



Promoting Intellectual Property Law Studies in the Mediterranean Region

TRADEMARK LAW

An-Najah National University
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Ernesto Cebollero González
Attorney at Law



PRELIMINARY CONSIDERATIONS

PART 1: OVERVIEW OF THE REGISTRATION PROCEDURE

PART 2 :ABSOLUTE GROUNDS

PART 3: RELATIVE GROUNDS

PART 4: RIGHTHOLDER'S RIGHTS



Promoting Intellectual Property Law Studies in the Mediterranean Region

PRELIMINARY CONSIDERATIONS



TRADEMARKS VS OTHER IP RIGHTS

	PATENTS	TRADEMARKS	DESIGNS	COPYRIGHT
DURATION	20 (+5)	10 + 10 +...	5+5+5+5+5 3	70 After author's death
REGISTRATION?	YES	YES/NO	YES/NO	NO
REQUIREMENTS	NOVELTY INVENTIVE STEP	DISTICTIVENESS	NOVELTY INDIVIDUAL CHARACTER	ORIGINALTY
FUNCTION	PROTECTION OF A TECHNOLOGICAL BREACKTHROUGH	INDICATION OF ORIGIN	PROTECTION OF THE APPEARANCE OF A PRODUCT	PROTECTION OF AN INTELLECTUAL CREATION

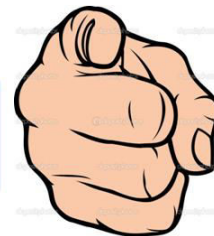
WHY TRADEMARKS?

INDICATION OF
ORIGIN



WHY TRADEMARKS?

INDICATION OF
ORIGIN



WHY TRADEMARKS?



QUALITY
CONTROL
MECHANISM

WHY TRADEMARKS?



QUALITY
CONTROL
MECHANISM



It takes 11 times more efforts that a consumer purchases your products for the second and subsequent times than it takes for the said consumer to do it for the first time.

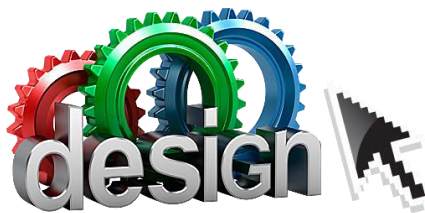


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WHY TRADEMARKS?



20 YEARS



25 YEARS



70 YEARS
after death

WHY TRADEMARKS?



always ♥ forever

(Virtually...like marriage)

WHY TRADEMARKS?



25 YEARS

TRADE MARK



20 YEARS

TRADE MARK



70 YEARS (a.d)

TRADE MARK

WHY TRADEMARKS?

TRADEMARKS ENABLES DIFFERENTIATION OF YOUR PRODUCT EVEN AFTER ANY OTHER IP RIGHT HAS EXPIRED!

IS KEY IN ORDER TO GUARANTEE CUSTOMER'S LOYALTY!!!



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WHY TRADEMARKS?



.-Patent protection

.-Monopoly (**Market leader**)

.-Trademark consolidation

.-Patent expired

.-Open market (**Market leader**)

