

A few remarks on the Implementation of the Trademark Directive in Sweden

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A brief overview

- Filing date requirements, 2 Ch 1a § VML
- Renewal period begins at application date 2 Ch 34 § VML
- Abandoned requirement for graphic representation; new types of marks
- Extended provisions on collective marks 2 Ch 7 § VML
- GI's and plant varieties; 2 Ch 7 § VML
- Amended absolute ground, *shape or other characteristic*

Oppositions

- Cooling off-period 2 Ch 27§ VML
- Use requirement for invoked earlier trademarks 2 Ch 30 § VML
- Maintained provisions of absolute grounds as a basis for opposition!
- Maintained provisions on bad faith
- No separate provision on "agent marks"

More novelties

- "Firma" changed for "företagsnamn"
- Co-existence of intervening rights 1 Ch 16 §
- Provisions on Comparative Advertising
- Goods in Transit

Omissions etc.

- The "cross" protection btwn trademarks and trade name remains
- No substantive examination of administrative cancellation before PRV
- Lacking distinctiveness still basis for oppo
- Bad faith, no amendments

"The cross"

1 kap 10 § Ensamrätten till ett varukännetecken enligt 6–8 §§ innebär att ingen annan än innehavaren, utan dennes tillstånd, i näringsverksamhet får använda *ett tecken för varor eller tjänster...*

1 Ch 10 § The sole right to a trade sign... entails that noone other than the owner, without his/her consent, may use the sign in the course of trade as a *sign for goods or services*

Som användning anses särskilt att...

As use in this respect, in particular the following is considered:

4. Använda tecknet som ett företagsnamn eller som ett annat kännetecken som en del av ett företagsnamn eller ett annat näringskännetecken

4. use of the sign as a tradename or another business sign, as a part of a trade name or other business name

The justification for the sole right of a trademark:

Use in the course of trade for the purposes of distinguishing goods or services; exception from the fundamental right of freedom of movement of goods/services; Art 28, 56, TFEU)

The imperative of the Directive:

recitals:

(5) ...include measures to make it more consistent with Regulation (EC) No 207/2009... thus reduce the areas of divergence within the trade mark system in Europe as a whole

10) ...essential to ensure that registered trade marks enjoy the same protection under the legal systems of all the Member States

Rights conferred by a Trademark (Art 10)

2b) the sign is identical with, or similar to, the trade mark and is ***used*** in relation to goods or services

3d) using the sign as a trade or company name or part of a trade or company name;

Continued...

18) ...infringement of a trade mark only...if the infringing mark or sign is used in the course of trade for the purposes of distinguishing goods or services. Use of the sign for purposes other than for distinguishing goods or services should be subject to the provisions of national law.

