



La marca y el diseño comunitario

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OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

OAMI



- **OHIM**

- Creada en 1994
- Es una agencia de la Union europea responsable del registro de la marca y el diseño comunitario, títulos de propiedad que son validos y protegibles en todo el territorio de la Union europea
- Es autosuficiente desde el punto de vista presupuestario gracias a las tasas cobradas por estos servicios

1. Administra la Marca Comunitaria:

- recibimos, examinamos y registramos solicitudes de marcas
- resolvemos oposiciones y solicitudes de nulidad contra las marcas comunitarias

2. Administra el diseño comunitario:

- recibimos, examinamos y registramos solicitudes de diseño
- resolvemos solicitudes de nulidad contra los diseños registrados



OHIM: Mission and Role

OFFICE FOR HARMONIZATION
OF THE INTERNAL MARKET
TRADE MARKS AND DESIGNS

- Respect of the basic principles of the internal market (the free movement of goods and services and free competition) is based on standardisation of IP at European level
- OHIM Member states (27):
 - Austria, Belgium, Bulgaria, Cyprus, Czech, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, The Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Sweden, Spain, and United Kingdom



Community Trade Marks

What is A Community Trade Mark (CTM)?



- It gives the company exclusive rights in the EU
- The owner of the CTM can prevent all third parties not having his consent from using in the course of trade:
 - any identical sign for identical goods and services
 - any identical or similar sign for identical or similar goods and services if likelihood of confusion
 - any identical or similar sign for goods and services not similar if CTM has a reputation

- **Trade Mark Directive (1988)**
 - harmonises the conditions for obtaining and continuing to hold a registered trade mark
 - but leaves member states free to determine procedural provisions concerning registration, revocation and invalidity of trade marks
 - also harmonises substantive provisions regulating conflicts between confusingly similar marks

- **Community Trade Mark Regulation (1993)**
 - The CTM offers the advantage of uniform protection in all countries of the European Union, via a single registration procedure with OHIM
 - It is valid for a period of 10 years and may be renewed indefinitely
 - CTM application must be filed in any of the 20 languages of the European Community



Interaction with other European National TM systems and with the Madrid Protocol

- **National** system (“the national route”):
 - File individual applications at each of the 25 EU national/Benelux TM offices
 - Each application subject to its own national law
 - Translations and attorney fees per application

Different ways to protect trade marks within the EU

- **International** system (“the international route”)
 - Trade Marks: Madrid system and/or Madrid Protocol for trade marks
 - home application/registration is needed
 - OHIM as office of origin and EU as “designated party”
 - Request in EN, FR or ES - basic fee to be paid to WIPO
 - No single unitary right is granted - ‘bundle’ of rights’
 - Subject to national law of each country
 - Individual fees are payable to the national TM offices
 - In case of problems: Translation Costs & Lawyers fees
- **Community** system: the **CTM**

Or a combination of these systems (at the free choice of the applicant)

A CTM is enforceable in any State of the EU, while a national TM (e.g. a French TM) is enforceable only where registered (e.g. France)

It is not possible to register, before a national IP office, a national TM which is identical to a prior CTM

It is not possible to register in OHIM a CTM which is identical to a prior national TM (e.g. French TM)

The owner of a national TM can claim a priority when filing a CTM before OHIM. Such priority can be claimed on a national TM or even a Chinese TM

If OHIM refuses a CTM, the applicant can convert the application into individual national TM applications

A non EU TM holder can file an international TM before WIPO based on its national TM and designate the EU

Therefore, a non EU applicant may protect its brand in Europe by choosing any of these options:

- filing before the TM office of each EU country**
- filing before OHIM and obtain a CTM**
- filing before WIPO and designate the EU in the form**

Each route has its advantages and disadvantages:

- for example, it is not possible to obtain a CTM if the word mark is descriptive in one EU language (e.g. “agua” for water bottles cannot be registered before OHIM, but it can be probably registered in Germany)**
- for obtaining a CTM via WIPO, the Chinese applicant must have a prior Chinese trade mark, otherwise, it is not possible**
- a Spanish or Maltese or German, etc. trade mark does not protect the other EU countries**