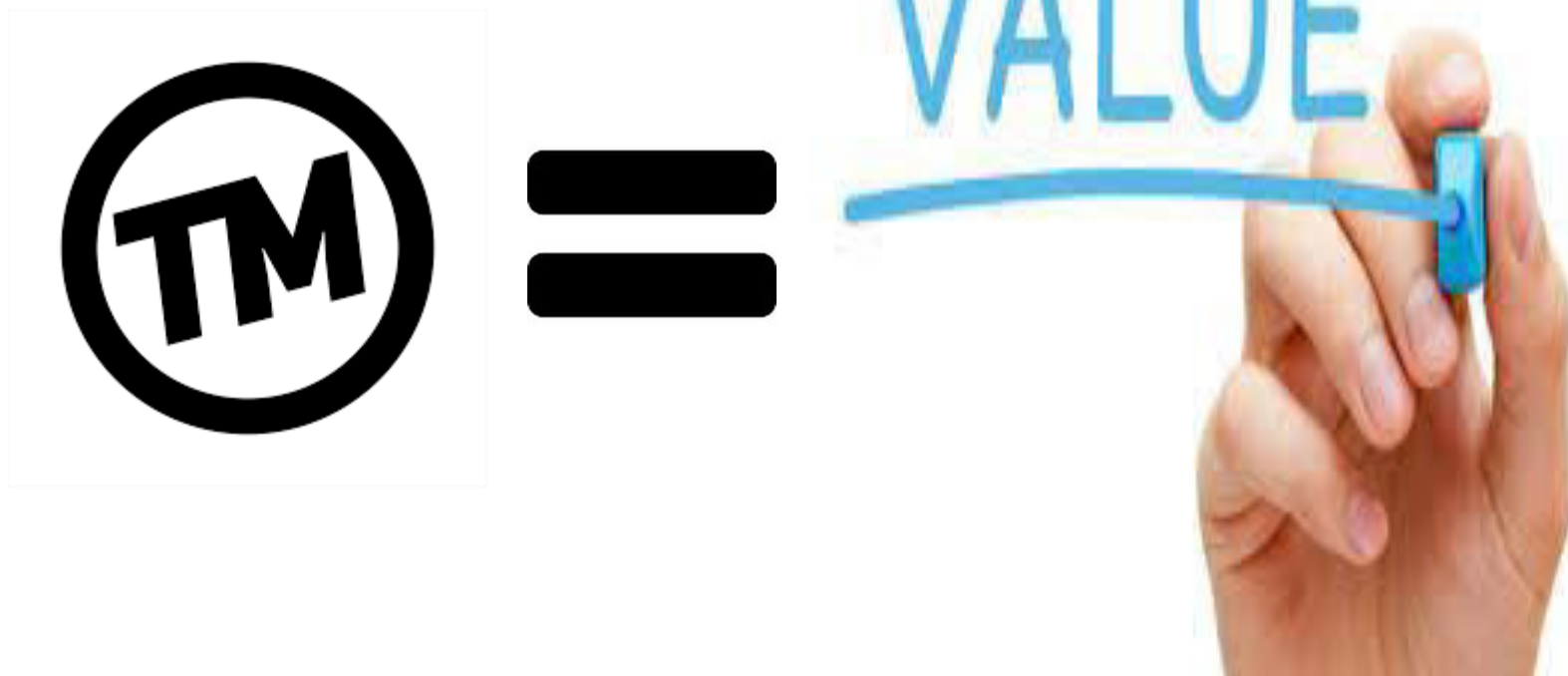
.-Trademark value



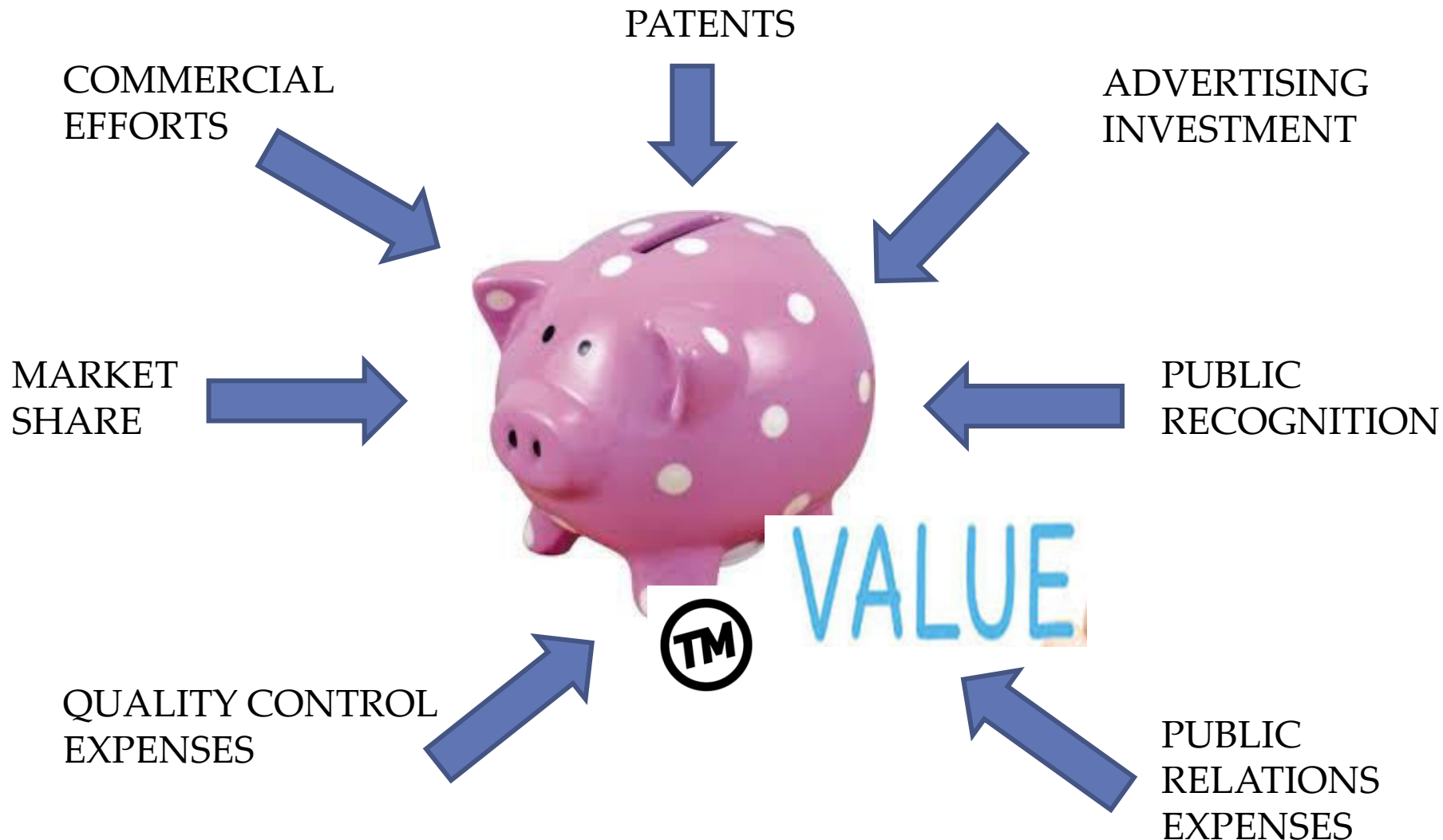
20 YEARS



WHY TRADEMARKS?



WHY TRADEMARKS?



WHY TRADEMARKS?

“I FELL IN LOVE WITH THE BRAND”



“I HAVE FALLEN IN
LOVE WITH
THE DESIGN” ¿?

“I HAVE FALLEN
IN LOVE WITH
THE PATENT” ¿?



WHY TRADEMARKS?

REAL EXAMPLE



- SPANISH COMPANY (LET'S SAY "X")
- PRESENT IN THE MARKET FOR DECADES
- NOTICEABLE MARKET PRESENCE (AT LEAST FOR A WHILE)
- GOES BANKRUPT
- SELLS ALL ITS TANGIBLE ASSETS
- ONLY REMAINING ASSEST WAS ITS TRADEMARK
- FOREIGN INVESTMENT GROUP PURCHASES THE SAID TRADEMARK



Million Euros

WHY TRADEMARKS?



