

Intellectual Property

Information Paper

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ANTONIOU
ADVOCATES

“As with every aspect of our legal practice, explaining the legal framework in clear and concise terms is a fundamental characteristic of the way we work. It is only natural for a law firm striving to provide as clear, practical and efficient legal solutions as possible to have developed a working structure which allows direct addressing of the issues our Clients are faced with. Particularly during the turbulent times we live in, we are not looking to overload our Client with ‘legalese’ and charge for the mere provision of information that is publicly accessible. Instead, we aim to increase value for our services by providing our Client with our own straightforward description of the regulatory framework in every industry well before they even decide to contact us for the first time. In this way both sides benefit, as we receive an informed initial enquiry in relation to which we can accurately identify the legal issues and start working on their solution while our Client receives our immediate legal support. This is how we comprehensively deal with complex legal challenges in an increasingly competitive environment and this is how we differentiate ourselves from traditional approaches.”

Anastasios Antoniou

SENIOR PARTNER

Our Legal Services in Intellectual Property

Patents, trademarks and copyrights constitute the foundation of many major businesses and are catalysts in the increasingly competitive business environment, in which innovation is the differentiating factor. How you define and protect your innovation and creativity are strategic bottom-line issues but in times in which piracy and counterfeiting are rampant and IP is becoming increasingly lucrative and exposed in spheres of high risk, its protection becomes an imperative aspect of doing business. Whatever industry you are active in, from technology to entertainment or advertising and from publishing to pharmaceuticals, we can help you identify, register, manage and protect your IP assets, while our legal services also include taking swift and effective action against competitors infringing your rights, undertake all aspects of IP agreements such as franchising and licensing and overall provide legal solutions to a world in change.

Contact us at ip@antoniou.com.cy for more information or to discuss your legal needs.

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IP law in Cyprus

DOMESTIC Intellectual Property in Cyprus is regulated both under statute and at Common Law. The most important statutes include the following:

- The Patents Law, 16(1)/98
- The Trade Marks Laws CAP. 268 as amended by Law 63/62, Law 69/71 and Law 206/90
- The Partnerships and Trade Names Law, CAP 116
- The Intellectual Property Law 59/76 as amended by Law 63/77 and Law 18/93.

INTERNATIONAL Beyond boasting a domestic legislative framework encompassing all aspects of intellectual property, Cyprus is also a State Party to the following international conventions whereby reciprocal arrangements are in force in respect of intellectual property rights:

- Paris Convention for the protection of Industrial Property (Lisbon Act) Law 63/65 and (Stockholm Act) Law 66/83
- Convention establishing the World Intellectual Property Organisation WIPO Law 36/84
- Berne Convention for the Protection of Literary and Artistic Works (Paris Act 1971) Law 86/79
- Universal Copyright Convention Law 151/90
- Nairobi Treaty on the Protection of the Olympic Symbol
- Geneva Trade Marks Law Treaty 1994, Law 12(III)/96
- Patent Cooperation Treaty, 1970, Law 16(1)/98
- European Patent Convention 1973, Law 16(1)/98

Trade Marks

REGISTRATION The registration and protection of marks in relation to goods and services is governed by the Trade Marks Law, CAP 268 as amended by Law 63/62, 69/71 and 206/90 and by the Regulations of 1951-1992. The international classification of goods applies whereby goods and services are

categorised into 34 classes and 8 classes (ie 35-42) respectively. The register is divided into Parts A and B and marks are entered according to their distinctive nature.

For a mark to be eligible for registration and protection it must be original work and be distinctive, not copied from an existing mark. This also means that it should not refer to the quality and the nature of goods or services.

In order to register a mark a qualified Advocate must file with the Trade Marks Registrar on behalf of the applicant the following:

- (i) a fully completed application containing all relevant details including the name address and occupation of the applicant, the name and/or picture of the mark, the required class of the Registry applicable and a description of the mark;
- (ii) a form signed by the applicant authorising the lawyer to file the application.

On receipt of the application forms, the Registrar appoints a filing date and a number to the mark and conducts a search to establish the registrability of the mark. Where the mark is not registrable the Registrar may either object to such registration or impose conditions.

The applicant has the right to present his case and arguments prior to the Registrar deciding upon the application. In the case that the Registrar does not object and the application is accepted, conditionally or unconditionally, the Registrar publishes the mark in the Official Gazette of the Republic of Cyprus. Any party wishing to oppose the registration is invited to do so within two months from publication. The applicant is automatically notified of any opposition and given the chance to respond.

