

World Trademark Law and Practice

2

Ethan Horwitz

WORLD TRADEMARK LAW AND PRACTICE

by

ETHAN HORWITZ

Member of the New York Bar

VOLUME 2

1983



**MATTHEW
BENDER**

235 E. 45TH STREET, NEW YORK, N.Y. 10017

Copyright © 1982, 1983

by

MATTHEW BENDER & COMPANY
INCORPORATED

All Rights Reserved
Printed in the United States of America

Table of Contents

VOLUME 1

Chapter 1

PREFILING CONSIDERATIONS

§ 1.01	Searches and Form of the Register	1-1
§ 1.02	Official Opinions of Registrability	1-14
§ 1.03	Rights Without Registration	1-17

Chapter 2

FILING REQUIREMENTS

§ 2.01	Who May File	2-1
§ 2.02	Form of Applications	2-15
	[1] Filing Requirements	2-15
	[2] Late Filing of Documents	2-42
	[3] Checklist for Filing	2-56
§ 2.03	Classification and Specification of Goods	2-58
§ 2.04	Simultaneous Registered User Entries	2-66
§ 2.05	Priority	2-68
§ 2.06	Part B Applications	2-81
§ 2.07	Special Provisions	2-89

TABLE OF CONTENTS

Chapter 3

ISSUES OF REGISTRABILITY

§ 3.01	Definition of a Mark and General Objections	3 -1
§ 3.02	Generic Objections	3-53
§ 3.03	Geographic Objections	3-71
§ 3.04	Surname Objections	3-96
§ 3.05	Descriptiveness Objections	3-112
§ 3.06	Other Objections to Inherent Registrability	3-146
§ 3.07	Citations of Prior Rights	3-163

Chapter 4

PROSECUTION

§ 4.01	Procedure	4-1
§ 4.02	Consents By Owners of Prior Rights	4-40
§ 4.03	Notice to Owners of Prior Rights	4-45
§ 4.04	Proof of Secondary Meaning	4-47
§ 4.05	Disclaimers	4-64
§ 4.06	Amendment of Goods	4-71
§ 4.07	Amending Form of Mark	4-75
§ 4.08	Conditions of Registration	4-78
§ 4.09	Associated Registrations	4-81

TABLE OF CONTENTS

v

Chapter 5

OTHER FORMS OF REGISTRATIONS

§ 5.01	Defensive Registrations	5-1
§ 5.02	Certification Registrations	5-10
§ 5.03	Honest Concurrent Use Registrations	5-17
§ 5.04	Collective Mark Registrations	5-26
§ 5.05	Other	5-39

Chapter 6

POST REGISTRATION REQUIREMENTS

§ 6.01	Requirements of Proving Use	6-1
§ 6.02	Marking	6-11
§ 6.03	Incontestability	6-21
§ 6.04	Alterations of Registration	6-31
§ 6.05	Effect of Registration	6-42
	[1] Right of Use	6-42
	[2] Geographic Coverage of Registration	6-47
§ 6.06	Rights of Owners of Lapsed Registrations	6-50

Chapter 7

RENEWAL

§ 7.01	Term of Registration and Requirements for Renewal	7-1
§ 7.02	Proof of Use at Renewal	7-18

TABLE OF CONTENTS**Chapter 8****OPPOSITIONS**

§ 8.01	Term and Procedure	8-1
§ 8.02	Basis and Standing	8-20

VOLUME 2**Chapter 9****CANCELLATIONS**

§ 9.01	Procedure	9-1
§ 9.02	Basis and Standing	9-17
[1]	Rights	9-17
[2]	Non-Use	9-40

Chapter 10**INFRINGEMENT**

§ 10.01	Standing and Basis	10-1
[1]	Prior Registration	10-1
[2]	Prior Use	10-18
[3]	Other	10-44
[4]	Defenses	10-73
§ 10.02	Similarity of Marks and Goods	10-99
§ 10.03	Procedure	10-144
§ 10.04	Relief	10-158
[1]	General	10-158
[2]	Preliminary Relief	10-174
[3]	Bars to Importation at Customs	10-186

