



Developments in EU Trade Mark Law

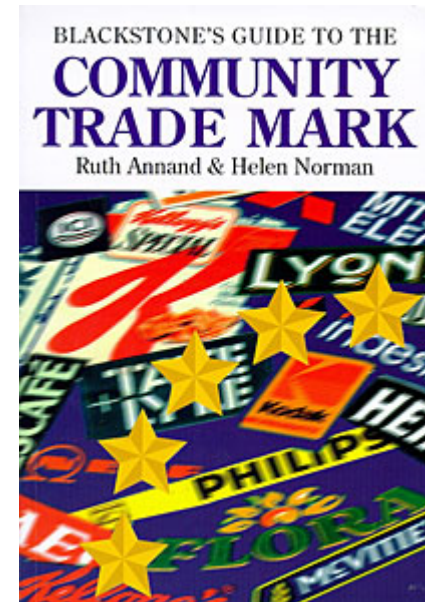
The ABC Meeting of FICPI, New Orleans

15-19 May 2013



Introduction

- The Community Trade Mark
- The Community Trade Mark – then and now
- The Max Planck Institute Study Proposals and the draft changes to the Community Regulation and Trade Marks Directive
- The CJEU decision in ‘IP TRANSLATOR’ – where does the law stand?
- Validating Use of a CTM Registration following the CJEU decision in ‘ONEL/OMEL’



The Community Trade Mark

- A unitary right
- Administered by OHIM
- Ex officio absolute grounds examination only
- Locus standi to file opposition/cancellation on relative grounds
- Conversion mechanism
- Seniority mechanism
- Cost efficient and effective
- A success story following in the great EU traditions of wine lakes and butter mountains



Ch..Ch..Ch..Changes at OHIM

- Then



- Now*



Ch..Ch..Ch..Changes at OHIM

- Then



- Now



Ch..Ch..Ch..Changes at OHIM

- Then



- Now



Ch..Ch..Ch..Changes at OHIM

- Then



- Now



Ch..Ch..Ch..Changes at OHIM

- Then



- Now



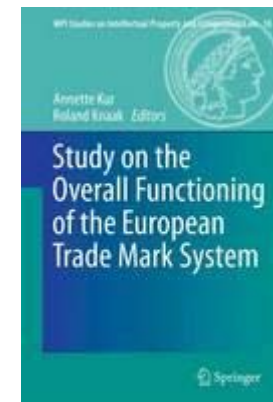
The MPI Study

The Institute focused on:

- investigating the views of the relevant stakeholders in the European trade mark systems (on the basis of the contributions received, the Institute organised two hearings with representatives of the various associations in June 2010);
- collecting information from national trade mark offices, in particular information on structure, procedures, enforcement and co-operation with users and with OHIM; and
- a representative survey among users of the Community Trade Mark (“CTM”) system which was conducted in February and March 2010 by the Institut für Demoskopie Allensbach.



MAX-PLANCK-GESELLSCHAFT



The MPI Study Proposals and the draft changes to the Community Regulation

1. Genuine Use



2. Distribution of renewal income to National offices



3. Removal of 1 month period to pay filing fee



The MPI Study Proposals and the draft changes to the Community Regulation

4. Shortening the Opposition period
5. Reduction of opposition term in respect of EM designations under IR
6. Deletion of the 2 month period to provide the statement of grounds of appeal



The MPI Study Proposals and the draft changes to the Community Regulation

7. Current regime on searches – no relative grounds examination – no presumed validity



8. Filing Applications through National Offices

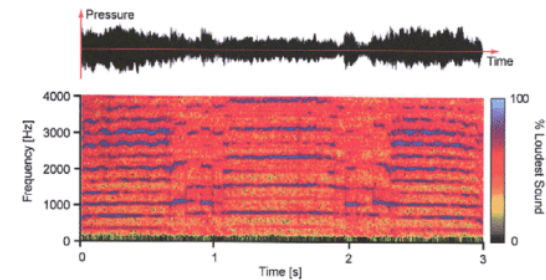


9. Class fees



The MPI Study Proposals and the draft changes to the Community Regulation

10. Graphical Representation



11. Seniority



12. Non-use calculation period



The MPI Study Proposals and the draft changes to the Community Regulation

13. Goods in transit



14. Comparative advertising

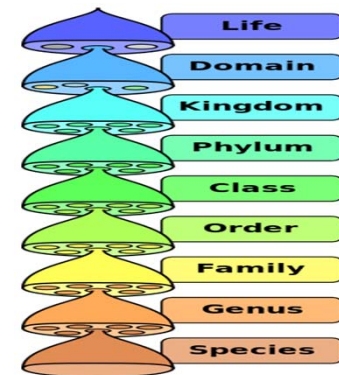


IP Translator

Case C-307/10 Chartered Institute of Patent Attorneys v Registrar of Trade Marks (CJEU Decision 25 June 2012; decision of UK Appointed Person Geoffrey Hobbs QC May 2013)



- Use of class headings
- Test case – divergent practice between UK/OHIM
- Specifications must be clear and precise
- The fall-out from the decision – OHIM's interim responses
- The Taxonomy Project
- Are specifications inflation proof? (find out at the FICPI Open Forum – Sorrento)



Validating use of a Community Trade Mark following the Omel/Onel case

Case C-149/11 *Leno Merken v Hagelkruis Beheer B.V.*
(CJEU decision of 19 December 2012)

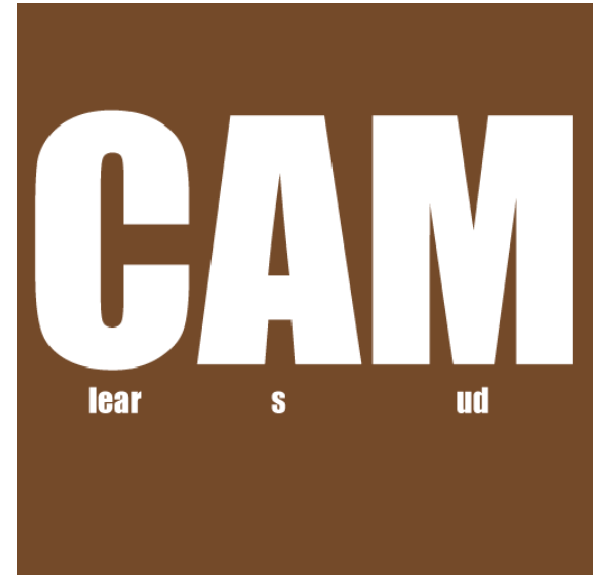
Article 15(1) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that:

- (i) use of a Community trade mark within the borders of a single Member State is not, of itself, necessarily sufficient to constitute genuine use of that trade mark, but
- (ii) it is possible that, when account is taken of all relevant facts, use of a Community trade mark within an area corresponding with the territory of a single Member State will constitute genuine use in the Community.



Validating use of a Community Trade Mark following the Omel/Onel case

- Genuine use in the Community is use that, when account is taken of the particular characteristics of the relevant market, is sufficient to maintain or create market share in that market for the goods and services covered by the Community trade mark.



Summary

- Continued European harmonisation
- Fear that the quality of examination and administrative opposition/cancellation decisions will suffer
- FICPI position paper
- Attendance at the forthcoming EC Commission hearing in Brussels – June 2013
 - Anticipated changes to Regulation – 2013
 - Anticipated changes to Directive and National law - 2014
- Further judge-made law seeking to please everyone but in fact pleasing nobody
- Watch this space!



J A ♦ K E M P



FICPI-UK

The British Association of The International
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Any Questions?

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