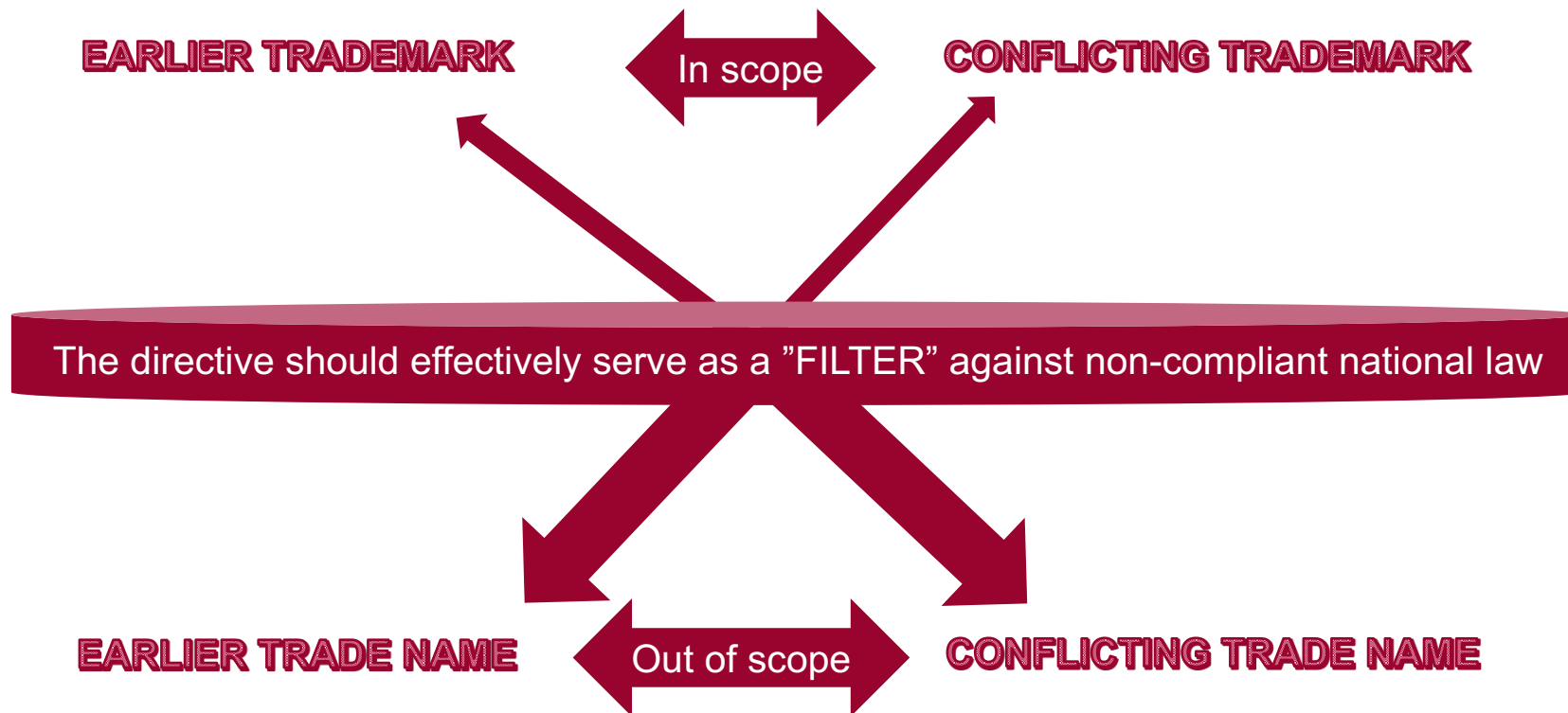
19) The concept of infringement of a trade mark should also comprise the use of the sign as a trade name or similar designation, ***as long as such use is made for the purposes of distinguishing goods or services***

EARLIER TRADEMARK

CONFLICTING TRADEMARK

EARLIER TRADE NAME

CONFLICTING TRADE NAME



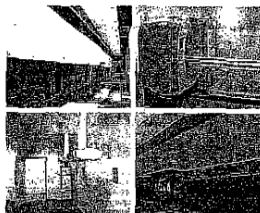
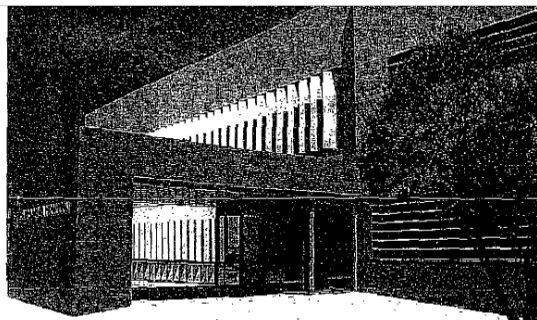
The requirement for genuine use:

Why does the Directive not contain any requirement for genuine use of invoked earlier trade names in oppositions?

EU Law; there is no need because of the Celine Case, as transposed in Article 10 of the Directive!

