



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS

THE CTM SYSTEM: When Third Parties come into play

Sandra Ibañez, Information Centre, OHIM

Cluj-Napoca 20 June 2011

WWW.OAMI.EUROPA.EU



When do third Parties come into play?

After publication of the application :

- **Third parties observations**
- **Opposition proceedings**

After registration:

- **Cancellation proceedings**



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS

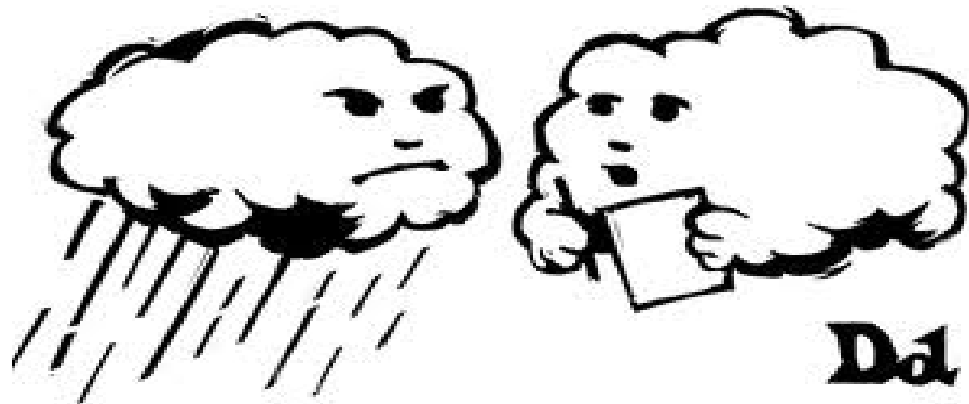
PLAN

- 1. Third party's observations**
- 2. Opposition proceedings**
- 3. Cancellation proceedings**



