



A tribute to Florent Gevers in memoriam <<à travers le temps >>

Administrative procedures for revocation and declaration of invalidity of trade marks in the EU and non-use defence in opposition procedures (articles 44 & 45 of EU Directive 2015/2436). Was it a wise and reflected decision? Risks involved for trade mark owners

Luis-Alfonso Durán
21st March 2019
Brussels

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Picture of Past Presidents of ECTA taken in Crete (May, 2000)

- Martin Tierney (IE) 2nd President (1984-1986)
- Fabrizio de Benedetti (IT) 5th President (1988-1990)
- Florent Gevers (BE) 7th President (1992-1994)
- David Tatham (UK) 8th President (1994-1996)
- Joao Pereira da Cruz (PT) 9th President (1996-1998)
- Luis-Alfonso Durán (ES) 10th President (1998-2000)

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EU DIRECTIVE 2015/2430 TO APPROXIMATE LAWS OF EU MEMBER STATES

Article 43.1

Member States shall provide for an **efficient and expeditious administrative procedure** before their offices for **opposing** the registration of a trade mark application on the grounds provided for in Article 5.

Article 44.1

In opposition proceedings pursuant to Article 43, where at the filing date or date of priority of the later trade mark, the five-year period within which the earlier trade mark must have been put to genuine use as provided for in Article 16 had expired, at the request of the applicant, the proprietor of the earlier trade mark who has given notice of opposition **shall furnish proof that the earlier trade mark has been put to genuine** use as provided for in Article 16 during the five-year period preceding the filing date or date of priority of the later trade mark, or that proper reasons for non-use existed. In the absence of proof to this effect, the opposition shall be rejected

Article 45.1

Without prejudice to the right of the parties to appeal to the courts, Member States shall provide for **an efficient and expeditious administrative procedure** before their offices for the **revocation or declaration of invalidity** of a trade mark.

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EU DIRECTIVE 2015/2430 TO APPROXIMATE LAWS OF EU MEMBER STATES

THESE ARTICLES IMPOSE TO EU MEMBER STATES:

- THAT THEY SHOULD PROVIDE FOR ADMINISTRATIVE OPPOSITION PROCEDURES TO TRADE MARK APPLICATIONS
- THAT IN OPPOSITION PROCEDURES PROOF OF USE SHOULD BE PROVIDED UPON REQUEST OF THE APPLICANT IF THE OPPONENT'S MARK HAS BEEN REGISTERED FOR MORE THAN 5 YEARS
- THERE SHOULD BE ADMINISTRATIVE PROCEDURES FOR REVOCATION OR DECLARATION OF INVALIDITY OF TRADE MARKS

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SITUATION BEFORE IMPLEMENTATION OF DIRECTIVE (1)

EU MEMBER	OPPOSITION	PROOF OF USE	ADMINISTRATIVE REVOCATION	ADMINISTRATIVE INVALIDITY	REVOCATION / INVALIDITY JURISDICTION
BX	YES	YES	NO	NO	COURTS
DE	YES	YES	YES	NO	COURTS
ES	YES	NO	NO	NO	COURTS
FI	YES	NO	NO	NO	COURTS
FR	YES	YES	NO	NO	COURTS
IT	YES	YES	NO	NO	COURTS
LT	YES	NO	NO	NO	COURTS
LV	YES	YES	NO	NO	COURTS
PT	YES	NO	YES	NO	COURTS
AT	YES	YES	YES	YES	---
DK	YES	YES	YES	YES	---
GR	YES	YES	YES	YES	---
HU	YES	YES	YES	YES	---
MT	NO	NO	YES	YES	---

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SITUATION BEFORE IMPLEMENTATION OF DIRECTIVE (2)

- THERE ARE SEVERAL EU MEMBER STATES THAT DO NOT HAVE THE TRADITION TO HANDLE ADMINISTRATIVE REVOCATION OR INVALIDATION ACTIONS
- THESE MATTERS WERE HANDLED BY THE COURTS
- THE DEADLINE GIVEN BY THE DIRECTIVE TO IMPLEMENT THESE ADMINISTRATIVE PROCEDURES WILL EXPIRE ON JANUARY 14TH, 2023 (IN LESS THAN 4 YEARS)

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REASONS GIVEN BY THE DIRECTIVE FOR THESE CHANGES

PARAGRAPH 38 OF DIRECTIVE PREAMBLE

For the purpose of ensuring effective trade mark protection, Member States should make available an efficient administrative opposition procedure, allowing at least the proprietor of earlier trade mark rights and any person authorised under the relevant law to exercise the rights arising from a protected designation of origin or a geographical indication to oppose the registration of a trade mark application. Furthermore, in order to offer efficient means of revoking trademarks or declaring them invalid, Member States should provide for an administrative procedure for revocation or declaration of invalidity within the longer transposition period of seven years, after the entry into force of this Directive.

