

No. 13-06, June 19, 2006

We remind all ECTA Conference delegates, who have not yet done so, to provide the secretariat with the CPD Course questionnaire duly completed.

A copy of the questionnaire can be found at:  
[http://www.ecta.org/Warsaw/CPD\\_Questionnaire.doc](http://www.ecta.org/Warsaw/CPD_Questionnaire.doc)

Thank you for your cooperation

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## 1. LAW

### BENELUX

#### The new Benelux Convention

The implementation of the Benelux Convention on Intellectual Property will give rise to a new international institution: the Benelux Organisation for Intellectual Property. As a result, from **1 September 2006** and not August 1, 2006 as previously advised and reported in ECTA Flash 11/05, the Benelux Trade Marks Office and the Benelux Designs Office will change their name into the **Benelux Office for Intellectual Property (BOIP)**. Under the new Convention, the office will assume full responsibility for the implementation of regulations in the fields of trademarks, designs and models.

In the coming months we will keep you posted on the progress made within our new organisation through a variety of channels, including our website ([www.boip.int](http://www.boip.int)).

#### The changes

From the users' perspective, the Benelux Convention on Intellectual Property will change current practice in a number of respects. One such change, the abolition of compulsory preliminary research, results from the Convention itself. The other changes arise from the Implementing Regulations that accompany the Convention. The most notable changes are the following:

- the compulsory preliminary research into marks will be abolished
- the compulsory power of attorney will be abolished
- the practice of "retroactive stamping" to the most recent time the Office or national offices were opened, will be abolished
- the admissibility of renewal requests will be subject to a single condition only
- opposition duties will be split
- the need to submit original documentary evidence in the event of changes will be abolished.

Additionally, everybody will obviously have to get used to the new numbering system and the new reference structure of the Convention and the Implementing Regulations. As a whole, however, the new system provides options that will make it of even better service to you than its previous version.

In the beginning of July we will publish a booklet with further details about the changes and their backgrounds. You will be able to download the booklet from our website starting 1 August 2006.

Reported by: Camille Janssen, Benelux Trade Mark Office, NL

### **ENFORCEMENT – Implementation of the Enforcement Directive No 2004/48 dated April 29, 2004 (J.O. June 2, 2004 – p.16)**

#### SPAIN

Spanish Law No. 19/2006, of 5 June 26, enhancing the means of enforcing intellectual and industrial property rights and laying down rules of procedure to facilitate the application of various Community regulations, was published on 6 June 2006.

The purpose of the Law is to implement the provisions of Directive 2004/48/EC concerning intellectual property rights in Spanish law.

The Law on Civil Procedure, Law No 1/2000 has been amended as well as specific legislation namely; the consolidated version of the Intellectual Property Act approved by Royal Legislative Decree No. 1/1996; the Patent Act, Law No. 11/1986; the Trade Mark Act, Law No. 17/2001; and the Industrial Design Protection Act, Law No. 20/2003.

Regarding the Law on Civil Procedure, the right to information is regulated by new preliminary procedures. Also new measures for protecting evidence have been established in the Law on Civil Procedure, Law No. 1/2000.

The main change to the specific legislation has been amendment of the provisions dealing with damages, which have been brought into line with the Directive, with two standards of calculation. In addition, damages shall expressly include the expenditures effected by the right holder on investigations to compile evidence of the infringement.

The wording of the articles dealing with damages in the new law is somewhat unclear compared with the previous wording. On the one hand, a definition of moral prejudice has been included, to coexist with the notion of damage to prestige of the IP right's introduced earlier by the Trade Mark Act of 2001. Damage to a right's prestige was formerly held to be in addition to purely economic losses, whereas under the current wording taken from the Directive, moral prejudice would seem to be in addition to economic loss only where the first standard for calculating damages (negative economic consequences suffered by the injured party) is employed, but not where the second standard (the amount of royalties or license fees) is used. This will be something for the courts to elucidate, because if this strict interpretation is followed, instead of extending the protection accorded to right holders as intended by the law, the revision would, paradoxically, be a step backwards compared to the system previously in force.

