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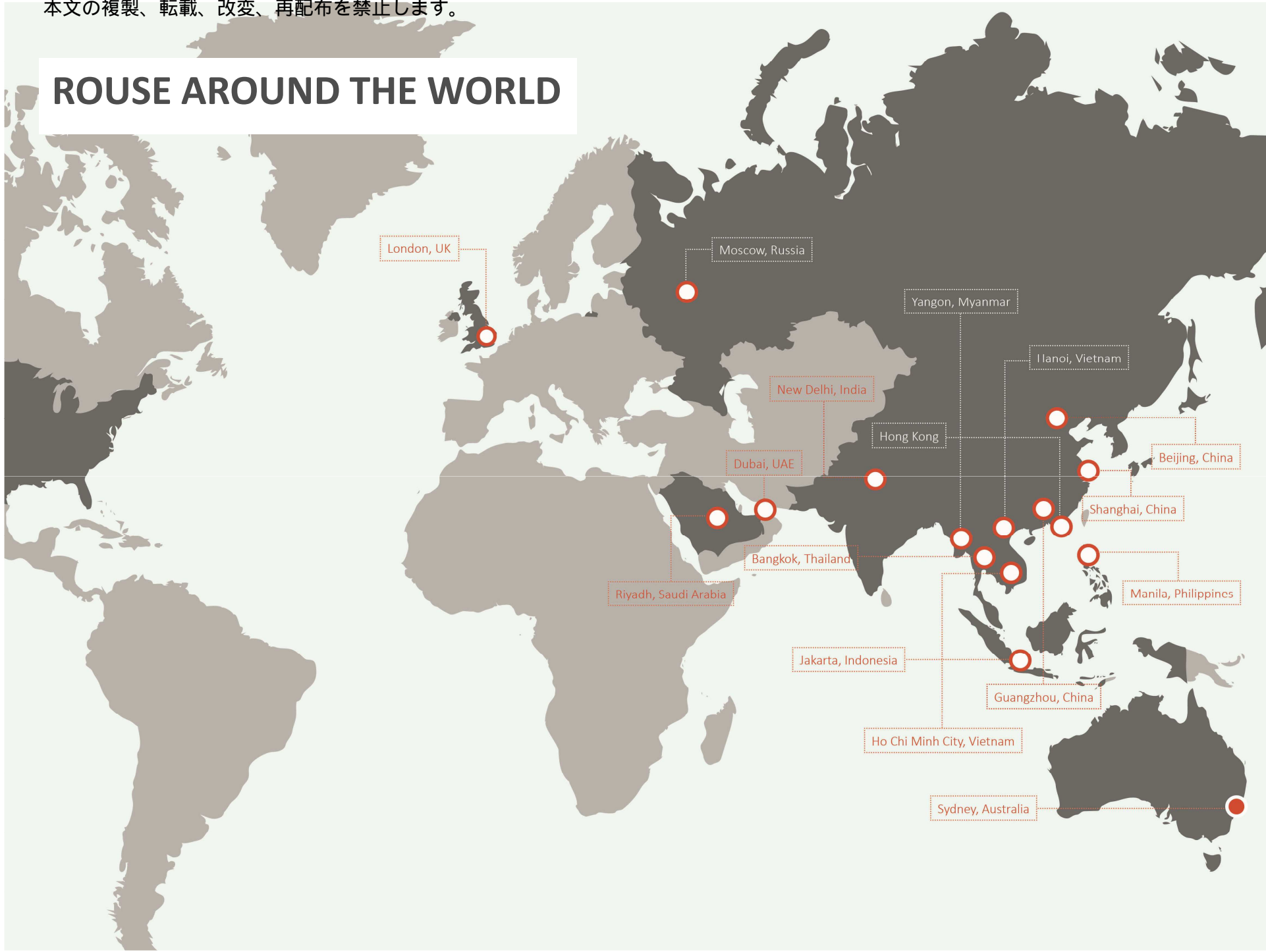
Patent Overview

Presentation to Japan Intellectual Property Association – Asia Committee

19 October 2015

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ROUSE AROUND THE WORLD



London, UK

Moscow, Russia

Yangon, Myanmar

Hanoi, Vietnam

Beijing, China

Shanghai, China

Manila, Philippines

Sydney, Australia

Ho Chi Minh City, Vietnam

Guangzhou, China

Jakarta, Indonesia

Bangkok, Thailand

Dubai, UAE

Hong Kong

New Delhi, India

Riyadh, Saudi Arabia



Gunawan Suryomurcito **Partner**

Professional Experience

Gunawan is the founding partner of Suryomurcito & Co and joined Rouse in 1997. Gunawan has more than 30 years of practical experience in IP protection and enforcement in Indonesia.

Gunawan is highly respected in the industry for his knowledge and has extensive practical experience . He is regularly invited as a guest speaker at local Government seminars and universities.



Kin Wah Chow **Partner**

Professional Experience

Kin-Wah Chow is a Registered Foreign Lawyer at Suryomurcito & Co, qualified in Singapore, England/Wales and New York (USA). He previously worked in Singapore, China and Hong Kong with established IP law firms in these jurisdictions.



Lisa Yong

Partner - Country Manager of Indonesia and Philippines

Professional Experience

Lisa Yong is a Singapore qualified lawyer with extensive Intellectual Property (IP) experience in South East Asia. Lisa has close to 20 years of experience, which has led her to handle a wide range of contentious and non-contentious IP matters. She manages Rouse's Indonesia and Philippines offices and is currently based in Tokyo.



