

MARCH 2020

ISSUE: XV.

ECTA BULLETIN

46 PAGES

INSIGHTS OF THE EUROPEAN COMMUNITIES TRADE MARK ASSOCIATION

IP LEGEND: JEAN CHARRIÈRE

BY

ISABEAU HARRETCHE

U.S. AND EU CUSTOMS
ENFORCEMENT OF
COUNTERFEIT GOODS –
STATISTICS AND TRENDS

REPORT BY

JAMES BIKOFF

PIETER VAN DER WEES

Amager Bakke in Copenhagen, Denmark, is a power plant and ski slope in a building. The roof is a recreational park, where you can, among other things, ski. Inside is ARC's energy plant and head office.

Contents

1. Introduction [3.]

2. Editorial board [4.]

3. Committee Section

3.1. Committee reports [5.]

4. Reports

4.1. Collective and Guarantee or Certification Marks in EU Member States [16.]

4.2. Implementation of the Trade Marks Directive: The Use of a Sign as a Trade or Company Name [18.]

4.3. IPR and Sustainability [20.]

4.4. U.S. and EU Customs Enforcement of Counterfeit Goods – Statistics and Trends [22.]

5. New Members [26.]

6. Interviews

6.1. IP Legend: Jean Charrière [28.]

7. Articles

7.1. Design Patent Applications in Mexico and Their New 'Play' GAME Rules [30.]

7.2. Spanish Trade Secrets Law Enters into Force [32.]

7.3. Can Internet Providers Be Considered as Intermediaries? Lithuania's Point of View [34.]

7.4. Russia Establishes Geographical Indications as a New Form of IP [36.]

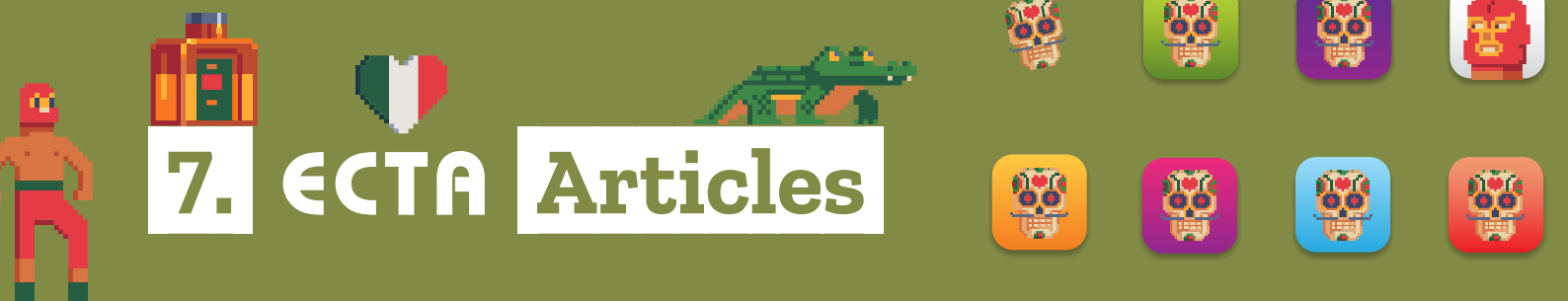
8. Case Law Reports

8.1. No Design Protection for Iconic Designs? The European General Court's Decisions 'PORSCHE' [38.]

8.2. Combit vs. Commit [42.]

8.3. Koton vs. EUIPO – You Act in Bad Faith When You Try to Undermine a Third Party's Interests or Have No Intention to Use Your Mark [44.]

Enjoy !



AUTHOR:

Andrés Esteva

Partner

Panamericana de Patentes y Marcas

andres_esteva@ppm.com.mx

VERIFIER:

Mariano Soni

Partner

Bufete Soni

sonim@soni.mx

MEXICO RECENTLY AMENDED ITS INDUSTRIAL PROPERTY LAW, INCLUDING, BUT NOT LIMITED TO, CHANGES FOR DESIGN APPLICATIONS, TRYING TO BRING FURTHER CLARITY TO DESIGN PROSECUTION.