Another amendment common to the specific legislation is intended to broaden the range of available actions designed to prevent fresh infringements, in particular destruction and impoundment of the means and instruments used to commit infringement.

Lastly, the time period for filing the main complaint when interim measures have been requested before the main complaint has been filed has been shortened to 20 working days, compared with the former time period of two calendar months.

Reported by: Ignacio D. Rivera Elzaburu, Chairmen of the ECTA Anti-Counterfeiting Committee, Elzaburu, ES

## **GUERNSEY**

### **Trade Marks (Bailiwick of Guernsey) Ordinance 2006**

The new Trade Mark law of Guernsey came into force on 1 June 2006.

The Ordinance establishes a two-tier system of registration. For the first time, substantive registrations are possible, known to the authorities as "primary registrations". However, it will also be possible to seek re-registration of a UK trade mark in Guernsey, as under the previous law. Whilst the Regulations have yet to be published, it is understood that it is also possible to apply for the re-registration of a Community Trade Mark as well as an International Registration designating the UK. It is not currently known whether a re-registration application will take the date of the corresponding UK mark, or whether the date

of filing in Guernsey will be the effective date of filing. It is hoped that the Regulations will shed some light on this, and these are expected to be published shortly.

The text of the new law mirrors the UK Trade Marks Act 1994 to the extent that it is almost identical to it. It therefore makes provision for Guernsey to join the Paris Convention, the Madrid Protocol, and gives the authorities power to enforce the Community Trade Mark Regulation at some stage in future. Whilst the law enables the Registrar to refuse applications on absolute or relative grounds, it is our understanding that examination on relative grounds will not actually take place. Instead, there is a section on the application forms requiring applicants or their agents to state that “ as far as (they) are aware, having made reasonable enquiries, the registration of this mark is not prohibited by Section 5 (relative grounds of refusal for registration)”. Thus, searching prior to filing will be vital if an application for a primary registration is filed, and we also recommend to applicants for re-registration of marks, particularly CTMs, search in Guernsey prior to filing. However, the efficiency of the search facility provided by the Registry be remains to be seen.

The cost of applying for a primary registration is very high considering the size of Guernsey as a market for trade mark owners; the official fees are more than in the UK. However, it is thought that the primary registration system will mainly be used by local traders in Guernsey who have no wish to register their marks in the UK and/or at OHIM first.

Reported by: Martin Chinnery, Lysaght & Co., Jersey (JE)

## MONTENEGRO

### Separation from Serbia

The former Yugoslav Republic of Montenegro declared independence on June 3, 2006 when its parliament adopted the May 21st national referendum decision to end its union with Serbia. Negotiations between Serbia and Montenegro on how to disentangle the two states, including the laws and court systems, are expected to begin shortly. The separation of the union will have significant effects on IP owners' rights. Currently, Montenegro does not have its own Patent and Trade Mark Office or its own Intellectual Property Laws. New legislation in Montenegro is likely to closely resemble the relevant Serbian laws. Based on the experience following the break-up of the former Yugoslavia into 5 countries, we anticipate that any new legislation will mandate a six to twelve month period of time for IP owners to revalidate rights registered under the old union in Montenegro. In the meantime, joint government agencies, such as the Patent and Trade Mark Office in Serbia, will operate under the same rules and regulations as before the independence declaration.

Reported by: Kathryn Szymczyk, SD PETOSEVIC

## 2. OFFICE PRACTICE

### OHIM

#### Error in the certificates of registration for CTMs published in Bulletins 18, 19, 20 and 21

OHIM draws users attention to the fact that the certificates of registration for Community Trade Marks published in Bulletins 18, 19, 20 and 21 contain an error, namely the renewal

date does not appear. Please rest assured that you will receive a corrected certificate during the month of July replacing the previous one.

### Response to user satisfaction survey

OHIM has made available its response to the user satisfaction survey.