1. OBSERVATION BY THIRD PARTIES : General principles

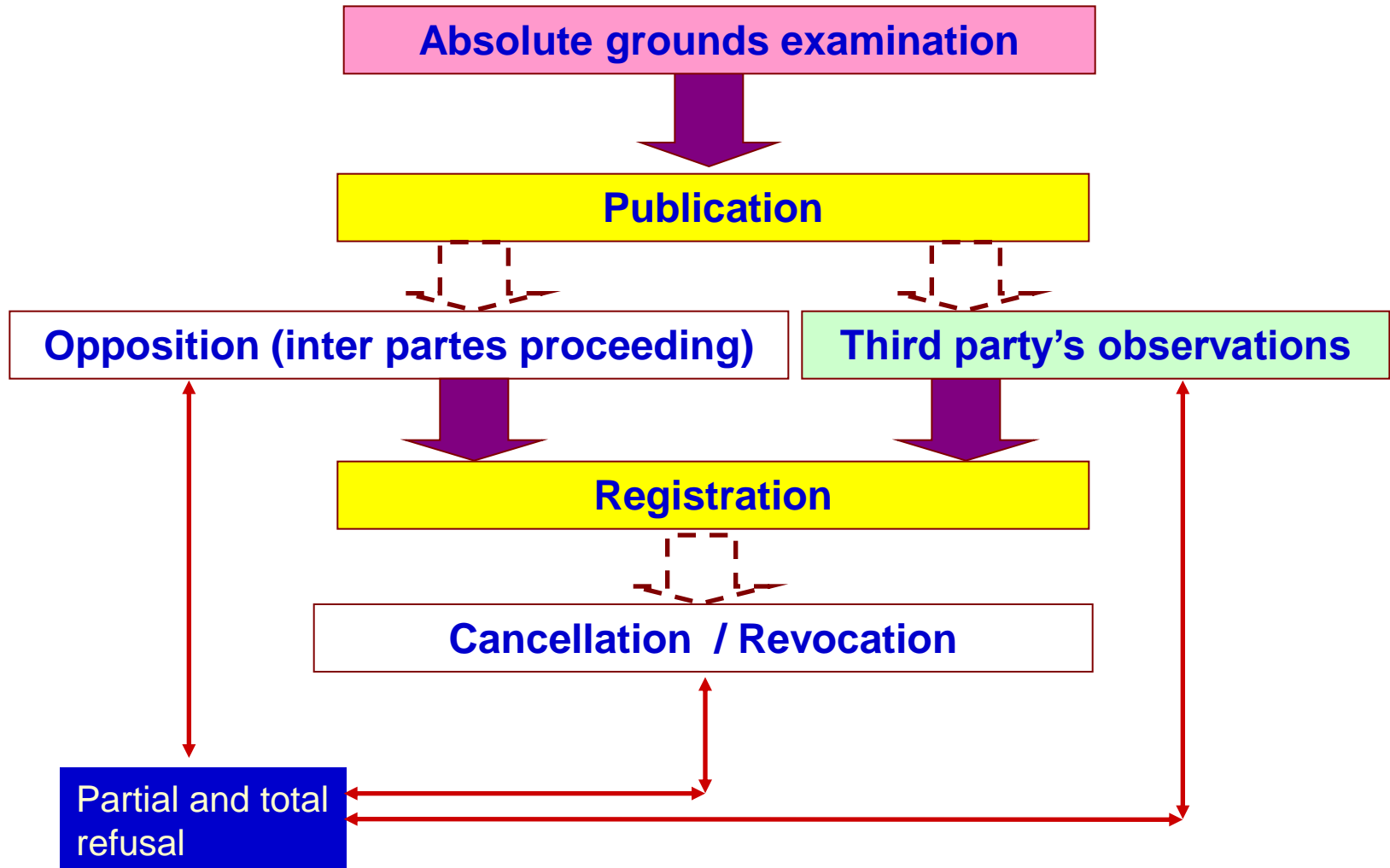
Article 40 CTMR



"I've learned to express my anger through my writing instead."



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS





1. OBSERVATION BY THIRD PARTIES : General principles

- **WHO?**

- Any natural or legal person, any group or body
- No need to be represented
- Person filing observations is not party to the procedure

- **WHEN?**

- After the publication of the application
- Before the expiry of the opposition period if the CTM is not opposed or,
- Before the end of the opposition proceedings if the CTM is opposed.

- **HOW?**

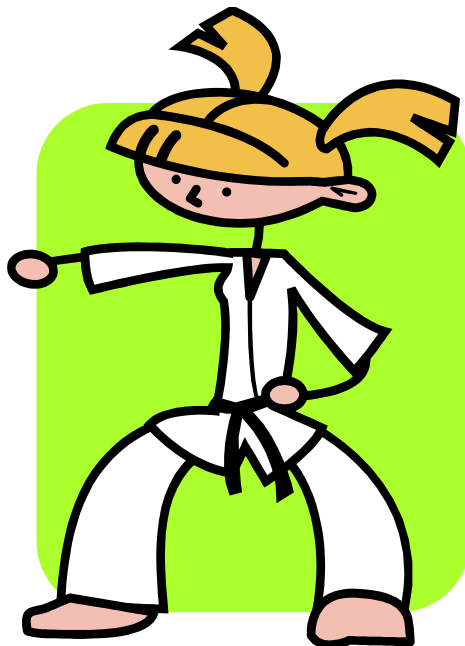
- In any of the five languages of the Office or in the language of application.
- In writing, special submission, no special form, no fee

- **WHY?**

- Due to an existence of an **absolute ground**, the trade mark shall not be registered.