Arifia Fajra

Senior Associate

Professional Experience

With a degree in chemical engineering, Arifia is a Registered IP Attorney and Patent specialist. She has more than 12 years of experience in patent prosecution.

Arifia manages our patent and design filing practice group that encompasses the areas of pharmaceutical, chemical engineering, biotechnology, and other technologies.

ROUSE



Dyah Paramita **IP Consultant**

Professional Experience

Dyah has more than 15 years of experience in patent and design prosecution. She has a degree in Metallurgical engineering.

Dyah specialize in prosecuting the examination of patents in the areas of chemical engineering and metallurgy.



Indah Handayani **IP Consultant**

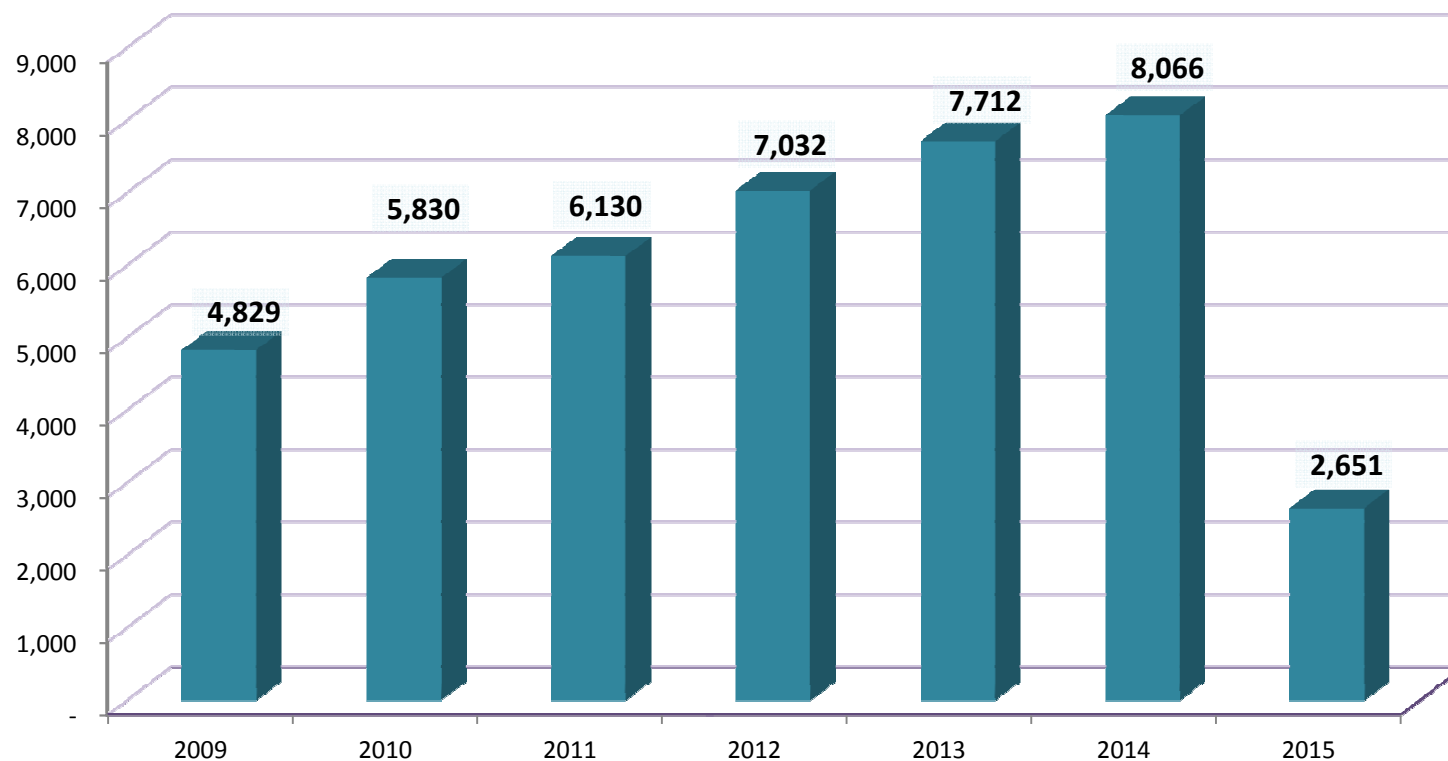
Professional Experience

Indah is a Registered IP Attorney and has a degree in pharmacy.

Indah specializes in reviewing pharma related patent translations, providing patent search, infringement advice and technical support in patent litigation matters. She is also familiar with the local Food & FDA Regulations (BPOM))

