



Rapisardi Intellectual Property

European IP Overview

Rapisardi Intellectual Property® - Confidential - 2013

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Topics

- **Who we are**
- **EU Facts & Figures**
- **Community Designs**
- **Community Trade Marks**
- **EU Customs Surveillance**

Who we are

Rapisardi Intellectual Property

- Founded in the early 1900's, the company is one of the most qualified intellectual property law firms, with offices in Milan (IT), London (UK) and Lugano (CH).
- IP boutique, provides a 360° specialized IP service, with departments dedicated to every single aspect of IP:
 - Legal consultancy, copyright, anti-counterfeiting → Attorneys-at-Law, Solicitors;
 - Trade marks → National and European Trade Mark Attorneys;
 - Patents → National and European Patent Attorneys;
 - Domain names → WIPO Domain Name Panelists;
 - Research and surveillance → research experts.
- Long-lasting and strong relationships with Clients and carefully selected Associates all over the world.
- Wide use of state-of-the-art IT tools and paperless office.

3 doors to correctly enter the European IP World



MILAN



LONDON



LUGANO

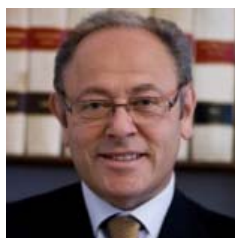
Rapisardi Intellectual Property



Mariacristina Rapisardi



Ugo Trojsi
*Patent
Department
Head*



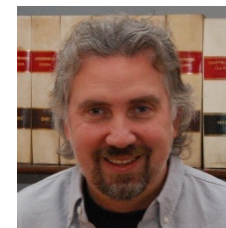
Gianluigi Volontè
*Trade Mark
Department
Head*



Rossella Solveni
*Law Office
Head*



Claudia Strola
*Research
Department
Head*



Andrea della Croce
*IT Department
Head*

The Team:

Senior Patent Attorneys



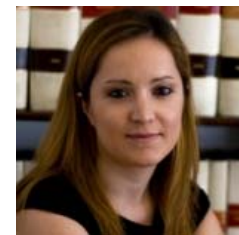
Ugo Trojsi
Patent Department Head



Giuseppe Mercurio
Patent Attorney



Catharina Waller
Patent & Trade Mark Attorney



Chiara Formenton
Patent Consultant

The Team:

Senior Trade Mark Attorneys



Gianluigi Volontè
Trade Mark Department Head



Paola Dalla Pozza
Head of Filings



Davide Taglia
Attorney-at-Law



Sonia Fodale
Trade Mark Attorney

The Team: The Lawyers



Rossella Solveni
Law Office Head



Alessandra Ferreri
Domain Names & Copyright



Davide Bresner
Anti-Counterfeiting



Wilma Zanin
Anti-Counterfeiting



Alessia Corciulo
Litigation



Chiara Mobidi
Litigation



Elena Cristofori
Litigation



Adam Goldman
Contract, Licensing & Transactions

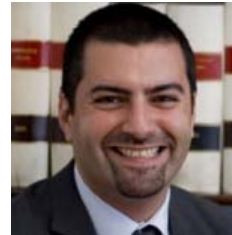
The Team: Other IP Seniors



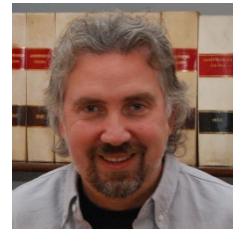
Claudia Monica Strola
Research Department Head



Antonella Santini
Research Consultant



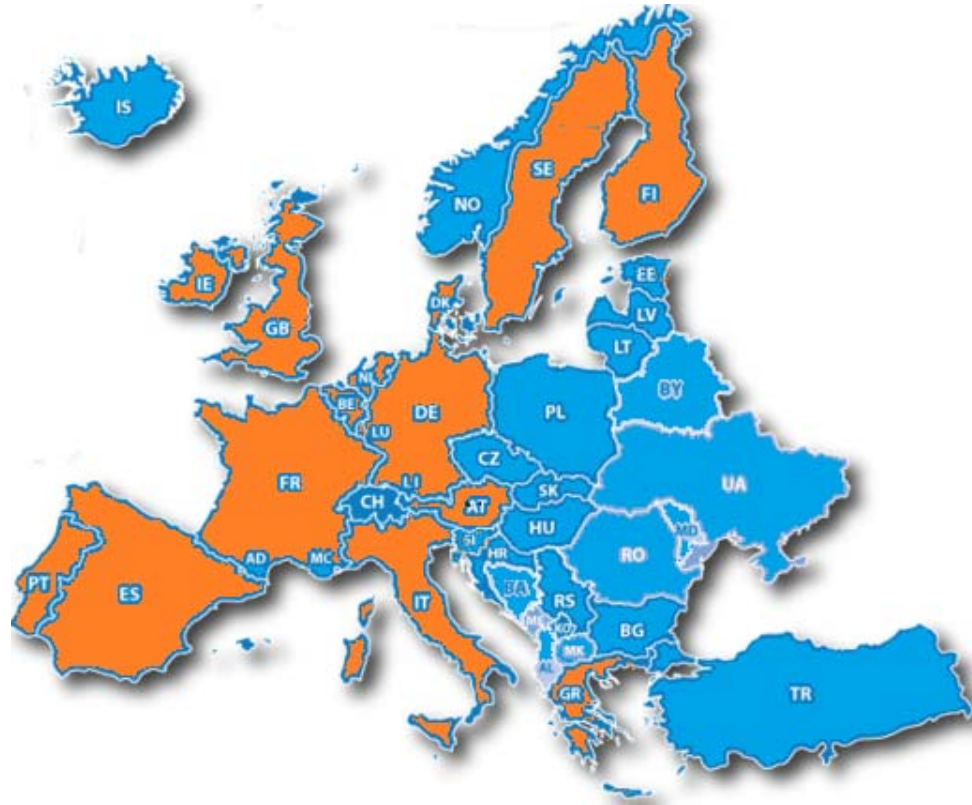
Alberto Giordano
Due Diligence & Valuation



Andrea della Croce
IT Department Head

EU Facts & Figures

European Union: 1st April 1996



Austria
Belgium
Denmark

Finland
France
Germany

Greece
Ireland
Italy

Luxembourg
Portugal
Spain

Sweden
The Netherlands
United Kingdom

European Union: 2004



Joining Countries:

Cyprus
Czech Republic
Estonia

Hungary
Latvia
Lithuania

Malta
Poland
Slovakia

Slovenia

European Union: 2007



Joining Countries:

Bulgaria
Romania

European Union: 1st July 2013



Croatia

European Union: The future



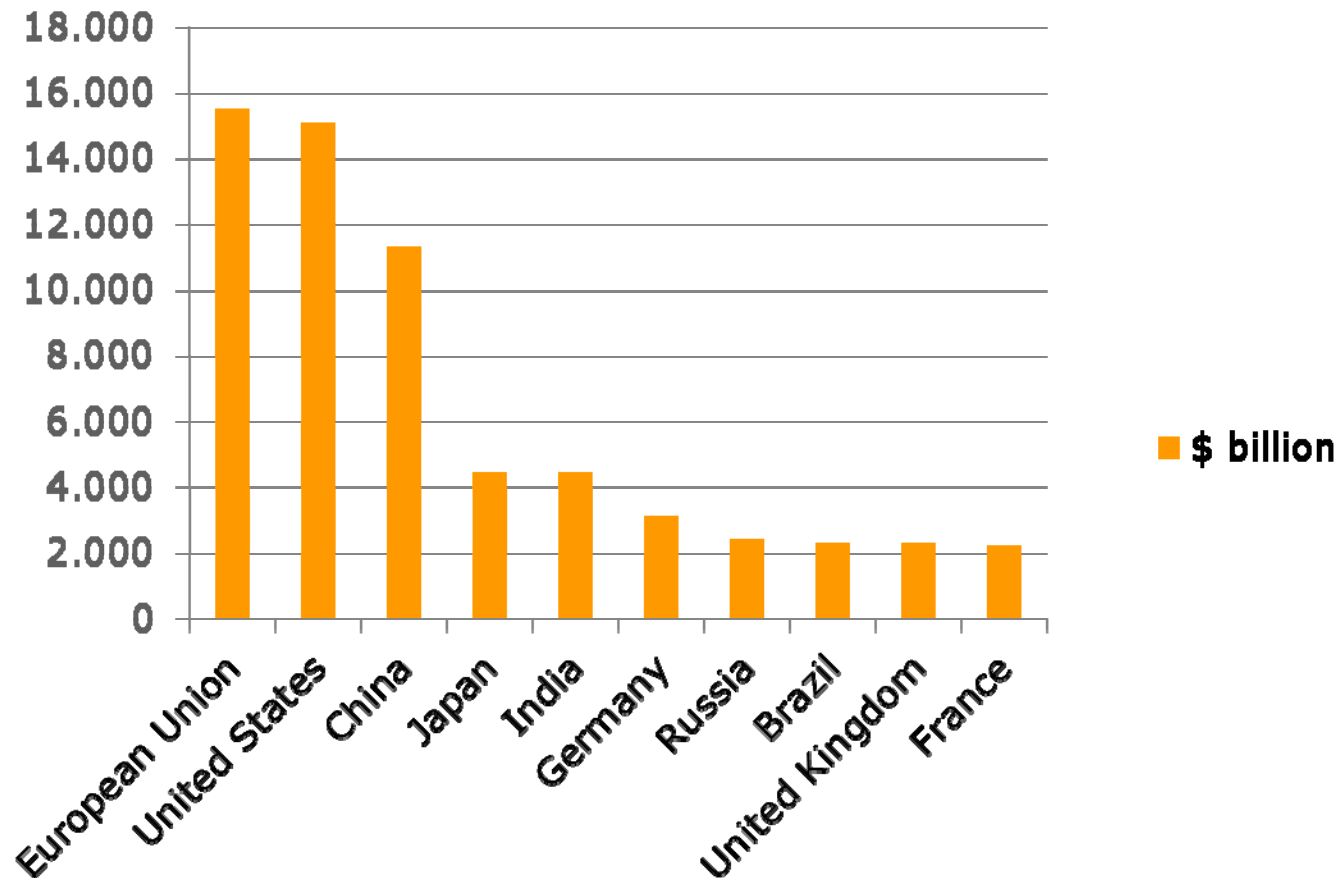
EU Countries

Austria	Finland	Latvia	Slovakia
Belgium	France	Lithuania	Slovenia
Bulgaria	Germany	Luxembourg	Spain
Cyprus	Greece	Malta	Sweden
Czech Republic	Hungary	Poland	The Netherlands
Denmark	Ireland	Portugal	United Kingdom
Estonia	Italy	Romania	Croatia (from 1 st July 2013)

EU information

- The EU covers over 4 million km², the population is over 500 million inhabitants (the world's third largest population after China and India).
- With just 7% of the world's population, the EU's trade with the rest of the world accounts for around 20% of global exports and imports.
- The EU is the largest world trading market.
- The EU is the world's biggest exporter and the second-biggest importer after the USA.
- The EU is the most important partner for trade agreements.

Top 10 World's gross domestic product (GDP)



Source: Central Intelligence Agency 2011

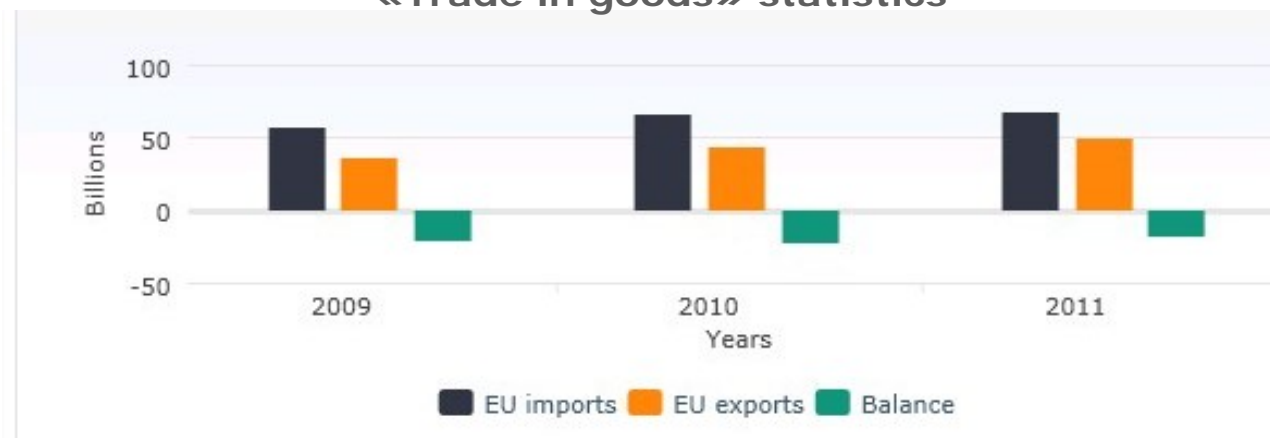
Japan-EU

- Together the EU and Japan account for more than a third of the world's GDP.
- Japan is the EU's second biggest trading partner in Asia, after China.
- Japan remains a major trade partner for the EU and Europe is a very important market for Japan. Japan is also a major investor in the EU.
- Imports from Japan to the EU are dominated by machinery and transport equipment and chemical products.
- EU exports to Japan are dominated by machinery and transport equipment, chemical products and agricultural products.