Patent design prosecution in Mexico is more akin, at least in its prosecution, to US Patent Design prosecution, where substantive examination is carried out. Mexican law divides patent design applications into industrial drawings and industrial models, the first being a two-dimensional representation of lines, colours and patterns which may be reproduced in a three-dimensional model, whereas the second is the three-dimensional model per se. Formerly, Mexican law required that design patents needed to be novel and capable of industrial application. Novel designs were

those of independent creation and differing in significant grade from known designs or combinations of features of known designs. Further definitions were not provided. The new law is intended to define what independent creation and significant grade should be.

Independent creation is now defined as one in relation to which no other identical design has been made public before the filing date of the application or its recognised priority date. Identical designs are considered to be those whose features differ only in irrelevant details. Significant grade is defined as the general impression that a design creates to an expert in the field, which general impression must differ from the general impression created by any other design made public before the filing date of the application or the recognised priority date, considering the degree of

freedom of creation which the designer had for the creation of the industrial design. While the proposed changes bring clarity, there are still some parts of the law which remain vague. For example, what precisely are irrelevant details and who should determine what irrelevant is? It is clear that the relevancy of a design will differ from mind to mind. Furthermore, it is inferred that the degree of freedom, is defined by the prior art. Therefore, if there is a plurality of prior art documents, then any contribution over all the prior art, however insignificant it may seem, should be allowable regardless of how similar the rest of the shape of the design is. However, what is the degree of freedom and who defines the parameters of the degree of freedom? Again, should it be the skilled person defining those parameters of degree of freedom and how subjective will those parameters be? While the above-mentioned changes have good intentions, the game rules to be applied to these new aspects of Mexican law remain uncertain. So far, while there have been objections based on these amendments, there has been no statement about these questions by the Mexican Patent and Trademark Office (MXPTO). Another change to the law is that design application prosecution is now carried out on the same basis as that for utility patent prosecution, with the exception of certain Articles of Chapter II, among other Chapters. Among the changes is reference to Art. 17, stating that, to determine the novelty and

freedom of creation which the designer had for the creation of the industrial design.

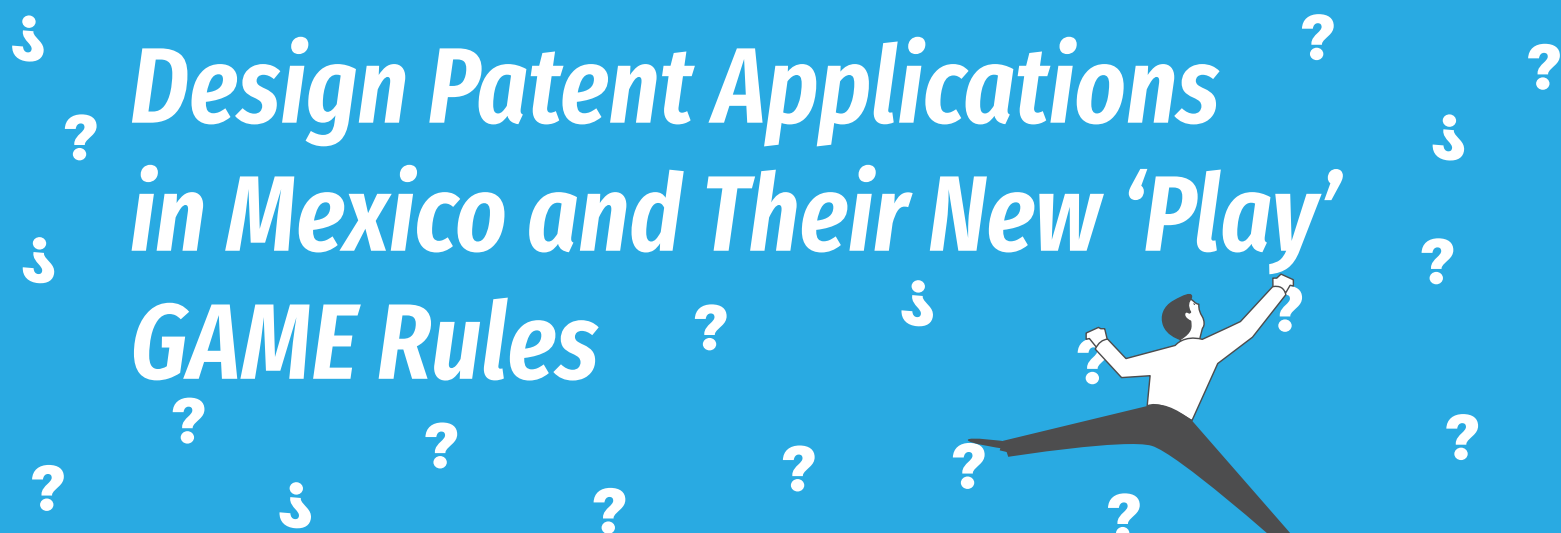
While the proposed changes bring clarity, there are still some parts of the law which remain vague. For example, what precisely are irrelevant details and who should determine what irrelevant is? It is clear that the relevancy of a design will differ from mind to mind.

