

QUESTION 104

Trademarks: Conflicts with prior rights

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Q104

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Resolution

1.0 In the context of the harmonization of trademark laws undertaken in particular by WIPO AIPPI has studied the question of prior rights that can be used to challenge a trademark registration or application for registration. The first part of this Resolution addresses the substantive legal issues and the second part deals with the procedure of invoking such rights. This Resolution is concerned only with relative grounds of objection.

Substantive law

- 2.0 AIPPI believes that at least the following grounds should be available for challenging a registration or an application for registration:
- 2.1 A mark which was previously applied for or registered by a third party, being identical or similar for designating identical or similar products or services, thus generating a likelihood of confusion. In determining the question of likelihood of confusion, the likelihood of association should be included.
- 2.2 A mark having a reputation, a well-known mark and a mark of a high reputation, to the extent that the conditions set out in the Resolution adopted at Barcelona by AIPPI on Question 100 (Annuaire 1991/I, page no. 295) are met.
- 2.3 Collective, certification and guarantee marks, which should receive the same treatment as ordinary marks, in accordance with 2.1 and 2.2 above.
- 2.4 The prior use of an unregistered mark in good faith to a significant extent in the country where protection is sought, at least in the circumstances where the opposed applicant or registrant was aware of the existence of the mark or could not reasonably invoke ignorance.

One condition for the exercise of this right could be that the prior user applies for registration.

- 2.5 A trade name, in the light of article 8 of the Paris Convention, provided that, taking into account the resolution adopted at Madrid on Question 41B (Annuaire 1971/I page no. 53, 127, 201), the following conditions are met:
- a) The trade name is used or is sufficiently known in the country where protection is sought, or
 - b) The trade name is used or is sufficiently known in international trade and the owner shows an interest in trading in the foreseeable future in the country where protection is sought.
- 2.6 Geographical names, to the following extent:
- a) A protected geographical name of earlier date can be used to object to a subsequent mark;
 - b) Any geographical name, if a significant part of the relevant public knows it as a name, and the opponent, which may be a local or municipal authority, has a justified interest.
- 2.6.1 If a geographical name is registered as a mark, the mark should not prevent third parties from making **bona fide** use of that name to indicate the place of origin of their products.
- 2.7 Literary or artistic property rights (copyright) or registered design rights.
- 2.8 Rights to a name, including a family name, a pseudonym and a signature, and a right of personal portrayal (image of a person).
- 2.9 Claims deriving from unfair competition law.
- 2.10 If it is possible to challenge use of a mark on the basis of any other non-trademark right, then in general it should be possible to challenge registration of the mark.

Procedures

- 3.1 AIPPI has no uniform view on whether examiners should have the power to object **ex officio** on the basis of prior rights during registration proceedings.
- 3.2 If the examiner has the power to object on the basis of prior rights, he shall have the power to object on the basis of a prior filed or registered mark, and may have the power to object on the basis of an unregistered mark or trade name of high reputation, a registered protected geographical name, and a registered corporate name or registered trade name.
- 3.3 AIPPI recommends that all national laws and international instruments should provide for a simple and inexpensive opposition procedure, after a hearing and with the possibility of an appeal.

- 3.4 The possible grounds of opposition must in any event include a mark which was previously applied for or registered by the opponent. AIPPI takes the view that opposition proceedings should be open to any opponent wishing to enforce his own earlier rights. AIPPI notes that certain countries permit opposition to be based on rights owned by third parties.
- 3.5 Especially if the examiner or an opponent has the power to object on the basis of a prior registered mark, AIPPI recommends that there should be an administrative simple and inexpensive procedure for challenging the objection on the ground of non-use of the prior mark.
- 3.6 Where the proprietor of a prior right consents to the registration of a mark by a third party, AIPPI believes that the examiner should not have the power to refuse the mark.
- 3.7 AIPPI takes the view that cancellation and invalidation procedures should be open to any party on the grounds of their own prior rights, subject to the possibility that the rights are no longer enforceable, for example, due to acquiescence.

The question of prior use as opposed to prior filing

- 4.1 AIPPI notes the existence of a different treatment as to the acquisition of exclusive rights in a trademark. Many countries recognize the first applicant as the owner of a mark, whereas other countries regard an earlier user as being the owner of a mark.
- 4.2 AIPPI further notes that there is a demand from trademark applicants for trademarks of supranational extent. Such marks would then cover countries from both groups, hence there is a need to consider the possibilities of reconciling the two approaches.
- 4.3 AIPPI also notes a trend towards convergence of the two legal systems. It has been proposed in common law jurisdictions that there should be a subsidiary registration system as a condition for enforcement of any rights in a mark. Equally, civil law jurisdictions are increasingly tending to recognize that use may give rise to a right of action in certain circumstances.
- 4.4 AIPPI recommends that the question should be given further detailed study.

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