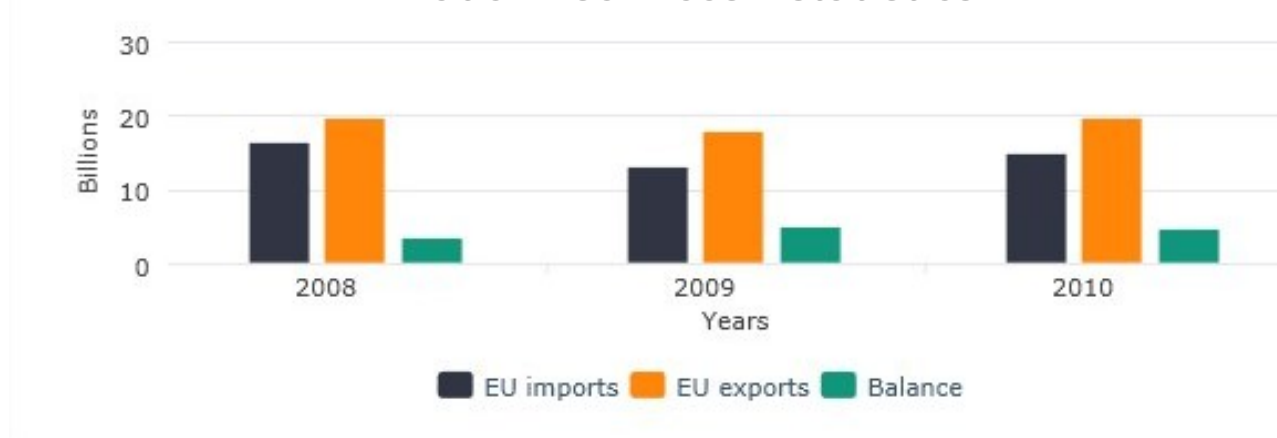
Source: European Commission – Directorate-General for Trade

EU-Japan trade statistics

«Trade in goods» statistics



«Trade in services» statistics



Source: European Commission – Directorate-General for Trade

EU/Japan Trade with Main Partners

EU's Trade					
Rank	Partner	%	Rank	Partner	%
1	USA	13.8	6	Turkey	3.7
2	China	13.3	7	Japan	3.6
3	Russia	9.5	8	India	2.5
4	Switzerland	6.6	9	Brazil	2.3
5	Norway	4.4	10	South Korea	2.1

Japan's Trade					
Rank	Partner	%	Rank	Partner	%
1	China	21.8	6	Thailand	4.0
2	U.S.	13.7	7	Indonesia	3.2
3	EU27	11.1	8	Hong Kong	3.2
4	South Korea	6.6	9	Saudi Arabia	3.0
5	Australia	4.4	10	Malaysia	2.9

Source: European Commission 2011

Community Designs

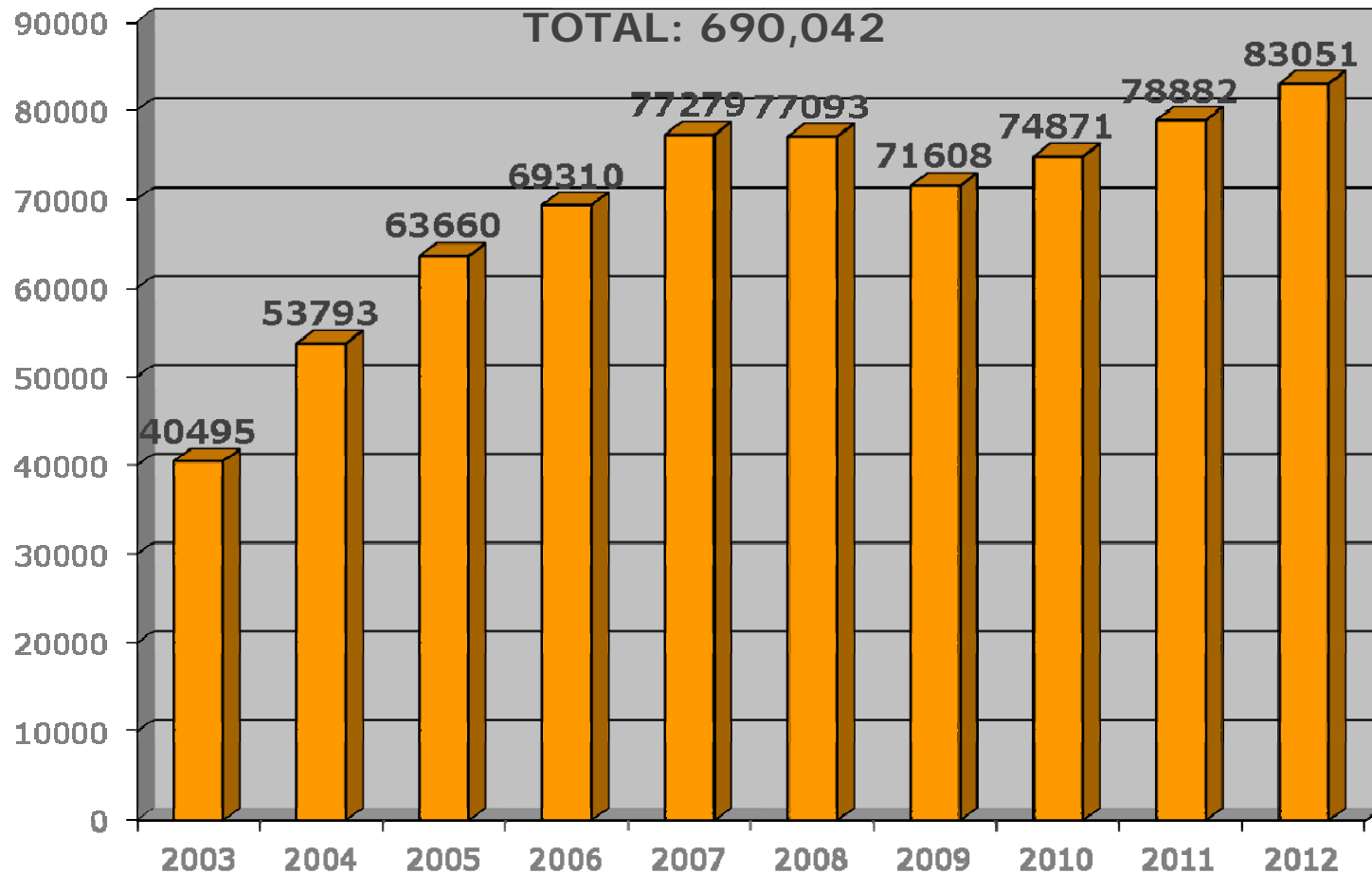
What is a Community Design?

A Registered Community Design (RCD) is an exclusive right for the outward appearance of a product or part of it, resulting from the features (in particular the lines, contours, colors, shape, texture and/or materials) of the product itself and/or its ornamentation.

Holders of valid registered designs have exclusive rights to use the design and to prevent any third party from using it anywhere within the European Union. They will be protected against both deliberate copying and the independent development of a similar design.

Community Designs

Latest OHIM update (31st December 2012)



Community Designs: Top 10 by Nationality of Owner

Latest OHIM update (31st December 2012)

<i>Nr.</i>	<i>Country</i>	<i>1996-2012</i>	<i>%</i>
1	Germany	166,513	24.13
2	Italy	95,876	13.89
3	France	58,778	8.52
4	United States	56,186	8.14
5	United Kingdom	45,904	6.65
6	Spain	39,968	5.79
7	Japan	22,992	3.33
8	Netherlands	22,118	3.21
9	Switzerland	19,833	2.87
10	Austria	18,440	2.67

<i>Nr.</i>	<i>Country</i>	<i>2012</i>
1	Germany	19,520
2	Italy	8,955
3	United States	7,125
4	France	6,904
5	United Kingdom	5,187
6	Spain	4,031
7	Poland	3,087
8	Japan	2,942
9	China	2,659
10	Netherlands	2,418

Community Designs: Top 10 by EuroLocarno Class

Latest OHIM update (31st December 2012)

The EuroLocarno classification is a list of products based on the Locarno Classification, the international classification for designs prepared under the aegis of WIPO.

<i>Nr.</i>	<i>Class</i>	<i>2012</i>	
1	06	10,291	Furnishing
2	02	9,153	Articles of Clothing and Haberdashery
3	14	7,121	Recording, communication or information retrieval equipment
4	26	5,351	Lighting apparatus
5	09	5,307	Packages and containers for the transport or handling of goods
6	07	4,628	Household goods, not elsewhere specified
7	23	4,428	Fluid distribution equipment, sanitary, heating, ventilation and airconditioning equipment, solid fuel
8	32	4,304	Graphic symbols and logos, surface patterns, ornamentation
9	08	4,263	Tools and hardware
10	12	3,946	Means of transport or hoisting

Advantages (I)

- Simple filing procedures
 - Filing procedures are simple; a Community Design can be obtained by means of a single application.
- Not reserved to EU Member States
 - A Community Design applicant is not required to have a commercial establishment in the EU.
- No requirement for a national design registration
 - The Community Design system does not require the existence of a registration in the applicant's home country.
- Period of grace
 - A one-year period of grace from first disclosure is allowed.
- Protection for a complex product and for a component thereof as well, provided that it is visible during normal use.

Advantages (II)

- Low registration fees
 - The cost of filing a Community Design application is significantly less than multiple filings in the Member State patent offices.
- Single opposition proceedings
 - Any opposition will be examined in front of the OHIM in a single proceeding rather than putting forward the same arguments in different EU jurisdictions.
- The average registration time is two months
- Uniform right to protection throughout the EU
 - The Community Design registration protects the owner's rights in the same way in all the 27 EU Countries.
- Customs surveillance may be requested in the EU Countries as well as in most Countries of the world. Just by filing one application, any EU trade mark or design owner may ask for Customs surveillance in all 27 EU Countries.

Advantages (III)

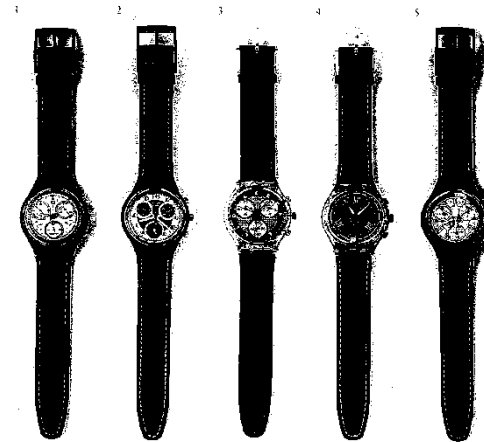
- Multiple application
 - More than one model can be combined into a single application, provided that all products belong to the same EuroLocarno class.
- In a multiple application, the holder is free to renew only those designs he is really interested in.

Multiple Community Design

It is possible to file a single Community design or a multiple Community design. A multiple design is a collection of designs belonging to the same EuroLocarno class of the EuroLocarno Classification.

