

World
Trademark
Law and
Practice

1

Ethan Horwitz

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WORLD TRADEMARK LAW AND PRACTICE

by

ETHAN HORWITZ

Member of the New York Bar

VOLUME 1



MATTHEW
BENDER

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CHAPTER 1

Prefiling Considerations

§ 1.01 Searches and Form of the Register

Argentina

Applications for registration and renewal are recorded by the National Board of Industrial Property showing:¹

- (a) the date and hour of filing;
- (b) the application number;
- (c) the mark;
- (d) the applicant's name and address; and
- (e) the products or services.

Registrations and pending applications are open to the public and where a final decision has been rendered in an application, an interested person may obtain copies of the file.²

Registrations, renewals, reclassifications, transfers, abandonments, refusals to register, cancellations, changes in the registrant's name are all published by the National Board³ in the *Revista* ⁴ and list:⁵

- (a) the mark;
- (b) the number of any decision;
- (c) the registrant's name;

Argentina

¹ Law, Article 43.

² Law, Article 22.

³ Law, Article, 45.

⁴ Regulations, Article 27.

⁵ Regulations, Article 28.

- (d) the products or services and their classification; and
- (e) the registration number of the Patent Agent, if one is used.

A publication of an assignment lists only the new registered owner's name, the registration number, the class, recordal date and the registration number of the Patent Agent, if any.⁶

A request for a certified copy of a registration must include a description of the mark and proof of payment of fees. A single request can be submitted to obtain several copies of the same registration⁷. A certificate listing the mark, the goods, the registration date and number, the registrant's name and other pertinent file data can be requested by any interested party.⁸

Denmark

The Trademark Register contains details of all registrations, including:¹

- (a) the application's filing date and time;
- (b) the date of publication;
- (c) the registration date and number;
- (d) the applicant's name or firm, business, trade, profession or occupation, place of business and postal address;
- (e) the classes of the goods or services of the registration;
- (f) any claim to a right of priority; and
- (g) the name and place of business of an agent, if the applicant is not domiciled in Denmark.

Anyone may inspect the Trademark Register, obtain extracts of it or ascertain if a mark is registered.²

⁶ *Id.*

⁷ Regulations, Article 24.

⁸ *Id.*

Denmark

¹ Rule 8(1).

² Law, Section 45.

The Register may be amended to reflect changes in previous entries³ or changes in agent.⁴ Entries may be made on the Register as to assignments,⁵ the granting or termination of licenses,⁶ pledges or levy of executions.⁷ A registration may be removed from the Register⁸ or amended by minor insignificant alterations not affecting the general appearance or overall impression of the mark.⁹

Ireland

The Trademark Register contains details of all registered marks including:¹

- (a) the names, addresses and descriptions of their proprietors;
- (b) assignments and transmissions;
- (c) the names, addresses and descriptions of all registered users;
- (d) disclaimers, conditions, limitations and all other pertinent data.

The Register may be corrected for errors and for changes in names, addresses or descriptions.² Registrations may be cancelled in whole or in part,³ and, provided existing rights are not extended, goods may be amended and disclaimers or memoranda entered on the Register.⁴

³ Rule 13(1).

⁴ Rule 12(1).

⁵ Law, Section 33; Rule 10(1) See Chapter 12 *infra*.

⁶ Law, Section 34; Rule 11(1). See Chapter 11 *infra*.

⁷ Law, Section 35; Rule 11(2).

⁸ Law, Section 25; Rule 16(1). See Chapter 9 *infra*.

⁹ Law, Section 24; Rule 9(1). See §6.04 *infra*.

Ireland

¹ Act, Section 9(1).

² See §6.04 *infra*.

³ See Chapter 9 *infra*.

⁴ See §6.04, *infra*.