STATISTICS IN INDONESIA

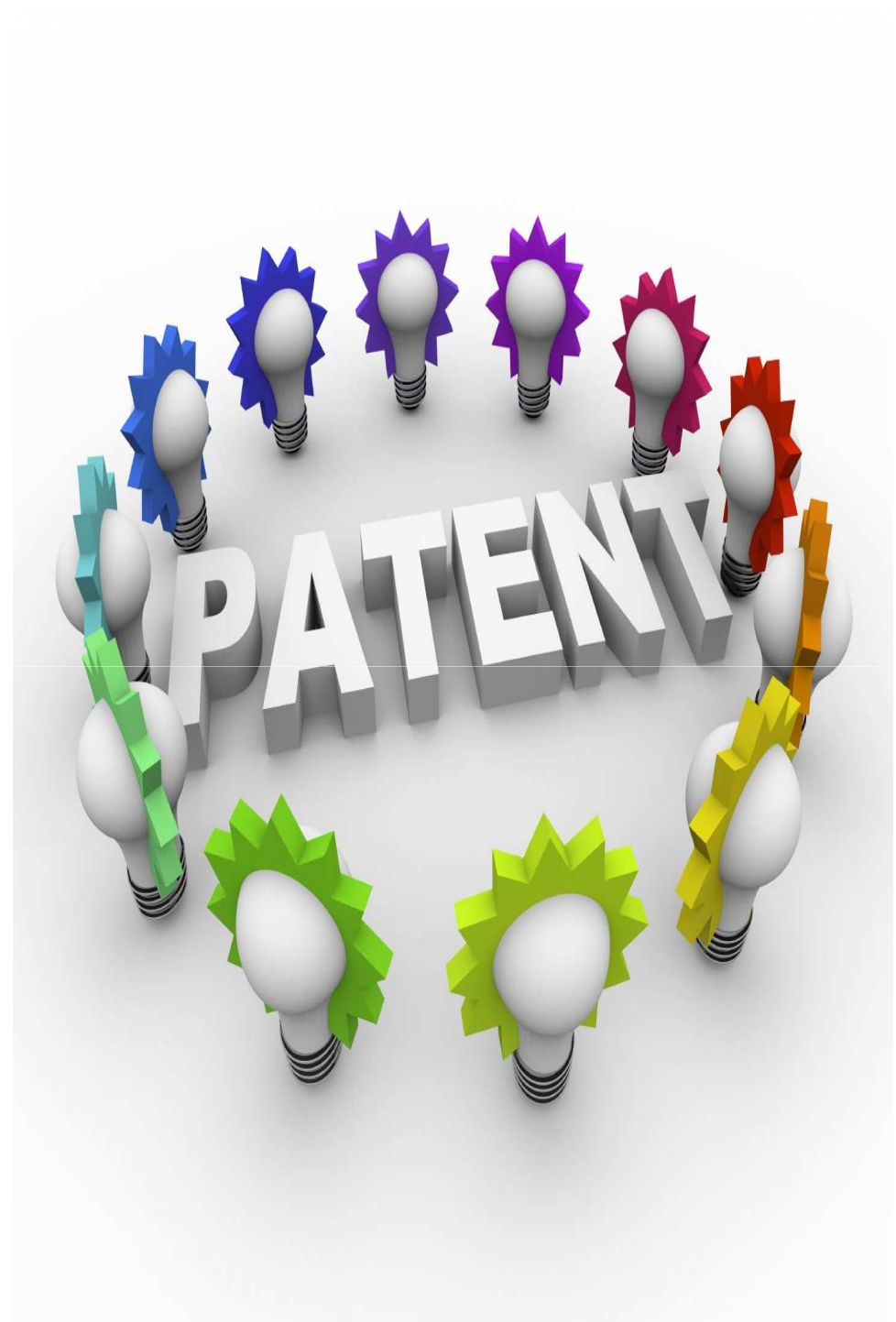
Patent Applications filed 2009-2015



* Data for 2015 only up to April 2015

SEARCH

- Online system: <http://e-statuski.dgip.go.id/>
- Some limitations – not always online, or up to date, keyword search only against title and abstract
- Indonesian key words –
 - 2 to 4 equivalent Indonesian terms
 - Broad choice of key words needed
- Ask for corresponding search to verify the result against patent documents carrying same key word



PROSECUTION – FILING

- Translation filed within 30 days of filing
- Inventors - assignments signed by inventors/notarized copies of the employment contract with inventors (grace period up to 3 three months)
- Notarization or legalization is not required for the original Power of Attorney or Deed of Assignment
- Copy of Deed of Assignment – need to be notarizedGeneral Power of Attorney – not allowed
- The priority document's front page needs to be translated into English
- In the case of PCT, in practice, no need to provide the translation
- Two times extension of time is acceptable for formality document submission
- Incomplete document means application shall be deemed withdrawn

EMPLOYEE INVENTION AND BENEFITS

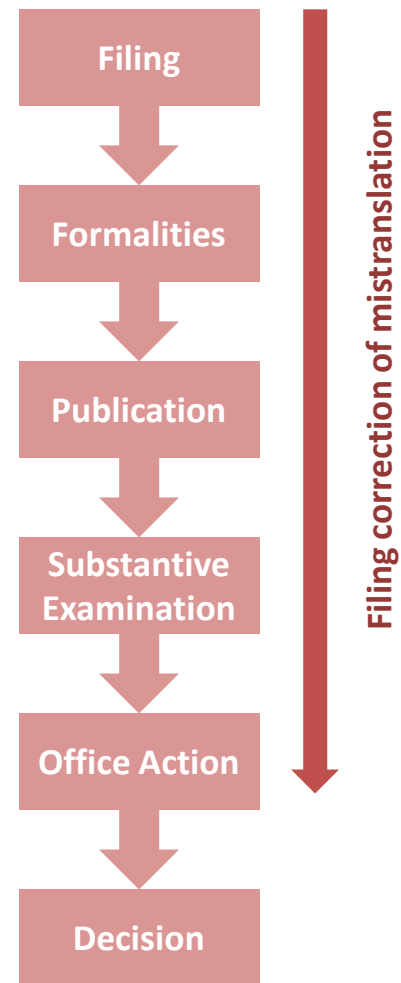
- **Employer owns the invention if**
 - the invention is made in an employment relationship or
 - the employee has used data and or facilities available at his work even though the employee is not required to exercise any inventive activity
- **Employee entitled to reward considering economic benefits from invention**
 - Paid in lump sum, percentage, a combination of both, gift or bonus, other any other forms agreed between the parties
- **Strategy**
 - inventor employee to acknowledge that the improvement is not the sole reason for the success of the product
 - there are also factors – such as marketing and other product features
 - it becomes very difficult to be quantified by the court if there is dispute

