

Latin America IP Update

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Worldwide

Fight against piracy: creation of an online web platform

The United Nations Educational, Scientific and Cultural Organization (UNESCO) announced last April the creation of an online web platform in order to contribute to the fight against piracy, which is named World Anti-Piracy Observatory (WAPO).

This web platform provides all kinds of useful, comprehensive and updated information concerning anti-piracy policies and measures taken by the UNESCO member states.

That means that the main objective of this site is to provide data and information about measures, policies and administrative mechanisms used by the state members in the fight against piracy, a current worldwide problem, which increases every year.

The information contained in WAPO is a useful and beneficial resource for national authorities, since same will have access to the different solutions taken by other state

members in order to improve its own measures and piracy policies.

It is also a useful instrument for authors, creators, and other property right holders, who can get information from this web platform, and consequently know more about their rights, and enforce same.

The creation of this platform was recommended during the 13th session of the Intergovernmental Copyright Committee in 2005; and has finally entered into force.

Everyone has free access to WAPO and it is available in three languages: English, Spanish and French.

Visit: [World Anti-Piracy Observatory](#)

Argentina

New Disposition for filing of Divisional Patent Applications

On July 15th, 2010, Disposition 147/2010 entered into force, which rules the filing of divisional patent applications and limits considerably the possibility of filing such applications.

The most important items in this disposition are:

- Applicants may split their applications until they receive the first substantial examination report;
- Once substantial examination has been started, if the examiner verifies that the application lacks unity of invention or that the application is a complex one, he will request the applicant to split the application within the term of 30 days;
- In all cases, the parent application must not have been granted at the moment a divisional application is filed;
- To file a divisional application (c), which is the divisional application of an application (b), which itself is the divisional application of another application (a), it is necessary that the parent application (a) has not yet been granted.

The Argentine Patent Attorney Association (AAAPI) filed a very strong letter of complaint with the Argentine Patent Office arguing that this new rule is unconstitutional because of many reasons, one of them being that no rule can be applied in a retroactive way.

During a meeting held between representative of AAAPI and the Argentine Patent Office, the latter explained that there is no intention to modify the original ruling. However, they unofficially expressed that it would be considered to *soften* the requirements.

Argentina

Tribunal of Second Instance reverse a ruling and finds patent infringed awarding monetary damages

This is a very relevant local ruling given the very small number of final decisions issued by the competent Court of Appeals over patent infringement,

which has not reached even a case per year so far.

According to the text of the decision, the key fact of the case to decide was whether patent No. 255.628 (the '628) protecting the active principle FIPRONIL, which has been broadly used as an insecticide since the middle of the 90's, was infringed or not.

Patent '628 was originally filed in Argentina under former Argentine Patent Law No. 111 by Rhone Poulenc Agroculture Limited (that later become Bayer CropScience S.A.), which in turn granted an exclusive license to Merial Ltd., the plaintiff in this case against Labyes S.A. and other defendants.

The claim of Patent '628, on which Merial Ltd. based this infringement action, read as follows: *a derivative of N-Fenilpirazol excluding its use for the treatment of the bodies of humans and animals carried out by a physician or veterinary as a therapy; a process to prepare it; a composition that encompass it; a method for the repression of plagues of arthropods, nematodes of plants, earthworm and protozoon as well as compounds useful as intermediaries* (this is our own translation).

Therefore, the tribunal had to determine whether the infringing product was among the subject matter excluded from the claims or not, which had been made given that treatments for humans and animals were unpatentable under Law 111.

According to the plaintiff, the infringing product was not a veterinary product so it should not be excluded from the reaching of the claims because it was used to clean the skin of animals from insects and acarus such as flea and ticks, which, in his view, was the right interpretation supported by the fact that veterinary and insecticides were included in different classes of the pertinent classification.

