



IP Developments
in Spain, EU
and LATAM
2017/18

UNGRIA®

Dear Colleagues,

We are glad to present you the following publication summarizing the main legislative developments occurred in Spain, European Union (EU) and Latin America in relation to Intellectual Property practice during 2017 and the beginning of 2018.

Among the many relevant changes we outline below, 2017 was an intense year in Spain, with the entry into force of a new Patent Law (Law 24/2015, of July 24) on April 1; in the EU, with the latest revised version of the European Patent Office (EPO) Test Guidelines, effective as of November 1, the entry into force of the Regulation (Regulation (EU) No. 2015/2424 of the Parliament and the European Council of December 16, 2015) and the latest news about BREXIT and IP; lastly, in Latin America, where there have been substantial changes in the main jurisdictions of the region, especially in Argentina and Brazil.

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DATA AND STATISTICS

Before further discussing the many relevant changes, we would like to mention some data that shows the position of Spain, EU and Latin America in relation to matters of our business activity.

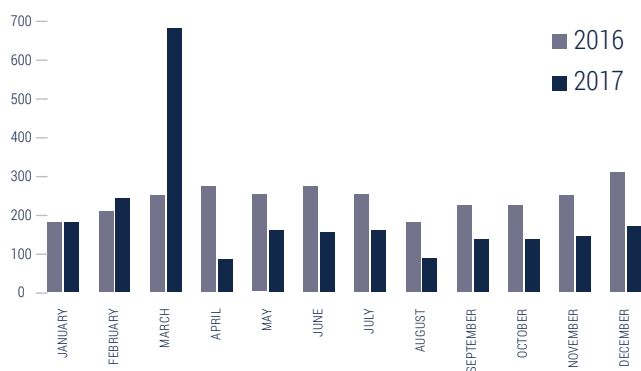
In **Spain**, the Spanish Patent and Trademark Office (SPTO) ended the year with an increase in the number of Distinctive Signs applications by 3.4%, keeping the number of Trademark applications stable with respect to the previous year, and with an increase of 27.9% of Trade Names. With regard to Patents, with the entry into force of the new Law 24/2015 on 1 April 2017, the number of applications decreased by 19.7%. Likewise, with regard to Utility Models, the new Law 24/2015 includes minor changes to its prosecution and granting procedure and the reception of applications is constant. Finally, there has been an increase of 22.5% in the number of Industrial Designs filed with the SPTO.

Year	National Trademarks	Trade Names	Patents	Utility Models	Designs
2016	52,103	7,388	2,849	2,427	18,035
2017	52,041	9,451	2,286	2,438	22,109
Total	-62	2,063	-563	11	4,074
Difference %	-0.11%	27.9%	-19.7%	0.45%	22.5%

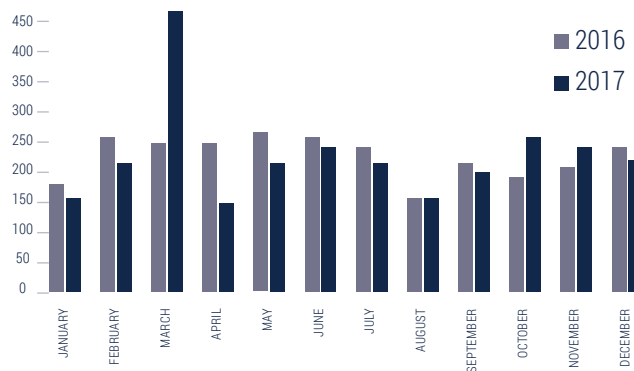
Source: OEPM

However, in comparison to the beginning of 2016, there was an increase in filed patent applications (from 628 patent applications filed in 2016 to 1,103 in 2017) of an additional 75% during the first three months. This increase was due to those holders who sought to take advantage of the provisions of the previous Patent Law, and specifically, the general granting procedure without the patentability examination. The same occurred with the number of utility model applications, increasing by 22.7% during the first three months of 2017 with respect to those filed during the same months in 2016.

NATIONAL PATENT APPLICATIONS



UTILITY MODELS APPLICATIONS



Source: OEPM

In **Europe**, the number of European Patent applications filed with the European Patent Office remains constant (Spain registered a total of 1,676 applications, 8.1% more than in 2016), of which more than 90% designate Spain; with 29,348 validations being granted, which entails an increase of 69% with respect to 2016 due to the “shock plan” of the SPTO against the backlog.

