

***GUIDELINES FOR EXAMINATION IN THE  
OFFICE FOR HARMONIZATION IN THE  
INTERNAL MARKET (TRADE MARKS AND  
DESIGNS) ON COMMUNITY TRADE MARKS***

***PART C***

***OPPOSITION***

***SECTION 4***

***RIGHTS UNDER ARTICLE 8(4) CTMR***

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## 1 Introduction

The relationship between the Community Trade Mark system and national law is characterised by the *principle of coexistence*. This means that both the Community Trade Mark system and the national laws exist and operate side by side. The same sign can be protected by the same proprietor as a CTM and as a national trade mark in one (or all) of the Member States. The *principle of coexistence* further implies that the CTM system actively acknowledges the relevance of national rights and their scope of protection. Where conflicts arise between CTMs and national trade marks or other national rights, there is no hierarchy determining that one system prevails over the other; instead, these conflicts apply the principle of priority. If the respective requirements are met, earlier national trade marks or other earlier national rights can prevent registration of, or invalidate a later CTM.

Although the TM Directive and its subsequent implementation have harmonised the laws relating to *registered trade marks*, no such harmonisation has taken place on an EU scale with regard to *non-registered trade marks* nor for most *other earlier rights* of a similar nature. These un-harmonised rights remain completely governed by national laws.

The types of earlier rights which can be relied upon in proceedings before the Office are specified in the CTMR under:

- Article 8(4) CTMR, which restricts the scope of protection in *opposition proceedings* to earlier **non-registered trade marks and other signs used in the course of trade of more than mere local significance**;
- Article 53(2)(a)-(d) CTMR, which broadens the scope of possible earlier rights to be relied upon for *invalidity proceedings* beyond those of Article 8(4) CTMR to also cover other earlier rights, in particular the right to a name, the right of personal portrayal, a copyright and an industrial property right;
- Article 111 CTMR, which complements the range of earlier rights to be relied upon in opposition proceedings by providing that rights which are only valid in particular localities and, thus, do not meet the ‘more than mere local significance’ criterion of Article 8(4) CTMR, can oppose use of a CTM even though these local rights cannot impede its registration.

This part of the Guidelines only deals with the earlier rights falling under Article 8(4) CTMR.

## 2 Structure of Article 8(4) CTMR

Article 8(4) CTMR reads:

Upon opposition by the **proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance**, the trade mark applied for shall not be registered where and to the extent that, pursuant to the law of the Member State governing that sign:

- (a) rights to that sign were **acquired prior** to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;
- (b) that sign confers on its proprietor the **right to prohibit the use of a subsequent trade mark**.

Article 8(4) CTMR means that in addition to the earlier trade marks specified in Article 8(2) CTMR, non-registered trade marks and other signs protected at Member State level used in the course of trade as 'business identifiers' of more than mere local significance can be invoked in an opposition provided that such rights confer on their proprietors the right to prohibit the use of a subsequent trade mark.

Article 8(4) CTMR does not expressly or exhaustively enumerate the particular rights which can be invoked under this provision, but rather outlines a broad spectrum of rights that might serve as basis for an opposition against a CTM application. Therefore, Article 8(4) CTMR can be regarded as a general 'catch-all-provision' for oppositions based on non-registered trade marks and other signs used in the course of trade.

Nevertheless, the broad scope of earlier rights to be relied upon in opposition proceedings under Article 8(4) CTMR is subject to a number of restrictive conditions: these rights must confer an entitlement to the proprietor to exercise them, they must be of more than local significance, they must be protected by the national law governing them against the use of a subsequent trade mark and the rights must have been acquired prior to the CTMA under the law of the Member State governing that sign.

The 'more than mere local significance' requirement aims at restricting the number of potential opposing non-registered rights, thus avoiding the risk of a collapse or paralysis of the CTM system by being flooded with opposing, relatively insignificant rights.

The 'national protection' requirement is deemed necessary as the non-registered national rights are not easily identifiable and their protection is not harmonised on an EU level. Consequently, only national law governing the earlier signs may define the scope of their protection.

While the requirements of 'use in the course of trade' and 'use of more than mere local significance' are to be interpreted in the context of Community law (European standard), national law applies when determining whether a particular right is recognised and protected under the national law, whether its holder is entitled to prohibit the use of a subsequent trade mark, and what conditions need to be met under national law for the right to be successfully exercised.

As a consequence of this dualism, the Office must apply both the relevant provisions of the CTMR and the national law governing the earlier opposing right. In view of the two-tier examination to be applied under Article 8(4) CTMR, this provision, as the link between Community and national law, displays a somewhat 'hybrid' nature.

### 3 Conditions of Article 8(4) CTMR

The conditions for successfully invoking Article 8(4) CTMR are:

- a) the opponent must be the beneficiary of a non-registered trade mark or of another sign used in the course of trade;
- b) use of more than mere local significance;
- c) acquisition prior to the CTMA under the law of the Member State governing that sign;
- d) right to prohibit the use of a subsequent trade mark under the law of the Member State governing that sign.

#### 3.1 Direct right conferred on the opponent

The legal systems of the EU Member States provide various means of preventing the use of later marks on the basis of earlier signs used in the course of trade. However, in order to come within the meaning of Article 8(4) CTMR, the earlier right must be vested in a particular owner or a precise class of user that has a **quasi-propiertorial interest** over it, in the sense that it can exclude or prevent others from unlawfully using the sign. This is because Article 8(4) CTMR is a 'relative' ground for opposition and Article 41(1)(c) CTMR provides that oppositions may be filed only by the proprietors of earlier marks or signs referred to in Article 8(4) CMTR and by persons authorised under the relevant national law to exercise these rights. In other words, only persons having an interest directly recognised by law in initiating proceedings are entitled to file an opposition within the meaning of Article 8(4) CTMR.

For example, in some Member States, the use of a sign may be prohibited if it results in unfair or misleading business practices. In such cases, if the earlier right lacks any 'proprietary quality', it will not fall within Article 8(4) CTMR. It does not matter whether these signs are protected against misleading or unfair use under trade mark law, the law relating to unfair competition, or any other set of provisions. An example in this respect is the German Regulation governing the use of the geographical indication 'Solingen' for specific goods (cutlery scissors, knives etc.). This law would not be a proper basis for an opposition under Article 8(4) CTMR because the sign in question lacks any proprietary quality and, as such, is more public in nature.

Earlier right	Case No
A.O. CUBA	R0051/2007-4
Where the national law does not confer on a legal entity (whether public or private) a subjective right allowing it to prohibit the use of a subsequent trade mark, the "proprietary requirement" is not met. The Board found that the Spanish law giving effect to the bilateral Agreement between Spain and Cuba for the protection of the appellation of origin "Cuba" was not sufficient to grant such a subjective right (para. 23-27).	

In assessing the proprietorship of a sign used in the course of trade, the Office must analyse specifically whether the opponent has acquired rights over the sign 'in accordance with the national law' (judgment of 18/01/2012, T-304/09, 'Basmati').

## 3.2 Types of rights falling under Article 8(4) CTMR

### 3.2.1 Introduction

When assessing which kind of intellectual property rights can be invoked under Article 8(4) CTMR and which cannot, a European standard applies. The distinction follows from the scheme of the CTMR and, in particular, from the differentiation made between the kinds of earlier signs upon which an opposition may be based under Article 8(4) CTMR and the types of further rights that may be the basis for invalidity under Article 53(2) CTMR. While Article 8(4) CTMR refers to *signs* ('non-registered trade mark or ... another sign'), Article 53(2) CTMR refers to a broader set of rights: (a) a right to a name; (b) a right of personal portrayal; (c) a copyright; and (d) an industrial property right.

Therefore, although the signs covered by Article 8(4) CTMR fall within the broad category of 'industrial property rights', not all industrial property rights are 'signs' for the purposes of Article 8(4) CTMR. Since this distinction is contained in the CTMR, the classification of a right under the respective national law is not decisive, and it is immaterial whether the national law governing the respective sign or industrial property right treats both types of rights in one and the same law.

The types of rights falling under Article 8(4) CTMR are:

- 'non-registered trade marks'; and
- 'other signs used in the course of trade' which cover:
  - business identifiers such as:
    - trade names;
    - corporate names;
    - establishment names;
    - titles of publications or similar works;
    - domain names;
  - geographical indications.

Most national business identifiers falling within the category of earlier rights within the meaning of Article 8(4) CTMR will be non-registered signs. However, the fact that a sign is also registered in accordance with the requirements of the respective national law does not bar it from being invoked under Article 8(4) CTMR.

### 3.2.2 Non-registered trade marks

Non-registered use-based trade marks exist in a number of the Member States<sup>1</sup> (see the Table at the end of the document for an overview) and are signs that indicate the commercial origin of a product or service. Therefore, they are signs which function as a trade mark. The rules and conditions governing acquisition of rights under the relevant

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<sup>1</sup> Benelux, Cyprus, Croatia, Estonia, France, Lithuania, Poland, Romania, Slovenia and Spain do not protect unregistered trade marks (unless, for some jurisdictions, they are considered well-known within the meaning of Article 6bis of the Paris Convention).

national law vary from simple use to use having acquired a reputation. Neither is their scope of protection uniform, although it is generally quite similar to the scope of protection under the provisions in the CTMR concerning registered trade marks.

Article 8(4) CTMR reflects the existence of such rights in Member States and grants the proprietors of non-registered marks the possibility of preventing the registration of a CTMA where they would succeed in preventing use of that CTMA under the relevant national law, by showing that the conditions set by the national law for prohibiting use of the later CTM are satisfied and the other conditions of Article 8(4) CTMR are met.

Example: R 1529/2010-1 'Gladiator', where a non-registered trade mark in the Czech Republic was invoked and R 1446/2006-4 'RM2007', where a non-registered trade mark in Belgium was invoked and the opposition rejected as unfounded because non-registered trade marks are not protected in Belgium.

### 3.2.3 Other business identifiers

'Other signs used in the course of trade' is a broad category that is not enumerated in Article 8(4) CTMR. In order for such signs to come within the ambit of Article 8(4) CTMR, they must have an identifying function, that is, they must primarily serve to identify in trade a business (business identifiers) or a geographical origin (geographical indications). Article 8(4) CTMR does not cover other types of intellectual property rights that are not 'commercial signs' – such as patents, copyrights or design rights which do not have a primarily identifying function but which protect technical or artistic achievements or the 'appearance' of something.

Some examples of cases dealing with whether a right is a 'sign' for the purposes of Article 8(4) CTMR are set out below.

Earlier right	Case No
JOSE PADILLA (copyright)	T-255/08
The Court found that copyright cannot constitute a 'sign used in the course of trade' within the meaning of Article 8(4) CTMR. It is apparent from the scheme of Article 53 CTMR that copyright is not such a sign. Article 53(1)(c) CTMR provides that a Community trade mark is to be declared invalid where there is an earlier right as referred to in Article 8(4) CTMR and the conditions set out in that paragraph are fulfilled. Article 53(2)(c) CTMR provides that a Community trade mark is also to be declared invalid where the use of such a trade mark may be prohibited pursuant to any 'other' earlier right and in particular a copyright. <u>It follows that copyright is not one of the earlier rights referred to in Article 8(4) CTMR.</u>	

Earlier right	Case No
Dr. No (copyright)	T-435/05
In addition, it is clear from Article 8(4) CTMR read in conjunction with Article 53(2) CTMR that the protection provided for by <u>copyright cannot be relied on in opposition proceedings</u> , but only in proceedings for a declaration of invalidity of the Community mark in question (para. 41).	

Earlier rights	Case No
 <p data-bbox="395 456 625 488">(Community designs)</p>	B 1 530 875
<p>Designs are a form of intellectual property dealing with the ornamental or aesthetic aspects of an article's appearance. Designs are deemed to be the result of a creative work which needs to be protected against unauthorised copying or imitation by third parties in order to ensure a fair return on investment. <u>They are protected as intellectual property, but they are not business identifiers or trade signs. Therefore, designs do not qualify as signs used in the course of trade for the purpose of Article 8(4) CTMR.</u></p>	

### 3.2.3.1 Trade names

Trade names are the names used to identify businesses, as distinguished from trade marks which identify goods or services as produced or marketed by a particular undertaking.

A trade name is not necessarily identical with the corporate name or commercial name entered in a commercial or similar register as trade names can cover other non-registered names such as a sign which identifies and distinguishes a certain establishment. Trade names are protected as exclusive rights in all Member States.

