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Yours,
David Postolski

Welcome to our IAG March 2016 Newsletter

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THE “360º TEST” FOR TRADEMARK CONFUSION

In common law countries, we can observe the development of judgment methods for the analysis of trademark confusion cases, as the notorious Polaroid factors test.

Brazil is a civil law country, which means the laws provide general commands, leaving to Judges the task to construe and enforce it according to each case. Thereby, the Brazilian Industrial Property Law, in Article 124, XIX, states that a mark cannot be registered if it is likely to entail confusion or association with a mark registered in the name of a third party. As we can see, the Law does not provide criteria to assess the likelihood of confusion or association. the characterization of trademark confusion.

Brazil’s Superior Court of Justice had its own understanding when it comes to trademark infringement, i.e, the Plaintiff had to demonstrate not only the similarity between the marks and the type of products in question, but also the evidence of actual confusion of consumers. Nevertheless, the decisions of the courts still lacked a detailed set of standards to be followed to gauge the occurrence of trademark confusion or association, making this analysis personal and subjective.

After analyzing the Brazilian Courts’s decisions on trademark confusion matters of the past two decades and conducting comparative law studies, Mr. Filipe Fonteles Cabral and Mr. Marcelo Mazzola, lawyers and partners at Dannemann, Siemsen Advogados noticed the existence of seven criteria that usually guided Justices when ruling these cases, which “coincided, in many aspects, with the tests applied in other jurisdictions”.

In view of this, they published a study entitled “360º trademark confusion test”, in which they have established seven criteria to be used when determining whether trademarks are confusingly similar: (i) the marks’ intrinsic degree of distinctiveness, (ii) the degree of similarity between the marks, (iii) the legitimacy and fame of the alleged offender, (iv) the amount of time the marks have co-existed in the market, (v) the type of products in question, (vi) the specialization of the target public and (vii) dilution.

This is an excellent tool for litigation before Brazilian courts and also for the administrative proceedings before the Patent and Trademark Office, since it provides an objective, accurate and systematized model for the resolution of trademark confusion cases.

As a consequence, the 3rd Panel of the Superior Court of Justice, in a recent decision involving the trademarks Chester (BRF S.A.) and Chester Cheetah (Pepsico, Inc.), both related to the food industry, expressly applied the judgment method proposed by the “360º Test” to reaffirm the possibility of coexistence of the Trademarks in the same market niche. In order words, the Superior Court of Justice has recognized the relevance of the “360º Test”.

It is worthy to notice that this new standard has also been applied by Brazilian State Courts specialized in Industrial Property matters.
The “360º Test” is not only important to create a model for the analysis of whether trademarks are confusingly similar, but also contributes with the approximation among common law and civil law, since it reveals an inclination to lay down parameters for the analysis of trademark cases, as it has already been done in common law jurisdictions.

This recent precedent gains even more relevance with the upcoming of the New Brazilian Civil Procedure Code (Law n. 13.105), which will become effective as of March 18th, 2016, especially when considering the provision of Article 489, § 1, VI, which establishes the duty to comply with the precedents of the Superior Courts when related to the same matter in discussion, so as to ensure foreseeability and greater legal certainty for parties, lawyers and foreign investors.

Therefore, we conclude that we shall see other rulings involving the use of the “360º Test” and, as a consequence, a path to a systematic approach toward trademark matters between common law and civil law.

Rodrigo A. Torres and Daniella L. Fischer Matos, Dannemann, Siemsen Advogados, ratorres@dannemann.com.br, Brazil.

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3 AgRg no RECURSO ESPECIAL Nº 1.346.089/RJ, Reporting Justice Moura Ribeiro, Third Panel, Judged on May 14th, 15.

4 Como a Justiça brasileira diferencia marcas semelhantes, published in Jota, jun. 2015.
“Trunki” – the end of the road

On 9 March 2016, the UK Supreme Court handed down its decision in the case of PMS International Group Plc (Respondent) v Magmatic Limited (Appellant). This case relates to Magmatic’s ever popular ride-on suitcase for children, the “Trunki”.

