

IP RANKINGS

As Asia becomes a major innovation hub, and the filing of patents and trademarks continues at pace, law firms specialising in intellectual property are finding themselves increasingly in demand.

In the 2020 edition of its annual list, ALB once again picks the top firms for IP work across the region.

BY MARICEL ESTAVILLO AND ASIAN LEGAL BUSINESS

With the coronavirus pandemic certain to pull down global economic prospects from this year on, 2019 could go down in history as both the last hurrah before the impending slump and the prelude to a new era in innovation in industries pushed to the fore to mitigate the unprecedented health crisis.

“Last year was the best year we have experienced in the course of the past decade,” was how Francis Gurry, the outgoing director-general of World Intellectual Property Organization (WIPO), describes the 2019 performance of WIPO’s services.

International patent, trademark, and industrial design applications filed with the WIPO systems all posted record growths last year, according to the United Nations (UN) agency for IP. Year-on-year international patent applications filed with the Patent Cooperation Treaty (PCT) grew by 5.2 percent to 265,800; international trademark applications filed with the Madrid System grew by 5.7 percent to 64,400; and industrial design applications filed with the Hague System grew by 10.4 percent to 21,807.

For the first time in the long history of PCT, China became the biggest user of the system last year, WIPO reported. This was a position previously held consistently by the United States since the system began operations in 1978. China filed 58,990 PCT applications last year, a 200 percent increase from the 276 applications it filed in 1999.

“China’s rapid growth to become the top filer of international patent applications via WIPO underlines a long-term shift in the locus of innovation towards the East, with Asia-based applicants now accounting for

more than half of all PCT applications,” says Gurry.

China and Asia’s new dominant role in global innovation was also highlighted in a separate WIPO report on “The Geography of Innovation: Local Hotspots, Global Networks” that was published last year. The report finds that while innovation has become more collaborative and transnational, it remains concentrated in a handful of countries and even within these countries, in particular cities and regions.

China, Japan, and South Korea were three of the five countries, along with Germany and the U.S., which accounted for most of the patent production and scientific activity from 2015 to 2017.

“China and the Republic of Korea are largely responsible for the rising share of new areas in knowledge production and innovation; together, they account for over 20 percent of patents registered in the years 2015–2017, compared to under three percent in 1990–1999,” notes the report.

Patents filed in Asia rose to 48 percent from 32 percent since the 2000s, while scientific publications increased to 36 percent from 17 percent. “This reflects the rise of China and the Republic of Korea and comes despite the relative decline in Japan’s share of patents and publications,” the report further elaborates while also emphasizing the emergence of new global innovation producers, among them India and Singapore.

A testament to Asia’s rise in the global IP and innovation scene, a major shift in leadership at WIPO favouring the Asian group is set to happen this year. ^{ALB}

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- Baker & McKenzie
- Bird & Bird
- Deacons
- DLA Piper
- Hogan Lovells
- Mayer Brown
- Orrick, Herrington & Sutcliffe

TIER 2

- AWA Asia
- Barron & Young
- CMS
- ELLALAN
- Fangda Partners
- Freshfields Bruckhaus Deringer
- Jones Day
- Morrison & Foerster
- Nixon Peabody
- Oldham, Li & Nie
- Quinn Emanuel Urquhart & Sullivan
- Stephenson Harwood
- Wilkinson & Grist
- Winston & Strawn
- Vivien Chan & Co

TIER 3

- Dechert
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- Morgan, Lewis & Bockius
- Norton Rose Fulbright
- Robin Bridge & John Liu
- Ropes & Gray
- Squire Patton Boggs

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- Dechert
- Fangda Partners
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- Oldham, Li & Nie
- Quinn Emanuel Urquhart & Sullivan
- Robin Bridge & John Liu
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- Jones Day

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- Spruson & Ferguson
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- Anand and Anand
- Chadha & Chadha
- Khaitan & Co
- K&S Partners
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- L&L Partners
- Remfry & Sagar