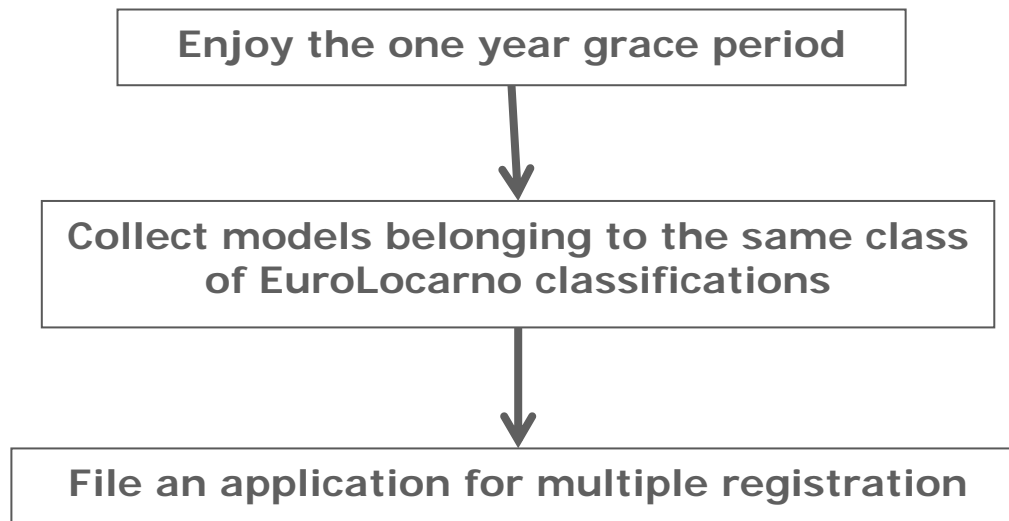


Single Community Design



Multiple Community Design

How to get LARGE protection with SMALL costs



Please pay attention to...

- | | | |
|---------------------------|----|---------------------------|
| ➤ Partial design | vs | Complete design |
| ➤ Black & white | vs | Colors |
| ➤ Drawings | vs | Photos |
| ➤ Single perspective view | vs | Multiple prospecting view |

Case Study

A



The entire product > narrow protection

Case Study

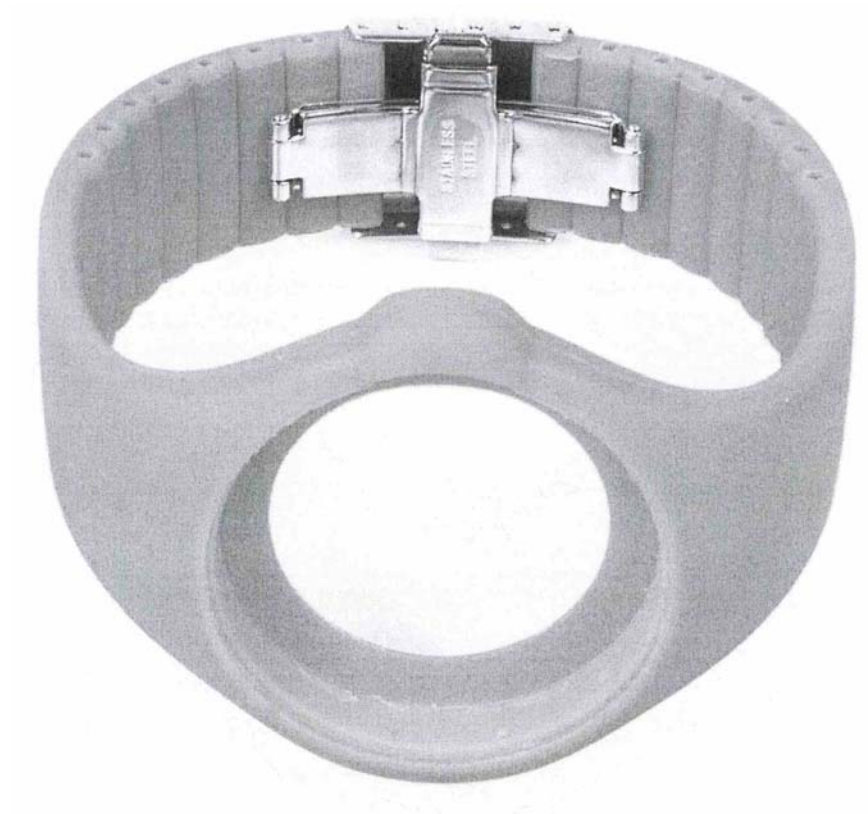
B



The distinguishing part > broader protection than A

Case Study

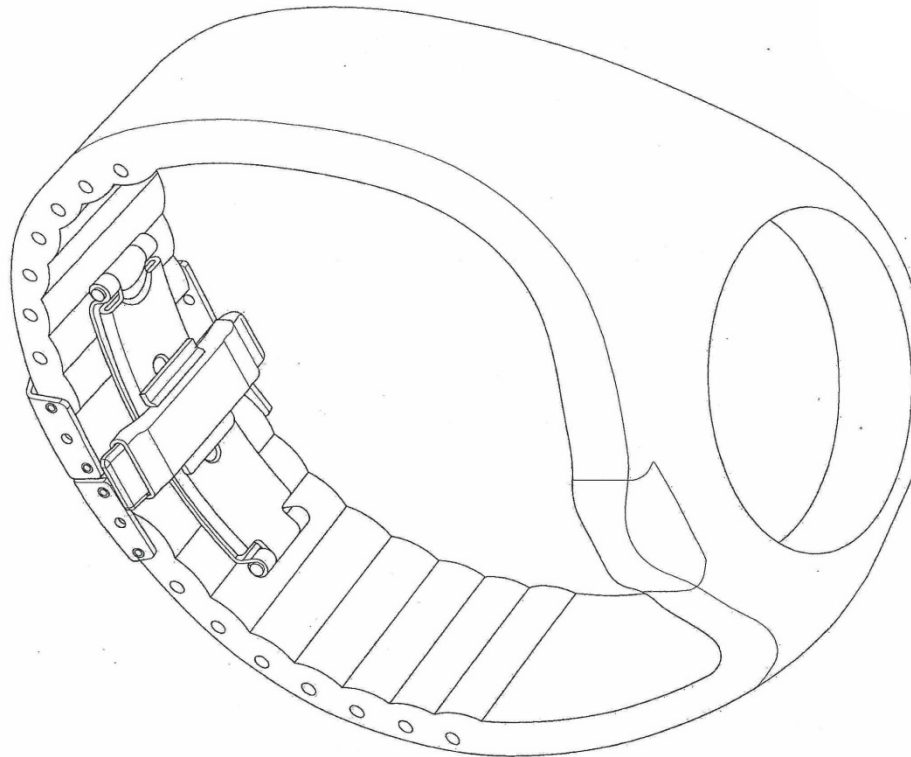
C



All colours > broader protection than B

Case Study

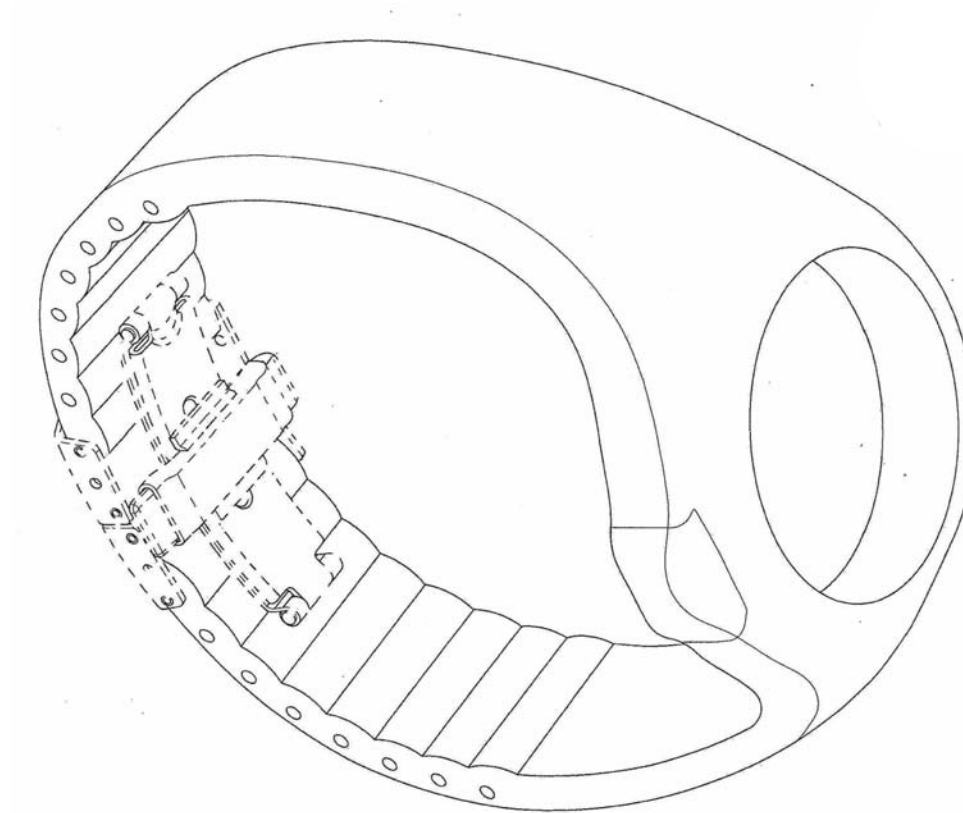
D



All materials > broader protection than C

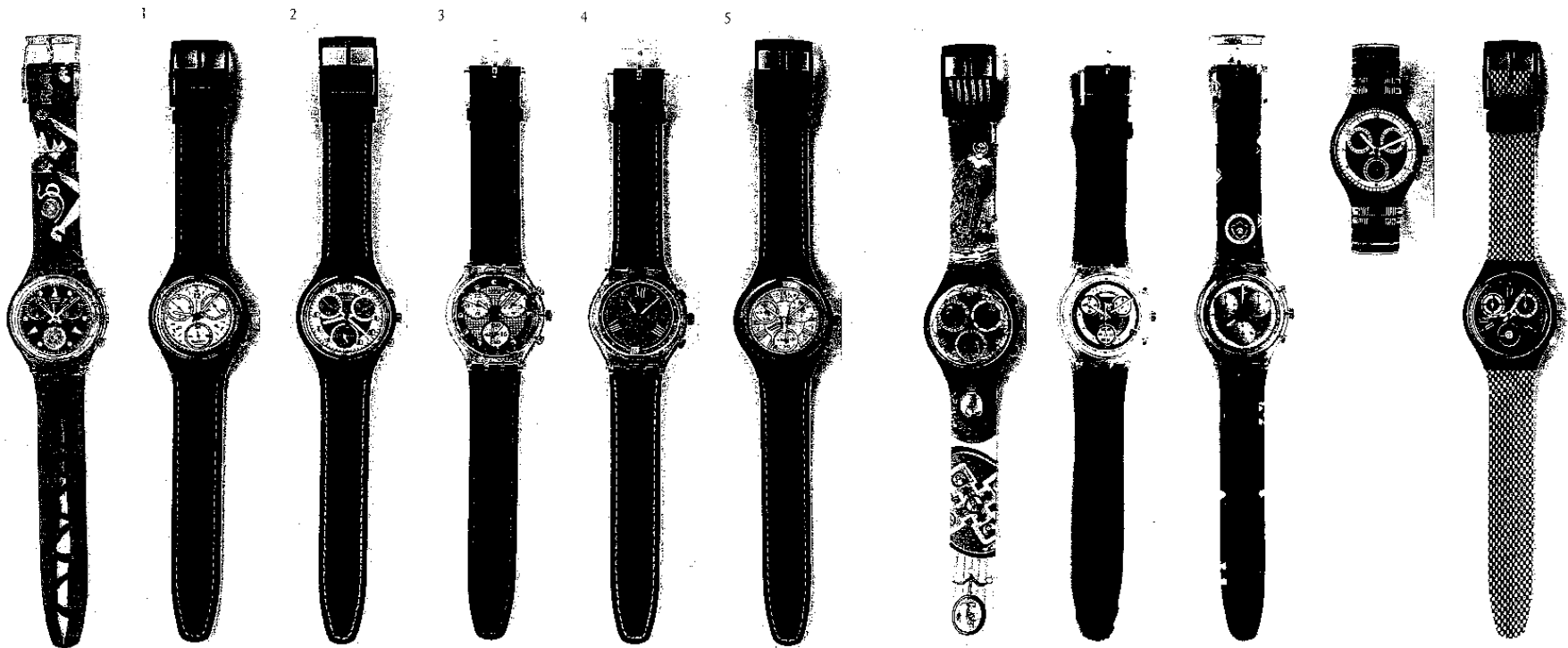
Case Study

E



What else?

