of the overall due diligence process.



David Halberstadter

**Halberstadter:** In 2013, Comcast acquired NBCUniversal Media for \$16.7 billion. In June 2015, Verizon Communications closed its \$4.4 billion acquisition of AOL. One month later, AT&T closed its \$49 billion acquisition of DirecTV. Then in August 2016, Comcast also acquired DreamWorks Animation SKG for \$3.8 billion. In June 2018, AT&T finally received a federal judge's blessing to formally close its \$81 billion deal for Time Warner. In December 2018, Nexstar Media Group Inc. acquired Tribune Media in a \$4.1 billion deal. And in March 2019, Disney finalised its plan to acquire most of 21st Century Fox for \$71.3 billion, after fending off rival bids from Comcast.

One thing that all of these transactions have in common is that the acquisition included prodigious quantities of intellectual property: Huge libraries of older motion pictures and television series; current films and programming; and projects in stages of development ranging from newly conceived to ready to green-light. Most existing content is subject to distribution and licensing agreements throughout the world; and many projects still in development are potentially subject to output arrangements by which exploitation for a specified term has already been committed to other companies.

A key aspect of any merger or acquisition of a company whose principal assets consist of intellectual property is getting a handle on exactly what IPRs the target company actually owns and how much of those rights are already tied up with existing contractual commitments, and for how long. Without knowing the answers to these questions, it is virtually impossible to place a reasonable value on the assets or company to be acquired or to know how and when the acquirer will be able to monetise these assets for itself.

The IP due diligence in such a transaction consists, on the simplest of levels, of a thorough assessment of what rights have come into the target's possession and what rights have been licensed out. This sounds conceptually simple, but the devil is in the details, because what this really means is that for each piece of intellectual property, counsel for the acquirer must review the complete chain of title to the target's acquisition of the content and every contract by which rights were granted to a third party. Suffice it to say that this is a complex and exhaustive process, but a critical one.



## Q12. Given the current strength of M&A activity in the technology sector can you outline the importance of due diligence in relation to IP prior to completing an acquisition?



**Emmanuel Ekpenyong**

**Ekpenyong:** Due diligence in relation to intellectual property is very important in M&A because it assist the acquirer or investor to:

- Ascertain the unknown liabilities and risks associated with IP of the company to be acquired (“the acquiree”).
- Determine the marketability of the acquiree.
- Identify inherent weaknesses associated with the IP portfolio of acquiree which may compromise a sale.
- Determine the ownership of the acquiree’s IP and documentation in proof of such ownership.
- Identify potential sources of wealth which the acquiree did not harness from its IP.
- Identify competing interest and a likely litigation risk.
- Demand for more information and documentation of the acquiree’s IP.
- Evaluate the worth of the acquiree’s IP.
- Ascertain which of their products or services in which they will use the acquiree’s IP.



**Patricia McGovern**

**McGovern:** IP can be an extremely valuable asset. When carrying out due diligence important things to establish are the ownership of any IP and its current status, for example, has registration been obtained where appropriate and are there adequate records for when any registrations need to be renewed, has any IP been licensed in or licensed out, are there any coexistence agreements in relation to its use. It is also important to become aware of any disputes that may exist and the chances of success in relation to those disputes. It would also be important to establish if any of the IP is subject to any vulnerabilities.



**Dr Silvana Zammit**

**Zammit:** Mergers and acquisitions (M&A) for entities operating in the technology sector facilitate their ability to enter into new markets and achieve effective scale and scope economies. The nature and extent of due diligence undertaken in relation to IPRs of the interested parties prior to the completion of the transaction have a significant bearing upon the success or otherwise of the M&A itself and the business thereafter.

Effective due diligence sheds light upon the existing IPRs retained by the interested parties, thereby identifying and confirming whether the contracting party retains legal title over the IPR it claims to own and enjoy benefits thereof, and whether the said right may be eventually transferred or assigned further on. Accordingly, an adequate and thorough due diligence exercise enables the contracting parties to conduct an informed evaluation upon the nature and extent of the technological innovation and market exposure that the counter-party will be contributing and making available.



### Q13. What key trends do you expect to see over the coming year and in an ideal world what would you like to see implemented or changed?

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**Raghuram  
Supramaniam**

**Supramaniam:** Malaysia's accession to the Madrid Protocol, which is expected to happen sometime in 2019 or 2020, is probably the most anticipated news amongst IP practitioners. The main advantage in the implementation of the international registration system in Malaysia is that a trademark owner may seek protection of its trademark in several member countries of Madrid Protocol simultaneously by filing just one application at its home office and by paying one fee. This would greatly benefit Malaysian companies who intend to protect their trademark in many other countries but are conservative when it comes to cost.

The Trade Marks Act 1976 is already being overhauled, by the introduction of the Trade Marks Bill 2019 which had its first reading in Parliament recently, to introduce relevant provisions relating to the governance and operations of the Madrid Protocol system.

IP practitioners are also expecting changes to be made to the now-dated Copyright Act 1987, as Malaysia needs to catch up with changing trends and technologies surrounding dissemination, sharing or distribution of media contents through the internet. Streaming of content has become a household standard, but the provisions of the Act are not sufficiently comprehensive to cover all the issues that may possibly arise.

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**Andrew Sherman**

**Sherman:** Over the next few years, as our workplaces adjust to the impact of AI, robotics and automation, virtual reality and the internet of things (IOT), company leaders will have no choice but to consider their intangible assets and IP to be the most important strategic asset on their balance sheet. Companies will need to recognise the strategic importance of their processes, systems, channels, know-how, show-how, data, brands and best practices, all as being central components of their enterprise valuation and at the core of their growth strategies. In an ideal world, the perspective of the debt and equity markets, the lending standards of commercial banks, the orientation of financial professionals and global accounting standards are all modified and updated to reflect this permanent new reality.

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**Emmanuel  
Ekpenyong**

**Ekpenyong:** In Nigeria, though the electronic process of filing IP has brought tremendous progress in the filing of trademarks, nevertheless, the Registrar should ensure that a Trademark Journal is published at least once every two months and not once or twice a year as is the case now.

Owners of IP should be vigilant and more courageous in protecting their IPRs even across borders.

There should be an effective way of curbing breaches of IP online and breaches in the social media.

The Registry, the Copyright Commission, legislators and the Court should be more innovative in preventive sanctions to discourage wanton infringement of IPRs in order for Owners to get their full reward for their work and to deter pirates from reaping where they did no sow.

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**Patricia McGovern**

**McGovern:** Over the coming year, we would expect to see more issues relating to the GDPR arising. In an ideal world, I would like to see the GDPR not resulting in decreased access to databases which had been a key element in assisting in the enforcement of IP rights. Brexit, as and when it occurs, is also likely to have an impact on IP but a lot will depend on the ultimate deal, if any, that is struck and whether the UK remains in the Customs Union or not.

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