



IP COSTA RICA Costa Rica **Contact us**

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Divisional Patent Applications in Costa Rica

For several years, it was a common practice to file divisional applications filing the same set of claims as the ones in the parent application. Said practice allows the applicant not only to amend the claims of the divisional application in a later moment, but also to be already aware of the outcome of the parent application.

The Costa Rican PTO did not object said practice in the past, but is now enforcing a policy in which a divisional application is accepted only if a problem of unity of invention arises. The PTO will determine if there is a problem of unity of invention, in which case the divisional application will be accepted for prosecution.

Therefore, there have been several rejections in the past months due to the enforcement of said policy. The legal basis of the policy is not clear and can be interpreted as a restriction to a legal prerogative of the applicant to modify or divide the application. Nevertheless, there have been no judicial claims against the policy so far and we do not foresee a change in the near future.

Evidence in Support of Well-Known Trademarks

As previously discussed in our bulletin, Under Costa Rican Law well-known trademarks are granted a special status that provides

In This Issue

* Divisional Patent Application in Costa Rica

* Evidence in Support of Well-Known Trademarks

* In Our Firm



- Patents
- Trademarks
- Trade Secrets
- Copyrights
- Regional Filings

an enhanced protection, greater than an ordinary trademark, which gives them the advantage of having extraordinary measures to fight infringement. This special classification is granted by the correspondent authority, in this case the Costa Rican Patent and Trademark Office (CRPTO), as well as the Administrative and Judicial Courts, after considering the requirements set forth in the Law.

In a recent decision, the Costa Rican Patent Office (CRPTO) ratified that a well-known status of a trademark cannot derive only from the knowledge that the public have of these marks. The CRPTO also indicates that the notoriety of a trademark is not determined only by a statement made by the owner; such statement of notoriety must be supported by evidence.

In this regard, a Trademark owner has the opportunity to prove the notoriety of a trademark during trademark litigation, even at the level of opposition proceedings. The owner must produce evidence demonstrating that his trademark is well-known in the market. Once incorporated to the file, all items of evidence will be evaluated by the examiner.

In this regard, a good attorney - client communication and a specific strategy are key in the process of preparing and submitting the evidence in a suitable way and in a timely manner. Some of the items may even be subject to extra formality requirements, like legalization of documents. All these considerations may determine a favorable outcome in case of trademark infringement.

In Our Firm

Partner Luis D. Castro Attending AIPLA IP Practice in Latin America Committee

Last week our Partner Luis Diego Castro, as member of the Intellectual Property Practice in Latin America Committee of the American Intellectual Property Law Association (AIPLA), attended a visit to Chile and Argentina.

Each year, the IP Practice in Latin America Committee travels to Latin America to get first hand exposure to the international IP laws and network with professionals from the region.

In this opportunity, the visit to Chile and Argentina resulted in very productive meetings with leading IP organizations, like the IP Office of Foreign Affairs Department of Chile, the Chilean Federation of Industry, the Chilean Patent and Trademark Office, the Board of the Argentine Association of Industrial Property Agents, and the Argentinian Patent and Trademarks Office.

The meetings took place from August 17 to 19 in Santiago, and August 20 to 22 in Argentina.

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