



European Communities Trade Mark Association

Brussels, 1 December 2012

ECTA Position Paper on the revision of the OHIM Manual of the Trade Mark Practice with regard to the protection of non-registered trade marks and other signs used in the course of trade of more than mere local significance under Article 8 (4) of the Council Regulation (EC) N° 207/2009 of 26 /02/2009

A. Introduction

ECTA, under the lead of ECTA Harmonization Committee, would like to thank the Office for the opportunity given to provide feedback in relation to the Manual of the Trade Mark Practice with regard to the protection of non-registered trade marks and other signs used in the course of trade of more than mere local significance under Article 8 (4) of the CTMR.

The Annex to the part of the Manual dealing with Art. 8 (4) CTMR forwarded for our review was carefully studied by the members of the ECTA Harmonization Committee.

The findings of this Committee were that amendments and comments are due in relation to the majority of countries.

The countries for which the information provided in the list of national earlier rights is correct and up to date are mentioned under Part B of this document.

Part C of this document lists the countries for which amendments are necessary in alphabetical order and indicates the proposed changes as well as comments.

For some countries the information contained in the Annex to the Manual is correct and up to date, but an English version of the relevant national legislation was missing. The respective legislation in English language is submitted under part D of this document.

We trust the Office finds our comments useful and will take them into account when revising the Annex to the Manual.

B. Countries for which no amendments are necessary

According to the findings of ECTA, the information contained in the Annex to the part of the Manual dealing with Art. 8 (4) CTMR is correct and up to date in respect of the following countries:

Finland, Hungary, Latvia and Malta.



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C. Countries for which amendments or comments are necessary

ECTA believes that amendments are necessary or comments are due with regard to the following countries:

Austria, Belgium, Bulgaria, the Czech Republic, Cyprus, Denmark, Estonia, France, Germany, Greece, Ireland, Italy, Lithuania, Luxembourg, the Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the UK.

The amendments proposed for these countries as well as comments are indicated below.

The original wording of the information in the Annex is reflected in black colour. Changes and additions to the original version of the Annex are marked in blue and comments in red colour. The relevant national legislation (in English translation) is marked in italics.

Austria

C. Unregistered TM:

Unregistered TM which has acquired ~~a certain degree of~~ recognition in the course of trade ('Verkehrsgeltung')

§ 31, AT-TML:

1) The cancellation of a mark may be demanded by any person who proves that the unregistered sign used by him for the same or similar goods or services was already known at the time of the application for registration of the contested mark identical to or resembling his unregistered sign within interested commercial circles concerned as being distinctive of the goods or services of his business, unless the mark had been used unregistered by the trade mark proprietor for at least as long a period as by the business of the party bringing the action.

2) The petition shall be rejected, if the applicant has tolerated the use of the registered mark for a period of five consecutive years, being aware of this use. This is only applicable for the goods and services, the registered mark has been used for, and only in such cases where the registered mark had not been applied for in bad faith.

3) The decision to cancel shall be retroactive to the beginning of protection (Sec. 19 sub Sec. 1).

Acquisition through use which has led to recognition by the relevant public that the sign is a mark of the claimant ('Verkehrsgeltung').

Right to prohibit use of subsequent (registered) trade mark provided that unregistered mark, at the date of application for subsequent TM, was known to the relevant public as designation for the goods or services of the claimant ('als Kennzeichen gegolten hat') and provided that the subsequent TM had not been used prior to application for the same period as an unregistered mark. **Danger of confusion must be given.**

D. Other signs used in the course of trade:

~~Trade names (the firm of an enterprise), special designations of enterprises and designations similar to them.~~

~~Acquisition through use.~~

~~§ 32, AT-TML, § 9 (1), (3) of the Law Against Unfair Competition~~

~~To the notion of a special designation of an enterprise are assimilated ('stehen gleich') such business signs ('Geschäftsabzeichen') or other signs designated to distinguish the business from~~

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~~other businesses (including the get-up or packaging of goods) which, within the relevant public, are considered to be the distinguishing sign ('Kennzeichen') of that business. Such other signs are acquired through use which has led to a recognition by the relevant public that the sign is a sign of the claimant ('Verkehrsgeltung').~~

~~§ 9 (3) of the Law Against Unfair Competition~~

~~Right to prohibit use~~

§ 32, AT-TML, § 9 (1), (3) of the Law Against Unfair Competition.

- Firm names of company registered in the Austrian Commercial Registry; Acquisition by registration in the Commercial Registry (Firmenbuch);
- Business designations including abbreviations and other business keywords under which the business is known in commerce; acquisition by any use in Austria unless such sign is not distinctive, in which a case a proof of acquired distinctiveness is necessary;
- Work titles not falling under the protection of the Copyright Act (Urheberrechtsgesetz) as well as work titles falling thereunder; acquisition by creation, unless such sign is not distinctive, in which a case a proof of acquired distinctiveness is necessary;
- Trade dresses which must have acquired recognition by the relevant public ('Verkehrsgeltung'), so that the trade dress is viewed as a product designation leading to a differentiation from similar products of other undertakings (this rule also applies to the interior of, for instance, coffee houses); acquisition by any use in Austria unless such sign is not distinctive, in which a case a proof of acquired distinctiveness is necessary;
- Personal names of natural persons which are not commonly used so that danger of confusion may arise, in the sense that the relevant public may confuse the name with the undertaking from which the designated product originates; acquisition by birth and entry into the respective personal registry;
- Domain names under the condition of their actual use, meaning that the mere reservation without any content on the website kept thereunder does not suffice to constitute use as a distinctive sign; acquisition by reservation of the domain name and presenting of commercially valuable content.

All of the above rights confer the right to prohibit the use of a subsequent trade mark and the right to cancel a subsequent trade mark in the trade mark registry (with the exception of work titles) if danger of confusion exists.

§ 32, AT-TML:

1) An entrepreneur may demand the cancellation of a mark if his name, his firm or the special designation of his establishment or a designation resembling these designations has been registered, without his consent, as a trade mark or as a part of the same (Sec. 12) and if the use of this mark were suited to cause confusion, in the course of trade, with one of the afore mentioned designations of the business of the party bringing the action.

2) The action shall be rejected, if the party bringing the action has tolerated the use of the registered mark for a period of five consecutive years, being aware of this use. This is only applicable for goods and services, the registered mark has been used for, and also in cases only where the registered mark had not been applied for in bad faith.

3) The decision to cancel shall be retroactive to the beginning of protection (Sec. 19 subSec. 1).

§ 9 (1), (3) of the Law Against Unfair Competition:

1) *Whoever, in commerce, makes use of a name, a trading name or any other special designation of an enterprise or of a printed publication to which section 80 of the Copyright Law does not apply or of a registered trade mark, in a manner apt to cause confusions with the name, the trading name or other special designation used legitimately by another, may be enjoined to cease and desist from such use by the latter.*

2) *The user shall be liable to compensate the injured party for the damage, if he knew or should have known that the misuse was apt to cause confusions.*

3) *Business signs and other devices designed to distinguish that undertaking from others, in particular also the get-up, packaging and wrapping of goods and of business papers, considered as characteristic of the enterprise with the commercial circles involved, shall be tantamount to special designations of an enterprise.*

Benelux

C. Unregistered trade marks:

Unregistered trade marks are not recognised under the uniform Benelux Convention on Intellectual Property (BCIP) unless the trade mark is well known in the sense of article 6^{bis} of the Paris Convention.

Article 2.19 BCIP

In the Annex it is stated that unregistered trade marks are not recognised under the uniform Benelux Convention of Intellectual Property, referring to Article 2.19 BCIP. However, Article 2.19 BCIP states:

Except for the owner of a well known trade mark in the sense of Article 6^{bis} of the Paris Convention, no one (...) can legally claim rights.... on an unregistered trade mark (interpretative translation).

In addition we remark that in Article 2.14 (1) (b) BCIP is stated that a (Benelux) opposition may be filed if the application might cause confusion with one's well-known mark in the sense of Art. 6^{bis} of the Paris Convention.

Art. 2.14 (1) (b) BCIP:

1) *The applicant or the owner of a prior trademark may submit a written objection to the Office, within a period of two months (...), against a trademark which:*

[...]

b) may give rise to confusion with its well-known trademark within the meaning of Article 6^{bis} of the Paris Convention.

Art. 2.19 BCIP:

With the exception of the owner of a trademark which is well known within the meaning of Article 6^{bis} of the Paris Convention, and regardless of the nature of the action brought, no one may claim

in court a sign deemed to be a trademark as defined in Article 2.1(1) and (2), unless that claimant can provide evidence of registration of the trademark which it has filed.

Art. 2.20 BCIP:

1. A registered trademark shall provide its owner with an exclusive right. Without prejudice to the possible application of ordinary law in matters of civil liability, the exclusive right to a trademark shall permit the owner to prevent any third party, without its consent, from:

(a) using in business a sign that is identical to the trademark for goods or services that are identical to those for which the trademark is registered;

(b) using in business a sign in respect of which, because it is identical or similar to the trademark and because the goods or services covered by the trademark and the sign are identical or similar, there is a risk of confusion in the mind of the public which includes the risk of association between the sign and the trademark;

(c) using in business a sign which is identical or similar to the trademark for goods or services which are not similar to those for which the trademark is registered, where the trademark enjoys a reputation in the Benelux territory and where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark;

(d) using a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.

D. Other signs used in the course of trade:

General remarks:

Article 2.20 (1) (b) BCIP states that the trade mark owner can prohibit the use of the sign when that sign is being used, other than to distinguish goods or services, where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

~~General remark:~~ In respect of the Benelux territory, each state must be considered separately.

Belgium

- Trade name ('nom commercial')
Article 2.19 BCIP, ~~Article 93 of 'loi du 14 juillet 1991 sur les pratiques du commerce et sur l'information et la protection du consommateur'~~ Article 95 of 'loi du 6 avril 2010 relative aux pratiques du marché et à la protection du consommateur' and Article 1382 of the 'Code Civil' (Civil Code).