ASSIGNMENT DOCUMENT

- Common practice – assignment from inventor to employee
- If not, provide employment agreement (original or notarized copy) – rare
- If inventor missing and without employment agreement , patent office can accept:
 - Declaration from the applicant company
 - Declaration from remaining inventors
- If inventor is deceased, patent office can accept:
 - Declaration confirming the death of the missing inventor.
 - A notarized copy of the death certificate.
 - Declarations from the surviving inventors
 - Declaration from the *applicant company*

MISTRANSLATION OF SPECIFICATIONS

- Voluntary correction for mistranslation of specification can be submitted at anytime before the grant of a patent
- Advisably before the issue of the first office action
- Basis for correction: English specification submitted to the DGIPR
- If the English text is also mistranslated, the correction can be based upon Japanese specification as long as a corrected English specification is also provided to the DGIPR
- Requirement: **MUST NOT** expand the scope of invention as originally filed



SUBSTANTIVE EXAMINATION

- Substantive examination mainly relates to conformance with international application
- Rarely, where the application is filed as a national application only, the examiner has to perform independent prior art search
- Not possible to file a divisional application after the Notice of Allowance has been issued
- Request of substantive examination should be filed at the same time of filing the divisional application
- Substantive examination will be started within 36 months, after the six month publication period has expired

SUBSTANTIVE EXAMINATION – PATENTABILITY - NOVELTY

- Invention considered **novel** if it is different from "the technology already used before"
- "Technology" " includes a number of Patent literatures" (Elucidation to Article 3(1))
- Article 3(3) also make clears that "technology" includes unpublished patent application –

“Technology revealed before as described in paragraph (1) shall include the Application documents submitted in Indonesia announced on or after the Filing Date which is still undergoing a substantive inspection, but the said Filing Date was earlier than the Filing Date or the Application priority date.”