TM_s MUST BE CENTRAL IN MOST IP PORTFOLIOS

WHY TRADEMARKS?



¿ACCUMULATION OF PROTECTIONS?



25



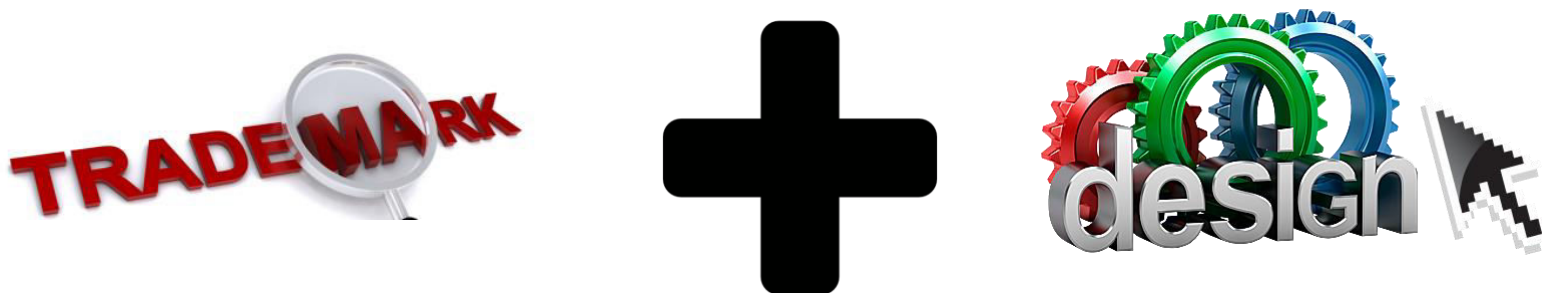
20 YEARS



¿ACCUMULATION OF PROTECTIONS?

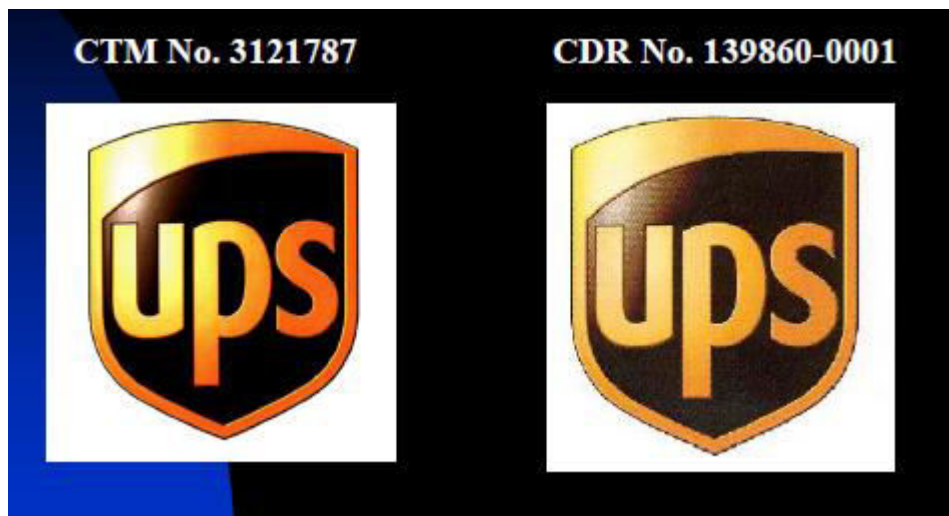
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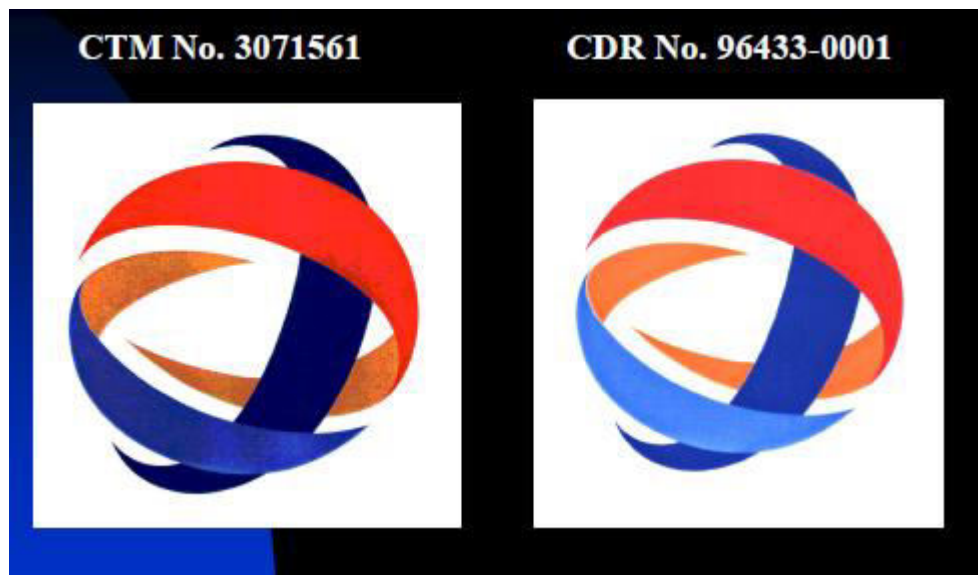
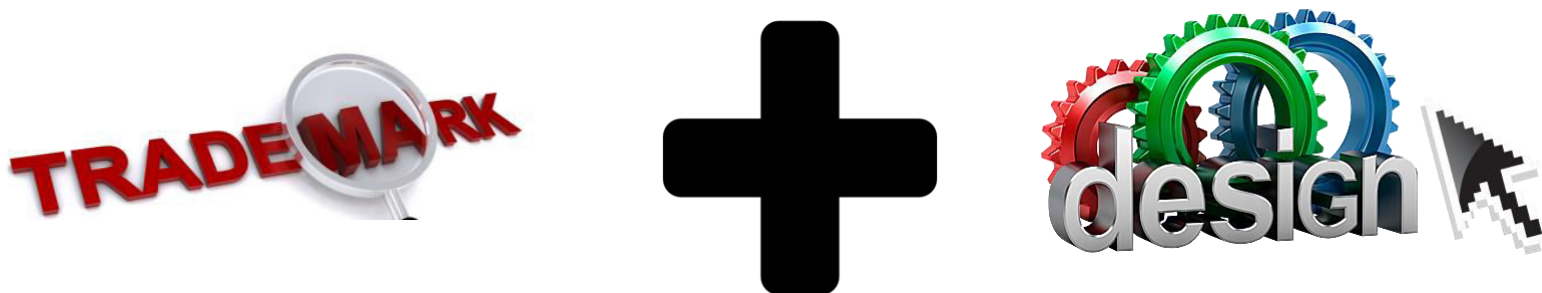


