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# Intellectual Property, Media and IT

Legal Flash | Portugal

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Decree-Law no. 110/2018**



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### New Industrial Property Code – Decree-Law no. 110/2018

On October 6, the new Portuguese Industrial Property Code (“PIPC”) was approved, transposing the (EU) 2015/2436 Directive, which approximates the laws of the Member States relating to trademarks, and the 2016/943 Directive on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure.

This legislative amendment seeks to establish a more complete and reinforced regime for the protection of know-how by providing stakeholders with more effective mechanisms to prevent and respond to breaches of their trade secrets before the judicial authorities.

It also aims to introduce improvements, clarifications and updates to the protection regimes of industrial property rights provided for in the PIPC regarding patents, utility models, designs, trademarks and logos, as well as to strengthen the protection system of these rights and to increase the persecution effectiveness of illicit activities under the PIPC.

The approval of this new Industrial Property Code will, namely:

- Introduce in the new PIPC greater clarity in the concepts of application date and priority date of patent applications, utility models and of registrations filed with the National Institute of Industrial Property, I.P. (“NIIP”);
- Provide new forms of representation of signs that may constitute a trademark;
- Establish new grounds for refusal, nullity or cancellation of registrations and redraft some of the existing grounds;
- Eliminate the requirement of registration of a prior application so that a well-known trademark may represent a relative ground for refusal of subsequent trademarks, as well as provide the requirement of a prior registration so that a reputed trademark may represent a relative ground for refusal of subsequent trademarks;
- Establish a new administrative procedure for the declaration of nullity or cancellation of registrations, in particular of designs, defining the respective fees;
- Regulate the rights granted by trademark registrations, clarifying aspects regarding the limitation of the effects of these registrations and the intervention of licensors;
- Redraft the conditions relating the use of trademarks and the consequences for the absence of such use, as well as to define a new way of counting the duration of this registration;



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- Adapt some of the rules applicable to trademark registration to the procedure of logos registration;
- Clarify some aspects relating to exclusion and patentability requirements, as well as the regime of invention units;
- Remove the prohibition of dual protection of national and European patents;
- Define with more detail the procedures for complementary protection certificates;
- Extend the deadlines for responding to NIIP notifications, regarding patent applications and utility models;
- Eliminate the possibility of adding technical matters to patent applications;
- Extend the scope of the rights granted by patents, providing new limitations to such rights;
- Eliminate the regime that exempts the examination of utility models, as well as to foresee new limitations regarding utility models;
- Provide the procedure for revocation of NIIP decisions, extending the situations in which it may occur;
- Clarify the deadline for filing a judicial appeal against NIIPs decisions;
- Provide the possibility of appealing arbitration decisions to the competent court, whenever the opposing party accepts it and where NIIP has a generic bond to an institutionalized voluntary arbitration center;
- Adapt to electronic means some of the procedures provided for in PIPC;
- Establish a new deadline for the initiation of judicial proceedings for the cancellation of patents, utility models and registrations;
- Exclude the practice of unfair competition acts as grounds for cancellation of registrations of designs, trademarks and logos;
- Provide the regime of destination of goods and ancillary sanctions for cases of contraventions provided for in the PIPC, as well as criminalize the violation of names, emblems and logos of undertakings;
- Provide the punishment of product import of counterfeit trademarks, and eliminate the requirement of an additional subjective element for the verification of the crime of sale and circulation of counterfeit products;



- Expressly provide the possibility of criminal police bodies to directly examine the seized objects when it is notorious that they are not manufactured or marketed by the holder of the right, as well as to institute a mechanism for the destruction of the goods before the beginning of the judicial proceeding;
- Define the concept of trade secret;
- Provide the conditions for the legal acquisition, use and disclosure of trade secrets, determining the situations in which these actions are illegal;
- Establish the necessary measures, procedures and remedies against the unlawful obtaining, use or disclosure of trade secrets, in particular measures to obtain and preserve evidence, the obligation to provide information, precautionary measures, arrest, obligation to indemnify, accessory sanctions, injunctions and measures relating to the publication of judicial decisions;
- Regulate the conditions, limitations and guarantees for the necessary measures, procedures and remedies against the unlawful obtaining, use or disclosure of trade secrets;
- Provide a transitional regime for some of the measures introduced in the PIPC;
- Replace the necessary arbitration regime established in article 2 of Law no. 62/2011, of December 12, by the possibility of appeal to voluntary arbitration, by expressly showing the will of all parties involved, in an arbitration agreement;
- Amend the arbitration process provided in article 3 of the said Law, providing the possibility of invoking and acknowledging the invalidity of patents with only *inter partes* effect;
- Amend the Law of the Organization of the Judicial System in order to adjust the competence of the intellectual property court in what concerns the cancellation and declaration of nullity of the rights provided for in the PIPC and to provide for the jurisdiction of that court for actions concerning trade secrets.

Regarding its entry into force, article 4 of this Decree-Law will enter into force 30 days after its publication. The provisions of the PIPC on the protection of trade secrets shall enter into force on January 1, 2019, and the remaining provisions, as well as the amendment to the Law of the Organization of the Judiciary, approved by Law no. 62/2013, of August 26, will enter into force on July 1, 2019.



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