

BREAKING THE BARRIER MADRID PROTOCOL IN MOTION



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1. INTRODUCTION



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THANK YOU!!



BREAKING BARRIERS?

- Paris Convention (1883)
- Nice Agreement
- Madrid Agreement (1891/1892)
- Vienna Agreement
- TLT
- Trips (1994)
- Madrid Protocol (1989/1996) [88/192 Countries]
- Regional Systems: CTM, Benelux, Aripo, Andean Community
- Global TM?

WHAT DO YOU MEAN BY INTERNATIONAL MARK?

One mark covering several jurisdictions?

A single TM registration or a bundle of national registrations?



THE AGREEMENT AND THE PROTOCOL BACKGROUND

Madrid system [two treaties]. Agreement [1892] and Protocol [1996]

Agreement

- Lack of international acceptance [UK, US, JP, Latin American and Asian countries]

- Central attack [5-year period of dependence]. Mitigated by [expensive] transformation of IR into national applications

PROTOCOL OVERVIEW

- Where to file? Through the Office of origin.
- Designations. One or more Contracting Parties. No self-designation.
- Effects. Protection in each designated Contracting Party = as if the mark had been filed with the Office of the Contracting Party.
- Refusal. Each office can refuse protection within a time limit of 12 months, optionally 18 months or longer if refusal based on an opposition.
- Central attack: IR depends on basic application/registration [5 years]. If refused/withdrawn ceases to have effect [following administrative/court decision, voluntary cancellation, non-renewal], IR will be cancelled.
- Transformation of IR in a bundle of applications in designated countries [opting-back]
- Duration. 10 years subject to renewal.

AGREEMENT vs PROTOCOL

- IR can be based on application.
- Contracting Party may elect a period of 18 months or longer in case of oppositions.
- Offices of Contracting Parties get higher fees.
- Transformation of cancelled IRs within the 5 year term.
- 88 Contracting Parties [end of 2012] / about 200

PROS

- Owner of basic application/registration may extend protection to one or more jurisdictions [designations]
- One application in one jurisdiction, one set of fees, central recordal [changes, transfers, limitation] and renewals through a single administrative process. Financial savings.
- One: sign, specification, language [EN, ES, FR], currency, registration date, term of protection [10 years], renewal, database [Romarin/Madrid Express]
- No administration costs: translation of specification, local representative fees, less delays

- Easy to manage TM portfolio
- Automatic protection if designated country does not notify refusal within time limit
- Open to intergovernmental organizations: OHIM
- Protection may be extended by subsequent designations
- Offices of designating Contracting Parties do not need to examine formalities/classification or republish the mark and collect part of the fees

WHAT IS NOT INTERNATIONAL?

[Bundle of TM registrations in separate jurisdictions: lack of unitary character]

DIFERENT:

- procedural / substantive laws
- absolute/relative grounds for refusal/invalidity
- rights conferred
- limitation of effects
- criteria for exhaustion of rights
- effects vis-à-vis third parties
- use requirements
- jurisdiction for enforcement proceedings [administrative/judicial]

STEP 1: INTERNATIONAL APPLICATION

- Office of origin: will certify rule of triple identity is met, check priority claim, and transmit the international application to WIPO

- Fees payable to IB

 - Basic fee (b/w) – 653 Swiss Francs

 - Supplementary fee for each class beyond three – 100 Swiss Francs

 - Complementary designation fee – 100 Swiss Francs

 - Individual fee: fixed by each Contracting Party

STEP 2: INTERNATIONAL REGISTRATION

WIPO checks filing requirements, classification and payment of fees

Registration date: date when application is received by the Office of origin

WIPO will notify designated Contracting Parties

STEP 3: IR PROCESSED BY DESIGNATED CONTRACTING PARTIES

Effects of IR in designated countries: same as if the mark filed directly with the local Office of the designated Contracting Party.

- Refusal/invalidity/cancellation on absolute/relative grounds governed by national/regional law
- Time limit for partial/total refusal: 12/18 months [can be expanded if opposition]
- Actions to be taken in case of refusal: appointment of representative [if required] and reply/appeal
- Rights conferred/jurisdiction subject by law of designated Contracting Party

Top applicants

Novartis

Richter Gedeon

Boehringer Ingelheim

Bosch / Siemens

L'Oréal

Philip Morris

Glaxo

Philips

Nestlé

Egis Gyógyszergyár

IRs by Office of origin

	Office of origin	2008	2009	2010	2011	2012
EM	European Union	3692	3517	4356	5553	6256
US	United States of America	3864	3225	3897	4652	5073
DE	Germany	6120	5391	4548	4943	4553
FR	France	4026	3565	3734	3785	3639
CH	Switzerland	2815	2448	3093	2928	2720
IT	Italy	2602	2231	2327	2333	2332
JP	Japan	1275	1335	1422	1582	1898
CN	China	1574	1346	1820	2053	1799
BX	Benelux	2582	2057	1915	1902	1774
RU	Russian Federation	1063	1097	1160	1328	1659
	Total	29613	26212	28272	31059	31703