“Spain filed a total of 1,676 applications before the European Patent Office, 8.1% more than in 2016”

Thus, it is confirmed that:

- Most non-resident applicants seek protection in Spain through the European Patent Convention.
- Spain is positioned among those with the greatest growth in the European Union (third after Austria and Denmark).
- Spain is established as a key territory in the strategy of applicants when obtaining protection for their intangible assets.

Likewise, the number of European Union Trademarks filed with the European Union Intellectual Property Office (EUIPO), which would have a direct effect on Spain, increased by 8.18% with respect to 2016.

Lastly, in the international context, in 2017 there was a two-fold increase of 32.4% and 41%, respectively, in the number of international trademark applications that designate the EUIPO and those that designate Spain.

Year	International Trademarks that designate the EUIPO	International Trademarks that designate Spain	EU Trademarks	European Patents	Granted validations in Spain
2016	18,784	2,132	135,346	159,316	17,353
2017	24,882	3,007	146,418	158,843	29,348
Total	6,098	875	11,072	-473	11,995
Difference %	32.4%	41%	8.18%	-0.29%	69%

Source: OEPM, EUIPO y UNGRIA.

As for **Latin America**, according to the indicators in the World Intellectual Property Organization (WIPO) Report 2017, Latin American Patent and Trademark Offices registered a total number of patent, trademark and industrial design applications similar to those of last year with 61,300 patents and 544,941 trademarks. However, with regard to designs, the quota of the Latin American offices only increases to 1.2% of design applications worldwide and the number of applications has decreased by -0.3% in the last decade.

It is also important to note the distribution between grants/rejections/abandonments in the patent examination decisions of the Latin American offices. Taking into consideration the region’s two largest offices (Brazil and Mexico), and in comparison to other offices worldwide, we see that Brazil has one of the lowest granting percentages (only 18.7%) and Mexico, on the other hand, has an average (64.3%) close to the highest percentage worldwide. Despite this, it should be noted that Brazil continues to grant more patents than it denies; the difference is that there is a high percentage of abandonment/withdrawals. With regard to trademarks, Brazil and Mexico have seen a significant increase as compared to last year (4.6% and 8.4%, respectively).

SPAIN AND THE EUROPEAN UNION (EU)

DISTINCTIVE SIGNS

NATIONAL TRADEMARKS

In January 2019, an important modification to the current Trademark Law will come into effect; a Draft modifying this Law is currently being drawn up which entails the required timely transposition to the Spanish legal system of the Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015, to approximate the laws of the Member States relating to trademarks, for the purpose of harmonizing the different national trademark systems to that of the European Union trademark registration systems.

This Draft considers important modifications, both of a procedural and substantive nature, among which the implementation for a trademark applicant, in the event of opposition based on a prior trademark that has been registered for more than five years, to require the counterpart to verify the true genuine use of the trademark that has been the basis of their opposition is deserving of special mention, since it is entirely new with respect to the present system of the current Trademark Law. Another significant development that would entail modification of the articles of the Organic Law of the Judicial Power, is the granting of competence to the Spanish Patent and Trademark Office to resolve matters regarding the nullity or expiration of trademarks in administrative proceedings before said Organism, notwithstanding the possibility of ordering said actions to cancel the registration (nullity or expiration) of trademarks via

counterclaim in judicial proceedings of trademark infringement.

Other modification introduced by the new law is the elimination of the previous requirement where the distinctive sign to be protected is capable of being represented graphically. Now, given the technological advances, it is only required that the sign has to be capable of being represented without specifying the means used, although it requires this representation to enable the object of the protection granted to the holder to be determined, such that the representation must be clear, precise, self-sufficient, easily accessible, intelligible, durable and objective, all of which will make it possible to use available technology when representing the sign at all times and that it is adequate for the purposes mentioned.

Registration prohibitions have not undergone significant modifications. However, the absolute grounds of refusal regarding the designations of origin are properly systematized, directly referring to the legal instruments of European Union Law or of national law to avoid errors of interpretation.

The new Trademark Law, or the current modified law, will enter into force on January 14, 2019, except for the items regarding the competence of the Spanish Patent and Trademark Office in terms of actions of nullity or expiration of trademark registrations, which is delayed until January 14, 2023, the maximum period of transposition as provided for the aforementioned Directive.

EUROPEAN UNION TRADEMARKS

BREXIT AND IP

(LATEST DEVELOPMENTS)

The European Union Commission and the UK recently announced that they have agreed to a transition period (TP) from March 30, 2019 (the withdrawal date) to December 31, 2020.

