hallmark ip

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Nigeria

Applications for registration of service marks are now being accepted in Nigeria. Services are as classified in Classes 35 – 45 in accordance with the International Classification. However, there is some concern that the Minister of Commerce and Industry, who has responsibility for trade mark matters, is not properly empowered to make this decision concerning acceptance of service marks, so there is a possibility that in future the Nigerian Courts might decide that the classification is invalid. However, given the reputation of Nigeria in the context of intellectual property matters, brand owners may wish to file their own service mark application marks now and take their chances, rather than delaying and risking some third party filing unauthorised applications for their marks.

India – Madrid Protocol

The Indian Government has approved accession to the Madrid Protocol. The matter now goes before Parliament and if approval is given, it will be possible for trade mark owners to extend their rights to India under the Madrid system. Indian applicants will have reciprocal rights to extend their trade marks to Madrid Protocol member states. Depending upon the progress through Parliament, the Madrid Protocol should come into effect in India some time during 2008.

OHIM - Registrability

The European Court of Justice has recently dismissed an appeal by OHIM against a decision by the Court of First Instance that the word mark CELLTECH was not descriptive. The original application for registration was refused on the basis that the mark comprised the combination of the terms CELL and TECH and therefore was non-distinctive and descriptive of the goods and services covered by the application, all of which related to cell technology. The ECJ took a reasonably robust view of the matter and basically reconfirmed the established principles in relation to composite marks, namely

(1) Provided that a composite word creates an impression that is sufficiently different from that produced by a combination of the individual elements, it should not be considered descriptive, even if the individual word elements may be descriptive of the goods or services.

(2) When considering a mark comprising of individual elements, it is not appropriate to isolate and consider each element separately – instead the mark should be looked at as a whole.

Montenegro - Establishment of an IP Office

As mentioned in our Newsletter of September 2006 - Montenegro and Serbia became separate states on 3 June 2006. The Governement of Montenegro has now provided a framework for establishment of its own national IP Office. The relevant legislation, for the time being at least, will be the same as that applicable in the former Union of Serbia and Montenegro. It is likely that revalidation of national trade marks applicable in the former Union will be an option, but cut-off dates and deadlines have yet to be fixed.

If you have any national applications/registrations currently covering Serbia and Montenegro which you may wish to revalidate or re-register in Montenegro, now is the time to ensure that you have all the key application/registration/renewal documents as these will be required for revalidation in Montenegro.

Serbia & Montenegro – International Registrations

Following the establishment of Montenegro as a separate legal state during 2006, WIPO is now issuing notices inviting the owners of International Registrations previously applicable in Serbia and Montenegro to apply for such registrations to be extended to the new independent territory of Montenegro. Any such applications for extension should be filed by 30 October 2007. The approximate costs of adding Montenegro to existing registrations would be somewhere around £100. In the absence of a request for extension any existing registrations will simply be regarded as applicable in Serbia alone.

UK – Change of Registration Practice

With effect from 1 October, UK registration practice will change to bring it more into line with that currently operated by OHIM. The UK IPO will continue to check new applications on both Absolute and Relative Grounds after 1 October, but it will no longer raise objections on Relative Grounds (prior rights). Instead, it will notify the applicant of any identical or similar marks which it has identified. If the applicant wishes, it can then withdraw the application. However, if the application proceeds to advertisement, the IPO will notify the owners of the identified prior rights (as of right if they are UK registrations, but only upon request and payment of an appropriate fee if the prior rights arise from CTMs) who will then have an opportunity to oppose the later application if they consider this necessary. The aim of this change in practice is to ensure that there is a degree of commercial reality in registration procedures. Since the introduction of the CTM system in 1996, applicants for registration in the UK have been disadvantaged in that the UK IPO could raise and maintain objections on the basis of prior rights even if cases where the owners of those marks had no particular interest in the marks going forwards. It was possible for applicants to seek letters of consent or to institute revocation proceedings against non-used marks. However, this caused delay and additional expenditure for applicants. The new system will be much fairer to applicants for UK registrations.

For further information please contact one of the HallMark IP Attorneys below who will be delighted to assist:

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