Acquisition of trade name from its first use in trade. Protection limited to geographical area where the trade name is used.

Right to prohibit use of subsequent (registered) trade mark.

Art. 1382 of the Civil Code:

Any act of a person that causes damages to another person, obliges the person by whose fault it happened, to repair the damages.

Article 2.19 BCIP (cited under Benelux) and article 95 of 'loi du 6 avril 2010 relative aux pratiques du marché et à la protection du consommateur':

Is prohibited any act contrary to honest practice in the market by which a company infringes or may infringe the professional interests of one or more other parties.

- Company name ('dénomination sociale')
Article 2.19 BCIP and Article 65 of 'Code de sociétés du 7 mai 1999'
Acquisition of protection as a company name, in principle, from the date of the establishment of the company. Protection extends to the whole national territory.
Right to prohibit use of subsequent (registered) trade mark.

Article 2.19 BCIP (cited under Benelux) and article 65 of 'code de sociétés du 7 mai 1999':

Every company is designated by a name which must be different from any other company. If it is identical or similar and the similarity may be misleading, any interested party can ask for change and claim damages, if applicable.

The founders, or in case of subsequent changes of the company name, the members of the management body are jointly liable for damages to interested parties as provided in Article 2.

Luxembourg

- Trade name ('nom commercial') / company name ('dénomination sociale')
Article 2.19 BCIP, Article 14 of 'Loi du 30 juillet 2002 réglementant certaines pratiques commerciales, sanctionnant la concurrence déloyale et transposant la directive 97/55/CE du Parlement Européen et du Conseil modifiant la directive 84/450/CEE sur la publicité trompeuse afin d'y inclure la publicité comparative' and Article 25 of 'Loi du 10 août 1915 concernant les sociétés commerciales'.
Right to prohibit use of subsequent (registered) trade mark.

Article 2.19 BCIP (cited under Benelux)

Article 14 of 'loi du 30 juillet 2002':

Commits an unfair competition act every person, who is exercising a commercial, industrial, skilled crafts or self-employed activity and who, by acts contrary to honest purposes in commercial, industrial, skilled crafts or self-employed activities, or to a contractual agreement, takes away or tries to take away from his competitors or one of them part of their clients or who interferes or tries to interfere with their competitive capacity.

Creating confusion or trying to create confusion between one's person, company, goods or services and the person, company, goods or services of a competitor is considered an unfair competition act by case law.

Article 25 of 'loi du 15 août 1915':

Every company is designated by a particular name or by the object of its activity. This name must be different from any other company. If it is identical or if the similarity may be misleading, any interested party can request it to be changed and claim damages, if applicable.

Netherlands

- Trade name

Article 2.19 BCIP and Law of 5 July 1921 on trade names ('Handelsnaamwet') and Article 6:162 of the Dutch Civil Code (Burgerlijk Wetboek).

Acquisition: Right to a trade name is acquired by its use; there is a possibility to have the trade name registered with the Trade Register at the Chamber of Commerce, but there is no obligation to do so, and doing so does not provide any right. No particular requirement that the trade name be distinctive and non-descriptive.

Right to prohibit use of subsequent (registered) trade mark where there is a risk of confusion.

Trade name rights are in the Netherlands considered signs other than to distinguish goods or services.

Article 5 of the (Dutch) Act of 5 July 1921 on trade names (based on Google translate):

It is prohibited to use a trade name, which, before the company under that name was driven, was already lawfully used by another, or one that only marginally deviates from the trade name, all this insofar as a result, due to the nature of the two companies and the place where they are established, confusion among the public between these companies is to be feared.

Article 6.162 of the Dutch Civil Code (based on Google translate):

1. A person who commits an unlawful act against another which is attributable to him, must repair the damage suffered by the other in consequence thereof.

2. An unlawful act is the violation of a right and an act or omission breaching a duty imposed by law or a rule of unwritten law pertaining to proper social conduct.

3. An unlawful act can be attributed to the perpetrator if it is due to his fault or to a circumstance which is by law or in general accepted for its account.

Bulgaria

C. Unregistered TM:

~~Only if well-known in the territory of the Republic of Bulgaria~~

~~Article 12 2 (iii), BG-TML~~

Unregistered trade marks are protected only if they are well-known in the territory of Bulgaria.

A well-known mark could be the basis for an opposition as well as for a cancellation action against an identical or similar mark for identical or similar goods.

Article 12 (2)(vii) of the BG-TML:

Art. 12. In case of opposition filed under Art. 38b shall not be registered a mark:

[...]

(2) An earlier mark in the sense of para 1 shall be:

[...]

(vii) a mark which is well-known in the territory of the Republic of Bulgaria by the date of submitting an application for a mark, respectively by the date of priority.

According to the last amendments of the Bulgarian Trade mark Law in force since March 9, 2010 the use of an unregistered mark in the territory of Bulgaria could be the basis for filing an opposition against a trade mark application with a filing date which is later than the actual use in the course of trade. But up to now there is no practice and it is not clear how it will be applied.

Art. 12 (6) of the BG-TML:

In case of opposition filed by the real holder of a non-registered mark used in the commercial activity in the territory of the Republic of Bulgaria, a mark shall not be registered if its filing date is later than the date of the actual commercial use of the non-registered mark.

D. Other signs used in the course of trade:

No other signs used in the course of trade are included by the Bulgarian trade mark law as prior rights which could be a basis for filing an opposition.

But the earlier personal right of others, i.e. personal name and portrait, copyright, industrial property right of others could be a basis for cancellation when the use of the trade mark could be forbidden on the basis of these rights.

Art. 26 (3) of BG-TML:

The registration of a mark shall be cancelled when:

[...]

(5) the use of the mark could be prohibited on the basis of an earlier right of third person which right benefits protection under other law and in particular:

- a) right of name and portrait;*
- b) copyright;*
- c) right of selectionist over the name of a variety or breed;*
- d) right on industrial property.*

Also a company name which is registered and used in the territory of Bulgaria could be a basis for cancellation of a trade mark registration in connection with identical or similar goods or services where the trade mark consists of or contains the company name.

Art. 26 (3) of BG-TML:

The registration of a mark shall be cancelled when:

(6) the mark consists of or contains the firm of other person, which firm has been registered and used in the Republic of Bulgaria before the date of submitting the application for registration in connection with identical or similar goods or services.

Cyprus

C. Unregistered trade marks:

~~Unregistered trade marks are not recognised under the law of Cyprus.~~

The Cyprus Trade Marks Law, Cap. 268 does not contain any provisions for the protection of unregistered trade marks. However, Section 35 of the Civil Wrongs Law, Cap. 148 provides protection for unregistered trade marks.

Therefore, unregistered trade marks can be enforced under Section 35 of the Civil Wrongs Law, with the initiation of a passing off action.

Use of the unregistered trade mark needs to be established.

Unregistered trade marks confer the right to prohibit the use of a subsequent trade mark, the right to prevent/object to the registration of a subsequent trade mark and the right to seek the strike off an already registered trade mark.

Section 35 of the Civil Wrongs Law, Cap. 148:

Any person who by imitating the name, description, sign or label or otherwise causes or attempts to cause any goods to be mistaken for the goods of another person, so as to be likely to lead an ordinary purchaser to believe that he is purchasing the goods of such other person, shall commit a civil wrong against such other person.

D. Other signs used in the course of trade:

Trade names

The use of the trade name needs to be established and if the trade name is registered its registration shall also be proved.

Trade names confer the right to prohibit the use of a subsequent trade mark where the sign and/or the goods-services are similar or identical.

Czech Republic

C. Unregistered trade marks:

~~Unregistered signs which have become characteristic through use prior to the filing of an opposing application and is more than of mere local significance~~

~~Article 7 (1)(g), CZ-TML~~

~~Acquisition through use in the course of trade.~~

~~Scope of protection: Identical to that of a Czech registered mark~~

~~Right to prohibit subsequent trade mark if signs are identical or similar and cover identical or similar goods and services~~

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The term 'unregistered trademark' does not exist in the laws of the Czech Republic and such trademarks are not recognised.

D. Other signs used in the course of trade:

~~Industrial property right, if it can be affected by the use of the sign applied for
Article 7 (1) (j), CZ-TML~~

- a) Unregistered signs which have become characteristic through use prior to the filing of a contested application/trademark and which are of more than mere local significance are addressed in Article 7 (1)(g) CZ-TML.

Article 7 (1) (g) CZ-TML:

Section 7

(1) The sign applied for shall not be registered in the register upon opposition against the registration of the trade mark in the register (hereinafter referred to as 'the opposition') filed with the Office by

[...]

g) the proprietor of a non-registered sign or of another sign used in the course of trade of more than mere local significance for identical or similar goods and services, if such sign is identical with or similar to the sign applied for, if the rights to that sign were acquired prior to the date of the application for registration;

Such signs can present the basis for filing an opposition and or invalidation action under CZ-TML.

The definition of an unregistered sign under CZ-TML is applicable only to the opposition and/or invalidation proceeding under CZ-TML

Unregistered signs which were acquired through use and prior to the application for registration of the later trademark provide also the right to prohibit use of a subsequent trade mark on the basis of unfair competition laws on condition that the respective conditions of unfair competition are fulfilled.

- b) Company names ('obchodni firma')

Acquisition through registration in the Commercial Register ('obchodní rejstřík')

They confer the right to prohibit the use of a subsequent trade mark if the signs are identical or similar and cover identical or similar goods and services on the basis of unfair competition laws and provisions on protection of a company name.

Denmark

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C. Unregistered trade marks:

- TM 'by commencement of use'

§ 3 (1) (ii), DK-TML

Acquisition: Right to unregistered trade mark by commencement of its use in Denmark

§ 3 (1) (ii), DK-TML:

1) A trade mark right may be established either

[...]

(ii) by commencement of use of a trade mark in this country for the goods or services for which the trade mark has commenced to be used and for which it is continuously used.

