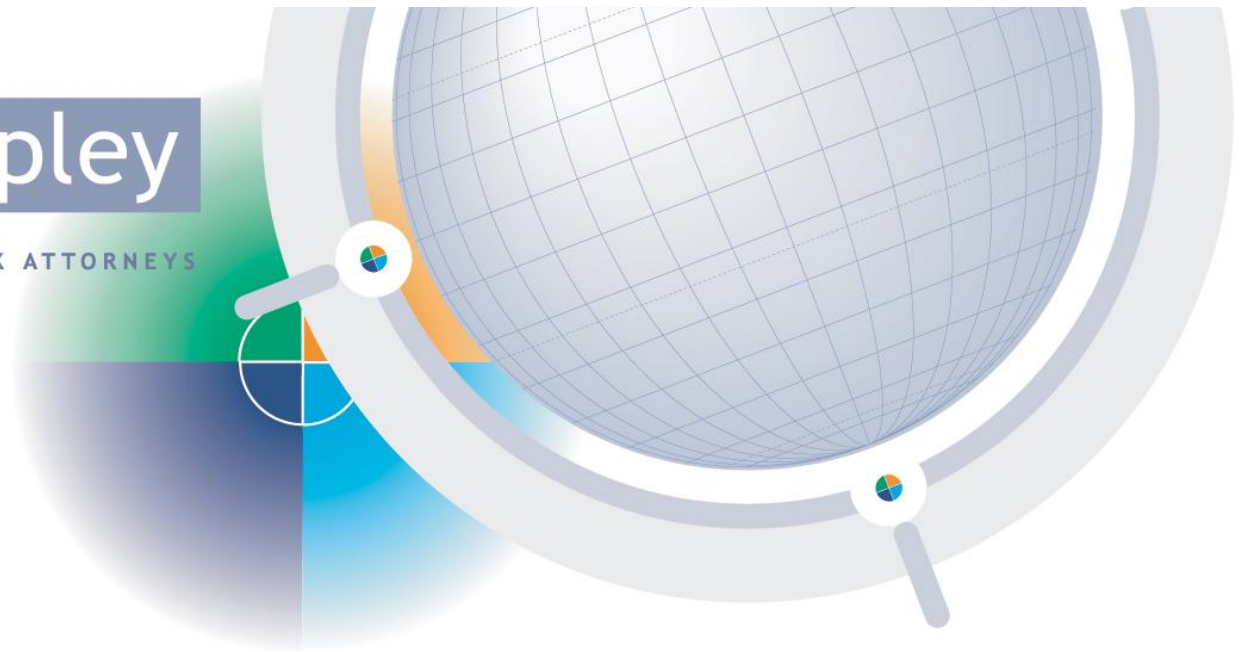


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EUROPEAN PATENT & TRADE MARK ATTORNEYS



Unregistered Rights and Their Use in Oppositions Kate Széll

26 March 2010

Article 8(4)

- Non-registered trade mark or another sign
- Used in the course of trade
- Of more than mere local significance
- Rights acquired prior to application/priority date
- Right to prohibit the use of a subsequent trade mark.

Practicalities

- Who can claim these rights – Article 41(1)(c)
 - Proprietors
 - Persons authorised under the relevant national law to exercise these rights
- Proving the existence of prior rights – OHIM's list of rights previously established by the office

County Variation

Many have no unregistered trade mark rights e.g

Benelux

France

Spain

Estonia

Lithuania

Romania

Slovenia

Cyprus

Unless mark is well-known

Country Variation

Those that do have unregistered rights include those where a lower degree of notoriety will do e.g.

Denmark

Hungary

Malta

Slovakia

United Kingdom

Ireland

Country Variation

Those that do have registered rights often also need high degree of notoriety e.g.

Finland

Germany

Greece

Italy

Sweden

Bulgaria

Poland

Portugal – also 6 months from use priority filing

Lithuania – only if recognised as well-known in a court decision

Country Variation

Business/company name/other rights e.g.

Austria

Belgium

Netherlands

Finland

France

Germany

Greece

Italy

Portugal

Spain

Sweden

Estonia

Slovakia

Luxembourg

Country Variation

Distinctive titles of protected literary and artistic works e.g.

Denmark

Finland

Germany

Greece

Sweden

Not Covered

Any other right e.g.