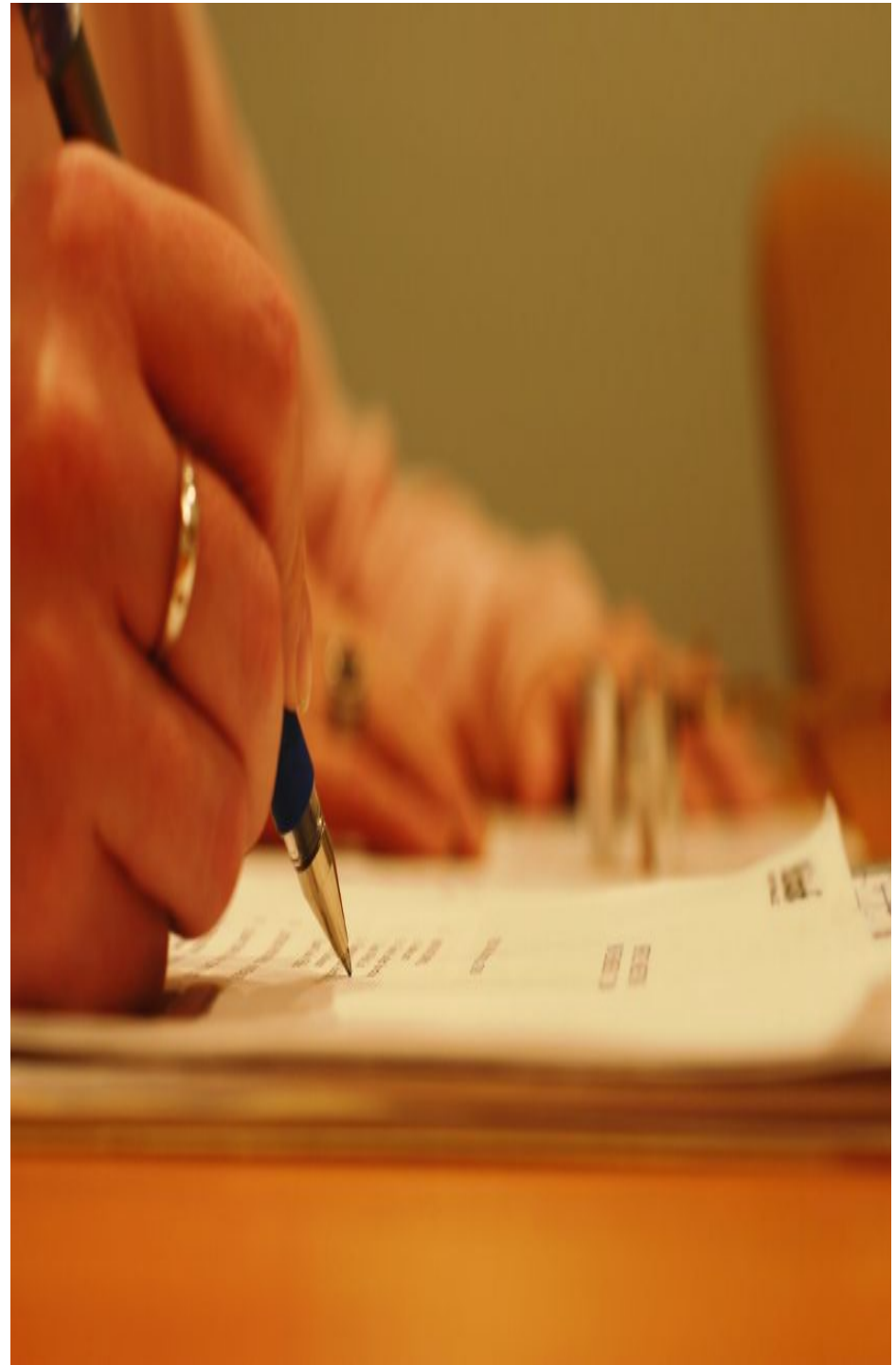
DOUBLE PATENTING

SUBSTANTIVE EXAMINATION – PATENTABILITY – INVENTIVE STEP

- *Patent Law provisions*
 - **Article 2(2)** *An invention contains inventive step if that invention to a person with specific expertise in the technical field is something that cannot be expected previously*
 - **Article 2(3)** *The evaluation that an invention is something that cannot be expected previously must be conducted by taking into account the expertise that existed at the time of filing the application or at the time of filing the first application in the event that the application was filed with priority right*
- Different terminology is used for inventive step - "expertise" instead of "technology"
- Reasonable to conclude that patent literature is not part of "expertise" on the question of inventive step. Even more so for unpublished patent

SUBSTANTIVE EXAMINATION

- The term “Best Mode” is not recognized in Indonesia
- Government Regulation no 34/91, Art 25, refers to one part and two part claim format – both acceptable.
- The two part claim is similar to the Jepson-type claims
- In practice, normally multiple dependencies are acceptable in DGIPR
- Simple patent shall only be granted for one invention. It may comprise a number of claims



PPH AND ASPEC

Patent Prosecution Highway (PPH)

- The practical differences with respect to speed of examination:

Type of Application	Speed with PPH*	Speed without PPH*
Paris Convention	Around 2 years	Around 3-5 years
PCT application	Around 2 years	Around 3-5 years

**from lodging date*

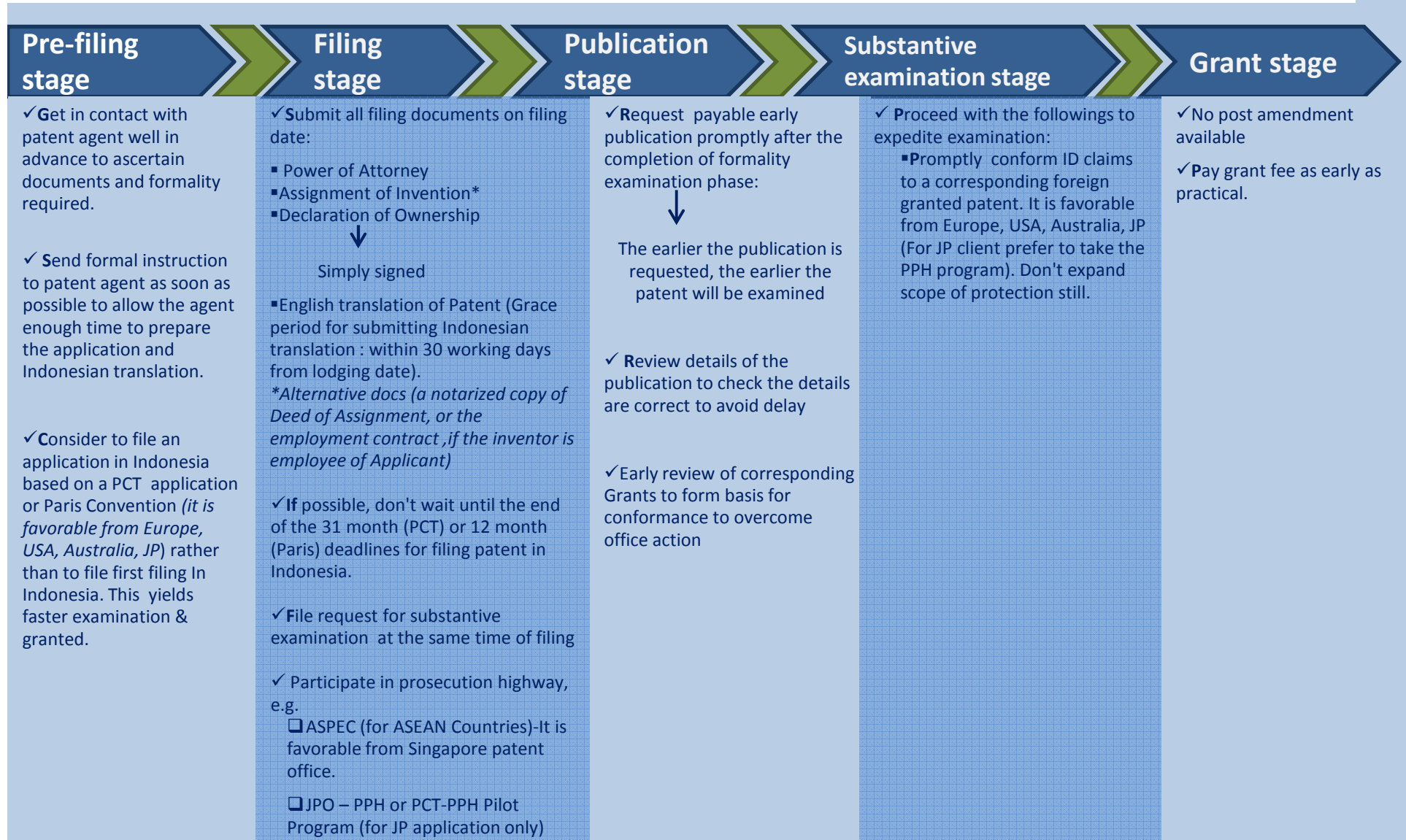
- From 360 PPH request, 9 cases are granted as of August 2015

ASEAN patent examination cooperation (ASPEC)

- From the 10 ASPEC request as of June 2015, all applications are still pending, and no final decision has been issued

Helpful tips for time saving patent examination and grant in Indonesia

A good head start is a key to get your patent application granted more quickly. Follow the tips below for a time saving patent filing and prosecution.



