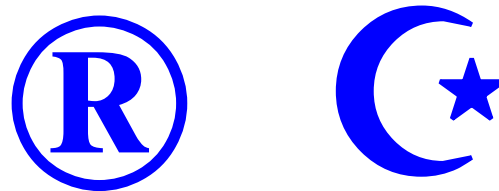


**INTA ANNUAL MEETING
Boston May 11, 1998
Luís-Alfonso Durán**

HOW VALUABLE IS YOUR MARK ?



**WOULD YOU SELL IT JUST FOR
FILING AND PROSECUTION COSTS ?**

FILING
SYSTEMS
IN THE
EUROPEAN
UNION

1) NATIONAL APPLICATIONS

2) CTM APPLICATIONS



since
April 1,
1996

3) MADRID (*)

AGREEMENT
&
PROTOCOL⁽⁺⁾



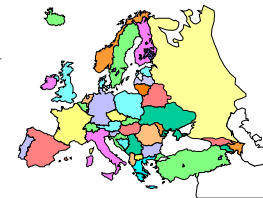
⁽⁺⁾since
April 1,
1996

(*) Only for contracting countries and for some Member States

**INTA ANNUAL MEETING
Boston May 11, 1998
Luís-Alfonso Durán**

- FILING**
- PROSECUTION**
- REGISTRATION**
- RENEWAL**
- REVOCATION/CANCELLATION**
- ENFORCEMENT**

**• NATIONAL (*):
1 PER COUNTRY :**

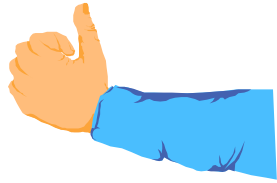


**• CTM SYSTEM :
1 PER 15 COUNTRIES :
UNITARY RIGHT**

**A
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U
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L
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S**



(*) Also International Madrid Agreement & Protocol except filing and renewal that is made by a single application.



NATIONAL SYSTEMS

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• ONLY INHERENT REGISTRABILITY
(ABSOLUTE GROUNDS) OF 1 COUNTRY

• ONLY EARLIER RIGHTS
(RELATIVE GROUNDS)
OF 1 COUNTRY

• MORE LEGAL CERTAINTY IN
SOME COUNTRIES

• RISK OF REVOCATION/CANCELLATION
(RESTRICTED TO THE COUNTRY)

UK



ES



IE



SE



DK



FI



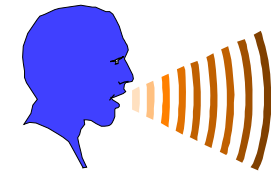
GR



PT



AT



• LANGUAGE
• CULTURE

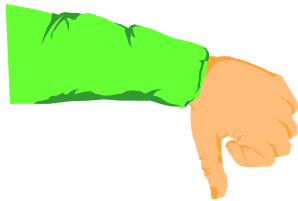


Examination

on
earlier
rights



NATIONAL SYSTEMS



DISADVANTAGES

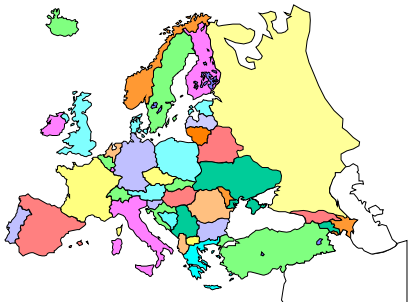
- HIGHER FILING, PROSECUTION/RENEWAL COSTS
(ONE PER COUNTRY)

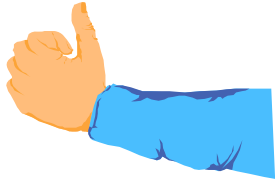


- ENFORCEMENT PER COUNTRY



- USE IN EACH COUNTRY TO AVOID RISK OF
CANCELLATION (5 YEARS)





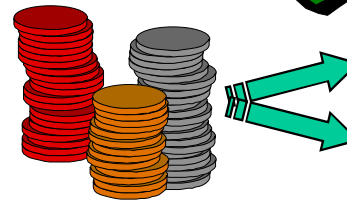
CTM SYSTEM

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• **SINGLE FILING, PROSECUTION, RENEWAL
(SAVE OF COSTS)**



• **SPLIT OF COSTS**



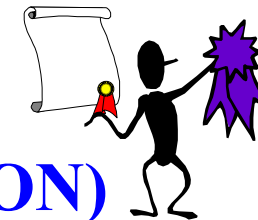
50 % FILING

50 % REGISTRATION

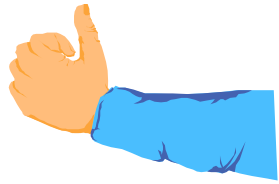
• **INCLUDES A SEARCH ON EARLIER CTMs AND
NATIONAL TMs (1)**



• **EASIER TO OBTAIN
(NO “EX OFFICIO” EXAMINATION)**



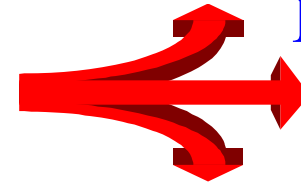
(1) Except France, Germany and Italy.