In the event of the Registrar not giving his consent to the registration, the applicant may apply for judicial review of the decision under Article 146 of the Constitution at the Supreme Court of Cyprus.

PROTECTION AGAINST INFRINGEMENT If a person infringes the registered mark of another person and refuses and/or fails to stop after the infringement has been drawn to his attention an action can be brought to restrain infringement.

The relief usually sought is an injunction restraining the further use of the mark by the unauthorised party or an

inquiry as to damages. If the infringement is in large scale, the court may order the delivery up of the spurious marks for destruction or order the defendant to tender an account of the profits made through the sale of the goods or the provisions of services in respect of which the proprietor's trade mark was infringed.

Proceedings cannot be instituted under the Trade Mark Law CAP. 268 in respect of infringement of an unregistered mark but the tort of passing off could offer relief. There are certain acts such as forging or falsification of marks and application of any false trade description to goods or services which are punishable by fine and/or imprisonment.

Trademarks and service marks are registered for an initial period of seven years which may be renewed on application for fourteen years periodically.

ASSIGNMENT

Registered marks Section 24 of the Trade Marks Law CAP 268 a registered mark allows the assignment of a trade mark on transfer of a business either with the entire or the remainder goodwill. A registered mark is assignable and in respect of either all or some of the goods or services. Section 26 provides that the registered proprietor of a mark has the power to assign it and give effectual receipts for any consideration for an assignment thereof.

Unregistered marks According to Section 24(3) of the Trade Marks Law CAP 268, an unregistered mark is assignable as a registered marks provided that at the time of its assignment the unregistered mark is used in the same business as the registered mark and is assigned at the same time and to the same person as the registered mark.

LICENSING

Registered marks The Cyprus Trade Marks Law, CAP 268, is identical to the British Trade Marks Act 1938 and the same principles which are applied under British Law for the licensing of trademarks apply also in Cyprus. Section 28 of the Trade Marks Law (which corresponds to Section 26 of the British 1938 Trade Marks Act) contains provisions for the registration of persons other than the proprietor as users of registered marks and provides that where this is done the mark is to be treated as still used only by the proprietor.

The 1938 Act left the prohibition of licensing of marks traditionally existed in British Law unaffected providing that cases where the licence was duly registered should be deemed not to be cases of licensing at all. The courts, however, held that under the 1938 Act any licensing arrangement which could properly be registered is legitimate whether registered or not. By registering the licensing the approval of the Registrar is obtained.

Unregistered marks As regards licensing of unregistered marks it seems that it is permissible as if the marks were registered.

EU TRADE MARK REGISTRATION Applications are filed at the Community Trade Marks office and upon approval a Community Trade Mark (CTM) Registration covers all 27 Member States of the European Union. The CTM system runs in parallel to the trade mark legislation of each Member State.



Patents

REGISTRATION The Patents Law 16(I) of 1998 established an independent local authority for the registration of patents, thereby rendering the registration of a patent in Cyprus independent from the registration of the same patents anywhere else but also allows patents granted under the European Patent Convention or under the International Corporation Treaty to be recognised in Cyprus upon registration. Any registered patents are published in the Official Gazette of the Republic thereby securing transparency and giving the right to any party to object to it. A Register of Patents identifying the owners of registered patents is maintained pursuant to statutory legislation.

PROTECTION AGAINST INFRINGEMENT Once a patent has been registered and a certificate of registration is granted and published, any persons other than the patentee are expressly prohibited from manufacturing, selling importing or otherwise commercially exploiting either the patented product or the product obtained by a patented process. Currently, the time period for which the State agrees to

prohibit third parties from using an invention is 20 years from the date of filing the application. In the event of infringement the patentee may commence an action in Court seeking an injunction and/or damages.

The most important grounds upon which any action for infringement of a patent may be defended or a patent may be invoked are that:

- (i) the patent is not for an invention within the meaning of the law;
- (ii) the invention was not novel;
- (iii) the invention was obvious;
- (iv) the invention is not capable for industrial application;
- (v) the invention belongs to a category of excluded subject-matter such as methods of treating humans and animals;
- (vi) the claims of the complete specification are ambiguous;
- (vii) the complete specification is insufficiently explicit;
- (viii) the application for the patent was irregular.

