

UK—Good-bye to Citations/Hello Oppositions

On October 1, 2007, the United Kingdom will reform its practices in the area of relative examination so that they are more closely aligned with the Community Trademark examination procedure. In particular, while Examiners will continue to cross-search new applications against earlier United Kingdom and Community trademarks, the results will be provided to the applicant on an informational basis and will not of themselves be a basis for refusing registration. It will fall to the owner of a prior right to lodge an Opposition if it wishes to block a later mark.

The change is being made in large part because it was considered unduly burdensome on applicants for United Kingdom marks to have their marks refused on the basis of earlier national and Community rights which themselves often overlapped due to the absence of relative examination at the Community level. This resulted in applicants for United Kingdom rights being at a substantially higher risk of encountering an objection than an applicant for a broader Community right.

Whether this change will devalue the perceived value of a United Kingdom national registration remains to be seen. Under the new practice, the owners of prior United Kingdom national rights will be notified of later-filed applications that may conflict with those rights while owners of Community and International rights extended to the United Kingdom can also opt-in for a fee so that they are notified of possibly conflicting United Kingdom national applications.

The change will mean that there will be a greater burden on the owners of United Kingdom national rights to police their marks and affirmatively assert these rights against later applicants by means of Oppositions and other enforcement measures.

No Area Geographically Obscure to Wine Fans

OHIM's Cancellation Division has cancelled Community Trademark 2020832 TUPUNGATO that covered "alcoholic beverages (excluding beer)," on the basis that it is or may become descriptive of the geographical origin of the goods and on grounds of bad faith.

The evidence indicated that Tupungato was longstanding, although small wine growing region in Argentina, accounting

for less than 1% of the country's wine output. Article 7(1)(c) CTMR provides for refusal of protection to marks that "consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service." The Board noted that the provision is not limited to marks that

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The United States May Have Designs on Fashion

Much to the chagrin of most fashion designers, the United States is lacking a statutory scheme for protecting apparel designs, comparable to protection offered in Europe. Copyright law only offers protection for fabric patterns, trademark law protects logos on the apparel item, and prosecution time for a design patent ordinarily exceeds the lucrative first few months of a fashion design's lifespan. With advent of the Internet, photographs of new designs from fashion shows

immediately make their way to overseas manufacturers who can produce a full line of knock-offs before the originals hit the market.

A bill is now circulating in the Senate that would amend U.S. copyright law to specifically provide protection to the overall appearance and ornamentation of apparel articles. Under this bill, entitled the *Design Piracy Prohibition Act*, "apparel" would be defined broadly to include: an

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US Patent Office Drastically Revises Rules of Practice to Reduce Number of Claims and Continuations for One Invention

New rules of Practice before the US Patent Office, promulgated by the USPTO on August 22, 2007, will reduce the number of claims available to an applicant in any one patent application and eliminate the unfettered ability to file an unlimited number of continuations and requests for continued prosecution. New rules would allow the USPTO to object on formal grounds and refuse to examine any applications that have over 5 independent or 25 total claims. The USPTO was required to include provisions to enable examination of applications with a larger number of claims, so that the rule does not limit rights that are not so limited by the US patent laws, but the requirements that must be met in order to make use of these provisions are so onerous as to make

them practically unavailable to all but the wealthiest of applicants. Two continuation applications, permitting an additional 25 claims each, will also be available, for a total of 75 claims (15 independent) for each invention. The original parent application and each of the continuation applications will be entitled to only one request for Continued Examination. The rule changes are set to become effective on November 1, 2007, but the continuation and claim provisions become effective for all applications filed after August 21, 2007. These rules have already been challenged in a federal district court—the plaintiffs are asserting that the rules are beyond the scope of USPTO regulatory authority and are contrary to the patent laws passed by the Congress.

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are currently associated with the category of goods in question, but also extends to marks that are capable of designating the geographical origin of the goods in the minds of the relevant consumers. Noting that a part of the wine-purchasing public is composed of "wine fans," who have a superior knowledge in the field, and that in wine shops, the customer is often assisted by an expert vendor, the Board found that it was "reasonable to assume that TUPUNGATO is a geographical

name which is liable to be used in future by wine traders and producers as an indication of the geographical origin of their goods and is, in the mind of the targeted public, capable of designating the geographical origin of the category of goods in question."

The Board also found that the registrant has acted in bad faith because "even though the knowledge of the name TUPUNGATO as a wine producing area on behalf of the proprietor (had) not been proved by positive evidence...it seems extremely unlikely that the proprietor could

have ignored the existing link between the name TUPUNGATO and the wine producing area having the same name and that it could consequently ignore that the sought monopoly over the name TUPUNGATO for alcoholic beverages, which include wines, would have been prejudicial to the interests of competitors producing and/or dealing with the import-export of wines from that area."

The United States May Have Designs on Fashion (continued from page 1)

article of men's, women's, or children's clothing, including undergarments, outerwear, gloves, footwear, and headgear; handbags, purses and tote bags; belts; and eyeglass frames. Registrations on apparel designs would have a three-year registration term and infringement of the registration would be assessed under the same standard existing under current copyright laws, namely substantial similarity in overall appearance. Statutory damages awards for infringement of a registered original design would increase to the greater of an amount not exceeding \$250,000 or \$5 per infringing article.

The proposed legislation requires that the application for registration of the design is made no later than three months after the date on which the design was first made public.

As with most new bills, this one will likely go through many iterations and drafts as it proceeds through Congress on its way to becoming law.