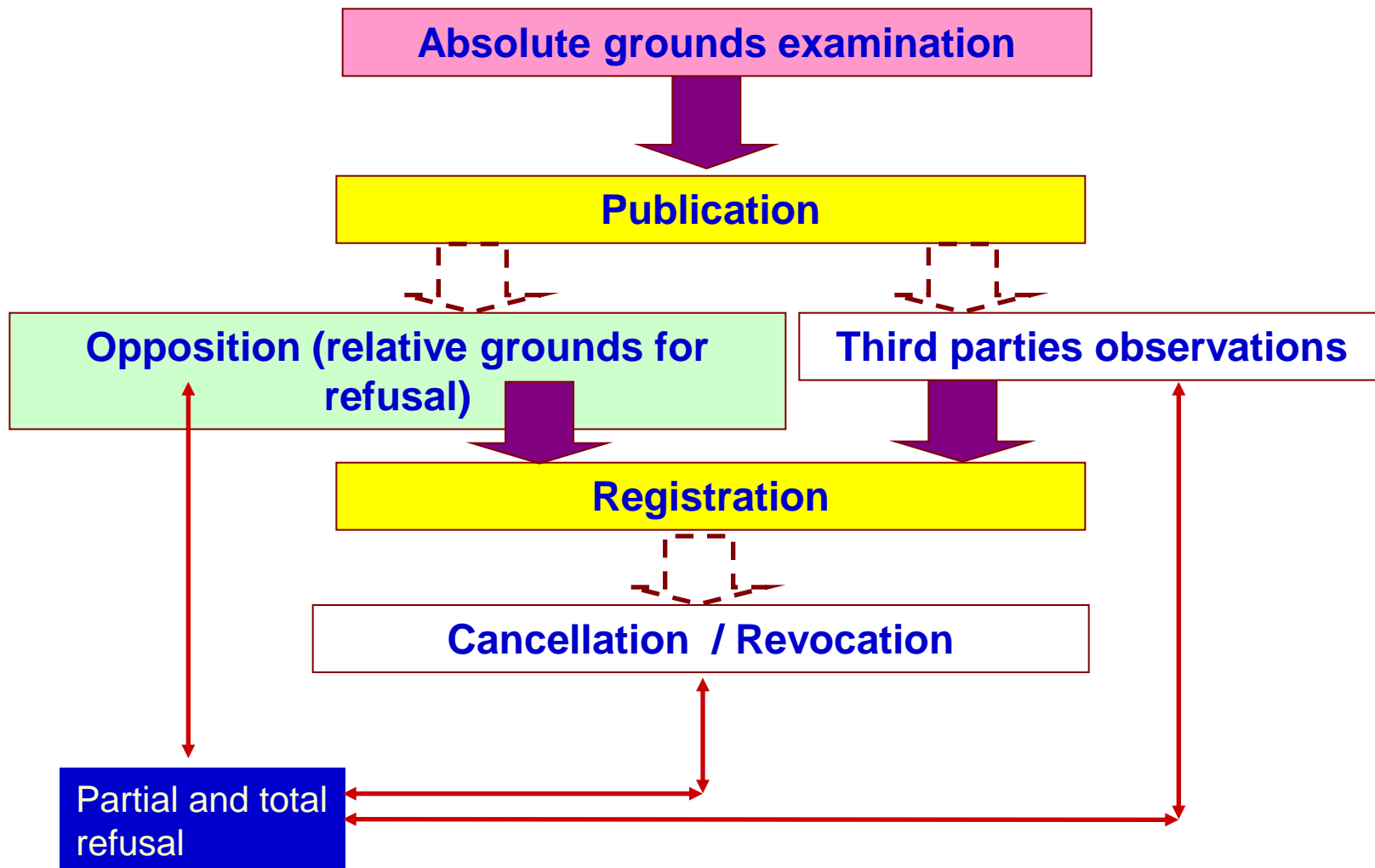
2. OPPOSITIONS



**For the protection of earlier
rights**



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS





2. WHAT IS 'OPPOSITION' and WHY AN OPPOSITION IS FILED ?

'Opposition' is a procedure that takes place before OHIM when a third party requests the Office to reject a CTMA.

The opponent intends to prevent the registration of a identical/similar trade mark due to a possible risk of confusion in the market among the clients.