Yes!

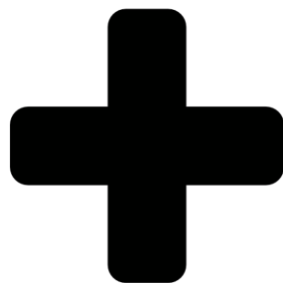
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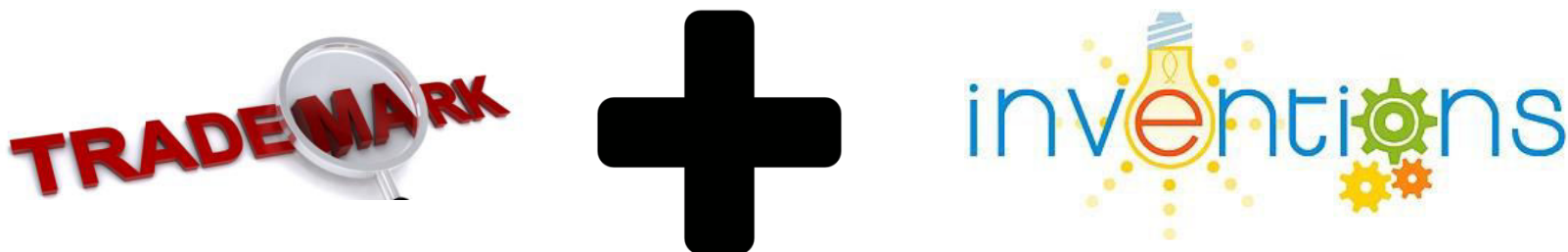
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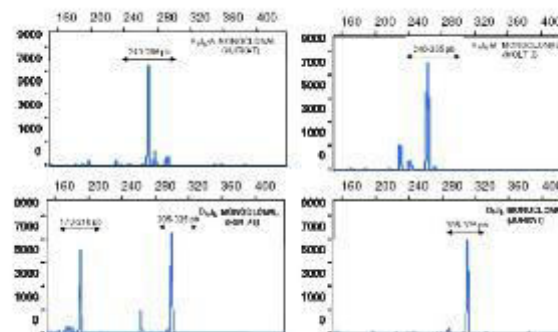
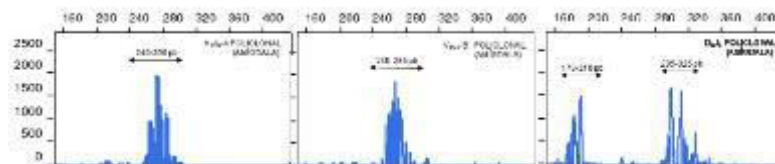
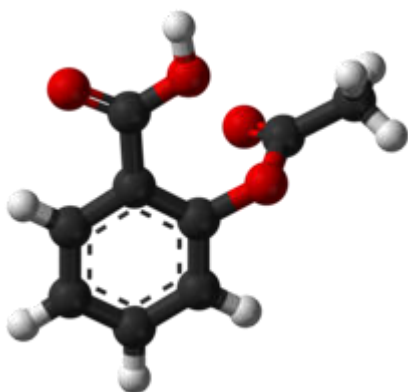
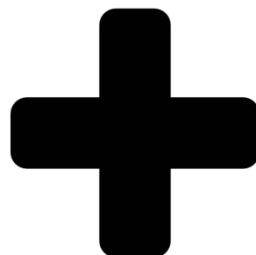
DIFFICULT

