European Commission

Intellectual Property for the Green Tech and Digital Economy Sectors

Why is IP relevant in the internationalisation process?

EU INDUSTRY WEEKS

IP HELPDESK

European Commission

1.

CONSEQUENCES OF NOT PROTECTING YOUR ASSETS

Opportunities

- *Exclusive rights → exclude third parties*
- *Recoup the costs incurred to create the intangibles*
- *Attracting investors and talent*
- *Partnerships and R&D collaborations*
- *Licensing, franchising or cross-licensing*
- *Gateway to new markets*

Risks

- *No access to local market*
- *Extra costs*
- *Loss of exclusivity / competitive advantage*
- *Loss of prestige / reputation*

2.

CONSEQUENCES OF IGNORING LOCAL PARTICULARITIES

Latin America

LOCAL PARTICULARITY	CONSEQUENCE
IPR Databases not exhaustive, freely accessible	Deficient prior searches/rely on external experts
Registration takes much longer	Signing local partnering agreements will be delayed
Foreigners cannot register themselves	Rely on external experts
Coexistence agreements are subject to NIPO's approval	Rebranding/no exclusivity/ face legal actions for infringement
Including © or ® symbols where relevant	Be not able to enforce legal actions
Non traditional trade marks are not accepted	Change the branding strategy
Non-registered design not available	No exclusivity

India

LOCAL PARTICULARITY	CONSEQUENCE
Patents - Statement of Working	Result in Patent Revocation and Opposition Proceedings
Copyright - Registration not mandated but is advisable	Aides during enforcement proceedings and online takedown notices
Design- Registration only through National Patent Office	Mandatory Design registrations for enforcement proceedings and custom seizures
Patent Applicants should inform the controller detail particulars of the patent filed in other countries and update any changes in the application.	Non- compliance is ground of revocation
Non traditional trade marks are not accepted	Change the branding strategy
Non–agricultural EU Geographical Indications are accepted but underused	Loosing business oportunities based on the added value protected Gis provide

China

LOCAL PARTICULARITY	CONSEQUENCE
4 IP jurisdictions: Mainland Chin, Hong Kong, Macao and Taiwan	Each has their own IP system and registration methods, should be considered by companies active in Greater China.
Using Chinese characters for your brand and or product registrations	Names will resonate better with a Chinese audience
Parallel registration of invention patents and utility models	With this strategy, companies compensate the lack of protection while the invention patent is still pending
Classes (Nice agreement) vs. Sub-classes	This can be problematic when applying through the international system – as subclasses will be determined by examiners at CNIPA. It is therefore recommended to register domestically.
Life extension of invention patents	2 scenarios for IP owners

South-East Asia

LOCAL PARTICULARITY	CONSEQUENCE
10 countries in SEA but not regional registration systems (like EU, Africa)	Each country has its own IP system / IP law and registration methods
IPR databases not exhaustive / updated	Inexact prior searches & more risks
Local requirements for protecting your IPRs	Need for local address or local representative
Existence of local languages in SEA	Translation of documents Local translation / version of trademark
Registration may take longer than expected	Plan & register ahead your IPRs
Many counterfeiting issues (onsite / online)	Be prepared & organized (awareness of enforcement avenues, local IP expert, evidence collection)
Non-registered design do not exist	Register your designs ASAP

Africa

LOCAL PARTICULARITY	CONSEQUENCE
55 states in total and 38 of which belong to 2 regional registration systems (OAPI / ARIPO)	Plan ahead which are the countries of interest.
ARIPO (21 member states) is a designation system. → Caters mainly to English-speaking countries.	For **ARIPO** = decide in advance which states to select.
OAPI (17 states) is a unitary system. → Caters mainly to French-speaking countries.	Local representative may be mandatory
National IP systems are used in the rest of Africa	Need to know national IP laws of these countries & contact local IP expert.
Need for local representative	For **ARIPO** = need local representative based in ARIPO. For **OAPI** / other countries → check national requirements

3.