Use in the course of trade for goods and services

Text-book practice by the EUIPO:



Inauguración Centro de Alta Resolución de Trujillo

OBRA CIVIL: 9.237.800,00 €
EQUIPAMIENTO: 1.896.500,00 €
ALTA TECNOLOGÍA: 410.000,00 €
EL CENTRO ATIENDE A 80.000 USUARIOS
PERTENECE AL ÁREA DE SALUD DE CÁCERES

Empresa constructora:

JOCA



JUNTA DE EXTREMADURA
Consejería de Sanidad y Dependencia

Data base of legal situation of files

Trade Mark:	M 2178368	Date:	15/12/11	12:01:46
Product/Service Mark				
Application date:	31/07/1998			
Type:	Wordmark			
Sign:	JOCA			
Applicant/Owner:	By assignment No. 2010.01512 dated 18/08/2010 JOCA INGENIERÍA Y CONSTRUCCIONES S.A.			
Address:	Sinforiano Madroñero 24-26			
City:	Badajoz			
Post Code:	06011 Badajoz			
Representative:	0805 (2) Pablo Aznárez Urbieto			
Address:	Corazón de María 6			
City:	Madrid			
Province/Post Code:	28002			

PRODUCTS/SERVICES OR ACTIVITIES APPLIED FOR

37 Execution, repair and maintenance on one's own account or on third party's account of buildings under construction; installation, repair and maintenance of electric and electronic apparatuses, equipment and systems.