MORE
FEASIBLE
FOR
MECHANICAL
PATENTS

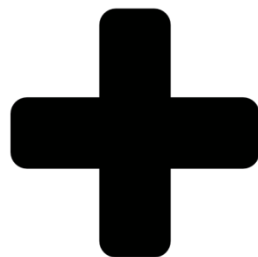
NOT
FOR
CHEMICAL/PHARMACEU
TICAL PATENTS



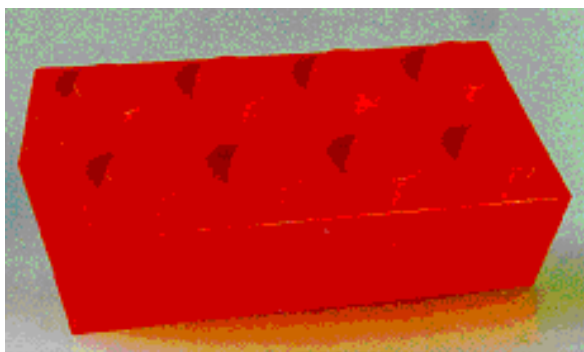
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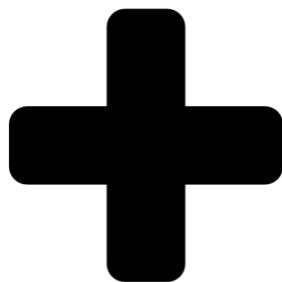
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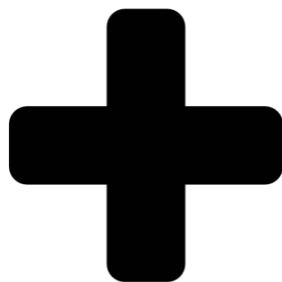
C-48/09 P



¿ACCUMULATION OF PROTECTIONS?



¿ACCUMULATION OF PROTECTIONS?



¿ACCUMULATION OF PROTECTIONS?

TRADE MARK



Yes and Yes
BECAUSE YES IS MORE FUN THAN NO.

¿ACCUMULATION OF PROTECTIONS?

TRADE MARK

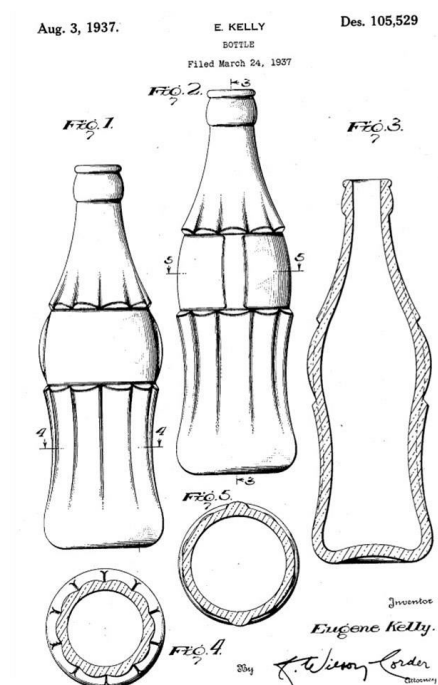


design



¿ACCUMULATION OF PROTECTIONS?

TRADE MARK



¿ACCUMULATION OF PROTECTIONS?

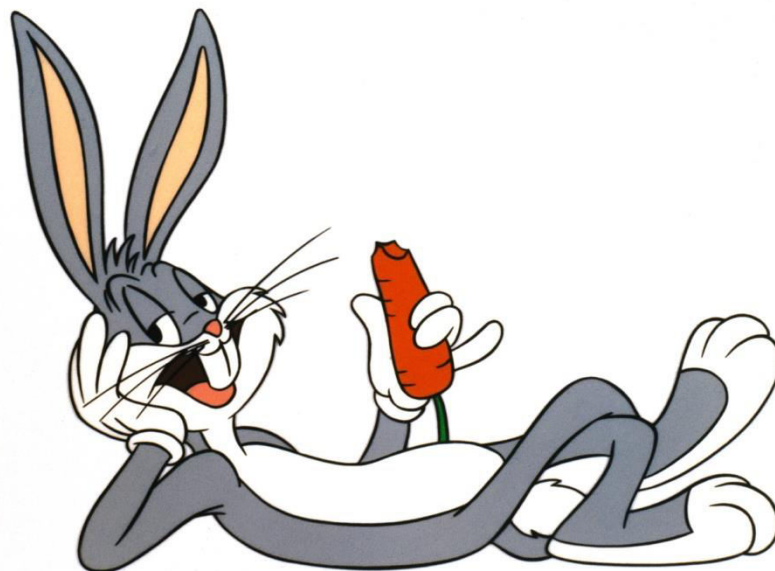


¿ACCUMULATION OF PROTECTIONS?

TRADE MARK



design





TRADEMARK AND ENTREPRENEURSHIP STRATEGY

TRADEMARK IS **ABSOLUTELY PARAMOUNT!!!**

Either as a complement to other IP rights

Either as a stand alone protection

IP OR “THAT THIN RED LINE”

IS THAT TRADEMARK
SIMILAR_{TC}
TRADEMARK?



IS THERE AN

CATION OR



N THOSE TRADEMARKS?

DOES THAT DESIGN
SAME GENER
IMPRESSION?

