



QUESTIONS & ANSWERS



Trade mark opposition procedures; and TM distinctiveness and likelihood of confusion in RG

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Questions and Answers

Part I

1. Clarifications on the Beatles vs Beatle case

The question on – whether you see Beatles on a wheelchair or equipment, would it remind you of the Beatles - also depends on the reputation the trademark has. In the case of the Beatles, they have a very high global reputation and especially within the European Union. The greater the reputation, the higher the probability that you will establish the link. Both the recording of music and wheelchair target the public at large. The question is “could the Beatle trademark for wheelchairs profit from the reputation of the Beatles in the area of sound records, video records and films?”. In this case the Court said yes, since the image of freedom, youth and mobility with which the earlier ‘Beatles’ trade mark is associated, can be transferred to the later ‘Beatle’ trade mark. More information can be found in the link below.

T-369/10

<http://curia.europa.eu/juris/document/document.jsf?jsessionid=CCCEA1A358E3674934EE2F0CBD7366D7?text=&docid=121151&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=8546764>

2. In the European regulation, bad faith can only be invoked by the action of a third party and in the invalidation process?

In principle yes. It will not be assessed ex officio. In opposition proceedings you cannot rely on bad faith as a separate ground. In Article 8 (3) EUTMR there are elements of bad faith, but you have these requirements mentioned before, which are more limited than the concept of bad faith. In cancellation proceedings you have the ground of bad faith, and if you prove it the entire trademark can be cancelled on this basis.

3. In relation to the Beatle case: was the case ever appealed?

This Beatle case was appealed to the Court of Justice and the appeal was dismissed. More information can be found in the link below.

C-294/12

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=137603&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=8546782>

4. What is the Spanish translation for “passing-off”?

“Passing-off” is used in English as a term in other languages. A possible translation to Spanish could be “Usurpación”.

Part II

5. You earlier referred to a database for comparison of goods and services.

This is the database of the office, called similarity tool. It is publicly available to anyone.
<https://euipo.europa.eu/sim/>

6. Can you tell us about the practice with regard to disclaimers? I know that disclaimers are at the request of the applicant.

First of all, in the new applications we do not accept disclaimers anymore. However, we have to deal with them because there can still be disclaimers in the existing trademarks or in the earlier ones.

For more information about the Disclaimer in the Office's practice see the links below.

<https://euipo01app.sdlproducts.com/1803468/1788652/trade-mark-guidelines/8-disclaimers>

<https://euipo01app.sdlproducts.com/1803468/1788372/trade-mark-guidelines/3-2-3-4-disclaimers>

http://trademarkblog.kluweriplaw.com/2019/07/15/disclaimers-a-thing-of-the-past/?doing_wp_cron=1594222042.2081239223480224609375

7. So you don't accept disclaimers at all in the applications even if the applicant offers it?

We don't have this option anymore. We still have limitations but we don't have disclaimers anymore so they cannot be offered.

8. If you have a mark eg. Apple computers in relation to computers, it is obviously registerable, would you disregard the word computers as a non-registerable element and move forward with the registration?

If we have apple computers, we would not have an issue with this trademark. We have to consider trademarks as a whole, which means that if the trademark has any distinctive element, then the trademark as a whole would be distinctive for us.

In the case of apple computers, I would say in a way we don't need the disclaimers. When we would be comparing it, the part computer would be afforded this minimal distinction.

9. What is the basis for not accepting the disclaimer anymore?

The basis for non-accepting disclaimers is a change of law. There was a legal reform and the disclaimers were just removed.

10. Was there a reason or justification?

Disclaimers are very complicated and have always caused a lot of problems. The disclaimer has the effect that the element disclaimed is not a part of the protection. If the element is non distinctive when we conduct our comparisons, we will consider it anyway. But it is not automatic like when you have a disclaimer.

11. With reference to the previous presentation and the second one: what approach will you use with regards to priority applications (when actually examining the mark where the applicant claims priority)?

Applicants have the possibility to claim priorities. When we conduct our assessment, we consider as a relevant date, the date of priority, if it has been proven. As a result of the priority that has been validly claimed and proven by the applicant if the earlier rights are not earlier then there is no likelihood of confusion, because the earlier right would have to be earlier.

12. Regarding timeline and opposition procedure.

Generally, we give each party 2 months to provide observations. When the cooling off period is finished, the opponent has 2 months. They can request an extension of another 2 months. This already makes 4 months. If they want another extension they will have to explain/argue why.

There can be situations where opposition proceedings can be suspended. This prolongs the proceedings as well. If that is not the case, after we receive observations from the opponent, the applicant has 2 months to reply. They can request an extension which is usually granted. If another extension is requested, then it has to be justified. Usually after this point no more extensions are granted and the proceedings are closed. Applicants can request another round of proceedings.

In theory, the proceedings last around 6 – 8 months, but extensions happen frequently, so normally one would have to count with at least a year.

EUIPO trade mark and design guidelines are constantly updated here:

<https://guidelines.euipo.europa.eu/1803468/1789398/trade-mark-guidelines/1-introduction>

13. On the existence of well-known trademarks. The legislation in Saint Lucia in this case does not speak of well-known trademarks but mentions a trade mark that has acquired a reputation in Saint Lucia. Would that be classified similarly as well-known trademarks?

Well known trademarks are defined in the Paris convention. Our laws also refer to this. We can invoke well known trademarks for example under likelihood of confusion. This is the only not registered trademark that can be invoked in this ground, the well-known trademark. It depends on how you understand it in your legislation.

In our practice, well known trademarks and reputed trademarks are not the same.

Relationship between marks with reputation (Article 8(5) EUTMR) and well-known marks (Article 8(2)(c) EUTMR)

<https://euipo01app.sdlproducts.com/1803468/1787430/trade-mark-guidelines/2-1-2-relationship-between-marks-with-reputation--article-8-5--eutmr--and-well-known-marks--article-8-2--c--eutmr>