



QUESTIONS & ANSWERS



Unregistered Marks and Other Signs Used in the Course of Trade

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Questions and Answers

- 1. After all that was said, would you then say that registered TMs would get better protection than the non-registered ones or is it the other way around?**

As long as the opponent fulfills all the requirements of the specific ground of opposition on which the opposition is based, the outcome will be the same, namely 'opposition upheld'. If the opposition is based on Article 8(1)(b) EUTMR (likelihood of confusion) and on an earlier registered trade mark, if the opponent substantiates its earlier mark, proves its entitlement to file an opposition and the requirements of Article 8(1)(b) EUTMR are met (e.g. identical/similar goods, identical/similar signs, etc.), the opposition will be upheld.

The same will happen if all the requirements of Article 8(4) EUTMR are fulfilled and the opponent bases the opposition on a non-registered trade mark used in the course of trade of more than mere local significance. The opponent, however, needs to prove that the requirements under that ground are fulfilled, namely the opponent has to be entitled to an earlier eligible right, to provide the Office with the applicable (national) law, as far as the requirements for acquisition of the earlier right and the right to prohibit use of a later sign are concerned, then the opponent has to prove (argue) that these requirements are fulfilled, and to show that the earlier sign is used of more than mere local significance.

- 2. Could you please elaborate on the second example ('Art' magazine case)? I did not see how the word 'Art' would be connected with the type of business. Why is it the business identifier?**

In this case (R 181/2011-1), 'Art' was the name of the magazine (title of work), that appeared on the cover of the magazine. Under this title the magazine was circulated on the relevant market and the business of its proprietor was conducted. Therefore, the title 'Art' was the business identifier for that particular magazine-oriented business of its proprietor, as it functioned as the name of the business under which the magazines were circulated and sold.

- 3. The use of more than mere local significance is a very important requirement. What evidence can be shown to prove that an earlier sign is used in that way?**

The opponents can submit a large variety of evidence as long as taken together it fulfills the requirements of time, place, nature and extent (of more than mere local significance) of use. I will give you a few examples of evidence that could be submitted. Invoices are valuable evidence, as long as they show the relevant goods or services and the sign in question in a way that connection is established between them. There are also other documents that can show business transactions such as customers' orders, distribution and sponsoring contracts, samples of correspondence with clients. Advertising and promotional material can also be submitted, such as advertising in magazines, or on other media.

Evidence from Internet can also be used. The website of the proprietor has to show that a commercial activity is conducted and a commercial turnover is received. This could be done

for example by evidence showing that the specific website has been visited and, in particular, that orders for the relevant goods and services have been made through the website by a certain number of customers in the relevant period.

4. **Would everyday language expressions receive protection under Article 8(4) EUTMR?**

The European Union Trade Mark Regulation does not protect everyday language expressions as such. I would not perceive an everyday language expression as a business identifier, meaning it would not serve to identify the business of certain entity as to show that certain goods and services or certain business activity are originating from that entity. So, the everyday language expressions would not fall in the scope of Article 8(4) EUTMR and they would not get protection under any other of the grounds available for filing an opposition under EUTMR.

If we, however, talk about a business identifier (e.g. a trade name) used to refer to the company's business in its **everyday transactions**, then depending on the provisions of the applicable law and provided all the requirements of Article 8(4) EUTMR are fulfilled, such an identifier could be eligible for protection.

5. **What kind of business or how big does it have to be to rely on protection under Article 8(4) EUTMR?**

The business does not necessarily have to be spread all over the relevant territory, but it is generally considered that a substantial part of that territory shall be covered. If the business is strictly local and it is confined to a small part of the territory (one town or even a province) then it would be difficult to prove that the requirement of use of more than mere local significance is fulfilled. However, as said before, it is a case by case assessment and it would depend on the circumstances of the specific case.

For instance, in the abovementioned 'Art' magazine example in a niche market of expensive cultural magazines, it was considered that relatively small circulation figures can suffice to qualify use of the sign as being of more than local significance. Respectively, the market and its specifics have to be taken into account, as well as the economic impact of the use of the sign.

Ultimately, it depends on whether the use of the sign under which the business is conducted fulfils the requirement of more than mere local significance. This is so, because the aim of the provision of Article 8(4) EUTMR is to provide protection for signs that have sufficient commercial presence, so not just any sign would prevent the registration of an EU trade mark, which is a mark with an effect of all Member States.