

ARNOLD RUESS

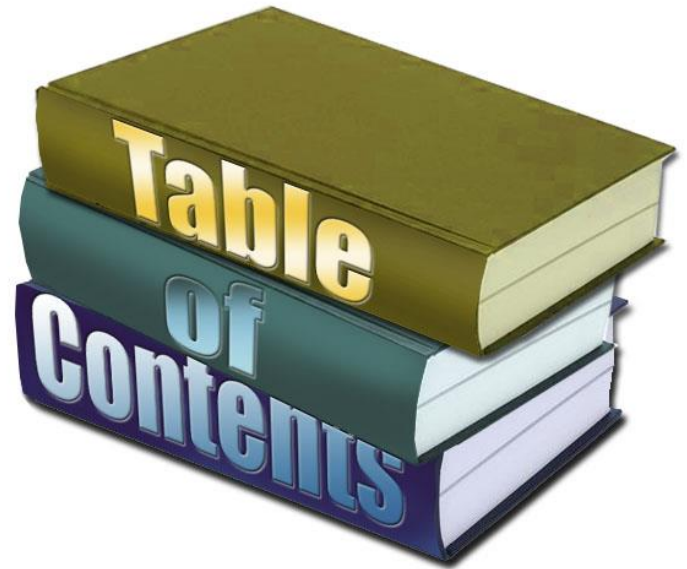
RECHTSANWÄLTE UND FACHANWÄLTE
FÜR GEWERBLICHEN RECHTSSCHUTZ

***Trademark Distinctiveness and
Trademark Office Decisions:
Is it time to look beyond borders?***

**Fordham IP Conference, 5 April 2013
Prof. Dr. Peter Ruess, LL.M.**

Overview

- The Introduction: Apple v. Gradiante case
- The issue
- The law
- The reality
- The vision



The Apple v. Gradiante Case 1/3

Brazilian Law No. 9.279 of May 14, 1996 (Industrial Property Law)

§ 124. The following are not registrable as marks:
[...]



XIX. reproductions or imitations, in whole or in part, even with an addition, of a mark registered by another party, to distinguish or certify an identical, similar, or alike product or service, likely to cause confusion or association with the other party's mark.

The Apple v. Gradiante Case 2/3

INPI Reg. # 822112175 (earlier priority)



INPI Reg. # 828743193

IPHONE
iPhone

The Apple v. Gradiante Case 3/3

- INPI refused to register Apple's TM
- Apple sued Gradiante, alleging „iPhone“ to be a descriptive term
- Lawsuit pending in Brazilian Federal Court, docket no. 0490011-84.2013.4.02.5101.



The issue

- TM owner can claim mark to be descriptive in market A, yet not in market B
- Problem: English term which is not descriptive in US / UK might be equally distinctive in countries where English not even mother tongue in absence of shift in meaning
- Strategically fine to proceed like Apple
- Can / should offices be able to decide this as they please?



Deutsches
Patent- und Markenamt



The law



- ECJ, opinion dated 12 February 2009
 - German court referred issue to ECJ, dec. C-39/08, 43/08
 - Member states officials must consider decisions pertaining to similar applications and focus on whether to take a decision in line with the „precedent“ or not,
 - They are not bound by said previous decisions

- Consequences
 - No real „claim“ for same decision (and rightfully so)
 - Strong indication if e.g. trademark is considered distinctive in mother tongue (registered in country of origin) and applied for in country
 - Albeit this only applies to harmonised law, the German Federal Supreme Court has recognised indicative effect also outside EU under certain circumstances (BGH, GRUR 1999, 1096 – ABSOLUT).

The reality



OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
TRADE MARKS AND DESIGNS

- 19 Lastly, it is sufficient to recall in that regard that the Community trade mark regime is an autonomous legal system with its own objectives which are peculiar to it; it applies independently of any national system. Accordingly, the registrability or protectability of a sign as a Community trade mark is to be assessed on the basis of the relevant Community legislation alone. Consequently, neither the Office nor, as the case may be, the Courts of the European Union are bound by decisions adopted in a Member State, or a third country, finding a sign to be registrable as a national trade mark. That is so even if such a decision was adopted in a country belonging to the linguistic area in which the word mark in question originated (judgment of 29 March 2012, T-242/11, '3D eXam', para. 44)

The vision (*open for discussion*)

- Similar decisions will have to be considered and commented on by decision-making body (office, boards of appeal, court)
- No claim of body to decide that case exactly like „precedent“ as we do not have „precedential“ system and offices are independent
- Failure to comment on „precedent“ will lead to reversing and remanding case, but not automatically to decision along that lines
- Long-term goal is to achieve utmost conformity on issues such as descriptiveness in certain language by native speakers



Closing Remarks

„Whoever has visions should better go and quickly see a doctor“

Helmut Schmidt

German Chancellor (1974 – 1982)



Thank you for your attention!

PROF. DR. PETER RUESS
LL.M. IP (GWU, Washington)

ARNOLD RUESS
Kaiser-Wilhelm-Ring 19
D-40545 Düsseldorf, Germany
T +49 211 54 24 40 30
F +49 211 54 24 40 44
E ruess@arnold-ruess.com (Law Firm)
E peter.ruess@ism.de (University)