- Right to prohibit use of subsequent (registered) trade mark if used for the goods or services for which it has commenced to be used and for which it is continuously used
§ 15 (4) (ii), DK-TML

§ 15 (4) (ii), DK-TML:

[...]

4) A trade mark shall, moreover, not be registered if

[...]

(ii) in consequence of use in this country a right has been obtained to an identical or confusingly similar trade mark or to another identical or confusingly similar sign used in the course of trade prior to the date of filing of the application for registration of the later trade mark or, where appropriate, the date of the priority claimed in respect of the application for registration of the later trade mark,

Scope of protection: The same as for Danish registered trade marks, i.e. against the acts corresponding to those referred to in Article 9(1) (a), (b) and (c) CTMR
§ 4 (1), (2), DK-TML.

§ 4 (1), (2), DK-TML:

1) The proprietor of a trade mark right shall be entitled to prohibit any person not having his consent from using any sign in the course of trade if

(i) the sign is identical with the trade mark, and the goods or services for which the sign has been put to use are identical with the goods or services for which the trade mark is protected, or

(ii) the sign is identical with or similar to the trade mark, and the goods or services are identical or similar, if there exists a likelihood of confusion including a likelihood of association with the trade mark.

2) Irrespective of the limitation in subsection 1 to goods or services being identical or similar, the proprietor of the trade mark shall be entitled to prohibit the use of the trade mark also in relation to goods or services which are not identical or similar if the trade mark has a reputation in this country and the use would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark.

D. Other signs used in the course of trade:

Company name to which the person concerned has a legal title.

The term 'company name' is to be given an extensive interpretation and covers not only private companies such as private firms, limited liability companies, other commercial companies, secondary trade names but equally foundations, unions, associations, museums and public institutions.

§ 14 (iv), DK-TML

Acquisition: Company name protection does not require its registration.

Right to prohibit use of subsequent (registered) trade mark where signs are identical or similar.

§ 14 (iv), DK-TML:

Furthermore, the following shall not be registered:

[...]

(iv) Trade marks which without permission consist of or contain an element which may be construed as a personal name or company name to which another party has a legal title, or as a portrait, provided allusion is not made to persons long dead, or which without permission contain a distinctive name of or a picture of the real property of another party.

Acquisition: Company name protection does not require its registration but depending of the type of company, the company must be registered with the Danish Business authority, to come into existence.

A company name confers the right to prohibit the use of subsequent (registered) trade mark where the signs are identical or very similar and where the company is active within the same line of business or the company is providing goods or services that are identical or similar to those for which a subsequent trade mark is used. It is a requirement that the company name, or its dominant element, is seen to be distinctive.

If a company is registered correctly it can prohibit the use and registration of trade marks where the signs/trade marks are identical or similar.

Nothing is said about a required similarity between the goods or services, but in our opinion, the courts will certainly take this into account. The reason is that it should not be possible to register a secondary company name which can hinder the registration or use of trade marks even if the goods or services are not similar.

- Signs used in the course of trade

§ 15 (4) (ii), DK-TML

The term 'signs used in the course of trade' is to be given an extensive interpretation and covers, according to Danish law, any commercial meaning or symbol, which can serve as a connecting link between a business and its customers/users. This includes, inter alia, trade marks, business names and shop-facades. Right to prohibit use of subsequent (registered) trade mark, where signs are identical or similar.

In our opinion the above is too simplified.

1) If 'signs used in the course of trade' are considered trade marks, normal opposition requirements are needed, such as similarity or identity between the signs and similarity between the goods and services as well.

2) If 'signs used in the course of trade' are not considered trade marks the same overall must apply, meaning that the courts will take business relations and goods and services into account.

- Distinctive titles of protected literary and artistic works

Only titles of protected literary and artistic works fall under this provision. Whether a literary or artistic work is protected is decided according to the Danish Law on Copyright.

§ 14 (v), DK-TML

Right to prohibit use of subsequent (registered) trade mark.

§ 14 (v), DK-TML:

Furthermore, the following shall not be registered:

[...]

(v) Trade marks which without permission consist of or contain an element which may be construed as a distinctive title of the protected literary or artistic work of another party or which infringe the copyright in such a work or the right to a photograph of another party or the industrial property rights of another party.

Estonia

C. Unregistered trade marks:

Unregistered trade marks are not protected under Estonian law, unless the marks can be considered to be well-known.

§ 5 (1) 3) and § 11 (1) 1) EST-TML

§ 5 EST-TML:

§ 5. Protectable trade marks

(1) Legal protection is granted to:

1) trade marks which are well known in Estonia within the meaning of Article 6^{bis} of the Paris Convention for the Protection of Industrial Property (RT II 1994, 4/5, 19) (hereinafter well-known trade marks);

§ 11 (1) 1) EST-TML:

§ 11. Earlier trade mark and other earlier rights

(1) An 'earlier trade mark' means the following:

1) a trade mark which became well known earlier;

D. Other signs used in the course of trade:

- Business names entered in the commercial register prior to the filing date of the registration, application, the date of international registration or the date of priority ~~or the priority date provided that the area of activity in respect of which a notation has been made in the commercial register includes the goods and services for which the trade mark is used to or is going to be used (designates)~~ and the area of activity of the respective undertaking is in the same field as the goods and services for which the trade mark is used to or is going to be used.

Article 10(1) 4), EST-TML

Article 10(1) 4), EST-TML:

§ 10. Relative circumstances which preclude legal protection

(1) Legal protection is not granted to the following trade marks:

[...]

4) trade marks which are identical or confusingly similar to a business name entered in the commercial register prior to the filing date of the application, the date of international registration or the date of priority, and the area of activity of the respective undertaking is in the same field as the goods and services which the trade mark is used to or is going to be used to designate;

Acquisition of protection as a business name is from date of entry in the commercial register. Those areas of activity of an undertaking which are included in the annual financial report submitted to the commercial register have a legal effect.

- Names of proprietary medicinal products registered in Estonia prior to the filing date of the application, the date of international registration or the date of priority if the goods which the trade mark is used to or is going to be used to designate belong to the field of medicine.

Article 10 (1) 5), EST-TML

Article 10 (1) 5), EST-TML:

§ 10. Relative circumstances which preclude legal protection

(1) Legal protection is not granted to the following trade marks:

[...]

5) which are identical or confusingly similar to the name of a proprietary medicinal product registered in Estonia prior to the filing date of the application, the date of international registration or the date of priority if the goods which the trade mark is used to or is going to be used to designate belong to the field of medicine;

- A name, a right of personal portrayal, a right to the name of an immovable, the name or image of an architectural site, an object of copyright or industrial property right or another earlier right.

Article 10 (1) 6), EST-TML

Article 10 (1) 6), EST-TML:

§ 10. Relative circumstances which preclude legal protection

(1) Legal protection is not granted to the following trade marks:

[...]

6) the use of which is detrimental to an earlier right to a name, a right of personal portrayal, a right to the name of an immovable, the name or image of an architectural site, an object of copyright or industrial property right or another earlier right;

Right to prohibit use of subsequent (registered) trade mark where the signs are identical or similar and if they are used for the goods and services for which the trade mark is registered.

France

C. Unregistered trade marks

~~Unregistered trade marks are not recognized under French law.~~

Acquisition: Unregistered trade marks are protected provided they are 'famous' in accordance with article 6^{bis} of the Paris Convention.

Scope of protection:

- Right to prohibit reproduction and/or imitation for identical(similar products, with a likelihood of confusion in case of imitation
Article L. 711-4 (a) and L. 712-4 al. 1 FR-IP Code

Article L711-4 (a) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

a) An earlier mark that has been registered or that is well known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property;

Article L. 712-4 al. 1 FR-IP Code:

During the period of time referred to in Article L712-3, opposition to an application for registration may be entered with the Director of the National Institute of Industrial Property by the owner of a mark that has been registered or applied for at an earlier date or which enjoys an earlier priority date or by the owner of an earlier well-known mark.

- Right to prohibit reproduction and/or imitation for different products, provided (i) damages caused to the owner or (ii) unjustified use of the unregistered famous trade mark
Article L. 713-5 FR-IP Code

Article L. 713-5 FR-IP Code:

Any person who uses a mark enjoying repute for goods or services that are not similar to those designated in the registration shall be liable under civil law if such use is likely to cause a prejudice to the owner of the mark or if such use constitutes unjustified exploitation of the mark.

The foregoing paragraph shall apply to the use of a mark that is well known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property referred to above.

D. Other signs in the course of trade

- Name or sign of a company ('dénomination sociale')
Article L. 711-4 (b), FR-IP CODE
Acquisition: Protection of the company name from completion of founding documents of the company.
Scope of protection: In principle, a company name is protected only in the area of effective activities.
Right to prohibit use of a subsequent trade mark.
Scope of protection: ~~In principle, a company name is protected only in the area of effective activities.~~

Article L711-4 (b) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

[...]

b) The name or style of a company, where there is a risk of confusion in the public mind;

- Trade name ('nom commercial')
Article L. 711-4(c), FR-IP CODE
Acquisition: Protection from its first and continuous use in trade. Must be known throughout the French territory.
Scope of protection: Risk of confusion in the mind of the public.

Article L711-4 (c) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

[...]

c) A trade name or signboard known throughout the national territory, where there exists a risk of confusion in the public mind;

- Business sign ('enseigne')
Acquisition: Protection from its first **and continuous** use in trade. **Must be known throughout the French territory.** ~~Geographical scope: limited, in principle, to area of activity (rayonnement local).~~
~~Right to prohibit use of a subsequent trade mark only if sign is known in the whole country (enseigne notoire).~~
Scope of protection: Risk of confusion in the mind of the public.

