

Analytical Examination of the Acquis – Intellectual Property

„Screening“ 6/7 February 2006 (Croatia, Turkey) - Trade Marks

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Overview

- Directive 89/104/EC on the approximation of MS trade mark law (TMD)
- Council Regulation (EC) No 40/94 on the Community Trade Mark (CTMR)
- Commission Regulation (EC) No 2868/95 implementing the CTMR
- Commission Regulation (EC) No 216/96 – Board of Appeal
- Madrid Agreement and Protocol

Directive 89/104/EC-TMD

- Harmonization of substantive trade mark law of Member States
- “shall” and “may” provisions
 - f.ex. Article 3(1): “The following shall not be registered...”
 - Article 3(2): “Any Member State may provide that...”

TMD (2)

- Article 2: Any sign capable of being represented graphically, and

(ECJ C-273/00 -Siekmann of 12/12/02: representation clear, precise, self-contained, easily accessible, intelligible, durable and objective)

- Capable of distinguishing the goods and services of one undertaking from those of another

TMD - Absolute Grounds (1)

- Article 3: not a mark, non-distinctive, descriptive, customary in trade, certain shapes, contrary to public policy and morality, deceptive, emblems (6ter Paris Convention)

TMD - Absolute Grounds (2)

➤ Some important ECJ judgments:

- C-108 and 109/97 – Chiemsee (4/5/99)
- C-299/99 – Philips/Remington (18/6/02)
- C-53 to 55/01 – Linde, Rado (8/4/03)
- C-363/99 – Postkantoor (12/2/04)
- C-218/01 – Bottle (12/2/04)

TMD - Relative grounds (1)

➤ Article 4:

- Identical/similar marks, identical/similar goods and services, likelihood of confusion
- Optional: earlier mark with a reputation, non-registered trade mark or other signs used in trade, and others

TMD - Relative grounds (2)

➤ Some important ECJ judgments:

- C-251/95 – SABEL/PUMA (11/11/97)
- C-39/97 – CANON (29/9/98)
- C-342/97 – Lloyd Schuhfabrik (re Art 5 of the Directive) (22/6/99)
- C-375/97 – CHEVY (re Art 5 of the Directive) (14/9/99)

TMD - Rights conferred

- Article 5: Prohibit use in the course of trade, in particular
 - Affixing of sign on goods
 - Offering goods or stocking them under the sign
 - Importing, exporting
 - Use on business papers and in advertising
 - Important ECJ judgments: C-63/97 – BMW (23/2/99) and C-206/01 – Arsenal (12/11/02)

TMD - Exhaustion

- Article 7: TM proprietor can not prohibit use if goods have been put on the market in the Community by him or with his consent
 - Some important ECJ judgments
 - C-355/96 – Silhouette (16/7/98)
 - C-173/98 – Sebago (1/7/99)

TMD - Use of trade marks

- Article 10: Genuine use within 5 years of completion of registration procedure
- Sanctions for non-use: Article 11, Revocation Article 12
 - Important ECJ judgment
 - C-40/01 – Ansul/Ajax (11/3/03)

Community Trade Mark (1)

- Unitary Community title valid throughout the Community
- Administered by the OHIM – Office for Harmonization in the Internal Market (Trade Marks and Designs), Alicante, Spain

Community Trade Mark (2)

➤ The system – overview

- Application
 - Classification
 - Check for absolute grounds (Article 7 CTMR)
 - Possibility to overcome some absolute grounds through use (Article 7(3) CTMR)
- Opposition (within three months of publication of application)

Community Trade Mark (3)

➤ The system – overview continued

- On request of applicant, opponent has to prove use of earlier right (Article 43(2))
- Relative grounds for refusal (Article 8)
- Registration: Valid for ten years from filing date (Article 46)
- Revocation (Article 50)
- Invalidity (Article 51)

Community Trade Mark (4)

➤ Legal review

- Appeal to OHIM Boards of Appeal (Article 57)
- Action before the Court of First Instance, Luxembourg
- Appeal to European Court of Justice, Luxembourg, on points of law

Community Trade Mark (5)

➤ Other important features

- Priority (Article 29 et seq.): application in State party to Paris Convention or WTO within six months before CTM application
- Seniority (Article 34 et seq.): earlier identical national Member State marks can be protected within the CTM

Community Trade Mark (6)

- Other important features – cont.
 - Conversion (Article 108 et seq.): if CTM application is rejected or registered CTM falls, possibility to convert into national marks keeping the original filing date
 - Language regime (Article 115): application in any official EU language, second language (EN,FR,DE,ES,IT) for opposition, revocation and invalidity

Community Trade Mark (7)

FEES



For what?	Before	Now
application, individual mark	975	900
e-filing, individual mark	no special rules	750
each class exceeding three	200	150
application, collective mark	1675	1300
each class exceeding three	400	300
registration, individual mark	1100	850
registration, i.m., class exceeding three	200	150

Community Trade Mark (8)



FEES

For what?	Before	Now
registration, collective mark	2200	1700
registration, c.m., class exceeding three	400	300
renewal, individual mark	2500	1500
e-renewal, individual mark	n.a.	1350
renewal, each class exceeding three	500	400
renewal, collective mark	5000	3000
renewal, c.m., class exceeding three	1000	800

Community Trade Mark (9)

➤ Legal Instruments (add to CTMR)

<http://oami.eu.int/en/mark/aspects/reg.htm>

- Commission Regulation (EC) No 2868/95: detailed rules implementing the CTMR, recent change
- Commission Regulation (EC) No 2869/95: regulates the fees payable to OHIM
- Commission Regulation (EC) No 216/96: rules of procedure for OHIM Boards of Appeal

Community Trade Mark (10)

- Some important ECJ judgments:
- C-361/01 – Kik (9/9/03) (languages)
 - C-383/99 – Baby-dry (20/9/01) (Article 7(1)(c) CTMR)
 - C-191/01 – Doublemint (23/10/03) (Article 7(1)(c) CTMR)
 - C-456 and 457/01 – Tabs (29/4/04) (Article 7(1)(b), 3D mark)

Madrid Protocol

- International registration of trade marks under the Madrid Protocol adopted on 27 June 1989
- As from 1 October 2004:
 - An international application can be based on a CTM application or registration
 - the EC can be designated in an international application
 - <http://oami.eu.int/en/mark/madrid/default.htm>