



Promoting Intellectual
Property Rights in the
ASEAN Region

Topic 6: Case study presentation

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Case 1

Case 1

- Two-person Spanish company applied for an **EUTM** covering *environmental audit*
- **Opposed** by a large multinational energy company providing *energy services* (including environmental audit for the provision of energy)
- Opposition based on a number of **earlier rights** at international, EU and national level.
- EUTM applicant filed **cancellation actions** against all the earlier rights.

Case 1

- **Infringement proceedings** commenced against EUTM applicant in Spain and in a number of other countries where the company had national registrations.
- Series of **cross-actions** all over EU and beyond both in IPOs and Courts
- Significant legal fees incurred

Case 1

- Failed negotiations
- Final attempt to settle
- Important imbalance in legal representation (David v Goliath)
- Red lines and authority
- Emotional stress

Case 1

- Kamikaze mode
- Defensive marks and purchase option
- Drop hands
- Lump sum (amount)
- Heads of agreement + timeline



Case 2

Case 2

- Conflict between two EU SMEs in the manufacturing sector
- Company A filed EUTMs at EUIPO
- Opposed company B on basis of company name
- Overlapping element descriptive

Case 2


- Both companies had various national registrations
- IPO proceedings in national offices
- Companies A and B wanted worldwide solution

Case 2

- Company A represented by three trade mark attorneys and two in-house lawyers. CEO only partially present + interpreter
- Company B represented by external counsel and CEO
- ‘You started it!’ syndrome
- Company A: problematic trade mark attorneys and disengaged CEO

Case 2

- Company B: frustrated CEO
- Separate the people from the problem – putting the CEOs together (WATNA)
- Point by point negotiation: trade mark proceedings, use of company name, packaging, trade fairs, etc
- Coexistence agreement: (communication channels, applicable law and jurisdiction, penalty clause)



Q&A



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