

Noli IP Newsletter

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Too Good to Be True: The “Genuine Use” Requirement of Community Marks

By Judit Marai and Mariana Noli

Let us imagine this scenario: you have a very strong mark, you have registered it in the U.S., and you are doing well in the local market. Now you are already planning the new step: expanding to new

registration based? Where and how exactly do you have to use the mark to get a registration?

Initiating an application in every single European

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markets in the European Union. Should you file the application in every single country where you are planning to do business? Should you explore other options? What does it mean that the U.S. trademark system is use based, and the European countries trademark systems are

country where you want to be present is always an option, but expect unnecessary work in many cases, and additional expenses. Alternatively, you can file with the OHIM (Office for Harmonization in the Internal Market) one single application to protect your mark as a Community

New Addition: Mr. Raouf Rizk



Raouf Rizk is a U.S. patent licensed attorney with several years of experience in patent prosecution. With his experience in both US and foreign patent prosecution, we believe Mr. Rizk will be a great addition to our team.

Ms. Mariana Noli had the opportunity to work with Raouf for the first time almost five years ago. It is our pleasure to publicly announce that Mr. Rizk has been working with us since February 2015.

Raouf may be contacted at raouf@noli-ipsolutions.com. We are truly excited to announce that Raouf has joined our patent group at NOLI IP SOLUTIONS PC.

Mark. Its most important advantage is that your CTM registration will cover every single one of the member states of the European Union. Yes, all 28 of them in one filing.

As you may know, in the United States there are mainly two prerequisites to register a trademark: (1) the mark has to be distinctive, and (2) it must be used in commerce in the United States. However, the Applicant does have an option to file an application for a trademark without prior actual use of the mark in commerce as an intent-to-use application under Section 1(b). Even if the application is filed with a mere bona fide intention to use the mark in commerce, Applicant will have to prove use to acquire the registration.

In Europe, distinctiveness is still a requirement but the use of the mark in commerce is not a prerequisite to get a registration. In order to keep a trademark registration, the

regulations require "Genuine Use of the Mark." After long discussions, the Court of Justice of the European Union (CJEU) finally clarified the meaning of "Genuine Use" in 2012. For a long time the "Genuine Use Requirement" was interpreted to mean the use of the mark on a wide geographical territory in the EU, however, it was not until 2012 when the CJEU stated that national territorial borders should be disregarded when assessing the "Genuine Use of the Mark" in the European Union. A mark is in "Genuine Use" when it is "used in accordance with its essential function and for the purpose of maintaining or creating market share within the Community for the goods or services covered by it." Reaching the decision, the court must consider the following four (4) factors: (1) the characteristics of the market concerned, (2) the nature of the goods or services protected by the trade mark, (3) the territorial extent and

scale of use, and (4) the frequency and regularity of use. This decision changed the interpretation of the use requirement in Europe which now accepts the use of the mark in a single member state as sufficient if that particular market for these goods and/or services is restricted to that particular country.

From the point of view of the use requirement, Community trademarks are much simpler. "**Genuine Use of the Mark**" is not subject to any official supervision, nor is the mark owner obligated to submit evidence of such use. Just keep in mind that not using the mark could result in the loss of its rights as a result of a cancellation proceeding. Should you have any questions relating to the European Community Trademark, please do not hesitate to contact Judit Marai, our expert in European Intellectual Property Law, by e-mailing her at judit@noli-ipsolutions.com.

Use or No Use? That is the Question

By Luciana Eugenia Noli and Judit Marai

Everybody knows that in order to obtain trademark registration in the United

States, there must be "**Use of the Mark**" in commerce. Regardless of whether you are

applying under **Section 1(a) "Use in Commerce"** or **Section 1(b) "Intent to Use"**

filing basis, you must demonstrate that you have used the mark in commerce prior registration.

There is very simple, difference between these two filing basis. While an Applicant may file under the "**Use in Commerce**" basis if he or she has already used his/her mark in commerce; Applicant must file under the "**Intent to Use**" basis if no use of the mark has been made, but there is an intention to do so in the future. Applicant must have at least a bona fide intention to use the mark in commerce. This *Bona Fide Intention* means that you have more than just an idea, however, you are still less than market ready, for example, having a business plan, creating samples products, or performing other initial business activities.

Section 1(a) contemplates the "**Actual Use**" situations. To proceed under this filing basis, Applicant must be able to provide proof of use of the mark in the U.S. at the time of filing. One of the benefits of proceeding under the Section 1(a) basis is that no further filings, other than addressing office actions and/or oppositions, will be necessary

since the use of the mark is proved at the very beginning of the process.

An "**Intent to Use**" application filed under Section 1(b) basis requires filing an additional form and payment of a fee prior to registration. "Use of the Mark in Commerce" is not required at the outset, however, use will be established before the trademark is registered by providing the date of first use of the mark anywhere and in commerce, as well as submitting a specimen (example) showing how you use the mark in commerce.

According to the U.S. trademark law, an application can have multiple classes of goods and/or services, each with its own filing basis. Even within the same class number, you could have different filing basis. As an example in class 25 for clothing items, you can file sweaters as Actual Use and shirts as Intent to Use. The types of commerce contained in this definition are interstate, territorial, and between the United States and a foreign country.

Under certain international agreements, you may file in the U.S. based on a **foreign**

application (Section 44d), foreign registration (Section 44e), or international registration (Section 66a).

Under **Section 44(d)**, a "**Foreign Application**" may be used as a basis for filing in the U.S. Thanks to the famous Paris Convention, you can also claim priority to a previously filed foreign application when the US case was filed within six (6) months. If the foreign registration fails, the 44(d) filing basis may be substituted with 1(a) or 1(b) basis.

At any time after a foreign trademark has registered, the "**Foreign Registration**" can be used as the basis of a US filing under **Section 44(e)**. Just like a Section 1(a), proof is required at the time of filing, but instead of proving use, it requires the foreign registration certificate. Having a foreign registration does not automatically guarantee U.S. registration because the mark is still examined by the U.S. trademark examiner and it may be rejected due to prior U.S. filings.

However, the main advantage of the Section 44(d)/44(e) approach is that use of the

mark in the US to get initial registration is not needed.

Last but not least, there is a “**Madrid Protocol**” or a **Section 66(a)** filing basis which applies when you have filed an Extension of Protection under the Madrid Protocol in the United States.

We believe it is always good to know your options. After studying these differences, you can decide which one is the right filing basis for your particular trademark application.

We encourage our clients to explore all the choices available to them at the time of filing to avoid unnecessary

hurdles and delays at the end of the registration process.

Please feel free to contact our office at mail@noli-ipsolutions.com should you have any questions when contemplating the registration of your trademark. We are here to help.

INNOVATION: Workshop at Startup Chile

During a recent business tour in South America, Ms. Mariana Noli gave a seminar on “How to Do Business in the USA” to several start-ups, which was held at the Startup Chile Office at the Movistar InnovaChile on Monday February 23, 2015 in the city of Santiago, Chile. For more information on the work of this organization, please visit: <http://www.startupchile.org/>



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