On February 28, 2018 a comprehensive Draft Withdrawal Agreement (DWA) was presented by the European Commission for further discussion and among the various aspects foreseen in the DWA, Title IV thereof deals with IP rights.

As far as EUTMs are concerned, the DWA makes a clear distinction between EUTMs already granted at the end of the TP and those still under prosecution.

For the first group, the UK shall provide for an automatic national validation, free of local representation and free of charge, affecting all EUTMs granted by the EUIPO by December 31, 2020. The protection period of the resulting UK national mark will expire on the same date as of the corresponding EUTM.

However, the outcome of any proceedings started against a granted EUTM before the end of the TP will affect the validity of the resulting UK national mark in the same way as it may affect the corresponding EUTM whose validity was challenged.

For pending EUTMs at the end of the TP, an “ad hoc” six months priority term has been established for those applicants wishing to file a corresponding UK national application who will benefit from the filing / priority date of the pending EUTM. This new national application will be treated as a standard national application and hence, it may be the subject of an application fee and local examination as to absolute and relative grounds of refusal. The outcome of the EUTM application should have no legal effects on the outcome of the resulting national UK mark.

For EUTMs filed via WIPO as International Registrations, the DWA leaves it open as to the measures to be adopted by the UK to ensure an

“On February 28, 2018 a comprehensive Draft Withdrawal Agreement (DWA) was presented by the European Commission for further discussion. Title IV thereof deals with IP rights and sets forth the proposal for the transition from the EU system to a national UK system”

equivalent degree of protection compared to the one enjoyed by the corresponding EUTM. The point is that International Registrations are administered by WIPO and most likely, will not accept the UK being designated as the “successor territory” free of charge. Although nothing has been foreseen at this stage, in our opinion a kind of “Montenegro solution” will be adopted in the sense that within a prescribed term after the end of the TP, the owner of such a EUTM may designate the UK by paying a slight “continuation of effects” fee.

All the above comments refer to the content of the DWA as it stands at the time this Newsletter was released and hence, it may be the subject of future alterations depending on the outcome of the ongoing negotiations between the European Commission and the UK. In this sense, we shall not fail to keep you duly updated.

THE “SECOND PACKAGE” OF RULES CONTAINED IN THE NEW REGULATION (EU) NO. 2015/2424 OF THE EUROPEAN PARLIAMENT AND THE COUNCIL OF DECEMBER 16, 2015

The “Second Package” of rules contained in the new Regulation (Regulation (EU) No. 2015/2424 of the European Parliament and the Council of December 16, 2015) became effective as of October 1, 2017 once the set of rules concerning the Acts of Delegation and Rules of Implementation were passed.

Perhaps one of the main highlights foreseen in the Second Package refer to the possibility to file European Union Trademarks (EUTMs) without the need of submitting a graphic representation and to put an example, “sound marks” are permitted to be filed since October 01, 2017 using an electronic format, let’s say MP4. The same happens with “hologram marks”, “position marks” and other new type of marks which as of the said date can be filed using another kind of representation in lieu of the graphic one, provided the representation takes place “in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor”. Therefore, so called “olfactory marks” cannot be filed as EUTMs considering that the technical means available at present do not match the said representation requirements.

However, it appears that applicants, at least for the time being, still like to stick to the traditional representation filing standards considering that from October 01, 2017 up to February 28, 2018 only twelve new “sound marks” using an electronic format were filed, from which two of them have already matured into registration, four of them are now published and two of them were withdrawn. The remainder “sound marks” are still under examination.

As far as hologram marks are concerned, only one single mark using an electronic format was filed since October 01, 2017 and up to February 28, 2018.

Another highlight of the “Second Package” refers to the possibility to file “certification marks” as EUTMs

“The number of European Union Trademarks filed with the Intellectual Property Office of the European Union (EUIPO), which would have a direct effect in Spain, increased by 8.18% with respect to 2016”

and indeed, in the above mentioned period, 91 new “certification EUTMs” were filed. However, only one has been granted, five have been published and four of them have been withdrawn. It would not be surprising that some of the “certification EUTMs” still under examination will not meet the requirements applicable to “certification EUTMs” as they resemble, at least prima facie, more to standard “collective trademarks”.

The “Second Package” brought also considerable prosecution advantages, however most of them refer to the technical aspects which exceed the purpose of this Bulletin. But to mention one, in opposition and cancellation proceedings the need to file a copy of the filing form or of the certificate of registration or a copy of the official database where the prior mark was filed / registered has been abolished, provided the said mark appears in the “TMview” database.