Other rights provided they are used in the course of trade:

- A protected appellation of origin
Article L. 711-4 (d) FR-IP Code
Article L711-4 (d) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

[...]

d) A protected appellation of origin;

- Author's rights
Article L. 711-4 (e) FR-IP Code
Article L711-4 (e) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

[...]

e) Authors' rights;

- Rights deriving from a protected industrial design
Article L. 711-4 (f) FR-IP Code
Article L711-4 (f) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

[...]

f) Rights deriving from a protected industrial design;

- The personality rights of another person, particularly his surname, pseudonym or likeness
Article L. 711-4 (g) FR-IP Code
Article L711-4 (g) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

[...]

g) The personality rights of another person, particularly his surname, pseudonym or likeness;

- The name, image or repute of a local authority
Article L. 711-4 (h) FR-IP Code
Article L711-4 (h) FR-IP Code:

Signs may not be adopted as marks where they infringe earlier rights, particularly:

[...]

h) The name, image or repute of a local authority.

- Domain names

Acquisition by first and continuous use.

Scope of protection: likelihood of confusion/damages caused to first user.

Germany

C. Unregistered trade marks:

Trade mark acquired by use ('Benutzungsmarke').

Acquisition through use which has led to recognition by the relevant public that the sign is a mark of the claimant ('Verkehrsgeltung').

§ 4 No. {2}, DE-TML

§ 4 No. 2 DE-TML:

Trademark protection shall accrue

[...]

2. from the use of a sign in the course of trade, provided that the sign has acquired recognition as a trademark among the trade circles concerned.

Right to prohibit the use of a subsequent trade mark in the whole territory of Germany, if the recognition exists in the whole of Germany. Not, if recognition is established only for a particular locality.

§14, DE-TML

Scope of protection: The same as for registered German trade marks, i.e. against the acts corresponding to the acts referred to in Article 9 (1) (a), (b) and (c) CTMR.

§ 14 (2) no. 1, 2 and 3, DE-TML

D. Other signs used in the course of trade:

Business identifiers ('geschäftliche Bezeichnungen'), namely

- business signs ('Unternehmenskennzeichen'),

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- work titles ('Werktitel').

§ 5 (1), DE-TML

A business sign is a sign which is used in the course of trade as the name or firm or as the special business designation of a business establishment ('Geschäftsbetrieb') or business enterprise ('Unternehmen'). To the notion of a special designation of a business are assimilated ('stehen gleich') such business signs ('Geschäftsabzeichen') or other signs designated to distinguish the business from other businesses which, within the relevant public, are considered to be the distinguishing sign ('Kennzeichen') of that business.

§ 5 (2), DE-TML

The name or firm is the official or officially registered designation of the trader. The special designation of business is a sign used by the trader to identify his business or undertaking as such, which functions as the name of the business or enterprise. A work title is the name or other designation of printed publications, films, musical works, stage works or other comparable works, § 5 (3), DE-TML

This can be an individual work, a series of works, or a periodical publication. Under German jurisprudence, this also includes titles of radio or television series, computer games and video games, possibly also computer programs. It is not required that the work designated by the work title is protected under copyright law.

§ 5 DE-TML:

Business identifiers ('Geschäftliche Bezeichnungen')

1. Business signs ('Unternehmenskennzeichen') and work titles ('Werktitel') are protected as business identifiers.

2. Business signs are signs used in the course of trade as name; company name or special designation of a business establishment ('Geschäftsbetrieb') or of an undertaking. Business symbols and other signs intended to distinguish the business establishment from other business establishments, which are regarded as symbols ('Kennzeichen') of the business establishment among the trade circles concerned, shall be deemed equivalent ('stehen gleich') to the special designation of a business establishment.

3. Work titles ('Werktitel') are the names or special designations of printed publications, cinematographic works, music works, stage works or other comparable works.

Acquisition of rights:

- Business signs:

Main rule: If the sign is inherently distinctive, acquisition through use in trade as a business sign.

If the sign is not inherently distinctive, through acquisition of market recognition ('Verkehrsgeltung').

Exception: other business signs ('Geschäftsabzeichen') or other signs designated to distinguish the business from other businesses are protected only if they have become

known in the course of trade as distinctive signs, i.e., if they have acquired distinctiveness through market recognition ('Verkehrsgeltung')

- Work titles:

If the work title is inherently distinctive, acquisition through use in the course of trade, i.e. normally as from the appearance of the work. The required degree of inherent distinctiveness is low. If the work title is not inherently distinctive, acquisition through acquisition of market recognition ('Verkehrsgeltung').

It is possible according to German jurisprudence to benefit from a priority date which is earlier than the actual publication of the entire work if the work title is announced in a so called title protection notice ('Titelschutzanzeige') provided that the work is published under this work title within a reasonable time period.

Right to prohibit use:

Right to prohibit unauthorized use of the **business signs identifier** or similar signs ('ähnliches Zeichen) in the course of trade where there is a risk of confusion (§ 15 (2) DE-TML). If the business sign has a reputation in Germany it is also protected regardless of likelihood of confusion if the use would be detrimental to, or take unfair advantage of, the distinctiveness or reputation of the business **sign identifier**.

§ 15, DE-TML:

§ 15 Exclusive right of the proprietor of a business identifier; right to an injunction; claim for damages

1. The acquisition of protection of a business identifier shall grant to its proprietor an exclusive right.

2. Third parties shall be prohibited from using the business identifier or a similar sign in the course of trade without authorisation in a manner which may cause confusion with the protected designation.

3. If the business identifier is a business identifier which has a reputation in this country, third parties shall also be prohibited from using the business identifier or a similar sign in the course of trade if there is no likelihood of confusion within the meaning of Subsection 2; insofar as the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the business identifier.

Domain names:

Depending on their actual use domain names might be protected as trade marks acquired by use ('Benutzungsmarken') or business identifiers ('geschäftliche Bezeichnungen'). The acquisition of rights and the right to prohibit use correspond to the above mentioned criteria.

Greece

Changes are due to the fact that there is a new trade mark law in Greece (Law No. 4072/2012) which was fully enacted in October 2012. We have updated the references relevant for Part C

and D, but would recommend to revise also the other parts of the Manual referring to the Greek Trade Mark Act.

C. Unregistered trade marks:

Introduction:

There are two sets of provisions dealing with the protection of unregistered trade marks and related signs: (a) trade mark law confers on the owner the right to prohibit registration of a later trade mark, whereas (b) the law on unfair competition and other specific provisions deal with the issue of use. As the complementary application of trade mark law for any matter not directly dealt with in other statutes is generally accepted, both sets of rules are discussed here. Acquisition through use in the course of trade. If not inherently distinctive, they must have also been 'established in the market'. Necessary conditions of protection: Prior use, likelihood of confusion as to origin.

~~Article 4 (3) (a), GR-TML~~ [Article 124 \(3\)\(a\) GR TML \(Law No. 4072/2012\)](#)
Law 146/1914 on Unfair Competition, Article 13 (1)

D. Other signs used in the course of trade:

- Company names:
Acquisition exclusively through use in the course of trade. Registration is not relevant for protection, it only serves administrative purposes.
Necessary conditions of protection: Prior use, likelihood of confusion as to origin.
Civil code, Article 58
Law 1089/1980, Article 4-8, as amended by 1746/1988
- Trade names and commercial establishment insignia:
Acquisition through use in the course of trade. If not inherently distinctive, they must have also been 'established in the market'.
Necessary conditions of protection: Prior use, likelihood of confusion as to origin.
~~Article 4 (3) (a), GR-TML~~ [Article 124 \(3\) \(a\) GR TML \(Law No. 4072/2012\)](#)
Law 146/1914 on Unfair Competition, Article 13 (1) (2)

[Article 124 \(3\) \(a\) of Law 4072/2012:](#)

A trade mark shall not be registered:

(a) If it conflicts with a non-registered trade mark or with any other distinctive sign or feature used in the course of trade, which confers upon its owner the right to prohibit the use of any later trade mark, provided such rights have been acquired prior to the date of the application for the later trade mark, taking into account any priorities claimed.

[Article 1 of Law 146/1914 \(Unfair Competition\):](#)

Any act made in commercial, industrial or agricultural transactions for purposes of competition which is contrary to moral principles shall be prohibited.

The offender may be sued to refrain [from committing such act] and to make good any damage caused.

Article 13 of Law 146/1914 (Unfair Competition):

Anyone who, in the course of business, makes use of a name, a firm name, or the special designation of a business establishment or of an industrial enterprise, or of a printed work, in a manner capable of causing confusion with the name, firm name, or special designation legitimately used by another, may be enjoined from such use by the latter. He shall be also liable to the injured party for damages, if he knew or should have known that the misuse was capable of causing confusion.

Business symbols of a business establishment or an enterprise which are considered within the trade concerned as the distinctive signs of such establishment or enterprise shall be equivalent to the special designation.

The special presentation or the special decoration of the goods and the packaging or the covering thereof are assimilated to the special designation, if they are considered within the trade concerned as the distinctive signs of the similar goods of another.

The provision of the last sub-paragraph of Article 10 is applicable by way of analogy.

- Titles of periodical publications:
Generally regarded as sui generis exclusive rights, whether or not original enough to be protected as literary works.
Acquisition through use in the course of trade (i.e. from date of first publication).
Necessary conditions of protection: Prior use, likelihood of confusion as to origin.
~~Article 4 (3) (a), GR-TML~~ [Article 124 \(3\) \(a\) GR TML \(Law No. 4072/2012\)](#)
Law 146/1914 on Unfair Competition, Article 13 (1)
- Other distinctive signs:
The peculiar shape of the goods or of their packaging, as well as the peculiar get up or decoration thereof (Ιδιαίτερος διασχηματισμός, διακόσμηση), provided they are known in the relevant commercial sector as product identifiers of a given trader.
Acquisition through use in the course of trade. They must be capable of performing a trade mark-like function (i.e. to possess a distinctive character afforded by a certain degree of originality).
Necessary conditions of protection: Prior use, likelihood of confusion as to origin.
~~Article 4 (3) (a), GR-TML~~ [Article 124 \(3\) \(a\) GR TML \(Law No. 4072/2012\)](#)
Law 146/1914 on Unfair Competition, Article 13 (3)

General note:

All the exclusive signs referred to above are also protected under Art. 1 of Law 146/1914 on 'Unfair Competition', especially as regards infringing acts not covered by the above provisions (e.g. protection of reputed signs for dissimilar goods – dilution of, or unfair advantage to, their distinctiveness or repute, that is, where likelihood of confusion is not relevant).