Magmatic owns Community Registered Design (CRD) No. 43427-0001 (‘the design’).

In February 2013, Magmatic issued proceedings seeking damages and an injunction against the respondent, PMS International Group plc, alleging that PMS was importing into, and selling in, the United Kingdom and Germany a “Kiddee Case” which infringed the CRD.

Here, an image from the design is shown alongside a Trunki product and the alleged infringement:

At first instance, Arnold J found the design to be valid and infringed.

PMS appealed to the Court of Appeal solely on the issue of whether the Kiddee Case infringed the CRD. The first instance finding of infringement was overturned by Kitchen LJ.

Magamatic appealed to the Supreme Court.

The arguments of substance before the Supreme Court were limited to whether the Court of Appeal’s criticisms of Arnold J’s approach at first instance, as set out in paras 41-42 and 47-48 of Kitchin LJ’s Appeal judgment, were correct.

Paras 41, 42 and 47 of the Appeal judgement read as follows:

“41. … Further and importantly, the suitcase looks like a horned animal with a nose and a tail, and it does so both because of its shape and because its flanks and front are not adorned with any other imagery which counteracts or interferes with the impression the shape creates. As Mr Vanhegan submits, the CRD is, in that sense, relatively uncluttered and it conveys a distinct visual message. Here then the first of the judge’s errors can be seen: he failed to appreciate that this is a design for a suitcase which, considered as a whole, looks like a horned animal.”

“42. … That is not the end of the analysis, however, because each of the representations shows a distinct contrast in colour between the wheels and the strap, on the one hand, and the rest of the suitcase, on the other. I have given anxious consideration to whether this is simply an artefact of the computer generation process or a visual cue to indicate that the wheels and the strap are each separate components. However, I do not find either of these alternative explanations convincing. The clasps are also separately functioning components and they are not shown in a contrasting colour and it seems to me that the wheels could perfectly well have been shown and depicted as separate components in the same colour as the rest of the body. Moreover, depicted as they are and standing as they do at the four corners of the animal, the wheels are, to my eye, a rather striking aspect of the design as a whole.”
47. First and most importantly, it seems to me the judge failed to carry out a global comparison having regard to the nature of the CRD and the fact that it is clearly intended to create the impression of a horned animal. This is plainly one of its essential features. Necessarily, therefore, a global assessment of the CRD and the accused designs requires a consideration of the visual impression they each create and in so far as that impression is affected by the features appearing on their front and sides, it seems to me those other features must be taken into account. Thus taking the insect version of the Kiddee Case, I believe that the impression its shape creates is clearly influenced by the two tone colouring of the body and the spots on its flanks. As a result it looks like a ladybird and the handles on its forehead look like antennae. Overall the shape conveys a completely different impression from that of the CRD. It was, in my judgment, wrong for the judge to eliminate the decoration on the accused design from his consideration entirely because it significantly affects how the shape itself strikes the eye, and the overall impression it gives. At least in the case of this particular registered design, the global comparison necessarily requires account to be taken of the context in which the accused shape appears. …

The Supreme Court has upheld the decision of the Court of Appeal and has refused to make any reference to the European Court – the CJEU. As such this is the end of the road for Magmatic in this case.

The “Kiddee Case” does not infringe the design.

The full judgement is available [here](#).

**Guidance**

The key point of note is that great care should be taken in the preparation of registered design applications.

For many designs the best protection will be afforded by line drawings, which should protect the shape of a design irrespective of whether a product to the design (or an infringing product) has any ornamentation or tonal differences.

Rupert Knights, Dolleymores, UK (rupertknights@dolleymores.com)
Key changes to the Community Trademark Regulation and the OHIM on March 23, 2016

The following provides an overview of some important changes which are being made to the Community Trademark Regulation and the Office for Harmonisation in the Internal Market, coming into force on March 23, 2016.

