

## **Guidance on answering the discussion questions in the book**

### **Para 13.7**

**Can you summarise the key features of registered trade mark protection, and compare those features to the other principal IP rights?**

#### *Nature of the registered trade mark monopoly:*

Registered trade mark protection does not confer monopoly rights in the mark *per se*. Trade marks are registered in respect of specific goods and/or services: the registration protects the relationship between the mark and those goods/services. This is explored in detail in Chapter 15.

#### *Duration:*

Registered trade mark protection can last indefinitely, provided that registration is renewed every 10 years. This contrasts sharply with the time-limited protection conferred by other IP rights.

#### *'Genuine use' requirements:*

As a counterbalance to the potentially indefinite nature of registered trade mark protection, a trade mark owner must put their mark to 'genuine use' in relation to the goods/services for which it is registered within five years from the date of registration, and without any period of more than 5 years continuous interruption thereafter. This contrasts with other IP rights (for example, patents) where there is no legal requirement to actually put the IP right into use.

### **Para 13.16**

**The area of registered trade marks has attracted more case law at European level than any other intellectual property right. Why do you think this is so?**

There are various likely reasons for this. The creation of the EU trade mark (previously called the Community trade mark) generated a whole new body of trade mark disputes at the EUIPO which have, over time, found their way up the appeal process to the EU General Court and Court of Justice. In addition, because registered trade mark protection can last for such a long time (see the discussion point above), in practical terms it is well worth fighting registered trade mark cases to the highest level, including preliminary references to the Court of Justice.

### **Para 13.31**

**Why might a trader want to have a single trade mark registration effective throughout the EU? Consider the advantages and disadvantages of EU trade mark protection.**

Advantages:

- *Procedural simplification*: Via the EU trade mark system, only one application is filed and one set of application fees paid to obtain protection throughout the EU. EU trade mark owners also only have to keep track of one registration for renewal purposes, rather than having to keep on top of a larger portfolio of national registrations which may come up for renewal at different times.
- *Seniority*: The EU trade mark ‘seniority’ rules allow the owner of an EU trade mark to claim the seniority of an earlier national registration for the same mark, registered for the same goods and services, in any member state. The trade mark proprietor can let

the earlier national registration lapse, while at the same time continuing to have the same rights as if the national trade mark had continued to be registered.

- *Enforcement benefits:* An EU trade mark court hearing an infringement dispute may have jurisdiction, and therefore be able to grant remedies, in respect of acts of infringement committed or threatened in any EU member state, avoiding the need for separate proceedings in multiple jurisdictions.

Disadvantages:

- *Increased vulnerability to refusal/invalidation:* The downside of the EU trade mark's unitary character is its increased vulnerability to refusal or invalidation. The EU trade mark stands or falls as a single, unitary whole. As explained in Chapter 14, to be validly registered an EU trade mark must meet the requirements of registrability across the whole of the EU. For example, if an EU trade mark is considered non-distinctive or descriptive in part of the EU (for example, because it is a word mark which is descriptive in one language of the EU) then it is inherently unregistrable. Similarly, a conflict with prior rights existing in only in one or some Member States would give rise to relative objections sufficient to block registration. However, if these circumstances arise it may possible to 'convert' an EU trade mark into national registrations – see: <https://euipo.europa.eu/ohimportal/en/conversions>.