PRINCIPAL FEATURES

- Before Registration
- Not *ex officio* proceedings (only upon request)
- Who may file an opposition?
 - Owners of earlier rights or authorised licensees
 - Opponent can be from outside the EU, with an earlier right in the EU (representation by an agent is mandatory)
- Only in one of the 5 languages of the Office (English, French, Spanish, German, Italian) according to the languages of the application.



What rights are protected?

- EARLIER COMMUNITY TRADE MARKS
- EARLIER NATIONAL RIGHTS
 - Registered trade marks (also applications), including IR marks
 - Non-registered trade marks (insofar protected by national law)
 - well-known marks
 - non-registered signs (insofar protected by national law), e.g. company or trade name, titles of publications



MAIN RELATIVE GROUNDS

- **Identity** of goods/services and signs
- **Likelihood of confusion**
- **Special protection for reputed marks** against dissimilar goods and services
- Protection **under national law** for **unregistered** rights and signs **used in the course of trade**



Admissibility

- Filing of a notice of opposition
 - within time limit (3 months after publication)
 - in writing (correspondence sent by fax, post or by e-comm)
 - before the Office
 - unlike CTM applications which may be filed through the national offices.
 - opposition fee of € 350,-- must be paid within the 3-months opposition period
- NB: The use of the official form is not mandatory but highly recommended.

