

AIPPI Qs and Rs Zurich 16 November 2011

Question Q218 – Final Resolution ExCo Hyderabad 2011

The requirement of genuine use of trademarks for maintaining protection

From the country report to the Final Resolution – The journey is its own reward

The resolution text is not supposed to reflect one's own national law, but rather what the law ought to be based on the experience had with the law in force.

Genuine use = serious use = use for maintaining the mark

2. Use as a mark

Who decides whether a specific form of use is "use as a mark"? The perception of the public? Of the trade? "Sofern der Verkehr die Verwendung konkret als Kennzeichnung versteht" (Federal Administrative Tribunal Decision B-B7487/2010 of 28 June 2011 - "sparco" (fig.)/SPARQ). Is the fulfillment of one of the functions of a trademark relevant? As an adword with Google? Is showing an image of a camel, a cowboy, an apple that's missing a bite use for maintaining the trademark rights?

6. Territory

What about use in another jurisdiction that is treated as use in the territory on the basis of an international treaty? Cf. consideration 9 of the Final Resolution "without prejudice to any applicable international agreement" (e.g. German-Swiss Treaty on use of trademarks; the Benelux Trade-mark Act, the Andean Pact).

What about use in a part of the territory only (decision of Benelux Office for Protection of Intellectual Property/Intellectuele Eigendom en Reclamerecht 2010/29 - ONEL/OMEL; Court of Appeal in The Hague, Case 200.057.983/01, 01.02.2011, available in fr and en on www.boip.int, which has referred four questions to the ECJ Case C-149/11; decision of Hungarian Patent Office of 11 February 2010 - C City Hotel (fig.)/City Inn)?

What about use in Samnaun/Sampuoir (Federal Administrative Tribunal Decision B-7191/2009 of 8 April 2010 - YO/YOG (fig.))? What about use intended for over-the-border shoppers, but not an export mark (YO/YOG (fig.)).

7. Use in the course of trade

Reference to preparations for external use deleted because misleading. Merely preparations for use are irrelevant if they do not lead to actual use before expiry of the grace period. But type and scale of preparations may decide whether actual use is token or bona fide use.

10. Grace period

When does grace period start? When does it end? Or rather from what point is it counted backwards? From written objection of non-use?

Use after expiry of the grace period but before validity of the mark is properly challenged should "cure" the adverse consequences of non-use. Is objection letter a proper challenge? If so, after what period is renewed use relevant for cure?

Repetition mark: Re-filing should be allowed provided it is not in bad faith. Is re-filing with identical list of goods & services always a sign of bad faith?

12. Challenge

No reference to cancellation ex officio/by way of administrative cancellation procedure (cf. Art. 35a E-URG Swissness Project).

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