



THE IMPACT OF TRADEMARKS ON ECONOMY AND SOCIETY

On 21 November 2012 the report *Impacto de las marcas en la economía y la sociedad españolas* ("The impact of trademarks on Spain's economy and society") was presented. Prepared by the University of Alicante at the request of the Spanish Patent and Trademark Office (OEPM) and the National Association for the Defense of Trademarks (ANDEMA), this report quantifies the impact that an active trademark policy has on different parameters such as employment rates, R&D, exports or taxation. Over 300,000 companies were surveyed for this study.

The results show that in the trade sector, trademarks are directly responsible for 60% of the sales turnover, 45% of Spanish exports, 33% of the employment rate in companies and 55% of the investment in R&D. In these bitter days of economic downturn, these figures show how connected brands and competitiveness are. The two sides of a coin called Added Value.

THE UNITARY PATENT KEEPS THE PACE

24 countries in Europe have recently signed the International Agreement on the Unitary Patent Courts. On February 19, all EU states except Spain, Poland and Bulgaria staged with "pomp and circumstance" the signature of the Agreement that took place in Brussels witnessed by the European Commission. The process will now continue with the ratification in the respective national parliaments.

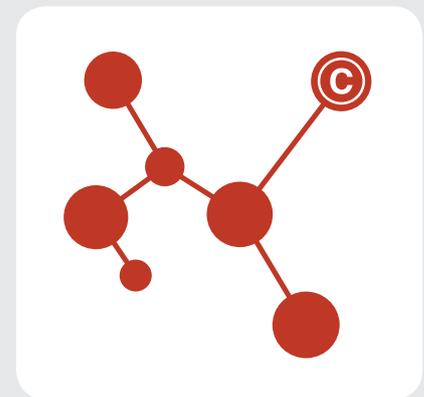
In this long story, Italy has now signed this agreement, which is one of the pillars of the so-called Patent Package needed to establish a Unitary Patent System. Nevertheless, this means only that traditionally validated European patents will be enforced in Italy before the unitary patent courts, but not that the upcoming unitary patents will have full effects without further translation requirements in this country. Spain, the other opposing party against the whole system, is awaiting the imminent outcome of its appeal before the ECJ.

SPANISH IP ATTORNEYS ASSOCIATION



Joan Salvà, Operations Manager of Oficina Ponti, SLP has been elected a member of the Board of Directors of COAPI, the Spanish IP Attorneys Association, in representation of the Catalan branch of the profession for the next two years.

MASTER IN BIOTECHNOLOGY FOR THE CHEMICAL AND PHARMACEUTICAL INDUSTRY



Between February 11 and 15, 2013. Rafael Moreno, EPA and MSc. (Chemistry), lectured the IP module of this advanced one-year program organized by the IUCT (Science and Technology University Institute) at its premises in Barcelona.

AGENDA / EVENTS:

22-25.04.2013 Bio International Convention / Chicago, US

01-03.05.2013 CEIPI Tutor's meeting / Strasbourg

04-08.05.2013 International Trademark Association, INTA / Dallas, US

ENLARGEMENT OF THE EU AND CTM/CD SYSTEMS

Next 1st July 2013, the European Union (EU) will be enlarged for the seventh time since the establishment of the European Community back in 1957.

The last enlargement took place on 1st January 2007, when two new Member States, Bulgaria and Romania, entered the EU. Next July 1st, the new Member State entering the EU will be Croatia.

The Office of Harmonisation for the Internal Market (OHIM) was established in 1994. This EU agency acts as an Intellectual Property Office which handles the procedures concerning Community Trademarks (CTM) since 1996 and Community Designs (CD) since 2003. The number of applications for CTMs and CDs has increased year after year since their establishment. In 1996, the OHIM received 43,700 CTM applications and in 2012 there were 107,925. The total number of CTM applications filed between 1996 and 2012 amounts to 1,140,259. As for CDs, in 2003 there were 4,500 applications filed, and 83,079 in 2012. The total number of CD applications filed between 2003 and 2012 was 690,075.

The accession of these new Member States has had several consequences on the CTM and CD systems. However, from our point of view, the most important effect is the automatic extension of those Community rights filed before the date of accession to the territory of the new Member States. This means that the owners of Community rights will not have to take any action or pay any additional fee in order to have them extended to the new Member State(s).

The other side of the story is represented by the owners of national rights in the new Member States. In order to protect themselves, they can prohibit the use of extended Community rights in the territory covered by their prior national right, provided that it has been registered or applied for before the date of accession and that it has been acquired in good faith. The extended CTM would then be valid in all Member States, but its use would be prohibited in the new Member State.

As regards examination and cancellation procedures of CTMs, absolute grounds of refusal which become effective after the enlargement will not be applied in respect of extended CTMs; only the situation prior to enlargement will be taken into account (grandfathering clause). However, those CTMs consisting of a descriptive, non-distinctive or generic terms in the language of the new Member State(s) and for the territory of the new Member State(s)



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will be able to rely on article 12 CTMR to defend themselves from actions on the basis of extended CTMs.

As to relative grounds for refusal of CTMs, it will not be possible to oppose or file an invalidation action against an extended CTM on the basis of an earlier national right acquired in a new Member State(s) prior to its date of accession. The only exception to this general rule applies to CTMs filed within the six-month period prior to the date of accession. In the next enlargement to Croatia, this exceptional period corresponds to CTMs filed between 1st January 2013 and 30th June 2013.

Moving on to CDs, the accession of a new Member State will not change the grounds for non-registrability of the designs. The grounds for invalidity after registration of a CD will only be affected by the accession of a new Member State in a limited number of situations: (i) a prior national design disclosed after the filing of the CD or (ii) a conflict with an earlier national right. When the grounds for invalidity become applicable only as a consequence of the accession, article 110.a.3) CDR will grandfather the extended CD.

Taking all the above into consideration, we understand that the enlargement of the EU should definitely be considered as an extra advantage for anyone interested in applying for a trademark or a design in more than one Member State. Indeed, the Community system reduces the costs and simplifies the procedure, as it is only necessary to file a single application in order to cover all Member States (currently 27 countries and 28 from July 1st). Moreover, and assuming that the current rules will not change in future enlargements, it would also mean that the Community rights would be automatically extended to any new Member State from its date of accession. However, the Community system has also a con that cannot be ignored: if the Community right is denied or cancelled, the denial or cancellation will affect the complete EU en bloc. This means that the owner of a Community right could face the possibility that the owners of prior rights in all the Member States could challenge its registrability and/or validity. Therefore, when opting for the Community system, it is highly advisable to start by running a prior rights search before filing an application. This can anticipate any possible obstacles and permits establishing the best protection strategy in every case.

Anyway and to sum up, the Community system must always be considered an option in a global IP strategy when the objective is to protect trademarks and/or designs in more than one Member State.

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