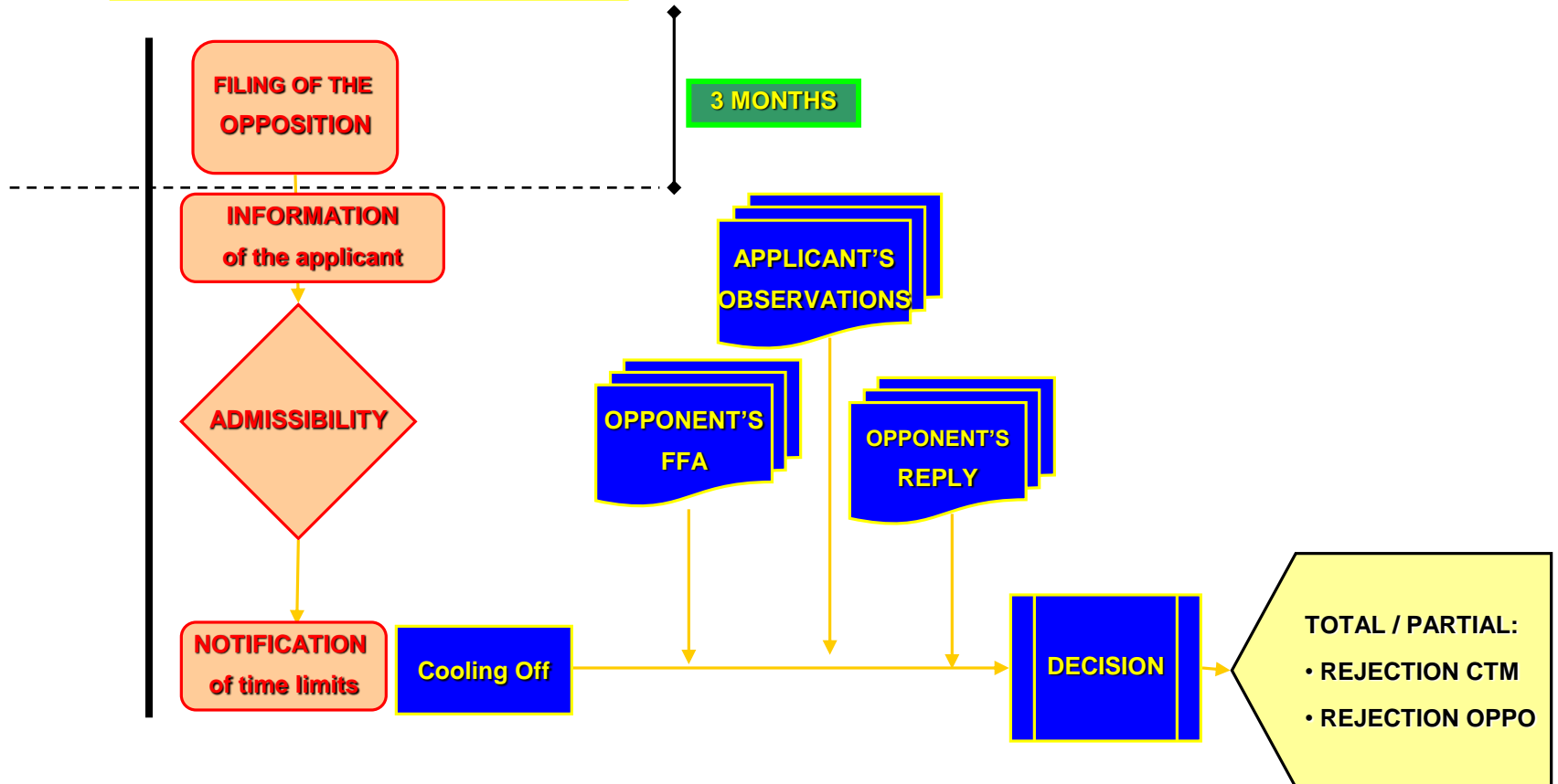


Admissibility

- The language regime
 - It must be filed in one of the 5 languages of the Office
(English, German, French, Spanish, Italian): depending on
first + second language of the contested CTMA
 - Translation possible within 1 month from the expiry of
opposition period



PUBLICATION OF THE CTM APPLICATION





DECISIONS

- Possible outcome:
 - (1) Opposition rejected
 - Opponent bears costs
 - (2) CTMA rejected
 - Applicant bears fees and costs
 - (3) CTMA rejected in part
 - Each party bears own costs
- Approx. 6 months until decision is issued after the closure of the proceedings
- Decision is signed by three examiners



DECISIONS by the opposition division

- Appeal:

- within two months after notification of decision
- after payment of fee € 800.

The appeal is decided by OHIM's Boards of Appeal. A further appeal can be made to the General Court and ultimately to the Court of Justice.

- Revocation of decisions

- when it contains obvious procedural error on the part of the opposition division



PRACTICAL CASES

Identity of goods/services and signs



Identity of goods/services and signs

Article 8(1)(a) CTMR – Requirements:

1. Identity of signs

2. Identity of goods/services



GOODS AND SERVICES

- Accepted
 - full coincidence:
 - *beers – beers; bicycle - cycle*
 - synonym:
 - *medicine, medicament, pharmaceutical products*
 - general term-specific term:
 - *clothing - trousers*
 - *restaurant services - meals offered in a pizzeria*
- Refused
 - Coffee – tea; clothing – footwear



PRACTICAL CASES

Likelihood of confusion



Likelihood of confusion

- Article 8(1)(b) CTMR – 3 Requirements:
 - Similarity of goods/services
 - Similarity of signs
 - ⇒ Leading to: Likelihood of confusion on the **part of the public** in the **territory** in which the earlier right is protected



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS

OPPOSITION

Decision 362/2000

No L.o.C.

Decision 253/1999

L.o.C.

MARKS

MARKS

SAGA



**CREAZIONI
OLIVER
MODA GIOVANILE**

S. Oliver

Classes goods / services

Classes goods / services

18, 25

18, 25, 35

25

25



- Application



- leather products, clothing, games, sporting articles

- Earlier Mark

GRAY-LINE

- travel arranging and conducting of travel tours

Strong similarity between word elements but goods/services were considered different.

Opposition: rejected



- Application

**PRIVATE
PLEASURES**

Cosmetics, perfumes in class 3

High conceptual similarity

Opposition: accepted

- Earlier Mark

**SECRET
PLEASURES**

Cosmetics, perfumes in class 3



**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
TRADE MARKS AND DESIGNS

OPPOSITION

Decision 3080/2000

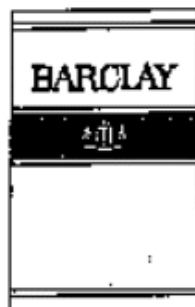
L.o.C.