Chapter 11**LICENSING**

§ 11.01	Permissibility and Requirements	11-1
§ 11.02	Requirement to Record	11-24
§ 11.03	Procedure for Recording	11-33

Chapter 12**CHAIN OF TITLE**

§ 12.01	Permissibility and Requirements	12-1
§ 12.02	Requirement to Record	12-16
§ 12.03	Procedure for Recording	12-22

Chapter 13**TREATIES**

§ 13.01	Paris Convention	13-1
[1]	Introduction	13-1
[2]	Priority	13-6
[3]	Requirement of Use	13-8
[4]	Independence of Marks	13-9
[5]	Well-known Marks	13-9
[6]	Unregistrable Marks	13-10
[7]	Assignments	13-12
[8]	Telle-quelle	13-12
[9]	Service Marks	13-15
[10]	Wrongful Registration	13-15
[11]	Collective Marks	13-16
[12]	Trade Names	13-16
[13]	Bars at Importation	13-17
[14]	Unfair Competition	13-17

TABLE OF CONTENTS

§ 13.02 Madrid Union	13-19
[1] Introduction	13-19
[2] Records and Searches	13-21
[3] Applications	13-23
[4] Prosecution	13-28
[5] Grant of Registration	13-33
[6] Post Registration	13-34
[7] Renewals	13-38
[8] Cancellations	13-41
[9] Assignments	13-43

Appendix A
CLASSIFICATION SYSTEMS

Appendix A1: International Classification of Goods and Services	App. A1-1
Appendix A2: Other Classification Systems in Use	App. A2-1
Appendix A3: Former Classification Systems	App. A3-1

Appendix B
FORMS

Index	I-1
-------------	-----

VOLUME A
STATUTES AND REGULATIONS**AUSTRALIA**

Trademarks Act, 1955 as amended to 31 July 1980	Austl-3
Trademarks Regulations as amended to 29 February 1980	Austl-55

TABLE OF CONTENTS

viii (a)

AUSTRIA

Law of 18 August 1970 as amended 17 June 1977 and 3 December 1981	Aus-3
--	-------

BENELUX

Unified Benelux Trademarks Act (effective as of 1 January 1971) ...	BNX-3
---	-------

BRAZIL

Patent and Trademark Law No. 5772 of 31 December 1971	Braz-3
Sections of Decree—Laws Nos. 7903 and 8481 of 27 August and 27 December 1945, respectively	Braz-36

CANADA

Trademarks Act of 1952-53 as amended to July 1976	Can-3
Trademarks Regulations of 1954 as amended to March 1980	Can-53

(Continued on page ix)

TABLE OF CONTENTS

ix

FRANCE

Law No. 64-1360 of 31 December 1964 as amended to Law No. 75-536 of 30 June 1975	Fr-3
---	------

GERMANY (WEST)

Trademark Law of 2 January 1968 as amended to 1 April 1979	Ger(W)-3
Regulations for Trademark Applications of 16 October as amended to 1 July 1979	Ger(W)-27

HONG KONG

Trademarks Ordinance No. 47 of 1954 as amended to Ordinance No. 55 of 1977	HK-3
Trademarks Rules of 1954 as amended to 31 July 1981	HK-48

VOLUME B

ITALY

Trademark Law-Decree No. 929 of 21 June 1942 and select pro- visions of the Civil and Penal Codes	Italy-3
Trademark Regulations-Decree No. 795 of 8 May 1948	Italy-31

JAPAN

Trademark Law, No. 127 of 3 April 1952 as amended by Law No. 140 of 1962, No. 161 of 1962, No. 148 of 1964, No. 81 of 1965, No. 91 of 1970, No. 46 of 1976, No. 27 of 1978 and No. 89 of 1978	Japan-3
--	---------

(Pub.425)

TABLE OF CONTENTS

KOREA (SO.)

