

TRADEMARK REGISTRATION IN EUROPE

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INTRODUCTION

Madrid Agreement, Madrid Protocol, Community Trade Mark, National registration - which is to be preferred or is a combination the best course? What circumstances dictate the decision? What are the respective costs? How does one search for conflicting marks? Can a watch be placed on filings for similar marks? The protocol/CTM link has been available for one year now. What is the experience so far?

THE MADRID SYSTEM

- The Madrid System of International Registration of Marks
- The Madrid Union: the Contracting Parties to the Agreement and the Protocol
- The International Bureau
- The Contracting States in Europe

REGULATIONS ON THE MADRID SYSTEM

- Madrid Agreement Concerning the International Registration of Marks of April 14, 1891
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of June 27, 1989
- Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement
- Administrative Instructions for the Application of the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating Thereto

MEMBERS OF THE MADRID UNION

5. Madrid Agreement Concerning the International Registration of Marks

Madrid Agreement (Marks) (1891), revised at Brussels (1900), Washington (1911),
The Hague (1925), London (1934), Nice (1957) and Stockholm (1967), and amended in 1979

and

6. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Madrid Protocol (1989)

(Madrid Union)¹

Status on September 22, 2005

State/IGO	Date on which State became party to the Madrid Agreement ²	Date on which State/IGO became party to the Madrid Protocol (1989)
Albania	October 4, 1995	July 30, 2003
Algeria	July 5, 1972	—
Antigua and Barbuda	—	March 17, 2000
Armenia	December 25, 1991	October 19, 2000 ^{5,10}
Australia	—	July 11, 2001 ^{5,6}
Austria	January 1, 1909	April 13, 1999
Azerbaijan	December 25, 1995	—
Bahrain	—	December 15, 2005
Belarus	December 25, 1991	January 18, 2002 ^{6,10}
Belgium	July 15, 1892 ³	April 1, 1998 ^{3,6}
Bhutan	August 4, 2000	August 4, 2000
Bosnia and Herzegovina	March 1, 1992	—
Bulgaria	August 1, 1985	October 2, 2001 ^{6,10}
China	October 4, 1989 ⁴	December 1, 1995 ^{4,5,6}
Croatia	October 8, 1991	January 23, 2004
Cuba	December 6, 1989	December 26, 1995
Cyprus	November 4, 2003	November 4, 2003 ⁵
Czech Republic	January 1, 1993	September 25, 1996
Democratic People's Republic of Korea	June 10, 1980	October 3, 1996
Denmark	—	February 13, 1996 ^{5,6,7}
Egypt	July 1, 1952	—
Estonia	—	November 18, 1998 ^{5,6,8}
European Community	—	October 1, 2004 ^{6,10}
Finland	—	April 1, 1996 ^{5,6}
France	July 15, 1892 ⁹	November 7, 1997 ⁹
Georgia	—	August 20, 1998 ^{6,10}
Germany	December 1, 1922	March 20, 1996
Greece	—	August 10, 2000 ^{5,6}
Hungary	January 1, 1909	October 3, 1997
Iceland	—	April 15, 1997 ^{5,10}
Iran (Islamic Republic of)	December 25, 2003	December 25, 2003 ⁵
Ireland	—	October 19, 2001 ^{5,6}
Italy	October 15, 1894	April 17, 2000 ^{5,6}
Japan	—	March 14, 2000 ^{6,10}
Kazakhstan	December 25, 1991	—
Kenya	June 26, 1998	June 26, 1998 ⁵
Kyrgyzstan	December 25, 1991	June 17, 2004 ⁶
Latvia	January 1, 1995	January 5, 2000
Lesotho	February 12, 1999	February 12, 1999
Liberia	December 25, 1995	—
Liechtenstein	July 14, 1933	March 17, 1998
Lithuania	—	November 15, 1997 ⁵
Luxembourg	September 1, 1924 ³	April 1, 1998 ^{3,6}
Monaco	April 29, 1956	September 27, 1996
Mongolia	April 21, 1985	June 16, 2001
Morocco	July 30, 1917	October 8, 1999
Mozambique	October 7, 1998	October 7, 1998
Namibia	June 30, 2004 ²	June 30, 2004 ⁸
Netherlands	March 1, 1893 ^{3,11}	April 1, 1998 ^{3,6,11}
Norway	—	March 29, 1996 ^{5,6}