Ireland

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C. Unregistered trade marks:

Unregistered trade marks used in the course of trade

Section 10 (4) (a), IE-TMA

Right to prohibit use of subsequent TM if protected by any rule of law, in particular, the law of passing off. The action for passing-off is based upon goodwill acquired by use of the earlier sign. Goodwill is sometimes called reputation. In Ireland, goodwill can be acquired without necessarily trading in the territory of the State. The tort arises if a later sign causes a misrepresentation likely to lead to deception or confusion, with consequent likelihood of damage to the goodwill or business of the proprietor of the earlier sign. [The plaintiff must prove that its goodwill and business suffered or are likely to suffer damage as a result of the activities of the defendant.](#) The law is explained in 'Intellectual Property in Ireland' by Robert Clark and Shane Smyth, Butterworths, 1997, Chapter 24. Authoritative statements of the law are found in Court judgements, for example in *C. & A. Modes v. C. & A. (Waterford)* [1978] Fleet Street Reports 126; *Adidas K.G. v. O'Neill & Co. Limited* [1983] Fleet Street Reports 76; and *Guinness Ireland Group v. Kilkenny Brewing Co. Limited* [2000] Fleet Street Reports 112 [Mc Cambridges Ltd v. Joseph Brennans Bakeries \[2012\]](#).

D. Other signs used in the course of trade:

Business sign used in the course of trade

Section 10 (4) (a), IE-TMA

Right to prohibit use of subsequent TM if protected by any rule of law, in particular, the law of passing off.

On the law of passing-off, see remarks above under point C.

Section 10 (4) (a) [and \(5\)](#), IE-TMA

[Section 10 \(4\), IE-TMA:](#)

A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or

b) by virtue of an earlier right, other than those referred to in subsections (1) to (3) and paragraph (a), in particular by virtue of the law of copyright, registered designs or any other law relating to a right to a name, a right of personal portrayal or an industrial property right.

Section 10 (5), IE-TMA:

Where by virtue of any such rule of law or earlier right as is referred to in subsection (4) a person would be entitled to prevent the use of a trade mark, that person is in this Act referred to as the proprietor of an "earlier right" in relation to the trade mark.

Italy

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C. Unregistered trade marks:

Sign known as a trade mark or as a sign which is distinctive for manufactured goods or services which have been put on the market or rendered by others (= notorious prior used mark).

Article 12 (1)(~~b~~a), IT-IP CODE

Right to prohibit use of a subsequent trade mark, where known by the relevant public throughout Italy or in a substantial part of it.

Scope of protection: Identical or similar signs and identical or similar goods or services and likelihood of confusion including likelihood of association.

Article 12 (1)(a), IT-IP CODE:

Art. 12 Novelty

1. Should one of the followings apply at the date of application, the relevant signs shall not be registered as trade mark:

a) if they are identical with or similar to a sign already known as trade mark or distinctive sign of products or services manufactured, marketed or provided by a third party for identical or similar products or services, if due to the identity or similarity of the signs and the identity or affinity of products or services there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the two signs. A trade mark that pursuant to Article 6^{bis} of the Paris Convention for the protection of Industrial Property, as revised at Stockholm on July 14, 1967, and ratified by law No. 424 of April 28, 1976, is notoriously known to the concerned public, also due to the reputation acquired in the Country through the promotion of the trade mark, shall also be considered as known. Earlier use of the mark that does not establish reputation, or that establishes a merely local reputation, will not rule out novelty, but the earlier user shall have the right to keep using the trade mark, also for advertising purposes, limited to local diffusion, despite of the registration of the trade mark itself. Prior use of the mark by the applicant or his assignor shall not bar the registration.

D. Other signs used in the course of trade:

Company name, corporate name, trade name or business signs, domain name adopted by others ('ditta', 'denominazione sociale', 'ragione sociale', 'insegna', 'nome a dominio')

Article 12 (1) (~~e~~b), IT-IP CODE

Right to prohibit use of subsequent trade mark, where known by the relevant public throughout Italy or in a substantial part of it.

Scope of protection: Identical or similar signs and identical or similar goods.

Article 12 (1) (b), IT-IP CODE:

Art. 12 Novelty

1. Should one of the followings apply at the date of application, the relevant signs shall not be registered as trade mark :

b) if they are identical with or similar to a sign already known as business name, corporate or trade name, signboard and domain name used in the course of trade, or other distinctive sign used by a third party, if due to the identity or similarity of the signs and the identity or affinity of the business activity run by the third party and the products and services covered by the trade mark registration there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the two signs. Earlier use of the mark that does not establish reputation, or that establishes a merely local reputation, will not rule out novelty. Earlier use of the mark by the applicant or his assignor shall not bar the registration.

Lithuania

The information on Lithuania provided in the Annex is correct in general, however, Section D is a bit unclear. We would paraphrase it in the following way:

D. Other signs used in the course of trade:

Trade names/other business identifier

Business names, Article 7 (1) No 4, LT-TML

~~Scope of protection (general rule) — identical with or similar to the earlier mark (signs) and because of the identity or similarity of the goods and/or services covered by the marks there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier mark~~ Registration of a mark shall be declared invalid if the mark is identical with the business name of a legal person or shows a misleading likelihood to the business name of a legal person whose proprietor is another person who acquired the right to that name in the Republic of Lithuania prior to the date of application for registration of the mark or the date of the priority, if on the day specified in the date the legal person had a right to engage in identical or similar trade to which the goods and/or services covered by the registered mark may be attributed.

Article 7 LT-TML

Poland

C. Unregistered trade marks:

~~Unregistered trade marks, when well-known and used in the course of trade.~~

Unregistered trade marks that are well known in Poland are protected. The owner of a well known trade mark may request the invalidation of the registration in Poland of an identical or similar trade mark in the name of another party for goods or services identical or similar to those for which the well known trade mark is used.

Article 132. of the Law on Industrial Property:

132.1. A right of protection shall not be granted for a trade mark in respect of identical or similar goods, if the trade mark is identical or similar to:

[...]

(ii) a trade mark which, before the date according to which priority to obtain a right of protection is determined, has been well-known and used as a trade mark in respect of the goods of another party,

Additional protection is available to unregistered well known marks with a reputation (renowned trade mark). The owner of such a trade mark may request the invalidation of the registration of a later identical or similar trade mark, irrespective of the goods or services for which the trade mark is registered, if the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark. A trade mark owner is prohibited from bringing such an action if the owner has tolerated for five consecutive years the use of the later trade mark while being aware of such use.

Article 132 of the Law on Industrial Property:

132.2. A right of protection for a trade mark shall not be granted, if the trade mark:

[...]

(iii) is identical with or similar to a renowned trade mark registered or applied for registration with an earlier priority (provided that the latter is subsequently registered) on behalf of another party for any kind of goods, if it without due cause would bring unfair advantage to the applicant or be detrimental to the distinctive character or the repute of the earlier trade mark. The above provision shall apply to well-known marks accordingly.

D. Other signs used in the course of trade:

- Company names
Article 131 (1) and (5) of the Law on Industrial Property

Article 131 (1) of the Law on Industrial Property:

131.1 Rights of protection shall not be granted for signs:

(i) whose use infringes third parties' personal or economic rights, or

(ii) that are contrary to law, public order or morality or

(iii) which, as for their nature, may mislead the public, in particular as to the nature, properties of the goods or, with regard to paragraph (3), as to the geographic origin thereof.

Article 131 (5) of the Law on Industrial Property:

131.5 The filing, as a trade mark, of a sign which is used by another person as the name under which that person's business activity is run, in particular where the name in question is an ordinary word, shall not constitute an autonomous ground for refusal to grant a right of protection, where the applicant has acted in good faith and:

(i) the name is not used as a notorious trade mark in the territory of the Republic of Poland for the goods of the same kind, or

(ii) at the date of filing of the trade mark application there were no conflicting interests due, in particular, to a different sphere of activity, the range of activity limited to a local territory, or different forms of use of the both signs.

- Geographical indications
Article 132 (1) of the Law on Industrial Property

Article 132 (1) of the Law on Industrial Property:

Article 132.1. A right of protection shall not be granted to a trade mark in respect of identical or similar goods, if the trade mark is identical or similar to:

(i) a registered geographical indication, unless the applicant is entitled to use that indication and the grant of a right of protection for the trade mark is not supposed to excessively restrain other entitled parties from using the registered geographical indication

Portugal

C. Unregistered trade marks:

In principle there is no protection for unregistered trade marks under the Portuguese Trade Mark Law except in the following cases:

- Unregistered signs which are well-known marks in Portugal
Article 241, PT- IP Code

Confers the right to prohibit the registration of a subsequent trade mark where the signs are identical or similar or a translation and the goods and/or services are identical or similar and there is a possibility of the signs being confused with one another or if there is a possibility of giving rise to an association with the owner of a well-known trade mark.

Article 241, PT- IP Code:

Article 241

WELL-KNOWN TRADE MARKS

1. Registration will also be refused for a trade mark that, as a whole or in an essential part, is a copy, imitation or interpretation of another well-known trade mark in Portugal if it is applied to identical or similar products or services and may be mistaken for the other trade mark, or if, through this application, it is possible to establish an association with the holder of the well-known trade mark.

2. The interested parties in the refusal of the registration of the trade marks as referred to in the preceding paragraph may only intervene in the respective process after they have made the application for registration of the trade mark that gives origin to and is the basis of their interest.

- Unregistered signs having a reputation in Portugal

Article 242, PT- IP Code

Confers the right to prohibit the registration of a subsequent trade mark even when the goods and services are dissimilar where the use of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier sign.