Furthermore, it is inferred that the degree of freedom, is defined by the prior art. Therefore, if there is a plurality of prior art documents, then any contribution over all the prior art, however insignificant it may seem, should be allowable regardless of how similar the rest of the shape of the design is. However, what is the degree of freedom and who defines the parameters of the degree of freedom? Again, should it be the skilled person defining those parameters of degree of freedom and how subjective will those parameters be?

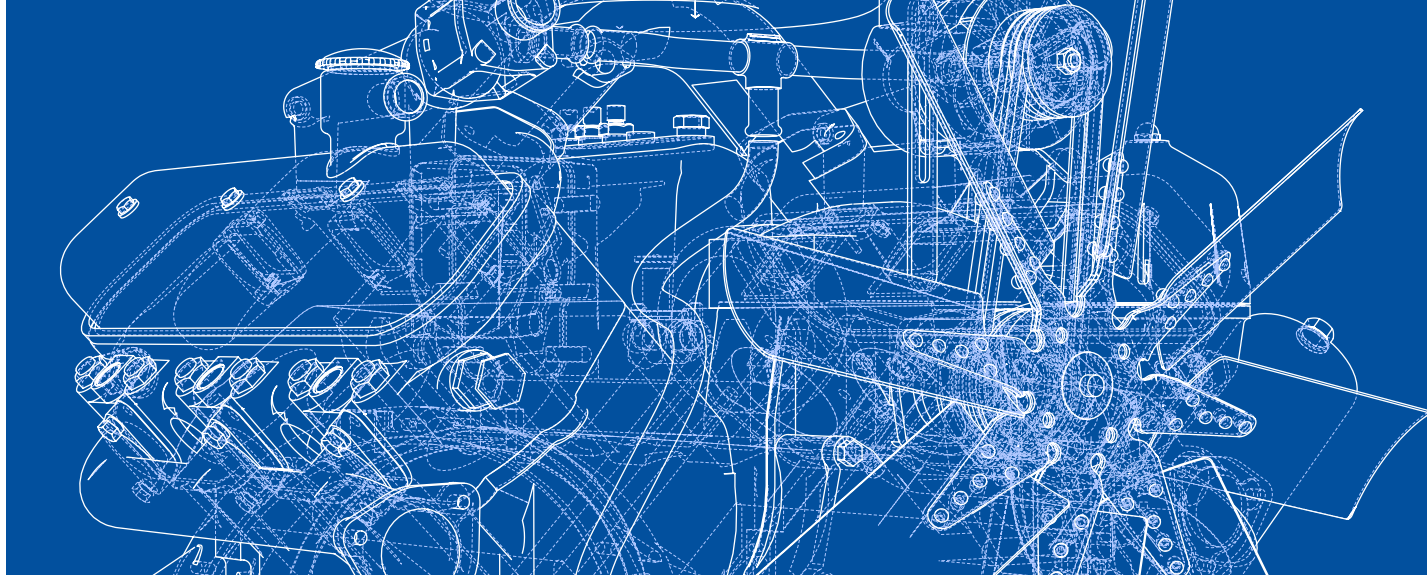
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Design Patent Applications in Mexico and Their New 'Play' GAME Rules



inventive activity of an invention, the state of the art on the filing date of the patent application or, if applicable, the claimed priority date will be considered. Art. 17 then goes on to state that to determine if an invention is novel, all patent applications filed in Mexico prior to said date will be considered, even if publication is made at a later date.

