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March 9, 2023

LEGAL ALERT

CPTTP: Trademark, domain name and patent matters

Among the main aspects regulated by the CPTPP in terms of trademarks, domain names and patents, the following should be considered:

- Recognition of non-traditional trademarks and collective and certification trademarks

  The Treaty states that the fact that a sign is visually perceptible shall not be a condition for the registration of a trademark, and the possibility of registering sound and olfactory marks is contemplated. It also provides that trademarks include collective and certification marks.

- Well-known marks

  The CPTPP provides that it shall not be required, as a condition for determining that a mark is well known, that it has been registered, included in a list, or been previously recognized as such.
- Procedural aspects of trademark processing

  For the examination and registration of trademarks, the CPTPP provides that the system must consider a written communication of the reasons for the rejection of a registration; the opportunity to respond to and challenge decisions; the opportunity to oppose or cancel the registration of a trademark, and require that decisions be reasoned and in writing, also stipulating that an electronic application system and a public information system must be provided.
- Trademark license registration is not required

  For the purposes of determining the validity of a trademark license or as a condition for a licensee's use to be deemed to constitute use by the trademark holder, registration of a license shall not be required.

- Protection of geographical indications

  The CPTPP establishes that this type of privilege can be protected through a

trademark, a sui generis system or other legal means, contemplating for these purposes certain requirements that must be met by the administrative procedures for its protection or recognition; the grounds for proceeding with its opposition and cancellation, and certain parameters related to the protection or recognition of a geographical indication in accordance with international agreements.

- Domain Names

In this regard, the CPTPP provides that for the administration of country code top-level domain names (ccTLDs), an appropriate dispute resolution procedure shall be established based on the principles set forth in the applicable policy of the Internet Corporation for Assigned Names and Numbers (ICANN). It is also considered that there should be public online access to a database with contact information regarding the holder of ccTLD domain names.

- Regulation on patentable subject matter

Under the Treaty, patents are available for inventions that claim to be at least one of the following: new uses of a known product, new methods of using a known product, or new use proceedings of a known product.

It also provides that it shall be possible to exclude the patentability of inventions under certain conditions, including those inventions whose commercial exploitation in the national territory must necessarily be prevented in order to protect public order or morality, including to protect human, animal or plant life or health, or to avoid serious damage to the nature or the environment, provided that such exclusion is not made merely because exploitation is prohibited by local law.

- Grace period

The CPTPP notes that information contained in public disclosures used to determine whether an invention is novel or has an inventive step will be dismissed when (i) they have been made by the applicant or by a person who obtained information directly or indirectly from the applicant and (ii) they took place within the twelve months prior to the date of filing of the application in the national territory.

- Limited exceptions to patent rights

The Treaty considers the possibility of providing for limited exceptions to patent rights provided that such exceptions do not unreasonably conflict

with the normal exploitation of the patent or unreasonably prejudice the legitimate interests of the patent owner, taking into account the legitimate interests of third parties.

- Adjustments to patent duration for unreasonable delays by the authority

According to the Treaty, at the request of the patent owner, the means will be made available to adjust the term of the patent in case there are unreasonable delays that need to be compensated.

For these purposes, an unreasonable delay in the granting of a patent of more than five years from the date of filing of the application in the national territory, or three years since the date of the request for examination, whichever occurs later, shall be considered an unreasonable delay, providing certain circumstances that are excluded for the purposes of this determination, such as periods of time that are not directly attributable to the authority or those that are attributable to the applicant.

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