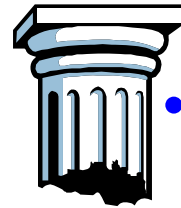
CTM SYSTEM

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• **POSSIBILITY TO CONVERT**

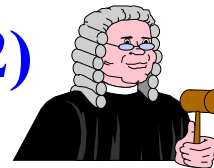


**NATIONAL
TMs**



• **SENIORITY CLAIM**

• **POSSIBILITY TO ENFORCE WITH A
SINGLE ACTION (2)**



• **LOWER USE REQUIREMENTS (3)**



(2) Provided that action is filed following the rules on jurisdiction of article 93 (1) to (4).

(3) But see contradiction between Statement to article 15 and wording of article 108.2(9) of the CTMR.

CTM SYSTEM

• **INHERENT REGISTRABILITY
(ABSOLUTE GROUNDS) (EEC)**

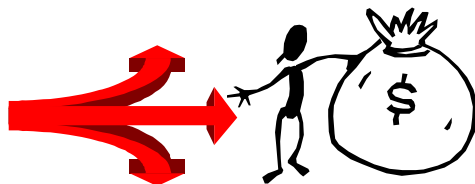
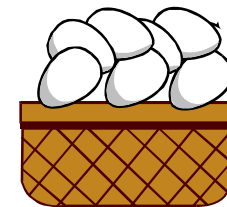
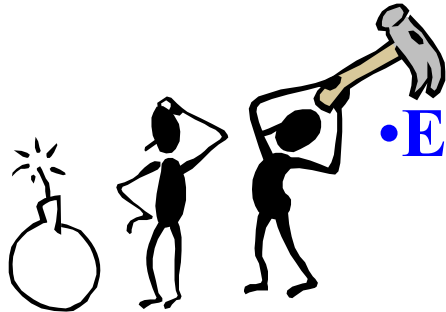
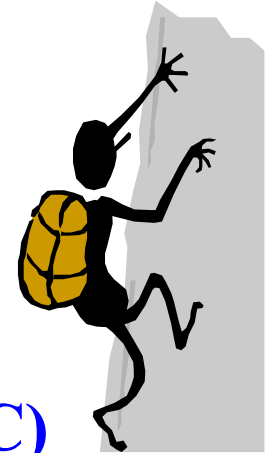
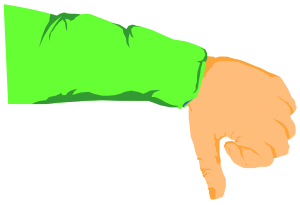
• **EARLIER RIGHTS (RELATIVE GROUNDS) (EEC)**

• **EASIER TO ATTACK (SINGLE OPPOSITION /
REVOCATION / CANCELLATION)**

• **LESS LEGAL CERTAINTY (ONLY OPPOSITIONS)**

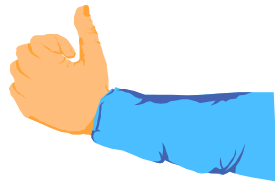
• **REVOCATION/CANCELLATION (EEC)**

• **COST OF CONVERSION**



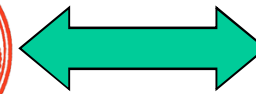
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MADRID AGREEMENT & PROTOCOL



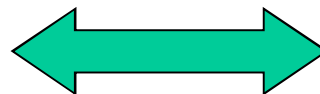
ADVANTAGES

- **SAME AS NATIONAL OR CTM SYSTEMS (*)**
(*) WHEN LINK AVAILABLE



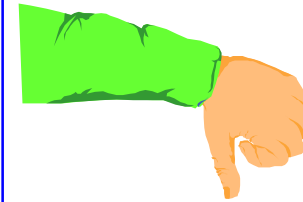
plus

- **LOWER FILING AND RENEWAL COSTS THAN DIRECT FILINGS**



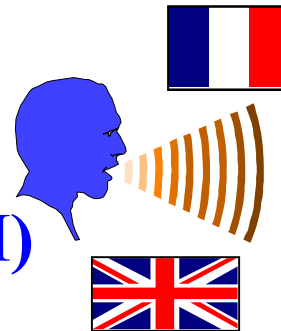
MADRID AGREEMENT & PROTOCOL

SOME DISADVANTAGES



• SAME AS NATIONAL OR CTM SYSTEMS (*)
(* WHEN LINK AVAILABLE)