In the first instance, the judge agreed with the defendant but in second instance, surprisingly, the tribunal overturned that decision and awarded monetary damages applying the standards developed by local case law. Under these standards, the amount of damages were calculated as the

30% of the commercial value of the infringing products (without using this term, the tribunals are applying the method of *reasonably royalty*) or the 80% of the revenues received by the infringer (this method would also be the equivalent to *lost of profits*).

There are many other consequences deriving from this case related to local patent law, which are not included herein given space limit.

Decision of the Court of Appeals in Civil and Commercial Matters, Chamber III, date November 12, 2009 in *Merial LTD v. Labyes SA y otro s/cese de uso de patentes, daños y perjuicios*, case no. 6631/03.

Caribbean

Disintegration of the Netherlands Antilles

The Kingdom of The Netherlands will adopt a new structure as from October 10, 2010. The Netherlands Antilles (AN), formed by five Caribbean islands, will be disintegrated; and instead, two new autonomous countries will turn up in this Kingdom.

Curacao (with approx. 144.000 inhabitants) and **St. Maarten** (approx. 40.000). These islands follow the steps of Aruba, who has a separate status since 1986.

For **Bonaire**, **St. Eustatius** and **Saba (BES islands or Caribbean Netherlands)**, which are the smallest ones (and have 20.000 inhabitants altogether) the change will be more intense, since they will become special municipalities and will fall under the directions of The Netherlands.

Not much has been officially decided regarding intellectual property matters. So far, it can be announced that:

In Curacao

- has been approved the CW country code.

- The Registrar is still contemplating whether he will go along with WIPO's proposal. Said proposal would consider TMs already registered and applications filed before October 10th, 2010 declared valid in the new entities (countries and municipalities) free of charge and without having to file an application for re-confirmation.

In St. Maarten

- has yet to decide what they will do.

In BES Islands (or Caribbean Netherlands)

- The new Trademark Law will be identical in many aspects to the existing Trademark Law of the Netherlands Antilles. One major difference is that trademark applications will not be examined on absolute grounds.
- An application for re-confirmation of existing AN registrations can be filed until October 10th, 2011 and no official fees will have to be paid.

For International Registrations

- All I.R.'s with AN designation will automatically be transformed to Caribbean Netherlands, Curaçao and St.Maarten. Trademark owners do not need to take any action.
- Not only the Protocol but also the Arrangement of Madrid will be in force for Caribbean Netherlands.
- A new website will be created www.caribie.nl (Caribie stands for Caribbean Bureau Intellectual Property) and will be accessible on October 10, 2010.

We will keep on updating this information on our website www.moellerip.com

Ecuador

Change in annuity payment system

On June 01, 2010 the Ecuadorian PTO increased the official fees and also established new rules regarding annuities.

These new rules are quite controversial and have raised several questions and doubts, which need to be cleared.

Up to now, the first annuity was paid at the moment of filing the application in Ecuador. The following annuities were then due each year on the last day of the month in which the national patent application was filed.

The new rules are now as follows:

- Utility models pay annuities as from June 01, 2010.
- Granted patents, industrial designs and utility models pay annuities within the first three months of each year.
- Annuities should be paid on the last day of the filing anniversary month.

Regarding point 2, it can be clearly stated that this rule is against the current law and such disposition is therefore not applicable. This was confirmed with the local PTO.

Point 3 has raised one essential doubt: This rule does not mention which filing date it refers to, nevertheless the list of official fees refers to *annuity as from the national or international filing date*.

The PTO Director declared some days ago that annuities should be paid as from the international filing date and in consequence, she ordered the responsible PTO officers to change the current system in this sense.

She explained that the fee list mentions *national or international* date meaning that the PTO could choose between both dates and she also stated that the WIPO had requested such a change.

There will be a six-month grace period for paying outstanding annuities in order to adapt to the new system.

So far, these are verbal declarations by the Director, no written decision nor further rules on how to execute this system have been published. However, keeping in mind that we are dealing with an order given by the PTO Director, it is highly recommendable to follow the new rules.

Guatemala

October 31st: upcoming deadline to renew slogans.