<table>
<thead>
<tr>
<th>Summary of the key changes</th>
<th>Summary of what you need to do</th>
</tr>
</thead>
<tbody>
<tr>
<td>1. Renaming of the Office and the CTM</td>
<td>• Note your records internally.</td>
</tr>
</tbody>
</table>
| 2. Changes to Fee Structure | • Take advantage of the current filing fees by filing new EU applications in three or more classes before March 23, 2016.  
• Take advantage of the reduced renewal fees by delaying your renewals until after March 23, 2016. |
| 3. The IP Translator case will be implemented in respect of registrations filed before June 22, 2012 | • Have your portfolio reviewed for trade marks filed before June 22, 2012 and that cover entire class headings; and  
• Where appropriate, file Article 28(8) Declarations before September 23, 2016 deadline. |

1. Renaming of the Office and the CTM
- The Office for Harmonisation in the Internal Market (OHIM) will be renamed the European Union Intellectual Property Office (EUIPO).
- The Community trade mark (CTM) will be renamed the European Union trade mark (EUTM). Any existing CTM applications/registrations will automatically become EUTM applications and registrations on March 23, 2016.

2. Changes to Fee Structure
- There will be changes to the fee structure charged for new applications and the renewal of existing registrations.
- There will also be reduced fees for opposing EUTM applications, seeking cancellation of existing registrations and for filing appeals.
- The current official fees and the revised fees for filing new applications and renewing existing registrations are set out below:

2.1 Official Application Fees for an EUTM filed electronically

<table>
<thead>
<tr>
<th>Class(es)</th>
<th>Current OHIM fee (EUR)</th>
<th>New EUIPO fee (EUR)</th>
</tr>
</thead>
<tbody>
<tr>
<td>One</td>
<td>900</td>
<td>850</td>
</tr>
<tr>
<td>Two</td>
<td>900</td>
<td>900</td>
</tr>
<tr>
<td>Three</td>
<td>900</td>
<td>1050</td>
</tr>
<tr>
<td>Four</td>
<td>1050</td>
<td>1200</td>
</tr>
<tr>
<td>(4th and subsequent class)</td>
<td>150</td>
<td>150</td>
</tr>
</tbody>
</table>
A key change to the fee structure for new trade mark applications is that the official fee no longer covers up to three classes.

From March 23, 2016, the official fee will be reduced to €850 for the first class, with the second and third classes costing €900 and €1050 respectively. Each additional class from the third class will cost an extra €150 per class. For example, the official fees for an application in five classes will cost €1350, €1500 for an application in six classes and €1650 for an application in seven classes. Therefore, whilst the official fees will be reduced if just filing in a single class, the costs of filing in three classes will now be increased (€1050 rather than €900 as was previously the case).

With this in mind, if you are considering filing new EU applications in three or more classes, you should file these before March 23, 2016 so as to take advantage of the lower fees.

### 2.2 Official Renewal Fees for EUTMs

<table>
<thead>
<tr>
<th>Class(es)</th>
<th>Current OHIM fee (EUR)</th>
<th>New EUIPO fee (EUR)</th>
</tr>
</thead>
<tbody>
<tr>
<td>One</td>
<td>1350</td>
<td>850</td>
</tr>
<tr>
<td>Two</td>
<td>1350</td>
<td>900</td>
</tr>
<tr>
<td>Three</td>
<td>1350</td>
<td>1050</td>
</tr>
<tr>
<td>Four</td>
<td>1750</td>
<td>1200</td>
</tr>
<tr>
<td>(4th and subsequent class)</td>
<td>400</td>
<td>150</td>
</tr>
</tbody>
</table>

By contrast, the fees for renewing registrations will be significantly reduced after March 23, 2016 and in cases where you have registrations due for renewal after this date and which are already in the renewal period, you should hold off on filing the renewal applications until after March 23, 2016.

### 3. The IP Translator case will be implemented in respect of registrations filed before June 22, 2012

#### 3.1 Background

Prior to June 22, 2012, CTMs covering class headings were deemed to cover all goods and services in the class. However, this was changed by the IP TRANSLATOR decision. In order to clarify the position on pre-2012 CTMs, the following process has been adopted.

