

## **Topic 5: Legal Status**

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# Objectives

- Understand the importance of legal status information for patents and trademarks
- Understand the current issues and constraints
- Propose further work

# Example Case (patents)

*I am a generic pharmaceutical manufacturer. The US patent on a major drug will expire soon. I want to know if I can manufacture a generic in Malaysia and market it in ASEAN. I need to know if there are equivalent patents in force in each country, who owns them, and when they will expire.*

# Example Case (trademarks)

*I want to start a chain of coffee shops in all major ASEAN cities - « Jolt Coffee »*  
*If I use the same brand in all countries, I can save costs on marketing, merchandising, etc.*  
*I need to know if there are conflicting marks in all countries, if they are valid, and who owns them.*

# The approach (patents)

- Search international databases (Espacenet, Patentscope) for patent family members in ASEAN.
- Search ASEAN online databases (if available) for patent family members and parallel applications
- Search 10 Gazettes and Registers (some are online, some are not)
- Write to the 10 offices to request current status information
- Hope I haven't missed something

***=> only the patent owner actually knows the legal status***

# The approach (trademarks)

- Search 10 ASEAN databases (if available) for conflicting marks
- Search 10 Gazettes and Registers (some are online, some are not)
- Request status information (and pay)
- File or request a pre-filing search in 10 offices, wait for results
- Hope I haven't missed something

**⇒ *There is a risk of opposition or invalidation***

# Availability of Legal Status in ASEAN

|    | Journal/Gazette Online | Searchable Database | Online File Content Access |
|----|------------------------|---------------------|----------------------------|
| BD | Y                      | Y                   | Search at Office           |
| ID | Y                      | Y                   | Search at Office           |
| KH | N                      | N                   | Search at Office           |
| LA | N                      | N                   | Search at Office           |
| MM |                        |                     |                            |
| MY | Y                      | Y                   | Y                          |
| PH | Y                      | Y                   | Search at Office           |
| SG | Y                      | Y                   | Y                          |
| TH | Y                      | Y                   | ?                          |
| VN | Y                      | Y                   | Search at Office           |

# Availability of Legal Status in ASEAN

## General Observations :

- Trademark registers are online
- Trademark legal status is not always available
  
- Patents are very difficult to search
- Patent legal status is almost always not available



# Definitions

Basic legal status :

- Is an IP right valid or not ?
- In which jurisdictions ?
- Who owns it ?

Extended legal status information :

- Filing history
- Examination history
- Office actions
- Oppositions
- Etc

=> access to dossier content

# Basic legal status

## Trademarks :

- Application
- Registration
- Invalidation
- Renewal
- Assignment

## Patents :

Application/Publication  
Withdrawal  
Grant/refusal  
Renewal  
Invalidation  
Assignment

# Issues

- Policy issues (e.g. Govt. information policy, fees)
- Reliability
- Availability
- Comparability
- Accessibility

See WIPO study on legal status :

CDIP/4/3 REV./STUDY/INF/3

[www.wipo.int/patentscope/en/programs/legal\\_status/](http://www.wipo.int/patentscope/en/programs/legal_status/)

# Issues - Reliability

IP Administration system may not be integrated with other systems.

Not all legal status events are captured

Coding may be non-standard

# Issues - Availability

Information is not available online

Users need to come to IP office and pay a fee

# Issues - Comparability

WIPO standard ST.17 is too broad

Several thousand codes from only 50 jurisdictions

Definitions depend on the legal framework of each country.

# Issues - Comparability

e.g PCT national phase entry

- A form may be required
- A translation may be required
- A fee may be required

PCT national phase entry is considered to occur when all the requirements have been met.

When does a non-entry occur ?

- When the translation has not been filed ?
- When a fee has not been paid ?

# Issues - Accessibility

Gazettes are impossible to search

Registers are available for Trademarks, but not for Patents

Search systems are not connected to registers

e.g. USPTO

- PatFT
- AppFT
- PAIR
- Patent Maintenance Fees System
- Patent Official Gazette
- Patent Assignment Database



# Recommendations

- Record status events in IP Admin System
- Standardise status event codes (st.17?)
- Create online registries for all IP rights
- Public access
- Integrate search systems and online registries
- Exchange data internationally
- Regional Portal...

Thank you very much.