



BUFETE CANDANEDO

ATTORNEYS AT LAW

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AN EASY GUIDE TO FILE TRADEMARKS IN PANAMA

Registration:

FIRST STEP, filing the application. In this step, it is necessary to provide and file the following information and documents:

1. Trademark's information: denomination, class.
2. Owner's Information: natural person's name, address, citizenship and ID number. If company, denomination, laws of incorporation, address.
3. Documents:
 - a. Power of Attorney: executed by the applicant, notarized and legalized by the Apostille or the Panamanian Consulate. If a company then,
 - b. A recently issued Company's Certificate of Existence, duly legalized by the Apostille or the Panamanian Consulate. It is a Certification issued by a Notary Public or by the authorities in charge of the Companies Register of the country of origin (if US company it can be a Goodstanding issued by the Secretary of State), certifying the legal existence of the company, that it is still in force and any other information they may consider relevant.
 - c. An Affidavit (of Use) executed by the applicant. This document does not require legalization. Note that the Power of Attorney authorizes us to execute the Affidavit on behalf of your client.
 - d. 15 labels 7.5 cm x 6.0 cm.
 - e. Priority document: (if you're the applicant is interested in claiming the Convention's Priority

only). A certified copy –no legalization needed– of the application issued by the Trademarks Office of a Paris Convention member country.

- f. Classes and goods/services to be covered. Please note that we must provide the specification of goods or services that will be covered by each application (Nice Classification).

Our law allows us to file any application without Power of Attorney and Certificate of Existence; this proceeding is very useful for filing urgent applications. To act without Power of Attorney, we must submit with the filing application of each trademark a surety bond of US\$100.00, which would be returned to us as soon as the documents are incorporated. In case the documents are not submitted by the deadline, the Trademarks Office will keep the sum guaranteed with the bond and the application will be refused.

SECOND STEP, examination of the trademark:

The trademark would be examined as for absolute grounds of refusal within a period between two months and four months from the filing date. Against refusal of a trademark, we can file Reconsideration and Appeal Recourse within the following ten days from the Notice informing the examiner's decision.



THIRD STEP, publication:

Once the trademark is examined and found in order, the publication in the Industrial Property Bulletin would be ordered. The IP Bulletin does not have an established periodicity. You may check any development in the Trademarks Office webpage: <http://www.digerpi.gob.pa/boletines.html> The Bulletins are published in PDF format for your easy perusal.

FOURTH STEP, opposition:

Within the following two months from the publication date, any party may oppose the registration of the published trademark.

The opposition proceedings in Panama take place within the Civil Courts (specialized courts for IP matters), and thus, evidence to support the arguments and general proceedings are ruled by our IP Law and Civil Procedural Code.

Oppositions may take from six months to three years depending on the complexity of the case.

FIFTH STEP, registration:

If no opposition proceedings take place within two months from the publication, the trademark would be registered.

The registration date is the same as the application date in Panama.

AFTER THE REGISTRATION

Renewals:

The registration is granted for a ten years period that may be renewed for additional periods of ten years each. The renewal of the registration of a mark shall be requested within a period from one year prior to the expiration date until six months after it.

If said period expires without the renewal having been requested, the registration shall lapse as of right.

Renewal of the registration during the six months following expiration shall require payment of the prescribed surcharge. The registration shall remain in full force during the latter period.

The renewal request may not introduce changes to the mark or extend the list of goods or services for which it is registered; nevertheless, the owner may limit the said list. For the introduction of changes or the addition of goods or services, a new application shall be filed.

YOU SHOULD KNOW THAT:

In Panama, the following International Agreements have been adopted:

- Paris Convention
- TRIPS
- Interamerican Convention

Declaration System

The use of a trademark gives the right to register the sign, however, only with the registration the owner can use its trademark exclusively.

The rightful owner can oppose or file infringement against any trademark or third party attempting the use of its sign. Meanwhile, the user (without registration) can only oppose the registration of a similar sign, but not file infringement against the use of another party of its sign.

Classification Applicable:

Panama follows the Nice International Classification System, and the Vienna International Classification for design elements.

GUIDELINES FOR PATENTS REGISTRATION IN PANAMA

1. cope of protection

The inventions, understanding as such a product (or a special use or non-obvious use of a product) or a process or both, are subject to patent registration.

Is important to point out that all inventions should comply with the requirements of novelty, inventive step and industrial applicability.

In addition, the Law expressly states that it shall not be considered inventions among others, the following:

1. Theoretical or scientific principles;
2. plans, schemes, principles or methods pertaining to economics or business, those relating to purely mental activities, and games.
3. Computer software per se.
4. Methods of surgical, therapeutic or diagnostic treatment applicable to the human body and to animals. This provision shall not apply to the products, notably the substances or compositions, or to inventions of apparatus or instruments for the implementation of such methods.

There are excluded from patentability the following inventions relating to live material:

1. Essentially biological means of breeding or propagating plants, animals or varieties or breeds thereof so far as the Patents Office considers them a violation of morality or the integrity or dignity of mankind.
2. Plant species and animal species and breeds;
3. Biological material as encountered in nature;
4. Live material that forms part of the human body;
5. Plant varieties.

