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UPDATES**

ARGENTINA:

Registration of EU Geographical Indications.

On November 1st, the Argentine Agroindustry agency issued a resolution in its official Gazette, detailing the institution and registration of Geographical Indications (GI's) and Appellations of Origin (AO's) from the European Union in accordance with ongoing discussions between the EU and MERCOSUR, with the aim of signing a free-trade agreement.

As such, on November 2nd the following list of GI's and AO's were published in the Official Gazette, allowing 3rd party opposition until December 1st, based on legitimate interest for invocation:

- The GI / AO is the generic name of the product (or common name that identifies the product in Argentina).
- The GI / AO is a trademark that has been registered in good faith and is in force, or where rights to a trademark have been acquired through use in good faith before the publication of the GI and/or DO.
- The GI / AO is an identical or similar name that has been recognized as an AO and may mislead consumers as to the true identity of the product.
- The GI / AO may mislead consumers as to the true qualities and/or characteristics of the product.
- The GI / AO may indicate or suggest, in the designation or display of the product, that the product originates from a geographical area other than the true place of origin and may mislead consumers as to its geographical origin.
- The GI / AO are a plant variety or breed that may mislead consumers as to the true geographical origin of the product.

BRAZIL:

Software registration - PPH Program with EPO - New Memorandum of Understanding with Chinese Patent Office.

The Brazilian Patent Office recently issued a resolution ruling the new procedures to register software in the country. These rules are already in force and, in a nutshell, (i) institute a completely electronic process (including the acceptance of documents with electronic signature), (ii) implement a so-called, "hash digital summary" which confers a safe way to protect the registered software and (iii) standardize the rates of all software services (reducing most of the official fees).

The EPO and Brazil launched a joint Patent Prosecution Highway (PPH) pilot program to enable work-sharing and accelerate patent prosecution at both offices, with the aim of improving the global IP system, supporting applicants and encouraging innovation. It will initially run for two years and will entitle applicants, whose claims have been found to be patentable by either the EPO or INPI, to ask for accelerated processing of their corresponding applications, pending before the other office.

The Brazilian Patent Office recently issued a resolution regulating the scope of the PPH. It will start December 1st and will be in force for 2 years. There will be a limit of 300 petitions accepted per year and limited to a patent family first filed in Brazil of the EPO. The applications have to be within the following technologies: basic chemistry; organic chemistry; fine chemicals; macromolecular chemistry and polymers; medical technology. Finally, there are certain additional requirements that need to be met:

- Filing must have been published/application must have been disclosed. Examination must have been requested.
- A response to an office action in Brazil cannot be pending. Annuities must be paid.
- No other priority examination request must have been granted. The patent cannot be the object of litigation.
- The application cannot be a divisional one (with one exception: that the divisional comes from the original application, consequence of a lack of unity objection raised by the Office of Earlier Examination).

Similarly, on November 13th, the Brazilian Patent Office and the Chinese Patent Office signed a memorandum of understanding, setting up the basis for a PPH program pursuant to which applicants will be able to seek for an accelerated examination whose Chinese/Brazilian counterpart has been already approved. The PPH program is expected in the near future and we will keep you posted of any developments. As of today, it is expected to cover the following areas: IT, packaging, measurement and chemistry.

In addition, the INPI has recently entered into discussions regarding the institution of Geographical Indications for EU countries. This has been a point of contention for the Brazilian bloc, but talks are underway as of last week which may bring the additional protection to specification of certain

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products which are attached to specific European locales. Some opposition has been noted, specifically in some cases as outlined below:

- GI may conflict with existing plant variety / animal breeds, which would prove impossible to define the origin of the product.
- The GI may conflict with acquired rights, which would cause possible interference.
- The GI may conflict with an identical or similar name already registered or with registration in process for the same product or similar, which would prejudice the decision to purchase by the consumer.
- The GI may conflict with generic name or common use in Brazilian product, necessitating in this case, that the use in good faith and the date of beginning of production must be proven.

CHILE:

Vertical Integration of Labs and Bioequivalent Drug Regulations.