According to Section 26 of the Patents Law the duration of protection is twenty years from the date of registration. It should be noted that the duration of protection depends on the payment of an annual renewal fee. As regards exhaustion of rights attached to a patent, it can be said that once a product has been put on the market by the patent owner or with his express consent, he cannot restrict the use or the resale of the product. Nor can the patents owner prevent private acts that do not substantially affect the financial benefit of the right holder, i.e. the acts are done for non-commercial purposes.

ASSIGNMENT Patents rights can be sold by the patentee to anyone who is willing to buy them.

COMPULSORY LICENSING An application for a compulsory licence can now be filed with the Registrar at any time after the expiration of four years from the date on which the patent was granted (or after some other period described by the Registrar). When making its decision the patent office must consider the need to work inventions as well as the need for the inventor to receive reasonable remuneration.

SUPPLEMENTARY PROTECTION CERTIFICATE The law provides for an application of a supplementary protection certificate for pharmaceutical products which was not available under the old law. The certificate confers the same rights as the basic patent. The length of the period of protection offered by the

certificate is calculated in relation to the period for which protection was lost due to the authorization process but it cannot exceed five years.

Copyright

SCOPE OF PROTECTION Copyright in Cyprus is regulated by the Intellectual Property Rights Law, 59/76 as amended by subsequent Laws 63/77 and 18/93. Although no protection is afforded to works whose authors are not citizens or habitual residents in the Republic, or which are not first published in the Republic, section 18 of the Law extends the protection to works of non Cypriot origin by providing that the Law shall apply also to works which would be eligible of protection by virtue of International Treaties or Conventions binding the Republic. Such Treaties are eg the Berne Convention and the Universal Copyright Convention.

REMEDIES The Right of Intellectual Property Law provides remedies for copyright infringement. Section 14 of Law 18/93 sets out a range of offenses committed by those who infringe copyright. Penalties include fines or imprisonment for a term up to three years. The criminal court may order copies of the work in possession of the alleged offender, which appear to be infringing copies, to be destroyed or delivered to the owner of the copyright regardless of whether the alleged offender is finally not convicted.

In addition to the above remedies, The Right of intellectual Property Law provides that infringement is actionable per se independently of any contractual remedies which may be available by virtue of the copyright contract. Section 13 sets out the civil remedies which may be sought in the event of copyright infringement. They fall into two categories, namely: preventive and compensatory.

The preventive remedies are:

- (a) the power of search and seizure of infringing material
- (b) anticipatory injunctions

The compensatory remedies are:

(a) the award of damages to the plaintiff

(b) orders for destruction or delivery up of the infringing copies and the equipment by which copies are produced

(c) accounts

DURATION OF PROTECTION The term of protection is the life of the author and 50 years after his death. However, there are shorter minimum terms prescribed for certain types of works. The copyright for cinematographic work or a television work is 50 years after the work has been made available for the public. The term of protection of photographs is 25 years from the making of the work as is the term for works of applied art.

Copyright of Computer Programs

The transposition of the EC Directive on the Protection of Computer Programs into the Cypriot legal order means that computer programs are protected on the same basis as literary works. Therefore, provided the program constitutes original work, its author will have the exclusive right to copy the program, issue copies to the public, demonstrate the program to the public, and adapt or translate the program.

Converting a copyright program into or between computer languages and codes will normally constitute an 'adaptation' of the work. Similarly, storing a copyright work on a computer amounts to 'copying' the work, and running a computer program or displaying work on a visual display unit will usually involve copying. Any such use will therefore require the consent of the copyright owner unless it falls within an exception.

Certain specific exceptions apply in relation to computer programs, including:

- Making back-ups of computer programs which are necessary for the purposes of lawful use of the program;
- Copying the program in the course of decompiling it;
- Observing, studying or testing the functionality of a program in the course of lawful loading, displaying, running, transmitting or storing of the program;
- Copying or adapting the program, provided the person copying or adapting is the lawful user and the copying or adapting is necessary and is not prohibited by any term or condition of an agreement regulating the circumstances of lawful use.

In assessing whether an alleged infringement involves the whole or a substantial part of a computer program, courts will consider the content of, and the elements which make up, the program. The courts have held that substantiality is to be judged by looking at the skill, labour and expertise that went into the specific bits of code which are alleged to have been infringed. It is not a question of whether the system would work without that piece of code, or the amount of use the system makes of the code. As a result, there can be copyright infringement even if the actual code copied amounts to a very small percentage of the total software code in the program.

Contact us at jp@antoniou.com.cy to discuss your legal needs regarding the registration, protection or any other issue related to your intellectual property.