Designations in IRs

	Designated contracting party	2008	2009	2010	2011	2012
CN	China	15888	13267	14237	16584	17584
EM	European Union	13698	11844	13701	15375	15924
US	United States of America	14457	12186	13024	14432	15000
RU	Russian Federation	14875	12762	12768	14160	14829
CH	Switzerland	14080	12451	11759	12779	12510
JP	Japan	11552	9308	9941	11038	11067
AU	Australia	9377	7662	8207	9289	9452
KR	Republic of Korea	8228	6691	7103	8411	8476
TR	Turkey	8439	6855	6877	7841	8192
UA	Ukraine	9222	7506	7212	7798	8113
	Total	119816	100532	104829	117707	

Top Classes

Classes	2008	2009	2010	2011	2012
9	9305	7935	7804	9286	9598
35	7683	6798	6454	7596	7912
42	6092	5337	4823	5505	5966
25	5308	4482	4959	5411	5617
5	4868	4553	4673	4663	4936
41	4882	4469	4047	4687	4804
3	3979	3405	3578	3875	3965
16	4652	3925	3515	3969	3751
7	3294	2857	2707	3129	3287
30	3191	2991	2968	3031	3087
Total	53254	46752	45528	51152	52923

A PRACTICAL CASE



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R2219/2012-5 ECOLABEL- 08/07/2013

Scope of protection of IR's designating the EU.
Interpretation after IP translator

Art. 2 PC. National Treatment for Nationals of Countries of the Union. (1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; ...


Art. 3 PC. Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union. Nationals of countries outside the Union who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the countries of the Union shall be treated in the same manner as nationals of the countries of the Union.

Communication 4/03 of the President 16/06/2002, the use of a particular general indication found in the class heading will embrace all of the individual goods or services falling under that general indication

Communication 2/12 of the President 20/06/2012. As regards CTMs registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, the Office considers that the intention of the applicant, ..., was to cover all the goods or services included in the alphabetical list of that class

***Judgment of the CJ of 19/06/2012 in Case C-307/10
IP TRANSLATOR***

An applicant... who uses all the general indications of a particular class headingmust specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services.

Earlier Marks (IRs designating the EU)	Contested CTM
<p data-bbox="542 554 691 589">ECOLAB</p> 	<p data-bbox="1277 605 1431 641">ecolabel</p>
<p data-bbox="262 786 973 876">Classes 1, 3, 4, 5 and 11: class headings.</p> <p data-bbox="262 939 973 1025">Other classes: 8, 9, 21, 35, 37, 41 and 42</p>	<p data-bbox="1000 786 1711 825">Classes 35, 41 and 44: class headings.</p> <p data-bbox="1000 888 1715 978">Class 42: Design and development of computer hardware and software.</p> <p data-bbox="1000 1041 1696 1079">Class 43: Temporary accommodation.</p>

Findings of the Cancellation Division

As concerns the contested trademark, the Cancellation Division will compare the goods and services of the earlier mark to the indicated class headings as well as to those elements in the corresponding alphabetical lists which do not fall within the natural and usual meaning of said class headings. ...

As concerns the earlier International trademark registration, when the earlier mark is registered for a class heading, the Cancellation Division will interpret it literally, unless the corresponding Register – where the international mark is recorded – indicates something different. In the present case, since the corresponding Register does not indicate anything different, then the class headings in the earlier international trademark will be interpreted literally.

Findings of the BoA

On the violation of the general principle of equal treatment.

.... both the contested Community trademark and the two earlier marks, were applied for and registered prior to 19 June 2012

...the contested decision applied an *extensive* interpretation in relation to the contested Community trademark and, without any legal basis, ..., applied a *restrictive* interpretation.

The contested mark seeks protection for all of the class headings in classes 35, 41 and 44 ..., the Office considers that the applicant's intention... was to protect all of the services contained in the alphabetical lists ... in the Nice Classification....

... restrictive interpretation criteria with respect to the earlier marks, ..., the contested decision established:

“As concerns the earlier international mark, when the earlier mark is registered for all of the indications ..., the Cancellation Division will interpret them using a literal criterion ...

Concept and legally binding aspect of the principle of equal treatment

... according to reiterated case law, discrimination consists, in particular, of treating comparable situations differently.

The Madrid Protocol and the CTMR

According to ... the Protocol ... the *protection* of the trademark in each one of the Contracting Parties in question *will be the same* as if that mark had been applied for directly at the Office of that Contracting Party. ..., *the protection* of the mark ..., with effects as of said date, *the same as if that mark had been registered by the Office in that Contracting Party.*

... the international registration of a trademark designating the E.U. will produce, ..., the same effect as the Community trademark registration.

