

**Challenges of relying
on foreign law in the
context of Article 8 (4)
EUTMR**



Overview

- I. General aspects
- II. Conditions
- III. Signs used in the course of trade
- IV. Of more than mere local significance
- V. Acquisition of right prior to the CTM application
- VI. Rights arising from the sign relied on

Art. 8 (4) EUTMR:

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 Community 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 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.**

I. General aspects of Article 8 (4) EUTMR

- Taxonomy
 - Principle of coexistence
 - Principle of unity

- Reforms
 - No change of Article 8 (4) EUTMR
 - New Article 8 (4a) EUTMR

- Nature: relative grounds for refusal

- In deciding on an opposition based on Art. 8 (4) the Office must apply both
 - the relevant **provisions of the EUTMR** *and*
 - the **national law** governing the earlier opposing right
 - Office has been afforded a limited degree of own competence of relevant national law (GC, *OHIM v National Lottery Commission*, mn 37)



II. Conditions of Art. 8 (4) EUTMR

1. Signs used in the course of trade
 - a) Use in the course of trade
 - b) Proprietor
 - c) Of a non-registered trade mark or of another sign
 2. Of more than mere local significance
 - a) Significance
 - b) Of more than mere local
 3. Acquisition of right prior to the EUTM application
 4. Rights arising from sign relied on
- NB: fairly **complex provision**

III. Signs used in the course of trade

1. Use in the course of trade

- A specific requirement of EU law
- Requirement:
 - Use in the context of a **commercial activity** with a view to economic advantage
 - **'Continued existence'**
(Rule 19 (2) (d) EUTMIR)
- Partly national law exempts signs from an obligation of continued use
 - nevertheless: a valid basis for opposition proceedings **only with actual use**
(CJEU, *Anheuser-Busch v Budějovický Budvar*, mn 159)



III. Signs used in the course of trade

2. Proprietor

- No uniform definition under national laws
 - The **person authorized under national laws to exercise the relevant right**
 - A **licensee does not have a standing** to file an opposition

III. Signs used in the course of trade

3. Of a non-registered trade mark or of another sign

- 'Non-registered trade marks'
 - Recognition in almost all of the Member States:
e.g. Germany, § 4 Nr. 2 MarkenG
 - No recognition e.g. in Benelux and France

- 'Other signs used in the course of trade'
 - business identifiers (e.g. trade names, corporate names, domain names, titles)
 - geographical indications
 - Excluded: right to a name, right of personal portrayal, copyright, industrial property right, Art. 53 (2) EUTMR (only in invalidity proceedings)
 - In some member states titles of artistic works are protected "as distinctive signs outside the field of copyright" under the respect of national laws
 - qualify as 'other signs' when used as indicator of commercial origin (GC, *Danjaq v OHIM*, mn 42)



IV. Of more than mere local significance

1. Significance

- Addresses the **economic dimension** of the usage of the sign in question (usual parameters e.g. scope, duration, promotion, turnover)
- No 'stiff' thresholds or fixed quantities; **individual circumstances decisive**
- Some guidelines re. significance of use provided by case law
 - OHIM Dec. of 17/3/2011 – *Gladiator*, mn 24: 230 invoices for 'all terrain vehicles' (sold in Czech Rep.) sufficient
 - OHIM Dec. of 1/6/2011 – *Forge de Laguiole*, mn 56: rapid expansion from 5 employees in 1987 to over 100 empl. in 1998 with sales figures of 10 million Euro in 2003 was held to be sufficiently significant
- Advertising catalogues **without evidence on products sold do not suffice**

IV. Of more than mere local significance

2. Of more than mere local

- Geographical dimension of the use of the earlier sign
- used in a **substantial part** of that territory
(CJEU, *Anheuser-Busch v Budějovický Budvar*, mn 159)
- Geographical aspect to be assessed under **individual circumstances**/market conditions
 - 'More than mere local significance' in the meaning of Art. 8 (4) can be found even in cases where national law may require the sign to have been used in the entire territory (GC, *Peek & Cloppenburg v OHIM*, mn 54)
 - Use mainly in one location with costumers in 10 cities across Germany (turnover of only 200,000 DM) held to be of more than local significance (GC, *Granuband v OHIM*, mn 20)
- Viewed in conjunction with **Art. 111 EUTMR**
 - Proprietors of rights of mere local significance: they retain their exclusive rights under the applicable national law **w/o the right to oppose/invalidate** junior EUTM

V. Acquisition of right prior to the EUTM application

(a) Date of acquisition of the earlier right

- Scrutiny under national law
- Prior to the filing date of the contested EUTM application
NB: Seniority claims are of no relevance
- Submission of the evidence that would be likely to convince a court in the relevant member state (e.g. success in an action for passing off)

VII. Rights arising from sign relied on

(b) Conferring the right to prohibit

- application of the respective standards of national law
 - Evaluation, whether the opponent has acquired rights in the sign according to the legal requirements of the member state
(GC, *Tilda-Riceland v OHIM*, mn 21)
- Scope of the information of the applicable law
 - Legal texts allowing the protection of the sign
 - Submission of evidence of relevant case law, commentaries and jurisprudence interpreting the law invoked, **etc.**
 - Burden of proof: opponent

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