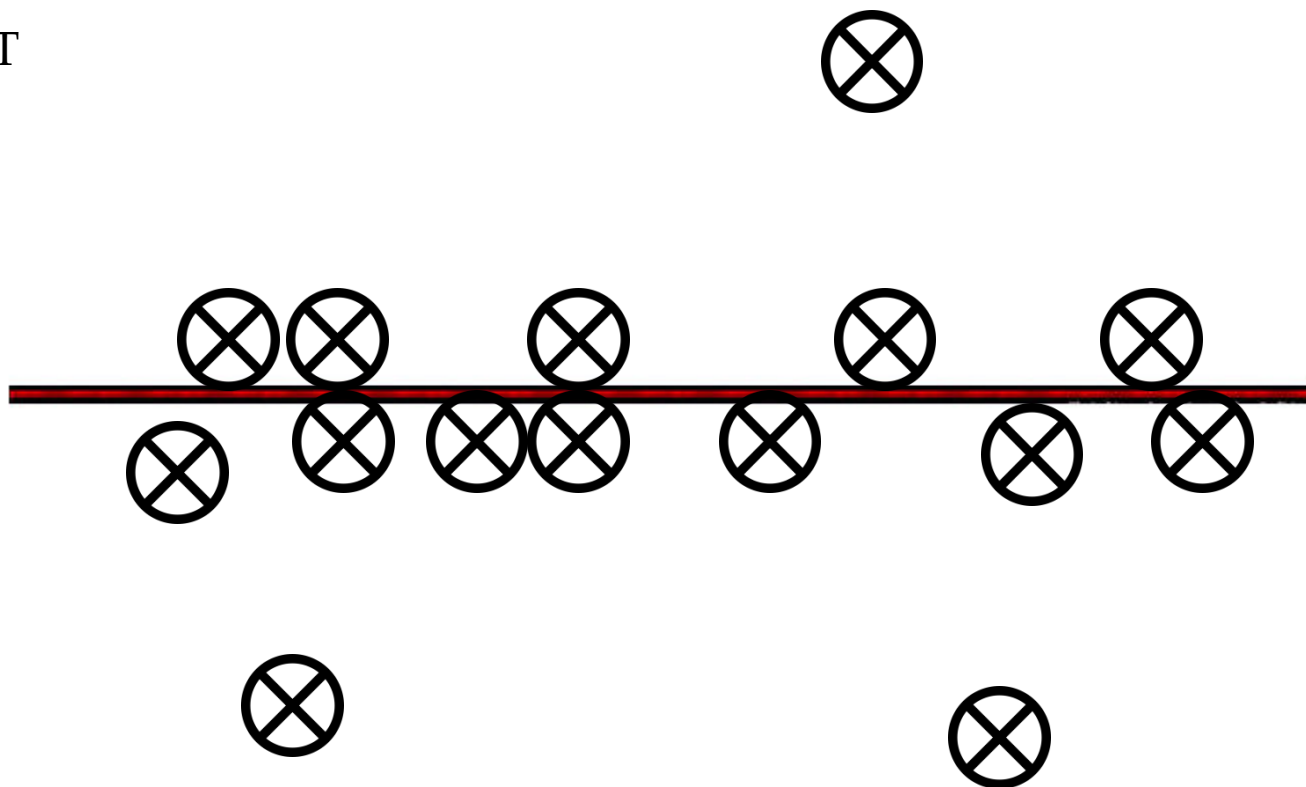
OLUTION

VALENT_{TO}

HER ONE?

IP OR “THAT THIN RED LINE”

LICIT



ILICIT

THE 2 SIDES OF IP



REGISTRATION

ENFORCEMENT



Promoting Intellectual Property Law Studies in the Mediterranean Region

THE IDEAL IP SYSTEM

LEGAL CERTAINTY
(HOMOGENEITY)

FAST PROCEEDINGS



SKILLED PROFESSIONALS

AFFORDABLE COSTS

THE LACKS IN A “REGULAR” IP SYSTEM

RELATIVE LEGAL CERTAINTY
(HOMOGENEITY)

LENGHTY
PROCEEDINGS



JUST SOME
SKILLED PROFFESIONALS

HIGH COSTS

THE LACKS IN A “REGULAR” IP SYSTEM

¿IMPOSIBLE TO ENFORCE?



SPANISH INVENTION PATENTED IN EU 28 BY A PARTICULAR.

PATENT INFRINGED BY ALMOST 200 PARTIES ALL ALONG EUROPE.

KIND OF IMPOSSIBLE TO ENFORCE PATENT RIGHTS AGAINST ALL INFRINGERS.



THE LACKS IN A “REGULAR” IP SYSTEM

LENGHTY PROCEEDINGS (EXAMPLE: SPAIN)