Pursuant to Article 8 of the Paris Convention, trade names enjoy protection without any registration requirement. If national legislation requires registration for national trade names, the respective provision is not applicable by virtue of Article 8 of the Paris Convention with respect to trade names held by a national of another Contracting Party to the Paris Convention. This applies as well in respect of nationals of a member of the WTO Agreement.

As regards the application of Article 8(4) CTMR to trade names, where the trade name is invoked on the basis of the law of one of the Member States where a registration is a condition for the enforcement of rights in a trade name, the Office will apply this requirement where the Member State and the nationality of the opponent are the same, but will not apply this requirement in all other cases, since this would violate the provisions of Article 8 of the Paris Convention.

Examples: R 1714/2010-4 where the Spanish trade name 'JAMON DE HUELVA' was invoked.

### 3.2.3.2 Corporate names

A corporate name or company name is the official designation of an undertaking, in most cases registered in the respective national commercial register.

Article 8(4) CTMR requires that actual use be shown, even if national law vests in the holder of such a name the right to prohibit the use of a subsequent trade mark on the basis of registration alone. However, if under national law registration is a prerequisite for protection, registration must be shown as well. Otherwise, there would be no

national right that the opponent could invoke.

Examples: judgment of 14/09/2011, T-485/07, 'O-live (fig.)' where the Spanish commercial name 'OLIVE LINE' was invoked and R 0021/2011-1 where the French company name 'MARIONNAUD PERFUMERIES' was invoked.

### 3.2.3.3 Domain names

A domain name is a combination of typographical characters corresponding to one or several numeric IP addresses that are used to identify a particular web page or set of web pages on the internet. As such, a domain name functions as an 'address' used to refer to a specific location on the internet (oami.europa.eu) or an email address (@oami.europa.eu).

Domain names are registered with organisations or commercial entities called 'domain name registrars'. Although a domain name is unique and may be a valuable commercial asset, a domain name registration per se is not an intellectual property right. Such registrations do not create any form of exclusive right. Instead, 'registration' in this context refers to a contractual agreement between a domain name registrant and the domain name registrar.

However, the *use* of a domain name may give rise to rights that can be the basis for an opposition under Article 8(4) CTMR. This can occur if the use of the domain name means that it is protected as a non-registered trade mark or a business identifier under the applicable national law.

Examples: R 0275/2011-1, where rights based on the use of the German domain name 'lucky-pet.de' were invoked; B 1 719 379, where rights based on the use of the French domain name 'Helloresto.fr' were invoked; T-321/11 and T-322/11, where rights based on the use of the Italian domain name 'partidodellaliberta.it' were invoked and the Court considered that references to this site in the Italian press did not in themselves substantiate its use in the context of a commercial activity.

### 3.2.3.4 Titles

Titles of magazines and other publications, or titles of similar categories of works such as films, television series, etc. fall under Article 8(4) CTMR only if, under the applicable national law, they are protected as business identifiers.

The fact that the copyright in a title of a work can be invoked under the respective national law against a subsequent trade mark is not material for the purposes of Article 8(4) CTMR. As set out above, whilst a right in copyright may be used to invalidate a CTM under Article 53(2) CTMR, it is only where a title has an 'identifying' function and acts as a business identifier that it comes within the scope of Article 8(4) CTMR. Therefore, for such signs to be relied on under Article 8(4) CTMR in the context of opposition proceedings, the national law must foresee a protection which is independent from that recognised by copyright law (judgment of 30/06/2009, T-435/05, 'Dr. No', paras. 41-43.)

As with all rights under Article 8(4), the title must have been used in the course of trade. This will normally require that the work to which the title relates must have been placed on the market. Where the title relates to a service (such as a television

programme), that service must have been made available. However, there will be circumstances where pre-use advertising may be sufficient to create rights, and where such advertising will constitute ‘use’ within the meaning of Article 8(4) CTMR. In all cases, the title must have been used as an indicator of the commercial origin of the goods and services in question. Where a title is used only to indicate the artistic origin of a work, such use falls outside the scope of Article 8(4) CTMR (judgment of 30/06/2009, T-435/05, ‘Dr. No’, 25-31).

Example: R 0181/2011-1 where the magazine title ‘ART’ was invoked.

### 3.2.4 Geographical indications

Geographical indications are used to designate the origin of goods as being from a particular region or locality. For a general overview on geographical indications see the Guidelines, Part B: Examination, Section 4 Absolute Grounds for Refusal and Community Collective Trade Marks, paragraph 2.09 on Article 7(1)(j) CTMR and paragraph 2.10 on Article 7(1)(k) CTMR.

Depending on the context, as described below, the term ‘protected geographical indication’ (PGI) may cover terms such as ‘designations of origin’, ‘appellations of origin’ and equivalent terms, and is used in this chapter to refer to PGIs in general.

PGIs are protected in various ways in the EU (national law, EU law, international agreements) and cover various product areas (such as foodstuffs or handicrafts).

This section identifies the types of PGIs that may serve as a valid basis for oppositions under Article 8(4) CTMR.

#### 3.2.4.1 Earlier rights deriving from EU legislation

At EU level, there is protection for PGIs for the following categories of products:

1. **certain foodstuffs and certain non-food agricultural products** (pursuant to Regulation No 1151/2012<sup>2</sup>, the ‘Foodstuffs Regulation’);
2. **wines and sparkling wines** (pursuant to Regulation No 1308/2013<sup>3</sup>, the ‘Wines Regulation’); and
3. **spirits** (pursuant to Regulation No 110/2008<sup>4</sup>, the ‘Spirits Regulation’).

The nature of the indications covered is broadly the same albeit that the precise definition of terms varies according to the legislation. Earlier rights that are registered or applied for as PGIs under the above regulations (which can even include PGIs from third countries), can constitute a ‘sign used in the course of trade’ under Article 8(4) CTMR and may be a valid basis for an opposition to the extent that they allow the proprietor **to prevent use** of a subsequent mark. Their ability to prevent use is

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<sup>2</sup> Replaced and repealed Regulation No 510/2006 which had replaced and repealed Regulation No 2081/92.

<sup>3</sup> Replaced and repealed Regulation No 1234/2007 which had integrated, through codification by Regulation No 491/2009, Regulation No 479/2008 which was repealed at the same time.

<sup>4</sup> Replaced and repealed Regulation No 1576/89.

governed by the relevant provisions of the Regulations cited above (Article 13, Article 103(2) and Article 16 of the Foodstuffs, Wines and Spirits Regulations respectively). In this context, it is important to distinguish the latter provisions preventing use from those that prevent registration<sup>5</sup> of a trade mark, which are not a basis for opposition under Article 8(4) CTMR.

In order to substantiate its right, the opponent must provide the Office with the necessary facts and evidence regarding the existence of its right. A mere extract of the relevant online EU databases (DOOR, E-Bacchus or E-Spirit-Drinks) or in the case of spirits, an extract of Annex III of the Spirits Regulation, is not sufficient, as they do not contain sufficient data to determine all the relevant particulars of the earlier right (e.g. entitlement of the opponent or goods protected by the PGI).

The opponent must in any event provide the Office with **copies of the publication and registration of the PGI in the Official Journal** and, if these documents lack information on the opponent's entitlement, further documents proving its entitlement to file the opposition as **proprietor or person authorised under the relevant national law to exercise the right** (Article 41(1)(c) CTMR and Rule 19(2) CTMIR). See in this respect decision of 17/10/2013, R1825/2012-4 'Dresdner StriezelGlühwein/Desdner Stollen' para. 37).

The EU system of protection of PGIs for foodstuffs, wines and spirits is **exhaustive in nature and supersedes national protection** for those goods. This arises from the findings of the Court in the judgment of 08/09/2009, C-478/07 'BUD', paras. 95-129. Here the Court held that the aim of Regulation No 510/2006 (the predecessor of the current Foodstuffs Regulation) was to provide a uniform and exclusive system of protection of PGIs for agricultural products and foodstuffs that superseded national laws for the relevant products<sup>6</sup>. Although the Court has not specifically pronounced upon the exhaustive nature of the Wines and Spirits Regulations, the same principle must apply because they contain substantively similar provisions to the Foodstuffs Regulation and they have the same purpose for the respective products.

#### 3.2.4.2 Earlier rights deriving from the laws of Member States

Certain PGIs deriving from the laws of Member States may be a basis for opposition under Article 8(4) CTMR. Nevertheless, for the reasons set out above, in the areas of foodstuffs, wines and spirits protection at EU level is exhaustive in nature which means that an opposition under Article 8(4) CTMR cannot be based on national rights in these areas. This is because the EU system of protection comprising the above regulations **overrides and replaces** national protection of PGIs for foodstuffs, wines and spirits.

Consequently, PGIs for certain foodstuffs<sup>7</sup> and certain non-food agricultural products<sup>8</sup> (as set out in Annex I of the Treaty on the Functioning of the European Union (TFEU) and Annex I of the Foodstuffs Regulation), wines and grapevine products<sup>9</sup> (as set out

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<sup>5</sup> Articles 14, 102 and 23 of the Foodstuffs, Wines and Spirits Regulations respectively.

<sup>6</sup> For additional information, see the Guidelines, Part B: Examination, Section 4 Absolute Grounds for Refusal and Community Collective Trade Marks, paragraph 2.09 on Article 7(1)(j) CTMR and paragraph 2.10 on Article 7(1)(k) CTMR.

<sup>7</sup> e.g. *meat, cheese, pastry, edible oils, vegetables, fruits, beverages made from plant extracts, vinegar (including wine vinegar), unmanufactured tobacco, beer, confectionery.*

<sup>8</sup> e.g. *wool, leather, essential oils.*

<sup>9</sup> e.g. *wine, sparkling wine, liqueur wine, wine must, but not wine vinegar.*

in Annex VII, part 2 of the Wines Regulation) and spirit drinks<sup>10</sup> (as set out in Annex II of the Spirits Regulation) that are protected under national laws are not a proper ground of opposition under Article 8(4) CTMR. For the latter products, the opponent *must* invoke the relevant *EU* legislation in the notice of opposition.

Nevertheless, **where no uniform EU protection is in place for a category of goods** (e.g. *handicrafts*), PGIs that are protected under national laws can be a basis for opposition under Article 8(4) CTMR (e.g. ČESKÝ PORCELÁN / FINE BOHEMIAN CHINA for crystal ware).

### 3.2.4.3 Earlier rights deriving from international agreements

In order for an opposition under Article 8(4) CTMR to be successful on the basis of a right deriving from *any* international agreement, the provisions under the international agreement must be directly applicable and they must allow the holder of a PGI to take direct legal action to prohibit the use of a subsequent trade mark.

In the latter respect, international agreements are **not always self-executing**. This depends on the characteristics of the agreement itself and on how they have been interpreted in the relevant jurisdiction. For example, the Office considers that the provisions of the Lisbon Agreement (in particular Articles 3 and 8) are not self-executing. As expressly indicated by Article 8 of the Lisbon Agreement, it is the relevant national legislation that must determine which type of legal actions may be taken, their scope and whether these legal actions include allowing the proprietor of an appellation of origin to prohibit the use of a subsequent trade mark. Therefore, in such cases, the requisite national legislation must be adduced as this is a necessary component in order for the opponent to prove that the PGI in question can prevent use of the subsequent mark and that the opponent is entitled by the law governing the right to exercise this right.

#### International agreements entered into by the EU

PGIs deriving from agreements between the EU and third countries can be invoked under Article 8(4) CTMR if the provisions of these agreements vest the PGI **in a particular beneficiary or a precise class of users** that have direct right of action<sup>11</sup>.

#### International agreements entered into by Member States including the Lisbon Agreement<sup>12</sup>

For the reasons set out in paragraph 3.2.4.2 above, a PGI protected under an international agreement concluded by Member States (either among Member States or with third countries) cannot be invoked as an earlier right under Article 8(4) CTMR if it encroaches upon the exhaustive nature of EU law in the relevant areas (currently foodstuffs, wines and spirits).

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<sup>10</sup> e.g. *grain spirit, wine spirit, fruit spirit, brandy, liqueurs, rum, whisky, gin*.

<sup>11</sup> PGIs from third countries can also be registered at EU level under the Foodstuffs, Wines and Spirits Regulations.

<sup>12</sup> Some Member States (Bulgaria, Czech Republic, France, Hungary, Italy, Portugal and Slovakia) are party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 (as revised at Stockholm 1967, and as amended on 28/09/1979). The European Union is **not** a signatory to the Lisbon Agreement.

In C-478/07 'BUD', the Court discussed the exhaustive nature of EU law as regards PGIs originating from Member States. In the Office's interpretation, this also applies a fortiori to third-country PGIs in the relevant product fields which enjoy protection in the territory of a Member State through an international agreement concluded between that Member State and a non-EU-country<sup>13</sup>.