Continuing with the information provided in our Newsletter No. 3 dated January 2010, we remind you that slogans registered before November 1st 2000, date when the actual law came into force, have to be renewed until October 31st 2010.

Under the old law, slogans had an unlimited duration, though were dependant to the linked trademark.

The actual law established that *all slogans executed conforming to the previous laws will be due when ten years are accomplished up to the legal effect of this law*.

This means that slogans registered on/or after November 1st, 2000 have a duration of 10 years from the registration date, same like trademarks.

Honduras

New Rules for the Payment of Annuities in National Phase Entries

The Patent Office has recently decided that national phases of PCT applications must now pay annuities as from the filing date of the international patent application. Therefore, the 1st and 2nd annuities have to be paid at the moment the national phase is entered in Honduras.

Furthermore, on September 6th, 2010, during a meeting with the General Director of the Patent Office as well as the Head of the Patent Department, it was orally

confirmed that before December 31st, 2010 annuities will have to be paid retroactively for all pending national phases of PCT applications. However, an official resolution in this regard has not been issued so far. We will keep you informed about the further development of this matter.

Although, up to now, the term for retroactive payment seems to lapse on December 31st, 2010, we strongly recommend to take care of such payment as soon as possible in order to be sure that your rights are not endangered.

Latin America

Geographical Indications (GI) and Denominations of Origin (DO) moving forward by fostering respect thereto

In the last months, there have been important legal decisions comprising GI&DO in different Latin-American countries. Some of these decisions involved only the registration of GI&DO and others also touched the interaction between them and trademark rights (TMs) that included a geographical term that was or could have been protected by a GI&DO.

Peru

TM application: CHAMPAGNE FOR ROOM and design in class 43

This TM application was rejected through Resolutions 1404-2010/CSD - 1600-2010/CSD on the basis of the following arguments:

- CHAMPAGNE is a geographical indication (French region) protected in Peru for wines and spirits, through Andean Community Decision 486 art. 135., reading signs that contain protected geographical indications for wines and spirits shall not be registered as marks.

- Geographical indications are registered at WIPO and protected by the Lisbon Agreement, of which Peru is a member.
- Another expressions mentioned in this Resolution as examples of protected denominations of origin are COGNAC and BOURGOGNE.

Honduras

Five beverages have been recognized as denominations of origin in connection with the industry of wines and spirits: cognac, sherry, champagne, mescal and tequila.

Honduras has considered the word TEQUILA as a denomination of origin, being this product a distilled liquid originating from the city of same name (TEQUILA), in Jalisco, Mexico.

The Honduran IP Law defines a denomination of origin as a geographical indication constituted by the denomination of a determined country, region or place used to distinguish a product that is originated therein. The characteristics of a denomination of origin are given exclusively or essentially by the geographical environment in which it is produced, including natural and human factors.

Furthermore, it is considered as a denomination of origin, a sign constituted by a denomination that without being related to a determined country, region or place, it refers to a place when its used in connection with products originating from said area.

Mexico

chili (hot pepper) protected as denomination of origin

After a hard lawsuit that reached the Supreme Court of Justice, it was finally declared that "chile habanero de la pensinsula de Yucatan" (translation: habanero chili of Yucatan peninsula) must be protected as denomination of origin.

The conflict had arisen since originally, it was published that chile habanero de

Yucatan (without the word PENINSULA) was to be considered a denomination of origin. The governors of the States of Quintana Roo and Campeche in Mexico filed a lawsuit based on constitutional controversy, since with that publication, the States of Quintana Roo and Campeche were disregarded as places where the product at issue is also produced.

Therefore, after reaching an agreement all parties involved in this trial, it was decided that the denomination of origin to be protected is "**chile habanero de la pensinsula de Yucatan**", demonstrating that it is the same product (chili) originating from the whole Yucatan peninsula (formed by the three Mexican states: Yucatan, Quintana Roo and Campeche).