State/IGO	Date on which State became party to the Madrid Agreement ²	Date on which State/IGO became party to the Madrid Protocol (1989)
Poland.....	March 18, 1991	March 4, 1997 ¹⁰
Portugal.....	October 31, 1893	March 20, 1997
Republic of Korea.....	—	April 10, 2003 ^{5,6}
Republic of Moldova.....	December 25, 1991	December 1, 1997 ⁶
Romania.....	October 6, 1920	July 28, 1998
Russian Federation.....	July 1, 1976 ¹²	June 10, 1997
San Marino.....	September 25, 1960	—
Serbia and Montenegro.....	April 27, 1992	February 17, 1998
Sierra Leone.....	June 17, 1997	December 28, 1999
Singapore.....	—	October 31, 2000 ^{5,6}
Slovakia.....	January 1, 1993	September 13, 1997 ¹⁰
Slovenia.....	June 25, 1991	March 12, 1998
Spain.....	July 15, 1892	December 1, 1995
Sudan.....	May 16, 1984	—
Swaziland.....	December 14, 1998	December 14, 1998
Switzerland.....	July 15, 1892	December 1, 1995 ^{5,6}
Syrian Arab Republic.....	August 5, 2004	May 1, 1997 ^{6, 10}
Tajikistan.....	December 25, 1991	August 5, 2004
The former Yugoslav Republic of Macedonia.....	September 8, 1991	—
Turkey.....	—	August 30, 2002
Turkmenistan.....	—	January 1, 1999 ^{6, 8, 10}
Ukraine.....	December 25, 1991	September 28, 1999 ^{6, 10}
United Kingdom.....	—	December 29, 2000 ^{5, 6}
United States of America.....	—	December 1, 1995 ^{5, 6, 13}
Uzbekistan.....	December 25, 1991	November 2, 2003 ^{5, 6}
Viet Nam.....	March 8, 1949	—
Zambia.....	—	November 15, 2001
(Total: (78))	(56)	(67)

¹ The Madrid Union is composed of the States party to the Madrid Agreement and the Contracting Parties to the Madrid Protocol.

² All the States party to the Madrid Agreement have declared, under Article 3*bis* of the Nice or Stockholm Act, that the protection arising from international registration shall not extend to them unless the proprietor of the mark so requests.

³ The territories of Belgium, Luxembourg and the Kingdom of the Netherlands in Europe are to be deemed a single country, for the application of the Madrid Agreement as from January 1, 1971, and for the application of the Protocol as from April 1, 1998.

⁴ Not applicable to either the Hong Kong Special Administrative Region or the Macau Special Administrative Region.

⁵ In accordance with Article 5(2)(b) and (c) of the Protocol, this Contracting Party has declared that the time limit to notify a refusal of protection shall be 18 months and that, where a refusal of protection results from an opposition to the granting of protection, such refusal may be notified after the expiry of the 18-month time limit.

⁶ In accordance with Article 8(7)(a) of the Protocol, this Contracting Party has declared that, in connection with each request for territorial extension to it of the protection of an international registration and the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fee, an individual fee.

⁷ Not applicable to the Faroe Islands and to Greenland.

⁸ In accordance with Article 14(5) of the Protocol, this Contracting Party has declared that the protection resulting from any international registration effect under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

⁹ Including all Overseas Departments and Territories.

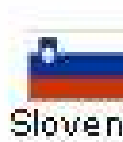
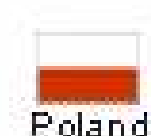
¹⁰ In accordance with Article 5(2)(b) of the Protocol, this Contracting Party has declared that the time limit to notify a refusal of protection shall be 18 months.

¹¹ The instrument of ratification of the Stockholm Act and the instrument of acceptance of the Protocol were deposited for the Kingdom in Europe. The Netherlands extended the application of the Madrid Protocol to the Netherlands Antilles with effect from April 28, 2003.

¹² Date of accession by the Soviet Union, continued by the Russian Federation as from December 25, 1991.

¹³ Ratification in respect of the United Kingdom and the Isle of Man.

MEMBERS OF THE MADRID AGREEMENT AND MADRID PROTOCOL IN EUROPE



TOTAL: 15 STATES



MEMBERS OF THE MADRID PROTOCOL IN EUROPE



TOTAL: 8 STATES



DISADVANTAGES OF THE MADRID SYSTEM

Importance in determining the Country / Office of Origin – Which Strategy?

- Central Attack:
 - Possibilities of oppositions or of infringement actions in the country of origin?
 - Practice of the National Trademark Office in examining and accepting trademark applications and/or oppositions?
- Specification of goods and services:
 - Is the National Trademark Office rigorous?
- Form of marks:
 - Country variations in acceptance of form of marks?