Article 242, PT- IP Code:

Article 242

TRADE MARKS WITH REPUTATION

1. Without prejudice to the preceding article, registration will also be refused if a trade mark, even when it is designed for products or services without identity or affinity, is a translation of, or is identical or similar to, an already existing trade mark that enjoys a reputation in Portugal or the European Community, if it is registered in the European Community, and whenever use of the subsequent trade mark seeks to take undue advantage of the distinctive character or prestige of the trade mark or may prejudice it.

2. The provisions of paragraph 2 of the preceding article apply to the above paragraph 1, whereby it is understood that, in this case, registration of the trade mark for the products or services that conferred the reputation must be applied for.

D. Other signs used in the course of trade:

- Trade name, company name and other registered names of legal persons

Article 239 (2)(a), Article 4(4) PT- IP Code

Confers the right to prohibit the registration or use of a subsequent trade mark where there is a likelihood of error or confusion for consumers.

Article 239 (2)(a) PT- IP Code:

Article 239

OTHER GROUNDS FOR REFUSAL

[...]

2. When cited in an opposition, the following are also grounds for refusal:

- a) Reproduction or imitation of a business or corporate name and other distinctive signs, or merely a characteristic part thereof, that do not belong to the applicant or where the applicant is not authorised to use them, if it is likely to mislead or confuse the consumer;*

Article 4(4) PT- IP Code:

Article 4

EFFECTS

[...]

4. Registrations of trade marks, logotypes, appellations of origin and geographical indications are grounds for refusal or annulment of company names that may be confused with them, if the applications for authorisation or alteration are submitted later than registration applications.

- Logotypes

A logotype is a distinctive sign capable of being graphically represented which identifies an entity providing services or trading products. Logotypes are subject to registration which lasts for a renewable period of ten years counted from the date of granting. The old registrations for establishment names and insignias were converted into logotypes under the Decree-Law 143/2008 of 25 July.

Articles 304-A, 304-N, 239(1)(b), PT-IP Code

The registered logotype confers the right to prohibit registration or use of a subsequent trade mark where there is a likelihood of error or confusion for consumers.

Articles 304-A PT-IP Code:

Article 304-A

COMPOSITION OF LOGOTYPE

1. A logotype may consist of a sign or number of signs that can be represented graphically, namely by nominative or figurative elements or a combination of both.

2. A logotype must be appropriate for distinguishing an entity that provides services or commercializes products. It can be used, for instance, in places of business, advertising, forms and correspondence.

Article 304-N PT-IP Code:

Article 304-N

RIGHTS GRANTED BY REGISTRATION

Registration of a logotype confers upon the proprietor the right to prevent third parties from using, without its consent, any other identical or similar sign that is a reproduction or imitation of its own.

Article 239 (1)(b)PT-IP Code:

Article 239 (1)(b)

OTHER GROUNDS FOR REFUSAL

1. Further grounds for refusal of registration of a trade mark are:

[...]

b) Reproduction or imitation of all or part of a logotype already registered by another person to distinguish an entity whose activity is identical or similar to the products or services for which the trademark is designed, if it is likely to mislead or confuse the consumer;

- Trade mark registrations with use priority claim

Under Portuguese law the mere use of a trade mark confers a priority right during six months for the purpose of filing a corresponding trade mark application. The date of commencement of use must be claimed in the application.

Article 227, PT- IP Code

The registration of the mark based on a claimed use priority right confers a standard trade mark right.

Article 227, PT- IP Code:

Article 227

UNREGISTERED TRADEMARKS

1. Whoever uses a unregistered trade mark for a period of no more than six months has the right of priority, during that period, to register the trade mark and can oppose to any registration applications made by other entities.

2. The veracity of the documents provided as proof of that priority shall be evaluated freely, with the exception of authentic documents.

- Geographical indications

Appellations of origin and geographical indications when registered are the common property of the residents or those established in the place, region or territory in an effective and serious manner.

Articles 305(4), 312, 239(1)(c), PT-IP Code; Lisbon Agreement for the Protection of Appellations of Origin and their International Registration

Confers the right to prevent the use by third parties, in the designation or presentation of a product, of any means that indicates or suggests that the product in question originates from a geographic region other than the true place of origin. The protection extends to dissimilar products in case of registered appellations of origin or geographic indications which have a reputation in Portugal or the European Union where the use of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier geographical indication.

Articles 305(4), 312, 239(1)(c), PT-IP Code:

Article 305

DEFINITION AND OWNERSHIP

[...]

4. Appellations of origin and geographic indications, when registered, are the common property of the residents or those established in the place, region or territory in an effective and serious manner and can be used indistinctly by those, within the respective area, who are engaged in any characteristic production branch, when authorised by the holder of the registration.

Article 312

RIGHTS GRANTED BY REGISTRATION

1. Registration of an appellation of origin or geographic indication confers upon the proprietor the right to prevent:

- a) The use by third parties, in the designation or presentation of a product, of any means that indicates or suggests that the product in question originates from a geographic region other than the true place of origin;*
- b) Use that would constitute unfair competition as defined in Article 10bis of the Paris Convention, as modified by the Stockholm Revision of 14 July 1967;*
- c) Use by persons not authorised by the registration holder.*

2. The wording that makes up a legally defined, protected and controlled appellation of origin or a geographic indication may not feature in any form in appellations, labels, advertising or any documentation on products that do not come from the respective demarcated regions.

3. The aforementioned prohibition also applies when the true origin of the products is mentioned or the wording belonging to the appellations or indications in question are accompanied by qualifiers such as 'type', 'style', 'quality' or similar expressions and also extend to the use of any expression, presentation or graphic combination that may mislead or confuse the consumer.

4. Likewise prohibited is the use of a appellation of origin or geographic indication of prestige in Portugal or the European Union for products without identity or affinity, whenever the use thereof seeks to unjustly derive benefit from the distinctive or prestigious character of the previously registered appellation of origin or geographic indication or can be prejudicial to them.

5. The provisions of the preceding paragraphs do not prohibit a seller from putting its name, address or trademark on products coming from a region or country different from that in which the same products are sold. In such a case, the seller may not, however, suppress the trademark of the producer or manufacturer.

Article 239

OTHER GROUNDS FOR REFUSAL

1. Further grounds for refusal of registration of a trademark are:

[...]

- c) Violation of other industrial property rights;*

Romania

C. Unregistered trade marks:

~~Unregistered trade marks are not recognised under Romanian law~~

~~Article 4, RO-TML~~

- It is correct that trade marks in Romania are in principle only protected by registration according to Article 4 (1) of the TM Law 84/1998 (r).

Art. 4 (1) of the TM Law 84/1998 (r):

The right to a trade mark shall be acquired and protected by registration with OSIM.

- However, according to the wording of Article 6 (4) (b) of TM Law 84/1998 (r) also unregistered trade marks may enjoy protection.

Art. 6 (4) (b) of TM Law 84/1998 (r):

b) rights arising from an unregistered trade mark or another sign used in the commercial activity were acquired prior to the date of the application for registration of the subsequent trade mark, or prior to the priority date claimed by the application for the registration of the subsequent trade mark, and if that unregistered trade mark or used sign confer to its owner the right to prohibit the use of the subsequent trade mark.

In our view, this provision contradicts the remaining provisions of the Romanian trade mark law. We believe that a systematic interpretation of the Romanian trade mark law will show that unregistered trade marks are not protected under the Romanian trade mark system.

- There is another controversial provision in the Romanian trade mark law referring to unregistered trade marks, namely Art. 3 (d) of TM Law 84/1998 (r).

Art. 3 (d) of TM Law 84/1998 (r):

Well-known trade mark - a trade mark that is widely known to the segment of the public concerned by the goods or services to which it applies, without being required either registration or use thereof in Romania for the trademark to be opposed.

The only compulsory requirement of this article seems to be that the sign is well-known to the Romanian public for determined goods/services, even without registration or use in Romania. To our opinion, this provision is far more permissive than all other legal provisions concerning the well-known trade mark, including those of the Paris Convention. Trade marks in the sense of Art. 3 (d) of TM Law 84/1998 (r) might therefore fall under the scope of Article 8 (4) CTMR.

For proving notoriety in Romania, evidence in respect of the duration and purpose of publicity and the degree of recognition by the targeted consumer must be submitted.

- D. Other signs used in the course of trade:

Trade names and company names (the difference between the two not being provided for in any legal text but rather in the relevant doctrine).

Article 6 (4) (b) and (c) of TM Law 84/1998 (r)

There may be other signs in the sense of Article 8 (4) CTMR which fulfill all the conditions set forth by the Romanian legislation, but so far only trade names and company names been confirmed to constitute such other signs by the Romanian jurisprudence.

Art. 6 (4) (b) and (c) of TM Law 84/1998 (r):

Registration of a trade mark shall also be refused or, if registered, shall be susceptible of being cancelled if:

[...]

b) rights arising from an unregistered trade mark or another sign used in the commercial activity were acquired prior to the date of the application for registration of the subsequent trade mark, or prior to the priority date claimed by the application for the registration of the subsequent trade mark, and if that unregistered trade mark or used sign confer to its owner the right to prohibit the use of the subsequent trade mark.

c) there is an earlier right, other than those covered by paragraph (2) letter (d), in particular, a right to name, to image, a copyright, an industrial property right;

Slovak Republic

C. Unregistered trade marks:

The term 'unregistered trade mark' does not exist in the laws of the Slovak Republic and such trade marks are not recognised.

D. Other signs used in the course of trade:

a) Unregistered signs which have become characteristic through use in the territory of the Slovak Republic or in relation to the territory of the Slovak Republic prior to the filing of a contested application/ trade mark and which are more than of mere local significance are addressed in Article 7 (f) Act on Trade Marks, no. 506/2009 Coll (further only as 'SK-TML').