2. Patent requirements

The patent should meet the requirements of novelty, inventive step and industrial applicability.

Novelty requirement: The patent must meet the novelty requirement by an examination for absolute grounds for refusal. The examiners would consider all disclosures prior to the filing of the patent application.

Prior art includes everything that has been disclosed or made accessible to the public anywhere in the world. Prior art also includes the contents of a patent application pending in Panama whose filing date or priority date is earlier than that of the application under examination. There are exceptions to this rule that must be studied in each case.

3. Patent registration

For the registration of an invention, the following steps are followed:

FIRST STEP, filing the application: It is necessary to provide and file the following information and documents:

1. Patent's information: Title of the invention
2. Owner's Information: If an individual name, address, citizenship and ID number. If company: Denomination, laws of incorporation, address.
3. Inventor's information: name, citizenship, address.
4. Priority Information: if claimed, number, country and date of application.
5. Documents required: Power of Attorney, A recently issued Company's Certificate of Existence (if the applicant is a company), Assignment Document (from inventors); The Priority Document (if claimed). Each document must comply with formalities stated in our IP Law.
6. Patent specification: description, abstract, claims of the invention and drawings. These documents must be complete and in Spanish, they do not have to be legalized. This is the only case in which we are not required to file an authorized translation by Public Translator duly registered.

Once filed, the application would be assigned an application number and date.

SECOND STEP, examination of the patent:

The patent would be examined as to the formalities (documents enclosed) and the absolute grounds for refusal when the patent does not meet the requirements for an invention (patentable matter or live materials not to be registered).

If there are observations, then the representative before the Patents Office would be served of these observations in order to amend the application or provide the required documents.

The timeframe are as follows:

- Examination upon reception: approximately four months.
- Observations amendment: between two months to six months depending on the observation issued. Time extensions available.

THIRD STEP, publication:

If found in order (with complete documentation), the patents details would be published on the Industrial Property Bulletin (first publication). The information regarding title, owner, inventors and abstract would be published.

The IP Bulletin does not have an established periodicity. However, you may check any development in the Trademarks and Patents Office webpage: <http://www.digerpi.gob.pa/boletines.html> The Bulletins are published in PDF format for your easy perusal.

If you wish to obtain back issues of our newsletters please write to us at: info@bufetecandanedo.com

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FOURTH STEP, novelty examination:

The novelty would be examined after completion of the documents required, amendments filed as per requested by the examiners and the first publication been done.

After the examination and issuance of the State of the Art Report, a second publication would be ordered, this time of the results of the exam.

FIFTH STEP, observations to the results of the State of the Art Report:

Within the following two months from the Second Publication (Results of the State of the Art Exam), any third party can file observations. The observations filed by a third party would be communicated to the applicant of the patent invention that would file its response to each argument of the third party. The examiners are not complied by law to accept or refuse both or any of the two arguments filed by a third party or the applicant.

THERE ARE NO PROVISIONS REGARDING OBSERVATIONS FILED BY THE APPLICANT OF THE INVENTION HIMSELF, THEREFORE IT IS POSSIBLE TO FILE SUCH IF DEEMED APPROPRIATE TO CLARIFY MATTERS OR PROVIDE ADDITIONAL INFORMATION.

SIXTH STEP, registration:

The registration is granted for a twenty years period. To maintain the protection during this time, a payment must be filed every five years from the registration date (same as the application date). The payment can be filed at any time before the due date deadline, until six months after such date. The patent would expire if no payment is filed in its due date. It takes approximately 18 to 24 months to obtain a patent registration.

WITH INDEPENDENCE OF THE CONTENTS OF THE STATE OF THE ART REPORT, THE OBSERVATIONS FILED BY THIRD PARTIES OR THE ARGUMENTS FILED BY THE APPLICANT, THE REGISTRATION WOULD BE GRANTED.

4. Enforceability of patent protection

Against an infringer, there are court actions available, either criminal or civil.

The civil actions can be brought against the manufacturer, marketer, distributor and all persons who in any way have taken part in its production and circulation. Meanwhile, criminal actions can be brought against a person who manufactures or assembles a product protected by a patent, without the consent of the owner; commercializes or circulates a product manufactured or assembled without the consent of the owner and/or uses a patented procedure without the consent of the owner.

The owner of the patent would have the burden of proof, with the exception of infringement of a patented process. In this case, the proof would fall on the defendant to file evidence that the process used to obtain the product is different from the protected process allegedly infringed.

The protection granted by a patent registration is territorial, and thus, the activities that take place outside of the country do not support charge of patent infringement.

The time limit to seek remedy to a patent infringement is of six years from the most recent date on which the infringing act was committed.

5. Licensing

Panama does not have provisions regarding compulsory licenses. However, as Paris Convention members, the Patents Office may grant compulsory licenses when the lack of the exploitation of the invention is in detriment of the public interest.

*“When you think about Panama, think **Bufete Candanedo**”*

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DISCLAIMER

The content of this publication is for information purposes only; it is not intended to provide legal opinions or advice. Before making any decision you should consult you counsel or us.”