Conclusion

It is clear then, that denominations of origin are becoming more relevant each day and private parties as well as National Authorities tend to be more aware of the importance of their protection as well as of the eventual conflicts with TMs that may arise.

Did you know...?



Uruguayan Courts accepted a claim for damages and losses against the firm Rodesol SA, for reproduction of Carlos Gardel's pictures without the corresponding authorization, whose authorship belongs to Mr. Julio Cesar Silva.

Plaintiff alleges exclusive rights in connection with the singer's pictures, registered in due time at Copyright

Registrar, which were included in a publication that was sold with a newspaper, which was imported and distributed by Rodesol S.A.

Plaintiff emphasizes that economic rights are independent of each other, so that each use of his work must be expressly authorized by its author, which did not occur for the importation and distribution of the magazine that contains the mentioned pictures.

As defendant did not deny the facts alleged by the plaintiff, the burden of proof that belongs to the defendant, and considering that damage of protected rights of the owner, resulting from the unauthorized reproduction, took place, Court supports Silva's claim.

Carlos Gardel (11 December 1887/1890– 24 June 1935) was a singer, songwriter and actor, and is perhaps the most prominent figure in the history of tango. Although his birthplace is disputed between Argentina, Uruguay and France, he lived in Argentina from the age of two and acquired Argentine citizenship in 1923.

Source: Montevideo's Court, Sentence N° 26 ("Silva Julio Cesar c/ Rodesol s/ Daños y Perjuicios y multa") and Wikipedia.

Regulatory Affairs News

Mexico

Simplified steps with COFEPRIS announced by President Felipe Calderon on August 17th 2010

To avoid unnecessary costs and to facilitate the access to cutting-edge products and technology services, Mexican President Mr. Felipe Calderon has announced new measures that will benefit Mexican citizens and foreign pharmaceutical, cosmetic and food industries as well.

The six measures announced are:

- Over the counter drugs marketed in the USA and Canada with demonstrated

safety and efficacy will be approved through a fast track process in Mexico.

- The extension of allopathic registrations will be carried out through a digital file, based on the good practices established by the International Conference on Harmonization of Technical Requirements for Registration of Pharmaceuticals for Human Use (ICH).
- Aiming at the marketing in Mexico of cutting-edge medical devices, the evaluation process of those products with marketing authorization in the USA and Canada will be significantly simplified in order to accelerate the granting of the Mexican sanitary registration.
- There will be a direct interconnection between the Tax Administration Service (SAT in Spanish) and COFEPRIS for real-time transfers of importing sanitary permissions hence particulars will have lower storage costs and a quicker release of their products from Customs. Currently there are transfers of food and insecticides importing permissions, and from October 2010 psychotropic drugs and narcotics will count with this real-time transfers as well.
- The use of authorized third parties will be promoted to help in the verification process of requirements established by COFEPRIS for drug products, medical devices and food.
- Operation and sanitary responsible licenses of the sites regulated by COFEPRIS can be submitted through the website www.tuempresa.gob.mx, avoiding the traveling to different official agencies and the costs related. This measure will positively affect 216 industries such as food, health and cleaning products, medical devices and more.

Brazil

ANVISA´s new controversial resolution.

Last June, the ANVISA (National Sanitary Vigilance Agency in Brazil) issued Resolution RDC 24, which establishes obligatory inclusion of advertisements in food products, in order to provide necessary information to protect public health and avoid bad eating habits.

The requirements of this resolution must appear in the offer, propaganda, publicity, and all kinds of commercial promotion of food products, which contain high amounts of sugar, saturated fat, trans fat or sodium and in beverages with low nutritional value.

Moreover, the new warning statements require a direct association between the producer's mark and the warning message, and these advertisements have to be clear, of immediate visualization and being easy to distinguish.

In spite of the negative opinion of the Attorney General's Office, which considered the resolution unconstitutional for not being the warnings required by federal law, manufacturers will have to comply the resolution within 180 days of the publication date, in December 26th, 2010.

Search News

Patent Clearance in Latin America

What is a patent clearance?