TIER 2

- AZB & Partners
- Beruar & Beruar
- Cyril Amarchand Mangaldas
- Fox Mandal & Associates
- IndusLaw
- Khurana & Khurana
- Rahul Chaudhry & Partners
- Singh & Associates
- Majmudar & Partners
- Mason & Associates
- R.K. Dewan & Co
- Samvad Partners
- Singh & Singh Lall & Sethi
- Subramaniam, Nataraj & Associates

TIER 3

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- Sujata Chaudhri IP Attorneys
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- Krishna & Saurastri Associates
- Mason & Associates
- Phoenix Legal

INDONESIA

PATENTS

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- Am Badar & Partners
- Dwipo Lubis Baskoro & Partners
- HHP Law Firm
- Rouse/Suryomurcito & Co
- SKC Law
- Tilleke & Gibbins

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- Acemark IP
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- Biro Oktroi Roosseno
- George Widjojo & Partners
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- Inter Patent Office
- Januar Jahja & Partners
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- Pacific Patent Multiglobal
- Roosdiono & Partners

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- Makarim & Taira S.
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- Nakamura & Partners
- Oh-Ebashi LPC & Partners

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- Itoh International Patent Office
- Nishimura & Asahi
- Ohno & Partners
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- Seiwa Patent & Law
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- Tai E International Patent & Law
- TIPLo

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- Dharmniti Law Office
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- Vision & Associates

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- ZICO Law

COUNTRY REPORTS

Hong Kong

Last December, Hong Kong started accepting and examining filings under a new patent system which creates a direct route for applicants of standard patent protection.

“The OGP (original grant patent) system demonstrates the government’s commitment to bringing the local patent system on par with the mainstream patent practices of the international community. It will also facilitate the development of the innovation and technology sector in Hong Kong,” says David Wong, Hong Kong’s director of IP.

As one of the busier trade hubs in the region, Hong Kong was a routine leg for global law firms managing foreign IP for multiple jurisdictions in the region. Passing off and trademark infringement cases involving foreign brands were some of the top cases handled by top law firms last year.

In most cases, the work, from due diligence, to prosecution, or enforcement, bundled the territory with neighbouring Macau and China. In one key account for McDonald’s, DLA Piper handled IP management for the iconic American brand in Hong Kong, Macau, and Mainland China as it ramped up its brand protection strategy in the region following the divestment of its assets in the three territories to CITIC and Carlyle in a deal reportedly worth \$2 billion.

In another landmark case handled last year, Mayer Brown worked with the Asia Video Industry Association to find a solution to copyright infringement in Internet streaming pending changes in Hong Kong’s copyright regulation.

India

IP is both a source of pride and a matter of contention in India especially with some of its trading partners which demand higher level of protection for their exported IPs.

The U.S. for instance, in its 2019 Special 301 Report that put India on the Priority Watch List continued to push for reforms in the country’s patent system.

“India has yet to take steps to address long-standing patent issues that affect innovative industries. Companies across different sectors remain concerned about narrow patentability standards, the potential threat of compulsory licensing and patent revocations, as well as overly broad criteria for issuing such licenses and revocations under the India Patents Act,” it says.

IP is of particular importance in India’s pharmaceutical industry. India’s generic drugs industry is the world’s biggest and local manufacturers are either competitors or collaborators of the world’s top pharmaceutical companies. Naturally, the caseload of top law firms in India last year included filings and litigation cases for both domestic and foreign pharmaceutical firms.

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Deep & Far is confident to be the best IP firm, and is prepared to take challenge for verification of its competence by receiving from the client, e.g. 1) a pending or granted patent for comments about how it can improve the claims, 2) a pending patent specification without the claims for drafting the claims for comparison with the original claims, or 3) an initial disclosure for preparing a claim set at the same time with the firm the client is currently using so that the client can compare and find out which firm can provide the better claims. The claims Deep & Far prepares always trap therein all competitors of the clients.

