



# Interact Law

## **Trademark Law**

The Intellectual Property Practice Group

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## **INTRODUCTION**

The following document contains trademark law briefs for the following ten countries; Brazil, Denmark, France, Greece, Ireland, Mexico, The Netherlands, Nigeria, Portugal, and Romania.

Each country section contains the following sections; governing law, prerequisites to obtaining trademark protection (in the given country), how to obtain trademark protection, processes and costs of trademark registration, application process, and some frequently asked questions.

For more information on trademark law briefs, contact the respected law firms via their contact page. Or visit [www.interactlaw.com](http://www.interactlaw.com)

## I. Trademarks in Brazil

### Madrona AVOGADOS

#### GOVERNING LAW

In Brazil, trademarks are mainly ruled by Law No. 9,279/96 (Industrial Property Law), the Paris Convention for the Protection of Industrial Property, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and several norms issued by the National Institute of Industrial Property (*Instituto Nacional de Propriedade Industrial* - “INPI”).

#### TRADEMARK DEFINITION AND REQUIREMENTS FOR PROTECTION

In Brazil, a trademark is a sign applied to a product or a service to distinguish it from other identical or similar products or services. The distinctive signs that may be visually perceived are subject to registration. Other requirements relate to the veracity and legality of the product or service to be identified by the trademark. Misleading trademarks and/or those related to illegal products and/or services are not registrable.

#### TRADEMARK REGISTRATION

The protection of trademarks in Brazil is obtained by registering the trademark with the INPI. Trademarks not duly registered with the INPI are not granted protection, even if used for several years. Only the trademark registration grants its owner the property of the asset and the exclusive right for its use.

Trademarks are divided in the following groups:

- **Nominative** - composed by one or more words and/or numbers, such as the shoe brand Adidas
- **Figurative** - composed by drawings, images and or symbols, such as:



- **Mixed** – composed by word and/or numbers and drawings, images and/or symbols, such as:



- **Three-dimensional** - the form of the product or its package, such as:



### **APPLICATION PROCESS**

After submission of the application, INPI will analyze the request and may issue requirements, determine the suspension of the analysis (in case of a temporary obstacle for the analysis, such as another similar request that is currently under analysis) or publish the request to allow third parties to present oppositions.

After completing the above-described process, INPI shall decide on the request, granting or denying the registration. Appeals are available for both the granting and the denial of the request. The whole procedure may take a couple of years, but the priority of the request counts from its submission.

### **CONTACT INFORMATION**

**mADRona**  
A D V O G A D O S

*\*\*For more information regarding the Brazilian Trademark process, please contact Luciana Renouard at [Luciana.renouard@madronalaw.com.br](mailto:Luciana.renouard@madronalaw.com.br) or by phone at 55.11.4883.8750.*

## II. Trademarks in Denmark

### ADVODAN

#### **GOVERNING LAW**

In Denmark, trademarks are governed by Danish law, EU-legislation and International law.

##### *Danish law*

The Danish Consolidate Trade Marks Act (Varemærkeloven) governs national trademarks in Denmark.

##### *EU-legislation*

The Danish Consolidate Trade Marks Act implements the provisions set forth in the European Union's directive on trademark matters.

The European Union's regulation governs the EU Trade Mark System.

##### *International law*

Denmark has ratified a number of international treaties, i.e. The Nice Agreement, The Trade Mark Law treaty, TLT and The Madrid Protocol Concerning the International Registration Marks.

This brief is focused on obtaining Danish trademark protection according to the Danish Consolidate Trade Marks Act.

#### **PREREQUISITES TO OBTAINING TRADEMARK PROTECTION**

To obtain trademark protection in Denmark, the mark (sign):

1. must be *distinctive*; and
2. must be capable of being *represented graphically*; and
3. must not (i) be identical with an existing trademark of the same kind of products and/or services for which protection is sought; or (ii) create a likelihood of confusion with an existing trade mark of identical or similar kind of products and/or service for which the mark seeks protection; or (iii) must not create a likelihood of confusion with a "well-known" mark in Denmark regardless the identically or similarity of the products and/or services for which protection is sought.

#### 1. **Distinctiveness**

Distinctiveness is a fundamental prerequisite in order to obtain trademark protection.