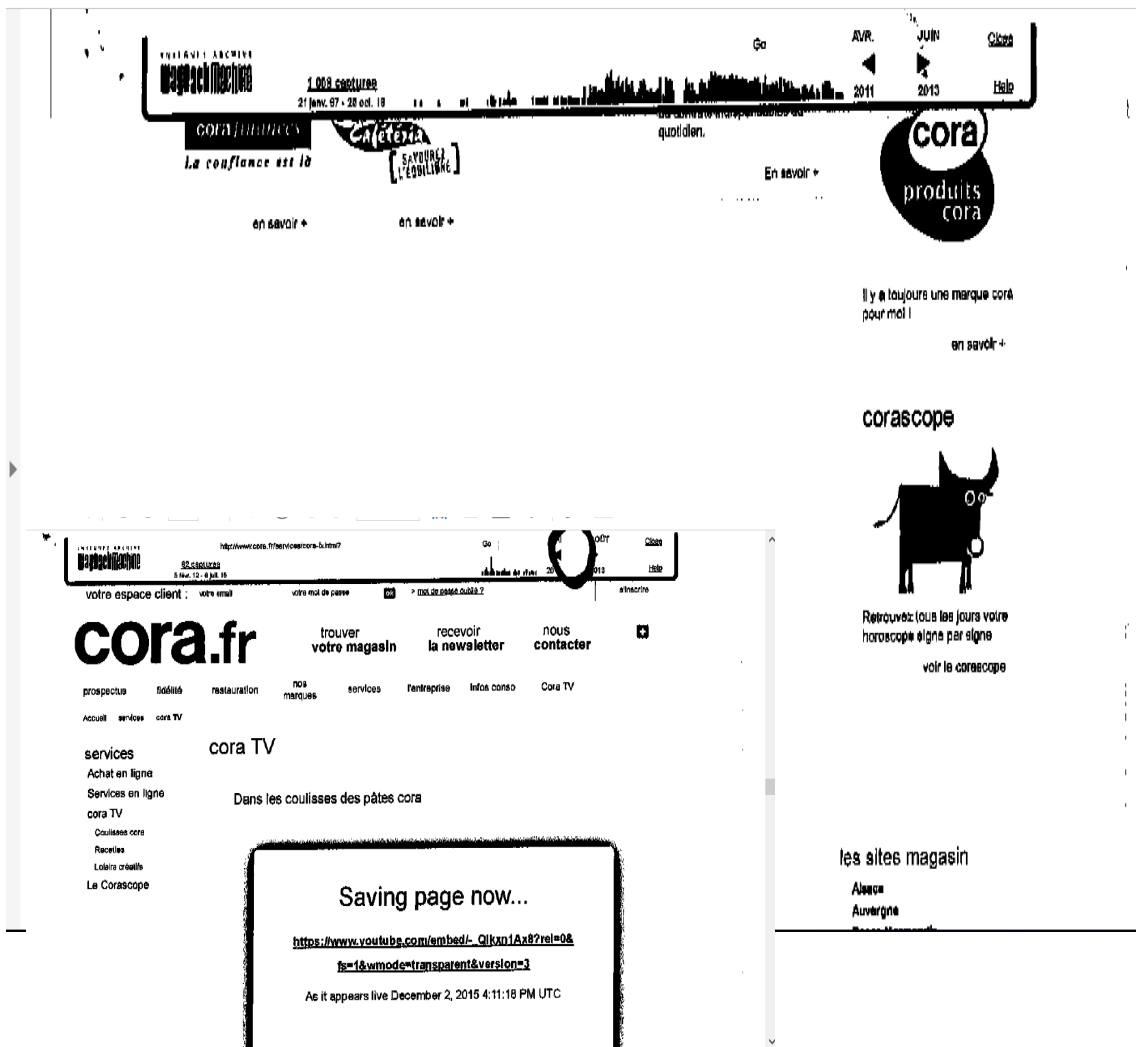
PRODUCTS/SERVICES OR ACTIVITIES GRANTED

The evidence of use of the name JOCA provided by the opponent is consistent with the use of a company name, but there is little to show that the sign performed the role of a trade mark. Even in the two advertisements, or information bulletins, the term JOCA appears more as a company name than anything else. The opponent did not supply evidence to show that the sign JOCA went beyond being a trade name to being used as a trade mark. A trade name is the name under which a company does business, which is why it appears on invoices and company annual reports. A trade mark, however, serves to identify goods and services and distinguish them from the goods and services of other traders. The opponent could, for example, have supplied the Opposition Division with advertisements and marketing materials which unambiguously demonstrated that the sign JOCA had been used as a trade mark in relation to the services in question.

The use of JOCA on transportation and building equipment, such as lorries and cranes, and building site hoardings, would have supported the opponent's case. In other words, evidence which established that the sign JOCA has been used to identify to consumers that the services in question originate from the opponent.

Under the circumstances, the Opposition Division is unable to conclude that the opponent has put the earlier right to genuine use in relation to services in question.

The opponent's failure to demonstrate genuine use of the earlier right in relation to execution, repair and maintenance of construction work on one's own account or on third party's account; assembly, repair and maintenance of electric and electronic apparatuses, equipment and systems is fatal to the opposition. It is an essential requirement of the legislation, as specified above, and therefore the opposition must be rejected for lack of proof of use pursuant to Article 42(2) and (3) CTMR.



services
achat en ligne
services en ligne
cora TV
le Corascope

cora TV

» Duo sablé fraises/chocolat



PRV

Use of the sign as a company name or trade name is not in itself, intended to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being run. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being run, such use cannot be considered as being ‘in relation to goods or services’ (11/09/2007, C-17/06, Celine, EU:C:2007:497, § 21; 13/05/2009, T-183/08, Jello Schuhpark II, EU:T:2009:156, § 31-32).

However, the use of a sign as a business, company or trade name can be regarded as trade mark use provided that the relevant goods or services themselves are identified and offered on the market under this sign (13/04/2011, T-209/09, Alder Capital, EU:T:2011:169, § 55-56). In general, this is not the case when the business name is merely used as a shop sign (except when proving use for retail services), or appears on the back of a catalogue or as an incidental indication on a label.

The use of a business, company or trade name can be regarded as use ‘in relation to goods’ where a party affixes the sign constituting its company name, trade name or shop name to the goods or even though the sign is not affixed, that party uses that sign in such a way that a link is established between the company, trade or shop name and the goods or services (11/09/2007, C-17/06, Celine, EU:C:2007:497, § 21-23). Provided that either of these two conditions is met, the fact that a word element is used as the company’s trade name does not preclude its use as a mark to designate goods or services (30/11/2009, T-353/07, Coloris, EU:T:2009:475, § 38).

