



# Protection of Non-Registered Trade Marks and Other Signs Used in the Course of Trade- Article 8(4) EUTMR

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# 1. ARTICLE 8(4) EUTMR

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*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 Union legislation or 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 EU trade mark, or the date of the priority claimed for the application for registration of the EU trade mark;*

b) *that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.*

## 2. PURPOSE AND SUBJECT MATTER OF THE PROVISION

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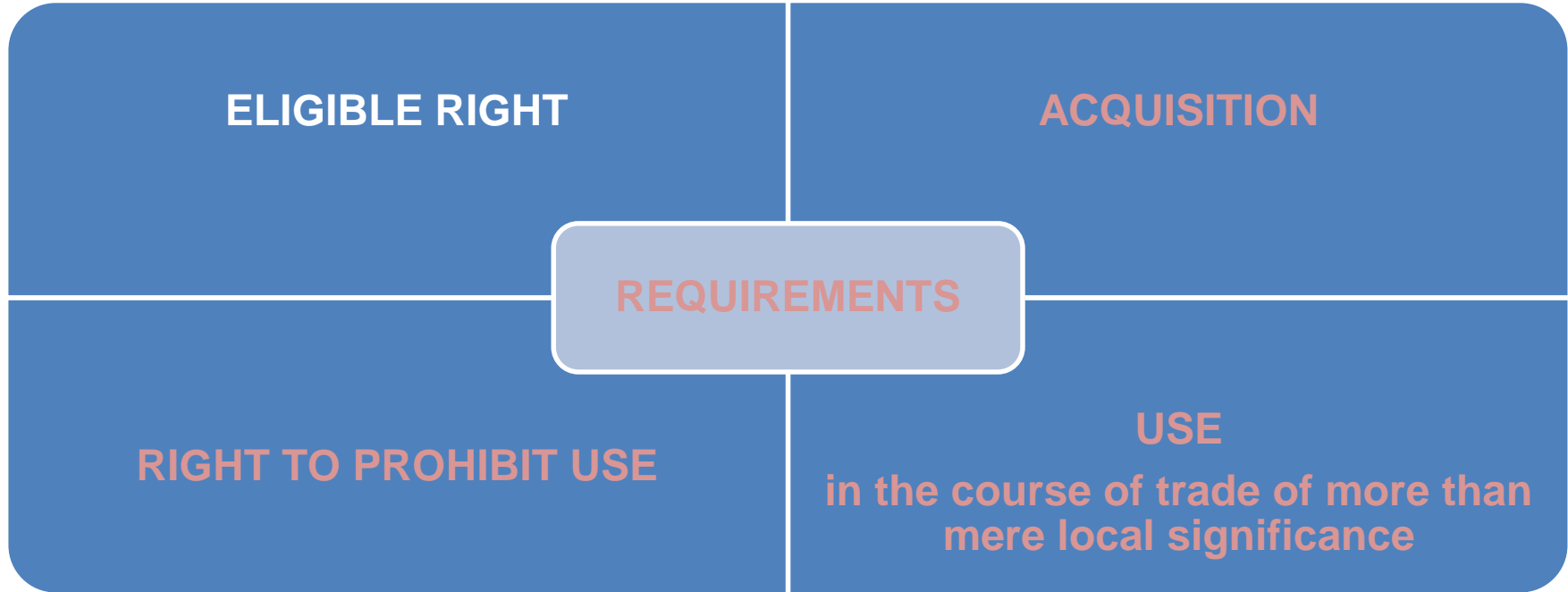
- safeguards a **wide variety of IP rights** (other than registered trade-marks)
- **protection in accordance with the function of the relevant IP right** (as defined in the applicable law, not in the EUTMR)
- unlike in other grounds of opposition, **the harm, injury, damage against which protection is granted not provided** in the EUTMR – framework provision: refers to the **applicable law**

### 3. REQUIREMENTS OF ARTICLE 8(4) EUTMR- Cumulative

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- **3.1.ELIGIBLE RIGHT-** a non-registered trade mark or another sign used in the course of trade
- **3.2.ACQUISITION** of the earlier right- under the applicable law governing that sign
- **3.3.USE** - in the course of trade of more than mere local significance
- **3.4.RIGHT TO PROHIBIT USE-** of the contested sign under the applicable law

