



NEW DRAFT OF INTELLECTUAL PROPERTY LAW

The draft bill was approved on February 14 by the Council of Ministers and will now begin its parliamentary proceeding.

There is one single meeting point among all business and social sectors involved: the current regulation is behind the times and has been remarkably unable to tackle the challenges of the digital era. Apart from that, there is much controversy and disagreement, as one may expect when it comes to finding the balance between the creators' legitimate interests on the one hand and the right of the general public to access culture on the other.

The project faces many battlefronts, but the main contested lines are the reduction in the scope of the exception for private copies, putting a curb on the massive infringement of rights in the P2P networks, a new regulation for rights management entities and the introduction of a compensation for the use of snippets by online news aggregators and search engines (i.e. Google).

MAJOR COUNTERFEITING GANG BUSTED BY LAYCA

A combined macro operation carried out by the Spanish and Portuguese polices last December under the name LAYCA has put an end to the largest active network of clothing counterfeiting in the Iberian Peninsula.

The operation has resulted in the detention of nearly 100 people and the intervention of more than 1.000.000 counterfeit products. The network was based in Morocco but its center of production was located in Portugal, with 10 factories supplying products which were later shipped to local resellers in Spain.

The business turnover that these products would have generated has been estimated by officials in around 5.5 million EUR. It has also been reported that the gang could have distributed 235 tons of counterfeit clothing and footwear over the last two years.

3rd CONTEST ON PATENT BUSINESS PLANS

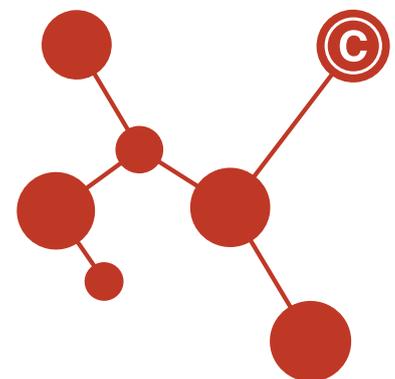
Oficina Ponti, SLP sponsors a new edition of VALORTEC contest on patent business plans and technology-based companies organized by the Catalan Government together with the main universities of Barcelona area. The awards ceremony took place on 26 March 2014.

The purpose of this contest is to promote IP awareness not only from the conception of the invention, but also up to its final commercialisation.

IP TRAINING SESSIONS AT IUCT

The Graduate Institute of Science and Technology (IUCT) hosted a new edition of its Master degree course in Biotechnology applied to the pharmaceutical industry.

Rafa Moreno, European Patent Attorney, was in charge of the IP related modules, namely patents and licensing.



AGENDA / EVENTS:

10-12.04.2014 Fédération Internationale des Conseils en Propriété Industrielle. FICPI. Symposium. Kyoto, Japan

10-14.05.2014 International Trademark Association. INTA. Annual Meeting. Hong Kong. SAR.

USE, BUT WHAT USE?



Imma Miralles
Lawyer

The recent judgment of the General Court of 21 November 2013 in case T-524/12 has come to confirm and acknowledge a widespread practice among intellectual property lawyers in administrative proceedings before the OHIM.

This judgment reaffirms the OHIM's Decision dated 29 September 2012 regarding the appeal filed by Certino Mode S.L. against the Decision of the Cancellation Division on which the Community trade mark no. 734.343 "RECARO" had been fully revoked.

At that time, the Board of Appeal established that, pursuant to article 76(2) CTMR on the submission of new evidence on appeal:

"The Office may disregard facts or evidence which are not submitted in due time by the parties concerned".

However, the Board enjoys discretion to decide - while giving reasons for its decision - whether or not to take such information into account if the material which has been produced late is likely to be relevant to the outcome of the proceedings.

In this sense, Rule 50(1) CTMR provides:

Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings mutatis mutandis.

Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 76 (2) of the Regulation.

That rule applies whenever an appeal is directed against a decision of the Opposition Division, but the Board finds that it can also apply mutatis mutandis if an appeal is directed against a decision of the Cancellation Division.

In applying this Rule, the Board has the discretion to take into account additional or supplementary facts and evidences, as in this case.

In the exercise of that authority, it should consider the stage of the proceedings at which the late submission takes place.

In this case, the Board of Appeal argues that the additional evidences filed with the appeal complement the proof

submitted before the Cancellation Division, and that they were filed in response to the conclusions of the contested Decision. Therefore, the evidences filed in the appeal were taken into account by the OHIM.

The Fourth Chamber of the General Court considers that Article 76(2) is applicable to all types of proceedings before the OHIM and that there is no distinction between opposition and revocation proceedings.

In applying this degree of discretion to accept or not facts and evidence produced late, the Board of Appeal must provide the reasons on which its decision is based.

With regard to the statement of reasons, the Court considers that it is sufficient with an overall assessment by providing a summarized and clear statement and the factual circumstances on which the Board of Appeal bases its decision. It is not necessary to explain the probative value of each item of evidence.

The evidence required in order to prove effective use must consist of indications concerning the place, time, extent and nature of use of the trade mark for the relevant goods and services.

In revocation proceedings it is the owner who must prove the effective and genuine use of the Community Trademark; such "genuine use" cannot be proved on the basis of probabilities, it must be demonstrated by objective evidences of effective and sufficient use of the trademark in the market. The "genuine use" must be consistent with the essential function of a trademark to guarantee the identity and the origin of goods and services to the consumers.

In this sense, the Court confirms the arguments of the Board of Appeal considering that each piece of evidence must not be analysed separately, but together. A separate assessment of the various relevant documents, each considered in isolation, is not appropriate.

In view of all the above, it is obvious that registering a trademark is as essential as the effective use of that trademark by the applicant as soon as the trademark is in force.

The General Court leaves no room for ambiguous interpretations in case of late filing of additional evidence in proceedings before the OHIM.

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