This equally applies to the Lisbon Agreement. The Lisbon Agreement creates an international registration and protection system for 'appellations of origin' (Article 2(1)). The definition of 'appellations of origin' for food and beverage products under this agreement is largely equivalent to that of a 'designation of origin'<sup>14</sup> under EU regulations. Therefore, appellations of origin protected in a Member State by virtue of the Lisbon Agreement cannot be a basis for opposition under Article 8(4) CTMR.

The only exceptions in this regard are the following.

- International agreements which cover PGIs which do not relate to foodstuffs, wines or spirits.
- International agreements concluded with third countries by a Member State before its accession to the EU. This is because the obligations arising out of an international agreement entered into by a Member State before its accession to the EU have to be respected. However, Member States are required to take all appropriate steps to eliminate the incompatibilities between an agreement concluded before a Member State's accession and the Treaty (see Article 307 Treaty Establishing the European Community, now Article 351 TFEU, as interpreted by the Court in its judgment of 18/11/2003, C-216/01 'BUD', paras. 168-172).
- International agreements concluded with a third country by a Member State after its accession to the EU, but before the entry into force of the uniform EU system of protection in the given product area.

As Member States are under obligation to eliminate incompatibilities with EU law, the Office will apply the last two exceptions (which exclusively concern third country PGIs in the fields of foodstuffs, wines or spirits) **only when the opponent expressly refers to the exception and supports it by a coherent line of argument and relevant evidence** (in particular, concerning the date of entry into force of the cited international agreement in the EU Member State where protection is claimed and its continued validity). General allegations by the opponent (such as merely citing the relevant international agreement) will not be sufficient in themselves for the Office to consider that one of the latter two exceptions applies.

#### 3.2.4.4. Scope of protection of PGIs

The ability of PGIs to prevent use is governed by the relevant provisions of the EU Regulations (Articles 13, 103(2) and 16 of the Foodstuffs, Wines and Spirits Regulations respectively). In this context, **it is important to distinguish the latter**

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<sup>13</sup> To which the EU is not a contracting party.

<sup>14</sup> This term is defined and explained in The Guidelines, Part B: Examination, Section 4 Absolute Grounds for Refusal and Community Collective Trade Marks, paragraph 2.09 on Article 7(1)(j) CTMR and paragraph 2.10 on Article 7(1)(k) CTMR.

**provisions preventing use from those that prevent registration<sup>15</sup> of a trade mark and which are not a basis for opposition under Article 8(4) CTMR<sup>16</sup>.** Therefore, under Article 8(4) CTMR, a PGI can prevail if the conditions set out in the provisions preventing use are met, these are:

- the contested CTMA exclusively consists of the whole PGI or adds other words or figurative elements (direct or indirect use) for comparable products or, even for non-comparable products, if the use of the PGI exploits the reputation of the protected name<sup>17</sup>
- the contested CTMA contains or consists of an imitation or of an evocation of the PGI<sup>18</sup>
- other misleading indications and practices.<sup>19</sup>

Detailed information on the scope of protection of PGIs protected under the EU legislation is included in the Guidelines, Part B: Examination, Section 4 Absolute Grounds for Refusal and Community Collective Trade Marks, paragraph 2.09 on Article 7(1)(j) CTMR and paragraph 2.10 on Article 7(1)(k) CTMR (e.g. definitions of direct use, comparable products or evocation).

The provisions of the EU Regulations preventing use contemplate situations where a PGI can be invoked against goods or services which do not necessarily fall within the scope of objectionable goods and services under the *ex officio* examination of absolute grounds, subject to the conditions of the relevant provisions of the corresponding EU regulations. For instance, under Article 13(1)(a), Article 103(2)(a)(ii) and Article 16(a) of the Foodstuffs, Wines and Spirits Regulations respectively, a PGI with repute can be invoked against products and services which would not be *ex officio* objectionable under absolute grounds.

The scope of protection of PGIs that are protected by regulations other than the abovementioned EU Regulations depends on the relevant provisions.

Nevertheless, either under EU or national legislation, the scope of protection of PGIs cannot exceed what is required in order to safeguard the function of the PGI, the function in question is to designate goods as being from a particular *geographic origin and the special qualities connected therewith*. Unlike other signs, PGIs are not used to indicate the commercial origin of goods and they afford no protection in this regard. Therefore, where the specification of a CTMA **is limited to goods in conformity with the specification of the relevant protected PGI**, the function of the PGI in question is safeguarded in relation to those products because the CTMA only covers products from the particular *geographic origin and the special qualities connected therewith*. Consequently, an opposition against a CTMA which has been appropriately limited will not succeed. See in this regard Article 12(1) of the Foodstuffs Regulation or Article 103(1) of the Wines Regulation.

Where a PGI is invoked under Article 8(4) CTMR, as for all other signs under this article, the opponent **must prove that the sign is used in the course of trade of more than mere local significance**. The use must be made in accordance with the

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<sup>15</sup> Articles 14, 102 and 23 of the Foodstuffs, Wines and Spirits Regulations respectively.

<sup>16</sup> See, in this sense, judgment of 12/06/2007, joined cases T-60/04 to 64/04, 'Bud', para. 78.

<sup>17</sup> Article 13(1)(a), 103(2)(a), 16(1)(a) of the Foodstuffs, Wines and Spirits Regulations respectively.

<sup>18</sup> Article 13(1)(b), 103(2)(b), 16(1)(b) of the Foodstuffs, Wines and Spirits Regulations respectively.

<sup>19</sup> Article 13(1)(c) and (d), 103(2)(c) and (d), 16(1)(c) and (d) of the Foodstuffs, Wines and Spirits Regulations respectively.

essential function of such a sign, namely **to guarantee to consumers the geographical origin of the goods and the special qualities inherent in them**, but it must also be shown that the sign was used in the course of trade, that is, **as a distinctive element which serves to identify an economic activity engaged in by its proprietor** (see judgment of 29/03/2011, C-96/09P 'BUD', paras. 147 and 149, respectively). Therefore, documents mentioning a PGI exclusively in a non-trade context are not sufficient for the purposes of Article 8(4) CTMR.

### 3.3 Use requirements

In order to successfully invoke Article 8(4) CTMR in opposition proceedings, the earlier rights must be used. There are two different use requirement standards which must be taken into account:

- National standard
- European standard

The two use requirement standards, however, clearly overlap. They must not be viewed in isolation but have to be assessed together. This applies, in particular, to the 'intensity of use' under the National standard and 'use in trade of more than mere local significance' under the European standard.

#### 3.3.1 National Standard

National standard is relevant as it defines the scope of protection of the earlier rights which are often not easily identifiable, all the more so since their protection is not harmonised on an EU level (see further below paragraph 3.4 on the scope of protection). This standard determines the existence of the national right and the conditions of protection. For non-registered trade marks and business identifiers which do not require registration, use constitutes the only factual premise justifying the existence of the right, including the ascertainment of the beginning of its existence. The National standard also prescribes the intensity of use under the relevant national law which may vary from mere first use in trade to use requiring recognition or reputation.

For example, right to an unregistered trade mark in Denmark is acquired by mere commencement of use of the mark in Danish territory.

In Germany, however, the right to an unregistered trade mark is acquired through use that has led to recognition by the relevant public of it as a trade mark ('Verkehrsgeltung'). According to case-law distinctive signs require 20 to 25% recognition whereas non-distinctive signs must acquire recognition by 50% of the relevant public.

#### 3.3.2 European Standard – use in the course of trade of more than mere local significance

Under Article 8(4) CTMR, the existence of an earlier non-registered trade mark or of another sign gives good grounds for opposition if the sign satisfies, inter alia, the following conditions: it must be **used in the course of trade and** the use must be of **more than mere local significance**.

The above two conditions are apparent from the very wording of Article 8(4) CTMR and must, therefore, be interpreted in the light of Community law. The common purpose of the two conditions laid down in Article 8(4) CTMR is to limit conflicts between signs by preventing an earlier right which is not sufficiently definite – that is to say, important and significant in the course of trade – from preventing registration of a new Community trade mark. A right of opposition of that kind must be reserved to signs which actually have a **real presence** on their relevant market (judgment of 29/03/2011, C-96/09 P, ‘BUD’, para. 157).

### 3.3.2.1 Use in the course of trade

The first requirement under Article 8(4) CTMR is that the sign must be used in the course of trade.

The notion of ‘**use in the course of trade**’ in accordance with Article 8(4) CTMR is not the same as ‘**genuine use**’ in accordance with Article 42(2) and (3) CTMR (judgment of 30/09/2010, T-534/08, ‘Granuflex’, paras 24-27). The aims and conditions connected with proof of genuine use of registered Community or national trade marks are different from those relating to proof of use in the course of trade of the signs referred to in Article 8(4) CTMR (judgment of 09/07/2010, T-430/08 ‘Grain Millers’, para. 26, and judgment of 29/03/2011, C-96/09 P, ‘BUD’ para. 143). Therefore, use must be interpreted according to the particular type of right at issue.

The Court of Justice ruled that the ‘use of the sign in the course of trade’ within the meaning of Article 8(4) CTMR refers to the use of the sign ‘in the course of a commercial activity with a view to economic advantage and not as a private matter’ (judgments of 12/11/2002, C-206/01, ‘Arsenal Football Club’, para. 40; of 25/01/2007, C-48/05, ‘Adam Opel’, para. 18; of 11/09/2007, C-17/06, ‘Céline’, para. 17).

However, the Court of Justice also ruled that deliveries made without charge may be taken into account in order to ascertain whether the requirement for use of the earlier right in the course of trade has been met, since those deliveries could have been made in the context of a commercial activity with a view to economic advantage, namely to acquire new outlets (judgment of 29/03/2011, C-96/09 P ‘BUD’, para. 152).

As far as the **time of use** of the sign is concerned, an opponent must prove that use took place before the filing of the CTM application or the priority date if relevant (see judgment of 29/03/2011, C 96/09 P ‘BUD’, para. 166-168).

Earlier sign	Case No
BUD	C-96/09 P
<p>The Court discussed whether use which takes place exclusively or to a large extent between the filing of an application for registration and its publication was sufficient to meet the use requirement. One of the parties had argued that only the <i>acquisition</i> of the right had to take place before filing of the CTMA but not its <i>use</i>. The Court applied the same temporal condition as to the acquisition of the right and concluded that use had to take place <b>before</b> the filing of the application. The Court of Justice considered that in view of the considerable period of time which may elapse between the filing of an application for registration and its publication, the obligation of use in the course of trade of the sign before the filing of the application guarantees that the use claimed for the sign concerned is real and not an exercise whose sole aim has been to prevent registration of a new trade mark (paras 166 to 168).</p>	

In the case of unregistered signs, the use must be continuous and uninterrupted until the filing of the opposition, since otherwise there is no certainty that the rights in the unregistered sign have not lapsed. In this context, Rule 19(2)(d) CTMIR expressly states that if an opposition is based on an earlier right within the meaning of Article 8(4) CTMR, the opponent shall provide evidence of its acquisition, **continued existence** (emphasis added) and scope of protection of that right.

The following is an example of an *inter partes* case relating to invalidity proceedings. The reasoning and the findings also apply to oppositions, given that Article 8(4) CTMR is a ground that can be invoked both in opposition and in invalidity:

Earlier sign	Case No
<p style="text-align: center;">‘BAMBOLINA’ (non-registered mark in a number of MS)</p>	<p style="text-align: center;">Cancellation decision 3728 C (confirmed by BoA R 1822/2010-2, and judgment T-581/11)</p>
<p>The evidence showed use in the course of trade of the non-registered trade mark for three years, not covering the last two years before the date of filing of the invalidity request. The Cancellation Division held that an earlier non-registered sign relied on in an invalidity action must be in use at the time of filing the request. Since for these signs use constitutes the factual premise justifying the existence of the right, the same factual premise must still exist, and be proven, on the date of filing of the invalidity request (paras 25-28 of the Cancellation decision). The Board confirmed the finding of the Cancellation Division, adding that Rules 19(1) and (2)(d) CTMIR state that where an opposition is based on Article 8(4) CTMR, evidence of, <i>inter alia</i>, its ‘continued existence’ must be adduced within the period given by the Office for presenting or completing facts, evidence or arguments in support of the opposition. Failure to prove the existence, validity and scope of protection of the earlier mark or right within that period will lead to the opposition being rejected as unfounded (Rule 20(1) CTMIR). In the Board’s opinion, these Rules apply <i>mutatis mutandis</i> to cancellation proceedings (para. 15 of the BoA decision).</p>	

The requirement that the sign be used in the course of trade must, as stated above, be interpreted in the light of Community law. It must be distinguished from the requirements provided for under the applicable national laws which might set specific requirements as far as the **intensity of the use** is concerned.

