

# Noli IP Newsletter

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## *Gray Issues in the IP Laws of Latin America*

*By Mariana Noli*

A few months ago, I get a phone call from my colleague and friend David Tseng, who is now Vice-Chair of the International Interest Group of the State Bar of California, inviting me to speak in a program about the IP Laws of Latin America. David and I used to work together at a patent litigation firm in downtown Los Angeles back in 2011. I was very thankful

that arise when working with clients and companies doing business in the region.

Our discussion of these relevant topics in trademark, copyright as well as other intellectual property issues showing the comparison between the rules and legislation in countries such as Argentina, Brazil, Chile, Colombia, and the Andean

*"Today the winds of hope blow through the Latin America and the Caribbean"- Daniel Ortega*

when he offered me the opportunity to speak to the CalBar members about a topic I am very passionate about. The goal of the webinar was to provide the audience with a quick overview of the intellectual property laws of several countries in Latin America emphasizing the differences with US trademark, patent, and copyright laws to help the audience get a better and deeper understanding of the challenges and obscure issues

Region, Central America, and Mexico, did not allow us enough time to go into detail in the different national legislations but we were able to provide certain interesting facts about the laws of some of the major players.

**ARGENTINA:** Because I was born in Buenos Aires, Argentina, it is even more surprising to me that Argentina is still not a member of the Patent

## Watch Out for "Patent Pending"

*By Karim Lagobi and M. Noli*

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It is not uncommon in our practice to receive urgent call/email from a client inquiring about a "Patent Pending" status.

A non-provisional application is published eighteen months from the earliest filing date, and it may not be discovered in patent searches during that whole time. If you have a patent application filed, and you want the public to know about it, then put "Patent Pending" on your product. The owner of a patent application may bring its existence to a potential infringer's attention, but, legal consequences may only start after the publication. So, if you are making or selling a product, make sure to inquire prior to executing a license from someone (or some company) who claims to have a "Patent Pending" on an invention.

For more information, contact us at [karim@noli-ipsolutions.com](mailto:karim@noli-ipsolutions.com).

Cooperation Treaty (PCT) nor the Madrid Protocol.

Argentina joined WIPO in 1980 and among the many interesting facts about its IP laws are that: (1) no use of the mark is required to obtain registration, (2) no renewal grace period is allowed, and (3) and sound, scents, smells, 3D designs can be registered as trademarks.

**BRAZIL:** Since 1975, Brazil has been a WIPO member. It is commonly known that trademarks require several years for granting in this country. While it is a member of the PCT, Brazil has encountered many difficulties in the implementation of the Madrid Protocol.

**CHILE:** Some interesting facts about the IP laws in Chile are that this country does not allow Non-Use Cancellation procedure. Chile is a multi-class country which also allows the registration of sound marks.

**COLOMBIA:** Together with Bolivia, Ecuador and Peru, this country is member of the Andean Region. Colombia is signatory of both the PCT and the Madrid Protocol.

**MEXICO:** It was not until after this CLE program, that Mexico approved a formal opposition procedure. Another interesting fact in its IP laws is that trade dress protection is limited, but notorious trade dress is

protectable via unfair competition actions.

Both member of the PCT and the Madrid Protocol, Mexico is one of the five players in Latin America because of its robust IP legislation.

Special attention was drawn to topics like the Madrid Protocol and Agreement and its lack of popularity in Latin America; Patent Cooperation Treaty and its slow implementation in certain countries; and the particularities of copyright law in those countries. You may access a copy of this presentation at the California State bar website or please ask via e-mail at [mail@noli-ipsolutions.com](mailto:mail@noli-ipsolutions.com).

## *BREXIT and its Impact in IP Rights*

*By Judit Marai*

Thanks to the UK (United Kingdom)'s decision of June 23, 2016, the whole world learned about the expression "BREXIT" which refers to the UK leaving the European Union (EU).

We immediately saw the effects on the world economy: currencies and stock prices started plummeting, and there were rumors about a new "Black Friday." Even if the situation did not go that far, there is no doubt that

everyone is wondering what is going to happen now.

Fortunately, in our legal environment is not like the currency or stock market: Nothing Changes Overnight.



According to Article 50 of the Lisbon Treaty, the withdrawal procedure starts with the

notice submitted by the UK to the EU. It continues with a 2-year period while the leaving state, in this case the UK, will negotiate the terms with the EU. In the meantime, the system will stay the same. Although it is not a fast change, it is very deep and substantive one, so we need to be prepared for it.

It is not surprising that the territorial definition of the European Trademark is going to change with the change in

the territory of the European Union. As expected, when the withdrawal goes into force, Applicants will have to file the application with the national trademark office if the UK is a target market, since the EUTM Application will not cover this territory anymore. The real question is what is going to happen with the already registered EUTMs (earlier CTMs). Will the Registrants need to re-file the application in the UK separately? Will they lose the priority date? Or will the EUIPO create a transition procedure making it easier and possible to keep the priority date of the registered

EUTM in the UK? Experts predict that the latter is the most likely, but this will be part of the withdrawal negotiations. In the meantime, if the UK is one of the core markets for you, it is worth to consider filing a separate application with the national IPO besides the EUTM.



The decision will probably not affect the UK's participation in the European Patent system; however, it will most likely not be part of the Unitary Patent System that will go in effect in 2017.

Also, it is highly unlikely that the Unified Patent Court will be in London as the original plan was. There is a possibility for the UK to ratify the Unified Patent Treaty, so nothing is certain just yet. The PCT and EPC patents stay unaffected in the UK even after Brexit, since both the PCT and the EPC are independent of the European Union membership.

Among other IP professionals, we are waiting for the changes that the BRETIX will bring us. We will keep you informed in connection with further developments, sharing with you future news and updates regarding this topic.

## My Favorite Week: San Diego Start-Up Week

Once again our San Diego Office participated of the **San Diego Startup Week 2016** in our ongoing efforts to work together with the local startup community, entrepreneurs, and small and medium size businesses.

San Diego Startup Week 2016 took place in our beautiful city from June 13<sup>th</sup> to 17<sup>th</sup> bringing together entrepreneurs to share progress, exchange resources, and celebrate our thriving innovation community. For more info, please visit: <http://sandiegostartupweek.com/>

