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LEGAL PROTECTION OF TRADEMARKS

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Legal Framework

- Regulation 207/2009 of the European Council of 26 February 2009 on the Community trade mark ;
- Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks;
- National laws of transposition.

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What is a trade mark ?

A trademark is a sign used in trade to identify products or services as to indicate its origin from a specific business.

The trademark right is an exclusive right enabling the proprietor to prohibit the use of identical or similar signs of other person or entities, if they do not have prior rights.

Requirements for trademark protection

The requirements for trademark protection are the same in all Member States and in the Community trademark system. The trade mark is composed by a sign, normally graphically represented, being distinctive and not illegal or contrary to public policy.

a) A sign, represented graphically

The basic function of a trademark is to indicate to the public from which company a good or service comes from (origin).

This sign must be represented graphically. The reason of that condition is really practical: trademarks must be registered and the register can be consulted. In consequence, the trademark Offices can only accept « visually » reproducible signs.

It is thus possible to register:

- A word mark: letters, numbers,...
- A figurative mark: pictures, graphics, logo,...
- A combined mark: with both words and pictures
- A 3D mark: representation of a three-dimensional shape, such as the actual product or its packaging.
- A colour mark: with its specific coordinates in the colour space
- A sound mark: represented graphically (musical notation,...)

b) Distinctive

Given the indication function of a trademark, the sign must be distinctive. This distinctiveness is assessed on a case by case basis.

Descriptive slogans or names, or a sign that can be used to describe one characteristic of the product/service won't be, in principle, distinctive enough.





c) **Lawfulness**

Certain forms of signs are prohibited. A few examples :

- if contrary to law and order, or to the morals;
- flags and other State (or international) emblems;
- signs misleading the public, for instance on the nature, the quality or the geographical origin of the goods/services.

The different trademark registries are usually accessible on the internet, which allows the applicants to check the availability beforehand.

Refusal of protection

A trademark is excluded from protection for absolute grounds if it is:

- Descriptive, that is to say that the brand itself describes the nature, destination or origin of the goods and services.
- Misleading, that is to say, in view of the trademark, the consumer expects that the products have quality, provenance or special features, but in reality they cannot exist for the product.
- Banal or without an distinctiveness, that is to say that the trademark does not have any distinctive feature.
- Illegal, this means that the sign is contrary to public order, morality and is banned from use.

During the application process, the Office will examine these requirements.

Opposition

A sign can also be excluded from protection for relative grounds if it is similar or identical to a mark previously registered for similar or identical goods or services. In the Community trademark system and in most (not all) other trademark systems, relative grounds must be claimed by the proprietors of prior rights by means of an opposition. Such opposition can be filed within three months (in many countries) after a trade mark has been published.

The Office will decide on the opposition after both parties, the applicant and the opponent, have submitted evidence and arguments.

Currently, one in five applications are opposed by the owners of trademarks that are already on the market. The applicant can minimize the risk of opposition by searching for potential conflicts before they apply.





Scope of protection

a) Rights of the owner

The owner of a registered trade mark is in most countries able to prevent 3 types of infringements, occurring in the course of trade

- The use of an identical sign for identical goods/services;
- The use of an identical or similar sign for identical or similar goods/services if there is a likelihood of confusion for the consumer;
- The use of an identical or similar sign for not similar goods/services when the trademark is well-known on the given territory, if unjustified profit is taken from the trademark or its reputation;

To obtain a sanction for such behavior and protect the brand in its distinctive feature, the trademark holder can file an action for infringement which, according to the country will be a judicial or administrative action.

Claims of national unfair competition law often go hand in hand with trademark infringements.

b) Territoriality and specialty

Two main principles have to be considered about trademark protection:

- The principle of territoriality. Trademark protection may only be enforced in the territory for which the registration was obtained. A Spanish registration does not allow an infringement action in China or the United States.
- The principle of specialty. The registration of the trademark does, in the absence of prior rights, confer a monopoly in respect of the products or services listed in the registration towards identical or similar products provided that a likelihood of confusion is given.

c) Extended protection for well-known trademarks

There is an exception of these two basic principles: the well-known or marks having a high reputation.

Article 6bis of the Convention of Paris (1967) provides that “in determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including in the Member concerned which has been obtained as a result of the promotion of the trademark.”





This enhanced protection is primarily intended to prevent companies from taking unfair advantages of the reputation of a famous mark or harm its reputation or image.

d) Use requirement

After a 5 years grace period, in which in many countries the trademark must not be used, the trademarks must be used for the registered goods or services to avoid being challenged by third parties and to enforce the rights based on the registration. Accordingly, after this grace period, the trademark owner can only successfully enforce his trademark if it is in use. If it is then not in use, any other party can also file a cancellation action for non-use.

Duration

The duration of trademark protection varies from country to country, but in most of them, it lasts 10 years. This protection, however, can be renewed indefinitely upon payment of a renewal fee.

Registering a trademark in the EU

Trademark law in Europe comprises both European Union (EU) legislation as well as the national laws of the 28 Member States of the Union on the protection of marks (or, for Belgium, the Netherlands and Luxemburg, the Benelux Convention).

The Regulation 207/2009 allows for registration of Community trademarks offering Community-wide protection. The trademarks are administered by the Office for Harmonization in the Internal Market (OHIM), in Alicante, Spain.

The community trademark covers the 28 EU members. This trade mark takes effect in the entire territory of the European Union.

a) Registration application to OHIM

A trademark can be registered for a person or a legal entity.

You can file directly with OHIM or via a national office that will communicate the application to OHIM. The application must include:

- Identification of the applicant
- Sign to be applied
- Payment
- The list of products or services for which the mark is registered





- The list of classes for the products or services.

b) Examination of the application for registration

The Office will examine the admissibility of the application and its formal regularity. It will further examine whether the mark is distinctive, not misleading and licit. However, there are no searches for prior rights.

Then the Office will publish the application for registration to allow third parties to intervene in the proceedings. Third parties may:

- Render observations concerning the conditions of validity
- File an opposition within 3 months.

Only after conclusion of the opposition proceedings the trademark will be registered and with this become effective.

c) Advantages and disadvantages

The major advantage of the community trademark is that one registration process results in trademark protection in 28 countries.

Another advantage is that it is not necessary to prove use of the trademark in each of the countries of the European Union. Indeed, the use in a significant part of the European Union can be regarded as sufficient (details are under discussion).

Its main drawback is that one prior right in any of the 28 member states is sufficient for its holder to object to the registration of the mark. That is why many applicants perform a search for prior rights in the member states of the EU before applying for a community trademark.