### 3. REQUIREMENTS OF ARTICLE 8(4) EUTMR



## 3.1. ELIGIBLE RIGHTS

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- **non-registered trade marks (only in some MS and not at EU level)**
- **‘other’ signs used in the course of trade (registered or not registered)**
  - **not defined – but they must be signs that identify a business: trade signs/business identifiers**
- **a sign of more than mere local significance: the geographical extent (territorial scope) of its protection must not be merely local (29/03/2011, C-96/09 P, ‘Bud’, § 156;159)**

## 3.1. ELIGIBLE RIGHTS

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### Examples of eligible business identifiers (subject to the conditions of the applicable law):

- trade names
- company names
- names of establishment or store names
- domain names
- titles of publications or similar works
- signs protected by the law of passing off
- others



## 3.1. ELIGIBLE RIGHTS- Non-registered trade marks

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- **Non-registered trade marks** exist in a number of the Member States and are signs that indicate the commercial origin of a product or service.

**Example:**

**GLADIATOR Vs GLADIATOR**

**R 1529/2010-1 (non-registered trade mark in the Czech Republic)**

## 3.1. ELIGIBLE RIGHTS- Company names

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- **Company name** is the official designation of an undertaking, in most cases registered in the respective national commercial register.

**Example:**

**MARIONNAUD PARFUMERIES Vs MARIANNA**

**R 21/2011-1 (French company name ‘MARIONNAUD PARFUMERIES’)**

## 3.1. ELIGIBLE RIGHTS- Trade names

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- **Trade names** are the names used to identify businesses and are protected in all Member States

**Under Article 8 of the Paris Convention- trade names enjoy protection without any registration requirement:**

*‘A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark’.*

## 3.1. ELIGIBLE RIGHTS- Trade names

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**Example:**

**JAMÓN DE HUELVA**

**Vs**



**R 1714/2010-4 (Spanish trade name)**

*‘a trade name is a sign or designation that serves to identify a physical or legal person in the course of their commercial activity’*

## 3.1. ELIGIBLE RIGHTS- Domain names

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### ➤ Domain names:

- internet addresses, registered with organizations called ‘domain name registrars’
- domain name registration per se is not an IP right
- protection obtained through use of the domain name as a non-registered trade mark or a trade sign identifying commercial origin under the applicable national law.

## 3.1. ELIGIBLE RIGHTS- Domain names

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Example:

lucky-pet.de

Vs



Happy Pet

R-275/2011-1 (German domain name 'lucky-pet.de')

## 3.1. ELIGIBLE RIGHTS- Titles of works

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- **Titles of works (films, television series, magazines and other publications):**
  - **only if, under the applicable national law, they are protected as a trade sign identifying commercial origin**
  - **independent from the protection recognized by copyright law**

**Examples:** 30/06/2009, T-435/05, Dr. No, EU:T:2009:226 (film title ‘Dr. No’)  
12/01/2012, R 181/2011-1 (German magazine title ‘ART’)

## 3.1. ELIGIBLE RIGHTS-EXCEPTIONS

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**IP rights that are NOT business identifiers and cannot be invoked under Article 8(4) EUTMR:**

- copyright
- right to name
- right to personal portrayal
- other industrial property rights (e.g. designs, patents)