Case study: What to file in order to obtain the desired protection?



SWATCH S.A. vs. S.M.R. ITALIA S.r.l. - *Italy 2007*

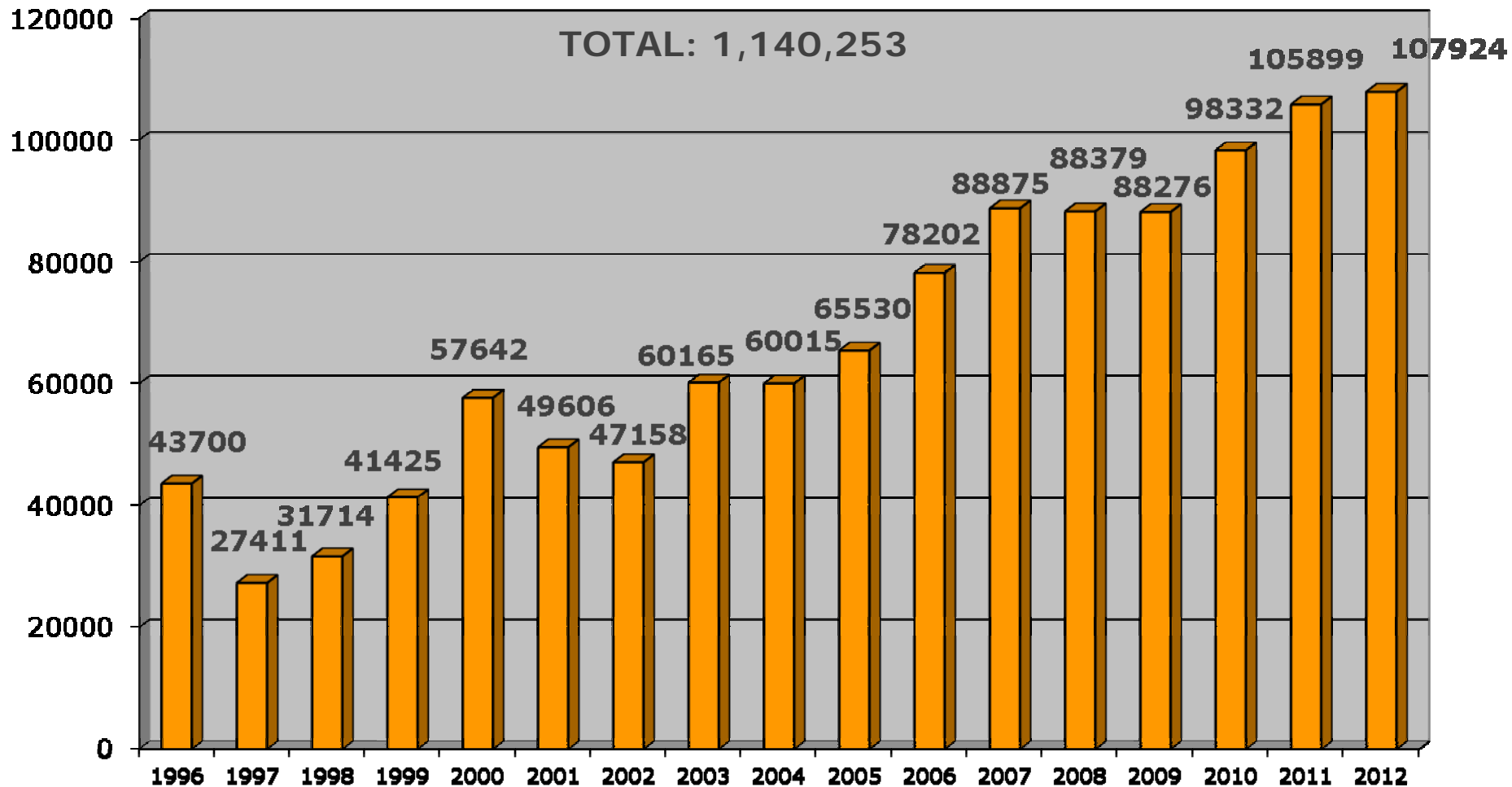
Community Trade Marks

What is a Community Trade Mark?

- The CTM system started on 1st April 1996.
- A CTM is a trade mark valid everywhere in the EU.
- The CTM system is managed by the OHIM (Office for Harmonization in the Internal Market) located in Alicante (Spain).
- The authorized professionals, like a Community Trade Mark Attorney, can do all the Community trade mark activities online. It is a real paperless trade mark.
- CTMs can be obtained by direct filing at the OHIM or as an extension of an international registration (Madrid system).
- A CTM is valid for 10 years starting from the filing date and is always renewable.
- As of 31st December 2012 a total of 1,140,253 CTM applications have been filed.

Community Trade Mark Applications

Latest OHIM update (31st December 2012)



Community Trade Mark Applications: Top 10 by Country

Latest OHIM update (31st December 2012)

<i>Nr.</i>	<i>Country</i>	<i>1996-2012</i>	<i>%</i>
1	United States	201,232	17.57
2	Germany	199,686	17.43
3	United Kingdom	120,118	10.49
4	Italy	89,916	7.85
5	Spain	88,433	7.72
6	France	78,567	6.86
7	Netherlands	39,101	3.41
8	Switzerland	34,409	3.00
9	Japan	27,947	2.44
10	Austria	24,221	2.11

<i>Nr.</i>	<i>Country</i>	<i>2012</i>
1	Germany	20,074
2	United States	14,099
3	United Kingdom	10,293
4	Italy	8,081
5	Spain	8,055
6	France	7,362
7	Netherlands	3,986
8	Switzerland	3,375
9	Austria	2,897
10	Japan	2,302

Community Trade Mark Applications: Top 10 by Nice Classification

Latest OHIM update (31st December 2012)

Nr	Class	1996-2012	%
1	09	309,327	9.96
2	35	244,088	7.86
3	42	215,936	6.95
4	41	169,374	5.45
5	16	162,044	5.22
6	25	142,837	4.60
7	05	108,671	3.50
8	38	105,346	3.39
9	03	95,355	3.07
10	36	84,898	2.73

Nr	Class	2012
1	35	29,251
2	09	28,864
3	42	19,733
4	41	18,258
5	25	14,712
6	16	12,427
7	05	10,433
8	38	9,479
9	03	9,409
10	30	8,114

Advantages (I)

- Simple filing procedure
 - The filing procedure is simple; a CTM can be obtained by filing a single application.
- Low registration fee
 - The cost of filing of a CTM application is low and significantly less than the sum of single national filings.
- Not reserved for EU Member States
 - A CTM applicant is not required to have a commercial establishment in the EU.
- Opposition
 - Any opposition will be examined in front of the OHIM in a single proceeding.
- Uniform right in the EU
 - The CTM registration protects the owner's rights in the same way in all of the 27 EU countries.

Advantages (II)

➤ Customs surveillance

- The owner of a CTM may with one single application ask for Customs surveillance in all of the 27 EU countries.

➤ Cancellation for non-use

- Use of the mark in some member states is enough to avoid cancellation for non-use.

➤ Extension of protection

- The protection of a CTM will be automatically extended to new member states.

➤ System of seniority

- The CTM system of seniority provides that trade mark owners may claim for their CTMs the seniority rights derived from national EU trade marks.

Cancellation for non-use

CTM regulations state that, in order to avoid cancellation for non-use, a CTM must be genuinely used in the EU.

What is a genuine use in the Community?

➤ Before the ONEL decision (19/12/12)

The use in one single member state was considered genuine use in the Community.

➤ After the ONEL decision (20/12/12)

In order to assess if the use is sufficient to avoid cancellation for non-use, it is necessary to take in consideration various aspects (such as the characteristics of the relevant market, the nature of the goods and services, the territorial extent and the scale of the use as well as the frequency and regularity).

The ratio

The EU must be intended as a single territory without consideration of national borders.



Extension of Protection: Croatia Case

- On 01/07/13 Croatia will enter the EU.
- The existing Community trade mark and design rights will automatically extend to Croatia without the payment of additional fees.
- At the time of accession, existing CTMs may come into conflict with earlier rights in Croatia, but take into consideration that:
 - Owners of earlier rights in Croatia can not file opposition against a CTM application filed before 01/01/13;
 - Owners of earlier rights will be able to prohibit the use of extended CTMs in Croatia.
- Therefore:
 - CTM filed before 01/01/2013 may not be opposed nor declared invalid on the basis of a prior Croatian mark;
 - CTM filed after 01/01/2013 can be opposed and/or declared invalid on the basis of a prior Croatian mark.
- Seniority of a national Croatian trade mark and an international trade mark extended to Croatia may be claimed into a CTM after 01/07/13.

System of Seniority

- **What:** the CTM system of seniority provides that CTM owners may claim for their CTMs the seniority rights derived from national trade marks or international trade marks registered in any EU Countries.
- **When:** at the filing date, within 2 months from the filing date or after the registration of a CTM.
- **How:** simply specifying the data of the national or international registration to the OHIM office. The OHIM office may ask for a simple copy of the registration if not available on the online database.

System of Seniority: The De' Longhi Case

Trade mark name :	DéLonghi
Trade mark No :	001334291
Trade mark basis:	CTM
Date of receipt :	04/10/1999
Number of results:	1 of 1
Request an inspection	
 Certified copy of the Registration Certificate	
<div>◀ ◀ ▶ ▶▶ </div>	
Trade mark	
Filing date:	04/10/1999
Date of registration:	16/01/2001
Expiry Date:	04/10/2019
Nice Classification:	7, 9, 11, 21 (Nice classification)
Trade mark:	Individual
Type of mark:	Figurative
Vienna Classification:	25.3.3, 25.3.99 (Vienna Classification)
Acquired distinctiveness:	No
Applicant's reference:	M A8065
Status of trade mark:	Registered (Glossary)
	Publication of registration <input checked="" type="checkbox"/>
	(Publication B1 or Publication B2)
	(History of statuses)
Filing language:	Italian
Second language:	English
Graphic representation	
	

System of Seniority: The De' Longhi Case

List of goods and services	
Nice Classification: List of goods and services	7 Heat pumps, electric machines and appliances for household purposes; electric machines and apparatus for cleaning; steam cleaning machines; vacuum cleaners; machines for cleaning and washing floors and carpets; window washers; wax-polishing appliances; kitchen apparatus and utensils, electric; dishwashers, washing machines; ironing machines.
Nice Classification: List of goods and services	9 Flat irons, hygrometers, thermometers.
Nice Classification: List of goods and services	11 Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
Nice Classification: List of goods and services	21 Household or kitchen utensils and containers; cooking pots; cookware; small hand-operated appliances and utensils, for kitchen and household purposes; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass; glassware, porcelain and earthenware not included in other classes.