This means that the mark must be capable of distinguishing the goods or services to which it applies from those of others, and it is further a prerequisite, that the mark must not be descriptive.

The non-descriptive prerequisite means that the trademark must not describe or characterize the products or services for which protection is sought, e.g. if the technology company 'Apple Inc.' in fact was in the fruit trade business and sold apples, the trademark would be descriptive and could not be protected.

## **2. Represented graphically**

The prerequisite of being represented graphically means that the mark can be the object of a graphically rendering which is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

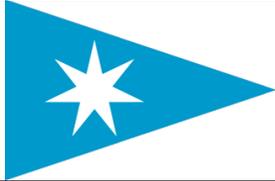
Traditionally, there are two main groups of trademarks; word marks and figurative marks. In addition to the main groups and more recently, there are also sound marks and the shape of the goods and their packaging.

The word marks consist exclusively of letters and/or numbers in a regular font, while figurative marks are a collective term for all other types of trademarks, including logos, words in special graphic designs, three-dimensional marks, moving marks, etc.

A trademark could either be:

- Words, collocations and slogans, i.e. Bang & Olufsen or Carlsberg – probably the best beer in the world.
- Letters and numbers, which are not words or collocations, i.e. B&O, BMW, HTC.
- Figures, pictures and logos, i.e. The Apple logo, McDonald's Golden Arches.
- The shape of the goods and their packing, i.e. the Coca-Cola bottle.

A few Danish examples:

<b>Bang &amp; Olufsen</b>	
<b>Carlsberg</b>	
<b>Novo Nordisk</b>	

### 1. Violating existing trademarks

It is a fundamental prerequisite that the mark for which trademark protection is sought has to be available.

A mark is available if it does not imitate or reproduce an existing mark of the same kind of products and/or services and that mark is protected either by registration or by use.

A mark is not available if it creates a likelihood of confusion with a “well-known” mark in Denmark. The rulings are, however, very specific and as an example a Danish pop group from the 1970’s named “Shit & Chanel” was violating the French firm Chanel Société Anonyme, but an owner of a Danish hot dog stand called “McAllan” was not violating the US firm McDonald’s Corp.

Trademarks that are contrary to Danish law, public order or morality will not be registered or protected.

Trademarks that include badges, emblems and escutcheons which are of public interest (i.e. royal crowns) and which use has not been approved by the competent authorities will not be registered or protected.

The Danish Patent and Trademark Office has an online database tool to check/search for registered trademarks in Denmark at:

<https://onlineweb.dkpto.dk/pvsonline/Varemaerke>

## **HOW TO OBTAIN TRADEMARK PROTECTION**

A trademark protection in Denmark can be obtained in two different ways:

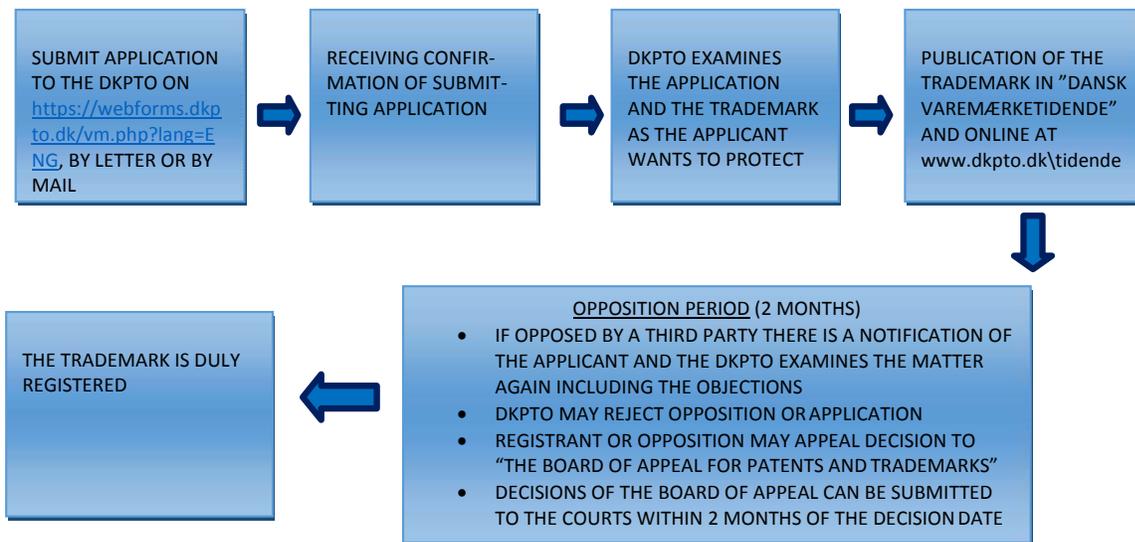
1. Protection can be obtained by *registration* of the trademark by the Danish Patent and Trademark Office (the DKPTO). Trademarks registered through the DKPTO will only be protected in Denmark (and Greenland and the Faroe Islands). A Danish trademark registration is valid for 10 years and may be renewed for further periods of 10 years.
2. Trademarks can also be protected in Denmark based alone on *use*. To obtain trademark protection through use, it is a prerequisite that the mark is used continuously, which does not apply for registered trademarks. Further, protection based on use alone only applies for the specific goods and services for which the mark is used. Finally, by choosing to register the trademark, the applicant can wait up until five years to initiate use of the mark without losing the right. That is not possible with the protection based on use.