#### 3.2 Proposed solution

Owners of CTMs predating June 22, 2012, which cover entire class headings, will be allowed a six month window from March 23, 2016 until September 23, 2016 to file Article 28(8) declarations amending the goods and services to include terms describing specific goods and services of interest, in addition to the class heading.

Once the six month window expires on September 23, 2016, all CTMs will be interpreted according to the literal meaning of the terms included.

#### 3.3 Which trade marks are affected and when can you file an Article 28(8) Declaration?

- CTM registrations filed before June 22, 2012 and that contain entire Nice Classification class headings are affected.
- CTM registrations including other goods in the class along with the class heading on the condition that the language used does not limit or disclaim the class heading.
3.4 Can registrations be amended to cover anything in that class?

- Yes, registrations can be amended to include any of the terms in the alphabetical list for that class in the relevant edition of the Nice Classification in force at the filing date and that are not already covered by the literal meaning of the class heading.
- Class heading terms can also be replaced with more specific terms included in their scope using the partial surrender procedure.
- Your Article 28(8) Declaration or the amended registration cannot be opposed by a third party. However, the Declaration will be examined by the EUIPO and the amended registration will be subject to proof of use requirements in the usual way.

3.5 What happens if you choose not to file an Article 28(8) Declaration amending CTMs filed before June 22, 2012?

- These CTM registrations will extend protection only to goods or services clearly covered by the literal meaning of class heading terms.

3.6 Which trade marks remain unaffected?

- International Registrations designating the CTM system with effect before June 22, 2012. National trade mark registrations.

3.7 When can't an Article 28(8) Declaration be filed?

- For CTM registrations filed on or after June 22, 2012. These CTMs will be interpreted according to the literal meaning of the indication or included class heading terms.
- For CTM applications filed on or before June 22, 2012 which have not yet been registered. However, it may be possible to amend the class heading terms in the application. For CTM registrations containing some, but not all of the terms from a class heading.

Matthias Berger, Fieldfisher, Hamburg, Germany (matthias.berger@fieldfisher.com)
The Australian *Intellectual Property Laws Amendment Act 2015*


The Act amends a suite of legislation, the *Patents Act 1990*, *Trade Marks Act 1995*, *Designs Act 2003*, and the *Plant Breeder’s Rights Act 1994*. The principle changes that are of interest here are changes to the *Patents Act 1990* relating to access to medicine, a Trans-Tasman patent attorney regime, and streamlined patent application and examination process for Australia and New Zealand. We will consider these changes from three perspectives, humanitarian, economic and patent practice.

It is an unfortunate reality that many least-developed and developing countries across the globe are experiencing public health challenges. Typically, such countries lack the ability to manufacture or access the required drugs to manage public health crises. Australia, on the other hand, has a well-developed drug manufacturing industry and can readily produce and export pharmaceuticals to such countries, thereby assisting these countries in their effort to overcome diseases such as HIV/AIDS, Ebola, Malaria, and the public health emergency related to the Zika virus.

From a humanitarian perspective, the Act facilitates the implementation of the Protocol amending the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Protocol) interim waiver. These changes came into effect on 25 August 2015 or will come into effect when the TRIPS Protocol *per se* comes into force for Australia. In light of these changes, Australian drug manufacturers can now apply to the Australian Federal Court for a compulsory license to manufacture patented drugs and export these drugs to countries in need in an effort to combat a prevailing public health crisis.

From an economics perspective, Australia and New Zealand have established a Single Economic Market agenda. Under this agenda, the Australian and New Zealand governments are attempting to establish a common Trans-Tasman business environment and to streamline many factors that affect, *inter alia*, intellectual property in the two countries. These changes have yet to come into effect, but pleasingly, with a deadline of 25 February 2017, these changes are practically on the horizon.

From patent practice perspective, once the proposed changes with respect to intellectual property come into effect, the Australian and Zealand patent attorney professions will become a single Trans-Tasman patent attorney regime. Furthermore, the changes will also facilitate a single patent application and examination process. While the patent application and examination process will be streamlined, the granted patents will be in respect of each country, i.e. there will not be a combined Australian and New Zealand patent.