The European use requirement as prescribed by Article 8(4) CTMR applies independently of whether national law allows prohibition of a subsequent trade mark on the basis of the registration of a sign alone, i.e. without any requirement relating to use. The following is an example where the opponent relied on the registration, at national level, of a trade name, but failed to prove that the sign was used in trade:

Earlier sign	Case No
<p style="text-align: center;">‘NACIONAL’ (Portuguese name of establishment)</p>	<p style="text-align: center;">R 693/2011-2</p>
<p>Under Article 8(4) CTMR, the fact that the opponent may, in accordance with the law of Portugal, have acquired exclusive rights plainly enforceable against subsequent trade marks on the basis of the registration of a ‘name of establishment’, does not exempt it from the burden of proving that the sign in question has been used in the course of trade of more than local significance. The mere fact that the sign is registered in accordance with the requirements of the respective Portuguese law is not in itself sufficient for the application of Article 8(4) CTMR (paras 20-26).</p>	

Depending on the applicable national law, an opponent might have to prove not only that the sign relied on is used in the course of trade (this being, as stated, a requirement under Community law), but also that it has been registered with the competent national authorities. It would not be sufficient that the European requirement of 'use in trade' is met if the registration requirement is not fulfilled. However, under certain national laws, rights in a company name may be invoked, as long as the company name has been used, prior to the registration of the entity in the companies register. The following is an example where the opponent invoked prior rights in a company name used in the course of trade in Germany that was not registered at the time of filing the contested CTMA:

Earlier sign	Case No
'Grain Millers GmbH & Co. KG' (German company name)	T-430/08
<p>The opponent invoked under Article 8(4) CTMR the company name 'Grain Millers GmbH &amp; Co. KG' used in the course of trade in Germany for 'flour, in particular wheat flour and rye flour'. Therefore, the opponent claimed the name of a GmbH (Gesellschaft mit beschränkter Haftung, 'limited liability company' in English). The applicant argued that, according to Article 11(1) German Limited Companies Act (GmbH Gesetz), a GmbH does not exist before its registration and that the opponent was therefore not entitled, in support of its opposition, to rely on its business name, because the company was registered only after the filing of the contested CTM application. The GC took a different view and held that, according to the case-law of the German courts, the right to a business name exists pursuant to Paragraph 5(2) of the Markengesetz from the first use in the course of trade, without the obligation to register (para. 36).</p>	

A sign is used in the course of trade where that use occurs in the context of **commercial activity with a view to economic advantage** and not as a private matter.

Therefore, the Office will reject an opposition in the absence of actual use of the invoked sign. The following are examples where the opponent failed to meet this basic requirement:

Earlier sign	Case No
Octopussy (film title)	R 526/2008-4
<p>The opponent merely submitted general information explaining the content of the film, its characters, gross figures, video offers on the internet and advertisements without any details as regards the relevant market. The information as regards turnover is also insufficient since it is too broad a general reference to the activities carried out by the opponent and does not specify either the type of activity or the territories concerned. For the same reason, the figures from a periodical, relating to the box office receipts generated by the film, have no bearing on the use of the sign in Germany. The remaining press articles furnished by the opponent concern subjects which cannot corroborate the use of the sign in the Member States indicated. The licence agreements for merchandising do not constitute any evidence with regard to the use of the sign as a film title. Lastly, the mere fact that the film was a worldwide success cannot substitute the obligation of the opponent to file concrete evidence with regard to the Member States in which it claims protection under Article 8(4) CTMR (para. 26).</p>	

Earlier sign	Case No
'lucky-pet.de' (German domain name)	R 275/2011-1
The opponent invoked under Article 8(4) CTMR the domain name 'lucky-pet.de' used in the course of trade in Germany for 'mats for animals; retail services with respect to pet supplies'. It has not been proven that the domain has been used with more than local significance for the claimed goods and services. The invoices provided and the catalogue only show the internet address www.lucky-pet.de. However, they do not prove that the website www.lucky-pet.de has been visited and, if so, to what extent. It has neither been stated nor proven by any document how many people visited the website and ordered products via email (para. 31).	

### 3.3.2.2 Significance of the use

Rights falling under Article 8(4) CTMR may only be invoked if their use is of more than mere local significance. This requirement applies for all the rights within the scope of Article 8(4) CTMR, that is, both to unregistered trade marks and to other business identifiers. The proprietors of rights the use of which is of mere local significance retain their exclusive rights under the applicable national law pursuant to Article 111 CTMR.

The question whether the use of a non-registered sign is of more than mere local significance will be answered by applying a uniform European standard (see judgment of 18/04/2013, T-506/11, 'Peek & Cloppenburg', paras 19, 47-48).

The General Court held that the significance of a sign used to identify specific business activities must be established in relation to the identifying function of that sign. That consideration means that account must be taken, firstly, of the **geographical dimension** of the sign's significance, that is to say of the territory in which it is used to identify its proprietor's economic activity, as is apparent from a textual interpretation of Article 8(4) CTMR. Account must be taken, secondly, of the **economic dimension** of the sign's significance, which is assessed in view of the length of time for which it has fulfilled its function in the course of trade and the degree to which it has been used, of the group of addressees among which the sign in question has become known as a distinctive element, namely consumers, competitors or even suppliers, or even of the exposure given to the sign, for example, through advertising or on the internet (judgment of 24/03/2009, T-318/06 to T-321/06, 'GENERAL OPTICA', paras 36-37 and judgment of 30/09/2010, T-534/08, 'GRANUflex', para. 19).

The Court of Justice clarified that the significance of a sign cannot be a function of the mere geographical extent of its protection, since, if that were the case, a sign whose protection is not merely local could, by virtue of that fact alone, prevent registration of a Community trade mark, even though the sign might be used only to a very limited extent in the course of trade. The sign must be used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local, which implies, where the territory in which that sign is protected may be regarded as other than local, that the sign must be used in a **substantial part of that territory** (judgment of 29/03/2011 C-96/09 P 'BUD', para. 158-159).

However, it is not possible to establish a priori, in an abstract manner, which part of a territory must be used to prove that the use of a sign is of more than mere local significance. Therefore, the assessment of the sign's significance must be made *in concreto*, according to the circumstances of each case.

Therefore, the criterion of '**more than mere local significance**' is more than just a **geographical examination**. The **economic impact** of the use of the sign must also be evaluated. Consideration must be given, and the evidence must relate, to these elements:

- a) the intensity of use (sales made under the sign)
- b) the length of use
- c) the spread of the goods (location of the customers)
- d) the advertising under the sign and the media used for that advertising, including the distribution of the advertising.

In the following examples, both the geographic and the economic dimension of use of the sign were found to meet the standards:

Earlier sign	Case No
GLADIATOR (non-registered trade mark in the Czech Republic)	R 1529/2010-1
The around 230 invoices are sufficient to conclude that the sign 'GLADIATOR' has been used in the course of trade for 'all terrain vehicles'. They are issued to the opponent's clients in Czech cities such as 'Praha', 'Kraslice', 'Dolní Lánov', 'Pelhrimov', 'Opava', 'Bozkov', 'Plzeň' and many other Czech cities which cover many different areas of the Czech Republic. Furthermore, the catalogues and the magazines '4X4 Style' from 2007 are written in Czech and it is very likely that they are distributed in different venues within the Czech Republic. The documents such as the list of distributors, catalogues and magazines support the findings that the sign has been used in the course of trade (paras 22-33).	

Earlier sign	Case No
'FORGE DE LAGUIOLE' (French company name)	R 181/2007-1 (appealed T-453/11)
The company name 'FORGE DE LAGUIOLE', which the invalidity applicant adopted in 1994, appears on all the documents supplied, in particular on the articles of association and on the extract from the company's certificate of registration, on the company's letterhead, on the 1998 price lists and on the correspondence and invoices, dated from 1998, sent to addressees throughout France. The very rapid expansion of the invalidity applicant's activities and its sales network, as well as its sales turnover, is proved by the documents filed. From the list of customers for 2001 it is clear that the applicant had gained a clientele covering the whole of the French territory. This finding is also confirmed by the invoices produced, made out to customers all over France as well as in other European countries. Finally, the fact is established that the company is mentioned in a number of articles both in the French press and in the European and international press (paras 52-68).	

Earlier sign	Case No
'PORTO' (Portuguese appellation of origin)	Opposition B 998 510 (confirmed by the BoA in R 1101/2009-2)
The evidence filed, and the amount and content of the legislation, regulation and registration certificates indicate that Port wine has been and is being used as an appellation of origin for wine. It is clear from the evidence in its totality that the significance of the appellation of origin is not merely local, but rather has an international impact, as reflected in its history and its use as a tool to attract tourists. The promotion of the appellation of origin has taken place, among others, through the establishments 'SOLAR DO VINHO DO PORTO' in Lisbon and Oporto, as well as through the 'PORT WINE ROUTE', in the Douro region. Taking this into consideration, the Office finds that the opponent has proved that it has used its appellations of origin in the course of trade and that the use is of more than mere local significance.	

Earlier sign	Case No
BRADBURY (non-registered trade mark in the UK)	R 66/2008-2
<p>As regards <b>goodwill</b> of the mark, the BoA held that <u>the evidence submitted by the opponent was sufficient to prove that the BRADBURY non-registered sign enjoyed goodwill</u>: 1) The invoice evidence shows sales of a range of goods to various entities in the UK and in other countries. 2) The amounts of those invoices vary from a little over GBP 100 to several thousand pounds sterling. This evidence proves sales of products bearing the earlier non-registered mark to various entities. 3) The declarations and market survey also demonstrate that the sign has enjoyed a degree of recognition among the relevant public for the right holder's goods. 4) The fact that the sign appears in a number of catalogues and advertisements and that after sales service centres are located in various major towns and cities throughout the UK demonstrates that the trade mark has been brought to the attention of a wide public in terms of geographic spread (paras 31-33).</p>	

Earlier sign	Case No
'GOLDEN ELEPHANT fig.' (non-registered trade mark in the UK)	T-303/08
<p>The party relying on the earlier non-registered trade mark had sold rice consistently under the sign since 1988, i.e. for a period of eight years prior to the date on which the applicant filed the application for the contested Community trade mark. The quantity of rice sold – between 42 and 84 tonnes per year from 1988 to 1996 – cannot be regarded as totally insignificant. The mere fact that the party's market share was very small in comparison with the total amount of rice imported into the United Kingdom is not sufficient to justify a finding that those rice sales were below the <i>de minimis</i> threshold. In that context, it should be observed that the courts in the United Kingdom are very unwilling to assume that a business can have customers but no goodwill. 'Even if it were to be assumed that that goodwill had to be regarded as low on account of the limited quantities of the sales, it cannot, on any view, be regarded as non-existent' (paras 112-116).</p>	

As far as the use of the sign is concerned, in general, neither the territory of a city alone, even a big one, is of more than mere local significance, and nor is a regional district or province. It will depend on the circumstances of the case (see examples below). The leading judgment in this respect is the one rendered by the General Court in the *General Optica* case, where use of the sign was confined to a specific locality and was, therefore, insufficient to meet the prescribed requirements:

Earlier sign	Case No
Generalóptica (Portuguese establishment name)	Joined Cases T-318/06 to T-321/06
<p>It is not apparent from the evidence provided by the opponent that the significance of the sign relied on in the present case is more than merely local within the meaning of Article 8(4) CTMR. As the Board of Appeal stated in paragraph 33 of the contested decisions, it is apparent from the documents submitted by the opponent that at the time when registration of the first two Community trade marks was applied for, the sign in question had been used for almost 10 years merely to designate a business establishment open to the public in the Portuguese town of Vila Nova de Famalicão, which has 120 000 inhabitants. In spite of its explanations at the hearing, the applicant did not provide any evidence of recognition of the sign by consumers or of its business relationships outside the abovementioned town. Likewise, the applicant has not shown that it had developed any advertising activity in order to ensure that its business establishment was promoted outside that town. It must therefore be held that the business establishment name Generalóptica is of mere local significance within the meaning of Article 8(4) CTMR (para. 44).</p>	