HOW TO CORRECTLY PROTECT YOUR IP

A. Protection strategy

COPYRIGHT

- *Berne Convention → proof of authorship*
- *Technological Protection Measures*
- *Digital Rights Management*

TRADE MARKS

- *Prior use → registration, opposition*
- *Domain Names*

PATENTS

- *Trade Secrets → TPMs, DRM, NDAs*
- *Grace Period*

DESIGNS

- *Non-registered designs*
- *Grace Period*

B. Registration strategy : local

COSTS

- *Official fees*
- *IP lawyer fees*
- *Prior searches costs*
- *Document translation*

ONLINE/PHYSICALLY

REGISTRATION PROCEEDINGS

PROTECTION DURATION

- *Total duration*
- *Renewable*
- *Counted from application/granting date*

REGISTRABLE

- *Subject matter*
- *Type of sign*

CUSTOM REGISTRY AVAILABLE

1) Local registration: national fees

COUNTRY	PATENTS	TRADE MARKS	DESIGNS	COPYRIGHT
Mexico	360€	126€	360€	12€
Brazil	170€	270€	160€	135-185€
Colombia	370€	246€	186€	Free of charge
China	500€	40€	70€	40€ - 280€
India	250-300€	300€	200€	200€
Singapore	1.150€ - 2.300€	230€	170€	No registration
Indonesia	200€	120€	50€ - 80€	30€ - 40€
Vietnam	180€	60€	90€	10€ - 30€
ARIPO*	USD $312	$USD 130	$USD 50	No registration

2) Local registration: length of registration proceeding

COUNTRY	PATENTS	TRADE MARKS	DESIGNS	COPYRIGHT
Mexico	3-5 years	2-6 months	8-10 months	14 days
Brazil	10 years	8-10 monrha	8-12 months	Up to 180 days
Colombia	2-4 years	6 months	15-20 months	10 days
China	3-5 years	9 months	1 year	1-30 days
India	2-3 years	6-8 months	6-8 months	N/A
Singapore	2-4 years *	6-9 months	4 months	No registration
Indonesia	3-4 years	2-3 years	2-3 years	14 days
Vietnam	4-5 years	18-24 months	12-18 months	15 days
ARIPO	3-4 years	14-16 months	9-12 months	No registration

C. Registration strategy : international systems

The PCT

- *Inventions*

The MADRID SYSTEM

- *Logos, slogans, company name*
- *Smell*

The HAGUE AGREEMENT

- *Shapes, forms, textures*

GOOD FOR

- *Operate in multiple countries in s/m term*
- *Medium-High budget level*
- *Start negotiation with several local potential partners*
- *Franchising, licensing-based business models*
- *Participation in Trade Fairs*
- *Marketing type portfolio*

1) The PATENT COOPERATION TREATY (the PCT)

ADVANTAGES

- *Multiplying effects*
- *Upfront information*
- *Amendment mechanisms*
- *Additional searches*
- *Additional time*
- *Fast-track procedures*
- *Flexible procedure*
- *Overall cost-effectiveness Document translation*

DISADVANTAGES

- *Only applicable to the registration procedure*
- *Potentially higher final costs filing and search fees + national phases fees*
- *Some countries/territories are not yet covered by the PCT*
- *Longer time to obtain a patent*
- *Effectiveness of the PCT procedure depends on the size of a company and on the number of countries / jurisdictions of interest*

1) The PCT

MEMBERS (155 Contracting States)

1) The PCT

COSTS

- *International filing: 1330 CHF*
- *Search: 150-2000 CHF*
- *Transmittal: c.a. 100€*
- *National entry fee: e.g. 160€ (MX)*
- *+ translations, etc.*

PROCEEDINGS DURATION

- *China: 32*
- *Colombia, India, Morocco Zimbabwe, ARIPO: 31*
- *Brunei Darussalam, Nigeria, Mexico: 30*
- *+ local granting time*

