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WOMEN IN BUSINESS LAW AWARDS 2011
Claridges Hotel, London June 29, 2011



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TRADE MARK STUDY: COEXISTENCE PROPOSAL TROUBLESOME

14 March 2011

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Simon Crompton, London

Although brand associations across Europe have broadly welcomed the Max Planck Trade Mark Study, there are serious concerns over the coexistence of similar marks

The study, commissioned by the European Commission to look at the overall functioning of the European trade mark system, was published last week. It was welcomed as serious, rigorous and well thought out by representatives of brand owners.

"This was a very thorough piece of work," said Tove Graulund, chair of the committee at MARQUES that is monitoring the study. "A lot of hard work has gone into it in order to try and address every question."

Some aspects of the study that had worried brand owners at earlier stages of the drafting had also been removed. These included providing evidence of use as part of the renewal of a trade mark, reducing the period within which use must be proven from five to three years (a particular concern for the pharmaceutical industry) and several points that threatened the unitary nature of the Community trade mark system.

Other points in the study that were welcomed included the emphasis on improved harmonisation of trade mark rules across the EU, and a statement reinforcing that trade marks can contain many aspects of a brand, not just a word or logo.

As expected, there were several points on which the brand groups disagreed, often with each other.

COEXISTENCE

One such point was the coexistence of marks across the EU, presumably intended to help with the problem of the broad coverage of the Community trade mark against what can be pretty narrow use.

The study proposes: "The registration and use of subsequent national trade marks in a Member State remote from the part of the Community where a conflicting earlier CTM, which has been registered for a period of at least 15 years, was used should be allowed provided that the later mark was applied for in good faith."

However, it would mean a national applicant would have to build up local use of a brand sufficient to make its registration, all the while facing the risk that before those 15 years are up the CTM owner would spread its market to that jurisdiction.

"I can see what they're trying to do, but it's a very woolly proposal," said Dawn Franklin, chair of European brand association AIM. "It is open to abuse and is unlikely to lead to any beneficial effects, either for the CTM owner or the national applicant. Would anyone actually launch a branding strategy given that it could all be undermined if the CTM owner decides to start selling in that market?"

Franklin pointed out that several safeguards have been introduced from previous drafts, including that if the national applicant is using an identical mark for identical goods, or is in a neighbouring country, then it can be assumed the application is in bad faith.

"But there will always be people waiting to abuse that system, to register something that is nearly identical or just register an identical mark and try to extract money from the CTM owner," she said.

Tove Graulund at MARQUES agreed: "The suggestion on 15 years is rather concerning. It does highlight how the Max Planck Institute believes there should be limits on the protection afforded by trade marks, though."

Christina Sleszynska, Europe representative at INTA, commented: "That proposal for the coexistence of the CTM and remote national marks was slightly surprising. It opens a lot of questions though, so we'll wait to see until there are some more details."

The more general point on genuine use, emphasising that this should be examined on a case-by-case basis and not restricted by geographical boundaries, was welcomed by all brand owners. There is more detail in Managing IP's report on the study's release, [here](#).

Among other concerns of brand groups were fees, revenue and renewals. See more detail from Managing IP [here](#).

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