

# Noli IP Newsletter

NOLI IP Solutions, PC

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## *Andean Community Trademark Registration: Does Title Mean Entitled?*

*By Luciana Noli and Monica Hernandez*

While handling a trademark matter before the Colombian Patent and Trademark Office, we received an office resolution refusing registration of one of our clients' trademark due to the

certificate had been issued for that mark by the Trademark Office, so can a sign become a trademark without use of the mark?

As some of you may know,

*"...the Andean Community, conformed by Colombia, Ecuador, Peru and Bolivia, was developed with the aim to promote the expansion of markets and guarantee an effective economic development to the region and it created the 486 Decision for establishing the common industrial property regime."*

existence of a previously registered trademark considered similar to our client's. As a result, we conducted an investigation and discovered that the previously registered trademark referenced by the Examiner as a blocking citation to our client's mark was not in use in commerce in the Andean region, in fact, it has never been used in the market. A registration

the Andean Community, conformed by Colombia, Ecuador, Peru and Bolivia, was developed with the aim to promote the expansion of markets and guarantee an effective economic development to the region and it created the 486 Decision for establishing the common industrial property regime. Article 154 of the 486 Decision establishes that the right to use a mark

## *Ms. Judit Marai at the AHEC*

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Ms. Judit Marai recently had the opportunity to represent Noli IP Solutions, PC at the American Hungarian Executive Circle (AHEC)'s meeting which took place last Friday, October 2, 2015 in Budapest, Hungary.

For more information on the work of this organization, please visit the link below: <http://americanhungarian.org/>



exclusively is conferred by registration with the competent national office, view which has been reinforced several times in the Interpretations made by the Andean Community Tribunal. Unlike in the United States, where rights over a mark are acquired by use, in the Andean Community, rights over a mark are given only with registration. As a consequence, it is possible to find that the owner of a mark, which has never been used in the market, can still enforce rights over the same, preventing that competitors use confusingly similar marks in the market.

The idea of conferring rights to mark by registration was born as a way to encourage the economical growing among the Andean Region population. Therefore, any person can register a sign which (1) has never been used (for example, defensive registrations or those merchants who wants to commercialize goods in the future but it never happens); (2) has been used for short period of time but after falls in non-use (for example, those marks who are easily replaced by new ones with design variations; and (3) has been used for short period of time but after are abandoned (for example, those trademarks created only for the advertising of goods that will be in commerce for short

periods of time). Notwithstanding, this defective attribution of rights was amended through the figure of cancellation.

A person who has a legitimate interest on the registered mark or a confusingly similar mark, can submit a petition to cancel the registered mark according to Article 165 of the 486 Decision. The requirements for canceling a registered mark are: (1) the trademark has not been in use by the owner, a licensee or another authorized person; (2) the trademark has not been used in at least one of the member countries of the Andean Community; and (3) the mark has not been used for the three consecutive year's preceding the date of submitting the petition to cancel the mark. To determine if a mark has been used or not, it is necessary to understand the meaning of use of the mark. The concept of use of the mark, for cancelation matters, is supported by one of the inspired trademark law principles: The principle of real and effective use of the mark. Such principle establishes that a mark is considered in use if the products or services covered by the registration are available in the market under that mark and in pertinent quantities, according to their nature and trade channels. In the Andean Community

regime, use cannot be merely symbolic or formal. Due to the identification finality of the mark, its use must be materialized by means of proof of sales, or the availability of the goods and services for their commercialization.

It is important to point out if evidence shows that the trademark has been used in at least one Andean Community country, even a different one from that where the trademark registration is being challenged on the basis of nonuse, the cancellation action cannot prevail. Article 166 of the 486 Decision establishes that a trademark has been used when the goods or services covered by the mark are exported from any country member of the Andean Community. It must be taken into account the quantities of the goods being exported according to their nature, and the methods of commercialization. Article 166 also provides that a mark used in the market in a different form in which was first registered, cannot be canceled on the basis of nonuse if such difference falls within non material alteration of the mark, which means, that small changes over the mark that do not alter its distinctive character cannot be canceled.

Based upon these rules, a sign in the Andean Community

can become a mark and obtain protection from trademark law from the moment it is registered, without proof of use. However, there is an obligation from the owner to

use the mark, otherwise, can be subject to cancellation. The use of the mark must be real and effective, it must be over the goods and/or services covered in the registration

and in quantities according to the nature of the good or service and trade channels. For more information, please make sure to email our team at [mail@noli-ipsolutions.com](mailto:mail@noli-ipsolutions.com).

## Opposition Against your CTM: Does it Mean You Lost Your Registration Chance?

By Judit Marai and Mariana Noli

As part of our day-to-day operation, our firm handles not only US but also worldwide trademark portfolios on behalf of our international clients. We have been on both sides of an opposition procedure before the OHIM (Office for Harmonization in the Internal Market) and familiarized ourselves with the issues faced by the opponents as well as the applicants.

