



## SPAIN JOINS THE PATENT LAW TREATY

Last 6 November 2013, the Patent Law Treaty (PLT) came into force in Spain. This treaty, administered by the World Intellectual Property Organization, aims to facilitate the formal requirements regarding the filing of patent applications and their processing while seeking further harmonization of the regulations applied by national patent offices. This should facilitate the obtention of patent protection abroad as well as reduce the costs for the applicant.

Among other things, the PLT permits to obtain a filing date for a patent application regardless of the language in which it is drafted. Nevertheless, it is subsequently necessary to provide a translation into the official language of the patent office.

With its accession to the PLT, Spain aligns with the vast majority of member states of the European Union and of the European Patent Convention, as well as with the European Patent Office itself, which is already implementing the PLT since the entry into force of the European Patent Convention 2000.

## NEW TRADEMARK LAW IN CHINA

On 30 August 2013, the standing Committee of the National People's congress of China adopted the third amendment to the Trademark Law, aimed at better protecting trademark rights. This new amendment will be effective from 1 May 2014.

Among the main changes, there is an increase in the penalties for trademark infringement. In this sense, the law provides the possibility of granting damages up to 3 million RMB (around Euro 375,000).

The simplification and shortening of the administrative procedures, the possibility of recognizing well known trademarks and the prohibition to register trademarks in bad faith have also been major changes.

It is expected that these improvements and modifications will help to improve the legal system for the protection and defence of trademarks in China.

## SESSION ON PATENTS IN THE IT FIELD

On 5 September 2013, Josep Mumburú, Head of our Patent Department, presented the session "Are patents suitable for my IT business?" at the PTV (Vallès Technology Park).



## NEW SPANISH OFFICIAL PATENT AND TRADEMARK ATTORNEY AT PONTI

Lawyer in the Trademark and Legal Department of Oficina Pontí, SLP, Ricardo Guerras has successfully passed the official qualifying examination to become a Spanish official Patent and Trademark Attorney.



## AGENDA / EVENTS:

01-04.12.2013

Asociación Interamericana de Propiedad Industrial  
ASIPI / Punta Cana, Dominican Republic

13-14.02.2014

Asociación Internacional para la Protección de la Propiedad  
Intelectual AIPPI (Spanish Group) / Barcelona, Spain

## THE EPO BECOMES MORE FLEXIBLE AND PRAGMATIC

New rules entering into force during 2014 will increase the ability of applicants to obtain protection for their inventions during prosecution of their applications before the European Patent Office (EPO). A new practice on divisional application filing and the possibility of having additional inventions searched for Euro-PCT applications lacking unity of invention may require applicants to reconsider their prosecution strategy in Europe.

### ***New regulation for divisional applications.***

New rules for filing European divisional applications will enter into force on 1 April 2014 and will apply to all divisional applications filed on or after that date. The change abolishes the cumbersome 24-month time limit of current Rule 36 EPC and returns to its old wording, which allowed divisional applications to be filed at any time as long as the earlier (parent) application was pending. At the same time, the EPO will introduce an additional escalating filing fee which will be due for divisional applications of second or subsequent generation. Such additional fee is meant to work as an economic deterrent to the strategy of filing a series of divisional applications. The new practice tries to address those aspects of the current system which are perceived as being negative, in particular, the difficulty for applicants and representatives to monitor the 24-month time limit.

The New Rule 36 EPC will have consequences for most currently pending applications, and even for those recently deemed to be withdrawn or refused, as it will be possible to file a divisional even if the time limit of 24 months has already lapsed. Therefore, we advise applicants to assess whether they should take measures to keep their applications pending until at least 1 April 2014 to benefit from the revised divisional application regulation. Such measures may include, for example, extending the period for responding an Office action or requesting oral proceedings if the examination is outstanding, filing a request for further processing or disapproving the text intended for grant and proposing minor amendments if the R. 71(3) EPC communication has already been received, or even filing an appeal against a refusal to restore the pendency of the application. In the latter case, it should be noted that a divisional application may be validly filed within the two-month period for filing a notice of appeal, even if such an appeal is never filed.



Mercè Vidal  
European Patent Attorney

### ***New practice to carry out additional searches for Euro-PCT applications lacking unity of invention.***

As from 1 November 2014, the new EPC regulation will permit applicants to obtain an EPO search for any invention forming part of the claims filed upon entry into the European regional phase.

Amended Rule 164(1) EPC will entitle Euro-PCT applicants to have further searches performed after having received an opinion by EPO on lack of unity of invention. In such cases, applicants will be invited to pay further search fees within two months from the communication of the non-unity opinion. If the applicant pays additional search fees, the EPO will draw up a supplementary European search report also for those parts of the application relating to the inventions in respect of which search fees have been paid.

Amended Rule 164(2) EPC will entitle Euro-PCT applicants to have further inventions searched in addition to those searched by the EPO when acting as ISA or SISA during the international phase. Along with an opinion on non-searched, non-unitary subject-matter, the EPO will invite the applicant to pay further search fees within two months from said communication. If the applicant pays additional search fees, the EPO will carry out an additional search and transmit the search results as an annex to an examining communication under R. 71(1) or R. 71(3) EPC. No search opinion will accompany the results of any of such further searches performed. A bonus of the amended R. 164(2) EPC is that it provides for a right to amend the application in response to the results of any further European search. This right is to be regarded as a limited exception to Rule 137(3).

The recently approved amended rule aims at establishing an equal treatment for direct European applications and Euro-PCT applications, irrespective of whether the EPO or any other authority acted as ISA or SISA. Amended R. 164(1) EPC will apply to applications for which the European search report has not yet been drawn up on November 1, 2014, while amended R. 164(2) EPC will apply to applications for which the examining division has not yet issued a communication on that date.

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