Earlier sign	Case No
FORTRESS FORTRESS INVESTMENTS FORTRESS INVESTMENT GROUP (non-registered trade marks in the UK)	R 354/2009-2  R 355/2009-2
<p>The fact that the invalidity applicant was involved in the acquisition, lease-back and management of nationwide property portfolios of major UK institutions and companies proves that the use was of more than mere local significance. The fact that use is limited to London is relevant in the sense that London is the seat of nearly all governmental institutions and bodies and home to the City of London, one of the leading financial centres of the world. The economic dimension of the sign's significance was important since by mid-2000 the invalidity applicant had already an equity capital under management in excess of US\$1 billion. Furthermore, the group of addressees among which the sign was known is significant since it included major players in the financial field and UK public institutions. The exposure given to the sign was also significant, cf. the national and specialised press coverage. Therefore, use in the course of trade was of more than mere local significance (paras 49-51).</p>	

The notion that the use in trade of the sign relied on must be proven in the territory of the Member State/s where protection is sought is not incompatible with use of the sign in connection with **cross-border commercial transactions**:

Earlier sign	Case No
GRAIN MILLERS (German business name)	T-430/08
<p>The use of a business name in the context of the importation of goods from another State (in this case, documents of the transaction concluded by opponent concerning the import of wheat from Romania to Germany) is indeed use in the context of a commercial activity with a view to economic advantage, since import-export constitutes a normal, everyday activity of an undertaking, necessarily involving at least two States (para. 41).</p>	

The following are examples where the opponent failed to prove that the **economic dimension** of the use of the signs concerned was sufficient to meet the prescribed legal requirements:

Earlier sign	Case No
BUD (appellation of origin)	T-225/06 RENV, T-255/06 RENV, T-257/06 RENV, T- 309/06 RENV
<p>Four very small invoices for only three cities, without any advertisements, did not meet the requirement for use in the course of trade of a sign of more than mere local significance (para. 56). The same conclusion applied to Austria since the GC found that use was limited to deliveries of 12-25 hectolitres per year, for a marginal turnover (around EUR 1 200), almost exclusively in Vienna (paras 59-61).</p>	

Earlier sign	Case No
BRIGHTON (non-registered mark in several MS)	R 408/2009-4
<p>The sales chart provided by the opponent shows that the sale activities in the Member States concerned were not consistent over time to the extent that for certain years no sales at all appear to have taken place and that for others the sales revenue was very low indeed. Therefore, the sales figures show that the opponent was not able to maintain an intensity of use of the signs over three consecutive years. It is unlikely in those cases that the public was able to memorise the mark as an indication of origin. The opponent did not submit any evidence relating to the advertising and promotion of the marks invested in the concerned Member States, or other material showing that the signs in question had established themselves in the marketplace to such an extent as to justify the acquisition of exclusive rights in non-registered trade marks (paras 12-21).</p>	

Earlier sign	Case No
 (Greek non-registered mark)	R 242/2010-1
<p>Although the documents confirm the geographical extent of the trade mark to Greece, the evidence regarding the extent of time of the alleged use is clearly insufficient. The last dated document is from 1997, i.e. seven years before the contested application was submitted. Moreover, the most recent documents in which the trade mark 'ESKIMO' can be seen are the invoices dating from 1991 to 1994. They only reflect the sales of a little less than 100 units throughout these four years, which cannot be deemed sufficient to prove the use of the mark as a business identifier by the opponent (paras 27-28).</p>	

Earlier sign	Case No
Up Way Systems – Representações Unipessoal LDA (Portuguese company name)	R 274/2012-5
<p>Three invoices, addressed to companies in the Porto region of Portugal, for a total sales amount of EUR 16 314, are not sufficient to show that the sign was used in the course, considering the price level of building materials and building services in general (paras 20-23).</p>	

Use of a sign relied on under Article 8(4) CTMR must be made in accordance with the essential **function** of such a sign. This means that if an opponent relies on a non-registered trade mark, proof of use of the sign as a company name would not be sufficient to substantiate the earlier right.

The following is an example where the evidence shows use of a sign whose function does not correspond to that of the sign relied on:

Earlier sign	Case No
JAMON DE HUELVA (Spanish trade name)	R 1714/2010-4
<p>The proof furnished in order to substantiate the use of 'Jamón de Huelva' almost exclusively relates to the designation of origin 'Jamón de Huelva'. Designations of origin are very different legal concepts from trade names, as, instead of identifying a particular commercial origin, they are geographical indications relating to an agricultural or food product of which the quality or characteristics are fundamentally or exclusively due to the geographical environment in which they are produced, processed or prepared. The opposition based on the use in Spain of the trade name 'Jamón de Huelva' must be dismissed in view of the fact that the proof furnished does not relate to this legal concept and does not identify a specific commercial activity, but instead the activities relating to a designation of origin and the Supervisory Council thereof (paras 34-37).</p>	

The requirement that the sign must be used in trade for its own particular economic function does not exclude that the same sign might be used for several purposes.

It is common market practice to also use company or trade names as trade marks, either alone, or together with other product identifiers. This is the case when use of a 'house mark' is concerned, that is, an indication which usually coincides with the manufacturer's company or trade name and which not only identifies the product or service as such, but also provides a direct link between one or more product/service lines and a specific undertaking.

Therefore, depending on the specific circumstances of the case, in a case where an opponent relies on a non-registered trade mark, the use of the same sign as a company name or trade name may well also accomplish the function of indicating the origin of the goods/services concerned (thus, a trade mark function), as long as the sign is used in such a way that a link is established between the sign which constitutes the company or trade name and the goods marketed or the services provided (see, by analogy, judgment of 11/09/2007, C-17/06 'CELINE' paras 22-23).

### 3.4 Earlier right

The right invoked under Article 8(4) CTMR must be earlier than the CTM application. In order to determine which of the conflicting rights is earlier, the relevant dates on which the rights were obtained must be compared.

- For the **CTM application**, this is the filing date or any priority date validly claimed (hereinafter the 'CTM date'). Seniority claims, even if they relate to the Member State where the other earlier right is claimed to exist, are not relevant.
- As regards the **right falling under Article 8(4) CTMR**, the relevant date of acquisition of exclusive rights under the national law is decisive (see judgment of 07/05/2013, T-579/10 'makro', where the Court confirmed the Board's rejection of evidence submitted by the invalidity applicant, which related to periods subsequent to the owner's application for the CTM (para. 70).

Where under the national law mere use is sufficient, this must have begun before the CTM date. Where recognition in the trade or reputation are required, these must have

been acquired before the CTM date. Where these conditions are fulfilled only after the CTM date, the opposition will have to be rejected.

### **3.5 Scope of protection**

Earlier rights falling under Article 8(4) CTMR are protected only if they confer on their proprietors under the applicable law the right to prohibit the use of a later trade mark.

This requires a finding that under the applicable national law rights of the type involved, in the abstract, are exclusive rights enforceable by means of an injunction vis-à-vis later marks and a finding that in the actual case under consideration the conditions for obtaining such injunctive relief, if the mark that is the subject of the opposed CTM application were used in the territory in question, are present (scope of protection). Both questions have to be answered in accordance with the applicable law. The Office will apply the laws of the Member States, Community law or International agreements.

For many, if not most, of the rights falling under Article 8(4) CTMR, the prerequisites of national regulations are quite similar to those applied in conflicts between trade marks which Office examiners are familiar with, namely, likelihood of confusion, or damage to reputation or distinctiveness.

For example, unregistered marks are generally protected against subsequent marks in the event of a likelihood of confusion and, thus, in accordance with the same criteria that are applicable to conflicts between registered marks, namely, identity or similarity of the signs, identity or similarity of the goods or services, etc. In these cases, the criteria developed by the courts and by the Office for applying Article 8(1) CTMR may easily be transported into Article 8(4) CTMR, unless the party can provide relevant case-law of the national courts proving a different approach.

Where the applicable national law provides protection for unregistered trade marks, which is different from that found in Article 8(1) CTMR, the scope of protection of the earlier right invoked follows from national law. If, for example, the applicable national law grants protection to unregistered marks also for dissimilar goods and services under certain conditions, the same protection will be granted under Article 8(4) CTMR.

## **4 Proof of the Applicable Law Governing the Sign**

### **4.1 The burden of proof**

According to Article 76(1) CTMR, in all *inter partes* cases, the burden is on the party making a particular claim or allegation to provide the Office with the necessary facts and arguments in order to substantiate the claim. Unlike other grounds in Article 8 CTMR, Article 8(4) CTMR does not specify the conditions governing the acquisition and scope of protection of the earlier right invoked. It is a framework provision where the particulars of the applicable law must be provided by the opponent.

Rule 19(2)(d) CTMIR provides that if an opposition is based on an earlier right within the meaning of Article 8(4) CTMR, the opponent shall provide evidence of its acquisition, continued existence and scope of protection.

It follows from the law as interpreted by the Court that the opponent must provide the relevant national law and show that it would succeed under that national law in preventing the use of a subsequent trade mark:

In that regard, it should be observed that Article 8(4)(b) [CTMR] lays down the condition that, pursuant to the law of the Member State governing the sign relied on under Article 8(4), that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Furthermore, in accordance with Article 74(1) of Regulation 40/94 [now Article 76(1) CTMR], the burden of proving that that condition is met lies with the opponent before OHIM.

In that context and in relation to the earlier rights relied on ... regard must be had, in particular, to the national rules advanced in support of the opposition and to the judicial decisions delivered in the Member State concerned and that, on that basis, the opponent must establish that the sign concerned falls within the scope of the law of the Member State relied on and that it allows use of a subsequent mark to be prohibited.

(See judgment of 29/03/2011, C-96/09 P 'BUD', paras 188-190.)

The Court held that in applications for a declaration of invalidity brought under Article 53(2) CTMR, it is for the party who seeks to rely on an earlier right protected under national law

to provide OHIM not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, in order to be able to have the use of a Community trade mark prohibited by virtue of an earlier right, but also particulars establishing the content of that law.

(See judgments of 05/07/2011, C-263/09 P, 'Elio Fiorucci', para. 50 and 27/03/2014, C-530/12 P, 'Representation of a hand', para. 34.)

Although these judgments referred to invalidity proceedings under Article 53(2) CTMR, since Article 8(4) also concerns the application of earlier rights protected under European Union legislation or under the law of the Member State governing the sign at issue, the cited case-law also applies to oppositions brought under Article 8(4) CTMR.

The information on the applicable law must allow the Office to understand and apply the content of that law, the conditions for obtaining protection and the scope of this protection, and allow the applicant to exercise the right of defence. It may also be particularly useful to submit evidence of relevant case-law and/or jurisprudence interpreting the law invoked.

The Office must effectively assess the applicability of the ground for refusal invoked. In order to ensure the correct application of the law invoked, the Office has the power to verify, by whatever means it deems appropriate, the content, the conditions governing the application and the scope of the provisions of the applicable law relied upon by the opponent (see judgment of 27/03/2014, C-530/12 P, 'Representation of a hand', paras 44-46), while respecting the parties' right to be heard. If, after verifying the evidence submitted, the Office is of the opinion that the parties' proposed interpretation or application of the law invoked was inaccurate, it can introduce new and/or additional

elements. In order to respect the parties' rights to be heard, the Office will invite the parties to comment on these elements, where appropriate.

This power of verification is limited to ensuring the **accurate application of the law relied upon by the opponent**. It does not therefore discharge the opponent from the burden of proof and it cannot serve to substitute the opponent in adducing the appropriate law for the purposes of its case (see decision of 02/06/2014, R 1587/2013-4 'GROUP', para. 26 and decision of 30/06/2014, R 2256/2013-2 'ENERGY', para. 26).

## 4.2 Means of evidence and standard of proof

Pursuant to Article 8(4) CTMR, the applicable law may be the law of a Member State or European Union law.

### 4.2.1 National law

As regards national law, the opponent must provide:

a) **the provisions of the applicable law:**

- on the **conditions governing acquisition of rights** (whether there is a requirement of use and, if so, the standard of use required; whether there is a registration requirement, etc.); and
- on the **scope of protection of the right** (whether it confers the right of prohibition of use; the injury against which protection is provided, e.g. likelihood of confusion, misrepresentation, unfair advantage, evocation).

b) **particulars proving fulfilment of the conditions:**

- of **acquisition** (entitlement; earlier acquisition; whether it is in force; evidence of use if use-based; evidence of registration if registration-based, etc.); and
- of **the scope of protection** (facts, evidence and/or arguments that the requirements laid down by the applicable law for a prohibition of use are met, e.g. the nature of the goods, services or business activity protected by the earlier right and their relation with the contested goods or services; a cogent argument showing that there is a risk of injury).