System of Seniority: The De' Longhi Case

Owner	
Name:	DE' LONGHI APPLIANCES S.R.L.
ID No:	408285
Natural or legal person:	Legal entity
Address:	Via Ludovico Seitz, 47
Post code:	31100
Town:	Treviso (TV)
Country:	ITALY
Correspondence address:	DE' LONGHI APPLIANCES S.R.L. Via Ludovico Seitz, 47 I-31100 Treviso (TV) ITALIA

Representative	
Name:	UFFICIO BREVETTI RAPISARDI S.R.L.
ID No:	15058
Type:	4 - Association
Address:	Via Serbelloni, 12
Post code:	20122
Town:	Milano
Country:	ITALY
Correspondence address:	UFFICIO BREVETTI RAPISARDI S.R.L. Via Serbelloni, 12 I-20122 Milano ITALIA
Telephone:	00 39-02763011
Fax:	00 39-0276301300
E-mail:	✉ rapisardi@rapisardi.com

System of Seniority: The De' Longhi Case

Seniority	
Country:	AUSTRIA
Registration number:	0498944
Status:	Accepted
Application date:	25/03/1985
Grant date:	02/08/1985
Country:	BENELUX
Registration number:	0498944
Status:	Accepted
Application date:	25/03/1985
Grant date:	02/08/1985
Country:	GERMANY
Registration number:	0498944
Status:	Accepted
Application date:	25/03/1985
Grant date:	02/08/1985
Country:	DENMARK
Registration number:	VR 1991 08767
Status:	Accepted
Filing date:	05/02/1988
Grant date:	20/12/1991
Country:	SPAIN
Registration number:	0498944
Status:	Accepted
Application date:	25/03/1985
Grant date:	02/08/1985
Country:	FINLAND
Registration number:	109002
Status:	Accepted
Filing date:	08/09/1988
Grant date:	20/09/1990
Country:	FRANCE
Registration number:	0498944
Status:	Accepted
Application date:	25/03/1985
Grant date:	02/08/1985

System of Seniority: The De' Longhi Case

Country: UNITED KINGDOM
Registration number: 1372453
Status: Accepted
Filing date: 08/02/1989
Grant date: 08/02/1989

Country: UNITED KINGDOM
Registration number: 2176209
Status: Accepted
Filing date: 29/08/1998
Grant date: 29/08/1998

Country: UNITED KINGDOM
Registration number: 1259403
Status: Accepted
Filing date: 31/01/1986
Grant date: 31/01/1986

Country: GREECE
Registration number: 81 789
Status: Accepted
Filing date: 04/02/1986
Grant date: 04/02/1986

Country: IRELAND
Registration number: 119613
Status: Accepted
Filing date: 11/02/1986
Grant date: 11/02/1986

Country: IRELAND
Registration number: 119611
Status: Accepted
Filing date: 11/02/1986
Grant date: 11/02/1986

Country: IRELAND
Registration number: 119612
Status: Accepted
Filing date: 11/02/1986
Grant date: 11/02/1986

System of Seniority: The De' Longhi Case

Country: ITALY
Registration number: 0000701402
Status: Accepted
Filing date: 25/03/1985
Grant date: 02/08/1985

Country: PORTUGAL
Registration number: 0498944
Status: Accepted
Application date: 25/03/1985
Grant date: 02/08/1985

Country: SWEDEN
Registration number: 248786
Status: Accepted
Filing date: 11/02/1988
Grant date: 07/05/1993

Exhibition priority

No entry for application number: 001334291

Priority

No entry for application number: 001334291.

International Registration Transformation

No entry for application number: 001334291.

Publication

Bulletin no.: 2000/058
Date of publication: 24/07/2000
Part: A.1

Bulletin no.: 2001/020
Date of publication: 26/02/2001
Part: B.2

System of Seniority: The De' Longhi Case

➤ CTM (04/10/1999):

- Bulgaria
- Estonia
- Malta
- Romania
- Cyprus
- Latvia
- Poland
- Slovenia
- Czech Republic
- Lithuania
- Slovakia
- Hungary

➤ WIPO - registration No. 498944 (02/08/1985):

- Austria
- Spain
- Benelux
- France
- Germany
- Portugal

➤ 11 National trade marks:

- Denmark (05/02/1988)
- Finland (08/09/1988)
- Greece (04/02/1986)
- 3 in Ireland (11/02/1986)
- Italy (25/03/1985)
- Sweden (11/02/1988)
- 3 in the UK (08/02/86)

System of Seniority: Statistics of Community Trade Marks



SSC009 - Statistics of Community Trade Marks

Hasta / Bis / Until / Jusqu'à / Fino : 12/2012

DESGLOSE POR ANTIGÜEDADES - AUFSCHLÜSSELUNG NACH ZEITRANGANSPRÜCHEN - BREAKDOWN PER SENIORITY
VENTILATION PAR ANCIENNETÉ - RIPARTIZIONE PER PREESISTENZE

TOP 25

	Estados	Staaten	States	Etats	<2012
	Stati				
1	(DE) - GERMANY				17,798
2	(FR) - FRANCE				9,544
3	(US) - UNITED STATES OF AMERICA				8,404
4	(GB) - UNITED KINGDOM				7,996
5	(ES) - SPAIN				7,903
6	(IT) - ITALY				4,200
7	(NL) - NETHERLANDS				2,653
8	(CH) - SWITZERLAND				1,916
9	(BE) - BELGIUM				1,569
10	(SE) - SWEDEN				1,564
11	(AT) - AUSTRIA				1,481
12	(DK) - DENMARK				1,479
13	(JP) - JAPAN				1,175
14	(PT) - PORTUGAL				765
15	(GR) - GREECE				620
16	(FI) - FINLAND				490
17	(LU) - LUXEMBOURG				450
18	(PL) - POLAND				386
19	(CZ) - CZECH REPUBLIC				337
20	(IE) - IRELAND				318
21	(CA) - CANADA				271
22	(HK) - THE HONG KONG SPECIAL ADMINISTRATIVE REGION OF THE PEOPLE'S REPUBLIC OF CHINA				138
23	(HU) - HUNGARY				121
24	(AU) - AUSTRALIA				108
25	(LI) - LIECHTENSTEIN				75
Σ (25)					71,761
Σ					73,455

	Estados	Staaten	States	Etats	2012
	Stati				
1	(DE) - GERMANY				774
2	(FR) - FRANCE				511
3	(ES) - SPAIN				364
4	(GB) - UNITED KINGDOM				250
5	(IT) - ITALY				237
6	(US) - UNITED STATES OF AMERICA				193
7	(NL) - NETHERLANDS				123
8	(AT) - AUSTRIA				74
9	(BE) - BELGIUM				67
10	(PT) - PORTUGAL				54
11	(SE) - SWEDEN				48
12	(CH) - SWITZERLAND				37
13	(JP) - JAPAN				35
14	(PL) - POLAND				29
15	(DK) - DENMARK				28
16	(GR) - GREECE				28
17	(FI) - FINLAND				27
18	(CZ) - CZECH REPUBLIC				22
19	(IE) - IRELAND				18
20	(LU) - LUXEMBOURG				15
21	(RO) - ROMANIA				13
22	(BG) - BULGARIA				9
23	(HU) - HUNGARY				9
24	(SK) - SLOVAKIA				8
25	(CA) - CANADA				7
Σ (25)					2,980
Σ					3,057

	Estados	Staaten	States	Etats	Σ
	Stati				
1	(DE) - GERMANY				18,604
2	(FR) - FRANCE				10,076
3	(US) - UNITED STATES OF AMERICA				8,606
4	(ES) - SPAIN				8,281
5	(GB) - UNITED KINGDOM				8,252
6	(IT) - ITALY				4,450
7	(NL) - NETHERLANDS				2,780
8	(CH) - SWITZERLAND				1,962
9	(BE) - BELGIUM				1,638
10	(SE) - SWEDEN				1,615
11	(AT) - AUSTRIA				1,555
12	(DK) - DENMARK				1,510
13	(JP) - JAPAN				1,211
14	(PT) - PORTUGAL				821
15	(GR) - GREECE				650
16	(FI) - FINLAND				517
17	(LU) - LUXEMBOURG				466
18	(PL) - POLAND				415
19	(CZ) - CZECH REPUBLIC				359
20	(IE) - IRELAND				336
21	(CA) - CANADA				278
22	(HK) - THE HONG KONG SPECIAL ADMINISTRATIVE REGION OF THE PEOPLE'S REPUBLIC OF CHINA				141
23	(HU) - HUNGARY				130
24	(AU) - AUSTRALIA				114
25	(RO) - ROMANIA				85
Σ (25)					74,852
Σ					76,638

Please pay attention to...

- Objection: 6.8% on the total applications:
 - Objection for wrong classification of products/services: 61%
 - Objection for lack of distinctiveness: 33%
 - Objection for other issues: 6%

- Oppositions due to earlier rights: more than 210,000

How to avoid objection for wrong classification of products/services

USE THE CLASS-HEADING PROPERLY

Case Study: OHIM Filing Page

<div data-bbox="154 675 220 701">15</div> <div data-bbox="154 711 182 729">EN</div>	<div data-bbox="319 675 519 696">Musical instruments.</div> <div data-bbox="319 839 1372 862">Enter goods & services. Items should be separated by a semi-colon. It is not necessary to click "Enter" ("↵").</div> <div data-bbox="319 868 1424 922"><input type="checkbox"/> By ticking the box, I declare my intention to cover all the goods/services included in the Alphabetical list of this class. ?</div>	<div data-bbox="1473 675 1629 696">Delete this class</div> <div data-bbox="1473 739 1763 761">Save & Validate this class</div>
---	---	--

Case Study: OHIM Filing Page

Class	List of Goods & Services	Actions
<div>15</div> <div>EN</div>	<div>Musical instruments.</div> <div>Enter goods & services. Items should be separated by a semi-colon. It is not necessary to click "Enter" ("↵").</div> <div><input checked="" type="checkbox"/> By ticking the box, I declare my intention to cover all the goods/services included in the Alphabetical list of this class. ?</div>	<div>Delete this class</div> <div><div>Save & Validate this class</div></div>

Case Study: OHIM Guide

Indicate class headings of Nice classification

Please note that when you select a class to add in the list of goods & services, the standard Nice Classification heading is displayed by default.

If you seek protection only for the goods or services indicated in the class heading, no further action is required.

If you seek protection for the class heading and all goods/services of the alphabetical list of the selected class, please tick the box appearing below the Goods & Services field. The class heading of the selected class plus the indication of all goods/services of the alphabetical list will be loaded in the goods/services field. If you want to insert additional goods/services to your list, it must be done by searching and importing them from the EuroClass using the functionality described in the section below: Basic Search in our database (EuroClass)

The Alphabetical list of Nice Classification can be consulted in Euroclass at <http://oami.europa.eu/ec2/>

For further information, please consult [Communication of the President 02/12](#) concerning the use of class headings in list of goods and services for Community trade mark applications and registrations.

Case Study: «i Pad Mini»

- CTM No.: 11288461 “i Pad Mini”
- Class: 9, 38, 42
- In the name of: Apple Inc.

Trade mark	
Filing date:	23/10/2012
Nice Classification:	9, 38, 42 (Nice classification)
Trade mark:	Individual
Type of mark:	Word
Acquired distinctiveness:	Yes
Applicant's reference:	306187-3999/JRO/MAP/KNP
Status of trade mark:	Application published (Glossary)
	Translations <input type="checkbox"/>
	(Publication A1 or Publication A2)
	(History of statuses)
Filing language:	English
Second language:	Italian
National search requested:	No

Graphic representation
No entry for application number: 011288461.

