TPPA – Implications for IP
An Overview

CHEW PHYE KEAT
President of ASEAN IPA
TPPA= Trans-Pacific Partnership Agreement

STATUS

Signed by the 12 countries - Brunei, Chile, New Zealand, Singapore [1st batch], Australia, Canada, Japan, Malaysia, Mexico, Peru, the United States, and Vietnam [2nd batch] – all signed the agreement in Auckland on 4th Feb 2016. Now is the period of ratification (two years) whereby each country will need to get approval from its home legislature.
STATUS

- 4 ASEAN countries in the TPPA

- 3 more ASEAN countries have registered interest – Thailand, Indonesia and The Philippines

TPPA
Consists of 30 Chapters

Chapter 18 is the Chapter on Intellectual Property covering
- Joining of international treaties
- Traditional Knowledge
- Trade Marks
- Geographical Indications
- Patents
- Industrial Designs
- Copyright
- Protection for Internet Service Providers
KEY IP PROVISIONS OF THE TPPA

INTERNATIONAL TREATIES required to be entered into:

• WCT (WIPO Copyright Treaty)

• WPPT (WIPO Performances and Phonograms Treaty)

• Singapore Treaty on Law of Trade Marks
TRADITIONAL KNOWLEDGE

- Parties to work on improving databases on TK particularly in connection with patent examination

TRADE MARKS

- To provide for non-traditional TMs including scent and sound
- To provide for collective and certification TMs
- Well-known marks to be protected as in Paris Convention
- Electronic filing of TMs
- Non-recordal of TM licences
- There should be dispute resolution procedures for domain names
GEOGRAPHICAL INDICATIONS

• Parties may provide for protection of GIs but procedures for opposition should be allowed

• Grounds for opposition should include confusion with a pre-existing good faith TMs

PATENTS

• Grace period of one year prior disclosure by the patent applicant

• Patent applications should be published after 18 months after priority date or filing date whichever is earlier

• There must be disclosures by patent office of search and examination results, communication from the patent applicant, relevant literature submitted by applicant and third parties

• To provide for expedited patent examination
EXTENSION OF PATENT TERM

- Patent Office to extend the term of the patent corresponding to any unreasonable delay in the Patent Office’s issuance of the patent.

- Delay is described as a period of more than 5 years from filing of patent or 3 years after request for examination is made, whichever is later but excludes any periods of time attributable to the patent applicant.

EXTENSION OF PATENT TERM (PHARMACEUTICAL)

- Extension of the term of a pharmaceutical patent in the event of “unreasonable curtailment of the effective patent term as a result of the marketing approval process”.

- Each Party to the TPPA may provide for conditions and limitations as to how this Article is to be implemented.
AGRICULTURAL PRODUCT

• **Data exclusivity** for the user/supplier/IP owner of a new agricultural chemical product who has provided data to the authority to support his application for marketing approval.

• The exclusivity period is for 10 years from the date of marketing approval

REGULATORY REVIEW EXCEPTION

• Each Party to the TPPA shall adopt and maintain a regulatory review exception for pharmaceutical products. A “regulatory review exception” means that potential competitors of a patent owner are permitted to use the patented invention, without the authorization of the patent owner during the term of the patent, for the purposes of obtaining government marketing approval, so that they will have regulatory permission to sell in competition with the patent owner by the date on which the patent expires.
**PHARMA PRODUCT REGISTRATION**

- **Data exclusivity** of clinical data submitted by a pharmaceutical manufacturer for a period of 5 years from the date of marketing approval by the Drug Control Authority (DCA)

- In the case where a person applying for a marketing approval of a pharmaceutical product ("Applicant") is using the data of the original supplier of the pharmaceutical product and that pharmaceutical product is protected by a patent the DCA must notify the patent holder of such intention of the Applicant to market his product so as to enable the patent holder to take legal action against the Applicant for any alleged infringement of patent. This is commonly referred to as "patent-linkage".

---

**BIOLOGICS**

- Enhanced data exclusivity protection for a certain category of pharmaceutical products known as "biologics" (broadly defined as medicines that are made using certain types of cells to produce the right kind of protein). The enhanced protective measures are:
  - data exclusivity of 8 years from date of marketing approval (instead of 5 years for other types of pharmaceutical products as provided in Article 18.50); or alternatively
  - data exclusivity of 5 years in combination with other protective measures.
INDUSTRIAL DESIGNS

- to provide ID protection for part of an article
- parties to consider joining the Hague Agreement on Designs

COPYRIGHT

- term of protection to increase to life of author plus 70 years or
- where period is not based on life then 70 years from authorised publication or
- if there is no publication within 25 years from creation of the work, then 70 years from creation of the work
- prevention of circumvention of technological prevention measures (TPMs) and Rights Management Information (RMI)
INTERNET SERVICE PROVIDERS

- to be given safe harbour based on no monetary relief and take down action by the ISP

BORDER MEASURES

- Goods in transit are to be made liable to legal action
SUMMARY

TPPA ups the ante for IP protection in ASEAN and ironically has successfully made “trade a driver of IP” instead of “IP being a driver of trade”!

THANK YOU

CHEW Phye Keat
Raja, Darryl & Loh
18th Floor Wisma Sime Darby
Jalan Raja Laut
50350 Kuala Lumpur
Tel: 603 – 26949999
Fax: 603 – 26984759
chewphyekeat@rdl.com.my