

Noli IP Newsletter

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Trademarks Under the 12 Stars: Comparison Between the EU and US Trademark Laws

By Judit Marai

A few months ago, Mariana Noli, the lead attorney and heart of our firm connected me with her respected colleague, and the Vice-Chair of the International Interest Group of the State

the European Union and the United States.

During the presentation, I attempted to show that the seemingly similar systems have a few very

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Bar of California, who offered me the opportunity to hold a presentation to the California Bar members. The topic was obvious knowing my background: a comparative analysis from the trademark point of view between the two jurisdictions I have had practical experience with:

important differences. I also drew it to the audience's attention that the whole European system got an "update" a few months ago in March: with an amendment to the 207/2009 Regulation, besides other deep changes, even the Office and the trademarks got

INTA Leadership Meeting in Hollywood, FL

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INTA is a global association of trademark owners and professionals dedicated to support trademarks and related IP rights to protect consumers and promote fair and effective commerce.



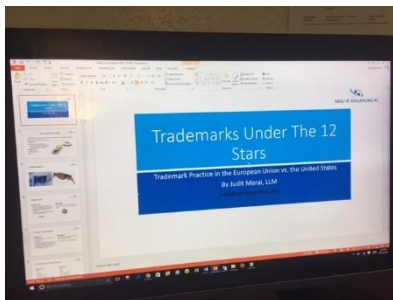
Once a year, INTA has a leadership meeting only members of all working committees and project teams gather together to contribute to the advancement of the organization's objectives. Ms. Mariana Noli was selected as part of the law firm committee for the 2016-2017 term and had the opportunity to attend this meeting. We thank Ms. Noli and our colleagues for their work in this organization.

new names: European Union Intellectual Property Office and European Union Trademark, leaving the OHIM and CTMs behind.

One big difference between the two systems we can notice easily is the language of the trademark processes. Similar to the legal background where the office has to reach out to the national legislations besides the European Union regulations to be able to perform the proper examination, the official national languages come in play all the time. The 28 member states of the European Union uses 24 official languages, and all the 24 languages can be used during the trademark process, until the trademark owner chooses one of the 5 office languages (English, Spanish, French, German and Italian) as the first or the secondary language.

Other surprising distinction is the differentiation between absolute and relative grounds for refusal. While the office examines

the absolute grounds for refusal ex officio, the relative grounds need to be raised by a third party as an opposition. It is actually surprising because the most common ground for refusal in the United States system, the likelihood of confusion is among the relative grounds, along with conflict with a mark with reputation or a non-registered mark and when the filing happened by an unauthorized representative.



The difference between the use requirement in the European Union makes the process a lot faster. Since the applicant is not required to show use of the mark on the marketplace, the mark gets registered a lot faster. Moreover, the owner of the mark has a 5-year protection (grace period) without the

necessity of using the mark. During this time, no one can challenge the mark based on lack of use. At the end of this period or at renewals, the owner is still not required to prove use of the mark, unless a third party challenges the mark due to non-use in a cancellation procedure. So while the mark becomes incontestable in the U.S., a EUTM becomes more vulnerable after 5 years.

These are the biggest differences, but there are other ones as well, like the fact that no disclaimer is possible to file to overcome the descriptiveness refusal, or seniority that allows marks to stay alive when the base national registration lapses. If you are interested in further and more detailed differentiation, or you have a specific question about the European Union system, please do not hesitate to contact me at judit@noli-ipsolutions.com.

New Resolution 56/2016 in Argentina: “The Fast Track Examination”

By Luciana Noli

The resolution No. 56/2016 issued by the Argentine Patent and Trademark Office (ARPTO) is now in force. According to its terms, the National Patent Administration (ANP) has to consider approved as done the international search of antecedents when the priority invoked under the terms of Section 4 A1 of the Paris Convention has been granted by a foreign Office with similar patentability standards. This provision also applies if no priority is claimed but there is proof that a patent has been granted for the same invention after the date of

filing the application in Argentina.

For this resolution to apply, the scope of the claims in the Argentine application cannot be broader than the scope of the foreign patent granted claims.

The advantage is that the owner of a pending patent application may voluntarily submit, prior to the substantive examination report, a petition for the application of this Resolution to the case. Applicant should accompany the adjusted claims translated into

Spanish with a copy of the claims of the granted patent. The petition for application of this resolution will be made by means of a special Form. The Argentine Patent Office is required to issue its decision within sixty (60) days of filing of said petition.

For more information about the Patent Prosecution Highway (PPH) in Argentina and the implications of the new resolution 56/2016, please contact me at luciana@noli-ipsolutions.com.

CONSENT OR NOT TO CONSENT: THAT IS NOT THE QUESTION *In re. Bay State Brewing Company, Inc.*

On February 25, 2016, the TTAB (Trademark Trial and Appeal Board) issued a decision not to allow registration of the mark TIME TRAVELER BLONDE for “beer” in International Class 32 because of the previously registered mark TIME TRAVELER for “beer, ale and lager” in the same class. The registration of both of these marks was likely to cause confusion among customers.



Regardless of the execution of a consent agreement between the parties, the TTAB found that the specific consent agreement in this case was outweighed by the other relevant likelihood of confusion factors, namely that the marks are virtually identical, and the goods, trade channels and purchasers are identical.