The Register is open for public inspection⁵ as are certification mark regulations; letters of consent; opposition notices and counter-statements; and applications for Register rectification and counter-statements.⁶ In addition, applications which are pending and which have been advertised in the Journal for entry on the Register are also open for inspection; these include applications for registration, for assignment or transmission, for alteration of address, for correction of register, for alteration of a registered mark, for rectification of certification mark entries, for registered user, or for applications to vary or cancel the registration of a registered user.⁷ Any information, which might be of interest to rivals in trade, will not be disclosed until time is allotted for objections to such disclosure.⁸

South Africa

The Trademarks Register is maintained in the Trademark Office in Pretoria¹ and contains details of all applications and registrations, namely:²

- (a) the names and addresses of their proprietors and registered users;
- (b) the date of registration and expiration;
- (c) all assignments, transmissions and disclaimers;
- (d) the mark and goods or services of the registration or application; and
- (e) any other matter pertinent to the registration.

⁵ Act, Section 9(3); Rule 104(1). Fees for inspections of the Register are payable at the Office. Rule 5(3).

⁶ Rule 106(1).

⁷ *Id.*

⁸ Rule 106(2).

South Africa

¹ Act, Section 5.

² Act, Section 31(1); Regulation 37.

The Register may be corrected for clerical errors and for the entry of changes of name, changes of address or changes of address for service.³ Registrations may be cancelled⁴ or the mark amended in a manner not substantially affecting the identity of the mark. The goods or services may be restricted but not expanded.⁵

The Register is open for public inspection⁶ and, upon the payment of the required fee, a certified copy of any entry in the Register may be obtained.⁷

The files relating to applications are not officially available for inspection.⁸

§ 1.02 Official Opinions of Registrability

No provisions regarding official opinions of registrability exists under the laws of:

Argentina

Denmark

Ireland

Upon a written request, a party may request the Controller's advice regarding the distinctiveness of a mark, namely whether it is inherently adapted to distinguish and thus is registrable in Part A or whether it is capable of distinguishing and thus registrable in Part B.¹ The application must include a statement of the goods, the fee

³ See §6.04 and Chapter 12 *infra*.

⁴ See §9.02 *infra*.

⁵ See §6.04 *infra*.

⁶ Act, Section 31(5).

⁷ Act, Section 31(6). Form TM 48.

⁸ In *Silver Seiko Co. Ltd. v. Kaisha*, 1982(1)SA623(T), [1982] EIPR D-208, Silver Seiko applied for SILVER REED for musical instrument and was opposed by Kaisha who owned the mark SILVER for goods in the same class. To obtain its registration, Kaisha had proven that its mark was distinctive through use and Seiko requested from the Registrar leave to inspect the evidence filed. The Registrar refused and Seiko appealed. The appeal was dismissed as the refusal was within the administrative prerogative of the Registrar.

or proof of fee payment and three copies of the mark.²

The opinion of the controller is not final, but if registration is sought within three months of a decision by the Controller that the registration is allowable and the Controller then reverses his decision and objects to the registration, all fees will be repaid if the application for registration is withdrawn within two months of the objection.³

Upon written request and payment of fee, the Controller will search the records for marks similar to the mark on the search application. Additional fees are required where there is more than one class of goods.⁴

South Africa

Upon request, the Registrar will search any class for specified goods or services and will advise the party of any marks which may be considered similar.¹

§ 1.03 Rights without Registration

Argentina

The ownership of a mark and the exclusive right to its use is only through registration.¹ However, a person who has used a mark may have:²

§ 1.02

Ireland

¹ Act, Section 48(1).

² Act, Section 48(2); Rule 16(1).

³ Act, Section 48(3); Rule 16(2).

⁴ Rule 109.

South Africa

¹ Regulation 70, Form TM 25.

§1.03

Argentina

¹ Law, Article 4.

² Aracama Zorraquin, *The Argentine System of Industrial Property*, 1967 Ind. Prop. 228, 234.