& Anand handled a landmark case for Ferid Allani against the Union of India which could pave the way for software innovation patents, a timely development amidst the rise of AIs and blockchain technologies. In its decision, the court for the first time gave a new interpretation of Section 3(k) of India's Patents Act which excludes algorithms from getting a patent.

In copyright, one of the big transactions handled by AZB & Partners was Thomas Cook India's \$1.9 million acquisition of the 'Thomas Cook' brand for India, Sri Lanka and Mauritius. This enabled Thomas Cook India to retain the brand in the three jurisdictions despite Thomas Cook UK entering into liquidation.

Ajay Sahni & Associates were in the top tier in both patents, as well as trademarks and copyright. Owing to a boom in the eCommerce industry, the firm received several mandates to initiate enforcement action against counterfeiters on popular eCommerce

websites and social media platforms, says partner Kritika Sahni. "With businesses going digital and getting access to a global audience, infringers are using more sophisticated techniques such as automated bots to create new seller accounts or social media handles when previous ones get delisted or blocked," she says. "Another disturbing trend that emerged was the mushrooming of local startups that steal from patents owned by larger multinational companies, often not commercialised in India, and receive large seed or pre-series A funding from VCs, usually without conducting IP due diligence. We received many briefs to contest pre-grant oppositions against such infringing patent applications – that were often on a fast-track route, owing to the applicant's startup status."

Indonesia

Despite experiencing a slower economic growth of 5.02 percent in 2019, Southeast Asia's largest economy continued to be

an in-demand market for foreign brands in the region.

With its strong consumer market and having the fourth largest population in the world, IP protection, especially of copyright and trademarks, accounted for a big share in the caseload of IP law firms in Indonesia.

Based on WIPO data, trademark filings had been on an increase since 2015, posting a growth of 59 percent in four years. Trademark filings via the Madrid system stood at 65,206 in 2018. Patent filings via PCT, meanwhile, were at 1,451 in the same year.

At the top of the list of concerns of IP holders in the country are the relatively widespread piracy and counterfeiting. Of late, law firms have handled an increasing number of IP disputes on the Internet and social media.

While IP work continued to be copyright and trademark-heavy, patent protection is gaining ground in Indonesia.

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Last year, the Direktorat Jenderal Kekayaan Intelektual signed an agreement on reinforced partnership with the European Patent Office, the second IP office to do so in Southeast Asia after Malaysia. The agreement is aimed at strengthening bilateral cooperation on capacity for searching and examining applications amid steady growth in patent filings.

Demand for complex patent work has also started to pour in. Tilleke & Gibbins handled one for Ping An Technology, the tech incubator and AI R&D arm of China's largest insurance company.

Japan

Despite the relatively sluggish performance of IP filings in Japan in recent years compared to its East Asian counterparts, it remains one of the top producers of innovation in the region and an indispensable market for foreign IP.

Japan's total number of patent applications declined by 1.78 percent to 307,969 in 2019. While domestic filings were slightly down, international patent applications grew by 4.6 percent to 66,968 from the previous year. Patent registrations totalled 179,910 last year.

Korea

Last year, South Korea introduced a new law, the Medical Device Industry and Innovative Medical Device Support Act, which is aimed at promoting the development of new innovative technologies and creating a new breed of local innovative companies.

There was no shortage of landmark cases in South Korea last year, especially in healthcare.

Yulchon successfully represented GSK in a preliminary injunction proceeding in a trademark infringement and unfair competition case against a domestic pharmaceutical company over its disk-shaped inhaler bearing

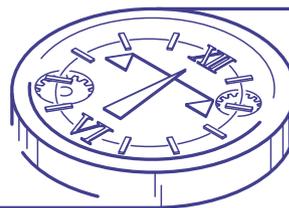
similar appearance to GSK's Diskus. In this particular case, the firm was able to convince the court that there was a likelihood of confusion despite it being a prescription drug.

Malaysia

Following Malaysia's implementation of its new trademark law last year, a subsequent increase in filings, especially for non-traditional trademarks is seen.