Case Study: «i Pad Mini»

List of goods and services	
Nice Classification:	9
List of goods and services	Computers; computer peripheral devices; computer hardware; computer gaming machines; hand held computers; tablet computers; personal digital assistants; electronic organizers; electronic notepads; electronic book readers; handheld electronic game units adapted for use with an external display screen or monitor; handheld digital electronic devices and software related thereto; handheld mobile digital electronic devices capable of providing access to the Internet and for the sending, receiving, and storing of telephone calls, faxes, electronic mail, and other digital data; electronic handheld units for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; sound recording and reproducing apparatus; MP3 and other digital format audio players; digital audio recorders; digital video recorders and players; audio cassette recorders and players; video cassette recorders and players; compact disc recorders and players; digital versatile disc recorders and players; digital audio tape recorders and players; radios, radio transmitters, and receivers; audio, video, and digital mixers; audio amplifiers; audio receivers; audio decoders; car audio apparatus; earphones, headphones; audio speakers; microphones; audio components and accessories; modems; network communication apparatus; electronic communication equipment and instruments; audiovisual teaching apparatus; optical apparatus and instruments; telecommunications apparatus and instruments; global positioning system (GPS) devices; telephones; wireless communication devices for voice, data or image transmission; cables; apparatus for data storage; magnetic

Case Study: «i Pad Mini»

data media; chips, discs and tapes bearing or for recording computer programs and software; facsimile machines; cameras; batteries; televisions; television receivers; television monitors; set top boxes; computer software; computer and electronic games; global positioning system (GPS) computer software; computer software for travel and tourism, travel planning, navigation, travel route planning, geographic, destination, transportation and traffic information, driving and walking directions, customized mapping of locations, street atlas information, electronic map display, and destination information; computer software for creating, authoring, distributing, downloading, transmitting, receiving, playing, editing, extracting, encoding, decoding, displaying, storing and organizing text, data, graphics, images, audio, video, and other multimedia content, electronic publications, and electronic games; computer software for use in recording, organizing, transmitting, manipulating, and reviewing text, data, audio files, video files and electronic games in connection with computers, televisions, television set-top boxes, audio players, video players, media players, telephones, and handheld digital electronic devices; computer software to enable users to program and distribute text, data, graphics, images, audio, video, and other multimedia content via global communication networks and other computer, electronic and communications networks; computer software for identifying, locating, grouping, distributing, and managing data and links between computer servers and users connected to global communication networks and other computer, electronic and communications networks; computer software for use on handheld mobile digital electronic devices and other consumer electronics; electronic publishing software; electronic publication reader

publishing software; electronic publication reader software; computer software for personal information management; downloadable pre-recorded audio and audiovisual content, information, and commentary; downloadable electronic books, magazines, periodicals, newsletters, newspapers, journals, and other publications; database management software; character recognition software; voice recognition software; electronic mail and messaging software; computer software for accessing, browsing and searching online databases; electronic bulletin boards; data synchronization software; application development software; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; electrical and electronic connectors, couplers, wires, cables, chargers, docks, docking stations, interfaces, and adapters for use with all of the aforesaid goods; computer equipment for use with all of the aforesaid goods; electronic apparatus with multimedia functions for use with all of the aforesaid goods; electronic apparatus with interactive functions for use with all of the aforesaid goods; accessories, parts, fittings, and testing apparatus for all of the aforesaid goods; covers, bags and cases adapted or shaped to contain all of the aforesaid goods; navigational instruments; apparatus to check stamping mail; cash registers; mechanisms for coin-operated apparatus; dictating machines; hemline markers; voting machines; electronic tags for goods; weighing apparatus and instruments; measures; electronic notice boards; measuring apparatus; optical apparatus and instruments; wafers [silicon slices]; integrated circuits; fluorescent screens; remote control apparatus; lights conducting filaments [optical fibers]; electric installations for the remote control of industrial operations; lightning arresters; electrolyzers; fire extinguishers; radiological apparatus for industrial purposes; life saving apparatus and equipment; whistle alarms; sunglasses; animated cartoons; egg-candlers; dog whistles; decorative magnets; electrified fences; electrically heated socks

Case Study: «i Pad Mini»

Objection:

«The Office has examined your application and has found that the classification of the goods and services does not entirely comply with Rule 2(2) CTMIR.

Class 9:

The term «*prize selection machines*» does not allow for proper classification and must be further specified.

Please amend the list of goods and services in your application as specified above within two months of the notification of this communication. If you do not amend the specification, the application will be partially rejected.»

How to avoid official actions for lack of distinctiveness



How to overcome official actions for lack of distinctiveness



Case Study: Soft Architecture

- CTM No.: 8615304 “Soft Architecture”
- Class: 11
- In the name of: FLOS S.p.A.
- Objection for lack of distinctiveness:
 - “soft architecture”, composed of English words, is considered descriptive since it regards a specific architectural movement.
- Overcome with arguments:
 - The architectural movement mentioned “soft architecture” is known by a very limited number of persons of a specific and restricted field;
 - The majority of consumers link “soft architecture” with softwares, which is a totally different field from the one of Flos’s interest.

Case Study: Soft Architecture

Trade mark name :	SOFT ARCHITECTURE
Trade mark No :	008615304
Trade mark basis:	CTM
Date of receipt :	25/09/2009
Number of results:	1 of 1

[Request an inspection](#)

[Certified copy of the Application form](#) [Certified copy of the Registration Certificate](#)

Trade mark	
Filing date:	25/09/2009
Date of registration:	27/07/2011
Expiry Date:	25/09/2019
Nice Classification:	11, 35 (Nice classification)
Trade mark:	Individual
Type of mark:	Word
Acquired distinctiveness:	No
Applicant's reference:	M16042
Status of trade mark:	Registered (Glossary)
	Publication of registration <input checked="" type="checkbox"/>
	(Publication B1 or Publication B2)
	(History of statuses)
Filing language:	Italian
Second language:	English
National search requested:	No

Graphic representation

No entry for application number: 008615304.

Case Study: Soft Architecture

List of goods and services	
Nice Classification:	11
List of goods and services	Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
Nice Classification:	35
List of goods and services	Advertising; business management; business administration; office functions.
Description	
Description of the mark:	-
Owner	
Name:	FLOS S.P.A.
ID No:	189510
Natural or legal person:	Legal entity
Address:	Via A. Faini, 2
Post code:	25073
Town:	Bovezzo (Brescia)
Country:	ITALY
Correspondence address:	FLOS S.P.A. Via A. Faini, 2 I-25073 Bovezzo (Brescia) ITALIA
Telephone:	00 39-0302438200
Fax:	00 39-0302438200
Representative	
Name:	UFFICIO BREVETTI RAPISARDI S.R.L.
ID No:	15058
Type:	4 - Association
Address:	Via Serbelloni, 12
Post code:	20122
Town:	Milano
Country:	ITALY
Correspondence address:	UFFICIO BREVETTI RAPISARDI S.R.L. Via Serbelloni, 12 I-20122 Milano ITALIA
Telephone:	00 39-02763011
Fax:	00 39-0276301300
E-mail:	rapisardi@rapisardi.com

Case Study: Soft Architecture

Seniority	
No entry for application number: 008615304.	
Exhibition priority	
No entry for application number: 008615304	
Priority	
No entry for application number: 008615304.	
International Registration Transformation	
No entry for application number: 008615304.	
Publication	
Bulletin no.:	 2010/044
Date of publication:	08/03/2010
Part:	A.1
Bulletin no.:	 2010/053
Date of publication:	22/03/2010
Part:	A.2.1.1
Bulletin no.:	 2011/076
Date of publication:	19/04/2011
Part:	A.1
Bulletin no.:	 2011/142
Date of publication:	29/07/2011
Part:	B.1

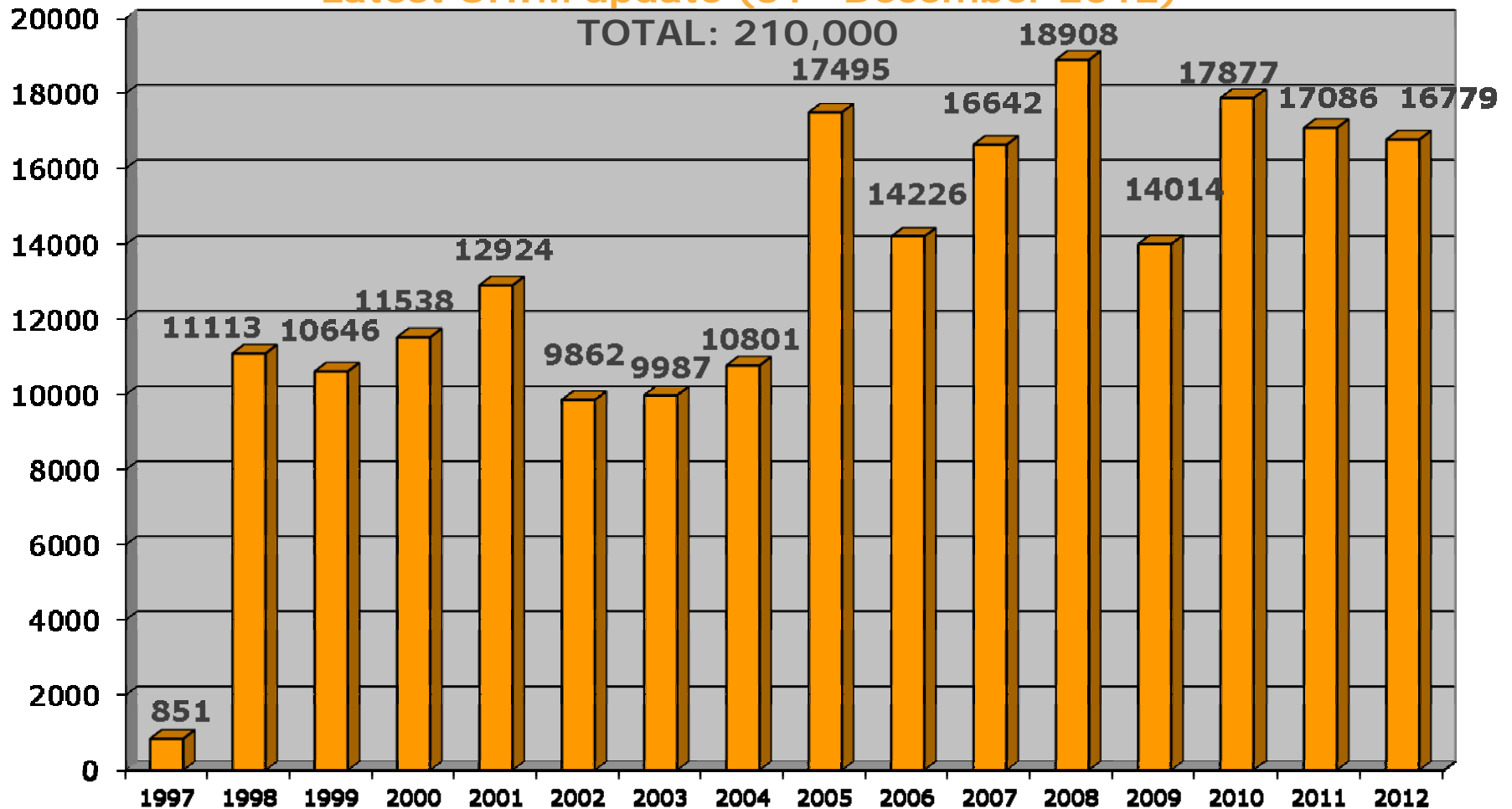
Case Study: MILKA

- CTM No.: 31336 “Lilac color”
- Class: 30
- In the name of: Kraft Foods Schweiz Holding GmbH
- Objection for lack of distinctiveness
- Overcome with arguments and evidence attesting acquired distinctiveness through use



Oppositions against Community Trade Marks

Latest OHIM update (31st December 2012)



Oppositions against Community Trade Marks

Latest OHIM update (31st December 2012)



SSC009 - Statistics of Community Trade Marks

Hasta / Bis / Until / Jusqu'à / Fino : 12/2012

Oposiciones - Widersprüche - Oppositions - Opposizioni - Opposizioni

	Oposiciones recibidas Erhaltene Widersprüche Oppositions reçues Opposizioni ricevute (1)	Procedimiento de oposición concluido Abgeschlossene Widersprüche Oppositions finally settled Oppositions résolues Opposizioni risolte (2) = (3) + (4)	Por decisión Durch Entscheidung By decision Par décision Per decisione (3)	Por sobreseimiento Einstellung ohne Entscheidung By not proceeding to judgement Por sobrePar non-lieu Non arrivate a giudizio (4)	Σ [(1)]	Σ [(2)]	En curso Anhängige Pending En cours En corso Σ [(1) - (2)]
1997	851	0	3	-3	851	0	851
1998	11,113	320	90	230	11,964	320	11,644
1999	10,646	6,936	1,065	5,871	22,610	7,256	15,354
2000	11,538	9,221	2,266	6,955	34,148	16,477	17,671
2001	12,924	10,516	1,728	8,788	47,072	26,993	20,079
2002	9,862	11,470	2,753	8,717	56,934	38,463	18,471
2003	9,987	8,858	2,073	6,785	66,921	47,321	19,600
2004	10,801	9,733	3,516	6,217	77,722	57,054	20,668
2005	17,495	12,340	4,066	8,274	95,217	69,394	25,823
2006	14,226	14,080	4,056	10,024	109,443	83,474	25,969
2007	16,642	13,938	5,009	8,929	126,085	97,412	28,673
2008	18,908	15,653	4,428	11,225	144,993	113,065	31,928
2009	14,014	16,287	5,508	10,779	159,007	129,352	29,655
2010	17,877	21,023	9,497	11,526	176,884	150,375	26,509
2011	17,086	18,304	6,490	11,814	193,970	168,679	25,291
2012	16,779	17,184	6,161	11,023	210,749	185,863	24,886
2013	650	853	126	727	211,399	186,716	24,683
Σ	211,399	186,716	58,835	127,881			24,683

How to avoid oppositions

MAKE APPROPRIATE RESEARCH

Advantages of CTM vs. International Trade Mark (I)

- Community Trade Mark attorney's support for correct advice
- No requirement for a national trade mark registration/application
 - Compared to the International Registration system, the CTM system does not require the existence of a registration/application in the applicant's home country.
- Independent registration
 - The CTM is independent from any other application or registration. On the contrary an international trade mark is linked to the national mother application or registration for 5 years (central attack).