**First, as regards the provisions of the applicable law** (see point a) above), the opponent must provide the reference to and content of the applicable law invoked. The opponent must provide the *reference* to the relevant legal provision (article number and the number and title of the law) and the *content* (text) of the legal provision either in its submission or by highlighting it in another publication attached to the submission (e.g. excerpts from an official journal, a legal commentary or a court decision). If the relevant provision refers to a further provision of law, this must also be provided to enable the applicant and the Office to understand the full meaning of the provision invoked and to determine the possible relevance of this further provision.

As the opponent is required to **prove** the content of the applicable law, **it must provide the applicable law in the original language**. If that language is not the language of the proceedings, the opponent must also provide a **complete translation** of the legal provisions invoked in accordance with the standard rules of substantiation. However, a mere translation of the applicable law does not itself constitute proof and cannot substitute the original; therefore, the translation alone is not considered sufficient to prove the law invoked. See Rule 19(2)(d) CTMIR, which requires evidence to be submitted and Rule 19(3) CTMIR, which requires translations be submitted within the time limit specified for submitting the original document.

Where the opponent seeks to rely on national case-law or jurisprudence interpreting the law invoked, it must provide the relevant information in sufficient detail (e.g. a copy of the decision invoked or excerpts from the legal literature) and not merely by reference to a publication. The translation rules apply equally to that evidence.

**Second, as regards the particulars proving fulfilment of the conditions of the applicable law** (see point b) above), apart from providing appropriate evidence of acquisition of the right invoked, the opponent must submit evidence that the conditions of protection vis-à-vis the contested mark are actually met and, in particular, put forward a cogent line of argument as to why it would succeed in preventing the use of the contested mark under the applicable law. Merely providing the applicable law itself is not considered sufficient, as it is not up to the Office to make the relevant argument on behalf of the opponent.

Furthermore, in an opposition under Article 8(4) CTMR, what matters is whether the relevant provisions of the law conferring on the opponent the right to prohibit the use of a subsequent trade mark would apply to the contested mark in the abstract, and not whether the use of the contested mark could actually be prevented. Therefore, the applicant's argument in defence that the opponent had not hitherto invoked or had not hitherto been able to prevent the actual use of the contested mark in the relevant territory cannot succeed (see judgment of 29/03/2011, C-96/09 P 'BUD', paras 191 and 193).

At the end of this Section of the Guidelines, there is an overview **Table** with the essentials of national laws applicable in the Member States. It is included in these Guidelines for information purposes only. As this table contains a description of the legal provisions for information purposes only, merely referring to the table does not discharge the opponent from the duty of proving the relevant law governing the sign that confers on it the right to prohibit the use of a later trade mark, as described above (see decision of 22/01/2013, R 1182/2011-4, 'Crown Lounge (fig. mark)', paras 48-50).

Based on the above, the Office will reject the opposition if:

- the opponent invokes a right but does not include a **reference** to any specific national law and/or legal provision protecting that right (e.g. the opponent only indicates that the opposition is based on a commercial designation in Germany or that the opposition based on a commercial designation in Germany is protected under DE-TMA); or
- the opponent provides a reference to the applicable national law and legal provision(s) but the reference is not complete: the legal provision only indicates the conditions governing the **acquisition** of the right but not the **scope of protection** of the right (or vice-versa) (e.g. the opponent indicates that the opposition is based on a commercial designation in Germany protected under Article 5 DE-TMA, which establishes the conditions for acquisition of the right, but

- the reference to the conditions governing the scope of protection, Article 15 DE-TMA, is missing); or
- the opponent provides the reference to the relevant legal provision but does not provide the **content** (text) of the legal provision (e.g. the opponent's submission refers to the DE-TMA but does not include the content of the law); or
  - the opponent provides the content of the legal provision only in the language of the proceedings but not in the **original language** (e.g. the language of the proceedings is English but the text of the DE-TMA is submitted only in English, not in German); or
  - the opponent does not provide any or sufficient evidence of the acquisition of the right invoked or does not provide arguments as to why it fulfils the conditions governing the scope of protection (e.g. the opponent refers to the relevant legal provisions and provides their content both in the original language and translated into the language of the proceedings, but does not provide any or sufficient evidence of the acquisition of protection or does not state whether it fulfils the conditions of the scope of protection).

#### 4.2.2 European Union law

The above requirements also apply to European Union law, except that the opponent is not obliged to provide the content (text) of the law invoked. However, the opponent has to provide particulars proving the fulfilment of the conditions under the relevant provisions of European Union law (point b) above).

**TABLE ON NATIONAL RIGHTS THAT CONSTITUTE 'EARLIER RIGHTS' IN THE SENSE OF ARTICLE 8(4) CTMR**

***FOR INFORMATION PURPOSES<sup>20</sup>***

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<sup>20</sup> The content of the Table is largely based on information and feedback from trade mark offices and user associations in 2013/2014. However, it is not a legal source and is made available for information purposes only. It may not contain the latest legislative developments or an exhaustive list of all national rights that can be invoked under Article 8(4) CTMR.

## 1 Benelux

### 1.1 Unregistered trade marks

Unregistered trade marks (TMs) are not recognised under the uniform Benelux Convention on Intellectual Property (BCIP).

### 1.2 Other signs used in the course of trade

For the Benelux territory each state must be considered separately.

#### 1.2.1 Belgium

##### **Trade name (nom commercial)/Company name (dénomination sociale)**

Article 2.19 BCIP

Article 95 of 'Loi du 6 avril 2010 relative aux pratiques du marché et à la protection du consommateur'

Article 1382 of the 'Code Civil' (Civil Code)

##### Conditions for protection

**Trade name** is acquired by its first use in trade. Protection is limited to the geographical area where the trade name or company name is used.

**Company name** is acquired, in principle, from the date of the establishment of the company. Protection extends to the whole national territory.

##### Rights conferred

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

#### 1.2.2 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'

Rights conferred

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

1.2.3 Netherlands

**Trade name**

Article 2.19 BCIP

Law of 5 July 1921 on trade names (Handelsnaamwet)

Article 6:162, Dutch Civil Code (Burgerlijk Wetboek)

Conditions for protection

Right is acquired by the first use of the trade name in trade. Protection is limited to the geographical area where the trade name is used. Trade names may be registered voluntarily with the Trade Register at the Chamber of Commerce but doing so does not confer any rights on the owner. There is no particular requirement that the trade name be distinctive and non-descriptive.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent (registered) trade marks.
- (b) Likelihood of confusion must be found.

## **2 Bulgaria**

### **2.1 Unregistered trade marks**

Unregistered trade marks (TMs) are protected in Bulgaria in two ways.

#### **Unregistered TMs**

Article 12(6) Bulgarian Trade Mark Law on Marks and Geographical Indications (2010)

Conditions for protection

The TM must have been used in the course of trade in the territory of Bulgaria prior to the filing date of the contested trade mark.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit registration of a subsequent trade mark.
- (b) The subsequent trade mark must be identical or similar and must cover identical or similar goods and/or services.

### **Well-known TMs**

Article 12(2)7 Bulgarian Trade Mark Law on Marks and Geographical Indications (2010)

#### Conditions for protection

The TM must be well-known in the territory of Bulgaria within the meaning of Article 6bis of the Paris Convention prior to the filing date of the contested trade mark.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit registration of a subsequent trade mark.
- (b) The subsequent trade mark must be identical or similar and must cover identical or similar goods and/or services.

## **2.2 Other signs used in the course of trade**

Other signs used in the course of trade are not included by Bulgarian trade mark law as prior rights that could form a basis for opposition.

## **3 Czech Republic**

### **3.1 Unregistered trade marks**

Unregistered trade marks are protected in the Czech Republic:

Article 7(1)(g) of the Czech Trade Marks Act (CZ-TMA).

#### Conditions for protection

Unregistered signs that have acquired distinctiveness through use in the course of trade of more than mere local significance prior to the filing of the contested application.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) Signs must be identical or similar (interpreted as likelihood of confusion) and must cover identical or similar goods and/or services. Scope of protection is identical to that of a Czech registered mark.

### **3.2 Other signs used in the course of trade**

Article 7(1)(g) CZ-TML

**Trade names and other related signs (e.g. names of non-commercial organisations)**

#### Conditions for protection

These names/signs must have acquired distinctiveness through use in the course of trade of more than mere local significance prior to the filing of the contested application.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) Signs must be identical or similar (interpreted as likelihood of confusion) and must cover identical or similar goods and/or services. Scope of protection is identical to that of a Czech registered mark.

## **4 Denmark**

### **4.1 Unregistered trade marks**

Unregistered trade marks (TMs) are protected in Denmark:

§ 3(1)(ii) of the Danish Trade Mark Act (DK-TML)

§ 4(1), (2) and § 15(4)(ii) DK-TML

#### Conditions for protection

Rights to an unregistered TM are acquired by starting to use the TM in Denmark.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent (registered) TMs.
- (b) The unregistered TM must continue to be used for the goods and/or services for which it was first used. The scope of protection is the same as for Danish registered TMs, i.e. corresponding to Article 9(1)(a), (b) and (c) CTMR.

## **4.2 Other signs used in the course of trade**

### **Company names**

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

§ 18 Danish Marketing Practices Act

§ 2(ii) Danish Companies Act

§ 6(ii) Consolidated Act on Certain Commercial Undertakings

### Conditions for protection

Company name protection does not require registration. However, the person concerned must have legal title to the company name.

### Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent (registered) trade marks.
- (b) Signs must be identical or similar.

### **Signs used in the course of trade such as business names and shop facades**

The term 'signs used in the course of trade' is to be interpreted broadly and, according to Danish law, covers any commercial name or symbol that can serve as a connecting link between a business and its customers/users, including, inter alia, business names and shop facades.

§ 18 Danish Marketing Practices Act

## **5 Germany**

### **5.1 Unregistered trade marks**

§ 4 No 2 German Trade Mark Act (DE-TMA), § 12, 14 DE-TMA

### Conditions for protection

Protection is acquired through use leading to recognition by the relevant public as a trade mark ('Verkehrsgeltung') (§4 No 2 DE-TMA). According to case-law, 20 to 25% recognition by the relevant public is normally sufficient, rising to 50% or more if a sign is not distinctive.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of a subsequent trade mark if recognition is established in the whole of Germany, i.e. not if recognition is only established for a particular town or region (§§ 12, 14 DE-TMA).
- (b) The same as for registered German trade marks, i.e. protection corresponds to Article 9(1)(a), (b) and (c) CTMR (§ 14(2) No 1, 2 and 3 DE-TMA).

## 5.2 Other signs used in the course of trade

§5(1), (2), (3) DE-TMA

**Commercial designations** ('geschäftliche Bezeichnungen') is a broad category that includes the following.

**Company symbols** ('Unternehmenskennzeichen') are signs used in the course of trade as a name, company name or special designation of a business operation or enterprise. Business symbols and other signs that are intended to distinguish one business operation from others and are regarded as symbols of the business operation by the relevant public are deemed equivalent to the special designation of a business operation.

A **name or firm** is a trader's official or officially registered designation. A business symbol is a sign used by a trader to identify its business or undertaking as such, which functions as the name of the business or enterprise.

**Titles of works** are the names or special designations of printed publications, cinematic works, music works, stage works or other comparable works. This can be an individual work, a series of works, or a periodical publication. 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 title is protected under copyright law.

### Conditions for protection

**Company symbols** – If the sign is inherently distinctive, protection is acquired through use in the course of trade as a company symbol. According to case-law the required degree of inherent distinctiveness is low. 'Use in the course of trade as a company symbol' covers every external business activity in Germany aimed at long-term commercial activity. If the sign is not inherently distinctive, protection is acquired through recognition as a sign of the undertaking by the relevant public ('Verkehrsgeltung').

**Business symbols and other signs for distinguishing business operations** – Protection is acquired through recognition as a sign of the undertaking by the relevant public.

**Titles of works:** if the title of work 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 of the right through market recognition ("Verkehrsgeltung").

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of a subsequent trade mark.
- (b) Likelihood of confusion (§ 15(2) DE-TMA); in the case of a business designation with reputation, if use would take unfair advantage of, or would be detrimental to, the distinctive character or repute of a commercial designation (§ 15(3) DE-TMA).

## **6 Estonia**

### **6.1 Unregistered trade marks**

Unregistered trade marks are not protected under Estonian law unless the marks are considered to be well-known in Estonia within the meaning of Article 6<sup>bis</sup> of the Paris Convention.