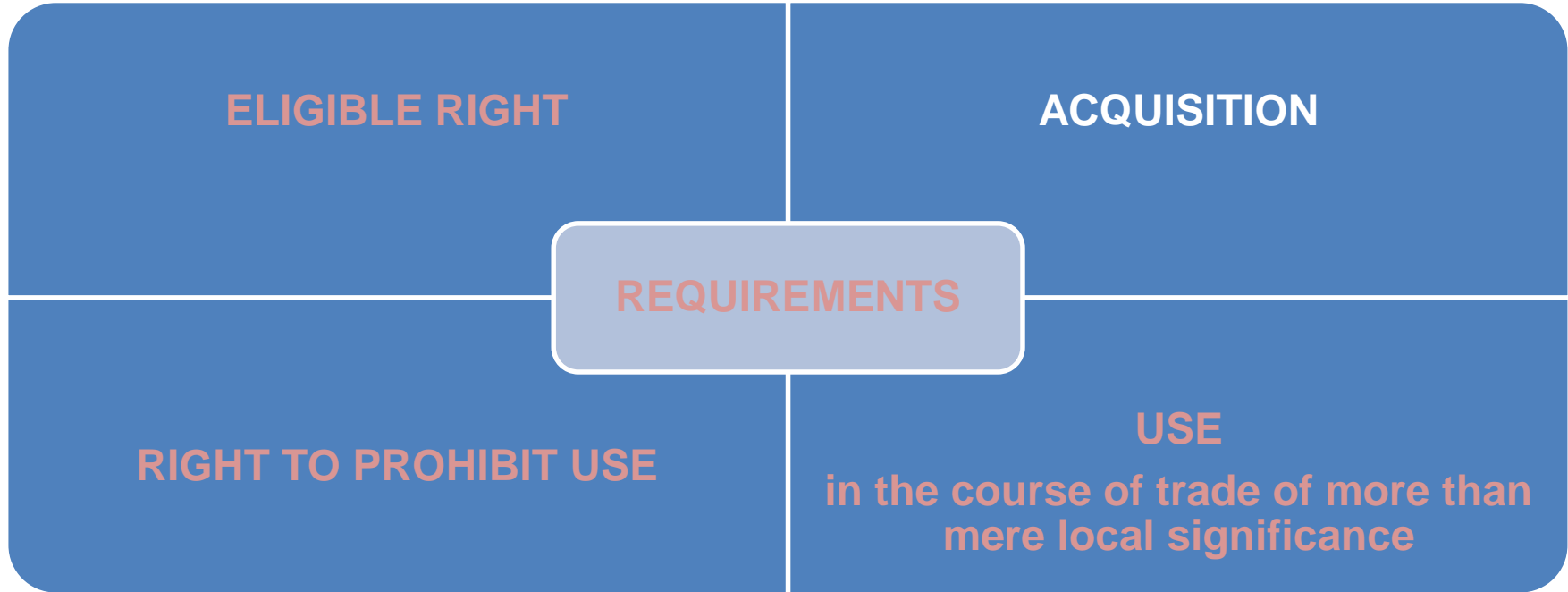
## 3.1. ELIGIBLE RIGHTS- EXCEPTIONS

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### Dr. NO vs Dr. No ([T-435/05](#))

- **Film title** (in the ‘James Bond’ series)
- use of the sign Dr. No on the cover of video cassettes or DVDs indicates the **artistic origin** of the film, but not the commercial origin
- the **commercial origin** is indicated by other signs- ‘007’ or ‘James Bond’, affixed to the covers of the goods
- **copyright is not a business identifier** and cannot be relied on in opposition proceedings

# REQUIREMENTS OF ARTICLE 8(4) EUTMR



## 3.2. ACQUISITION-of the earlier right under the applicable law

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The opponent has to prove:

- **entitlement to a right earlier than the EUTMA,**
- which right is **acquired under the conditions of the applicable (national) law;**
- **the provisions of the applicable (national) law, governing those conditions.**

## 3.2. ACQUISITION-Entitlement to an earlier right

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Who is **entitled** to oppose?



**Article 46(1)(c) EUTMR and Article 2(2)(h)(iii) EUTMDR:**

- **proprietor**
  - e.g. company name: the company itself
- **person authorised** under the applicable law to exercise the right
  - e.g.: licensee

## 3.2. ACQUISITION-Entitlement to an earlier right

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### Individual, direct right of action

- **The opponent must be conferred with an individual, direct right of action, i.e. can sue for infringement for unauthorised use.**
- **Entitlement is not sufficiently proven, if the opponent cannot prove to hold an exclusive right that he can enforce against infringing use.**
- **Irrelevant, if the sign is generally protected against e.g. misleading use under consumer protection laws of a Member State. If the earlier right lacks any 'proprietary quality', it will not fall within Article 8(4) EUTMR.**

## 3.2. ACQUISITION-Conditions of the acquisition of the right

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The opponent must provide the Office with information about the **conditions** of the applicable law




**WHY?**

- EUTMR does not regulate these rights
- burden of proof lies with the opponent

## 3.2. ACQUISITION- Fulfilment of the conditions

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### How does the opponent prove the acquisition of the earlier right?

