

Noli IP Newsletter

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Registered Community Design vs. Design Patent

By Judit Marai

For those of you who are familiar with the U.S. IP terms, patents can be utility and design. The former protects how an article works, the latter how it looks. The USPTO grants the registration for the design patent generally within 12 months from the filing, and the design

U.S. system. The first difference is that it is not “design patent,” but community design. Unlike in the U.S., the fact that the design is in public knowledge does not necessarily kill the possibility of the protection. Moreover, unregistered

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becomes protected for fourteen (14) years from the date of registration. The process is significantly easier and the protection term is shorter than for the utility patent. As in the U.S., in the European Union you can acquire protection for your design easier and faster than for a classic utility patent. However, there are some significant differences between the European and the

designs are entitled to protection too. Registered and Unregistered Community Designs have different kinds of protections as outlined below. An **Unregistered Community Design** is valid for three (3) years from the date of disclosure (not renewable), and it is protected only against intentional copies.

Congratulations to the new IALA Officers & Board Governors!

We would like to send our warmest congratulations to all the new officers and the board of governors of the IALA (Italian American Lawyers Association).



On January 28, 2017, we were proud to see our esteemed colleague and friend Lydia Liberio become President of this association and Ms. Mariana Noli sworn in as part of the new Board. We wish you all the best in this new term.



A **Registered Community Design** is valid for five (5) years, but it is renewable for all together twenty-five (25) years. It protects against any type of copying, even not intentional, and it is easier to prove ownership.

Although, patents are examined and registered with the European Patent Office, the design application is in the discretion of the European Intellectual Property Office (the same office where trademarks are registered). The application basically can be filed any time, even if the design is already disclosed. The official grace period to file the application is one (1) year after the first disclosure, but since the office does not examine novelty (and individual character), only third parties can commence an invalidity procedure in this case. The design is definitely more vulnerable to attacks after one year though.



U.S. Patent
D577,503
Embracer
Aircraft
Passenger Seat



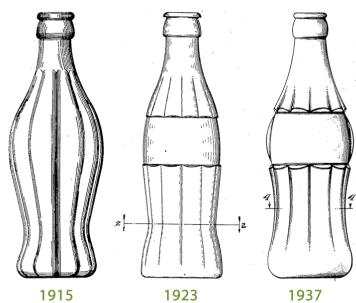
U.S. Patent
D581,758 Mundial
Scissors



U.S. Patent
D685,163
Alpargatas Shoe

It is important to keep in mind that the office examines

the applications narrower ex officio, and gives broader discretion to third parties to invalidate the design. It means that if it meets the formal requirements (representation, fee, graphical representation, classification), after a quick examination from the public policy and morality perspective, the design acquires registration. It still has to be novel and has to have an individual character, but the office does not reject the application on these grounds.



It is a possible ground for an invalidity procedure for interested third parties. The fact that the invalidity procedure with the substantive questions (other than public policy and morality) takes place after the mark registered makes the process very fast. The applicant can acquire a registration in a few days after the application is filed.

After the substantive examination of the office, the design will be published in the Community Designs Bulletin. If confidentiality is important for the applicant, there is a possibility to request that the publication be deferred for thirty (30) months. In this case, the graphic representation of the design is not published, only the date of application and registration and the name of the applicant and representative. After the thirty (30) months (or a shorter period of time if the applicant requested it), a full publication occurs. The registration certificate is only available after the full publication. The registration certificate is available online; however, if the paper copy is needed, it is available upon request.

If you have any questions regarding filing a Registered Community Design with the European Intellectual Property Office, e-mail us at judit@noli-ipsolutions.com. We are here to help you.

Meet the New TTAB Rules

By Mariana Noli

On January 14, 2017, the United States Patent and Trademark Office ("USPTO") will officially implement changes to the rules of practice before the Trademark Trial and Appeal Board ("TTAB"), including important changes to filing and service requirements, discovery protocol and limitations, evidence, and trial procedure, as well as an updated fee schedule that includes new fees for additional extensions of time to oppose. Below is a summary of the key changes to the rules.

All party filings must now be made through the Board's e-filing system, ESTTA.

The Board, rather than the opposer or petitioner, is now tasked with service of Petitions for Cancellation and Notices of Opposition on the defendant.