In addition to the above, trademark protection can also be obtained by filing an application for a European Trademark with the European Union Intellectual Property Office (the EUIPO). If protection is granted it applies in Denmark and the rest of the European Union.

## PROCESS AND COST OF THE TRADEMARK REGISTRATION

Applications has to be submitted to the DKPTO either online or by letter or mail. Using forms is not mandatory.

The basic costs consist of a fee of DKK 2,350 (approx. €315) for filing an application of maximum three different classes and a fee of DKK 600 (approx. €80) for each additional class.



## CONTACT INFORMATION



*\*\*For more information regarding the Danish Trademark Process, please contact Jens Gottlieb at [jeqo@advodan.dk](mailto:jeqo@advodan.dk)*

### III. Trademarks in France

COHEN AMIR-ASLANI

#### GOVERNING LAW

In France, trademarks are governed by the Intellectual Property Code which includes the French transposition of the provisions set forth in European Union's Directives on trademark matters.

#### PREREQUISITES TO OBTAINING TRADEMARK PROTECTION

To obtain trademark protection in France, the "sign" for which the applicant seeks protection:

1. Has to be distinctive; and
2. Must not (i) be already registered or (ii) create a likelihood of confusion with a sign already registered in the same class of product and/or service for which protection is sought; and
3. Must not create a likelihood of confusion with a "well-known" sign regardless the class of product and/or service for which protection is sought.

**Distinctiveness** - The trademark could be either a:

Word mark	Semi-figurative mark	Figurative mark	Tagline
Prada			Just Do It (Nike)
IBM			Panasonic Ideas For Life
307 (Peugeot)			Because you're worth it (L'Oréal)

The sign for whose protection is sought MUST NOT :

- Describe the good or service it refers to. For example, “*Café*” for coffee and “*Pur Laine*” (pure wool) for a wool carpet, are not protectable. Words in English and other languages may be used as marks even if they are descriptive, provided however that said word is not entered into common French language;
- Be a praise term used alone as “*Super*” or “*Extra*”;
- Be a term that could mislead the consumer about the nature, characteristics or origin of the product such as “*Genéva*” for watches made in France;
- Contain certain public coats of arms, flags or other protected official signs listed with the World Intellectual Property Organization (WIPO);
- Use an Appellation of Origin which is constituted by a regulated name, which is that of the place from which the product is derived, to which it owes its specific characteristics. E.g.: “*Bordeaux*” alone, for a wine, is prohibited.

**Anteriority and likelihood of confusion** - The sign for which trademark protection is sought must be available. A trademark is available when it does not reproduce or imitate a sign which is already under protection in the same class of goods and/or services. For example, three different companies were able to have the trademark “Lotus” protected in France because it was for goods and services classified in different classes;

- Class 12 vehicles (view below)



- Class 24 fabrics (view below)



- Class 38 telecommunications “Lotus Notes.”