- If registration required –proof of registration (e.g. certificate) 
- If use required- proof of use according to the applicable standards 
- If reputation required- proof of the recognition of the sign according to the applicable law 

## 3.2. ACQUISITION-Date of acquisition

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- Date of acquisition of the **earlier right** must be earlier than the filing (priority) date of the EUTMA
- Date of acquisition of the earlier right to be determined in accordance with the relevant **national law**
- If registration sufficient – registration (or priority) date, if mere use sufficient, date when use began, if recognition in trade or reputation required, they have to be shown before the relevant date

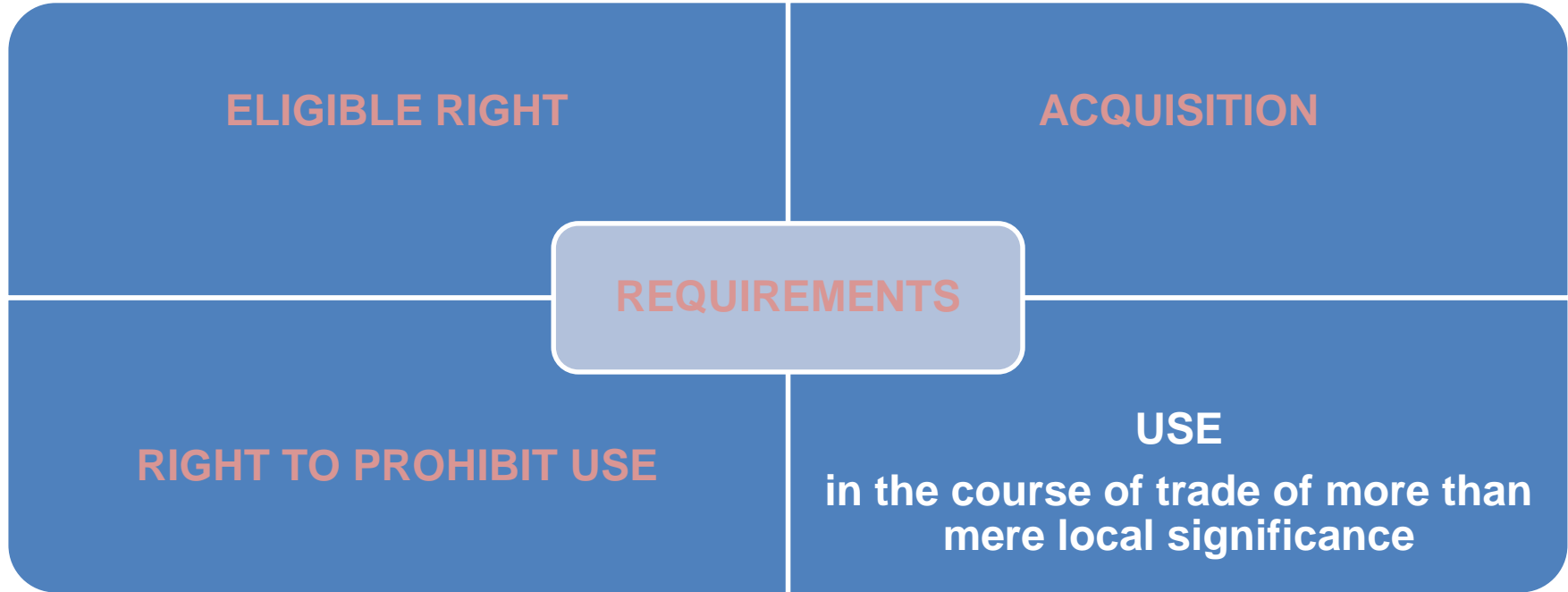


## 3.2. ACQUISITION- Examples

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- acquisition of a **company name** under **Estonian law** requires registration
- acquisition of a **non-registered trade mark** under **Bulgarian law** requires use in the course of trade in the territory of Bulgaria
- acquisition of a **non-registered trade mark** under **German law** requires a certain degree of recognition among the relevant public