Therefore, ..., the international registration of a trademark designating the E.U. will have the same protection and produce the same effect as if it had been registered by OHIM.

The Cancellation Division should have treated the Community trademark and the international registrations designating the E.U. identically because their legal effects are identical.

The General Court pronounced on the legality of said Communication no. 2/2102, establishing that, according to OHIM practice... the use of class headings must be considered to be a claim of protection for all of the goods or services included in that class.... The General Court also determined that, ..., if the owner of a Community trademark that was registered prior to the date of the mentioned communication used the class heading of a particular class, it should be understood that his intention was to protect all of the goods or services contained in the alphabetical list of said class...

... the Cancellation Division should have applied the extensive interpretation criteria they applied to the contested Community trademark as well and in the same manner to the international registrations designating the E.U. considering that the intention of the owner of the international registrations designating the E.U. was to protect all of the goods and services contained in the alphabetical lists in classes 1, 3, 4, 5, 8, 11, 21, 35 and 42...

On the disadvantage which arises from the different treatment of comparable situations

By not applying the same extensive interpretation criteria of point V of the Communication no. 2/12, the Cancellation Division created a disadvantage to the extent that they removed the elements in the corresponding alphabetical lists from the field of protection of the list of goods and services of the applicant for invalidity...

On the absence of justification of the different treatment

...., the different treatment of the Community trademark with respect to the international registrations designating the E.U. cannot be considered to be justified.

... the Cancellation Division violated the principle of equal treatment by treating comparable situations in a different manner.

Operative part

.... The Board has decided to return the case to the first instance so it can re-examine the application for invalidity with respect to all of the goods or services

Summary of BoA findings

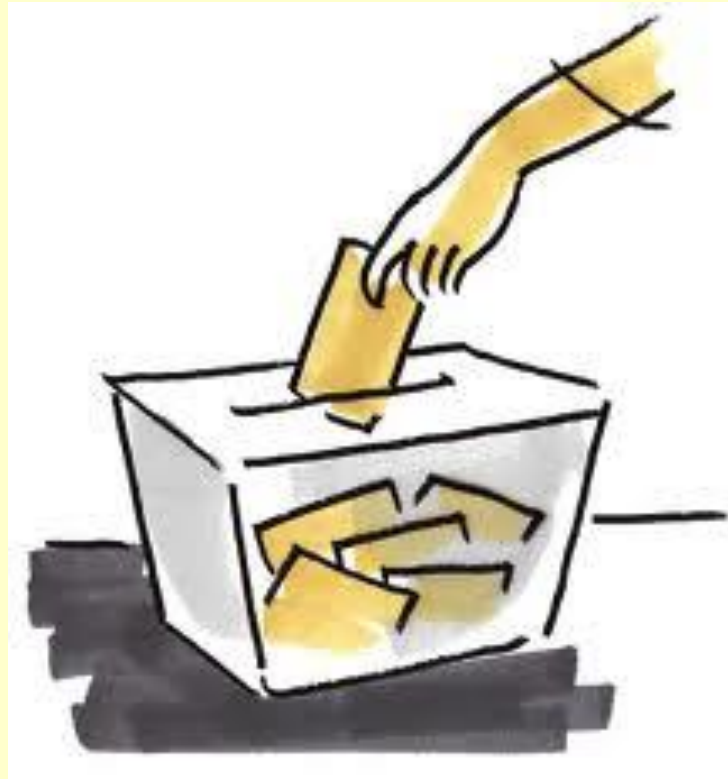
IRs designating the EU have the same effect as the registration of a CTM.

Consequently those IRs filed before 21/06/2012, registered for one or more entire class headings are to be interpreted as having the same scope of protection as CTMs filed before that date, i.e. as covering the entire alphabetical list of G&S in the respective classes in the Nice Classification edition in force at the filing date.

On the contrary, the Cancellation Division in the annulled contested decision erred in law infringing the cited provisions by interpreting literally and so restrictively the class heading of an IR. This erroneous and discriminatory interpretation was abandoned by the Office adopting the “IPT Instructions regarding IRs designating the EU”.



Place your vote!!



- *The legal effectiveness of Communication no. 4/03 of 16/06/2003*
- *Determining the scope of protection of IRs designating the E.U.*

*The National Law in the Contracting Party of origin?
The Harmonized European Law?*

- *The Triple Identity Rule: sign, goods/services and owner*
- *Determining the scope of the basic mark in the country of origin*
- *The duty to state reasons [Art. 75 CTMR]*
- *Examination of facts in inter-partes proceedings [Art. 76 CTMR]*

CONCLUSIONS



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Good Bye

Questions?

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