The Chamber of the Chilean Senate continued to debate the merits and oppositions in the regulation of bioequivalent medicines and their allowance in the marketplace. The aim is to avoid the vertical integration of pharmacies and laboratories, which would be able to dictate quasi monopolistic pricing and to provide medications which have the same therapeutic results, but with a more accessible pricing to the public.

The bill modification was approved by vote in the senate and allows for the registration of drugs in Chile, which are not currently accessible and are also deemed necessary for the people. This bioequivalence will also extend to those who are in charge of prescribing medication, who until now, have been obliged to prescribe a specific brand of a drug. The new allowance, as voted in the senate will allow for the proposition of any brand of equivalent drug by a doctor, which will have the same therapeutic effect.

COLOMBIA:

Amendments to the Single Circular of Intellectual Property of Colombia.

A few months ago, the Superintendent of Industry and Commerce resolved to amend a few regulations of the Single Circular of Intellectual Property of Colombia. We summarize below what we think are some of the main changes:

- Notification of admission and transfers of requests for cancellation to holders of trademarks that are result of a territorial extension made through Madrid Protocol and do not have representative or agent in Colombia, will be through publication in the Gazette of Industrial Property.
- Voluntary claim amendments are subject to a fee.
- Applications of Industrial Designs will require certain specifications in its views and presentations (i.e., they must be accompanied of 6 views: top, bottom, right side, left side, front and rear, and isometric perspective; they can be presented graphically or photographically; etc.);
- Divisional applications of Industrial Designs can be filed before the grant or denial of the design.
- The Superintendent will register the cancellation of an international trademark application extended in Colombia if the International Office communicates the cancellation of the international trademark at the request of the origin office within 5 years following the registration of international trademark.

EL SALVADOR:

Reforming Copyright Intellectual Property Law.

As a consequence of the need to clarify certain procedures related to copyrights in El Salvador, the applicable IP Laws have been amended. Among other things, the process to register an Entity of Collective Management ("Entidad de Gestion Colectiva") has been modified. If the corresponding requirements, which are clearly specified, are not met, the registration is denied. Once registered, these Entities have the obligation to file the prices which will be charged to their affiliates. These prices will have to be approved by the IP Registry and, later, published in the Official Gazette. Something similar will happen with the agreements of reciprocal representation which will also have to be published. An opposition by a third party against the prices will be possible and, in case of controversy, a mediation process will need to be followed.

EPO:

Changes to the Guidelines for Examination of European Patent applications.

The EPO published the last revised version of its Guidelines for Examination of Patent applications. This version came into effect on November 1st. Among the different changes, we believe the following are worth mentioning:

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- Summons to Oral Proceedings: Former practice required that the applicant be given the opportunity to respond to at least one examination report prior to being summoned to Oral Proceedings. Based on the current version of the Guidelines, if the examiner considers that the Search Opinion does not place the application in order for acceptance, the Examiner Division can summon the applicant to Oral Proceedings even if the applicant has not received yet an examination report. The Guidelines indicate however, that this can occur only in exceptional circumstances, requiring that certain conditions be met.
- Refund of fees: The revised Guidelines also confirm that if an application is withdrawn before the examination begins the fees paid are fully refunded. Also, if the application is withdrawn before the expiration of the term to reply the first substantive communication, 50% of the fees paid will be refunded.
- Products of essentially biological processes: Finally, the Guidelines amend Rules 27 and 28, setting out that plants and animals exclusively obtained by essentially biological processes are excluded from patentability under article
- 53(b) of the European Patent Convention.

EUROPEAN UNION TRADEMARKS:

The Second Phase – What you see/hear is what you get.

On October 01, 2017 the second phase of Regulation (EU) 2015/2424 of December 16, 2015 concerning the new rules governing the former Community Trademarks (now European Union Trademarks) became effective. Said new rules refer to practical and technical issues, being the purpose of this notice to focus on practical aspects which may be summarized as follows:

What you see/hear is what you get.