2) The MADRID SYSTEM

ADVANTAGES

- ☑ *Centralised filing*
- ☑ *Cost effective*
- ☑ *User friendly*
- ☑ *Centralised management (e.g. Data modification)*
- ☑ *Speed of examination*
- ☑ *Single renewal date*
- ☑ *Subsequent designations*

DISADVANTAGES

- ✕ *Need a basis TM (application or registration)*
- ✕ *Dependence on the basic TM*
- ✕ *Some countries/territories are not yet covered*
- ✕ *Registration process can still be long in some countries/territories*
- ✕ *Some foreign characters are not covered*

2) The MADRID SYSTEM

MEMBERS (126 countries)

2) The MADRID SYSTEM

COSTS

- *A **basic fee** (653 CHF / 903 CHF for color*) plus*
- ***Additional costs** depending on where you want to protect your mark and how many classes of goods / services will be covered by your international registration.*
- *Transmission fee from Office of origin, translations, etc.*

Note: After obtaining an international trademark registration, additional fees apply to expand the geographical scope of coverage, modify or renew your trademark portfolio.

PROCEEDINGS DURATION

- *China = approx. 9 months*
- *Singapore, HK, Macao = 6 /9 months*
- *Bolivia, Colombia, Mexico = 8/10 months*
- *Thailand, Uruguay = 12/24 months*
- *Brazil, Zimbabwe = approx. 18 months*
- *Indonesia = 24/36 months*
- *+ local granting time*

3) The HAGUE AGREEMENT / SYSTEM

ADVANTAGES

- ☑ *Centralised filing*
- ☑ *Up to 100 designs per application*
  (if same group of Locarno classification)
- ☑ *One set of fees (CHF)*
- ☑ *No pre-requirement to file a national or regional design application*
- ☑ *3 official languages (ENG, FR, SP)*
- ☑ *Centralised management (e.g. Data modification)*
- ☑ *Single renewal date*

DISADVANTAGES

- ✗ *No uniform drawing standards between member countries*
- ✗ *No limit for the number of reproductions (but fees apply per reproduction)*
- ✗ *Some countries/territories are not yet covered*

3) The HAGUE AGREEMENT / SYSTEM

MEMBERS (94 countries)

3) The HAGUE AGREEMENT / SYSTEM

COSTS

- *a **basic fee** (397 CHF for one design; 19 CHF for each additional design included in the same application),*
- *a **publication fee** (17 CHF for each reproduction; 150 CHF for each page on which one or more reproductions are shown) and*
- *a **standard designation fee** or **an individual designation fee** for each Contracting Party where protection is sought.*

Note: For standard designation fees, a three-level structure applies, reflecting the level of examination carried out by the contracting party.

PROCEEDINGS DURATION

- *China: approx. 4 months*
- *Indonesia = approx. 1.5 year*
- *Thailand = 2/3 years*
- *Vietnam = 2/3 years*
- *India = approx. 6 months*
- *OAPI = approx. 12 months*
- *Mexico = 8-10 months*

3.

CASE STUDY: PROTECTING YOUR TRADE MARK ABROAD

Protecting your trade mark abroad

BACKGROUND

- *Spanish IT SME that creates NFC devices and want to expand to Latin America ensuring their IP and in particular, their company name*
- *Very limited internal resources*
- *Business actions waiting for IP strategy*

ACTIONS TAKEN

- *Contacted IP SME Helpdesk for free of charge, confidential support*
- *IP diagnosis (IPR involved, priorities, timing, resources)*
- *Explanation of local particularities (longer proceedings, first to file system, CAN opposition, priority right)*
- *Identical trade mark availability preliminary search*

Protecting your trade mark abroad

RESULT

- *Registered trade mark in Colombia*
- *Started negotiating with local potential partners*
- *Included trade mark use clauses*

EU INDUSTRY WEEKS

European Commission

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