The most straightforward way to obtain a CTM is filing electronically at OHIM or filing an international application with WIPO and designating the EU

The CTM can also be filed by fax or by post/courier (although it is more expensive)

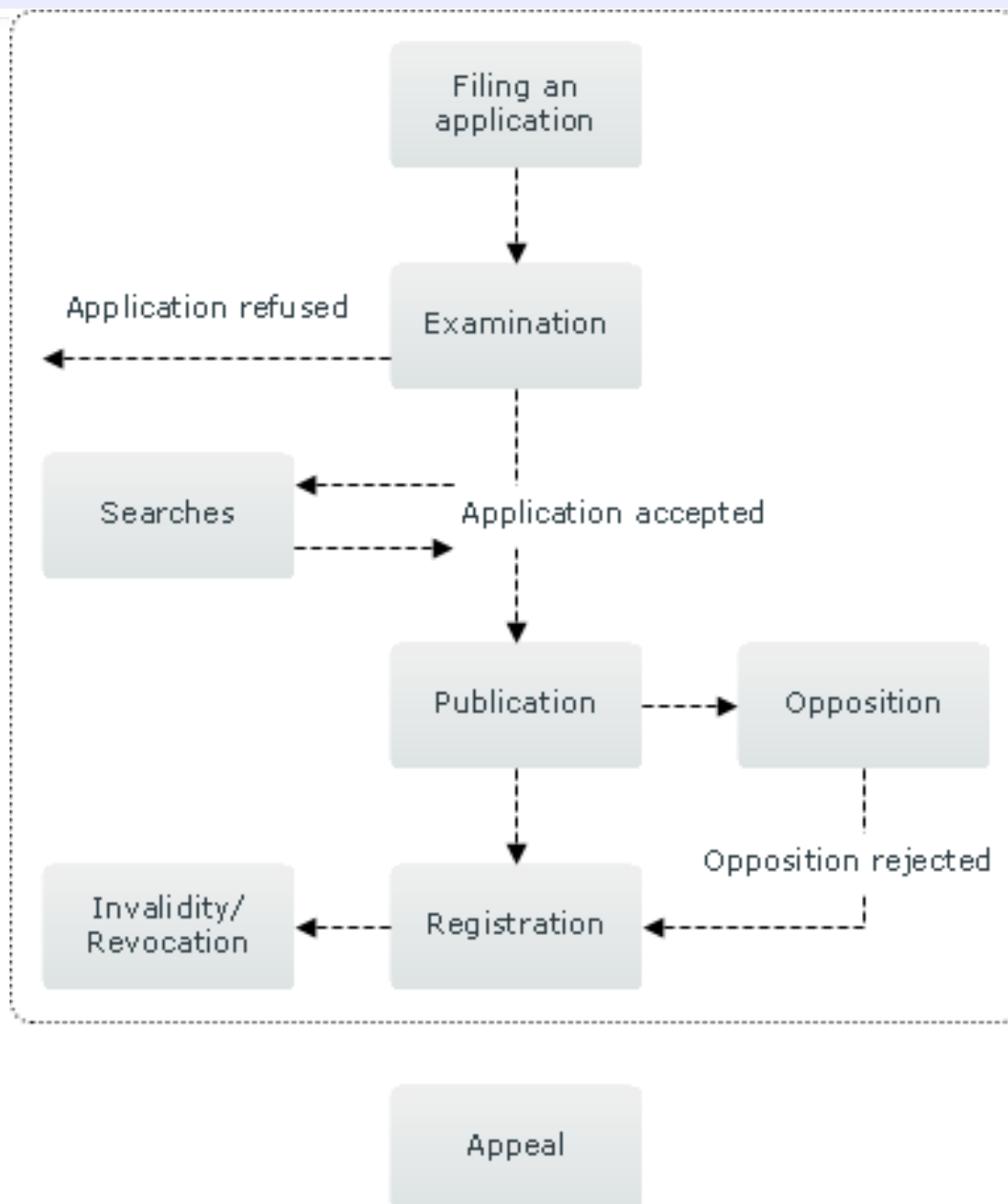
Filing directly at OHIM: there is no need to have a prior national TM

