



# 13th Open Forum

Rome, Italy, November 9-11, 2011

The overall functioning of the  
trade mark system in Europe.  
The Max Planck Institute study  
and the European Commission  
proposals

## INTRODUCTION

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# OBJECTIVES OF ANY TRADE MARK SYSTEM

- TO PROVIDE A LEGAL SYSTEM TO PROTECT TRADE INDICATIONS OF ENTREPRENEURS
- THE PROTECTION CONSISTS IN GRANTING AN EXCLUSIVE RIGHT OF USE OF THE PROTECTED TRADE MARK
- THE SIGNS PROTECTABLE ARE ANY SIGNS CAPABLE OF DISTINGUISHING GOODS OR SERVICES OF ONE UNDERTAKING FROM THOSE OF OTHER UNDERTAKINGS

# THE BASIS OF THE REGISTRATION SYSTEM

- TO PROVIDE A REGISTER WHERE ENTERPRISES RECORD THEIR RIGHTS
- THIS REGISTER PROVIDES LEGAL CERTAINTY TO ENTREPRENEURS BECAUSE:
  - ONE CAN CHECK WHICH RIGHTS ARE PROTECTED
  - SIGNS WHICH ARE NOT PROTECTABLE ARE NOT RECORDED (EXAMINATION BY TRADE MARK OFFICES)
  - THE REGISTER IS INTENDED TO REFLECT THE COMMERCIAL REALITIES OF THE MARKET
  - THE DURATION OF PROTECTION IS LIMITED IN TIME SO TRADE MARK PROPRIETORS MUST SHOW THEIR WILLINGNESS TO MAINTAIN THE REGISTRATION BY REQUESTING ITS RENEWAL

# THE BASIC PROBLEMS OF ENTREPRENEURS WITH THE TRADE MARK SYSTEM

1. CHECK WHETHER IT IS POSSIBLE TO ADOPT A NEW SIGN WITHOUT RISK OF INFRINGING THIRD PARTY RIGHTS (SEARCHES)
2. ONCE 1. IS SOLVED, WHETHER THAT SIGN CAN BE PROTECTED
3. TO OBTAIN PROTECTION (REGISTRATION SYSTEM)
4. TO WATCH WHETHER THIRD PARTIES DO NOT USE OR ATTEMPT TO PROTECT IDENTICAL OR CONFUSINGLY SIMILAR SIGNS
5. IF THIS HAPPENS TO 
  - PREVENT THE REGISTRATION (EXOFICIO EXAMINATION/OPPOSITION)
  - ENFORCE THE TRADE MARK (LEGAL ACTION)
6. PREVENT ABUSES OF OVERPROTECTION AND/OR KEEPING IN THE REGISTER UNUSED TRADE MARKS THAT UNDULY BLOCK THIRD PARTIES?

# TO ANALYSE THE PROPER FUNCTIONING OF THE TRADE MARK SYSTEM, IT IS NECESSARY TO EXAMINE THE FOLLOWING QUESTIONS:

1. DOES THE SYSTEM PROPERLY ENABLE SEARCHING AND LEGAL CERTAINTY ABOUT RISKS INVOLVED IN THE ADOPTION AND USE OF NEW MARKS?
2. IS THE CLEARANCE OF THE REGISTER OF UNUSED MARKS EFFICIENT?
3. DOES THE SYSTEM PROVIDE PREDICTABILITY CONCERNING:
  - REGISTRABILITY?
  - VALIDITY OF REGISTRATION?
4. DOES THE SYSTEM ENCOURAGE TRADE MARK APPLICANTS TO MAKE RATIONAL USE OF THE TRADE MARK SYSTEM?
5. DOES THE SYSTEM IMPOSE ON TRADE MARK OWNERS AN APPROPRIATE BURDEN IN THE WATCHING AND PREVENTING THE REGISTRATION OF NEW POTENTIALLY CONFLICTING APPLICATIONS?
6. ARE ENFORCEMENT MECHANISMS APPROPRIATE TO SOLVE THE CONFLICTS BETWEEN PARTIES?

# THE ADDITIONAL PROBLEMS OF THE EUROPEAN SYSTEM

- TWO COEXISTING PARALLEL SYSTEMS IN COMPETITION  $\left\langle \begin{array}{l} \text{NATIONAL (BENELUX) TRADE MARKS} \\ \text{COMMUNITY TRADE MARKS} \end{array} \right.$
- COSTS OF PROTECTION THROUGH EACH SYSTEM / GEOGRAPHIC SCOPE OF PROTECTION
- CONDITIONS OF PROTECTION  $\left\{ \begin{array}{l} \text{ABSOLUTE GROUNDS} \\ \text{RELATIVE GROUNDS} \end{array} \right.$
- USE REQUIRED TO MAINTAIN THE REGISTRATION
- INTERPRETATION OF GEOGRAPHIC REPUTATION TO ENLARGE PROTECTION
- THE SURPLUS OF OHIM

# THE TASK ENTRUSTED TO THE EUROPEAN COMMISSION

- 21/22.03.2007 • THE EU COUNCIL ENTRUSTED THE EUROPEAN COMMISSION TO:
  - PROPOSE A REDUCTION OF OHIM FEES
  - WORK ON A COMPREHENSIVE STUDY OF THE GLOBAL FUNCTIONING OF THE TRADE MARK SYSTEM IN THE EU
- 22.07.2009 • THE EUROPEAN COMMISSION PUBLISHED A TENDER FOR CONDUCTING A STUDY ON A SELECTED LIST OF ISSUES
- 16.10.2009 • MPI WAS SELECTED
- 08.03.2011 • MPI PUBLISHED A STUDY
- 26.05.2011 • A HEARING WAS ORGANISED BY THE EUROPEAN COMMISSION
  - NEXT STEPS?

# PANELISTS

- **MARGOT FRÖHLINGER:**  
NEXT STEPS OF EUROPEAN COMMISSION
- **ELIA SUGRAÑES:**  
FICPI POSITION ON A LIST OF SELECTED ISSUED