Therefore, nothing forbids two (or more) identical trademarks to legally co-exist, if they are related to different types of products, which have nothing in common, in order to exclude any likelihood of confusion.

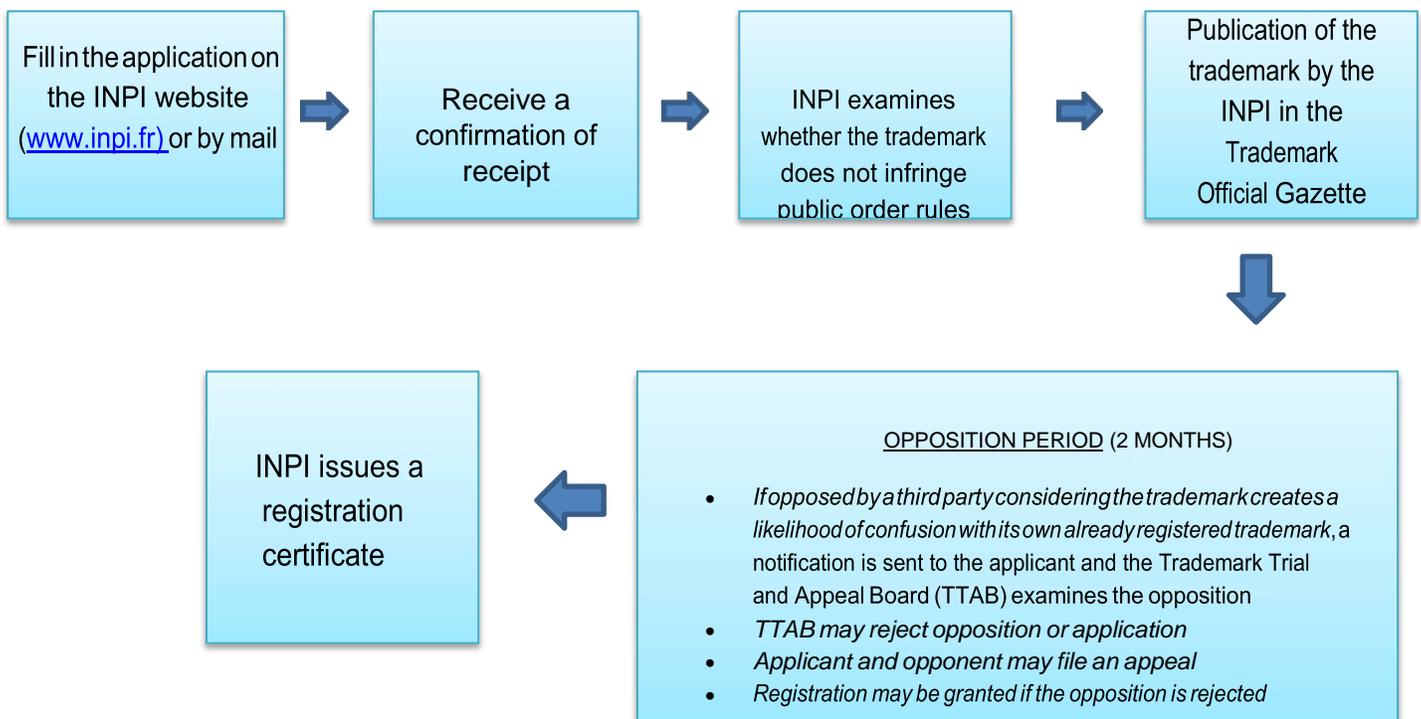
To be able to know the current availability of a trademark, the Nice Agreement of June 15th 1957 provides the relevant classification determining in which class the trademark will be classified.

Availability check of a sign is available on the website <http://bases-marques.inpi.fr/> (only in French).

**Well-known sign** - The contemplated trademark shall not represent or be confused with a well-known sign which is not registered in France or is registered but in a different class of the good.

### **THE PROCESS AND COST OF THE TRADEMARK REGISTRATION**

In France, the entity in charge of registering trademarks is the *Institut National de la Propriété Intellectuelle* (INPI).



The cost essentially depends on the number of classes selected in the application. Thus, the basic cost is €250 for a filing in a maximum of 3 different classes. An extra €42 is requested for any additional class.