ANNUITIES

- Annuities payable 1 year from grant, counted from application date
- If within 3 consecutive years from the grant date, the patent holder fails to pay the annuities, the patent shall be deemed void on the last date of the third year
- Elucidation: The period of three (3) years is meant to give the Patent Holder enough time to develop the sustainability of his or her Patent. A cancellation of a Patent due to failure to pay the annual fee shall be informed in writing by the Directorate General to the Patent Holder. The notice will indicate the date the Patent expires as provided by this Law. The annual fee to be paid in the *three(3)-year period shall remain payable by the Particular Patent Holder*
- Over 12,000 letters of demand sent by Patent office
- 7000 cases transferred to KPNL (State Assets and Auction Services Office)
- 400 letters of summon sent by KPNL to local agents

ANNUITIES

- Advice to pay , as it is a legal obligation
- Check for correct amount of payment as there may be discrepancies
- For patents which you have not received a demand letter but no longer wish to maintain, we recommend filing a request to cancel the patent
- Possibility of impact on pending applications
- Targeted companies are those companies which have significant assets in Indonesia and have local branches
- Assets may be seized by KPKNL



PATENT -ANNUITIES (PROPOSED NEW DRAFT)

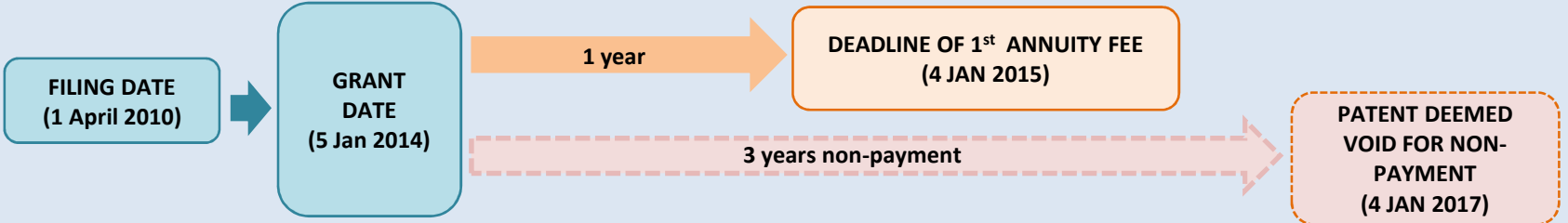
- **First annuity-** is payable 4 months from grant date, counted from application date plus annual fee of the next one year
- Failing to pay annuity within 4 months from grant date – patent deemed cancelled
- Grace period of six month – submit request during last week before expiry. Penalty 100%

Post grant annuity

- Must be paid one month before beginning of the next anniversary. Failing which patent will be considered cancelled
- Grace Period- same as above

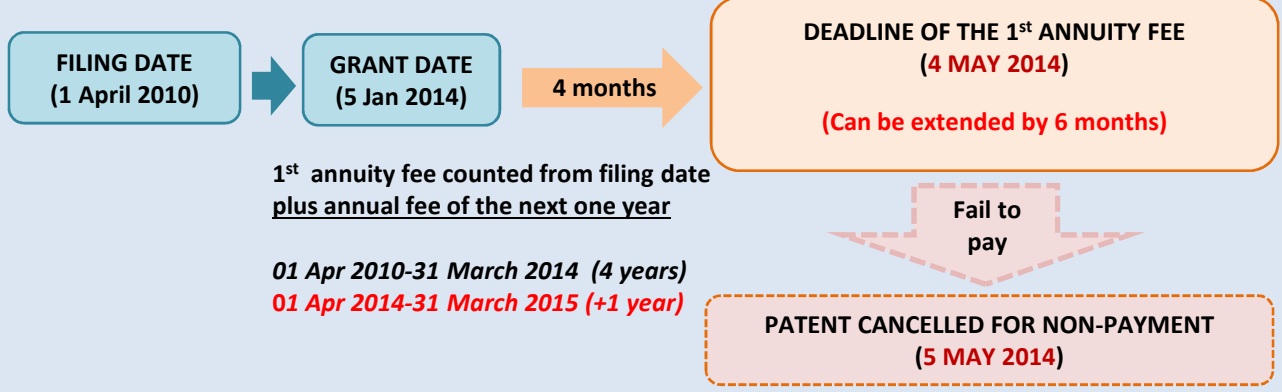
PATENT – ANNUITIES COMPARISON

Current Law



1st annuity fee, counted from filing date
01 Apr 2010-31 March 2014 (4 years)

New Draft



1st annuity fee counted from filing date plus annual fee of the next one year
01 Apr 2010-31 March 2014 (4 years)
01 Apr 2014-31 March 2015 (+1 year)

DRAFT NEW PATENT LAW - 2016

- **Disclosure**- 6 month grace period for announcement by the Inventor in the scientific session or in scientific forums in the context of the discussion of the results of research in universities or research institutes
- **Substantive Examination** - further extension period of 6 months due to "emergency" - example "force majeure" - war, strike etc
- **Post Grant amendment** - possible within 3 months from notice of grant for limited situations - translation of the specification; to clarify ambiguity; to narrow the scope of claims; and to reduce the number of claims
- **Compulsory license** - additional ground for State to grant compulsory license to *export* the patented product to developing countries that suffer from epidemic