Decision 353/1999

No L.o.C.

MARKS

BERKELEY

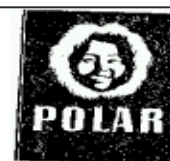


Classes goods / services

34

34

MARKS



POLAR

Classes goods / services

**32 : bières
33 : boissons
alcooliques**

**9 : appareils et
instruments
électriques et
électroniques**



4. CANCELLATION



Taking the mark out of the register

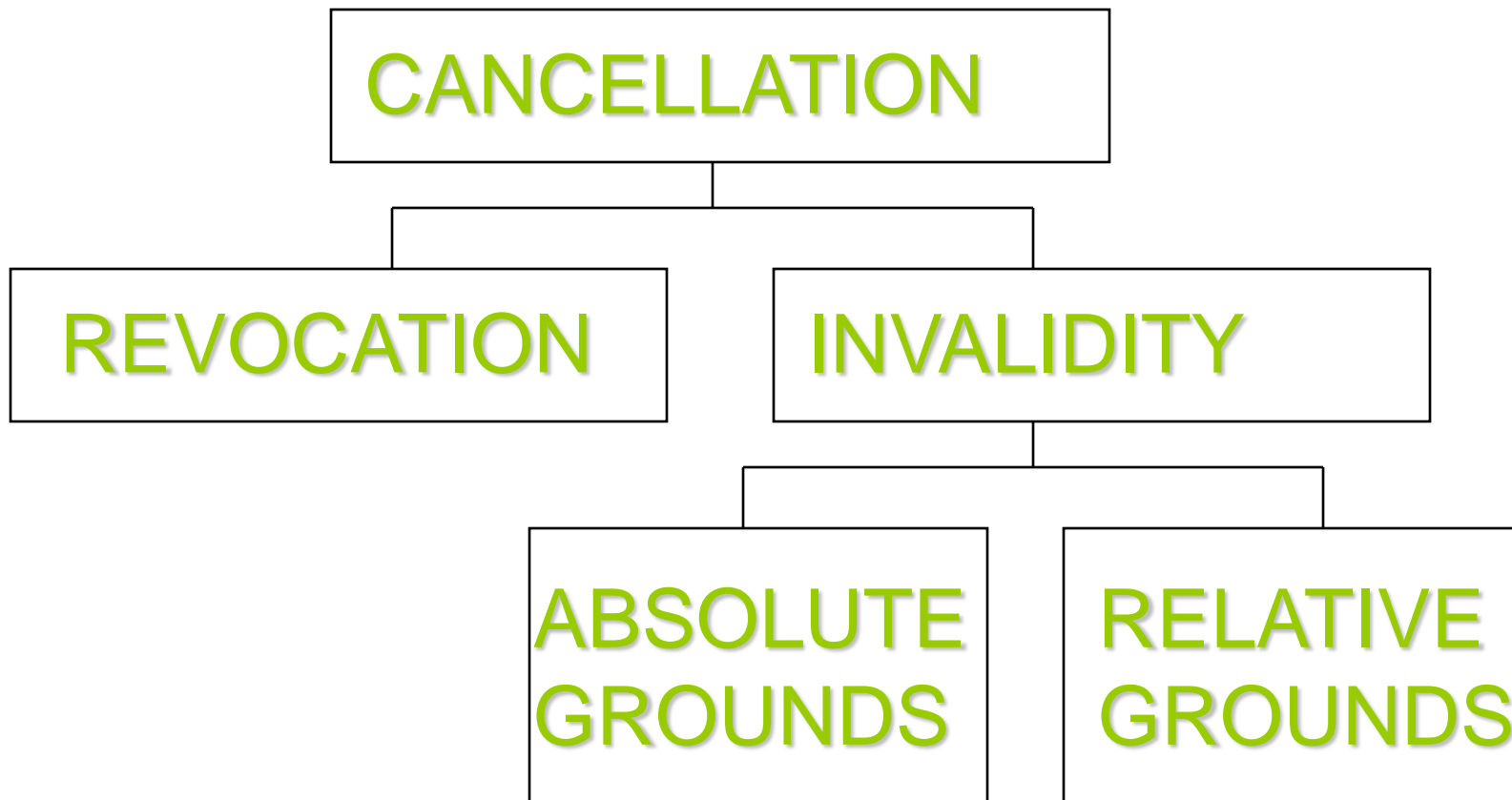


4. CANCELLATION

- Procedure **after** registration of CTM
- “Kill” CTM after it has been registered
- Before OHIM (directly) or before Courts (indirectly)
- Fee (both for invalidity and revocation):
 - 700 €



4. CANCELLATION





4. CANCELLATION

Revocation

- Art. 51 CTMR
- Grounds for revocation:
 - (a) Non use within a continuous period of five years;
 - (b) In consequence of acts or inactivity the mark has become the common name (generic);
 - (c) The mark has become misleading.



4. CANCELLATION

Invalidity – Absolute grounds

Art. 52 CTMR:

- (a) CTM registered in breach of the provisions of Article 7 CTMR (**AG for refusal – examination**)
- (b) applicant acted in bad faith.



4. CANCELLATION

Invalidity – Relative grounds

Art. 53 CTMR:

- (1) Existence of an earlier right as referred to in Article 8 CTMR (opposition)