REGISTRATION	6 MONTHS-4 YEARS
1ST INSTANCE	12-18 MONTHS
2ND INSTANCE	15-18 MONTHS
CASSATION	20-24 MONTHS



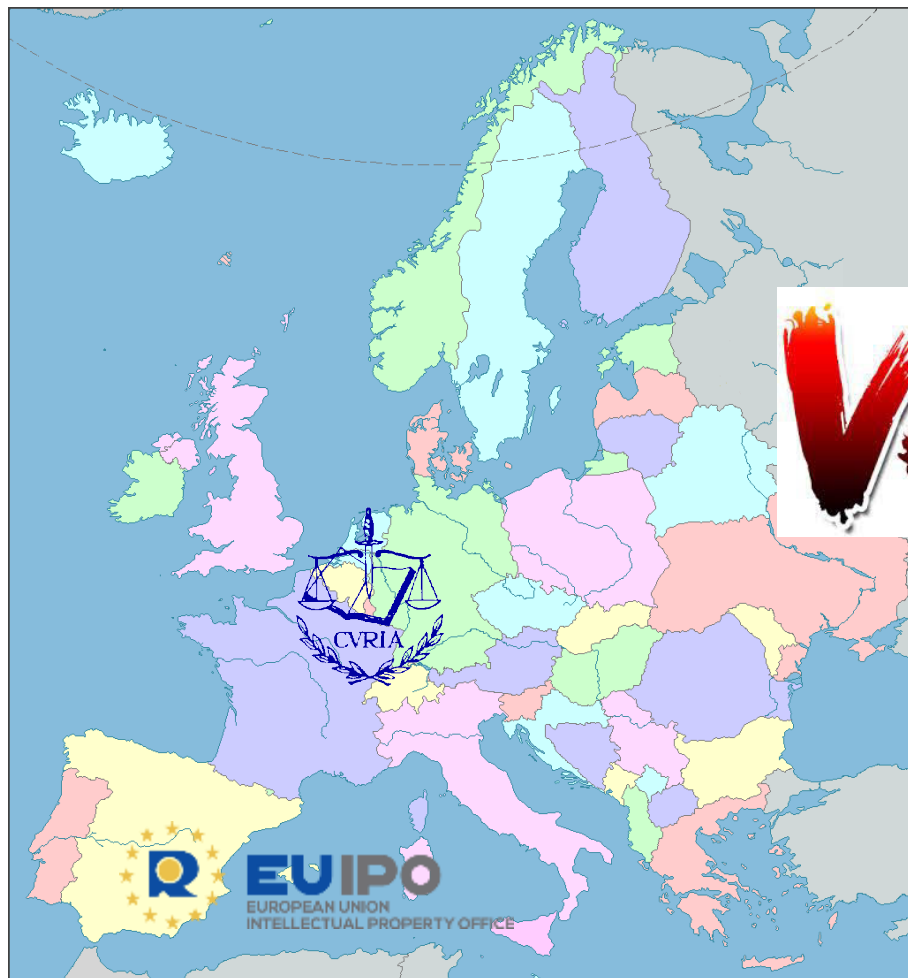
THE LACKS IN A “REGULAR” IP SYSTEM

HISGH COSTS (EXAMPLE: SPAIN)

REGISTRATION	143 EUROS (1 TM IN 1 CLASS)
1ST INSTANCE	6-15.000 EUROS
2ND INSTANCE	10-18.000 EUROS
CASSATION	14-22.000 EUROS

PART 1: GENERAL OVERVIEW OF THE REGISTRATION PROCEDURE (EU)

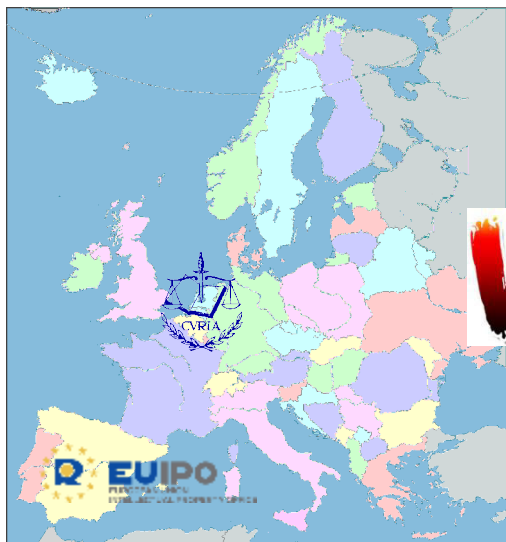
THE INSTITUTIONS



EUROPEAN UNION SYSTEM

“28” NATIONAL SYSTEMS

THE INSTITUTIONS



VS



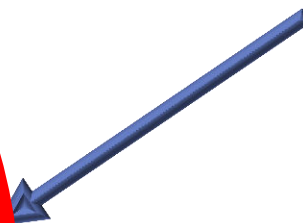
“28” NATIONAL SYSTEMS

- 2 Parallel systems
- 2 Interacting systems
- 2 Mutually influenciabile systems

INTERACTION

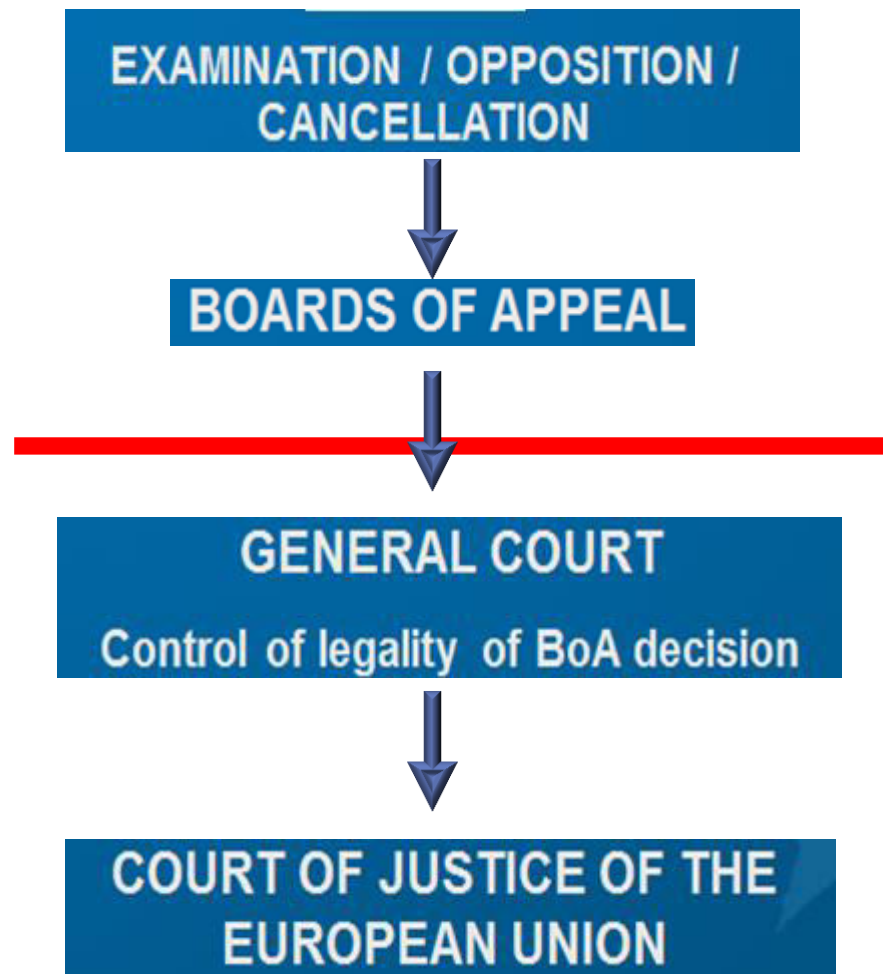


Purely
Administrative Matters
¿is this registrable?



