

Feedback form for comments on the draft Guidelines

User Association/National Office	MARQUES - The European Association of Trade Mark Owners
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Contributor (name & position)	MARQUES - European Trade Mark Law and Practice Team
Linguistic version the comments refer to	EN X DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT <input type="checkbox"/>
Part/Section/Chapter of the Guidelines the comment(s) refer to	Part C, Section 5, paragraphs 2.1.1 and 2.1.2., and paragraph 3.
Page of the document	Paragraph 2.1.1. at page 4; paragraph 2.1.2. at page 5; paragraph 3. at page 9, all of the document with track changes
Issue(s) you wish to comment on	<p>No reason is found for any objection to the reasoning on the scope of applicability of Article 8(5) EUTMR, according to the new version of its wording as introduced by the Amending Regulation:</p> <p><i>‘5. Upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.’</i></p> <p>At page 9, under paragraph 3 Conditions of Application, for a mere sake of absolute clarity, the wording of point 2. could be amended (proposed added wording is in bold) to read: “identity or similarity between the contested EUTM application and the earlier registered mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered”.</p> <p>With respect to the guidelines provided under paragraph 2.1.2 Relationship between marks with reputation (Article 8(5) EUTMR) and well-known marks (Article 8(2) EUTMR), also in view of the new version of the wording of Article 8(5) introduced by the Amending Regulation, the interpretation which is given seems to leave the question open, when a non registered well-known mark eligible to protection according to Article 8(2) (c) EUTMR had to be protected against a later applied for mark, when the goods and services are dissimilar.</p> <p>The purpose of Article 8(2)(c) has been to avoid a legal gap and to protect <u>reputed</u> (perhaps this term should be replaced by the term well-known, to avoid confusion) non registered trademarks, as Article 8(5) EUTMR protects only registered trademarks and those non-registered trademarks with a well-known character would have otherwise remained without protection – apart from that afforded by Article 8(4) EUTMR.</p> <p>Although well-known marks which are not registered in the relevant territory</p>

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cannot be protected under Article 8(5) EUTMR against dissimilar goods, the Office indicates that this is without prejudice to the fact that they may also be protected under Article 8(4) EUTMR, however provided that the relevant national laws afford them an enhanced protection against dissimilar goods and services.

It should be noted, however, that in practice, a legal gap is likely to remain, as in a certain, not irrelevant, number of national laws, there is no protection afforded to a non registered mark – unless in some jurisdictions, this latter may be considered well-known in the sense of Article 6bis of the Paris Convention, which in turn requires similarity or identity between the goods and services and that a likelihood of confusion must be found. In other national laws, where a non registered mark may be eligible to protection, the requirements governing the acquisition of rights may vary from a simple use to a use in such a way that the non registered mark has become established on the market or to a use having acquired a reputation. However, in general, such a reputation is not considered to have to exceed the threshold of a general knowledge - or a certain recognition in the course of trade - within the relevant market sector and in the relevant territory.

These facts are clearly also reflected and explained in Part C, Opposition, Section 4, Rights under Article 8(4) and 8(4)(a) EUTMR. Under paragraphs 3.2.2. concerning non-registered trademarks at page 7, it is also considered that the scope of protection for those non registered trademark rights under the national law regimes is not uniform, although – when it is foreseen - it is generally quite similar to the scope of protection under the provisions in the EUTMR concerning registered trademarks.

Under paragraph 3.5. Scope of protection in the same Part C, Opposition, Section 4, at page 26, it is stated that where the applicable national law provides protection for unregistered trademarks, which is different from that found in Article 8(1) EUTMR, the scope of protection of the earlier right invoked follows from national law. If for example, the applicable national law grants protection to unregistered marks also for dissimilar goods and services under certain conditions, the same protection will be granted under Article 8(4) EUTMR.

In practice, an enhanced protection to a well-known non registered mark, irrespective of the identity, or similarity or non similarity of the goods and services – and beyond likelihood of confusion or of misleading of the consumers - does not seem to be foreseen in most of the national laws of the EU Member States, unless the well-known non registered mark has become renowned (e.g. in Poland) or is prestigious (e.g. in Portugal), i.e. reputed, reasonably more in the sense of and according to the conditions that in the EU law would apply for registered trademarks under Article 8(5) of the EUTMR.

Under the above circumstances, it should be questioned that in light of the clear scope of applicability of Article 8(5) EUTMR, according to the new version of its wording as introduced by the Amending Regulation, which does not extend to non registered trademarks, well-known marks that are not registered might realistically be eligible to an enhanced protection against dissimilar goods, as such enhanced protection may neither be obtained under Article 8(4) EUTMR.

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<p>Suggestion for text</p>	<p>In Section 5, at page 9, under paragraph 3 Conditions of Application, for a mere sake of absolute clarity, the wording of point 2. could be amended (proposed added wording is in bold) to read: “identity or similarity between the contested EUTM application and the earlier registered mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered”.</p>
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<p>Part/Section/Chapter of the Guidelines the comment(s) refer to</p>	<p>Part C, Section 5, item 2.2.</p>
<p>Page of the document</p>	<p>7 of the document with track changes</p>
<p>Issue(s) you wish to comment on</p>	<p>No reason is found for objection to the reasoning on the fact that Art. 8 (5) – in the new version of its wording as introduced by the Amending Regulation, will be applicable , irrespective of whether the goods or services for which the later mark is applied are identical with, similar to or not similar to those for which the earlier trademark is registered.</p>
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<p>Part/Section/Chapter of the Guidelines the comment(s) refer to</p>	<p>Part C, Section 6, item 1.2.1.2</p>
<p>Page of the document t</p>	<p>6 of the document with track changes</p>

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<p>Issue(s) you wish to comment on</p>	<p>No reason is found for objection to the amendment provided to simply reflect the change of point in time from which consequences of lack of use become effective.</p>
<p>Suggestion for text</p>	

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<p>Part/Section/Chapter of the Guidelines the comment(s) refer to</p>	<p>Part C, Section 6, item 2.5.1.</p>
<p>Page of the document</p>	<p>21 of the document with track changes</p>
<p>Issue(s) you wish to comment on</p>	<p>No reason is found for objection to the amendment providing that for opposition filed on or after the entry into force of the Amending Regulation, if the earlier mark is subject to the use requirement, the actual period for which use must be shown, shall now be computed backwards, i.e. from the date of priority or of filing of the contested EUTM application, whichever is earlier, instead of the date of publication of the contested EUTM application.</p> <p>In line with the above change, when an opposition is filed against an international registration designating the EU, if the earlier mark is subject to the use requirement, the opponent shall prove use of the earlier mark in the five year before the date of the international registration. When an opposition is filed against a subsequent designation of the Union, it must be understood that the relevant date for computing the five years of use, shall start on the date that the subsequent designation was recorded by the International Bureau <u>and notified to the Office</u>.</p> <p>It is noted that an explanation on this latter situation in clearer terms in the relevant two paragraphs at page 22 may be needed, as the current reference to the 18 months period in the second paragraph might be confusing.</p>

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Suggestion for text	Amend the wording “or if the Union was subsequently designated ...” Into “or if the Union was subsequently designated and such designation notified to the Office on ...”