- “(a) the right to oppose the registration of any other mark which, directly or indirectly, would be capable of causing confusion with the goods which his own mark distinguishes;³
- “(b) the right to request the nullification of the registered mark which are of the kind referred to above;⁴ and
- “(c) the right to request, on a similar basis, discontinuance of the unlawful use of his own mark by an unauthorized third party, either as a mark or as a trade name or style.”⁵

Denmark

Rights in a mark can be obtained without registration if that mark has become established, i.e. if through use or other circumstances the mark has become known in Denmark within the pertinent trade as a distinctive mark for the user's goods or services.¹

Anyone can use his own name, the name of his firm or of his real property as a mark, but only in a way which is not likely to cause confusion with another's trade mark.² However, another's name, firm name or distinctive name of his real property may not be used as a mark without consent.³

Rights cannot be obtained, either through use or registration, for a mark which is liable to be confused with another mark already used in Denmark by another. Similarly, rights cannot be obtained to a mark already in use abroad by another if the user in Denmark knew the mark of that party or ought to have known it.⁴

³ See §8.02, *infra*.

⁴ See §9.02[1], *infra*.

⁵ See §10.01 [2], *infra*.

Denmark

¹ Law, Section 2. In fact, “the mere use of a mark creates a protection equalling that obtained by registration”. Torfing, *The New Danish Trade Mark Act, 1960*, 52 TMR 378 (1962).

² Law, Section 3.

³ *Id.*

A prior user with rights may oppose,⁵ cancel⁶ or sue for infringement.⁷

Ireland

Anyone who has used a mark has rights to the mark even though the mark is not registered. The user of the unregistered mark may not institute infringement actions¹ but may be entitled to bring a passing-off action.² Such user may file oppositions³ and rectification actions⁴ based on his rights.

An owner of a mark can not prevent a third party from using the same or similar mark where that party has used the mark continuously prior to the use or registration of the mark by the owner of the mark.⁵ Nor can the owner prevent that party from obtaining an honest concurrent use registration.⁶

Registration of a mark cannot prevent the *bona fide* use of a person's name or the name of his business or that of his business predecessors or the *bona fide* description of the character or quality of the goods.⁷

⁴ *Id.* "Danish trade mark law recognizes that title to a trade mark can be acquired by use as well as by registration, but if the use relied on is use abroad, the first user in Denmark is recognized as the proprietor of it unless he knew of use abroad when he adopted the mark. In that case the foreign user has priority." [1981]EIPR D-28.

⁵ See §8.02, *infra*.

⁶ See §9.02 [1], *infra*.

⁷ See §10.01 [2], *infra*.

Ireland

¹ See §10.01 [1] *infra*.

² See §10.01 [2] *infra*.

³ See §8.02 *infra*.

⁴ See §9.02 [1] *infra*.

⁵ Act, Section 15.

⁶ *Id.* See §5.03 *infra*.

⁷ Act, Section 16.

South Africa

A party who has used a mark (user) without registering it has certain rights to the mark. The user may not sue for infringement¹ but may possibly sue for passing off.² The user may oppose³ and may file rectification (cancellation) actions based on his rights if he is an aggrieved person.⁴

A user of a mark may continue the use of the mark without interference by a subsequent registrant of a similar mark for similar goods or services, but only if such use has been continuous prior to both the use and registration of the registrant.⁵ The registrant may not prevent such a user registering his mark as an honest concurrent user.⁶

No registrant may interfere with the *bona fide* use of a person's name, business name or the names of his predecessors or the use of a *bona fide* description of the character or quality of the goods or services.⁷

South Africa

¹ See § 10.01 *infra*.

² *Id.*

³ See § 8.01 *infra*.

⁴ See §9.02 *infra*.

⁵ Act, Section 45.

⁶ *Id.* See §5.03 *infra* for details on honest concurrent use.

⁷ Act, Section 46.

CHAPTER 2

Filing Requirements

§ 2.01 Who May File

Argentina

Anyone with a legitimate interest may file for registration of a mark.¹

An application for registration may be in the name of more than one person.² Unless stipulated otherwise, each owner can independently use the mark and can independently file an opposition, and protect his rights in the mark. However, all owners must act in unison to license, transfer or renew the mark.³

Denmark

Persons, firms or companies in a trade or business may apply for registration of marks for goods and services offered by them.¹ There

Argentina

¹ Law, Article 4. Under old case law, the only persons who could register a mark were industrialists, merchants, agriculturists or those engaged in mining activities. Case law was liberalizing this strict limitation but the new law changed the entire system, allowing any party with a legitimate interest to register the mark. The new provision's limitations are not clear and case law will have to further define this provision. Aracama Zorraquin, *New Legislation in Argentina*, 1982 Ind. Prop. 88, 90.