Substantive Matters

OVERVIEW OF THE REGISTRATION PROCEDURE (1/3)



DECISION ON THE MERITS !!!!!!!!!!!!!!!

OVERVIEW OF THE REGISTRATION PROCEDURE (2/3)



**EXAMINATION / OPPOSITION /
CANCELLATION**

4 -30 MONTHS



BOARDS OF APPEAL

8-12 MONTHS



GENERAL COURT

Control of legality of BoA decision

16-24 MONTHS



**COURT OF JUSTICE OF THE
EUROPEAN UNION**

16-24 MONTHS

DECISION ON THE MERITS !!!!!!!!!!!!!!!

OVERVIEW OF THE REGISTRATION PROCEDURE (3/3)



**EXAMINATION / OPPOSITION /
CANCELLATION**

1350-5000 €



BOARDS OF APPEAL

1.500-2.500 €



GENERAL COURT

Control of legality of BoA decision

6.000-12.000 €



**COURT OF JUSTICE OF THE
EUROPEAN UNION**

6.000 €-15.000 €

DECISION ON THE MERITS !!!!!!!!!!!!!!!

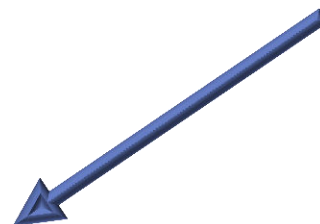
INTERACTION



EUIPO
EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE



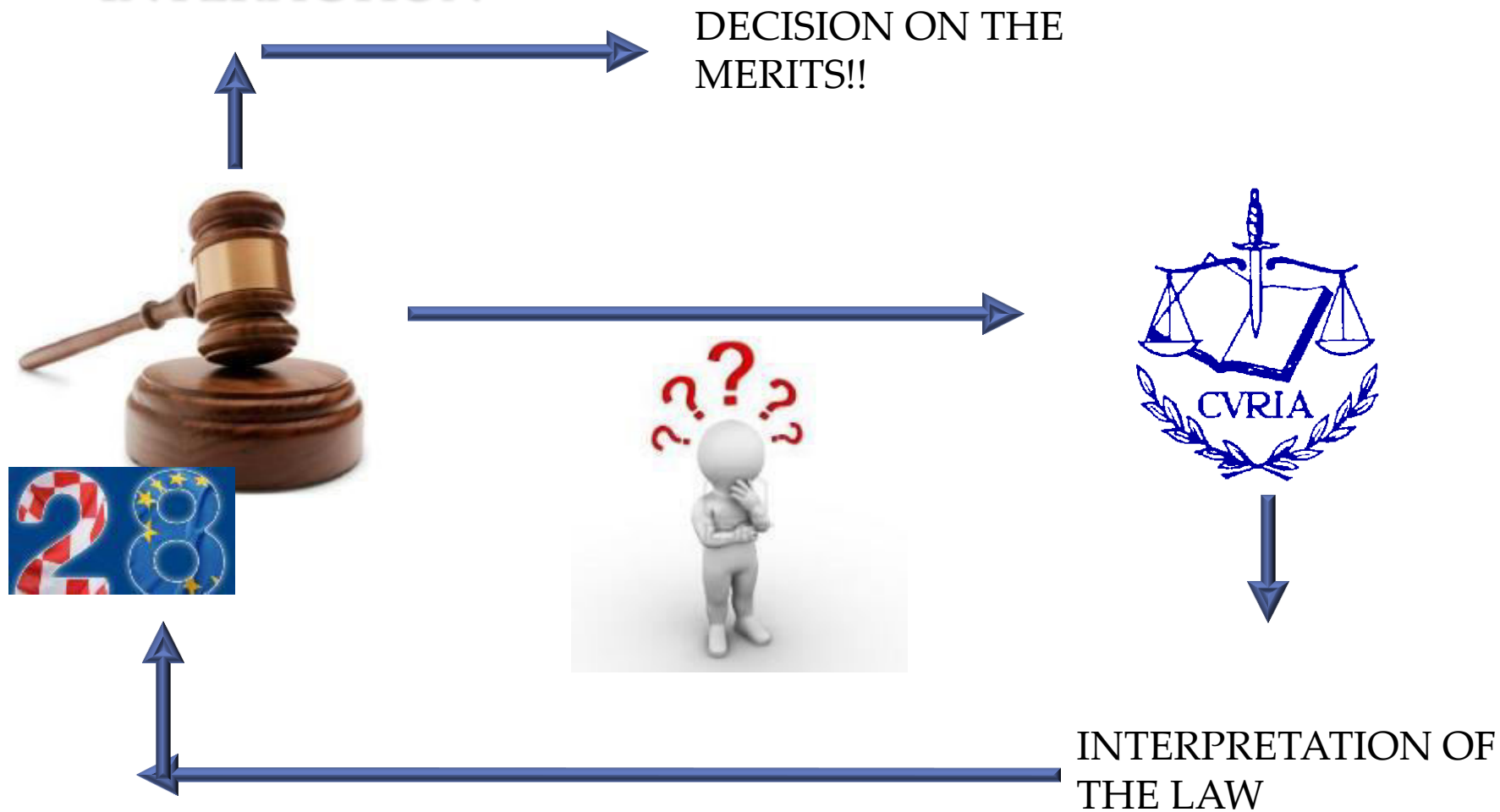
Purely
Administrative Matters
¿Is this registrable?



Substantive Matters



INTERACTION





**THANKS FOR
YOUR ATTENTION
AND
PLEASE DON'T ASK
TOO MUCH**