Trademark Law as amended to Law No. 3326 of 31 December 1980	S.Korea-3
Trademark Enforcement Regulations of 1 September 1981	S.Korea-25

MEXICO

Law on Inventions and Marks of 1976 as amended to August 1980	Mex-3
Regulations of the Mexican Law on Inventions and Marks of 1 September 1981	Mex-58

SWITZERLAND

Federal Law of 26 September 1980 as amended	Switz-3
Rules of Practice of 24 April 1929 as amended	Switz-19
Federal Council Resolution of 4 November 1966	Switz-36

UNITED KINGDOM

Trade Marks Act, 1938	UK-3
Trade Marks Rules of 6 July 1938, No. 661 as amended to Amendment No. 221 of 6 May 1980	UK-57

UNITED STATES

Trademark Act of 1946 as amended and selected other statutes	US-3
Trademark Rules of Practice (37 CFR)	US-43

CHAPTER 9

Cancellations

SYNOPSIS

§ 9.01 Procedure

§ 9.02 Basis and Standing

[1] Rights

[2] Non-Use

§ 9.01 Procedure

Australia

An application for rectification or cancellation may be made to the Supreme Court of a State, the Supreme Court of the Australian Capital Territory, the Supreme Court of the Northern Territory of Australia or the Supreme Court of Norfolk Island by an “aggrieved” person¹ or by the Registrar if it is in the public interest.² When an application is made by an “aggrieved” person, the Registrar may appear and be heard.³ The procedure is similar to the procedure in an infringement action.⁴ A non-use cancellation is before the Patent Office.⁵

Australia

¹ Act, Section 22(1).

² Act, Section 22(4).

³ Act, Section 22(5).

⁴ See § 10.03 *infra*.

⁵ See § 9.02[2] *infra* for the procedure in a non-use cancellation.

Austria

A mark is cancelled if:¹

- (a) the owner requests it;
- (b) it is not renewed on time;
- (c) rights have lapsed for reason other than (a) or (b);
- (d) there is a final decision by the Nullity Section granting cancellation in a cancellation suit.

An action for cancellation proceeds before the Nullity Division and may be initiated upon request of a party, but the Patent Office may proceed with the cancellation even though the original action is withdrawn.² A petition for cancellation³ must include a summary of the reasons the registration is claimed to be invalid and an outline of the evidence to be used in support of the cancellation request.⁴ If the plaintiff is not an Austrian domiciliary, the trademark owner may, within fourteen days, request security for costs.⁵ The cancellation may be filed by a local associate with a power of attorney which may follow.⁶ The action for cancellation may be rejected ex-parte by the Nullity Division if it is not based on valid reasons for cancellation.⁷ The cancellation may be for all or for only part of the registered goods or services. After its filing, the registrant is sent a copy of the action for cancellation and given a period within which to reply. If no timely reply is given, the registration is cancelled.⁸

If the registrant replies, the parties may then take part in preliminary proceedings to clarify the issues and to take evidence.

Austria

¹ Law, Article 29(1).

² Patent Law, Article 112 adopted by Law, Article 42.

³ See § 9.02 *infra* for details as to the substantive issues of cancellation.

⁴ Patent Law, Article 114 adopted by Law 42.

⁵ Patent Law, Article 112 adopted by Law, Article 42. But see Section 17 of the Hague Trial Agreement which exempts parties of signatories to the convention from granting security. This applied to proceedings before the Patent Office in Austria. See Decision of the Nullity Division dated 19 September 1975, PatB1. 1976 122, 1977 IIC Abstract No. 567.

⁶ Law, Article 61(6).

⁷ Patent Law, Article 113 adopted by Law, Article 42.

⁸ Law, Article 42(4).

Such proceedings are highly unusual and practically never occur. When the preliminary proceedings, if any, are complete,⁹ an oral hearing is scheduled.¹⁰ The hearing is a trial at which the parties may introduce evidence through witnesses, through the sworn statements of parties or through the prior testimony of witnesses who testified during the preliminary proceedings.¹¹

The decision of the Nullity Division then issues and includes a summary of the facts and the arguments of the parties and advice regarding appeal.¹² Costs are usually awarded to the successful party.¹³ An appeal from the Nullity Division to the Supreme Patent and Trademark Senate¹⁴ is possible and must be made within two months of the decision.¹⁵

The Senate only reviews the decision of the Nullity Division and does not hear new evidence.¹⁶ The Senate may, in certain circumstances, issue a decision without an oral hearing. However, it must have an oral hearing if either party requests it and such a hearing is held in most instances.¹⁷

Benelux

A cancellation action is brought in a court in one of the Benelux countries. The court with jurisdiction is that of the residence or domicile of the registrant. The place where the mark was registered is not sufficient grounds for basing jurisdiction.¹ If registrant has no residence or domicile, then the residence, domicile or abode in Benelux of the cancellor controls.² If cancellor also has no such

⁹ Patent Law, Article 116 adopted by Law, Article 42. Professor Schönherr advises that those proceedings almost never occur.