Arising from this, there are several uncertain aspects:

First, the law clearly distinguishes inventions (utility patents), utility models and industrial designs (design patents). Art. 17 makes reference only to inventions; and it is unclear whether it applies to design patent applications as well.

Secondly, Art. 17 makes clear reference to inventive activity and, thus, the question arises whether this is the first step towards designs needing inventive activity. If Art. 17 does, in fact, apply to design patent applications as suggested by including Chapter II as part of the prosecution for designs, then design applications will in fact require inventive activity.

Thirdly, in view of the possible interpretation that Art. 17 could apply to design applications, then all patent (utility patent) applications filed before the filing date of the design application or its claimed priority, will be considered as state of the art. Having said this, it seems that if this latter aspect does apply, design (design patent) applications filed before the filing date of the design application or its claimed priority – which are not published – would not apply, since it is not defined by the new law. Art. 17 clearly states that unpublished utility patent applications filed in Mexico will be part of the state of the art, given that design applications are

undefined in this Article, then all unpublished design applications filed in Mexico before the filing date or its claimed priority, should not be part of the state of the art.

Furthermore, there is reference to Art. 19, which defines non-inventions, the most relevant of which are Art. 19.V and 19.VIII. Again, given that Mexican law clearly distinguishes inventions (utility patents) from utility models and industrial designs (design patents), and Art. 19 makes reference only to inventions, then it is unclear whether or not this Art. 19 also applies to design patent applications.

Art. 19.V states that the manner in which information is presented is not considered as an invention. Why do we consider this to be relevant? Graphic User Interfaces, best known as GUIs, can be objected to for being manners in which information is presented. After all, what is a GUI but a screenshot of a particular state of a computer program? It should be noted that it is not the computer program as such, but simply a screenshot of the same. Icons can also be categorised as manners of presenting information. Thus, if this Art. 19.V does in fact apply, this would effectively end protection of GUIs and icons by means of design registrations in Mexico. Of course, some of these will have the option of being protected as a trade mark, as long as the trade mark is not descriptive or evocative.

Art. 19.VIII states that the juxtaposition of known inventions or mixtures of known products, its variation of use, form, dimensions or materials, are not considered as inventions, unless it is clear that their combination or fusion cannot function separately or that their qualities of feature functions of the same be modified to obtain an industrial result or a non-obvious use to a technician in the field.

The above-stated Article may also be relevant since it could be argued that novel designs are only in fact a variation of form of a priorly known design or juxtaposition of designs, which is the combination of two or more designs – which is akin to inventive activity or obviousness. This raises the same question as above, i.e. are we seeing the first steps towards the fact that design applications will now need inventive activity in Mexico?

It is unclear whether these Articles will apply to design applications since they clearly deal with inventions – which are, according to Mexican law, different to utility models and designs. All Articles in Chapter II in which Art. 17 and 19 are found, refer to inventions and patents. Therefore, it is unclear how any of the Articles found in this Chapter can apply to design applications. Having said this, the question arises as to why make the effort of stating that prosecution and grant of design applications/registers respectively, will be carried out in accordance with the Articles of Chapter II? For the correct application of the Articles of Chapter II to design applications, the Articles of Chapter II should have been amended as well.

The game rules are not only unclear they seem to be incorrect.

There are, however, some bright aspects to the amendments of the Mexican law. The one that shines out is the increase from 15 to 25 years for design protection. Hopefully designers will take advantage of this. It would also be good to see a similar increase in the number of years a utility patent is in force. After all, the effort that inventors make to invent is similar, if not greater than the effort a designer makes to design a product. «