Filing via WIPO and designating the EU: there is a need to have a prior national TM

Community Trade Mark Procedure



HARMONIZATION
OF COMMUNITY TRADE MARK
LAW



Representation
before the
OHIM

Inspection of
files and copies

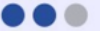
Changes to the
register

OHIM examines whether

- A) the application has been correctly filed**
- B) there is a reason not to register the TM (“absolute grounds for refusal”)**
- C) in which class the goods and services belong to**

Important: OHIM does not examine by its own motion whether the filed TM is in conflict with a prior TM or any other prior right

This is a FUNDAMENTAL difference between some national systems and the EU system



OHIM verifies if the application meets the formal requirements of the CTM regulations:

- Request for registration
- Applicant identification
- List of goods and services
- Representation of the mark

- Supporting priority documents
- Full payment of fee
- Legal representation (where necessary)

The Regulation foresees situations where trade marks cannot be registered because:

- the interest of the consumers must be protected (e.g. TMs which go against public order and morality)**
- free competition must be protected (e.g. TMs which are descriptive)**

OHIM must verify whether a given TM can be registered or must be refused, in light of the regulatory “grounds for refusal”

Language check - all EU languages

Opposition



- Within three months of publication, the owner of a prior right may request OHIM to refuse the CTM based on “Relative grounds for refusal” = conflicts with earlier rights of third parties
- **Not examined ex officio by the office**
- In practice, less than 20% of CTMs are opposed
- Based on earlier EU rights only
- Registered or unregistered signs (but not a copyright or a design right)
- Facts and arguments for the parties

Relative Grounds for Refusal

- Identical mark and identical goods/services...
- Identity/similarity - likelihood of confusion...
 - Earlier rights – registered marks...
 - Earlier rights – pending applications...
 - Earlier rights – well known marks...

Relative Grounds for Refusal

- Filing without consent of proprietor...
- Opposition by non-registered right owner...
- TM with reputation in EU - Detrimental to mark – no similarity of G&S...

Characteristics of the Opposition Procedure

- No waste of resources to solve conflicts where the parties are not harmed by the later application
- Proof of use or proof of reputation must be furnished by the interested party, not by the Office
- No opposition is granted on the basis of non-used marks
- Proceedings encourage friendly settlement
- (“cooling-off period”)

Characteristics of the Opposition Procedure

Further features:

- E-publication (faster to become aware of new CTMs)
- “Watch service”, owners of already registered CTMs are informed if they are cited in a search report; so they can decide whether to file an opposition
- Goods and services databases (which goods we consider similar) – predictability



Ex-officio examination of earlier rights:

- Blocks 100 % of all applications although only 20 % of them would catch an opposition
- Rejects more marks than required to protect owners of earlier rights
- Does not allow flexible approach to the use requirement
- Requires (rather than allows) official lists of reputation marks
- Discourages owners to defend their own marks and makes them rely on the Office
- But the Office is there to protect the public interest and not (necessarily) private economic interests

- Even if a CTM is registered, it can be cancelled by OHIM upon request: cancellation and revocation
- Courts may also cancel the CTM if the defendant introduces a counterclaim in infringement proceedings
- Revocation: it is revoked from a specific date, based on any of these grounds: the CTM is

NEVER USED

Becomes generic

Becomes deceptive

- Invalidity: it is declared void as if no CTM ever registered. It can only be declared based on one of the following
GROUNDS

Grounds for Invalidity..

