

December 4, 2012

LEGAL ALERT

Latest news on Intellectual Property matters in Chile

I.- New Requirements in Powers of Attorney, assignments and transfers

On November 9, 2012, the Chilean National Institute of Industrial Property (INAPI) issued its Circular Letter N°4 "About the way of appearing before the National Institute of Industrial Property", which states in mandatory character new formalities and requirements as to the presentation of Powers of Attorney, and assignments and/or transfers. This Circular, which came into effect immediately, applies with retroactive character regarding requests submitted at INAPI from May 23, 2012.

To assist in future presentations of applications in our country, we give you an explanatory summary of its upmost relevant norms.

****1) Power of Attorney****

****a.- Stricter deadlines to present a Power of Attorney****

The Power of Attorney must be accompanied within a period of 30 days, if the applicant is domiciled in Chile, or 60 days in case the applicant's domicile is located abroad. These periods will be taken into account from the moment the INAPI issues a resolution requiring the submission of the Power of Attorney.

The failure to submit the requested document by deadline in form, will be considered as a definite Abandonment with no possibility to reopen.

b.- Less requirements in the bestowal of Powers of Legal Entities

In case the power should be signed by the representative of a legal entity, it must clearly point out that he who signs appears on behalf of this entity, or else that such circumstance has been certified by a Notary Public.

No additional documents will be required to certify the signer's standing as a legal person.

****c.- Formalities of the power****

The power must be written in Spanish, or in its shortcoming accompanied by a simple translation.

There is no need to notarize and/or certify this power at the Chilean Consulate. Yet, in every case the power will have to be accompanied in original or in a photocopy authorized by a Notary Public.

****d.- Special situation of contentious cases****

In case a Power was granted abroad, it is subject to the “locus regit actum” rule (the place governs the act), by which it will only be legally binding if in addition to the requirements specified by the Chilean Law, it complies with the formalities established by the local law where it was signed.

****2) Assignments and Transfers****

a.- Formalities for the Assignment's Instrument of trademarks and patents

The instrument which evidences the assignment or transfer of a trademark or a patent, should be written in Spanish, or in its shortcoming, must be accompanied by a simple translation.

Although, the notarization and/or legalization of the instrument which contains the assignment or transfer application is not required, it must be accompanied, in every case, in original, or by an authorized copy certified by Notary Public. None the less, the INAPI may require the submission of more documents, in case there is doubt about the truthfulness of any indication contained in the document.

****b.- Admission of new documents to execute changes in the ownership of a Trademark****

Changes in ownership of a trademark on the Chilean Trademark Registry, may be carried out, in addition to the available legal procedures, through the submission of the following documents:

- i.- Certificate of transference not validated, written in form, containing matter accordingly to Form N ° 5 of the TLT Regulation, signed in original, by both the assignor and the new owner.
- ii.- Document of Transference not validated, written in form, containing matter accordingly to Form N ° 6 of the TLT Regulation, and signed in original, by both the assignor and the new owner.

** c.- New requirements for documents that credit change of entitlement in a Registry**

i.- The assignment contracts will have to be signed both by the assignor and the assignee.

ii.- If extracts of contracts or extracts from the Commerce Registry must be presented, the INAPI may require that these should be certified by a Notary Public or competent authority.

iii.- For those contracts that have been signed representing legal entities, the INAPI may require certification of the legal standing. In this case, the legal standing shall be certified with a true copy of the original by a Notary Public.

II. - Internationalization of Chile's National Institute of Industrial Property

****1) Inapi designated as an ISA/IPEA Office****

The National Institute of Industrial Property of Chile has been designated as an International Patent Authority by the World Organization of Intellectual Property (OMPI).

Chile is now part of the select ISA – IPEA authorities group (International Search Authority and International Preliminary Examination Authority), title only held, until now, by Brazil. Our country's appointment grants South America an important role in patent matters.

The latter implies advantages as well as simplifications in procedures for submission of international requests in Chile, according to the PCT Agreement. For example, the applicant may obtain in the same Office the International Search Report and the Preliminary International Examination, which will reduce procedure costs and avoid delays as a result of request overloads in other Offices.

The designation will be made official as an International Search Authority and International Preliminary Examination Authority Agreement, which regulate their running as Authority. According to INAPI, Chile would begin to formally work as an ISA – IPEA authority by the end of 2014.

2) Signing of Regional Cooperation PROSUR – PROSUL Agreement

Last October 16 -by means of Exempt Resolution N ° 536 of the Economic, Promotion and Tourism Chilean Ministry- INAPI signed the "Cooperation Agreement that establishes the PROSUR-PROSUL Regional Cooperation System on Industrial

Property."

The member parts are the national Industrial Property Authorities of Argentina (INPI),

Brazil (INPI), Chile (INAPI), Colombia (SIC), Ecuador (IEPI), Paraguay (DGPI), Peru (INDECOPI), Surinam (BIE), and Uruguay (DNPI).

The Agreement seeks to promote development in resource modernization and industrial property systems, thus enhancing industrial, science and technology development in the region.

****1) Target of the PROSUR – PROSUL Agreement:****

Completion of a Cooperation System on Operational Information and Industrial Property, regarding Trademarks, Patents, Utility Models, Drawings and Industrial Designs (parts may agree in further subject incorporations).

****2) Scopes of the Agreement:****

- a. Development of a common platform as to unify and simplify access to information in Industrial Property records, which supposes information and procedure data exchange amongst signing countries.
- b. Technology Cooperation and common problem resolution for more efficient procedures.

c. Information and experience exchange regarding:

- i. Developments in protection systems of Industrial Property.
- ii. Technical and scientific understanding of each member's role as promotion bodies, in the development of competitiveness, entrepreneurship and innovation.

iii. General Administration.

- iv. Provision of technical information to the user and to the industrial, managerial, scientific and University community, for scientific and economic development in each signing country.
- v. Industrial Property training and reinforcement of academic practice amongst signing countries.

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