THE COMMUNITY TRADEMARK SYSTEM

Legislation up to date

- Council Regulation (EC) No. 40/94 of December 1993 on the Community trademark (Consolidated version)
- Commission Regulation (EC) No. 2868/95 of 13 December 1995 implementing Council Regulation (EC) No. 40/94 on the Community trademark
- Commission Regulation (EC) No. 782/2004 of 26.04.2004 amending Regulation (EC) No. 2868/95 the accession of the European Community to the Madrid Protocol
- Commission Regulation (EC) No. 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and Designs)

- Commission Regulation (EC) No 781/2004 of 26.04.2004 amending Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)
- Council Regulation (EC) No. 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trademarks and Designs)
- Council Regulation (EC) No. 1992/2003 of 27 October 2003, amending Regulation (EC) No 40/94 on the Community trademark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989

EXTENSION

European Member States



From the date of accession (**1 May 2004**), a Community trade mark registered or applied for before the date of accession shall be extended to the territory of the ten new Member States (Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Slovenia and Slovakia)

TOTAL: 25 STATES

TIME TABLE OF THE OHIM PROCEEDINGS

	2004	Outturn		Target 2005	
		1 st quarter	2 nd quarter	2 nd quarter	Final
1. To reduce to 2 days the time taken to issue the receipt for 90% of electronically filed applications	2 weeks	7 days	<u>5 days</u>	4 days	<u>2 days</u>
2. To reduce to 1 week the time taken to issue the receipt for 90% of those applications which are filed by fax or mail	3 weeks	3 weeks	<u>2 weeks</u>	1 weeks	<u>1 week</u>
3. To reduce to 14 weeks the time taken to finalise examination for 80% of those applications that reach this specific milestone of the procedure	28 weeks	27 weeks	<u>21 weeks</u>	22 weeks	<u>14 weeks</u>
4. To reduce to 32 weeks the time taken to publish 80% of those applications that reach this specific milestone of the procedure	56 weeks	53 weeks	<u>45 weeks</u>	40 weeks	<u>32 weeks</u>
5. To reduce to 8 months the time taken to notify opposition decisions once the adversarial part of the proceedings has been closed for 80% of cases that reach this specific milestone of the procedure	19 months	16 months	<u>12 months</u>	12 months	<u>8 months</u>

OHIM FEES

- Commission Regulation (EC) No 1042/2005 of 29 June 2005 amending Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)
- New OHIM fees proposal:
 - Basic application - Existing fee 975 euros - Accepted new fee 900 euros (750 euros – electronic filing)
 - Madrid Protocol basic (inc registration) - Existing fee 1875 euros - Accepted new fee 1300 euros
 - Renewal (basic) - Existing fee 2500 euros - Accepted new fee 1500 euros

ACCESSION OF THE EUROPEAN COMMUNITY TO THE MADRID PROTOCOL

- Accession of the European Community to the Madrid Protocol (1989)
- The Madrid protocol (1989) entered into force, with respect to the European Community, on October 1, 2004

Statistics over the period 2004-2005 (to date)

- One year ago, on 1st October 2004, the accession of the European Community to the Madrid Protocol entered into force. During the first year, the EU was designated in more than 6,500 international registrations received in Geneva. On the basis of more than 3,700 designations received at the OHIM, the TOP 10 offices of origin are: United States (658), Germany (637), Switzerland (589), Benelux (370), France (314), Australia (211), United Kingdom (199), Italy (198), Japan (111) and Austria (56).
- During that same period, OHIM received more than 1,800 international applications where a CTM application or registration was used as basis. The TOP 10 countries of origin of the owners of these CTMs are Germany, the United Kingdom, Spain, France, Italy, the Netherlands, Sweden, Austria, Finland and Ireland.

NATIONAL FILINGS

- Disadvantage:
 - Expensive (if more than a very limited number of countries)
- Advantages:
 - Independency by other registrations
 - Registrations may be fast – expedited trademark examination

FOUR ROUTES FOR PROTECTING MARKS IN EUROPE

- National filing
- Direct filing of Community Trade Mark
- Designating the EC onto an International Registration
- Designating separately EC contracting states onto an International Registration

ADVANTAGES / DISADVANTAGES

- Extension of territory
- Legal proceedings
- Languages
- Searches
- Costs

ELEMENTS TO CONSIDER

before taking a decision

- Territories to be covered – National or regional systems
- Distinctiveness of the mark and its likelihood of registration
- Likelihood of oppositions
- Likelihood of infringement actions
- Likelihood of continued use
- Location of home application
- Duration to get a protection
- Fees