IN SUMMARY THESE REASONS ARE:

- ADMINISTRATIVE OPPOSITION: ENSURING EFFECTIVE TM PROTECTION
- ADMINISTRATIVE REVOCATION / INVALIDATION: OFFER EFFICIENT MEANS OF REVOKING TMS OR DECLARAING THEM INVALID
- THESE ADMINISTRATIVE PROCEEDINGS SHOULD BE "EFFICIENT"

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ARE ALL THE EU MEMBER STATES ABLE TO GUARANTEE THE EFFICIENCY IN THESE ADMINISTRATIVE PROCEDURES?

- NOT ALL TM OFFICES HAVE THE SAME RESOURCES:
 - VOLUME OF CASES
 - STAFF (NUMBER / QUALIFICATIONS)
 - OFFICES INCOME (FEES COLLECTED)

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2017

NAME	APPLICATION CLASS COUNT BY OFFICE	NUMBER OF EXAMINERS (FTE)
European Union Intellectual Property Office	117,208	300
France	270,412	..
Germany	225,768	71
United Kingdom	176,202	71
Italy	93,006	..
Spain	80,889	46
Benelux Office for Intellectual Property	67,205	..
Poland	40,434	..
Portugal	33,287	18
Czech Republic	25,339	..
Romania	22,987	25
Sweden	22,815	25
Austria	22,748	..
Bulgaria	17,552	..
Hungary	14,324	14
Slovakia	14,08	15
Denmark	11,135	..
Finland	9,376	8
Croatia	8,272	..
Lithuania	7,858	5
Ireland	7,648	..
Latvia	7,099	6
Estonia	5,493	12
Malta	1,167	2.8
Belgium	n.a.	..
Cyprus
Greece	..	5
Slovenia

Information extracted from WIPO

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THIS MEANS THAT FOR SOME MEMBER STATES IT WILL BE VERY DIFFICULT TO ENSURE THAT THE PROPOSED ADMINISTRATIVE PROCEDURES WILL BE CARRIED OUT EFFICIENTLY

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RISKS INVOLVED

- 1.- LONG PENDING DELAYS
- 2.- DIFFICULTIES FOR THE PARTIES TO SUBMIT THEIR ARGUMENTS
- 3.- LACK OF QUALITY AND CONSISTENCY IN THE DECISIONS
- 4.- UNDUE REVOCATION OR INVALIDATION OF REGISTRATIONS

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LONG PENDING DELAYS

- SOME COUNTRIES THAT ALREADY HAVE ADMINISTRATIVE CANCELLATION / INVALIDATION PROCEEDINGS REPORT THAT THESE ADMINISTRATIVE PROCEEDINGS HAVE LONG PENDING DELAYS
- THE SHORTAGE OF QUALIFIED EXAMINERS IN SOME MEMBER STATES MIGHT CONTRIBUTE TO LONG DELAYS
- BECAUSE OF THE SMALL NUMBER OF NATIONAL FILINGS IN SOME COUNTRIES THERE WOULD BE NO FINANCIAL RESOURCES TO EDUCATE, RECRUIT AND RETAIN ENOUGH EXAMINERS TO HANDLE THESE COMPLEX MATTERS UNLESS THEY ESTABLISH VERY HIGH FEES

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DIFFICULTIES FOR THE PARTIES TO SUBMIT THEIR ARGUMENTS

- ADMINISTRATIVE PROCEDURES NORMALLY ARE MORE SIMPLE THAN COURT PROCEEDINGS
- THIS NORMALLY ALSO MEANS THAT THE OPPORTUNITIES FOR THE PARTIES TO SUBMIT ARGUMENTS ARE RESTRICTED (NO HEARINGS, ETC.)
- ALSO TERMS TO REPLY ARE SHORTER (IN SOME COUNTRIES THE TERM GIVEN TO SUBMIT PROOF OF USE IS ONLY ONE MONTH)

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LACK OF QUALITY AND CONSISTENCY IN THE DECISIONS

- COURT PROCEEDINGS ARE CONDUCTED AND DECIDED BY JUDGES. THEY HAVE ALL THE GUARANTEES OF THE JUDICIAL POWER, PARTICULARLY IN COUNTRIES WITH SPECIALIZED IP COURTS
- IN ADMINISTRATIVE PROCEDURES, CIVIL SERVANTS WITH A LOWER DEGREE OF CAPACITATION ARE INVOLVED
- THE CAPACITATION OF THESE CIVIL SERVANTS MIGHT BE DIFFICULT, PARTICULARLY IN MEMBER STATES WITH SMALL NATIONAL FILING RATES
- INVALIDATION / CANCELLATION PROCEEDINGS DUE TO COUNTER CLAIMS IN INFRINGEMENT ACTIONS WILL NORMALLY BE RETAINED BY COURTS
- IF APPEALS OF TRADE MARK OFFICE DECISIONS ARE NOT APPELABLE BEFORE THE SAME COURTS, THERE IS A RISK OF INCONSISTENCY IN THE DECISIONS