We may conclude that the EUTM system continues to be a success, constantly improving, and most likely 2018 will beat the filing record achieved in 2017. If BREXIT will have future consequences not only in the number of filings, but also in the rights conferred by EUTMs in the UK territory, we shall have to wait until that time when the ongoing negotiations between the UK and the EU develop to more precise scenarios.

INVENTIONS

PATENTS

Last year has been marked by the entry into force of the **new Patent Law (Law 24/2015, of 24 July) on 1 April**. This new law adapts the legislation to current needs regarding patents and integrates various international treaties and European directives that have been implemented.

Among the changes introduced, it is worth mentioning the compulsory substantive examination (the possibility of obtaining patents without examination disappears) or the introduction of a post-grant opposition system, similar to that which exists for European patents (although the period is significantly shorter). Other important changes include the advance payment of the search fee at the time of the request; the possibility of revocation or limitation of the patent, by modifying the claims, at the request of the owner, or in the response of the claim for nullity or counterclaim for nullity; the creation of the figure of preventive writings, in anticipation of possible interpositions of precautionary measures; or various regulatory aspects of legal actions related to infringement, validity or compulsory licenses. With regard to **Utility Models**, the possibilities of protection have been extended to also include chemical products, substances or compositions, the novelty requirement has been raised (which now must be absolute) and the completion of the state of the art report before carrying out any action or claim is required.

EUROPEAN PATENT OFFICE (EPO)

In the scope of the EPO, there have been several developments, which are included in the latest revised version of its Guidelines for Examination, in effect as of November 1, 2017. One of them affects applications with lack of unity. Since April, the partial search report issued for the first invention is released with the corresponding provisional written opinion attached, prior to the payment of fees for additional searches. Another notable change affects the possibility of summons to an oral hearing. Until now, said summons could only take place once the applicant had taken the opportunity to at least respond to an examination report. With the new guidelines, the Examining Division can issue the summons in its first substantive communication, if it considers that the response to the search report has not been satisfactory.

The guidelines also include changes related to fees that took place in 2016, especially relating to the total or partial refund of the examination fees, according to the moment of abandonment or withdrawal of the application. The update likewise reflects the

amendments of Rules 27 and 28, created in July retroactively, specifying that plants and animals obtained exclusively by essentially biological processes are not patentable.

Lastly, it is worth noting the addition of Tunisia as a validation country of European patents, in effect since December 1, 2017.

Furthermore, 2017 has presented a new obstacle to the establishment and start of the system of the unitary patent and of the Unified Patent Court. In addition to the problems that began with BREXIT, there was the filing of a claim of unconstitutionality before the Constitutional Court of the Federal Republic of Germany. It is still unknown whether this Court will allow the claim to be heard, but it is not likely that this decision will be made before the summer. If accepted, the delay would be prolonged, at best, for several years, with scenarios having different outcomes also being possible. We must await developments this year to shed more light on this matter.

JURISDICTION, COMPETENCE AND PROCEDURES

RELATED TO INDUSTRIAL PROPERTY RIGHTS.

On April 1, 2017, the new Spanish Patent Law entered into force, Law 24/2015, which considers important developments regarding jurisdiction and competence, which affect all areas of IP, in the interest of the final third and fourth provisions of this new law.

In this regard, it is worth noting an important modification related to the objective competence in order to understand any legal confrontation related to industrial property rights, by providing that the Mercantile Judge in the seat of the Higher Court of Justice of the Autonomous Communities in which the Governing Council of the Judiciary has agreed to exclusively provide knowledge about said matters

In Spain, according to the Agreement of the Permanent Commission of the Governing Council of the Judiciary, the responsibility of hearing these matters relating to industrial property has been exclusively given to specific Mercantile Courts, of Madrid, Barcelona and Valencia.

As mentioned in the Preamble of said Law, it intends to further explore the model of judicial specialization related to matters of industrial property rights, strengthening the model by concentrating the matters, which attributes objective competence to predetermined judges.

There are no significant modifications with regard to territorial competence, although it must be taken into account that if the territorial competent court does not have attributed competences to hear these matters, then any court, of any territory, will be competent, to which the hearing of these matters has been attributed, all of this at the choice of the plaintiff, and all of which is limited to obtaining judicial assistance in very few judicial districts in Spain.

