IP AND PATENTS

What Is Wrong with The World Of IP?

Contact: Domenico De Simone, Partner at De Simone & Partners
E: nds@desimonepartners.com | W: www.desimonepartners.com

Domenico De Simone specialises in industrial and intellectual property (IP) law; he shares with us his insights to what will improve the IP sector. He touches on the occurring problems when he deals with IP cases and offers a solution that would make the process easier for practising lawyers, as well as businesses and clients who wish to protect their inventions.

DOMENICO DE SIMONE

Domenico De Simone has been practising in Intellectual Property Law since 1972; he was admitted to the Bar in Italy and before the Italian Court Sections specialised in Industrial and Intellectual Property Law. He is an Italian and European Intellectual Property Attorney (Trade Marks, Patents and Designs), Professional representative before the Italian Patent & Trade Mark Office, the European Patent Office, the Office for the Harmonization in the Internal Market.

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Harmonisation is to create soft connections between differences. Harmonisation is not suppression, but is instead education and respect for the history behind each harmonised party. We have been living during a period of time characterized by turbulences of all types and with a number of harsh issues and cases. One change in my view that has been special is that namely in the past, the offer provided by the opposing party was the trigger, whereas nowadays it seems to be more of a demand; this is because we have a rational expectation to obtain whatever we believe we are obliged to. Overtime, this has become more readily available thanks to the digital environment which is shared internationally; if we wish to obtain something that is not currently available, within a few hours we are able to get our hands on it, allowing the formal aspect of sales to be immaterial and extra fast.

Without doubt this has had effect on the IP sector; you may have noted how IP has been subjected to strong pressure, likely to be the result of artificial (European) unity, which has strategically pushed from the outskirts instead of challenging and facing the central issues of the (European) unification.

The World Intellectual Property Organisation (WIPO) eventually - in 2014 - stated and made clear that encouraging creativity is at the heart of WIPO and that all nations that harness the power of creativity and innovation - through the use of the IP system - can achieve or at least encourage economic growth and cultural development.

So, at that point it comes quite natural a question as to how had we survived previously? We questioned ourselves to how we had lived and worked alongside all countries, whilst dealing with their individual rules and methods without mutual harmonisation.

Contemporary: Does It Mean It Is Modern or Advanced?

This also begs the question to whether or not the Paris convention should be updated in order to allow priority claims for IP Recordals?

Contracts related to IP have significantly increased and it is expected to increase in the future; with this in mind, the priority mechanism could be positively applied, especially due to the fact that Recordals are not always an obvious or easy process.

Actually, in some countries, applications for Recordals must be requested for within a certain time from execution, especially if one has the need to enforce it. The reason to why I argue this is, when you have to record an IP transfer in several countries, it can become a costly and cumbersome exercise to prepare and file all Recordals together; therefore, it would be a much more relaxed and less expensive process if one could count on priority claims.

This is particularly true when you have to save on financial costs; a common issue that businesses face is that Registry Offices in different countries will claim a certain percentage out of the amount that is shown in the assignment.

Moreover, the text of the deed often requires changes from country to country, but if we were able to count on priority claims, it would be possible to fix a possible date and then begin drafting all the other alternative versions.

I also deal with cases of criminal relevance; this is where you can be the real assignee and be the first to record it in your home country, but then a third party tries to be first to record themselves fraudulently in an alternative jurisdiction.

Bad practice and mistakes by the Trade Marks Offices (TMOs)

When there is a change of ownership, simultaneously there are frequent cases whereby the examiners overlook the completed or pending Recordal and issue objections/refusals. We are now not dealing with a matter of opinion, but simply with a matter of material error; the updated information was available but the examiners' system did not get it, so that an ungrounded decision was issued. Where mistakes may occur, even for examiners, there ought to be a release from fees when such mistakes occur, a notice of correction by the applicant and to revoke the erroneous decision, thus letting the application to proceed without further costs.

To our knowledge, there is no express provision anywhere so that a substantial, further amount of work will be requested; nevertheless, we must consider the cost of updating the examiners' software which is often is the main cause for these mistakes. **LM**