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NEWSLETTER

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Patents, Trade Marks, Domain Names,
Designs and Utility Models,
Intellectual Property and Legal Defense

AND NOW…
THE UNITARY PATENT.

On November 10, 2010, after the failure in a final attempt to reach a language agreement for the Community Patent, eleven EU Member States –including France, Germany and Britain– requested the Commission to apply an instrument called “enhanced cooperation”. Said instrument would be aimed at implementing a unified patent system for these states, which would be open to any Member State.

Internal Market Commissioner Michel Barnier presented the formal proposal on December 21st, which was voted favorably on February 15, 2011 by the European Parliament.

If the system is finally implemented, the languages of this partial EU patent will be the same three official languages used in the current European patent system: English, French and German. Spain and Italy have already declared that this three-language system is discriminatory.

OFFICIAL FEES REDUCTION IN SPAIN

With the arrival of the New Year, the Spanish Patent and Trademark Office (OEPM) announced an average 10% fee reduction for many of its procedures. This reduction is aimed at helping SMSEs benefit from the Intellectual Property system and also at promoting innovation in the medium term. It should be stressed that, despite the title of the official campaign announcement, these reductions will be applied on a general basis, irrespective of nationality or corporate size.

COPYRIGHT INFRINGEMENT TACKLED?

Following long-lasting discussions between government, industry, consumers' associations and creators, last January the Spanish Senate passed the Sustainable Economy Law, also known as "Ley Sinde" after the Minister of Culture's name. The Law addresses a new and controversial legal mechanism to close down websites that provide links to copyrighted material. However, the Law does not deal with the real core question of online infringement: users. We will provide a more detailed overview on this subject in a future issue of our newsletter.

CEIPI COURSE AT PONTI

Last January 13, the first edition of the two-year CEIPI Training Program on European Patents started in Barcelona. This course is held at and coordinated by Oficina Ponti together with the CEIPI of The University of Strasbourg. International tutors from the industry, private practice areas and international bodies (WIPO,EPO) will share the sessions with our team of European Patent Attorneys.

TRADEMARK PROTECTION SEMINAR IN CHINA

A seminar on trademark protection in China was held on early November at our main office in Barcelona. Several IP managers from Catalan multinationals, Chinese lawyers and the whole of our legal team attended a session where different strategies for the protection of intangible trademark assets in the Chinese market were discussed.

SEMINAR: THE VALUE OF DESIGN

Last November, Oficina Ponti's European Patent Attorney Alfons Femenia took part in the roundtable "Design as a business asset", held within the international seminar "The Value of Design", organized by Design Innovation Research (d++) and KIM (Knowledge Innovation Market) with the support of the Barcelona Chamber of Commerce.

AGENDA / EVENTS:

17.02.2011
Meeting of the International Association for the Protection of Intellectual Property(AIPPI-Spanish Group). Madrid

14 - 18.05.2011
International Trademark Association (INTA).
133rd Annual Meeting. San Francisco (USA).

GENUINE USE OF COMMUNITY TRADE MARKS (The ONEL Decision)

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The territorial scope when assessing the genuine use of a Community trade mark has been recently put into discussion. On January 15, 2010, the Benelux Intellectual Property Office (BOIP) resolved on the ONEL/OMEL case, stating that the use of a Community trade mark in one member state –The Netherlands– was not considered genuine use within the European Union.

This resolution was appealed before the Hague Court of Appeal and it has derived in several prejudicial questions before the European Court of Justice. The European Court's ruling will have a significant impact on the connection between national and Community trade marks, but probably it will take several years to obtain an answer to these questions.

In the meantime, the Hungarian Office issued a decision in February last year which is completely in line with the Onel decision. Also the Danish Trademarks Office made a statement in this sense.

The context is that the law provides the obligation of use under article 15(1) of the Council Regulation (EC) No. 207/2009 dated 26 February 2009 of the Community trade mark (hereinafter "the Regulation"). It establishes that the proprietor of a Community trade mark must put it into genuine use in the Community in connection with the goods or services it has been registered for.

However, the Regulation does not define what genuine use in the Community really means. Instead, a joint declaration of the European Commission and the Council dated 20 October 1995* indicated that the use in one single country constituted genuine use in the European Union.

Certainly, at the time the Regulation was approved there were 15 Member States and therefore the use in one country was considered sufficient. Now the European Union has 27 Member States, of different sizes and extension, and this has brought back the discussion of what constitutes genuine use and whether the criteria of the joint statement are still appropriate.

The controversy has arisen due to the remarkable increase of CTM filings as well as to CTM fees reduction.

In order to avoid the registry to be overcrowded, some think it necessary to raise the standard for genuine use.

In our opinion, the Regulation deals with the EU as a single territory, and does not refer to the territory of the EU Member States. Therefore, genuine use needs to be assessed on the basis of the whole single market of the European Union. The reference to national boundaries does not add any value to the examination of what constitutes genuine use within the Community.

The question whether use is sufficient to maintain or create market share for the goods or services protected by the trade mark depends on several factors and on a case by case assessment. Use in one member state may be sufficient sometimes, and may not in other cases.

In any case, it must be taken into consideration that the resolution of the BOIP does not constitute a precedent, since the OHIM has reiterated that national decisions are not binding. The Community trade mark regime is an independent system with its own rules, and it is applied regardless of any national system.

The extended practice of many trade mark owners to abandon national trade mark applications to replace them with CTMs may change if the Benelux decision is followed by other national offices of the EU.

It is now up to the ECJ to decide what the standard for genuine use should be. In the meantime, the issue stays uncertain.

Notwithstanding this, the Max Planck Institute has undertaken a Study on the Overall Functioning of the Trade Mark System in Europe. This study has addressed what constitutes "genuine use", and different trade mark users associations have given their statements and opinions about this particular question. We expect the final report, which is now under examination by the Commission and has not yet been approved for publication, to give some clues on the answer to this complex issue.

* Joint Statements by the Council and the Comission of 20 October 1995, No. B.10 to 15 OHIM 1996, 615.

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