One of the most significant differences between the US and the CTM rules comes to light when your mark is already registered, but a third party files for registration of a confusingly similar mark that could cause confusion with your mark. As many of you may know, the USPTO automatically protects the registered marks by rejecting the application of the confusingly similar marks in the US. However, the OHIM does not have such authority,

thus, the mark owner has to *"take the matter into his/her own hands."*

When your mark gets published in the respective Gazette/Journal, an opposition filed against its registration acts as a red light in the procedure. In comparison, oppositions in the US system are fairly rare since the USPTO examines for similarity of the previously registered marks considering it an absolute ground for refusal. However, in the European system, one of every five applications gets challenged via opposition filed by a mark owner that has already been on the market.

At a glance, the opposition procedure is composed of three steps: (1) Filing the Notice of Opposition; (2) Cooling-Off Period; and (3) Adversarial Period.

Step 1 of the opposition process is the Filing the

Notice of Opposition. Since the existence of an earlier registered mark constitutes a relative ground for refusal of the registration, the OHIM cannot examine it. Thus, the owner of a potentially conflicting mark may oppose the registration of such mark during the three (3) months opposition period from the publication of the application in the Official Gazette.

If you have learned about a conflicting mark application earlier, you may file the opposition even before the mark gets published. Such opposition is based on an earlier application or registration (international, national or community mark), a well-known trademark or earlier rights in the European Union.

Step 2 is the Cooling-off Period. After the 3-month period for the filing the opposition ended, the Office notifies the Applicant if an opposition was filed.

The Cooling-Off period is a 2-month time period during which the parties to the opposition can contact each other to reach an amicable settlement of the dispute. The motivation in reaching the agreement during the cooling-off period is that if the parties succeed, they do not need to pay the costs of the procedure and in some circumstances even the opposition fee paid to the OHIM gets refunded.

Last but not least, Step 3 is the Adversarial Period. In case

the parties cannot settle the conflict by reaching an agreement during the Cooling-Off Period, the adversarial period begins. After examination of the documents by the Office, the opponent has two (2) months to complete the documents submitted. The Office will send the documents to the Applicant for submitting any observation regarding the opposition and another 2-month period opens. Applicant might request proof of use of the mark. Remember in the EU, there is no use requirement for registering the mark, but the mark owner has the responsibility for using the mark in commerce.

Confusion might only occur in the same or closely connected business area, when similar goods and/or services are traded/protected. Applicant can take advantage of this requirement by requesting proof of use from the opponent. If he/she/it fails to prove the use of the mark in the market, the questionable types of goods or services get excluded from the opposition, or the opposition gets rejected. We hope you found this summary informative. If you have any issues relating to an opposition in the CTM, or have any questions, do not hesitate to contact us at [mail@noli-ipsolutions.com](mailto:mail@noli-ipsolutions.com) for more information.

## DREAMING OF A BETTER “IP WORLD”

*We are dreamers. We believe and encourage changes to make this world a better place. We are very proud of Ms. Mariana Noli's participation, together with Ms. Flor Bermudez (Arochi & Lidner) and Ms. Cecilia Fernandez (Brands & Law) in the creation and development of a new non-profit organization to pursue the interests and rights of professional women in the workplace.*

ARTS-PB-801(x)(3) Articles of Incorporation of a Nonprofit Public Benefit Corporation

To form a nonprofit public benefit corporation in California, you can fill out this form or prepare your own document, and submit for filing along with:

- A \$26 filing fee.
- A separate, non-refundable \$10 service fee also must be included, if you drop off the completed form or document.

**Important!** California nonprofit corporations are not automatically exempt from paying California franchise tax or income tax each year. A separate application is required in order to obtain tax exempt status. For more information, go to <http://www.sos.ca.gov/professionalsnonprofits>, or call the California Franchise Tax Board at (916) 543-4171.

Note: Before submitting this form, you should consult with a private attorney for advice about your specific business needs.

For questions about this form, go to [www.sos.ca.gov/businessforfiling.htm](http://www.sos.ca.gov/businessforfiling.htm).

Corporate Name:  All the proposed corporate name. Go to [www.sos.ca.gov/professionalsnonprofits](http://www.sos.ca.gov/professionalsnonprofits) to verify for general corporate name requirements and availability.

The name of the corporation is **Women's IP Lunch**

Corporate Purpose: Check the (check one or both boxes - see 3c). The specific purpose of the corporation must be listed if you are registering for "public" purposes, or if you intend to seek for tax-exempt status in California.

a. This corporation is a nonprofit Public Benefit Corporation and is not organized for the private gain of any person. It is organized under the Nonprofit Public Benefit Corporation Law for:  public purposes.  charitable purposes.

b. The specific purpose of this corporation is to **pursue interest of professional women in the workplace**.

Service of Process: List a California resident or an active 1001 corporation in California that agrees to be your initial agent to accept service of process in case your corporation is sued. This may be any adult who lives in California. This may not be your own corporation or the agent. Be sure to list an address if the agent is a 1001 corporation or the address for service of process is different from the.

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FILED *LOW*  
Secretary of State  
State of California  
SEP 22 2015  
IPC  
This Space for Office Use Only

For more information on this project, please email us at: [womeniplunch@gmail.com](mailto:womeniplunch@gmail.com).