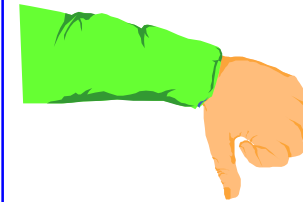
• LANGUAGE USE LIMITATION
(ONLY FRENCH & ENGLISH)



• REQUIRES A DOMESTIC REGISTRATION OR APPLICATION
THAT SHOULD MATURE INTO REGISTRATION

MADRID AGREEMENT & PROTOCOL

SOME MORE DISADVANTAGES



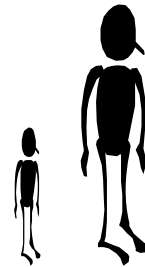
- REQUIRES IDENTICAL LIST OF GOODS / SERVICES
- DEPENDENCY OF DOMESTIC REGISTRATION FOR 5 YEARS
- CREATES A SATURATION OF UNUSED PROTECTED RIGHTS



WHICH WAY TO FOLLOW ? (I)

C
H
E
C
K

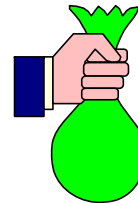
•SIZE OF APPLICANT



•COUNTRIES WHERE PROTECTION IS NEEDED

•INHERENT REGISTRABILITY OF MARK

•BUDGET AVAILABLE



•KIND OF SEARCH
BEFORE FILING



-EXTENSIVE
-ONLY IDENTICAL
-NO SEARCH

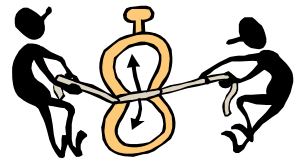
WHICH WAY TO FOLLOW ? (II)

C
H
E
C
K

• KNOWN EARLIER RIGHTS



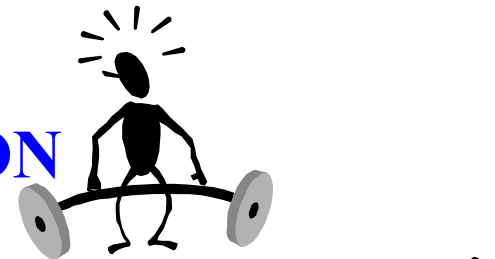
• LEGAL CERTAINTY REQUIRED



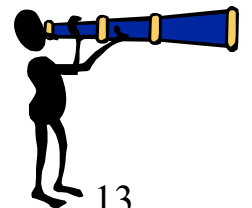
• URGENCY IN OBTAINING REGISTRATION



• STRENGTH OF DOMESTIC REGISTRATION






• ESTIMATION OF LEGAL COSTS AT LONG TERM





GENERAL

- FILING RECEIPT / FILING DATE { -2 WEEKS / 1 MONTH
-MERGER INTO 1 LETTER
- OHIM SENDS NO ACKNOWLEDGES
- SEARCHES ⇒ POOR QUALITY 
- LETTERS SENT UNDER ART. 39(6) 
- ELECTRONIC FILE SYSTEM ⇒ SLOW 



FORMAL EXAMINATION

- **GOODS & SERVICES / WIPO CLASSIFICATION REPORTS**



- **SENIORITY CLAIMS**

- **REPRESENTATION OF MARK (DECISION OF BOARD OF APPEALS)**

EXAMINATION ON ABSOLUTE GROUNDS

- **LACK OF UNIFORM CRITERIA**
- **DISTINCTIVENESS ACQUIRED ON GROUNDS OF USE**



OPPOSITIONS

• **HUGE NUMBER OF PUBLICATIONS ~ 1000 PER WEEK**

• **16 % OPPOSITION RATE**



• **ADMISSIBILITY EXAMINATION**



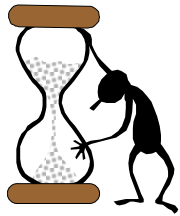
DELAYS
INFO. ABOUT
OPPOSITION

• **MULTIPLE OPPOSITIONS : SAME “COOLING-OFF” PERIOD**

CONVERSION

PROBLEM OF USE

HARMONIZATION



•SLOW PROCESS

•OHIM STANDARDS NOT YET KNOWN



•DECISIONS MAY BE APPEALED



•ENFORCEMENT : REAL TEST

•NATIONAL TENDENCY
TO KEEP TRADITION



INTA ANNUAL
MEETING

Boston May 11, 1998
Luis-Alfonso Durán

THANKS FOR YOUR
ATTENTION