- Relative grounds
 - Same GROUNDS that OHIM checks during an OPPOSITION, plus
 - Right to a name or of personal portrayal
 - A copyright
 - An industrial property right (e.g. a design right)
- Absolute grounds
 - Same GROUNDS that OHIM checks during examination, plus bad faith

Enforcement by national CT Courts

- Community Trade Mark Courts are national civil courts competent for **infringement actions**
- They are designated by the respective countries
- List of competent courts to be found at OHIM's website
- Which court is competent?
 - Defendant's domicile, establishment
 - Plaintiff's domicile, establishment
 - Alicante CTM courts
 - Agreement between the parties
 - Appearance before another court
 - Place where rights allegedly violated:

- **Order of prohibition (injunctions)**
- **Destroy counterfeits**
- **Damages**
- **Provisional measures**
- **The court decision in one EU State is enforceable in the others**
- **Courts must consider the registered CTM valid, unless the validity of the registration is contested by a counterclaim**
- **More than 460 cases throughout the EU have been reported - case law accessible at <http://oami.europa.eu/ows/rw/pages/CTM/caseLaw/judgementsCTMCourtsList.en.do>**

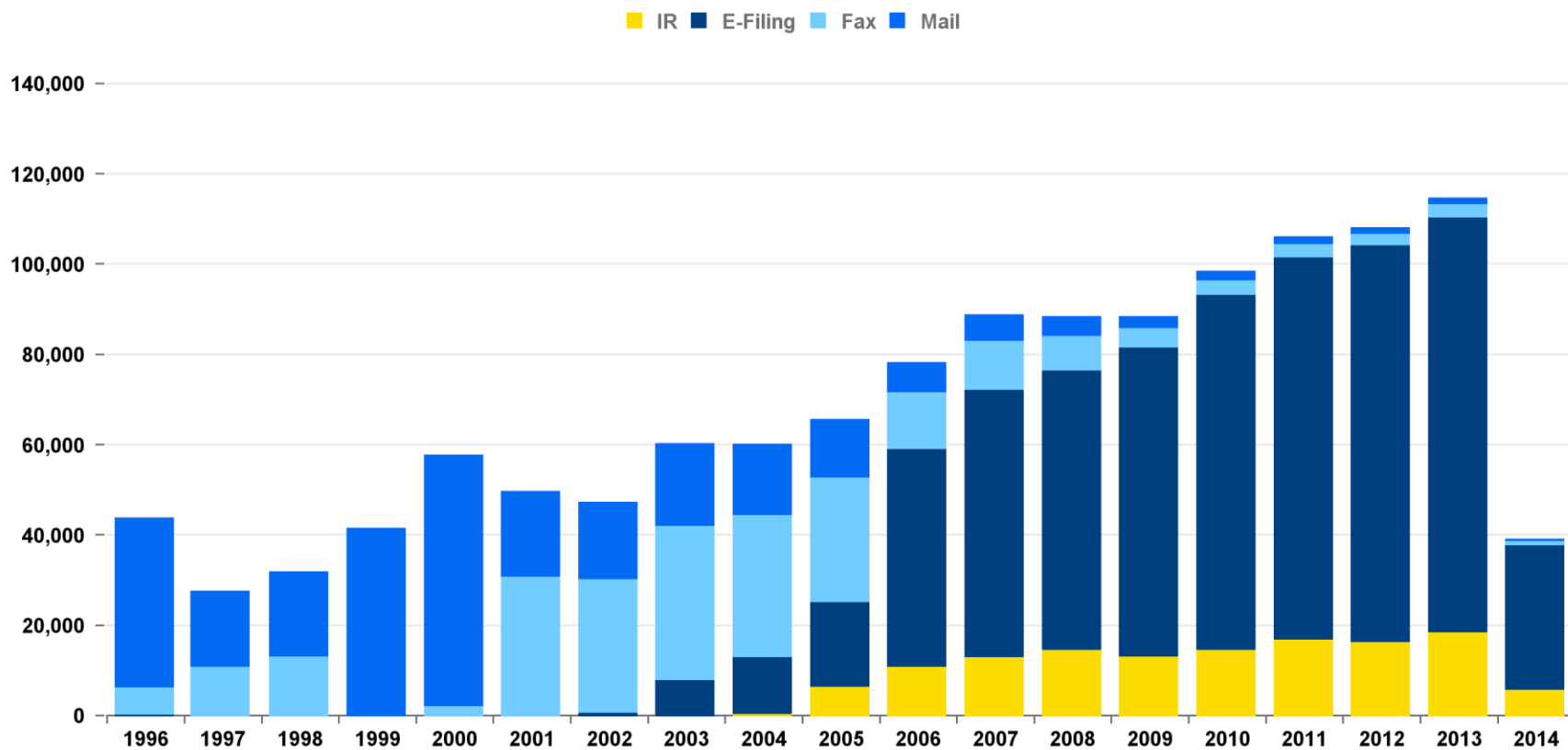


4. The CTM system protects well-known trade marks and allows to protect geographical indications under certain conditions
5. The system is based on the idea that the conflict between a prior right and a new application is solved **ONLY** if the owner of the earlier right has an interest to file an opposition
6. The system is sound from a legal and practical point of view: CTM holders can effectively enforce their rights
7. When you prepare your trade mark strategy so as to go global and become an innovative economy, think of the CTM as a valuable asset for protecting your brands in the 500-million inhabitants market known as the “European Union”

Estadísticas solicitudes



Overview of CTM Applications received



* IR stands for International Registration

Solicitudes españolas por año



1996 2,758 2,758