One of the main consequences of this statement concerns the graphical representation of a European Union Trademark (hereinafter EUTM) which has opened the possibility to file new type of EUTMs such as:

- Sound marks consisting exclusively of a sound or combination of sounds. Motion marks consisting of, or extending to, a movement or a change in the
- position of the elements of the mark.
- Multimedia marks consisting of, or extending to, the combination of image and sound.
- Hologram marks consisting of elements with holographic characteristics.

The main feature of the above mentioned EUTMs is the possibility to submit MP3 and MP4 files to meet the representation requirement, a possibility not available before October 01, 2017, in addition (now optional) to a graphic representation, for example, a musical notation for sound marks.

Moreover, pure figurative marks have been sub-classified to introduce new types, such as:

- Position marks consisting of the specific way in which the trade mark is placed
- on or affixed to the product.
- Pattern marks consisting exclusively of a set of elements that are repeated regularly.
- Colour marks consisting exclusively of a single colour without contour or a combination of colours without contours.
- Three dimensional marks have been renamed to read "Shape marks" which may consist either of a strict shape mark (no word elements) or a shape mark containing word elements.

Smell, taste and smell marks are not admitted at present as with the current technical means in hand they cannot be represented on the register properly as to meet the current requirements.

EU Certification Marks (new):

EU Certification Marks may be filed now in addition to EU Collective Marks. In this sense, an EU Certification Mark is an EU trade mark that is described as such when the mark is applied for and is capable of distinguishing goods or services that are certified by the proprietor of the mark in respect of material, mode of manufacture of the goods or performance of the services, quality, accuracy or other characteristics (with the exception of geographical origin) from goods and services that are not thus certified. In addition, it is compulsory to submit a set of rules governing the use of the EU Certification Mark and finally, the natural or legal person who applies for an EU Certification Mark must not carry on a business involving the supply of goods or services of the kind certified. In our opinion and considering the inherent peculiarities of EU Certification Marks, we foresee very few filings only.

Priority Claim (new practice):

Should a EUTM application claim the priority of a previous mark, the priority claim must be submitted at the time the EUTM application is filed, contrary to the previous practice where such claim could be filed up to two months after the filing date. Moreover, the Office will no longer

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carry out a substantial examination of the priority claim and hence, it is the onus of the applicant to submit a valid priority claim supported by a valid document.

Acquired distinctiveness as a subsidiary claim (new):

An applicant can make a claim as to acquired distinctiveness through use as principal one (i.e. irrespective of the outcome on inherent distinctiveness), in which case the Office will take a single decision both on the mark's inherent distinctiveness and, where there is none, on the claim of acquired distinctiveness through use. The second and new option is to make the claim as a subsidiary one subject to a decision on inherent distinctiveness. In this case the Office will take two separate decisions at different points in time: first, one on the mark's inherent distinctiveness and then, once that decision (finding lack of inherent distinctiveness) has become final, another on the claim of acquired distinctiveness through use. Should the applicant decide to file a subsidiary claim, same must be submitted jointly with the application or when replying to the first official action. Consequently, it cannot be submitted for the first time in appeal proceedings.

In cases where doubts may arise as to the distinctive character of a new EUTM, we would recommend filing the subsidiary claim after the first official action has issued as otherwise, if the subsidiary claim is filed jointly with the application, the Examiner may be put on alert by the applicant himself on this particular issue.

GUATEMALA:

Accession to Marrakesh Treaty.

On July 2017, the Foreign Ministry published the ratification of the Marrakesh Treaty to facilitate access to published works for persons who are blind, visually impaired or otherwise print disabled. As a consequence of this, the Copyright Law will have to be modified. A new project of Law has already been presented (number 5149), which is in process of consideration and approval.

INDONESIA AND THAILAND:

Join Madrid Protocol.

On August 7, 2017, Thailand joined the Madrid Protocol, becoming the 99th Contracting Party. The Protocol entered into force on November 7. Local brand owners in Thailand can begin using the Madrid System to protect their marks in the 114 territories of the System's other 98 members by filing a single international application and paying a single set of fees.

Indonesia has also joined the Protocol, becoming the 100th member, which will enter into force on January 2nd, 2018. From that time on, local brand owners will be able to file a single international application under the Madrid System to protect their marks in the territories of the System's other members. Likewise, foreign enterprises and brand owners can use the Madrid System to seek trademark protection for their products and services in Indonesia.