² Law, Article 9.

³ *Id.* See also Aracama Zorraquin, *The Argentine System of Industrial Property*, 1967 Ind. Prop. 228, 231 for an explanation of the prior law on joint ownership of a mark.

Denmark

¹ Law, Section 1.

is no requirement that the applicant use the mark or even intend to use the mark.²

An agent or distributor may register the mark of his supplier or manufacturer, but must be prepared to assign the registration to the true owner when requested to do so.³

Ireland

Anyone using or proposing to use a mark may apply for its registration.¹ The use or proposed use must be in the course of

² Torfing, *The New Danish Trade Mark Act, 1960*, 52 TMR 378, 380 (1962).

³ *Id.* at 385. The article states:

"In consequence, the licensing of a trademark has not been considered any problem, and it has been deemed irrelevant whether for instance an American mark is registered by the American holding company, by an American or English affiliated Company, or by a Danish licensee or agent. The registration is considered simply as having been made in the common interest of the 'Trademark Family.' As a matter of fact, this creates an atmosphere of relaxation within the family. If a Danish agent who has obtained registration of his American supplier's trademark should try to establish an independent right of his own to the mark the judge will kindly point out that as he has no doubt registered the mark on behalf of and in the interest of his supplier he must naturally be prepared to assign the registration to the supplier if and when the supplier so requests. And if an exclusive agent attempts to vindicate his sole distributor's right by means of a trademark registration, he will be told that the importation of 'original goods' through outsiders cannot be regarded as a trademark violation. This does not mean that Danish law tends to defeat sole distributing rights, but such rights must be secured by suitable contractual arrangements."

Ireland

¹ Act, Section 25(1). In *Penneys Ltd. v. Controller*, decision of the High Court, No. 478 Sp of 27 June 1980, [1980] EIPR D-335. Pursuant to a settlement between the parties, Penneys Ltd. applied for the mark PENNEY and was obligated to later assign it to J.C. Penney Company Ltd. who would license it back to applicant. The Controller rejected the application, inter alia, because applicant was not the proprietor of the mark. The High Court held that it made no difference that applicant only intended to be the registered user of the mark and not the proprietor of it and that applicant's intentions with respect to future use are only relevant if the mark has not been used prior to application.

trade² and may be by the owner of the mark or by his registered user. However, the application cannot be refused if it is in the name of a body corporate to be formed.³

South Africa

Anyone who claims to be the owner of a mark “used or proposed to be used by him” may apply for registration of that mark.¹ The use or proposed use must be by the owner or by his registered user.²

While the mark must be used in relation to the goods or to the performance of the services,³ use may include any printed or visual representation, any audible reproduction or, in the case of a container, it may include use of that container.⁴

It is also possible to file in the name of a body corporate about to be constituted.⁵

² See §2.03 *infra* fn 2.

³ Act, Section 37(1). See §2.04 *infra*.

South Africa

¹ Act, Section 20(1). The registration must be by the owner. Where an importer of American writing instruments attempted to register the manufacturers mark EVERGLIDE, it was refused. 1971 Ind. Prop. 216. See also *Broadway Pen Corp. v. Wechsler & Co. (Pty.) Ltd.* 1963 (4) S.A. 434 (T.P.D.). In another case, *Burger King Corp. v. S.A. Wimpy (Pty) Ltd.*, the court held that as applicant was aware of the reputation of the same mark owned by another in the United States, applicant was not the true proprietor of the mark and the applicant was denied.

² Act, Section 24(1)(b) See §11.01–11.03, *infra*. for details of registered users.

³ Act, Section 2(3).

⁴ Act, Section 2(2).

⁵ Act, Section 24(1)(a), See §2.04 *infra*.