Under the changes to the *Patents Act 1990*, Australian drug manufacturers can now join the international community in its humanitarian efforts to provide access to medicine. Furthermore, with the proposed streamlined approach to patent applications and examination, patent applicants can take advantage of a much more cost effective path to obtain patent protection in both Australia and New Zealand.

*Seán Klinkradt (Associate), Eager & Martin, Australia*

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1 Australia is a constitutional monarchy with Her Majesty Queen Elizabeth II as the Head of State. The Australian *Constitution Act 1900*, s58 provides that proposed laws passed by both Australian Houses of Parliament must be presented to the Governor-General for the Queen’s assent, hence Royal Assent.

2 The Tasman Sea is part of the South Pacific Ocean found between Australia and New Zealand. The term “Trans-Tasman” is a form of expression often used to describe collaboration between Australia and New Zealand.
One Step Closer To The Unitary Patent Court Agreement: Finland Joined The Club

The future introduction of the unitary patent (UP) and the Unified Patent Court (UPC) is a major novelty in the European patent landscape. Indeed, the way patents are granted and enforced in the European Union (EU), the largest trading bloc of the developed world, will fundamentally change. The UP will not only provide EU-wide uniform protection and having equal effect in all the participating member states, but it will offer a lower cost alternative to obtain rather than the basket of national patents in all designated states.

Under the current system, there is no such thing as a single Community patent; as opposed for instance to the European Community trademark system. Investors must maintain individual patents in each country of the European Patent Organization, at national level, in which they wish to do business (commonly referred as a ‘bundle’ of individual national patents). These patents must also be litigated and enforced in each jurisdiction separately, with the burden of compulsory translation of patents into national languages.

Fortunately, the European member states agreed on a “EU patent package”. It consists of three legislative acts: two Regulations and an international Agreement. On the one hand, a regulation on the unitary patent (UP) protection (Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection), and a Regulation on the language regime for the UP (Council Regulation (EU) No. 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements); and on the other hand, an Agreement (UPCA) setting up a new pan-European Court, the Unitary Patent Court (UPC), with divisions located all over Europe. The UPC will have exclusive competence in respect of European patents and European patents with unitary effect.

The two Regulations were accepted under the EU’s legislative procedure of "enhanced cooperation" i.e. a group of Member states can proceed without others when it is established that the objectives of the EU of such cooperation cannot be attained within a reasonable period by the EU as a whole. At the time of writing, 25 EU Member states signed the UPCA (except Spain, Poland, and Croatia). Although Albania, Iceland, Liechtenstein, Former Yugoslav Republic of Macedonia, Monaco, Norway, San Marino, Serbia, Switzerland, Turkey are members of the European Patent Convention (EPC), there are not member of the EU, so a UP will not be valid in these member states (they stay with the current system and the jurisdiction of national courts).

To enter into force, the UPCA still needs to be ratified by at least 13 states, including France, Germany, and the United Kingdom. So far, 9 countries have ratified the UPCA: Austria, Belgium, Denmark, France, Luxembourg, Malta, Portugal, Sweden, and Finland. The Finnish Patents Act was amended to achieve uniformity with the provisions of the UPC Agreement and ratified on January 8, 2016. Only 4 more needed to bring the Agreement into force, including Germany and the UK. The necessary preparations should be completed by Spring 2016 for the UK and September 2016 for Germany. Then, the UPC Agreement will come into force 3 months after the deposit of the relevant instruments of ratification.

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Brussels, Belgium
Standard Essential Patents

The standard-essential patents (SEP’s) are those that cover critical technologies for the operation of a particular technical standard. In the telecommunication industry, especially, technical standards are commonly adopted in order to ensure interoperability between devices, equipment and systems of different manufacturers and competitors. In other words, the technical composition is standardized, so as to enable, for example, a cellphone made by the brand “X” to receive calls from a mobile manufactured by the company “Y”.

This technical standard is made of several patents, the essentiality of which for the implementation of the standard is declared, unilaterally and voluntarily, by the patent holders seeking the benefits that this entails, being the biggest one the widespread and obligatory use of the technology by all companies connected to that standard.