Advantages of CTM vs. International Trade Mark (II)

- A CTM application is granted in less time than an International Trade Mark extended to the EU
 - Usually the CTM application is granted in about 8 months (if no official action or opposition is raised); the extension to the EU through the International Trade Mark is granted in about 18/24 months.

This is very important with regard to requests for Customs surveillance, as these can only be filed once the trade mark is registered.
- Freedom to use the class-heading

Madrid Agreement and Protocol Concerning the International Registration of Marks (I)

Indications that the Use of Class Headings of the Nice Classification in International Applications Is Intended to Cover all the Goods and Services Included in the Alphabetical Lists of the Classes Concerned

1. The International Bureau of the World Intellectual Property Organization (WIPO) would like to bring to the attention of applicants, holders, Offices of the Contracting Parties and users at large, that Rule 9 of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement does not allow for international applications to include indications that the use of class headings of the ~~International Classification of Goods and Services for the Purposes of the Registration of Marks~~ (Nice Classification) is intended to cover all goods and services in the alphabetical lists of the classes concerned. Accordingly, and with respect to international applications including such indications, the International Bureau of WIPO will disregard any such indications.

2. Reference is made to Communication No. 2/12 of the President of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), which entered into force on June 21, 2012. In the aforesaid communication, the President indicates that:

“As regards Community trade mark applications filed as from the entry into force of the present Communication, in the case of applicants who use all the general indications of a particular class heading of the Nice Classification, they must expressly indicate whether or not their intention is to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services in that class.”

3. It is also recalled that, barring any irregularity concerning the indications themselves or their classification, the International Bureau of WIPO would accept the terms contained in the class headings of the Nice Classification as the indications of the goods and services for which the international registration of a mark is sought. Nevertheless, it is the Offices of the Contracting Parties designated in the aforesaid international registration which would ultimately determine the scope of protection of the mark in their corresponding territories.

Madrid Agreement and Protocol Concerning the International Registration of Marks (II)

4. In the course of the past few months, the International Bureau of WIPO has received some international applications that, while indicating the terms contained in the class headings of the Nice Classification as the goods and services for which the international registration is sought, contain a statement, either appended to the aforesaid terms or in the form of a separate document, to the effect that the applicant seeks protection for all the goods and services included in the alphabetical lists of the classes concerned. In most cases, the statement specifically refers to a designation of the European Union and invokes the aforementioned communication of the President of OHIM. In a few cases, the statement refers to designations of Contracting Parties other than the European Union or to the international registration itself.

5. Applicants wishing to cover all goods and services in the alphabetical list of a particular class may consider indicating in the international application all the terms contained in the alphabetical list of a particular class or classes (subject to the certification of the international application by the Office of origin).

OHIM warning communication

“Over the last few years there has been a worrying increase in the volume of unsolicited requests for payment being sent to users by various kinds of unofficial directories or “registries”.

Three main types of abuses that OHIM is seeking to guard against:

- *Unauthorized incorporation of at least one element of our corporate identity in offers of service;*
- *The provision of a service similar to the services OHIM provides, causing confusion to the user;*
- *Providing an actual service before OHIM without being authorized to do so.”*

How to avoid frauds

CONTACT YOUR AGENT!

EU Customs Surveillance

EU Design / EU Trade Mark

The only requirement for filing EU Customs surveillance is being the owner of a fully registered EU design or trade mark.

EU design registrations may be obtained:

- a. by filing for EU design registration at the OHIM – if no objection is made, designs are registered about 2 months after the filing date;
- b. also, as of 1st January 2008, by extending an International Design to the EU.

EU trade mark registrations may be obtained:

- a. by filing for EU trade mark registration at the OHIM – if no objection is made, trademarks are registered about 8 months after the filing date;
- b. by extending International trade marks (WIPO) according to the Madrid Protocol - if no objection is made, trade marks are registered about 24 months after the filing date.

Applications

Applications may be submitted to any Customs agency of any EU Country.

They should include:

- 1.Details of the EU trade mark/design;
- 2.Contact details of the "administrative contact";
- 3.Contact details of the "technical contact";
- 4.An undertaking to be responsible for any damage caused by actions taken in respect of original products;
- 5.Accurate descriptions of original products (e.g. by means of catalogues, digital photos and labels).

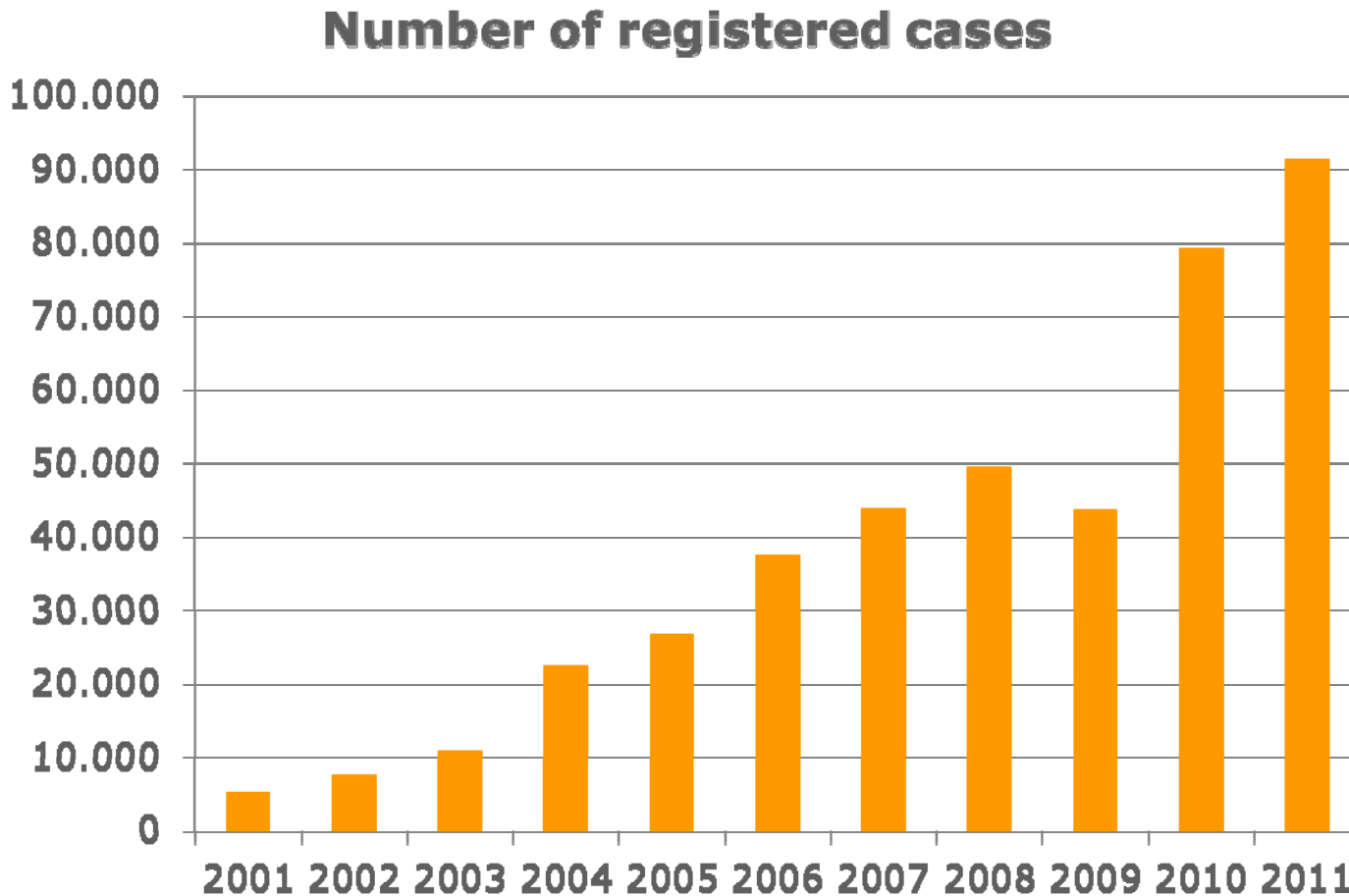
And, where available:

- 6.Information on original merchandise flow (usual destinations, means of transport, details of importers / exporters, and authorized distributors);
- 7.Information about previous cases of counterfeiting.

Notices/Actions

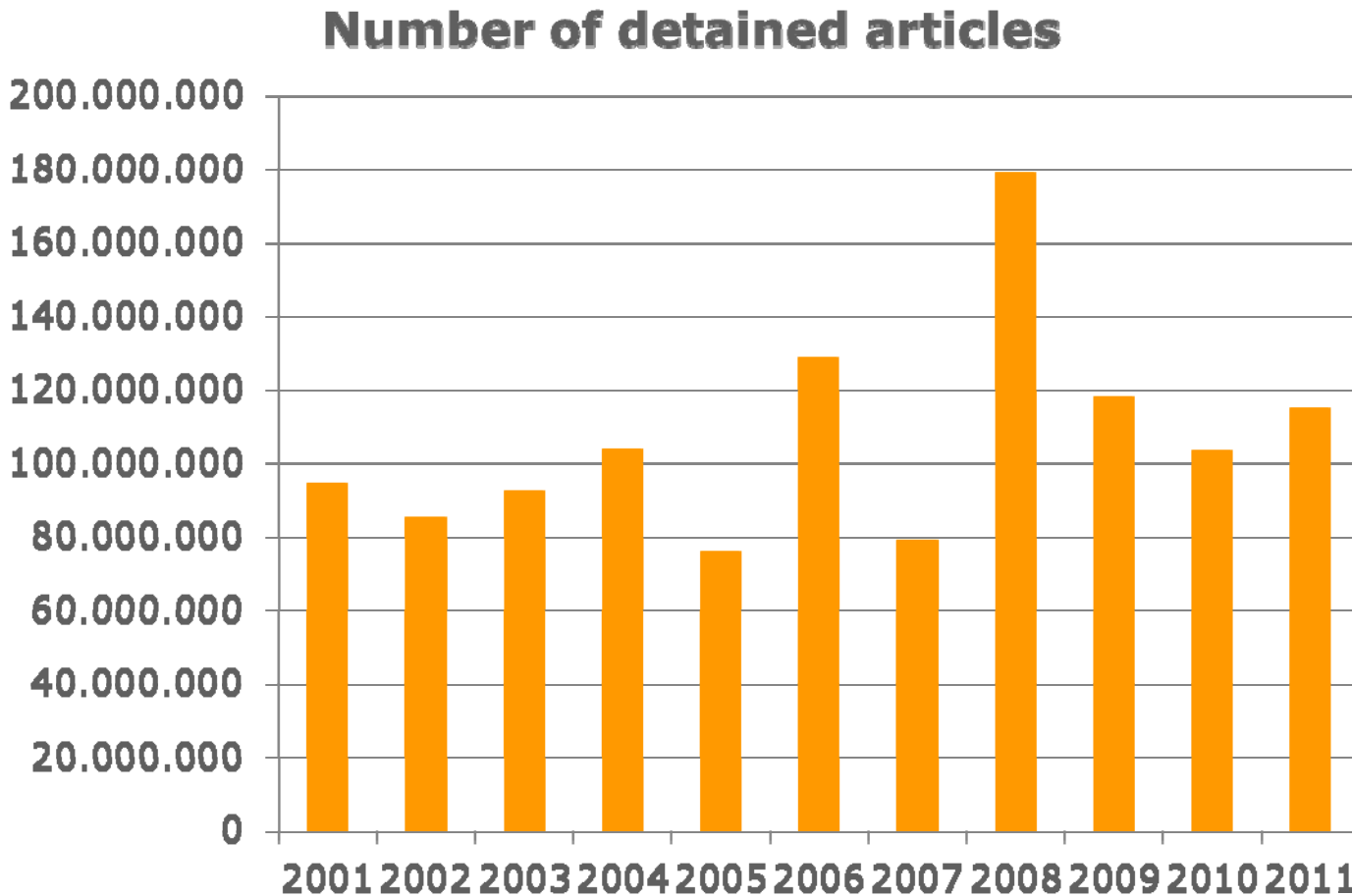
- Should any EU Country Customs authority detect suspicious products, such goods are immediately seized; a communication will be sent to the "administrative contact", who will confirm whether the products are counterfeits.
- The products will be seized for 10 working days (extendable by request from the "administrative contact" for 10 additional days).
- After ascertaining that the goods are counterfeits, relevant steps may be taken to obtain their destruction.