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DATABASE

- Online patent database (<http://e-statuski.dgip.go.id/>) – excludes full specification
- Limited information
- Examiner use internal database i.e. IPAS
- File wrapper of a patent application is not available for search by 3rd party

DJKI
DIREKTORAT JENDERAL KEKAYAAN INTELEKTUAL
KEMENTERIAN HUKUM DAN HAK ASASI MANUSIA RI

TENTANG KAMI | PATEN | MEREK | DESAIN INDUSTRI | HAK CIPTA | INDIKASI GEOGRAFIS | TEKNOLOGI INFORMASI | KERJA SAMA & PROMOSI | PENYIDIKAN

Direktorat Jenderal KI memperkenalkan satu inovasi baru dengan mengintegrasikan sistem penelusuran Paten, penelusuran Merek dan penelusuran Desain Industri ke dalam satu sistem yang disebut Sistem Layanan Data dan Informasi Kekayaan Intelektual (LADI KI).

Sebagai wujud dari keseriusan kami untuk memberikan informasi terbaru dan terbaik kepada publik, LADI KI mempermudah sistem penelusuran data KI melalui model penelusuran yang lebih mudah (simple search dan structure search) juga menampilkan status data permohonan KI terkini yang bisa diakses secara elektronik (e-status).

Dengan menggunakan aplikasi browser Mozilla Firefox dan Chrome, Klik e-statuski.dgip.go.id
Akhirnya kami mengucapkan selamat menggunakan LADI KI.

DIREKTUR JENDERAL
KEKAYAAN INTELEKTUAL
BLOG

E-TUTORIAL DJKI
BELAJAR SENDIRI SECARA ONLINE

E-HAKCIPTA

**LAYANAN DATA DAN INFORMASI
HAK KEKAYAAN INTELEKTUAL (LADI HKI)**

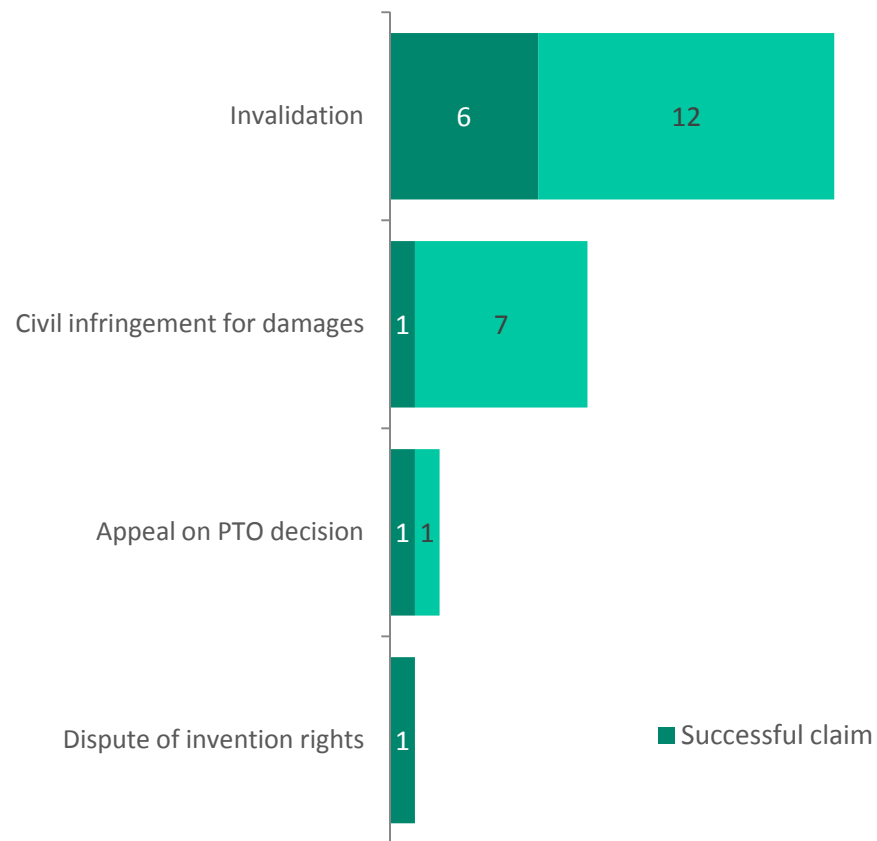
Patent ▼ Keyword Pencarian ...

ROUSE

LITIGATION

- Infringement actions rare
- Most litigation are revocations
- Successful damages claim even rarer
- Reason for low civil infringement actions:
 - Interlocutory injunction framework unworkable
 - Damages award uncertain
- Most revocations claims are in reaction to criminal enforcement action
- 70% local parties

Patent cases 2002-2015



INFRINGEMENT - DEFENCES

Prior user defense under Article 13

- Requires registration of prior use with the DGIPR
- However, there is still no implementing regulations to enable such recordation
- Defense unlikely to be available without recording -see Article 15

Article 15 (1)

The party making an Invention as described in [Article 13](#) shall only be acknowledged as the earlier user if he or she makes an application thereof to the Directorate General after a Patent has been granted to the same Invention

LICENSES

- License Agreement has to be recorded with DGIP to have the legal effect against *third party*
- License agreement shall not contain provisions that may adversely affect the economy of Indonesia or create unfair competition. For patents, it cannot obstruct the ability to master and develop technology
- Implementing regulations not passed. For example, draft TM Licensing Regulations specify control over use of trademark
- Not possible to formally record licenses, apart from informal filing of letters
- Licenses/agreements with Indonesian party must be in Indonesian language as well, to be enforceable