There has also been an important modification related to periods for responding to an infringement or nullity claim of an industrial property right, in which the terms for responding to the claim have been extended from 20 days to 2 months. The same period will be applicable to the possible counterclaim lodged by the defendant.

This extension of periods to respond to the claim leads to the greater demand of this law to provide the expert reports to the claim or response to the claim that the parties wish to use, the application of the provision for the defendant of article 337 of the Civil Procedure Law being limited to providing expert opinions at a later time, whenever the corresponding relevant justification is provided.

As mentioned above, another important development that is considered in the new Patent Law and which is applicable to all areas of industrial property is the possibility of filing preliminary injunctions by the person who foresees an application of cautionary measures against them without prior hearing, who could appear before the judge they consider competent to hear said measures and justify their position, in which case the Judge will agree to the creation of proceedings of cautionary measures, which will notify the holder of the right so that they may file an application of cautionary measures within the period of three months.

It is also of interest to once again note the novel prevision of the new Patent Law in the process in which the validity of a patent is questioned, such that the Judge agrees to issue an expert report from the Spanish Patent Office so that a ruling is made in writing regarding the specific items in which the expert reports provided by the parties are contradictory.

With regard to utility models, the new Patent Law demands, in the acts of infringement of said rights, both in those requested subsequent to the entry into force of said law, the prior application, and contribution to the process, of the state of the art report provided for the patents, a provision of importance that will avoid legal acts based on a utility model right that lacks requirements that are legally established for its validity.

TRADE SECRETS

The Directive EU 2016/943 of the European Parliament and the Council recognizes that the protection of certain technical and trade developments and other information of the companies are valuable and can entail a competitive advantage, declaring specific acts related to the procurement, use and disclosure thereof as illegal, ordering the establishment of legal mechanisms to prosecute said behaviors, similar to how the actions are regulated, through civil proceeding, related to infringement of exclusive rights, and industrial and intellectual property.

The Spanish legal system currently has no regulatory law on trade secrets, notwithstanding its possible protection through the Unfair Competition Law or the Penal Code, since the infringement of secrets is provided for and sanctioned in said legal text, a lack of regulation that in the interest of the aforementioned Directive, will be concluded shortly by the enactment of a law, which will regulate not only industrial secrets, but latter and trade secrets under the generic name of business secrets, offering solutions to situations that did take place and were not properly resolved by the mechanisms established in our legal system.

Notwithstanding the fact that it will be very difficult to defend the information, especially technology, through said law, we understand that it covers an important gap for those industries that, for some reason or other, do not want or qualify for the protection that is conferred by the protection system of industrial or intellectual property rights, but whose interests can be adversely affected.

“It is expected a regulatory law in Spain for the protection of trade secrets, by virtue of the appropriate transposition to the Spanish legal system of the Directive EU 2016/943 of the European Parliament and the Council, of June 8, 2016 related to the protection of undisclosed technical knowledge and business information (trade secrets) against the illegal procurement, use and disclosure”

LATAM

ARGENTINA

The most notable change in Argentina is the approval, on January 11, 2018, of a New Government Decree that modified the prosecution of trademarks, patents and designs. This Decree included quite a few substantive changes aimed at simplifying and reducing the length of proceedings before public institutions. It was further developed by the National Institute of Industrial Property ("INPI"), which published Resolution No. 1/2018 partially implementing some of the resolutions of the mentioned Decree.

Amongst the many changes implemented by this Decree, and which were summarized in our Newsletter dated of February 2018¹, we believe the following ones are worthy of noting:

"A recent Decree, aimed at simplifying and reducing the length of administrative proceedings, has modified substantially some relevant aspects of Patent and Trademark prosecution"

- New opposition procedure in trademarks.
- The nullity of a trademark may be requested before the INPI.
- Also in relation to trademarks, the use of certain products/services in a class benefits them and others that could be considered related, even claimed in other classes, but not the rest of the services or products.
- It is not necessary to present a certified copy of the priority document or its translation in relation to patent applications, unless the examiner specifically requests it. Similarly, it is not necessary to provide the authorization, unless specifically requested by the examiner.
- Several of the processing periods of a patent are reduced with the implementation of this new regulatory framework (term to request and pay examination fees, deadline for the late submission of formal drawings, sequence listings, etc.).
- The submission of multiple design patent applications is permitted, included up to a maximum of 20 designs and models, so long as they belong to the same class within the Locarno Classification.
- Finally, from now on, it is possible to present observations of third parties against the request for utility models.