1997 1,476 1,476

1998 1,928 1,928

1999 2,576 2,576

2000 3,451 3,451

2001 3,426 3,426

2002 3,877 3,877

2003 5,838 5,838

2004 5,532 5,532

2005 5,822 5,822

2006 6,320 6,320

2007 7,346 7,346

2008 6,912 6,912

2009 7,011 7,011

2010 7,767 7,767

2011 7,981 7,981

2012 8,066 8,066

2013 8,501 8,501

2014 3,191 3,191

Total 99,779 99,779

Top 25 solicitantes

EL CORTE INGLES, 459, 45.99 %

BANCO BILBAO VIZCAYA ARGENTARIA, S.A. 332 33.26 %

TELEFONICA, S.A. 261 26.15 %

ALMIRALL S.A. 182 18.23 %

MIGUEL TORRES S.A. 182 18.23 %

UNIDENTIFIED OWNER 145 14.53 %

BANKINTER S.A. 139 13.93 %

BANCO SANTANDER, S.A. 136 13.63 %

LABORATORIOS PHERGAL, S.A. 127 12.72 %

ISDIN, S.A 125 12.52 % FABRICAS AGRUPADAS DE MUNECA DE ONIL, S.A. 108 10.82 %

CAMPER, S.L 105 10.52 %

REPSOL, S.A. 104 10.42 %

ANTONIO PUIG, S.A. 102 10.22 %

GONZALEZ BYASS, S.A. 98 9.82 %

GRUPO OSBORNE S.A. 94 9.42 %

JIMENEZ SANCHEZ 94 9.42 %

VICENTE GANDIA PLA S.A. 94 9.42 %

CORPORACION DE RADIO Y TELEVISION ESPANOLA, S.A. 91 9.12 %

NATRAZAHOR S.A.U. 86 8.62 %

SESDERMA, S.L. 86 8.62 %

BEVELAND, S.A. 85 8.52 %

BODEGAS MARTIN CODAX SA 85 8.52 %

LABORATORIOS CINFA. S.A. 85 8.52 %



What signs cannot be trade marks



- **Article 7 CTMR**
- **Absolute grounds for refusal**
- **1. The following shall not be registered:**
 - **(b) trade marks which are devoid of any distinctive character;**
 - **(c) trade marks which consist *exclusively* of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, *geographical origin* or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;**

- Trade mark is contrary to Article 7(1) b) and c)
- Monaco is the name of the of the principality on the mediterranean see which capital is Monaco.
- Relevant public will perceive the terms as a reference to the territory
- Decision 29/1/2013 Fourth Board confirmed
- The Board held that MONACO is the subject matter for products of classes 9 and 16, the destination or the origin of services in class 39, the place for services of class 41 and the place where the services of class 43 will be offered.