The Trademarks Act 2019 offers protection for shape of goods, packaging, sound, scent, colour, holograms, positioning and sequence of motions that could be graphically presented to identify goods and services. The new law has also raised penalty for trademark infringements to RM1 million (\$232,070), a maximum of five years imprisonment, or both.

In 2019, trademark filings in Malaysia were up by 6.6 percent to 46,530 while registrations dipped by 43.6 percent to 19,481. Industrial design



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applications by 3.1 percent to 1,904 while registrations were down by 16 percent to 1,238. Meanwhile, patent applications in 2019 grew by 3.3 percent to 7,743 while registrations fell by 3.8 percent to 4,213.

Philippines

The Philippines saw record growth in IP protection filings in 2019, with total filings increasing by 10 percent from the previous year to 43,000.

Being a consumption-driven economy with strong growth prospects, filings for trademarks last year grew by 10 percent to 39,399. Most of the filings were in the areas of agricultural products and services and pharmaceuticals, health, and cosmetics.

Industrial design applications grew by 7 percent to 1,631; utility model filings increased by 4 percent to 2,228; and patent filings grew by 2 percent to 4,024 from 3,962. The top filers for patent protection were from the U.S., Japan, and China.

Like the rest of the developing economies in the region, IP protection in the country is hampered by counterfeiting and piracy. The caseload of the top law firms included conducting criminal raid actions for mostly foreign brands. The increasing popularity of the Internet has also created a new avenue for counterfeiters and copyright pirates to distribute fake products.

Singapore

In a step aimed at strengthening its position as the region's alternative dispute resolution hub for IP, Singapore worked with the WIPO Arbitration and Mediation Center to offer reduced rates to businesses and creators who opt for mediation to resolve copyright disputes in the city-state. The previous arrangement only covered patents, registered designs, and trademarks.

"The goal is for the diverse stakeholders in the copyright and creative industries to gain greater access to more efficient and cost-effective routes to resolve their copyright disputes, including those relating to collective management and orphan works," the Singapore IP Office says. It notes that there had been an increase in the

number of copyright cases involving parties based in other parts of Asia.

One landmark copyright case in Singapore last year was the one handled by Allen & Gledhill for Sea Group/Garena. It was touted as the first copyright case in the city-state relating to the mobile game industry.

Tony Yeo, managing director and head of Tier 1 firm Drew & Napier's IP practice, and Yvonne Tang, a director in the IP practice, say that the department has been kept busy this year as 2020 brought on a whole new set of challenges. "In light of the COVID-19 pandemic, the department had to quickly adapt to allow for work to continue seamlessly, first on an alternative team basis as a business continuity measure and subsequently to a full work-from-home basis," they say. "These measures were implemented swiftly and efficiently to allow Drew & Napier to honour its commitment to our clients to continue to provide excellent service regardless of the circumstances like we have done so for the past years. We are grateful for our clients' continued trust and confidence in our work."

Significant milestones for Drew's IP practice in 2019-20 included Yeo being appointed to the Intellectual Property of Singapore's (IPOS) panel of IP Adjudicators for a two-year term starting April 2019. "Only a very small number of leading private practitioners are appointed as IP Adjudicators," say Yeo and Tang. "As an IP Adjudicator, Tony recently heard a trademark opposition matter at IPOS. The matter is pending his written judgment."

Also, a team comprising Yeo and fellow director Meryl Koh, and senior associate Javier Yeo, represented Ila Technologies, an industry leader and manufacturer of lab-grown diamonds with the largest diamond growing facility in the world, in a patent infringement suit commenced by Element Six Technologies, a subsidiary of the De Beers Group, in Singapore High Court Suit No. 26 of 2016. "The suit includes a counterclaim by Ila Technologies to invalidate and revoke Element Six Technologies' patents in the Singapore High Court. The suit was one of the longest patent infringement

trials heard in Singapore, spanning over seven weeks in two tranches," say Yeo and Tang. "The issues in the suit involve extremely technical and contentious and highly complex patent invalidation and infringement issues, making it one of the most complex patent infringement case that the Singapore High Court has heard. There were two patents concerned, both of which relate to diamonds grown by chemical vapour deposition (CVD)."