Other than this substantial new scenario, Argentina also increased their schedule of official fees, which in many cases exceeded 30%, introducing also a new official fee to request an accelerated patent prosecution.

¹ A copy of which is available in our website www.ungria.es

BRAZIL

Most of the developments which have occurred in Brazil are somehow related to the extensive back-log with which the Patent Office struggles. Although Brazil has a provision, granting a 10 year patent term as of the time of granting (irrespective of the earliest priority date of the application), the Brazilian authorities are aware that this backlog affects its competitiveness.

PROJECTS TO REDUCE THE BACK-LOG IN PATENT PROSECUTION:

One of the main issues which is currently being deliberated is the possibility of implementing a simplified process of patent examination to address the aforementioned back-log. On July 27th 2017, the Brazilian Patent Office (BPTO) published a public consultation, opening a period of gathering opinions from third parties in relation to this simplified process. This period ended on August 31st and no decision has been taken so far; therefore, it is understood that deliberations are ongoing. Apparently there are different interests being considered, although it seems that the project has the support of the Ministry. It seems prudent to affirm, even if only for the sake of argument, that the following options are being considered:

"The INPI is considering different options to reduce its back-log. One of them is to accept the granting of applications without substantive examination. The project was made public a few months ago. Comments from interested parties have been received and the INPI is now considering all possibilities".

It seems that the simplified process would not apply to divisional applications or certificates of addition and would concern only those unopposed patent applications whose maintenance fees are up to date and for which no official notification has been previously issued.

According to what would be the first option under consideration, the new process could apply to all patent applications for which a request for examination had been submitted before the date of publication of the Decree, and would exclude pharmaceutical and biotechnology patent applications. However, it seems that there may be a second possibility which would be applied to patent applications filed before 2015. Moreover, there may even be a third option which would be applied to all patent applications published at least 30 days before the publication of the corresponding resolution. This is all under discussion.

As the project currently stands, there is a possibility for applicants to opt-out of the process, have their applications examined and, also, interested third parties would have up to 90-days to file pre-grant oppositions after an application is pre-approved for an automatic grant.

Notwithstanding the outcome of the above project, Brazil has undertaken other measures related to the mentioned back-log.

“Brazil is considering a simplified patent examination process to reduce its back-log”



OTHER DEVELOPMENTS.

In addition to the above, the following developments merit mention:

1) The Brazilian Patent Office recently published Resolution No. 208, which entered into effect on January 2, 2018 publishing the Guidelines for examining inventions in the Chemical Field, confirming the aspects proposed in the draft issued for public consultation to which we refer in our Newsletter of October 2017².

2) Also, on April 12, 2017 the President of the Patent Office and the Director of ANVISA issued a joint communication which essentially conveyed that ANVISA would be entitled to give their opinion as to the patentability of applications, although this opinion would not be binding to the INPI.

“ANVISA’s role should be now limited to evaluate if a patent application is contrary to public health. They

could also file arguments from a patentability point of view but they should be considered as third-party observation”.

Following that resolution, ANVISA issued on August 8th resolution 168/2017 detailing further the process of “prior consent” for pharmaceutical patent applications.

3) Also, in 2017, the Brazilian Patent Office also issued a resolution requiring new procedures to register software in the country.

4) Finally, a Normative Instruction was issued to reduce and simplify the scope of the examination by the INPI, of technology transfer and IP license agreements.

² A copy of which is available in our website www.ungria.es

CHILE

UPDATE ON DIVISIONAL APPLICATIONS:

One of the most notable developments, from a substantive point of view, was the update of the patent guidelines in relation to divisional applications announced on November 2017. The most relevant changes are the following³:

“It is clarified that, in the event that a request could give rise to more than one divisional application, the Chilean Patent Office must verify that the original request is not found with a definitive resolution. If this is the case, any divisional requests that may arise, whether first or second generation, will not be able to benefit from the processing of a divisional application and INAPI will have, among other measures, the correction of the database, eliminating the mention “divisional”.

It is also clarified and established that since the divisional application is separated from the original application for the purposes of its examination, and retains the same priority of the latter, the same rules apply as for the original application to determine its validity, as well as for the payment of fees.

For the purposes of determining the payment of maintenance fees for divisional applications, the date of termination of the five-year or tenths of the original application is established. In the event that the processing of the divisional application takes more than a quinquennium or decade as appropriate, both periods must be paid together, once the divisional application is granted, which, incidentally, is the same procedure followed in respect of any request.