# REQUIREMENTS OF ARTICLE 8(4) EUTMR



### 3.3. USE- in the course of trade of more than mere local significance

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*“It must be recalled that the object of the condition laid down in Article 8(4) of Regulation No 40/94 relating to use in the course of trade of a sign of more than mere local significance 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 [European Union] trade mark. [...]”*

(22/01/2013, joined cases T-225/06 RENV, T-255/06 RENV, T-257/06 RENV and T-309/06 RENV, ‘Bud’, § 47)

### 3.3. USE- in the course of trade of more than mere local significance

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**European requirement** of ‘use in the course of trade of more than mere local significance’- the sign must have been used, irrespective of national law requirements

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**possible national use requirement** for the acquisition of a right under national law

### 3.3. USE- in the course of trade of more than mere local significance

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➤ **Nature:**

- **must be used in accordance with the function of the earlier right in question (e.g. as a company name identifying a business) AND must be used as a distinctive sign (since it must meet the condition of ‘business identifier’)**
- **must relate to the goods or services or business activity indicated in the notice of opposition**
- **must relate to the sign indicated in the notice of opposition**

### 3.3. USE- in the course of trade of more than mere local significance

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- **Place:** must relate to the relevant territory (and not a territory outside the jurisdiction where the sign enjoys protection)
- **Time:** must be prior to the filing date/priority date
- **Extent:** must be of more than mere local significance

### 3.3. USE- in the course of trade of more than mere local significance

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**EXTENT of use- ‘used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local.’**

(29/03/2011, C-96/09 P, C-96/09 P, ‘Bud’, § 159)

*“As regards the relevant territory, in order to establish that the sign relied on is of more than mere local significance account must be taken, first, 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) of Regulation No 40/94. Account must be taken, secondly, of the economic dimension of the sign’s significance [...].*

(24/03/2009, joined cases T-318/06 to T-321/06, ‘General Optica’, § 37)

### 3.3. USE- in the course of trade of more than mere local significance

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#### ➤ Geographical Extent:

- in the territory in which the sign is used to identify its proprietor's economic activity
- the sign must be used in a substantial part of that territory, its impact should not be confined to a small part of that territory, as is generally the case with a town or a province
- assessment made, according to the circumstances of each case and not in isolation but in correlation with the economic extent of use.



### 3.3. USE- in the course of trade of more than mere local significance

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➤ **Economic Impact of the use of the sign:**

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.