They add that the Singapore High Court delivered its written judgment on Feb. 7 this year. "The High Court agreed with Ila Technologies that one of Element Six's patent was neither new nor inventive and ordered for the patent to be revoked," say Yeo and Tang. "As an invalid patent is a complete defence to infringement, the High Court also found that Ila Technologies did not infringe the said patent. As for the other patent, the High Court found that the patent was valid and infringed. Ila Technologies has filed an appeal against this finding and Drew & Napier will represent Ila Technologies Pte Ltd at the appeal before the Court of Appeal."

Additionally, Tang and her team, senior associate Jaswin Kaur Khosa and associate Edsmond Cheong, also successfully represented Adidas in its appeal against the decision of Principal Assistant Registrar of Trademarks, in a trademark opposition commenced in 2016 against a mark filed in Class 25 by Lutong Enterprise which resembled an inversion of the iconic Adidas trapezoid mark.

Taiwan

Taiwan, a known technology manufacturing hub, is seen to be a big winner from the U.S.-China trade war. A recent report by the UN Conference on Trade and Development (UNCTAD) estimated the amount of windfall to the island from the trade tension to reach \$4.2 billion.

The Government of Taiwan launched last year a program to lure more Taiwanese companies operating in the Mainland for at least two years and are affected by the trade tension to move back home. The transfers could give added lift to its technology industry.

Last year, patent applications in

Ajay Sahni & Associates

177, Lawyers' Chambers, Delhi High Court, New Delhi 110003 T +91 11 41032782, 41022982 E postbox@asahni.co W www.asahni.co



Ajay Sahni & Associates (ASA) is a boutique corporate law practice focused on intellectual property, innovation and technology. The firm was founded in 1983 with the objective of rendering creative, robust and effective strategic legal advice and representational services.

ASA is committed to delivering out-of-the-box, *avant garde* solutions to complex problems faced by its clients. The team strives to work with its clients as partners, helping them manage risk and navigate challenging legal and business landscapes.

ASA has a very strong disputes and enforcement practice with over 100 reported judgments in leading law journals and reports to its credit. The firm handles large IP portfolios for many Fortune 500 clients (both Indian and international) on the prosecution side. It has various awards and listings to its credit, such as the International Client Choice Award (Trademark), *World Trademark Review* (Leading firm and individual in enforcement & litigation as well as prosecution & strategy categories), *Thomson Reuters Asian Legal Business IP Rankings* (Tier 1 firm for Trademark and Copyright, Tier 2 firm for Patent) and *Thomson Reuters Asian Legal Business India Rising Stars 2019*, among others. Its members serve on various committees and expert groups in international associations, as well as government bodies.

ASA works with a sophisticated artificial intelligence and automation based in-house trademark portfolio management system to manage compliances, monitor threats and alerts for clients. It is also the first law firm in India to offer blockchain-based IP protection services.

ASA is led by its founder Ajay Sahni, who has been practising IP law since 1983 at the Supreme Court, high courts, district courts and tribunal levels across India. He has argued numerous landmark cases, many of which have been reported in leading law reports and journals. His dispute resolution experience covers a wide spectrum of industries, including pharmaceutical, retail, infrastructure, real estate, automotive, finance, fast-moving consumer goods, power, telecommunications, education, chemical and industrial products.