“In the event that a request could give rise to more than one divisional application, the Chilean Patent Office must verify that the original request is not found with a definitive resolution”

Finally, it is expressly stated that for the case that the original patent obtained an extension in the period of validity under the rules on Supplementary Protection, arts. 53 Bis 1 and following of Law 19,039, this extension will not be applicable to the divisional application(s) of the original application, since the allegation of any unjustified delays is related to the particularities of the processing and , in that context, with the requirement that was formulated and granted, if applicable, by the Industrial Property Court”.

³ <https://www.inapi.cl/sala-de-prensa/detalle-noticia/inapi-actualiza-las-directrices-de-examen-de-patentes>

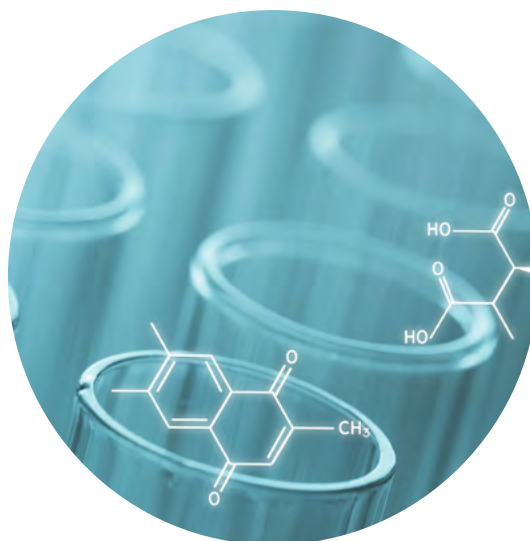
COLOMBIA

AMENDMENTS TO THE SINGLE CIRCULAR OF INTELLECTUAL PROPERTY OF COLOMBIA:

In 2017, the Superintendent of Industry and Commerce resolved to amend a few regulations of the Single Circular of Intellectual Property of Colombia. We summarize below some of the notable 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.

“Certain changes have been introduced in Colombian practice – For instance, voluntary amendments will now be subject to a fee”



ECUADOR

The most notable development in Ecuador is the implementation of a new legal framework, known as the **“Codigo Ingenios”** which derogates the former IP Law which had been in place for more than 18 years. Some of the main principles of this legal framework were (i) the right to share knowledge, (ii) to obtain cheaper medicinal products, (iii) to stimulate innovation in Ecuador, (iv) support and revalorize researchers and (v) guarantee the right of indigenous people over their traditional knowledge. This helps understand the many changes set forth, some of which are highlighted below: • Se amplía el requisito de actividad inventiva para una patente, añadiendo el requisito de que la invención confiera “una contribución técnica significativa”.

- The inventiveness requirement for a patent is extended, by adding as a requirement that the invention confers “a significant technical contribution”.
- The patentability of second uses is expressly prohibited. Similarly, the following are not considered inventions: salts, esters, ethers, complexes, combinations and other derivatives; polymorphs, metabolites, pure forms, particle sizes, and isomers of a known substance; genetic resources containing biological diversity and agro-biodiversity.
- The legal framework for inventions developed by employees has changed.
- New grounds to revoke a patent are offered: For instance, insufficient disclosure of the invention; non-supported claims in the description, etc).
- Amendments will be available until the administrative resolution.
- New formalities have to be met: the identification of the technological sector of the invention or the description of the state of the art technology.
- Compulsory licenses are substantially re-shaped. They may be conferred due to lack of use from the third year of the patent grant or from the fourth year after the filing, as long as the patent has not been used or if this was suspended for more than one year. They can also be granted based on reasons of “public interest” or as a consequence of anti-competitive practices.

IN RELATION TO TRADEMARK PRACTICE, THE MAIN CHANGES ARE THE FOLLOWING:

- A more complete list of the types of trademark that can be registered in the country is outlined, now expressly including sounds, smells, tastes, letters, numbers, colors, product forms, reliefs and textures, animations, holograms, among others.
- It includes the figure of Secondary Meaning for brands lacking distinctiveness, including for three-dimensional marks.
- The nullity of trademark procedure is reconsidered, with a term of 5 years in administrative proceedings for relative grounds, and an indefinite term for absolute grounds.
- It includes a new voluntary, non-contentious process of recognition of brand notoriety, in addition to that which exists within administrative processes before the Authority.

MEXICO

AMENDMENTS TO THE INDUSTRIAL PROPERTY LAW: EXTENSION OF THE TERM OF INDUSTRIAL DESIGNS.