The document can be retrieved at: <http://oami.europa.eu/EN/office/survey05.htm>

## 3. CASE LAW

To reach the **ECTA Info Database** including the **free Darts Europe** Case Law database, please click [here](#)





### Court of First Instance

**Case No:** [T-153/03](#)

**Date:** 13 June 2006

**Parties:** *Inex SA v. OHIM*

#### Trade marks:

	
Earlier trade mark	Trade mark applied for

Class 29

**Contested decision:** R106/2001-2, 4 February 2003

#### Decision:

The Court of First Instance (CFI) *upheld* the Board of Appeal's decision finding that the trade marks at issue were not similar.

In visual terms, the court found that since the 'inex' component contributes decisively to the overall impression conveyed by the earlier mark, the cowhide design alone is unlikely to dominate the public's perception of it. Thus, there are strong visual differences (paras 41 and 42).

On the conceptual level, the marks in question are similar insofar as both call to mind a cow, but this similarity is limited to an element which is not distinctive due to the goods for which the marks are used (para. 45).

## European Court of Justice

**Case No:** [C-235/05 P](#)

**Date:** 27 April 2006

**Parties:** *L'Oréal SA v. OHIM*

### Trade marks:

<b>FLEX</b>	<b>FLEXI AIR</b>
<b>Earlier trade mark</b>	<b>Trade mark applied for</b>

Class 3

**Contested decision:** T-112/03, 16 March 2005.

### Decision:

The ECJ dismissed an appeal against the Court of First Instance's decision finding that there was a likelihood of confusion given the similarity of the signs and of the goods.

The Community trade mark holder had argued before the ECJ that, in assessing the similarity between the signs at issue, the CFI should not take into account the prefix "flex" due to its weak distinctive character.

The ECJ restated that an earlier trade mark's distinctiveness is relevant, on the one hand, in assessing the similarity of the signs and, on the other hand, in determining the likelihood of confusion.

When assessing the similarity of two signs, the distinctiveness of the earlier trade mark has limited significance. The fact that a mark is not highly distinctive does not generally influence the consumer's perception of the similarity of the signs (para. 42).

With respect to the likelihood of confusion, the Court recalled that this must be assessed globally, taking into account all factors relevant to the case at hand (para.44). The distinctiveness of the earlier trade mark is thus not the only criterion to be taken into consideration (para. 45).

In the case at hand, the ECJ held that the CFI did not err in law in its assessment of the similarity of the signs in question and in finding a likelihood of confusion.

To find the full text of the national decisions mentioned in ECTA Flashes, please search the [ECTA Info Database](#) including the [free Darts Europe Case Law database](#) available on ECTA's website in the [members' only](#) section.

## 4. ECTA NEWS

### - ECTA 25th Annual Conference – Warsaw, Poland

All documents related to the conference are placed on the ECTA website as soon as available under the [Previous-Conference](#) section.

### - Madrid System

Jan Wrede, Member of the Law Committee and Sandrine Peters, ECTA Legal Coordinator attended the second session of the Ad Hoc Working Group on the Legal Development of the Madrid System for the International Registration of Marks at WIPO from June 12-16, 2006.

The report can be found on ECTA's website under the [Law Committee/Papers](#) section.

### - 13<sup>th</sup> OAMI Users Group

The 13<sup>th</sup> OAMI Users Group meeting will take place in Alicante on 3 July 2006.

Should you have any issues to be raised at this meeting, please send an e-mail to: Joao Pereira da Cruz (Chairperson of the OHIM link Committee) at: [jpcruz@mail.telepac.pt](mailto:jpcruz@mail.telepac.pt), and/or Sandrine Peters (ECTA Legal Co-ordinator) at: [Sandrine.peters@ecta.org](mailto:Sandrine.peters@ecta.org).

### - IP Crime Congress 2006 - The World Forum for Intellectual Property Risk and Security Management - Brussels, July 6-7, 2006

ECTA members benefit from a 10% discount on the registration fee for the [IP Crime Congress 2006](#), to be held at the World Customs Organisation conference centre in Brussels - Belgium on July 6 and 7, 2006.

### Next issue of the ECTA Gazette (due November 2006)

If you would like to publish an Article in ECTA's Gazette, please remember that the deadline for submission for the next publication is **July 31, 2006**.

Articles should be sent to Sandrine Peters at: [sandrine.peters@ecta.org](mailto:sandrine.peters@ecta.org).