Cases at the European Border



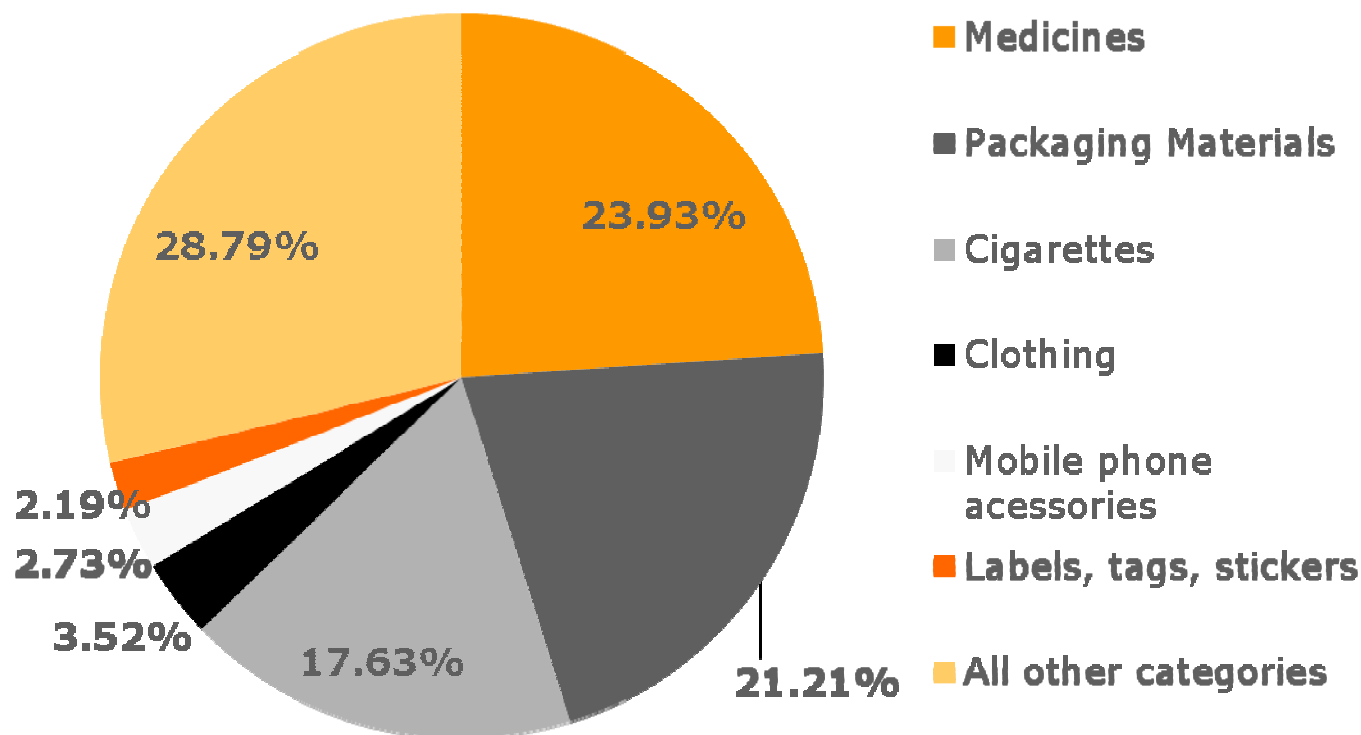
[Data Source: “Results at the EU Border - 2011”, by European Commission, Taxation and Customs Union]

Articles at the European Border



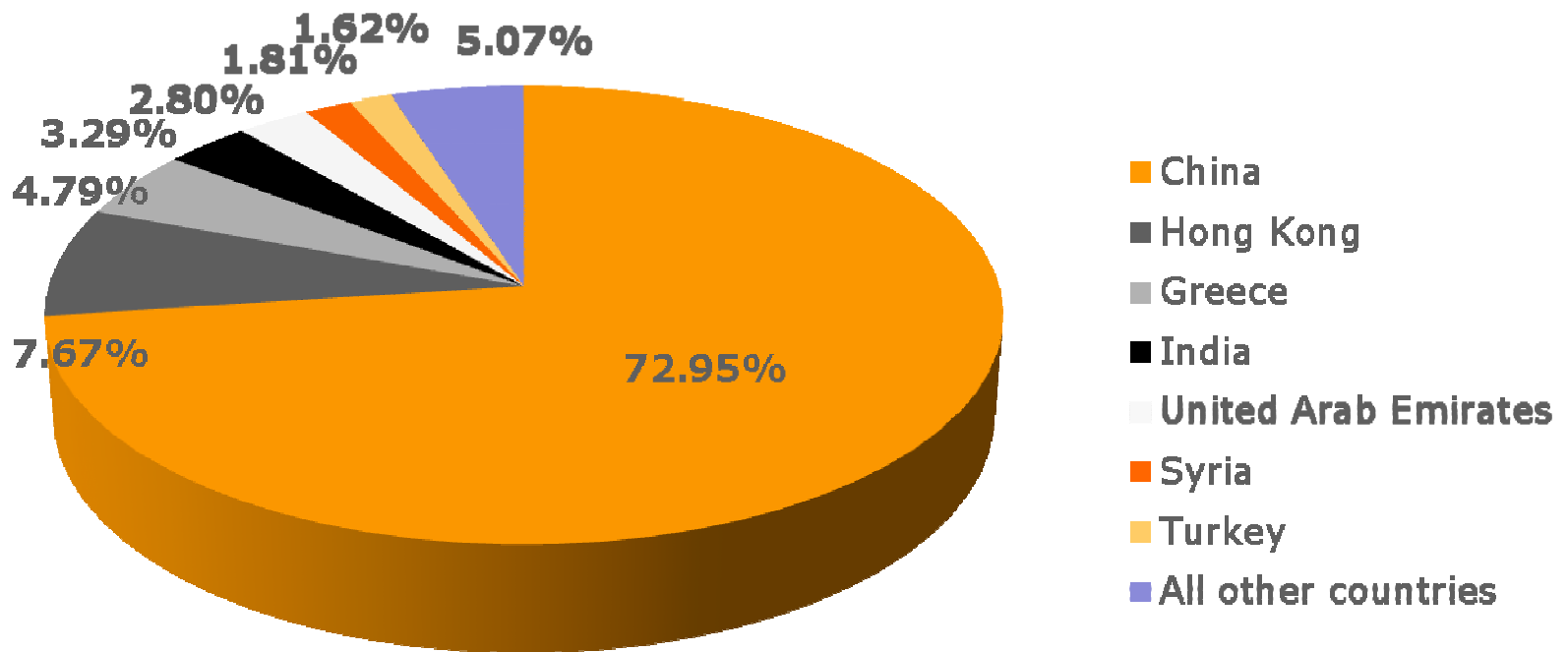
[Data Source: “Results at the EU Border - 2011”, by European Commission, Taxation and Customs Union]

Top Categories by Articles



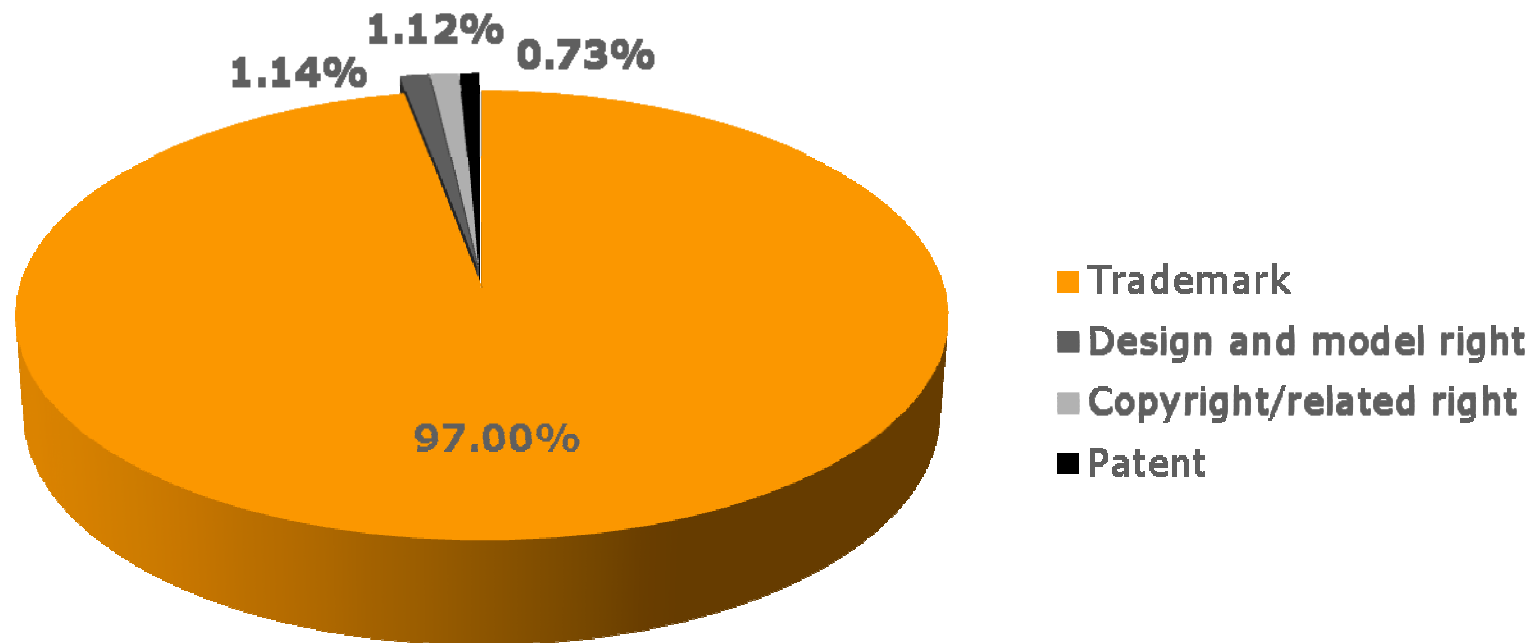
[Data Source: "Results at the EU Border - 2011", by European Commission, Taxation and Customs Union]

Provenance of Goods according to detained Articles



[Data Source: "Results at the EU Border - 2011",
by European Commission, Taxation and Custom Union]

Infringed IP Rights in relation to detained Articles



[Data Source: "Results at the EU Border - 2011",
by European Commission, Taxation and Custom Union]

Using F.A.L.S.T.A.F.F. (Fully Automated Logical System Against Forgery Fraud)

- The Italian Customs authority has created a Multimedia Database of genuine products. The key to achieve the expected results is that the Database is contributed by the right-holders.
- The Database allows, amongst other functions, comparison of suspect products with genuine products.
- Customs authorities can interrogate the Database, obtain results in real time.
- The Database is connected to the Customs Control circuit which monitors, in real time, all import and export declarations submitted to Customs.
- The future?

Conclusion

- Results relating to customs activities on counterfeit and piracy for the year 2011 show that the overall number of registered cases increased by 15% compared to the previous year.
- As in the 7 previous years, China continued to be the main source of counterfeit goods.
- As such, EU Customs surveillance has been found to be the most effective measure to prevent counterfeits from entering the EU at present.
- Most importantly, costs are cut by requesting EU Customs surveillance, as its cost is only slightly higher than the expenses for the same service in one EU country.
- EU Customs surveillance also allows, under certain conditions, information to be obtained about the so-called "Parallel market".

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ありがとうございました

ご質問等ございましたら、下記までお気軽に
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