It results from the above case-law, that depending on the circumstances, the use of a sign as a business name does not preclude the use of the same sign as a trademark. That is because the use of the sign can serve more than one purpose at the same time. Therefore, depending on the circumstances, evidence of use as a trade name or company name, may be suitable for supporting the genuine use of a registered trade mark.

Consequence:

Imbalance between the scope of protection between trademarks
and trade names in Sweden!

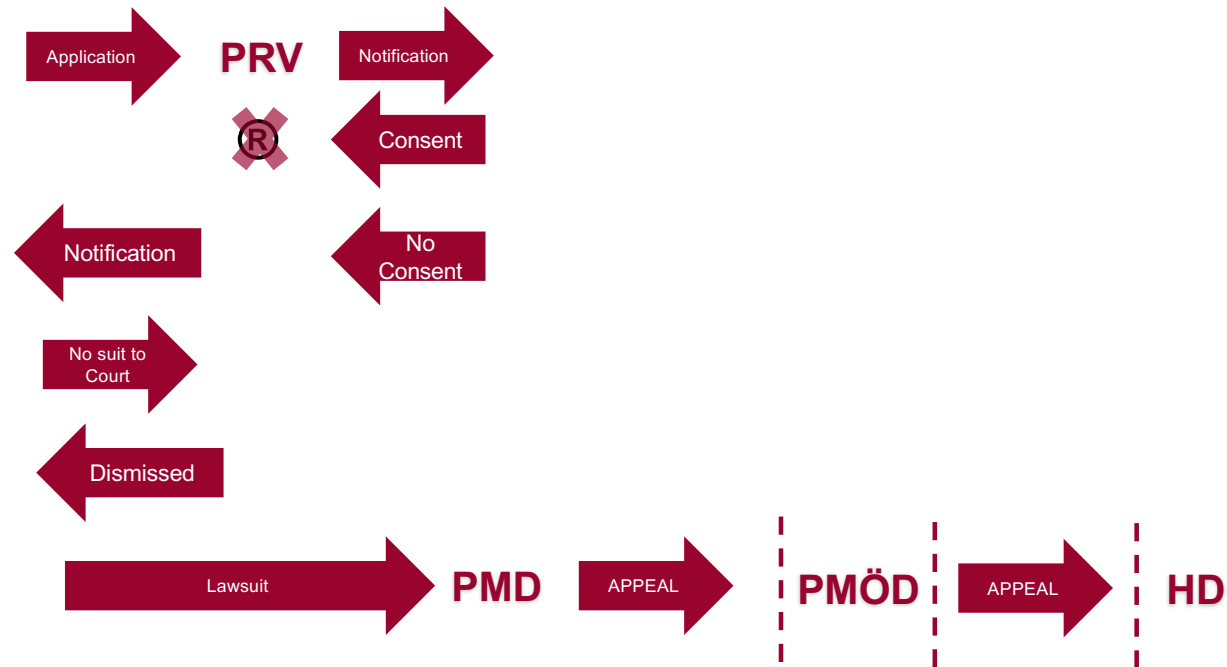
Bad Faith

Directive	Trademark Act
Art 4(2) A trade mark shall be liable to be declared invalid where the application for registration of the trade mark was made in bad faith by the applicant. Any Member State may also provide that such a trade mark is not to be registered. (AG)	"One provision covers all!"
Art 5(3)(b); the "Agent" situation (RG)	
Art 5(4)(c) Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where, and to the extent that: the trade mark is liable to be confused with an earlier trade mark protected abroad, provided that, at the date of the application, the applicant was acting in bad faith. (RG)	

Administrative cancellation

Cancellation
Applicant

Holder



Thank you for your attention!

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