Service of all papers must be made by email, unless otherwise stipulated.

There will no longer be an additional five days (i.e., the mailbox rule) added to response periods for service by first-class mail, Priority Mail Express®, or overnight courier, in light of the Board's transition to email service.

All discovery requests must be served early enough to allow for responses prior to the close of discovery.

The number of requests for production of documents and requests for admission will be limited to 75 each, the same as the current limitation on interrogatories.

The deadline for filing motions to compel discovery or to determine the sufficiency of responses to requests for admissions is now prior to the deadline for the plaintiff's pretrial disclosures for the first testimony period. Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. The Board will have the ability to reset the pretrial disclosure deadline and testimony periods after resolving any motions relating to discovery and to permit time to comply with any discovery orders.

The proposed amendments clarify that the Board's standard protective order is automatically imposed in all *inter partes* proceedings.

The Board may treat as not confidential material that "cannot reasonably be

considered confidential," notwithstanding party designations.

Motions for summary judgment must be filed prior to the deadline for the plaintiff's pretrial disclosures for the first testimony period.

Parties may submit witness testimony by affidavit or declaration, subject to the right of any adverse party to take and bear the expense of oral cross-examination of that witness. The offering party must make witnesses testifying by declaration or affidavit available to their adversary.

A party must file any motion to use a discovery deposition at trial along with its pretrial disclosures. All depositions must also include a word index and must be submitted in full-size, not condensed, format.

A party may file a motion for oral examination of a witness who has been noticed for deposition by written questions.

An adverse party will be permitted to move to quash a notice of deposition testimony if it was not included in the pretrial disclosure or move to

strike testimony presented by affidavit or declaration that was not included in the pretrial disclosure.

Pleaded registrations and registrations owned by any party may be made of record via a notice of reliance. Internet materials may also be submitted under a notice of reliance under the proposed rules. Notices of reliance must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Failure of a notice of reliance to meet this requirement is considered a curable procedural defect.

Evidentiary objections may be set out in a separate appendix that does not count against the page limit for a brief. Briefs exceeding the page limit will not be considered by the Board.

If a plaintiff has not submitted evidence and its time for taking testimony has expired, the Board may grant judgment for the defendant *sua sponte*, even where the plaintiff has responded to the Board's show cause order for failure to file a brief but has either not moved to reopen its trial period or not been successful in any such motion.

The new rules clarify that when no answer has been filed, all other deadlines are tolled. If the parties have continued to litigate after an answer is late-filed, it will generally be viewed as a waiver of the technical default.

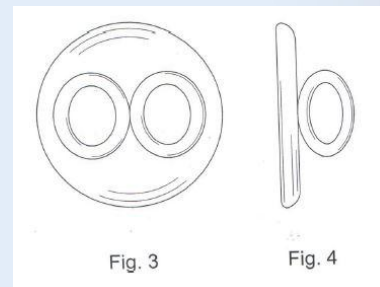
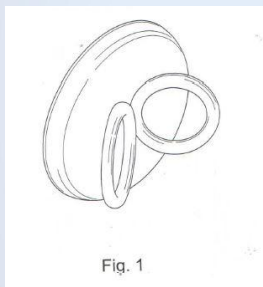
Parties, examining attorneys, and members of the Board may attend hearings remotely through video conference.

Please feel free to contact our office if you have any questions about the new rules and how they can affect your current process. E-mail us at mail@noli-ipsolutions.com

How to Register Models and Industrial Designs in Argentina

It is known that every country has peculiarities regarding the registration of an industrial design. In Argentina, Models and Industrial Designs are valid for fifteen (15) years; they are granted for an initial term of five (5) years starting from the date of concession, which can be renewed by two (2) periods of five (5) years each.

Protection granted is national. However, since Argentina is a signatory member of the Paris Convention, it recognizes a term of six (6) months to claim priority in other signatory countries under this Agreement for models and industrial designs.



At the moment of filing, the application for registration of a design must be submitted to the INPI (Patent and Trademark Office in Argentina) along with all the drawings of the model or design and a brief description. A single registration may cover up to fifty (50) different examples or embodiments of a single model or design, as long as they are all homogeneous.

Finally, regarding the time for renewal, the application with the same items as were required for the initial application shall be filed not later than six months before the expiration of the current term of protection.