### 3.3. EXAMPLES WHERE USE OF MORE THAN MERE LOCAL SIGNIFICANCE NOT PROVEN

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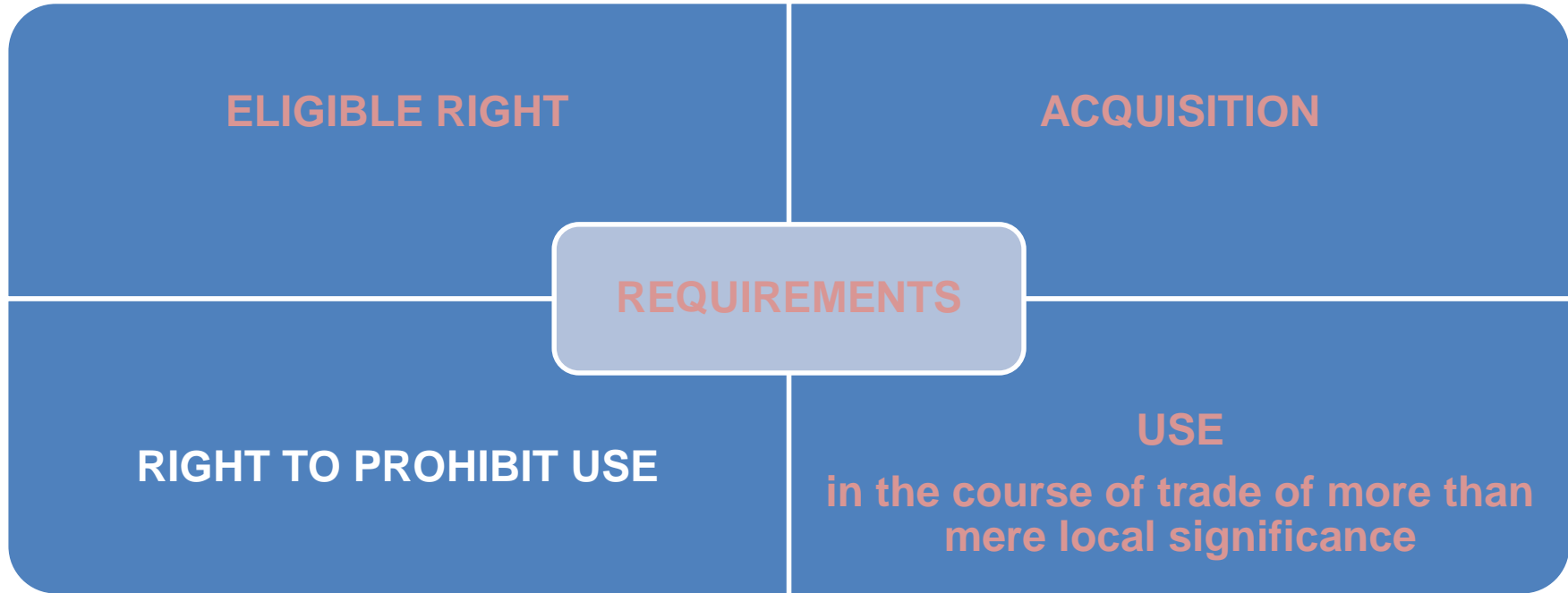
- **Generalóptica (T-318/06–T-321/06):** Portuguese establishment name- a business establishment in Vila Nova de Famalicão, town with 120 000 inhabitants
  
- **BRIGHTON (R 408/2009-4):** non-registered trade mark in several Member States- no sales at all for some years, very low revenue for others, no evidence relating to advertising and promotion

### 3.3. EXAMPLES WHERE USE OF MORE THAN MERE LOCAL SIGNIFICANCE NOT PROVEN

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- **Up Way** (R 274/2012-5): Portuguese company name- 3 invoices, addressed to companies in the Porto region of Portugal, for building materials and building services and for a total sales amount of EUR 16 314
-  **ESKIMO** (R 242/2010-1): Greek non-registered trade mark- invoices for sales under the mark of a little less than 100 units (of household appliances) in four years.

# REQUIREMENTS OF ARTICLE 8(4) EUTMR



## 3.4. RIGHT TO PROHIBIT USE

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- Earlier rights falling under Article 8(4) EUTMR are protected if they confer on their proprietors under the applicable law **the right to prohibit use of a later trade mark.**
- However, this is broadly interpreted – **prohibition of registration is also acceptable (right to prohibit registration implies a fortiori the right to prohibit use).**

## 3.4. RIGHT TO PROHIBIT USE- scope of protection

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### What could be the scope of protection under the applicable law?

- Concepts similar to those applied in conflicts between trade marks under the EUTMR:
  - **likelihood of confusion**- identity/similarity of signs/ goods or services, etc.
  - **damage** to reputation or distinctiveness
- Different concepts (the requirements set in the national law must be fulfilled):
  - **passing off** and the classic trinity: goodwill, misrepresentation and damage