A strong founder

Mr Sahni's experience is evident in the number of key positions he holds or has held:

- former vice president at Intellectual Property Attorneys Association, New Delhi;
- former vice president at Asian Patent Attorneys Association (India Chapter);
- invited by the Rajya Sabha Secretariat (upper house of the Parliament of India) and examined as an expert witness by the Parliamentary Standing Committee on Commerce in relation to the Trademarks (Amendment) Bill 2007;
- member on the Advisory Board of *The Patents and Trademarks Cases*, a leading monthly journal of IP case law in India;

- regular speaker on IP laws at the Institute of Company Secretaries, the Institute of Chartered Accountants, the Haryana Police Academy and the Export Promotion Council of India; and
- formerly appointed as a senior panel counsel in the High Court of Delhi for conducting central government cases.

In addition, Mr Sahni has written extensively on the subject of IP law, including as:

- a revising author of Lal's *Commentary on the Indian Copyright Act, 1957*; and
- a co-author of seven volumes of the book titled *Cases and Materials on Trademarks and Allied Laws*.

Firm's key service offerings

Litigation, enforcement and dispute resolution

- Handling civil, criminal and regulatory cases on infringement of patent, trademark, copyright, design, trade secrets, unfair competition; commercial mediation and arbitration
- IP dawn raids, enforcement cases and domain name disputes
- Dispute strategy, risk assessment, drafting of submissions, preparation of documentation, evidence, witnesses

Prosecution, compliance and audit

- IP prosecution
- Entry assistance: clearance searches, landscape studies, freedom-to-operate searches
- IP audits and health checks
- IP compliance management services
- Cutting-edge tools based on automation and AI for 360-degree IP monitoring, threat assessment and compliance management services

Transactional

- Acquisition and commercialisation of IP assets
- IP valuation
- Technology transactions and licensing
- Safeguarding IP assets in mergers, acquisitions and joint ventures

Advisory and public policy

- Anti-counterfeit investigations, forensics and enforcement strategy
- Customs border protection assistance and strategy
- Branding, advertising, marketing, packaging and labelling strategies
- Drug and pharma regulatory filings, representation and support
- Data protection and privacy
- Public policy advisory, advocacy and strategic litigation support

Taiwan increased by 2 percent from the previous year to 74,652. Of the total, invention patents were at 48,268; design patents at 8,804; and utility model patents at 17,580.

The government reported that the total invention patent applications filed by residents at 18,984 in 2019 was the highest in five years due to increases in the number of applications filed by corporations, large enterprises and small and medium-sized enterprises. In patents, Japanese firms were the top applicants followed by Chinese firms.

In addition to patent filings, top law firms in Taiwan for IP were kept busy handling infringement cases, with some patent-related cases matters of cross-border litigation.

Meanwhile, trademark applications at 86,794 were the highest since 2001. "This was due mainly to a 3 percent increase in resident applications," the government reports.

"Some industries have strongly backed up either the patent or trademark

filings in 2019 so everything looks quite well from the relevant statistics," CF Tsai, managing partner of Taiwanese firm Deep & Far, said. "However, from the firm's perspective, 2019 was a hardship year because this firm was subject to a last transition period from human-based management to deeply computer-based one by which we have seen various signs of recovery even at these COVID-19 rampant months."

Thailand

IP protection has improved considerably in Thailand, but a few challenges remained, at least that's according to the U.S. in its 2019 Special 301 Report.

"Concerns remain regarding the availability of counterfeit and pirated goods, both in physical markets and online," it says in its unilateral review of IP protection of its trading partners. The report put Thailand on the watch list with Vietnam in Asia, while China, India, and Indonesia were on the priority watch list.

Indeed, IP protection and deploying

anti-counterfeiting measures for their clients formed a big part of the work of law firms in Thailand last year.

For the bigger law firms, the work covered managing IP portfolio for the larger Southeast Asia. In one case, ZICO IP did the trademark portfolio management in eight countries in Southeast Asia for property and casualty insurer Chubb Limited.

Vietnam

Vietnam passed a new law last year effecting key changes to its IP regulation and to make it more aligned with the terms of a new trade agreement it signed with 10 countries, the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP).

Among the changes are the longer grace period for patent applications from the date of public disclosure to 12 months from the previous six months and the terms in determining common name of goods in applications for geographical indications. 