¹⁰ Patent Law, Article 118 adopted by Law, Article 42.

¹¹ Patent Law, Articles 119-120 adopted by Law, Article 42.

¹² Patent Law, Article 123 adopted by Law, Article 42.

¹³ Patent Law, Article 122 adopted by Law, Article 42.

¹⁴ Law, Article 39(1).

¹⁵ Patent Law, Article 138 adopted by Law, Article 42.

¹⁶ Patent Law, Article 140 adopted by Law, Article 42.

¹⁷ Patent Law, Articles 142-3 adopted by Law, Article 42.

Benelux

¹ Law, Article 37. (a) The different available courts are those of Belgium, the Netherlands and Luxembourg.

² *Id.*

residence, domicile or abode in Benelux, he may bring the action in any jurisdiction.³

The procedure is different for each jurisdiction and follows the same procedure as in actions for infringement.⁴

Any interested party or the Public Prosecutor may institute the action; if the Public Prosecutor brings the action, it must be in the courts of The Hague, Brussels or Luxembourg.⁵

After a judicial decision of the nullity of a registration, the cancellation of that registration takes place *ex-officio* or at the request of any party.⁶

Brazil

There are four ways a registration may be cancelled:

- (a) Extinction—the registration was not renewed or was voluntarily surrendered;¹
- (b) Forfeiture—the registration lapsed through non-use;²
- (c) Administrative Revision—the registration may be cancelled by the Patent Office within six months of the registration as improperly granted.³ When the granting of a registration violates any provision under Title II of the Act,⁴ the Patent Office has six months from acceptance to review the registration.⁵ If the Patent Office institutes a revision of the registration, it notifies the registrant who may file a defense within sixty (60) days.⁶ A decision must issue within sixty (60) days⁷ and can be appealed within another sixty (60)

³ *Id.*

⁴ See § 10.03 *infra*.

⁵ Law, Article 37.

⁶ Rules, Article 10(4).

Brazil

¹ Law, Article 93(1) and (2).

² Law, Articles 93(3) and 94–97; See § 9.02[2] *infra*.

³ Law, Article 101.

⁴ *Id.*

⁵ Law, Article 101(1).

⁶ Law, Article 101(2).

⁷ *Id.*

⁸ Footnote omitted.

days;⁸

- (d) Annulment—the registration may be cancelled by a court procedure.⁹ The proceeding may be instituted by any concerned party or by the National Institute of Industrial Property.¹⁰ The procedure is the same as that for an infringement action.¹¹ At the termination of the action, the result is recorded in the official record of the registration.¹² In fact, any cancellation (as well as any suspension, limitation or expiration) by administrative or judicial decision must be recorded.¹³

Foreign registrants must appoint an agent in Brazil which appointment becomes effective as of the date of filing and remains in effect throughout the entire registration period. If such an agent is not appointed, the registration is automatically cancelled.¹⁴

An appeal of a decision in the cancellation may be taken within sixty (60) days.¹⁵

Canada

A cancellation action may be filed by any person or the Registrar before the Federal Court of Canada.¹ Such an action may be filed for complete or partial cancellation or for the correction of the dates expressed in the registration, such as the claimed date of first use.²

Cancellation proceedings are instituted by the filing of an originating notice of motion or by introducing the claim in an existing action, such as by way of a counterclaim in an infringement

⁸ Law, Article 101(3).

⁹ Law, Articles 98–100.

¹⁰ Law, Article 100.

¹¹ See § 10.03 *infra*.

¹² Law, Article 88(3).

¹³ *Id.*

¹⁴ Law, Article 96.

¹⁵ Law, Article 97.

Canada

¹ Act, Section 57(1).

² *Id.*