- such signs can present a reason for filing of an opposition and or invalidation action under SK-TML
- the definition of unregistered sign under SK-TML is applicable only to the opposition and/or invalidation proceeding under SK-TML
- unregistered signs which were acquired through use and prior to the application for registration of the later trade mark provide also the right to prohibit the use of a subsequent trade mark on the basis of unfair competition laws on condition that the respective conditions of unfair competition are fulfilled.

b) Company name

- acquisition through registration in the Commercial Register
- right to prohibit the use of a subsequent trade mark if the signs are identical or similar and cover identical or similar goods and services on the basis of unfair competition laws and provisions on protection of a company name.

Article 7 (f) SK-TML:

Section 7

The sign shall not be registered upon oppositions against registration of a sign (hereinafter referred to as 'oppositions') filed pursuant to Section 30

[...]

f) by the user of a non-registered sign or of other sign used in the course of trade, if because of its identity with, or similarity to, a non-registered sign used in the course of trade in the territory of the Slovak Republic, which acquired prior to the date of application for registration by its using in the territory of the Slovak Republic or in relation to the territory of the Slovak Republic distinctive capability for identical or similar goods or services of the user and such sign is of more than mere local significance;

Slovenia

C. Unregistered trade marks:

Unregistered sign, which is in the Republic of Slovenia a well-known mark within the meaning of Article 6^{bis} of the Paris Convention or Article 16 (3) of the TRIPS Agreement.

The relevant article for the rights conferred to non-registered signs is section d of Article 44 of the Slovenian Industrial Property Act.

Article 44 (d) SL-TML:

A sign shall not be eligible for registration as a mark if:

[...]

d) it is identical with or similar to a mark or unregistered sign, which is in the Republic of Slovenia a well-known mark within the meaning of Article 6^{bis} of the Paris Convention or Article 16(3) of the TRIPS Agreement

This can be used as the basis for an opposition procedure before the Slovenian national trade mark office (SIPO).

D. Other signs used in the course of trade:

~~No~~

According to Article 44 section f a younger mark may be also attacked on the basis of other earlier rights.

Article 44 (f) SL-TML:

A sign shall not be eligible for registration as a mark if:

[...]

(f) its use would contradict an earlier right to a name, personal portrayal, plant variety, geographical indication or other industrial property right, or an earlier copyright, unless the owner of the earlier right gives his express consent to the registration of such sign.

Therefore a mark can also be refused or attacked on the grounds of an earlier right to a name, personal portrayal, plant variety, geographical indication or other industrial property right, or an earlier copyright.

Spain

C. Unregistered trade marks:

- Unregistered trade marks are not recognized under Spanish trade mark law.

D. Other signs used in the course of trade:

- Business names, provided that they have been registered or applied for at the Spanish Patent and Trade Mark Office.

Article 7 (2) (a) and (b), 8 (1) and (2) ES – TML

Article 7 (1) (a) and (b), (2) (a) and (b), ES – TML:

1) Signs may not be registered as trademarks if they are:

a) identical to a previous trade name which designates activities identical to the goods or services for which the trade mark is sought;

b) identical or similar to a prior trade name and, since the activities which they designate are identical or similar to the goods or services for which the trademark is sought, there is a risk of confusion among the public; the risk of confusion includes the risk of association with the prior trade name.

2) For the purposes of this Article, prior trade names means:

a) trade names registered in Spain, the application for registration of which has a filing or priority date prior to that of the application under examination.

b) applications for the trade names to which the previous subparagraph refers, provided that they are finally registered.

Article 8 (1) and (2), ES – TML:

1) A sign which is identical with or similar to a prior trade mark or trade name may not be registered as a trade mark, even though its registration is requested for goods or services not similar to those protected by said prior signs, where, since the latter are known or famous in Spain, the use of such a trade mark might indicate a connection between the goods or services covered by it and the owner of said prior signs or, in general, where that use, made without just cause, might constitute improper exploitation of, or detract from, the distinctive character, notoriety or fame of said prior signs.

2) For the purposes of this Law, “known trade mark or trade name” means one which, owing to its sales volume, the duration, intensity or geographical scope of its use, its value or prestige achieved in the market or for any other reason, is generally known in the

relevant public sector for which the goods, services or activities distinguishing said trade mark or trade name are intended. Where all the requirements provided for in Article 1 are satisfied, the protection granted in paragraph (1) shall cover goods, services or activities as much more different in nature as the extent of knowledge of the known trade mark or trade name is greater in the relevant sector of the public or in other related sectors.

- Business names, designations or corporate names of legal persons not registered at the Spanish Patent and Trade Mark Office, provided that such sign identifies a person (enterprise) for the purposes of trade, and that evidence is provided of use or such that a sign is well-known in the national territory.
Article 9 (1) (d), ES – TML

Article 9 (1) (d), ES – TML:

1) Without due authorization, the following may not be registered as trade marks:

[...]

d) the trade name, name or business name of a legal person who, prior to the filing or priority date of the trade mark applied for, identifies in economic transactions a person other than the applicant if, since it is identical or similar to such signs and its sphere of application is identical or similar, there is a risk of confusion among the public. For these purposes, the owner of those signs shall prove the use or knowledge of said signs throughout the national territory. Should they satisfy these requirements, the foreigners who, in accordance with Article 3 of this Law may invoke Article 8 of the Paris Convention or the principle of reciprocity, shall enjoy equal protection, provided that they supply proof of the use or knowledge in Spain of their unregistered trade name.

- Unregistered business names which are well-known within the ensemble of the Spanish territory, Article 9.1.d) ES – TML in combination with Articles 3.3, 87.3 ES – TML and Article 6^{bis} 1 of the Paris Convention.

Note:

This is a more controversial situation relating to the possibility of filing an opposition on the grounds of an unregistered business name, well-known within the ensemble of the Spanish territory (Article 9.1 d) ES-TML). Article 6 bis 1 of the Paris Convention obliges Member States to prohibit the use of unregistered well-known trade marks by third parties. Article 87.3 ES-TML makes applicable to trade names rules established for trade marks and Article 3.3 ES-TML grants the possibility of relying on the Paris Convention rules when more favourable than those of Spanish Law.

Article 3, ES – TML:

1) Natural or legal persons of Spanish nationality and foreign natural or legal persons whose habitual residence is, or who have a real and effective industrial or commercial establishment on Spanish territory, or who enjoy the benefits of the Paris Convention for the Protection of Industrial Property of March 20, 1883, in accordance with the provisions of the Act of this Convention in force in Spain, hereinafter referred to as 'the Paris Convention', may obtain the registration of trademarks or trade names, as may nationals of the Members of the World Trade Organization.

2) The registration of trade marks or trade names may also be obtained, in accordance with the provisions of this Law, by foreign natural or legal persons not covered by the

previous paragraph, provided that the legislation of the State of which they are nationals allows natural or legal persons of Spanish nationality to register such signs.

3) The persons mentioned in paragraph (1) may invoke, for their own benefit, the provisions of the Paris Convention and those of any other international treaty ratified by Spain, in so far as they are applied directly and are more favorable to such persons than the provisions of this Law.

Article 87 ES – TML:

1) A trade name is any sign capable of being represented graphically which identifies an enterprise in the trading process and which is used to distinguish it from the other enterprises carrying out identical or similar activities.

(2) In particular, the following may constitute trade names:

- a) patronymic names, business names and the names of legal persons;*
- b) imaginary names;*
- c) names alluding to the subject matter of corporate activity;*
- d) anagrams and logotypes;*
- e) images, figures and drawings;*
- f) any combination of the signs mentioned non-limitatively in the preceding subparagraphs.*

3) Unless otherwise specified in this Chapter, the provisions contained in this Law relating to trade marks shall apply to trade names in so far as they are not incompatible with the nature thereof.

Right to prohibit use of subsequent trade mark.

Scope of protection: Identical or similar signs and identical or similar goods or services and likelihood of confusion.

Sweden

The Swedish Trade Mark Act was revised in 2010, with the revised Act in force since 1 July 2011. It appears that the paragraphs in the current version of the Manual refer to the old Act no longer in force. We have updated the references relevant for Part C and D, but would recommend to revise the full section and other parts of the Manual referring to the Swedish Trade Mark Act.

Translations below are available at WIPO's website on:

http://www.wipo.int/wipolex/en/text.jsp?file_id=236794#LinkTarget_1131.

C. Unregistered trade marks:

Unregistered trade marks established on the market Chapter 1, § 2-(1) 7, SE-TMA

Acquisition: Use leading to the unregistered mark becoming established on the market.

Chapter 1, § 7, SE-TMA

Chapter 1, § 7, SE-TMA:

A trade mark shall be deemed incorporated in this country in a significant portion of the circuit to which it is addressed (the public) is known as a term for the goods or services supplied under the sign. If the trade mark is incorporated only in a part of the country, the exclusive right only in that area.

Scope of protection: Identical to that of a Swedish registered trade mark, i.e. against acts corresponding to those contained in Article 9(1)(a), (b), and (c) CTMR, but can be limited to such part of the country where it is established as per the above.

Chapter 1, §§ ~~1,2(3), 6, 14(6)~~ 10 (1 – 3), SE-TMA

Chapter 1, §§ 10 (1 – 3), SE-TMA:

The exclusive right to a trade mark under § § 6-8 means that no one other than the holder, without his permission, the business may use a character that is

1. identical with the trade mark for goods or services of the same kind

2. identical or similar to the trade mark for goods or services of the same or similar kind, if there is a likelihood of confusion includes the likelihood of use of the sign leads to the perception that there is a relationship between the user of the sign and the owner of the trade mark or

3. identical or similar to a trade mark which this country is known in a substantial proportion of the relevant class of persons, which relates to goods or services, and takes unfair advantage of, or without due cause is detrimental to the signs distinctive character or repute.

D. Other signs used in the course of trade:

- Trade Company names

~~§§ 1, 2(2), 3(2), 14(6)~~ Chapter 1, §§ 8, 10 (1 – 3), SE-TMA

Acquisition: Registration as company name or use leading to the trade name becoming established on the market. Can be limited to such part of the country for which it is established.