### **6.2 Other signs used in the course of trade**

#### **Business names**

Article 10(1)(4) of the Estonian Trade Mark Act (EST-TMA)

#### Conditions for protection

Entry in the commercial register prior to the filing date of the application, the date of international registration or the priority date. Protection for a business name is acquired from the date of entry in the commercial register.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent (registered) trade marks.
- (b) Signs must be identical or similar and the area of activity for which a notation has been made in the commercial register must include the goods and/or services for which the contested trade mark is used or is going to be used (designates).

#### **Names of proprietary medicinal products**

Article 10(1)(5) EST-TMA

#### Conditions for protection

The names must be registered in Estonia prior to the filing date of the trade mark application, the date of international registration or the date of priority.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent (registered) trade marks.
- (b) The contested sign must be identical or confusingly similar to the name of a proprietary medicinal product registered in Estonia and the goods for which the trade mark is used or is going to be used must belong to the field of medicine.

## **7 Ireland**

### **7.1 Unregistered trade marks**

Unregistered trade marks (TMs) used in the course of trade are protected in Ireland.

Section 10(4)(a) IE-TMA

Conditions for protection

Must be used in the course of trade if protected by any rule of law, including that of passing off.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade mark if protected by any rule of law, in particular the law of passing off.
- (b) The later sign must constitute 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 defendant's activities.

The action for passing off is based upon goodwill acquired by use of the earlier sign. Goodwill is sometimes referred to as reputation. In Ireland, goodwill can be acquired without necessarily trading within the territory, provided that a reputation in Ireland or customers in Ireland can be proven. The tort arises if a later sign constitutes 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 law is explained in 'Intellectual Property Law in Ireland' by Robert Clark, Shane Smyth, Niamh Hall, Bloomsbury Professional, 3rd edition 2010 (see <http://www.bloomsburyprofessional.com/1155/Bloomsbury-Professional-Intellectual-Property-Law-in-Ireland-3rd-edition.html>).. Authoritative statements of the law are found in court judgments, for example in *C. & A. Modes vs C. & A. (Waterford)* [1978] Fleet Street Reports 126; *Adidas K.G. v. O'Neill & Co Limited* [1983] Fleet Street Reports 76; *Guinness Ireland Group v. Kilkenny Brewing Co Limited* [2000] Fleet Street Reports 112; *Allergan Inc. v Ocean Healthcare Ltd* [2008] IEHC 189; *Jacob Fruitfield Food Group Ltd v United Biscuits (UK) Ltd* [2007] IEHC 368; and *McCambridge v Brennan Bakeries Ltd* [2012] IESC 46.

## **7.2 Other signs used in the course of trade**

### **Business sign used in the course of trade**

Section 10(4)(a) and (5), IE-TMA

Right to prohibit use of subsequent TMs 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 A.

#### Conditions for protection

As under Section 7.1 above.

#### a) Rights conferred (a) and conditions (b)

As under Section 7.1 above.

## **8 Greece**

### **8.1 Unregistered trade marks**

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 indicated.

Article 124(3)(a) GR-TML (Law No 4072/2012); Article 13(1) of Law 146/1914 on Unfair Competition

#### Conditions for protection

Protection is acquired through use in the course of trade. If not inherently distinctive, unregistered trade marks must also be 'established in the market'.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit registration of a subsequent trade mark.
- (b) Prior use, likelihood of confusion as to origin.

## **8.2 Other signs used in the course of trade**

### **Company names**

Article 58 Civil code

Articles 4-8 Law 1089/1980, as amended by 1746/1988

#### Conditions for protection

Protection is acquired exclusively through use in the course of trade. Registration is not relevant for protection; it only serves administrative purposes.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) Prior use, likelihood of confusion as to origin.

### **Trade names and commercial establishment insignia**

Article 124(3)(a) GR-TML (Law No 4072/2012)

Article 13(1)(2) Law 146/1914 on Unfair Competition

#### Conditions for protection

Protection is acquired exclusively through use in the course of trade. If not inherently distinctive, the trade name or insignia must also be 'established in the market'.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) Prior use, likelihood of confusion as to origin.

### **Other distinctive signs**

Article 124(3)(a) GR-TML

The peculiar shape of the goods or of their packaging, as well as the peculiar get-up or decoration thereof (Ιδιαίτερος διασχηματισμός, διακόσμηση).

#### Conditions for protection

The signs must be known in the relevant commercial sector as product identifiers of a given trader. Protection is acquired through use in the course of trade. The signs must be capable of performing a trade mark-like function (i.e. they must have distinctive character as a result of a certain degree of originality).

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) Prior use, likelihood of confusion as to origin.

General note: All the exclusive signs referred to above are also protected under **Article 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).

## 9 Spain

### 9.1 Unregistered trade marks

Unregistered trade marks are not protected in Spain unless they are considered to be well known in Spain within the meaning of Article 6<sup>bis</sup> of the Paris Convention.

### 9.2 Other signs used in the course of trade

#### **Business names (Nombres comerciales)**

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

#### Conditions for protection

The name must be registered or applied for at the Spanish Patent and Trade Mark Office.

#### Rights conferred (a) and conditions (b)

- (a) Right to oppose and prohibit the use of subsequent trade marks.
- (b) Identical or similar signs and identical or similar goods or services and likelihood of confusion.

#### **Business names, designations or corporate names of legal persons**

Article 9(1)(d) ES–TML

#### Conditions for protection

The names do not have to be registered or applied for at the Spanish Patent and Trade Mark Office provided that they identify a person (enterprise) for the purposes of trade. Evidence of use or evidence that the sign is well known in the national territory must be provided.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) Identical or similar signs and identical or similar goods or services and likelihood of confusion.

## 10 France

### 10.1 Unregistered trade marks

Unregistered trade marks are not recognised under French law with the exception of well-known trade marks in the sense of Article 6bis of the Paris Convention (Article L711-4(a) French Intellectual Property Code (FR-IP CODE))

### 10.2 Other signs used in the course of trade

Article L711-4 FR-IP Code provides a non exhaustive list of signs that, if qualified as earlier, might prohibit use of a later trade mark.

#### **Company name or style of a company** ('dénomination sociale', "raison sociale")

Article L711-4(b) FR-IP Code

#### Conditions for protection

Protection of the company name is acquired upon completion of the documents founding the company. Must be known throughout the French territory.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of a subsequent trade mark.
- (b) There must be a risk of confusion in the mind of the public.

#### **Trade name** (nom commercial)

Article L711-4(c) FR-IP CODE

#### Conditions for protection

Protection acquired from first use in trade.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of a subsequent trade mark.
- (b) There must be a risk of confusion in the mind of the public.

**Business sign** ('enseigne')

Article L711-4(c) FR-IP CODE

Conditions for protection

Protection acquired from first use in trade. Must be known throughout the territory of France (enseigne notoire).

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of a subsequent trade mark.
- (b) There must be a risk of confusion in the mind of the public.

**Domain names** ('noms de domaine')

Conditions for protection

The domain name is protected when it is reserved and used.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of a subsequent trade mark for identical or similar products and/or in the event of unfair advantage or dilution of reputations.
- (b) There must be a likelihood of confusion or damage to first user.

## 11 Croatia

### 11.1 Unregistered trade marks

Unregistered trade marks are protected in Croatia.  
Article 6(2), (4) Croatian Trade Marks Act and the Act on Amendments to the Trade Mark Act

Conditions for protection

The unregistered trade mark must be **well-known** in the Republic of Croatia prior to the filing/priority date of the contested trade mark in the sense in which the words 'well-known' are used in Article 6<sup>bis</sup> of the Paris Convention.

Rights conferred (a) and conditions (b)

- (a) Right to oppose the registration of a subsequent trade mark.
- (b) The subsequent trade mark must be identical or similar and have applied for identical or similar goods and/or services.

## 11.2 Other signs used in the course of trade

### Earlier firm

Article 6(6) Croatian Trade Marks Act and the Act on Amendments to the Trade Mark Act

Conditions for protection

It must be registered.

Rights conferred (a) and conditions (b)

- (a) Right to oppose the registration of a subsequent trade mark.
- (b) The firm or the essential part thereof must be identical or similar to the sign in respect of which registration is sought, and the goods and/or services must be identical or similar, unless the applicant had the identical or similar firm at the time of filing the application for registration of a trade mark.

## 12 Italy

### 12.1 Unregistered trade marks

An **unregistered trade mark** ('marchio di fatto') is defined as a sign known as a trade mark or as a sign that is distinctive for manufactured goods or services on the market. Prior use must be notoriously known.

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

Conditions for protection

The unregistered trade mark must be used to the extent that it is 'notoriously known throughout Italy or a substantial part thereof.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent trade marks.

- (b) Identical or similar signs and identical or similar goods or services and likelihood of confusion including likelihood of association.

## 12.2 Other signs used in the course of trade

Article 12(1)(b) IT-IP Code

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

### Conditions for protection

Used to the extent that it is 'notoriously known throughout Italy or a substantial part thereof.

### Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent trade mark, provided it is known by the relevant public throughout Italy or a substantial part thereof.
- (b) Identical or similar signs and identical or similar goods or services and likelihood of confusion including likelihood of association.

## 13 Cyprus

### 13.1 Unregistered trade marks

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

## 14 Latvia

### 14.1 Unregistered trade marks

Unregistered trade marks are protected in Latvia.  
Article 9(3) No 4 LV-TML

### Conditions for protection

The unregistered mark must have been used in good faith and lawfully prior to the date of filing of the application for registration of the trade mark (or the priority date

respectively) in commercial activities in Latvia in connection with identical or similar goods or services.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) Identical or similar signs and identical or similar goods or services; use of the subsequent trade mark must also be capable of misleading consumers as to the origin of the goods and services.

## 14.2 Other signs used in the course of trade

**Trade names** originating in Latvia or in a foreign country (**commercial designations, names of a mass medium, or other similar signs**) that are well-known in Latvia.

Article 9(3) No 3, LV-TML

Conditions for protection

The trade name must be acquired through fair and lawful use in the course of trade in Latvia before the filing/priority date of a subsequent trade mark used in an identical or similar business sector. A 'well-known' trade name must have become well known in Latvia before the filing/priority date of the subsequent trade mark.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) The signs must be the same or confusingly similar and must cover identical or similar goods and services.

## 15 Lithuania

### 15.1 Unregistered trade marks

Article 7(1), (3), 9 LT-TML.

Conditions for protection

Unregistered trade marks are protected only if recognised as well known by a court decision.

## **15.2 Other signs used in the course of trade**

### **Trade names/business names and other business identifiers**

#### Rights conferred (a) and conditions (b)

- (a) Right to invalidate subsequent (registered) trade marks.  
(b) Registration of a mark will be declared invalid if the mark is identical to a legal person's business name or is likely to be confused with a legal person's business name.

Article 7(1), No 4 LT-TML

## **16 Hungary**

### **16.1 Unregistered trade marks**

An unregistered trade mark is not protected under Hungarian trade mark law unless it has been used effectively in the country where use of the sign without the consent of the prior user would be contrary to law.

Article 5(2)(a) HU-TML

Article 6 of Act LVII of 1996 on the prohibition of unfair and restrictive market practices prohibits the manufacture, distribution or advertising of goods and services without the consent of competitors if the goods and services concerned have a characteristic presentation, packaging or labelling (including designation of origin), and the use of a name, mark or designation by which a competitor or its goods and services are usually recognised.

The abovementioned provisions are only an example.

## **17 Malta**

### **17.1 Unregistered trade marks**

Chapter 26 of Malta's Trade Mark Act; Article 6(4) MT-TMA

#### Conditions for protection

Protection is acquired through continuous prior use.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) Signs must be likely to be confused and must cover identical or similar goods and services.

## **17.2 Other signs used in the course of trade**

Article 11(3) MT-TMA

Conditions for protection

Protection is acquired through continuous use.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks (Article 6(2) MT-TMA).
- (b) Likelihood of confusion.

In view of Articles 6(4) and 11(3) MT-TMA, other signs used in the course of trade are regarded as earlier rights.

## **18 Austria**

### **18.1 Unregistered trade marks**

Unregistered trade marks (TMs) are protected in Austria:

§ 31 Austrian Trade Mark Protection Act (1970)

Conditions for protection

An unregistered TM must have acquired a certain recognition in the course of trade ('Verkehrsgeltung') before the owner of a subsequent (registered) TM applied for registration of its TM, unless the owner of the subsequent (registered) TM has used its TM in trade without registering it for at least as long as the owner of the unregistered TM.

Rights conferred (a) and conditions (b)

- (a) Right to apply for cancellation of a subsequent (registered) TM.
- (b) The owner of the unregistered TM must not have tolerated use in trade of the subsequent registered TM during five successive years ('Verwirkung'). This applies only to those goods and/or services for which the registered trade mark

was used and only if the application for the registered trade mark was not filed in bad faith. Likelihood of confusion must be found.