On the other hand, however, the holder of the standard-essential patent is committed, before the standard international body, to automatically license the SEP in FRAND terms (i.e., “fair, reasonable and non-discriminatory” terms), to any interested party.

Therein lies the main difference between SEPs and “ordinary patents”, since the technology, once declared essential, is considered obligatory to a particular technical standard and deserves special treatment, due to the limitations on the enforcement of patent rights as a result of the FRAND system.

So, because of the commitments assumed before the International Institute responsible for the standardization system, the judicial remedies available for the holders of a SEP to protect their industrial property rights, without abusing of their dominant position, are limited.

In Brazil the two leading cases are taking completely opposite directions at the Court of Rio de Janeiro. In the first one, the Judge of the 2nd Business Court of Rio de Janeiro granted an injunction to prohibit a Chinese company from selling cellphones that supposedly used certain essential patents. In view of this, the Chinese company filed a motion requesting the suspension of the preliminary injunction, based on the payment, under protest and into a Court escrow account, of royalties.

The judge granted the request, considering that "[T]he Plaintiff himself affirms that his invention was incorporated to a technical standard, being of obligatory use by industry, in order to allow devices from different manufacturers to be compatible with each other and work properly in cellular networks," and concluded that "In the standardization negotiation, the business corporations that participate in the standardization process and offer their patents agree to license them on fair and reasonable terms. It is credible the allegation of the Defendant relative to the impossibility of refusing the licensing of the patent".

In the second leading case, filed against another Chinese company, whose discussion was exactly the same, the Defendant made an equivalent request, i.e., deposit of royalties to suspend the injunction that restricted the selling of several equipments, allegedly infringing an essential patent. When analyzing the offer, the Judge of the 5th Business Court of Rio de Janeiro understood that "it was not responsibility of the judge to impose the licensing value to the parties, but them to reach an agreement". Thus, considering that “the Plaintiff did not accept the offer”, the Judge rejected the request and upheld the PI, which remains effective until nowadays.
As seen, although addressing similar discussions, the two leading cases involving essential patents in Brazil were analyzed in a completely opposite way. While in the first case the understanding prevailed that the deposit of royalties is a reasonable way to balance the scales between the parties – not an injunction seeking to stop the sales of the Defendant –, in the second one the Court analyzed the lawsuit without complying with the particularities relative to SEPs.

This is because, in the first case, the Judge considered the fact that the protection of essential patents should be reduced before the FRAND commitment and also because of the burdens arising from the self-declaration of the technology essentiality. In the opposite way, the second case was treated as a classical infringement of an ordinary patent.

Therefore, we conclude that the parties involved on a SEP litigation in Brazil – where the discussion of SEP matter are brand-new – must demonstrate the sophistication involving these technologies, so that the Judge take into account the singularities of this discussion and do not treat it as an act of mere ordinary patent infringement.

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ABA-IPL Section Participates in Public Service Project at the San Diego Food Bank

Members of the section participated in a public service project during the recent ABA Midyear Meeting in San Diego. About 35 section members traveled to the Jacob & Cushman San Diego Food Bank to help pack boxes of food items for senior citizens in need. Organizing into work groups to build boxes, unpack food crates, pack the boxes, seal the boxes and stack the boxes, the participants worked at a frenzied pace for a two-hour shift. In the end the group had packed 480 boxes, which they were informed, was just shy of the record of 900 completed boxes by members of the U.S. Marine Corps.
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Download a digital version of International IP Legal Updates at http://ambar.org/IPLawIAG

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ABA-IPL offers exceptional value to international intellectual property law professionals interested in affiliating with the Section; in particular there are many opportunities for international affiliates with an interest in US and comparative IP law, such as:

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• Maintain your connection to U.S. and global trends in IP law with the Section’s bi-monthly Landslide® magazine;

• Network and participate in Section international programming and events with member colleagues: leaders, global law firms, and multi-national corporate counsel from over 75 countries; and

• Present proposals to speak, moderate, or organize a program at an ABA-IPL conference, teleconference or webinar in the United States.