COMPULSORY LICENSING

- Compulsory licensing –none in practice because no implementing regulations
- Implementation of Patent by Government – many licenses granted in respect of pharmaceutical drugs
- **Two framework for compulsory license**
 - Compulsory license issued by the DGIPR on application of a party under provided in Articles 74 to 87
 - Implementation of Patent by Government under Chapter VII of Patent Law Article 99



IMPLEMENTATION OF PATENT BY GOVERNMENT

Presidential Decree No. 83 of 2004

- Nevirapine
- Lamivudine

Presidential Decree No. 6 of 2007

- Nevirapine
- Lamivudine
- Efavirenz

Presidential Regulation No. 76 of 2012

- Efavirenz
- Abacavir
- Didanosine
- Combination of Lopinavir and Ritonavir
- Tenofovir
- Combination of Tenofovir and Emtricitabine
- Combination of Tenofovir, Emtricitabine and Efavirenz

CURRENT SITUATION - IMPLEMENTATION OF PATENT BY GOVERNMENT

President Regulation No. 76 of 2012

No.	Active Ingredient	Patent owner	Implementation Period	Registered product in Indonesia - NAFDC online database
1	Efavirenz	Merck & Co, Inc (ID 0005812)	Patent has been expired on August 7, 2013	EFAVIRENZ and EVIRAL (Kimia Farma) STOCRIN (Registered in the name of Schering Plough, Manufactured by Zhejiang Tianyuan Bio Pharm, China)
2	Abacavir	Glaxo Group Limited (ID 0011367)	Until patent expired on May 14, 2018	n/a
3	Didanosin	Bristol - Myers Squibb Company (ID 0010163)	Until patent expired on August 6, 2018	n/a
4	Combination of Lopinavir and Ritonavir	Abbot Laboratories (ID P0023461)	Until patent expired on August 23, 2018	LUVIA (registered in the name of Abbott Indonesia, manufactured by Abbott GmbH & Co KG Germany)
5	Tenofovir	Gilead Sciences, Inc (ID 0007658)	Until patent expired on July 23, 2018	RICOVIR (registered in the name of Kimia Farma, manufactured by Mylan Pharmaceutical USA) VIREAD (Registered in the name of IDS Marketing Indonesia, Manufactured by NYCOMED - Ireland)
6	Combination of Tenofovir and Emtricitabine Combination of Tenofovir, Emtricitabine and Efavirenz	Gilead Sciences, Inc (ID P0029476)	Until patent expired on November 3, 2024	TRUVADA (Registered in the name of IDS Marketing Indonesia, Manufactured by Gileadsciences, Inc. USA)

COPYRIGHT - LAW NO. 28 YEAR 2014

- **Copyright** is a useful alternative if Industrial Design registration cannot be applied for because of novelty loss
 - Industrial design - Novelty is lost through commercial launch before applying for Industrial Design registration
- **Copyright registration** not compulsory, but recommended to easily prove ownership using registration certificate when filing complaint
- **Landlord Liability** for the management of trade venues (e.g. malls, retail centers)
- **Online Infringement** - the Ministry of Information now has power to block access to infringing material on websites
- **Copyright infringement** is now classified as a complaint-based offence.
- **Collective Management Organizations** are now required to register with the Ministry of Law

IP KOMODO DRAGON (<http://ipkomododragon.blogspot.co.id/>)


IP Komodo

From the islands of Indonesia, the IP Komodo prowls South East Asia and beyond looking for succulent morsels of intellectual property news with the aim of to raising awareness of South East Asia's IP issues to help people understand this diverse region's IP complexities.

Powered by **Rouse**, the emerging markets IP firm. www.rouse.com

Monday, October 12, 2015

Singapore accredited for PCT searching and examination



The development of SEA and in particular Singapore as a patent centre continues with the appointment of IPOS as an International Search Authority (ISA) and International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT).

MoUs have been signed with the Directorate General of Intellectual Property (DGIP) of Indonesia, and with the United States Patent and Trademark Office (USPTO). Already IPOS is an ISA and IPEA for a number of countries, including in SE Asia, Vietnam, Brunei, and Laos. IPOS launched operations as an ISA and IPEA on 1 Sep 2015, so is now the first IP office in SE Asia through which businesses and inventors can fast track patent applications for protection in the 148 PCT member countries. IPOS has already received 41 PCT applications appointing IPOS as an ISA and IPEA.

Posted by Komodo Dragon at 8:30 PM

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Labels: Singapore patents

Articles on IP in South East Asia

- Pharmaceutical Trademarks 2010 – Vietnam
- Preventing Trade Name Infringement in Vietnam
- Scotch Whisky Becomes Vietnam's Third Foreign GI
- New Vietnam IP Enforcement Procedures
- Patenting strategy in South East Asia
- Well-known trade mark protection in Indonesia
- Champagne's GI journey in Asia
- Diageo win Indonesian trademark case
- Indonesia's opportunities for pharmaceutical companies
- Counterclaims in cancellation litigation in Indonesia

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The logo for Rouse, featuring the word "ROUSE" in a bold, sans-serif font. Each letter is filled with a different color: 'R' is purple, 'O' is green, 'U' is blue, 'S' is purple, and 'E' is blue. The letters are slightly overlapping and have a subtle drop shadow.

Thank You!

Indonesia

www.rouse.com

Offices in Rouse Group: Africa | China | Hong Kong | India+ | Indonesia | Myanmar | Philippines | Russia | Saudi Arabia+ | Thailand | UAE | United Kingdom | Vietnam | + Associated office