



Newsletter March 2013

TRADEMARKS

CROAZIA JOINS EUROPEAN UNI

On 1st July 2013, Croazia will join the European Union and become the 28th Member State.

Further the accession of Romania and Bulgaria on January 2007 and ten Member States on May 2004, this event will have as a consequence the automatic extension to Croatia for holders of Community trademark registrations and Community trademark Designs.

The enlargement of the European Union will not request either the respect of any formality or any cost for the owner of Trademark and Design registrations and applications. Community trademark applications filed between 1st January 2013 and 30th June 2013 can be subject to oppositions based on earlier rights in Croatia.

USE OF A REGISTERED TRADEMARK IN DIFFERENT FORMS: COURT OF JUSTICE CLARIFIES THE CONCEPT

The Court of Justice of the European Union has confirmed that it shall be regarded as genuine use of a trademark the use of a Community trademark in a form differing in elements which do not alter the distinctive character of the trademark in the form in which it was registered (in Case C-553/11 of 25th October 2012).

We remind that trademarks' owner may file a revocation action if, within a period of five years following registration, the proprietor has not put the Community trademark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years (art. 51 EC Reg. No. 207/2009).

The proprietor of the national trademark "PROTI" brought an action seeking cancellation of the later trademark "Protifit", registered for food supplements, vitamin preparations and dietetic foodstuffs, and prohibition of use of that trademark, relying on the rights deriving from his earlier trademarks "PROTIPLUS" and "Proti Power". All these trademarks are registered for, among other things, protein-based products.

The defendant argued that the plaintiff had failed to put the trademark "PROTI" to genuine use.

The plaintiff replied that its use of the terms "PROTIPLUS" and "PROTI POWER" constitutes use of "PROTI" in a form which does not alter its distinctive character.

Having both the court of first instance and the court of appeal dismissed the plaintiff's action, he brought an action before the Federal Court of Justice which decided to stay the proceedings and refer the questions on the interpretation of use of the trademark in a form which does not alter the mark's distinctive character to the Court of Justice of European Union for a preliminary ruling.

The Court confirmed that in case of family trademarks, "the proprietor of a registered trademark is not precluded from relying, in order to establish use of the trademark, on the fact that it is used in a form which differs from the form in which it was registered, without the differences between the two forms altering the distinctive character of that trademark, even though that different form is itself registered as a trademark". Therefore, use of PROTIPLUS and PROTI POWER could be regarded as genuine use of the PROTI trademark, even though PROTI was also registered.

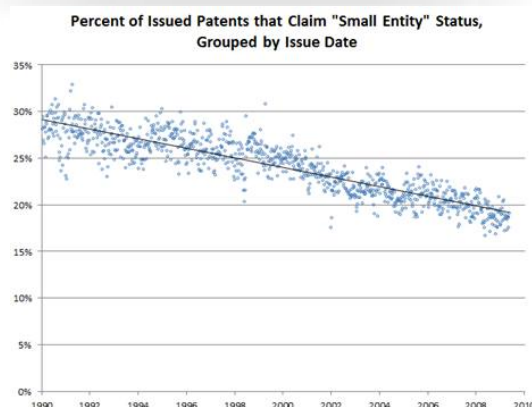
The decision brings the attention of trademarks' proprietors to **keep updated records of use and consider re-filing where trademarks are being used in a way that alters their distinctive character.**

In any case, it is advisable an opinion of a consultant specialized on the matter in order to ascertain whether a trademark, which is altered in some element to adapt it to marketing and promotion requirements of the goods or services concerned, may be considered still protected by the registration or it is a better solution to re-file the trademark.

PATENTS

NEW FACILITATION IN USA FOR PATENT HOLDERS

It is well known that in the United States an applicant for a patent application can take advantage of its status as a small entity to achieve reductions in fees. Below is a chart showing the number of U.S. patents granted to someone who was granted the status of small entity (source Dennis Crouch's Patently-O).



Currently, the small entity, and its economic benefits, is granted provided that:

- The owner is a "person" (i.e. one or more natural persons) who has not assigned, granted, transferred, or licensed, and has no contractual or legal obligation to assign, grant, convey, or give license, the rights to the invention;
- The owner is a "small business." According to SBA regulations, this means that the owner, including affiliates, has less than 500 employees and the owner has not assigned, granted, transferred, or licensed, and has no contractual or legal obligation to assign, grant, transmit, or license of, any rights on the invention;
- There is a non-profit organization (regardless of size), including institutions of higher education, which has not assigned, granted, transferred, or licensed, and has no contractual or legal obligation to assign, grant, convey, or license, any rights on the invention;
- The owner has transferred or licensed the rights, or has an obligation to do so, he can still obtain the status of small entity, provided that each third party individually meets the requirements listed here.

Shortly a new micro entity status will come into force, which looms as additional benefits. We suggest to keep in mind this opportunity, which we will comment as soon as the final implementing rules will be clarified and defined.

IN USA FIRST-TO-FILE STARTS

The patent system of the United States goes from a system where it mattered who was the first inventor (first to invent) to a system (such as the European or Italian one) in which it matters who is the first to apply for a patent (first to file).

The First-to-file will take effect from the 16th, March 2013.

It is a revolution which will mean for the American holders the abandonment of old habits, and the race to the American Patent Office. Although in the U.S. there is the possibility to file low-cost and fast Provisional Applications, the fact remains that the filing date will count. So, even a provisional application must be well written and technically complete.

ANOTHER STEP FORWARD FOR THE EUROPEAN PATENT

The creation of a Unified Patent Court (UPC) has been sanctioned by an international agreement signed on 19 February in Brussels. Not only it starts the Unified Patent Court, but forms the basis for the future Unitary European patent.

In the current system the national courts and institutions of the Contracting States to the European Patent Convention (EPC) are called to decide on infringement and validity of European patents. In practice, when a patent holder enforces it in several countries, not only he incurs in high costs but decisions can vary. In short, there is no legal certainty.

The agreement on the Unified Patent Court tries to solve the above problems by creating a Unified Patent Court specialized with exclusive jurisdiction in any dispute relating to European patents and European patents with unitary effect (unitary patents).

Although the agreement was signed, it has yet to be ratified by 13 countries (of which at least the United Kingdom, Germany and France) before it can enter into force.

It is interesting to note that Italy, who has renounced the unitary patent and is (together with Spain) currently active to challenge its legitimacy, signed the Agreement on the Unified Patent Court. This means that if the Agreement comes into force, the "traditional" European patents validated in Italy are under the responsibility of the new Unified Patent Court.

MISCELLANEOUS

A lot of organizations are familiar with generic name extensions of top-level domains (gTLD or Top-Level Domain) such as .com, .org and .net. However, last year, ICANN (Internet Corporation for Assigned Names and Numbers) has offered to third parties the opportunity to apply for registration of new top-level domain extensions like ."brand" (e.g. .cb_firm or .fiat) or ."generic term" (e.g. .shop. or .tree) or ."geographical location" (e.g. .london or .milan).

Nearly 2,000 applications for new TLDs have already arrived!

This expansion in the number of TLDs will forever change the Internet as we know it.

With hundreds of openings TLD names provided by the end of 2013, brand owners need to determine which of the new TLDs may be relevant to their company and their brand.

We will be happy to give you the necessary advice and to define the right business strategy.