On this occasion, the Madrid System takes another step toward expanding its geographical coverage while offering brand owners in Thailand access to 115 additional international markets.

MYANMAR:

New Trademark Law Expected shortly

Myanmar has been working towards its first ever formal trademark law for the past years. Its enactment is expected at the end of this year, which would bring certainty and clarifications on trademark prosecution in the country. Amongst the rules which can be expected, the following may be highlighted: a) It will follow a first-to-file principle; b) Smell and touch signs, visual marks, and perceivable sound may be subject of trademark protection; c) Trademarks will be valid for 10 years, renewable; d) trademarks, service marks, certification marks and collective marks can be registered; as well as geographical indications; e) and a new Myanmar Intellectual Property office and new IP Courts will be established. Civil and criminal actions will be available and trademark rights will be enforceable through customs.

Finally, a transition period is expected. Owners of registered trademarks will be required to re-register their trademarks within a certain period of time.

OMAN:

Adoption of GCC TM Law.

On Monday July 31, 2017, a Royal Decree was published in the Official Gazette formalizing the implementation of the GCC Trademark Law. Oman becomes the fourth member of the Gulf Cooperation Council to implement its Trade Mark Law, after Kuwait, Bahrain and Saudi Arabia (UAE and Qatar have not yet implemented). The implementing regulations will be issued shortly, which will determine the official fees, the supporting documents or the duration of the examination period.

As a consequence of the implementation, the opposition period is reduced, from 90 days to 60 days, trademarks are defined broadly (including colors, sounds and smells), there should be a stronger protection for well-known trademarks as well as, in general, for trademark infringements.

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We are waiting to see if, as happened in other countries, the implementation of the GCC Trade Mark Law results also in a substantial increase of the official fees.

SINGAPORE:

Revision of Examination Guidelines.

On 30 October 2017, the Intellectual Property Office of Singapore (IPOS) published its revised Examination Guidelines. The main changes include the extension up to a year of the grace period provision, the ability to shift amongst substantive and supplementary examination and the dismissal of post-grant amendment claims which are "obviously invalid".

SPAIN:

Six months with the New Patent Law.

It has already been more than half a year since the new Patent Law in Spain came into force. This allows us to carry out, although with a small sample size, a first balance of the predictions that, in turn, were made about the trend of the requests.

Two of the main changes introduced, if not the most important ones, are the obligatory nature of the substantive examination for patent applications (farewell to the granting of patents without having been examined) and the extension of the subject matter protected by utility model (these without examination). The forecast was that, after the entry into force, there would be a notable reduction in the number of patent applications, accompanied by the corresponding transfer to utility model applications. The data available so far indicates that there has indeed been a decrease in the number of patent applications and that the alleged transfer to utility models is not so clear. It may still be early, though, to extract definite conclusions as to the future trends in the country and we will have to continue waiting for a more solid hypothesis.

SOUTH KOREA:

Amendments to Korean Design Protection Act.

As of September 22nd, Korean Design Protection Act has been amended. Out of the several changes, we believe the following two are of most import: The grace period is extended from 6 to 12 months, which can be claimed any time before the applications is granted/rejected; priority documents no longer need to be submitted as long as an access code of WIPO DAS is provided.

THAILAND:

Acceptance of sound trademark applications.

On September 1, 2017, the Thai Department of Intellectual Property started accepting applications for sound trademark registration. The following is required: 1) list of goods or services; 2) a detailed written description of the sound and specifying whether the sound is categorized as a human or animal sound, a piece of music/melody, or other type of sounds; and an audio recording of the mark. The trademark must not directly represent a product's properties, or be sounds naturally made by the product or a result of the use of the product.

TUNISIA:

European Patent Validation.

As of December 1, 2017 patents will be validated in Tunisia and thus regarded as national Tunisian patents. Tunisia becomes the third non-EU member state, following Morocco and Moldova, where this is possible. Companies and inventors from all around the world will be able to easily extend the scope of their patent protection to Tunisia.