## **18.2 Other signs used in the course of trade**

§ 32 Austrian Trade Mark Protection Act (1970)

§ 9 of the Federal Act Against Unfair Competition (1984)

**Corporate signs ('Unternehmenskennzeichen'), i.e. names, firms (trade names) ('Firma') or specific designations of an undertaking ('besondere Bezeichnung eines Unternehmens'), or similar designations**

### Conditions for protection

The entrepreneur must be the owner of the corporate sign(s).

### Rights conferred (a) and conditions (b)

- (a) Right to apply for cancellation of a subsequent (registered) TM.
- (b) The entrepreneur must not have tolerated use in trade of the registered TM during five successive years ('Verwirkung'). This applies only to those goods and/or services for which the registered trade mark was used and only if the application for the registered trade mark was not filed in bad faith. Use of the trade mark could entail a likelihood of confusion in trade with one of the petitioner's aforementioned corporate signs.

**Business signs ('Geschäftsabzeichen') and other facilities designed to distinguish the enterprise from other enterprises including the get-up or packaging of goods or the presentation of business stationery**

### Conditions for protection

The business signs must be perceived as designations of the enterprise by the market participants involved or have acquired such recognition through use ('Verkehrsgeltung').

### Rights conferred (a) and conditions (b)

- (a) [Only] the right to sue the infringer to cease and desist [from such action] as well as to claim damages if the infringement was carried out with intent or in a negligent way. [In addition to the above, with registered TMs the owner also has the right to sue for cease and desist [use of its TM] and to claim damages before a civil court.]
- (b) The entrepreneur must not have tolerated use in trade of the registered TM during five successive years ('Verwirkung'). This applies only to those goods and/or services for which the registered trade mark was used and only if the application for the registered trade mark was not filed in bad faith. The trade mark

must be used in such a way that it is likely to be confused in trade with one of the entrepreneur's business signs.

## 19 Poland

### 19.1 Unregistered trade marks

Article 132(1)(ii) PL-IP Law

#### Conditions for protection

Unregistered trade marks (TMs) are protected only if they are well known and used in the course of trade.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) Unregistered TM must be well known and used in the course of trade; likelihood of confusion.

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

### 19.2 Other signs used in the course of trade

Article 131(1), (5) PL-IP Law

Article 156(1)(i) PL-IP Law, Article 158(1) PL-IP Law

#### **Name or address under which a person runs his business activity**

#### Conditions for protection

Name under which a person runs their business activity.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit the filing of a trade mark.

- (b) There must have been prior use of the name for business activity for identical or similar goods such as to be likely to mislead the public as to the origin of the product.

## 20 Portugal

### 20.1 Unregistered trade marks

The following unregistered trade marks (TMs) are protected in Portugal.

#### **Unregistered TMs that are being used**

Article 227 PT-IP Code

#### Conditions for protection

The unregistered TM must have been used in Portugal during the six months prior to the filing of an application for registration.

#### Rights conferred (a) and conditions (b)

- (a) Right to oppose registration of the same trade mark by other entities.
- (b) The signs and the goods and/or services must be the same.

#### **Well-known marks**

Article 241, PT-IP Code

#### Conditions for protection

The mark in question must be well known in Portugal.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) The signs must be identical or similar and the goods and/or services identical or similar; likelihood of confusion or association with the holder of the earlier right must be established; the interested party must have applied for registration of the well-known mark.

#### **Prestigious trade marks**

Article 241 PT-IP Code

Conditions for protection

The mark in question must enjoy prestige in Portugal.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) The signs must be identical or similar or, even if the goods and services are dissimilar, use of the trade mark applied for must be likely to take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier prestigious trade mark; the interested party must have applied for registration of the prestigious trade mark.

## **20.2 Other signs used in the course of trade**

### **Trade names, company names**

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

Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) The name in question must be likely to mislead or confuse the consumer.

### **Logotypes (name and emblem/insignia of an establishment)**

(Word and figurative signs identifying an entity trading products or providing services)

Article 304-N PT-IP Code

Conditions for protection

The sign in question must be registered.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent signs.
- (b) The proprietor must not have given its consent, and the subsequent sign must be identical or similar to the proprietor's sign.

## 21 Romania

### 21.1 Unregistered trade marks

As a general rule, unregistered trade marks (TMs) are not protected under Romanian TM Law (Law No 84/1998 on trade marks and geographical indications). As an exception to that rule, in the case of an opposition, an unregistered trade mark may be regarded as an earlier right if it is well-known in Romania within the meaning of Article 6bis of the Paris Convention).

Article 3(d) and Article 6(2)(f) of the RO-IP Law

#### Conditions for protection

The unregistered TM must be well known in Romania within the meaning of Article 6bis of the Paris Convention.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) It must be well-known in Romania and there must be a likelihood of confusion.

### 21.2 Other signs used in the course of trade

Other signs used in the course of trade that are considered to be earlier rights are **trade names**.

Only the owner of a trade name, can oppose a trade mark or request the competent judicial body to cancel that trade mark.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks. Only the owner of a trade name can oppose a trade mark or request the competent judicial body to cancel that trade mark right.
- (b) Prior use on the market.

## 22 Slovenia

### 22.1 Unregistered trade marks

Unregistered trade marks are not directly recognised under the Slovenian IP Act.

Nevertheless, under Article 44(1)(d) SL–IP Act, a sign is not eligible for registration as a mark if it is identical or similar to a mark or unregistered sign; in the Republic of Slovenia, the latter is regarded as a **well-known mark** within the meaning of Article 6bis of the Paris Convention.

## 22.2 Other signs used in the course of trade

Article 44(1)(f) SL–IP Act

**Registered trade names (registered company names)**, where the term ‘company name’ is interpreted broadly and covers not only private companies such as private firms, limited liability companies, other commercial companies, and secondary trade names, but also foundations, unions, associations, museums and public institutions.

## 23 Slovakia

### 23.1 Unregistered trade marks

Article 7(f) SK-TML

Unregistered marks are defined as non-registered signs acquired and used in the course of trade prior to the filing of a subsequent application. They must be distinctive and of more than mere local significance.

#### Conditions for protection

The unregistered mark must have been used earlier in the course of trade of more than mere local significance and must have acquired distinctiveness through use in the course of trade in the territory of the Slovak Republic of more than mere local significance prior to the filing of the contested application.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) Signs must be identical or similar and must cover identical or similar goods and/or services

### 23.2 Other signs used in the course of trade

Article 7(f) SK-TML

Trade names and other related signs.

Conditions for protection

Recordal in the Register of Companies or a similar register.

These signs must have acquired distinctiveness through use in the course of trade in the territory of the Slovak Republic of more than mere local significance prior to the filing of the contested application.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) Signs must be identical or similar and must cover identical or similar goods and/or services..

## 24 Finland

### 24.1 Unregistered trade marks

Unregistered trade marks are protected in Finland:

§ 1, § 2(3), § 6, § 14(1), (6) of the Finnish Trade Mark Act (FI-TML)

Conditions for protection

Use leading to an unregistered mark becoming established on the market. A mark is 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 and/or services.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit use of subsequent (registered) trade marks.
- (b) The scope of protection is identical to that of a Finnish registered trade mark, i.e. corresponding to Article 9(1)(a), (b) and (c) CTMR.

### 24.2 Other signs used in the course of trade

§ 1, § 2(2), 3(2), § 6, § 14(1), (6) FI-TML

**Trade names** (*toiminimi, firma*: any name that a natural or legal person uses in business activities), including **secondary trade names** (*aputoiminimi, bifirma*: natural or legal persons can carry out part of their business under a secondary trade name) and **secondary symbols** (*toissijainen tunnus, sekundärt kännetecken*: signs, including figurative signs, used in the course of trade).

Conditions for protection

Use leading to a trade name becoming established on the market.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) The signs must relate to identical or similar goods and/or services and there must be a likelihood of confusion.

**Trader's name**

§ 1, 6, § 14(1), (6) FI-TML

Rights conferred (a) and conditions (b)

- (a) Right to prohibit subsequent trade marks.
- (b) The signs must relate to identical or similar goods and/or services and there must be a likelihood of confusion.

## **25 Sweden**

New Swedish Trade Marks Act (2010:1877)

### **25.1 Unregistered trade marks**

Chapter 1, Article 7 and Chapter 2, Article 8 SE-TMA

Conditions for protection

The unregistered trade mark must have been used in such a way that it has become established on the market.

Rights conferred (a) and conditions (b)

- (a) The same as for registered trade marks: right to prohibit the use of subsequent trade marks.
- (b) A mark is considered to have become established on the market when it is, within a significant portion of the circle for which it is intended, known as a symbol for the goods being made available under it.

## **25.2 Other signs used in the course of trade**

### **Trade names/Company names**

Chapter 1, Article 7(1); Chapter 1, Article 8; Chapter 2, Article 9 SE-TMA

#### Conditions for protection

The name must be registered as a company name or used in such a way that it has become established on the market. May be limited to the part of the country in which it is established on the market.

#### Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) There must be a likelihood of confusion and the signs must cover identical or similar goods and services.

## **26 United Kingdom**

General note for unregistered signs: passing off is not in any way a 'proprietary right' that 'protects an unregistered trade mark or other sign used in the course of trade'. It refers rather to a 'wrongful invasion' of a property right, but the property protected in this case is the goodwill and reputation of a business that is likely to be harmed by misrepresentation. Whether, e.g., an opposition based on Section 5(4)(a) is successful will, then, depend on a number of cumulative factors: (demonstration and scope of goodwill; misrepresentation, damage to goodwill). On that basis, any distinction between 'protection' given to 'unregistered trade marks' and to 'other signs used in the course of trade' in the context of the UK's common-law right of 'passing off' is meaningless. The right of 'passing off' could potentially (and more often than not does) arise purely at local level (relative to the UK as a whole). (See below, 'The particularities of the action of passing off').

### **26.1 Unregistered trade marks**

Unregistered trade marks used in the course of trade

Section 5(4)(a) UK-TMA

#### Conditions for protection

Must be used in the course of trade if protected by any rule of law, including that of passing off.

Rights conferred (a) and conditions (b)

- (a) Right to prohibit the use of subsequent trade marks.
- (b) **Goodwill** must be demonstrated in the UK at the relevant date, the scope of which **must extend to the goods or services** of the application; **misrepresentation as regards the 'signs'** at issue; **damage to the opponent's goodwill** can be inferred by use of the sign applied for.

## 26.2 Other signs used in the course of trade

Section 5(4)(a) UK-TMA

Sign used in the course of trade.

Sign used in the course of trade, protected by any rule of law, including that of passing off.

Conditions for protection

Same as under Section 26.1.

Rights conferred (a) and conditions (b)

Same as under Section 26.1.

*Remarks:* The Olympic Symbol Protection Act 1995 contains provisions on the exclusive use for commercial purposes of the Olympic symbol and certain words associated with the Olympic games by an individual nominated by the Secretary of State; such entitlement is not a basis for Article 8(4) CTMR.

### The particularities of the action of passing off

Passing off is an economic tort in the common-law jurisdictions, the essential elements of which are (i) a misrepresentation (ii) causing damage to (iii) the goodwill of a trader or traders. It is a form of intellectual property enforcement against unauthorised use of an intellectual property right.

The purpose of this section is not to analyse the substantive requirements of passing-off actions as developed by the jurisprudence of the common-law courts but rather to set out which rights that can be protected by passing-off actions fall within the scope of Article 8(4) CTMR, and to show how the European judicature has applied the key requirements of Article 8(4) CTMR as regards passing off.

Historically, and in their most common form, passing-off actions offer protection similar to that for registered trade marks to non-registered trade marks in that they prevent use of a name, word, device or get-up that leads to the goods or services of one trader being misrepresented as those of another. In doing so, passing-off actions protect the goodwill that traders accrue by using signs rather than protecting signs per se.

The tort of passing off covers a broad set of situations ranging from its usual form above to an extended form which may prevent the use of generic terms where such use misrepresents goods or services as possessing a characteristic or quality that they do not have (e.g. Vodkat used on a type of drink that is not Vodka).

In passing-off actions, the opponent (claimant) must prove three elements, the so-called classical trinity:

- (a) **goodwill** attached to the goods or services that it supplies;
- (b) **misrepresentation** by the defendant to the public (intentional or not) leading or likely to lead the public to believe that the goods or services offered are those of the opponent (claimant);
- (c) **damage** (actual or potential) by reason of the erroneous belief engendered by the defendant's misrepresentation.