Copyright
Design rights

Invalidate – Article 53

Used in the course of trade

- Opposition no. B1365289 to Application no. 577556 HAVIS AMANDA
- Havis Amanda – famous statue conveyed to Helsinki in 1908 which has become a symbol of the city

Of more than more local significance

- More than one city/province
- rationale

Examples - Spain

Opposition no. B1359282 to Application no.
6508212 LA GRAN TASCA – 25 January
2010

- Spanish business name
- Use not more than merely local
- In general, the territory of a single city, even if large, is merely local, as is also that of a region or province

Examples – France

- Opposition no. B1060203 to Application no. 4764494 CIF
- CIF EURO MORTGAGE on the Parisian company and commercial register
- Relevant article of French IP Code refers to registration
- However, for OHIM “the restriction on registering a mark includes the possibility of objecting to use”
- Relevant services – those for which use shown

Examples - UK

- Board of Appeal decision R513/2008-1 of 19 March 2009.
Tilda Riceland Private Ltd v. Siam Grains Company Limited BASMALI (figurative)
- Extended passing-off
- 1st instance decision – no goodwill
- Board of Appeal – no proprietorship of the unregistered mark BASMATI

Examples - UK

“This does not mean that a passing-off argument may never be brought in the framework of Article 8(4)CTMR. The argument may be brought provided the claimant proves ownership of the earlier sign in addition to ownership of the goodwill” – paragraph 28

Examples - Denmark

Opposition no. B144115 to Application no. 227728
IL FORNAIO – 21 October 2004

- Unregistered trade mark and company name
- Mere commencement of use in Denmark of a trade mark establishes a trade mark right which persists as long as the mark is continuously used
– Section 3 Danish Trade Marks Act

Examples - Denmark

- Provisions talk about registration not use ...
- Danish law complies with European standards in terms of conflicts between signs used in the course of trade.

To Sum Up

Not enough just to have a national right

use in more than one city or region

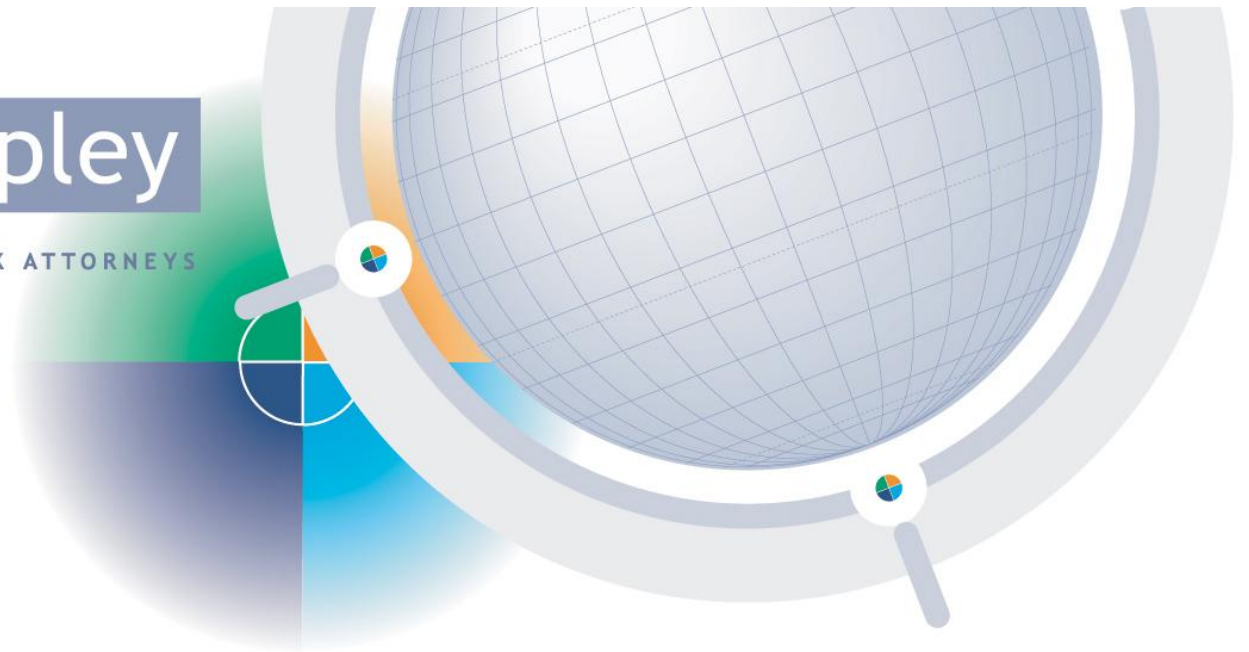
right to prevent registration gives a ground ... for
now

Anything slightly unusual is going to be difficult.

Any questions?

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