A patent clearance is a search of already registered patents and/or still pending for registration, which allows you to determine if your product or process infringes a previous right.

When is a patent clearance needed?

During a decision making process for commercializing a product or a process in a particular jurisdiction, it is very important to

determine if said product or process infringes any of the claims of the issued patents or pending patent applications in that particular jurisdiction, in order to evaluate the best strategy.

For further information please contact our search partner, IP Services GmbH, at mail@ipservices.eu or visit its website at www.ipservices.eu.

FAQ'S

Which Latin-American countries accept multiclass TM filing?

Yes	No
Belize	Argentina
Chile	Bolivia
Costa Rica	Brazil
Cuba	Colombia
Dominican Republic	Ecuador
Guyana	Guatemala
Nicaragua	Honduras
Peru	Mexico
Surinam	Panama
El Salvador	Paraguay
Uruguay	Venezuela

Thus we strongly recommend requesting the expert's advice, since some of the mentioned countries have special rulings, such as separating goods from services, or not filing more than 5 classes simultaneously, among others.

About us

Moeller IP Advisors passed satisfactorily the annual auditory of ISO 9001.



After a year of working according to and following ISO 9001 regulations, we recently had our yearly evaluation, which we approved with high standards, proving the high level of compromise on behalf of our complete staff with the continuous improvement of the quality of our services.



Coming very soon...

re-launch of our online services with more features.

Upcoming events!

VPP Autumn

When? October 28th – 29th

Where? Ulm, Germany

Who? Gerardo Messerer - Partner

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ASIPI

When? November 27th – December 2nd

Where? Santiago de Chile, Chile

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and to our Latin American colleagues!

Sources: INPI, WIPO, Inta Bulletin, Marcasur, G.A. Winkel SR. N.V., Wikipedia,

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Disclaimer

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Useful information

Holidays in Latin America

Argentina

- October 12th: Columbus Day
- December 8th: Immaculate Conception Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Bolivia

- November 1st: All Saints Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day
-

Brazil

- October 12th: Our Lady Aparecida
- November 2nd: All Soul's Day
- November 15th: Republic Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day
-

Chile

- October 11th: Columbus Day
- October 30th: Reformation Day
- November 1st: All Saint's Day
- December 8th: Immaculate Conception Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Colombia

- October 11th: Columbus Day
- November 1st: All Saint's Day
- November 11th: Independence of Cartagena

- December 8th: Immaculate Conception Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Costa Rica

- October 11th: Columbus Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Cuba

- October 10th: Anniversary of the beginning of the War of Independence in 1868
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Ecuador

- October 9th: Guayaquil Independence Day
- November 2nd: All Soul's Day
- November 3: Independence of Cuenca
- December 6th: Foundation of Quito
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

El Salvador

- October 11th: Columbus Day
- November 1st: All Saints Day
- November 2nd: All Soul's Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Guatemala

- October 20th: Revolution Day
- November 1st: All Saints Day
- December 24th: Christmas Eve
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Honduras

- October 3rd: Soldier's Day
- October 11th: Columbus Day
- October 21st: Armed Force's Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Mexico

- November 20th: Revolution Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Nicaragua

- December 8th: La Gritteria Immaculate
- December 12th: Immaculate Conception Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Panama

- November 3rd: Separation Day
- November 4th: Flag Day
- November 5th: Colon Day
- November 10th: The uprising in the Villa de los Santos against Spain
- November 28th: Independence Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Paraguay

- December 8th: Virgen of Cacupe
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Peru

- November 1st: All Saint's Day
- December 8th: Immaculate Conception Day
- December 24th: Christmas Eve
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Uruguay

- October 11th: Columbus Day
- November 2nd: All Soul's Day
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day

Venezuela

- October 12th: Day of Indigenous Resistance
- November 1st: All Saint's Day
- December 8th: Immaculate Conception Day
- December 24th: Christmas Eve
- December 25th: Christmas Day
- December 31th: News Year's Eve
- January 1st: New Year's Day