The most relevant development in Mexico took place on March 13, 2018 when the amendments to certain chapters of its Industrial Property Law were published. Such modifications will enter into force on April 25, 2018.

One of the most relevant amendments is the protection term for Industrial Designs, which will change from a non-extendable 15-year term to a 25-year term, renewable every 5 years.

As such, the amended Article 36 of the Industrial Property Law (IPL) will now read:

“The registration of industrial designs shall have a term of 5 years, starting from the filing date of the application, renewable for consecutive terms of the same duration up to the maximum of twenty-five years, subject to payment of the relevant fee.

Registration of Industrial Designs and its renewals will be published in the Gazette of the Institute.”

Article 36 BIS of the IPL will read as follows:

“Renewal of the registration of an industrial design must be requested by the holder within six months prior to the expiration of its validity. However the Institute will process those requests that are submitted within the grace period to which refers to fraction II of article 80 of this law.”

“Applicants may request the extension of the protection term of designs from 15 to 25 years”



Given the above, the following should be noted:

• **PENDING DESIGN APPLICATIONS:**

With regards to the Design applications currently in prosecution, interested applicants can request to prosecute the Design application based on the recent amendments to the Law. Applicants will have a term expiring June 05, 2018 to file the corresponding writ requesting the change.

If the above change is requested, the Mexican Patent Office (MXPTO) can request re-filing documents, completing missing information, clarification or any other amendment required to continue the prosecution of the original Design application based on the amendments to the Law.

• **DESIGNS ALREADY GRANTED:**

For Industrial Designs (Design Patents) granted prior to April 25, 2018, these will keep the granted protection term until their expiration and shall continue paying the quinquennial or annuities, as applicable, according to the corresponding fees. These designs may be renewed for up to two successive periods of five years after their

“Acquired distinctiveness is also accepted as an exception to absolute grounds for refusal”

15-year expiration without the corresponding term of protection exceeding twenty-five years starting from the application filing date.

The first renewal request must be submitted within six months prior to the end of the original fifteen-year term in the terms provided in the Law.

Also, the Amended Law sets forth that design and utility model applications will be published after formal examination is complete (until now designs and utility models are only published once granted). After being published, the application will be open to public inspection.

On the other hand, it is worth mentioning also that the above mentioned amendment also includes relevant changes in relation to Appellations of Origin (“AO”) and Geographical Indications (“GI”). AOs were included in Mexico, in accordance to the Lisbon Agreement. However, GIs are conferred specific protection in Mexico, for the first time, pursuant to this recent amendment. Recognition of foreign AOs and GIs is also possible. A Declaratory Protection from the Mexican Patent Office will have to be obtained for AO’s and GI’s. Once an authorization of use is granted, it will expire in ten years, renewable for identical term; authorization which can also be invalidated or cancelled for non-use.

Finally, some changes in relation to trademark applications were also included. Among them, the following:

- Protection for non-graphic signs (i.e. smell and sound) is conferred in a broader manner and certification marks are recognized.
- Acquired distinctiveness is also accepted as an exception to absolute grounds for refusal.
- Consent and coexistence agreements are accepted unless when dealing with identical trademarks for identical goods or services.
- Class headings are no longer permitted. It will be required to specify the products and services described according to the Nice Classification.
- A Declaration of use will be required within the next three months after the third anniversary of the grant of the trademark; that use will be required in the class claimed in the trademark, not in other classes.

PERU

NEW FORMAL PROVISIONS FOR TRADEMARK REGISTRATION:

New articles have been drafted in the registration of TM's in Peru. These have a number of defining features which have come into effect as of June 2017. Article 2 states that if a power of attorney has already been registered in public registries, it can also be enforced before the INDECOPI. In addition to this, any information which may be lacking at the time of filing, such as representation of the mark, the express description of products and / or services or the proof of payment of the fee will result in no formal date of entrance being assigned. Article 13 of the regulation marks an interesting difference between the consequences of submitting a withdrawal of the claim and the withdrawal of a proceeding. In this way, the withdrawal of the procedure implies that the resolutions issued during the procedure of the procedure are rendered ineffective. On the other hand, the withdrawal of the claim means that the resolution has the same effects as declaring the claim denied or unfounded.

“Any information which may be lacking at the time of filing, such as representation of the mark, the express description of products and/ or services or the proof of payment of the fee will result in no formal date of entrance being assigned”

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