



SHALL WE ...COACH?

The Commercial Court no. 6 of Barcelona has cancelled the Spanish trade name registration 0266493 "AUTOCOACHING", registered in class 45 for personal and social services provided by third parties, after considering that the concept in question was a generic word. Our client, who owned and used a trademark containing the disputed word and was sued by the owner of the earlier sign for TM infringement and passing off, counterclaimed for cancellation of the trade name. In its findings, the Court backed the expert evidence in which it was highlighted that the word "coaching" had been added to the Spanish vocabulary as an anglicism, and was of common use in different professional fields such as sport, psychology or economics. The ruling also declared a proven fact that the concept was already in use in the late nineties and that only a few years later it expanded to other languages such as French in 2003 and Spanish around 2005.

THE NEW JURY OF DESIGN

Last June 30, 2011 the new Jury of Design was presented in Valencia, a new institution of national scope that will elaborate expert reports and act as a mediator or arbitrator in Intellectual Property conflicts related to industrial designs. This jury will have a mixed composition and will be integrated by several experts of the Design, Law and Consumers Area. The institution tries to emulate the success of the *Italian Giuri del Design*, today a reference entity for Italian judges in disputes regarding the genuineness of design creations.

NEW U.S. PATENT ACT

President Obama signed last September the Leahy-Smith America Invents Act (AIA). This Act represents the most significant change to the US Patent System since 1952. Its emblematic shift from the "First to invent" to the "First to file" system will align one of the major world players in the patent field with the majority of patent laws. Nevertheless, this should not overshadow other relevant changes such as the creation of the Prior Use Defense, the expansion of the opposition procedures and the recognition of a special status to micro-entities with reduced patent fees.



NEW INTELLECTUAL PROPERTY STRATEGIC SERVICES

Intellectual Property is much more than a patent, a trademark or a design; it is one of the most important business assets and does not end with the registration of a right. Oficina Ponti, SLP has developed new Intellectual Property Strategic Services to supplement other previous services set some months ago with great success.

OFICINA PONTI SLP AWARDED ON ITS 75TH ANNIVERSARY

On October 26, 2011, Day of the Barcelona Chamber of Commerce, Oficina Ponti received an award for its 75 years of professional career.

THE MONETIZATION OF INTANGIBLE ASSETS

Our firm, together with KIM BCN technological consultants, is organizing a conference series on the monetization of intangible assets. The first session was held at the auditorium of the Barcelona Chamber of Commerce on October 3, 2011. Alfonso Femenia, European Patent Attorney at Oficina Ponti, SLP, made a presentation on the main aspects for the qualitative assessment of patents.

AGENDA / EVENTS:

30.10.2011

Inter-American Association of Intellectual Property,
Santa Cruz. Bolivia

12.11.2011

Asian Patent Attorneys Association,
Manila. Philippines

PATENT HARMONIZATION: SPECIES TO GENUS AMENDMENTS

Harmonization and cooperation efforts are now everyday business in our globalized world of patents. They are conducted by major patent offices and take many legal forms: administrative regulations under the PLT, international cooperation under the PCT, mutual recognition of search results and enhanced cooperation. Patent examiners and specialists around the world meet more often than ever, their databases are easier to access and their files can be inspected on-line.

Not surprisingly, efforts towards substantive harmonization are slowly showing results. Recent examples of such undertakings include the new patent bill signed in the US this last September (America Inventor Act). The US has now adopted the first-to-file principle, namely that the exclusive right belongs to the first inventor to file a patent application, as the former interference proceedings were cumbersome and almost invariably ended with the party having the most and best lawyers winning the case. Additionally, a new post-grant review procedure will be available. It seems very much inspired by the EPO opposition procedure. New inter partes review and a revision procedure are introduced to avoid the perils of inequitable conduct. It is quite clear that the American legislator is making this law a bit more "European".

And what are the Europeans up to? Probably the efforts spent with the Unitarian patent at its present form under enhanced cooperation take up most of their lobbying energy. One could say from a European perspective that the implementation of EPC 2000 is still in full swing and we need to wait a few more years just to realize how far the new legislation can go and what new problems it will bring about. Concerning forgotten topics, many of us believe that we are far away from knowing the contents and limits of what constitutes an implicit disclosure, let alone from achieving international harmonization on the matter. For instance, Rule 40 EPC 2000 allows an application without claims to obtain a date of filing before the EPO. Although this was a direct consequence of international obligations under the PLT, the post-EPC 2000 applicant could fall into the trap of believing that the filing of a scientific paper a few hours before disclosure would be a good strategy.

In fact, embodiments in scientific papers normally contain all sort of details and elaborated sets of parameters that



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can only support very restrictive features. These latter preclude, according to the ubiquitous Art. 123(2) EPC, any (intermediate) generalization. The EPO standard requires amendments to be directly and unambiguously derivable from the application as originally filed. Moreover, when confronted with subject-matter only present in figures, it is virtually impossible to extract features individually: the examiner will almost inevitably object to added subject-matter. This very strict standard has constituted a pillar in examination for a number of years and is well reflected in the EPO guidelines for examination. On the contrary, the USPTO practice, based on 35 USC paragraph 132(a) and related MPEP texts, is apparently more lenient. The person having ordinary skills in the art is someone who could accept generalizations as being implicit and inherent features and not adding new matter. Rephrasing parts of the description is not considered as introducing new matter if the original meaning is retained.

However, if we look close enough, the doctrines (guidelines) across the Atlantic share some common ground. The situation comes nevertheless from an unexpected source, namely from objections arguing that the whole scope of a claim must be supported by the description. Objections of lack of support normally happen when only limited examples and embodiments are present in the application and very broad claims are drafted. American examiners seem happy in situations where the skilled person can name examples to cover the full scope of a general claim, even if said examples have not been mentioned before. Along the same line, the EPO finds that an embodiment concerning parameters of two lists may be considered as implicit in the prior art if the two lists have few possibilities (species).

Thus, if the skilled person finds a number of very limiting embodiments, he should theoretically be able to find a general term or genus without contravening the principle of Art.123(2) EPC. In practice, this establishes a bi-univocal relationship between the genus and species that may be subsumed to a generalization process. It would thus be possible to predict that, if both the EPO and the USPTO continue moving along these lines, substantive harmonization in examination may be easier than expected.

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