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UNDUE REVOCATION OR INVALIDATION OF REGISTRATIONS

- CANCELLATION / INVALIDITY PROCEEDINGS MIGHT INVOLVE VERY COMPLEX SITUATIONS:
 - USE OF THE REGISTERED MARK IN A WAY THAT DIFFERS THE WAY HOW IT IS REGISTERED
 - PRODUCTS / SERVICES OF GREAT COMPLEXITY (SOFISTICATED TECHNICAL PRODUCTS)
 - USE IN ONLY ONE PART OF THE TERRITORY
 - CASES WHEN THE ASSEMENT OF THE EVIDENCE IS COMPLEX

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SERIOUS CONSEQUENCES FOR TRADE MARK OWNERS

- REGISTERED TRADE MARKS ARE VERY VALUABLE FOR ITS OWNERS
- SIMPLIFICATION OF THE PROCEDURES FOR REVOCATION / INVALIDATION OF A REGISTERED MARK, MAY LEAD TO LOOSING THE RIGHT DUE TO AN UNDUE ASSEMENT OF THE EVIDENCES
- USUALLY, BEHIND A REQUEST OF CANCELLATION / INVALIDATION OF A TRADE MARK REGISTRATION IS A THIRD PARTY THAT PRETENDS TO MAKE USE AND/OR REGISTER THE SAME OR A VERY SIMILAR MARK
- HENCE, THE SIMPLIFICATION OF THE REVOCATION / INVALIDATION PROCEDURES MIGHT PUT AT RISK THE CORRECTNESS OF THE DECISIONS

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USE OF A MARK IN A FORM DIFFERING FROM THE ONE REGISTERED (CP8)

1.- TM X IS REGISTERED, BUT USED AS X'

2.- A THIRD PARTY PRETENDS TO USE AND/OR REGISTER X''

3.-

1.- OWNER OF X OPPOSES THE REGISTRATION OF X''

2.- OWNER OF X SUES THE USE OF X''

3.- USER OF X'' REQUESTS THE CANCELLATION FOR LACK OF USE OF X

} PROOF OF USE OF X IS REQUESTED

4.- IF THE DECISION IS THAT USE OF X' IS NOT CONSIDERED USE OF X, BECAUSE IN APPLICATION OF ART. 16.5(c) OF EU DIRECTIVE IT IS CONSIDERED THAT USE OF X' ALTERS THE DISTINCTIVE CHARACTER OF X, THE CONSEQUENCES WILL BE THAT:

1.- X'' WILL BE REGISTERED

2.- USE OF X'' WILL BE AUTHORIZED

3.- REGISTRATION OF X WILL BE CANCELLED

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IN ALL THESE SCENARIOS USE OF

X' AND X'' BY TWO DIFFERENT COUNTRIES WILL COEXIST

WILL IT NOT BE LOGICAL THAT ONE OF THE ASSEMENTS TO BE DONE BEFORE DECIDING IF USE OF X' IS SUFFICIENT TO PROOF OF X, WOULD BE:

“ARE X' AND X'' CONFUSINGLY SIMILAR?”

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AND EXAMPLE TAKEN FROM CP8

USE OF

Bubblekat FOR CLOTHING (CLASS 25)



Bubblekat FOR CLOTHING (CLASS 25)

IS NOT CONSIDERED USE OF THE REGISTERED MARK

THIS WOULD MEAN THAT A THIRD PARTY WILL BE ABLE TO USE AND REGISTER

Bubblekat FOR CLOTHING

EVEN THOUGH THE OWNER OF TM



IS USING EXACTLY THE SAME MARK **Bubblekat**

Bubblekat

FOR THE SAME GOODS

IS THIS REASONABLE?

WAS THAT WHAT THE DRAFTER OF THE LAW PRETENDED WHEN ESTABLISHED THE COMPULSORY USE?

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THIS TRICKY MATTERS WILL HAVE TO BE ASSESED IN THE FUTURE BY THE EXAMINERS OF ALL NATIONAL OFFICES ACCORDING TO THE NEW DIRECTIVE

IT IS UP TO BE SEEN WHETHER THE EFFICIENCY PRETENDED BY THE DIRECTIVE WILL BE ACHIEVED BY ALL EU NATIONAL OFFICES OR WHETHER TRADE MARK OWNERS WILL SUFFER THE CONSEQUENCES

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THE ATTEMPT TO ALIGN NATIONAL PROCEEDINGS WITH EUIPO PROCEEDINGS DID NOT PROPERLY TAKE INTO ACCOUNT THE BIG DIFFERENCES BETWEEN THE ECONOMIC AND HUMAN RESOURCES OF EUIPO COMPARED WITH THOSE OF NATIONAL OFFICES

ONE SIZE DOES NOT FIT ALL

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**THANK YOU FOR
YOUR ATTENTION**

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