Chapter 1 § 8, SE-TMA:

The holder of a business name or other trade names have exclusive rights to sign as trade marks. If the business establishment name is protected only in a part of the country, the exclusive right is only in that area.

He who uses his name as trade marks has exclusive rights to sign as a trade mark, the name is distinctive for the goods or services it is used. If the name is used only in a part of the country, the exclusive right is only in that area.

Chapter 1 § 10 (1 – 3), SE-TMA:

The exclusive right to a trade mark under §§ 6-8 means that no one other than the holder, without his permission, the business may use a character that is

- 1. identical with the trade mark for goods or services of the same kind,*
- 2. identical or similar to the trade mark for goods or services of the same or similar kind, if there is a likelihood of confusion includes the likelihood of use of the sign leads to the perception that there is a relationship between the user of the sign and the owner of the trade mark or*
- 3. identical or similar to a trade mark which this country is known in a substantial proportion of the relevant class of persons, which relates to goods or services, and takes unfair advantage of, or without due cause is detrimental to the signs distinctive character or repute.*

Right to prohibit use of a subsequent trade mark, if signs can be confused and cover identical or similar goods and services

- ~~Distinctive titles of protected literary or artistic work~~

~~§ 14 (5), SE-TMA~~

~~Right to prohibit use of a subsequent TM if it contains an element which is likely to convey the impression of being the distinctive title of another person's protected literary or artistic work.~~

~~[Removed, new act in force since 1 July 2011]~~

- Name of trader

~~Chapter 1, §§ 8, 10 (1 – 3) §§ 1, 6, 14 (6), SE-TMA~~

~~Right to prohibit subsequent trade mark if signs can be confused for identical or similar goods or services. Can be limited to such part of the country where it is used.~~

~~Chapter 1 § 8, SE-TMA:~~

~~*The holder of a business name or other trade names have exclusive rights to signs as trade marks. If the business establishment name is protected only in a part of the country, the exclusive right is only in that area.*~~

~~*He who uses his name as trade mark has exclusive rights to signs as a trademark, the name is distinctive for the goods or services it is used. If the name is used only in a part of the country, the exclusive right is only in that area.*~~

~~Chapter 1 § 10 (1 – 3), SE-TMA:~~

~~*The exclusive right to a trade mark under §§ 6-8 means that no one other than the holder, without his permission, the business may use a character that is*~~

- ~~*1. identical with the trade mark for goods or services of the same kind,*~~

2. identical or similar to the trade mark for goods or services of the same or similar kind, if there is a likelihood of confusion includes the likelihood of use of the sign leads to the perception that there is a relationship between the user of the sign and the owner of the trade mark or

3. identical or similar to a trade mark which this country is known in a substantial proportion of the relevant class of persons, which relates to goods or services, and takes unfair advantage of, or without due cause is detrimental to the signs distinctive character or repute.

United Kingdom

~~C. Unregistered trade marks:~~

~~Unregistered TM used in the course of trade~~

~~Unregistered TM used in the course of trade, if protected by any rule of law, including that of passing off.~~

~~Section 5 (4)(a), UK-TMA~~

~~D. Other signs used in the course of trade:~~

~~Sign used in the course of trade~~

Unregistered marks are protected by the common law action of 'passing off'. Passing off also protects other signs used in the course of trade, including but not limited to trade names, company names, and product packaging ('get-up').

The cause of action is derived from case law and is heavily reliant on evidence and an assessment of all the facts and surrounding circumstances of the case.

There are three conditions which must all be satisfied for a passing off claim to be successful.

1. The mark must have been used such that there is a reputation and goodwill in the mark amongst UK consumers. The reputation does not need to be throughout UK (a local reputation within the UK is sufficient) nor are there any fixed levels of consumer awareness that must be met.
2. The defendant's conduct must constitute a misrepresentation to consumers. Most commonly, the misrepresentation will be based on resemblance between the defendant's sign and the claimant's mark, such that the defendant's goods or services appear to originate from or somehow be connected to the claimant. Consumers must actually be deceived or be likely to be deceived. A mere likelihood of confusion is not sufficient.
3. The defendant's conduct must cause, or be likely to cause, damage to the claimant's goodwill. This is typically via lost sales, or by diluting the goodwill in the mark, or by tarnishing the claimant's reputation.

If these three conditions are satisfied, the claimant is entitled to prohibit the use of the later mark and to claim financial relief for any damage suffered.

Passing off can also form the basis for preventing the registration of a later mark in the UK under s5(4)(a) Trade Marks Act 1994.

Section 5(4)(a) Trade Marks Act 1994:

1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

[...]

4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

[...]

Section 6 (1) and (2) Trade Marks Act 1994:

1) In this Act an “earlier trade mark” means

a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which

*(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and
(ii) accordingly has the same claim to seniority, or*

c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

D. Provisions relating to countries for which no amendments are necessary

For some countries the information contained under section C. and D. of the Annex to the Manual is correct and up to date, but an English translation of the relevant national legislation was missing. This translation – marked in italics – is provided below.

Finland

Section 1:

Registration shall confer exclusive rights in a trade mark as a special symbol for distinguishing goods to be offered for sale, or otherwise purveyed in business, from those of others. Any kind of mark that can be represented graphically and by means of which goods marketed in business can be distinguished from those of others may be a trade mark. A trade mark may in particular consist of words, including personal names, figures, letters, numerals or the shape of goods or of their packaging. The provisions of this Act concerning goods shall apply by analogy to services.

Section 2:

Exclusive rights in a trade mark may be acquired, even without registration, after the mark has become established. Exclusive rights in symbols other than the special business symbols defined in the second paragraph of Section 1 may also be acquired through their becoming established. A trade symbol shall be considered established if it has become generally known in the appropriate business or consumer circles in Finland as a symbol specific to its proprietor's goods.

Section 3:

Any person may use his surname, address or trade name in his business as a trade symbol for his goods unless that use is liable to cause confusion with another's protected trade mark, or with a name, address or trade name already being lawfully used by another in his business. The foregoing provision on trade names applies also to the auxiliary trade name and secondary symbol referred to in the Trade Names Act. The name or trade name of another may not be included in a trade mark; neither may the auxiliary trade name or secondary symbol of another be included in a trade mark except where they lack distinguishing power or where the branches of trade or kinds of goods concerned are different.

Section 6:

Trade symbols shall be regarded under this Act as liable to cause confusion only if they apply to goods of identical or similar type. Notwithstanding the foregoing, the confusability of trade symbols may be judged in favor of a symbol that has a reputation in Finland where the use of another's trade symbol without due cause would constitute unfair exploitation of, or action detrimental to, the distinctive character or fame of the earlier trade symbol.

Section 14:

A trade mark shall not be registered:

1) if it is contrary to law and order, or to morality;

[...]

5) if it is composed of or contains anything likely to give the impression of being the title of another's protected literary or artistic work, such title being original in character, or if it constitutes an infringement of another's copyright in such a work or of his rights in a photographic illustration or a protected design;

6) if it is liable to be confused with the name or protected trade name of another trader, with an auxiliary trade name or secondary symbol of the kind referred to in the third paragraph of Section 3, with the trade mark of another which has been registered on the basis of an earlier application or with the trade symbol of another party that is already established when registration is sought;

Hungary

Article 5 (2) a):

A designation shall not be granted trade mark protection

(a) if it has been used by someone else genuinely inland without registration where the use of the designation without the consent of the prior user would be contrary to law;

Article 5 (1) a)-b):

A designation shall not be granted trade mark protection

(a) if it would infringe earlier personal rights of others, in particular a right in a name or of personal portrayal;

(b) if it would conflict with an earlier copyright or industrial property right of others, including conflict with the name of a protected plant variety

Latvia

Article 9 (3) No 4, LV-TML:

Section 9. Other Earlier Rights as Grounds for Invalidation of Trade Mark Registration

(3) A trade mark registration may be also declared invalid on the basis that another person has, prior to the trade mark filing date (also taking into account its priority date), acquired in Latvia other rights which allow the prohibition of the use of the trade mark; registration may be contested also on the basis of the following rights:

[...]

4) other industrial property rights including rights related to an unregistered trade mark or other mark used for distinguishing the goods or services, and the domain name if the unregistered trade mark, other mark referred to or domain name has been used honestly prior to the date of filing of an application for the registration of the trade mark (or the priority date respectively), in commercial activities in Latvia in connection with identical or similar goods or services for so long and in such amount that the use of the registered trade mark may confuse consumers about the origin of the respective goods or services.

Article 9 (3) no 3, LV-TML:

Section 9. Other Earlier Rights as Grounds for Invalidation of Trade Mark Registration

(3) A trade mark registration may be also declared invalid on the basis that another person has, prior to the trade mark filing date (also taking into account its priority date), acquired in Latvia

other rights which allow the prohibition of the use of the trade mark; registration may be contested also on the basis of the following rights:

[...]

3) commercial rights, that is, rights related to a trade name (commercial designation, name of a mass medium, or other similar sign) that is used in an identical or similar business sector, if its fair and lawful use in commercial activities in Latvia was commenced before the date of filing of an application of the trade mark, or the priority date respectively, or a trade name (commercial designation, name of a mass medium or other similar sign) of Latvia or of a foreign state that was well known in Latvia.

Malta

Article 6(2):

A trade mark shall not be registered if because it is either identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trademark is protected, there exists a likelihood of confusion on the part of the public, including the likelihood of association by the public with the earlier trade mark:

Provided that the mere association without the likelihood of confusion shall not prevent a mark from being registered.

Article 6(4)(a):

A trade mark shall not be registered if, or to the extent that, its use in Malta is liable to be prevented

(a) by virtue of any rule of law protecting an unregistered trade mark or other sign used in the course of trade, or

[...]

A person thus entitled to prevent the use of a trademark is referred to in this Act as 'the proprietor of an earlier right' in relation to the trademark.

November 2012

*Carolin Kind
Chair of the Harmonization Committee*