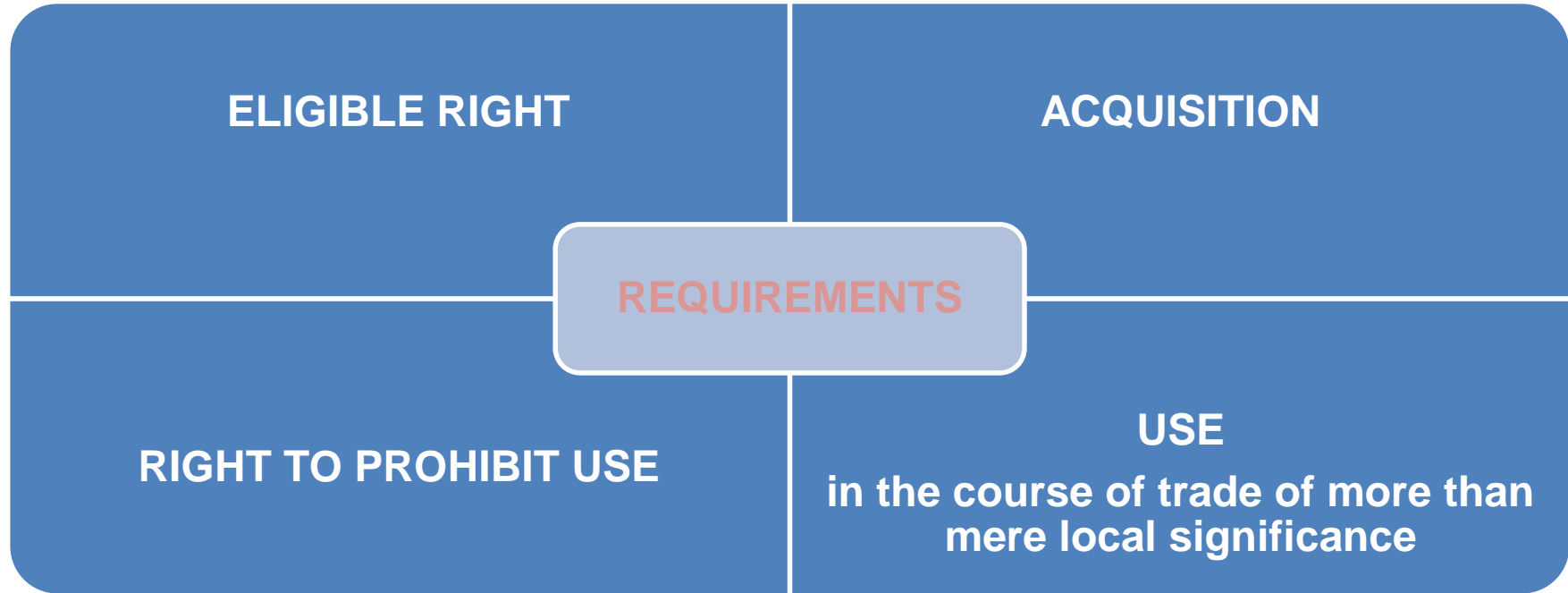
## 3.4. RIGHT TO PROHIBIT USE

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The opponent must prove:

- The **conditions of protection** under the applicable law (proof of the law)
- **Fulfilment** of those conditions- to put forward a cogent line of argument as to why it would succeed in prohibiting the use of the contested mark under the applicable law (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).

## 4. REQUIREMENTS OF ARTICLE 8(4) EUTMR- Re- Cap





## 4. EXAMPLES

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### GLADIATOR Vs GLADIATOR (R 1529/2010-1)

- **Sign:** non-registered trade-mark in the Czech Republic
- **Evidence-** 230 invoices referring to a number of cities in many different areas of the Czech Republic; supporting documents- list of distributors, catalogues, magazines
- **National law:** likelihood of confusion-similar/identical goods and signs
- **Goods-** inter alia, *all terrain vehicles* (ATV) in both signs

OPPOSITION UPHELD

## 4. EXAMPLES



(R 181/2011-1)

- **Sign:** title of a magazine (‘work title’) in Germany
- **Evidence:** inter alia, cover pages of the magazine, **circulation figures** 60 000 to 80 000 copies/ year, information on customer’s profile
- **Market:** niche market for expensive periodicals on cultural matters
- **National law:** **likelihood of confusion**
- **Goods:** inter alia, *magazines* in both signs.

OPPOSITION PARTIALLY  
UPHELD



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