- (2) Existence of other kind of earlier right according to the national law :right to a name; right of personal portrayal; copyright; industrial property right.



4. CANCELLATION

Examples

Genuine use in the Community

- CTM 2245587 : ProteoPrep



Partially revoked



4. CANCELLATION

Examples

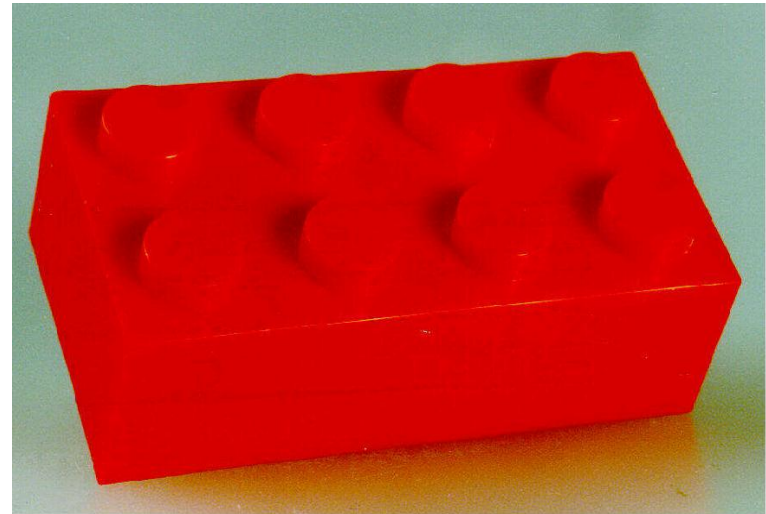
Mark has become generic

- e.g. “Hoover” (historical case)
- “Stimulation” (cl. 30, 32, 33), CTM 835033
Partially revoked, since “stimulation drink” has become the common name used in the trade for some kinds of beverages.



4. STRUGGLE FOR A TRADE MARK: THE LEGO BRICK





- Acceptance of application based on acquired distinctivity
- Third Party observations received
- Registration of the CTM
- Cancellation request
- Boards of Appeal
- Pending before the Court of Justice





OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET

TRADE MARKS AND DESIGNS

- Information:
-  (+ 34) 965 139 100 (switchboard/information center)
 -  (+ 34) 965 139 400 (e-business technical incidents)
 -  (+ 34) 965 131 344 (main fax)
 -  information@oami.europa.eu
 -  e-businesshelp@oami.europa.eu
 -  [twitter/oamitweets](https://twitter.com/oamitweets)
 -  [youtube/oamitubes](https://youtube.com/oamitubes)