



THE SPANISH PATENT SYSTEM MOVES FORWARD

The Draft Law of the new Patent Act follows its way. Last April, the Spanish Council of Ministers passed the final Draft, which is supposed to be discussed in parliament during 2015. The time limit to have the Law enacted is December next year, as it coincides with the end of the current election term.

The project marks a major shift in the Spanish patent landscape and aligns the national system with our environment, namely the European Patent system. The two milestones of the project are the introduction of substantive examination for all patent applications, up to now this was possible for certain technical fields and always upon request by the applicant, and a post-grant opposition system.

TRADEMARKS ON THE MOVE

The European Trademark and Design Network (ETMD), a joint initiative of national and regional IP offices across the EU is adopting a set of common practices aimed at harmonizing the interpretation of certain aspects of different European TM Laws and what's more, the subsequent scope of protection granted to these rights.

The project will cover seven different topics of TM Law and up to now, five of them have been already addressed. Questions such as the protection of black and white marks, the acceptability of certain classification terms for the purposes of the description of products and services or the assessment of the likelihood of confusion by TM Offices may end up having a direct impact on the strategies to be followed by the applicants from now onwards.

Much has to be said about the legal binding effect of this set of common practices, but the truth is that applicants should start considering not only what they are going to do with their future trademark applications but also to which extent the scope of protection of their registered marks remains at safe harbor in the light of these projects.



THE ALIMENTARIA HUB Fira Barcelona

Last May, Oficina Ponti SLP led a panel discussion on the importance of TM protection during the celebration of *Alimentaria*, one of the most important world trade fairs for the Food and Beverage Industry. The Head of our TM team, Anna Jarques, together with some of our clients from the food industry discussed with the audience examples of good (and bad) trademark practices for a growing industry that can't afford to stay away from IP protection.

TRAINING IP SESSIONS AT THE SPTO

The Spanish Patent and Trademark Office together with EOI Business School organized the 4th edition of the course on Advanced Patent Formalities. Our colleague Josep Mumbú, European Patent Attorney, addressed the topic "Patent drafting for international applications".

AGENDA / EVENTS:

23-26.09.2014 European Brand Owners Association. MARQUES. Copenhagen. DK.

08-12.11.2014 Asian Patent Attorneys Association. APAA. Penang. Malaysia.

30.11-13.12.2014 Asociación Interamericana de Propiedad Intelectual ASIPI. México DF.

KEY CHANGES INTRODUCED BY THE NEW TRADEMARK LAW IN CHINA

On 1 May 2014, the long awaited amendment to the Chinese Trademark Law passed on 30 August 2013 entered into force, introducing the following key changes.

Multiclass applications:

Multiclass applications are now admitted in China, which will facilitate the administration of trademarks. However, the new law only allows an application to be split in the event of an objection to the goods and services raised by the CTMO (and not in the event of an opposition).

Additionally, since China follows a subclass system and the CTMO is very strict with the class specifications, it is very important to seek advice on the best protection for your trademark in every case.

Simplification of procedures:

The new law includes time limits for the different stages of examination during prosecution.

Therefore, under the new law, trademark applications would mature into registration within 15 to 18 months from the application date.

The new law does not yet regulate time limits for suspension of pending applications on the basis of prior rights. Therefore it is highly advisable to conduct prior searches before filing a trademark application in China.

The time limits for issuing a decision in cancellation (9 months after receipt of the application, extendable by 3 months under special circumstances) and opposition (12 months from publication) procedures have also been regulated.

Clarification of the recognition of well known trademarks:

The Trademark Office may recognise the well known character of a trademark during the examination process or the enforcement action, upon request of the concerned party and based on a case by case basis.



Anna Jarques
Spanish Patent
and Trademark Attorney

Also the Trademark Review and Adjudication Board (TRAB) and the Courts may recognize well known trademarks in their procedures. The new law also prohibits the use of well-known marks as an advertising tool.

Prohibition to applications in bad faith:

The law establishes a prohibition to apply for a trademark which is similar to a third party's pre-used and unregistered trademark when the applicant is fully aware of this trademark because of a previous business relationship. Under the new regulation, the relationships are no longer restricted to those with the "agent" or "representative".

Increase of Damages for Trademark Infringement:

In case of trademark infringement, the amount of damages shall be the loss suffered by the trademark owner. If this loss cannot be determined, the profits earned by the infringer shall be considered.

If this is still hard to determine, the damages could be the license fee. If the amount cannot be determined by any of these methods, the court shall decide on the amount of the damages, which shall be less than RMB 3 million (EUR 375,000). Under the current law, the maximum amount of awarded damages has been RMB 500,000 (EUR 60,000).

If the infringement involves bad faith, and if serious circumstances concur, the amount of damages can be one or three times the amount determined by in any of the methods.

Therefore, we can conclude that the new trademark law strengthens the legal protection of trademarks in China, which is good news for trademark owners in this country. However, we are awaiting further implementing regulations of this new trademark law, which should introduce more clarity in some of the recently regulated matters.

Experts in Intellectual
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