EXAMPLE 1

A

23/10/2000 Spanish Trademark

a) Cl. 29

EUROSNACKS

Granted: 07-05-2001

b) Cl. 30

c) Cl. 44

03/11/2000 Community Trademark Application

Cl. 29, 30 i 44

EUROSNACKS

Granted: 05-12-2001

B

<i>World Intellectual Property Organization</i>	
ROMARIN 11/2001	Marks
111 NUMBER	Número expediente
151 DATE	2001.01.23
171 PAID FOR	10 years
141 EXPIRATION DATE	2011.01.23
580 NOTIFICATION DATE	2001.10.25
450 PUBLICATION	GAZ 2001/21 (2001.11.22)
270 LANGUAGE	EN
540 MARK	EUROSNACKS
550 DETAILS	standard characters:
732 HOLDER	TITULAR Dirección
841 ORIGIN	AT
822 BASIC REG.	2001.01.23 193 403
300 PRIORITY	AT2000.08.01 AM 5597/2000
831 DESIGNATIONS	BX, CH, CZ, DE, ES, FR, HR, HU, IT, LI, MC, PL, PT, SI, SK
832 DESIGNATIONS	DK, FI, GB, NO, SE
511 NICE CLASSIF	03, 05, 25, 28, 32, 35, 41, 42
511 GOOD/SERV	03
	<i>Perfumery products; products for the body and beauty care.</i> Produits de parfumerie; produits de soins corporels et esthetiques.
	05
	<i>Balsamic preparations for medical purposes; bandages for medical purposes; bandages for health purposes; bath additives for medical purposes; bath salts; biological preparations for medical purposes; blood-cleaning products; chemical products for medical purposes; diagnostic products for medical purposes; dietetic food and beverages for medical purposes; dietetic substances for medical purposes; drugs for medical purposes; elixirs (pharmaceutical products); enzyme products for pharmaceutical preparations; fitness products, namely pharmaceutical products for health care; hormones for medical purposes; medical beverages; medical supplements for sports persons; medicines; mud for bath and oxygen baths; nutritional supplement products included in this class; pharmaceutical products; products for health care; tapes for medical purposes; tranquilizers.</i> Balsamiques à usage médical; bandages à usage médical; bandages élastiques pour la santé; additifs pour le bain à usage médical; sels de bain; préparations biologiques à usage médical; dépuratifs sanguins; produits chimiques à usage médical; produits de diagnostic à usage médical; aliments et boissons diététiques à usage médical; substances diététiques à usage médical; drogues à usage médical; élixirs (produits pharmaceutiques); préparations enzymatiques pour produits pharmaceutiques; produits pour la condition physique, à savoir produits pharmaceutiques pour soins de santé; hormones à usage médical; boissons médicales; compléments médicaux pour sportifs; médicaments; boues pour le bain et bains oxygénés; compléments nutritifs compris dans cette classe; produits pharmaceutiques; produits pour soins de santé; bandes magnétiques à usage médical; calmants.

C

01/08/2000 Austrian Trademark

23/10/2000 Spanish Trademark

a) Cl. 29

EUROSNACKS

Granted: 07-05-2001

b) Cl. 30

c) Cl. 44

03/11/2000 Community Trademark Application

Cl. 29, 30 i 44

EUROSNACKS

Granted: 05-12-2001

23/01/2001 International Trademark

EUROSNACKS

EXAMPLE 2

Protection in Spain, France, United Kingdom for one class

Fees				
	Spain	France	United Kingdom	Total 1
National filing	143 (*)	215 (*)	294 (*)	652
CTM filing	Filing 900 (*)	Registration 850		1.750
National filing (ES)	143 (*) [if Spain is the country of origin] + 47 [expedited examination]			
+ International Registration (designating FR and UK)	424 + 48 (FR) + 250 (individual fee – UK)			912

(*) Professional Representative

EXAMPLE 3

Protection in Spain, France, United Kingdom AND Portugal and Benelux

Fees	Total 1	Portugal	Benelux	Total 2
National filing	652	79 (*)	240 (*)	971
CTM filing + National filing	1.750			1.750
National filing (ES) + International Registration (designating FR, UK, PT, Benelux)	912	48	48	1.008

(*) Professional Representative

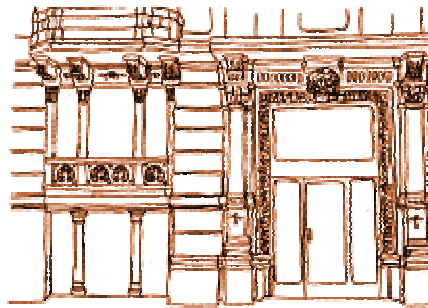
EXAMPLE 4

Protection in Spain, France, United Kingdom, Portugal, Benelux and Switzerland

Fees	Total 2	Switzerland	Total 3
National filing	971	453 (*)	1.424
CTM filing + National filing	1.750	453 (*)	2.203
National filing (ES) + International Registration (designating FR, UK, PT, Benelux, CH)	1.008	48	1.056

(*) Professional Representative

THANK YOU FOR YOUR ATTENTION !

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