Note: If you consider using your trademark outside of France, especially in Europe, you can also file a single European trademark application at the EUIPO (European Union Intellectual Property Office), in order for your Trademark to be automatically protected in the entire European Union (excl. Switzerland, Norway and Monaco). In such case, the costs are different (from €850).

### **THE CONTENT OF THE PROTECTION GRANTED**

From the date of the application, the Trademark will benefit of a full protection in France for 10 years. The Trademark protection may be renewed every 10 years by completing the required form.

### **FREQUENTLY ASKED QUESTIONS**

*What happens when a Trademark is not used?*

Should the owner of a French Trademark not use it for the products and services described in its application for 5 years, the latter may lose its trademark's protection.

*Does the INPI check on the availability of a Trademark?*

The INPI is not allowed to do so during the application phase. It is up to the applicant to proceed with searches prior to apply for a trademark protection.

*Does the INPI control whether the registered trademark is counterfeited?*

The INPI is not allowed to control the eventual counterfeiting of registered Trademarks. It is up to the owner to put into place a counterfeiting surveillance and go in front of a court if necessary to protect its rights.

### **CONTACT INFORMATION**



COHEN AMIR-ASLANI

*\*\*For more information regarding French Trademarks and the process, contact Rebecca Guyot at [r.guy@caa-avocats.fr](mailto:r.guy@caa-avocats.fr)*

## **IV. Trademarks in Greece**

### **POLITIS & PARTNERS**

#### **LEGAL FRAMEWORK**

The registration of Greek trademarks is governed by Law 4072/2012, as amended and in force (hereinafter “**Greek Trademark Law**”).

The registration of a trademark requires the filing of an application with the national trademark authority, namely the General Secretariat of Commerce and Consumer Protection of the Ministry of Economy, Development and Tourism.

Trademark rights are acquired through registration, following an accepting decision on a previous application by the concerned natural or legal person. The trademark grants its holder with an exclusive, erga omnes, right of use of the said trademark. This includes, but is not limited to, the right to use it, to affix it to products which is intended to distinguish, including packaging, writing papers, invoices, price lists, notices, advertisement and other printed material, to characterize services provided and to use it in any electronical or audiovisual media.

As far as the unregistered marks are concerned, the said marks also enjoy a certain degree of protection under articles 13 to 15 of Law 146/1914 on Unfair Competition, as amended and in force. The protection, however, of non-registered marks is territorially limited in the sense that covers only the geographical area where the aforementioned marks have been used.

#### **SCOPE**

Pursuant to article 121 of the Greek Trademark Law, any sign capable of being represented graphically and of distinguishing the goods and/or services of one undertaking from those of others may constitute a trademark.

Trademarks can particularly be words, names of natural or legal persons, pseudonyms, illustrations, designs, letters, numbers, colors, sounds, including the musical phrases, the shape of a product or its packaging and the advertising slogans.

A trademark under Greek Trademark Law may consist of a combination of word/name and illustration/design elements (composite/composition trademarks). It is worth noting that Greek Law provides for collective marks (signs deriving from a membership to a particular association) but not for certification ones (signs guaranteeing to the public that the relevant goods or services possess a certain characteristic, i.e. material, quality etc.) given that the latter are considered unable to perform a distinctiveness function.

## **Procedure for Trademark Registration**

As of November 3, 2014, the Greek Trademark Office has implemented an e-filing and e-renewal online procedure for national trademarks, enabling therefore trademark registration or renewal applications to be submitted 24 hours a day, seven days a week.

For filing a trademark application before the Greek competent authority, following supporting particulars are required:

- Complete list of goods/services (classification classes of Nice Agreement dated June 15, 1957); a single application may be filed for registration of a mark for more than one class of goods/services;
- Full name, address and nationality of applicant;
- A special, duly signed power of attorney, in case a lawyer is retained. It should be noted that the filing procedure has now been simplified and therefore the appointment of a lawyer is optional. In any case, though, the applicant is required to designate an addressee, lawyer or not, for the service of procedural documents.
- In case of application by physical presence, the applicant must additionally submit a digital, soft- copy of the application form (on a CD or USB).

Following a trademark application filing, the Greek Trademark Office examines each filing with respect to both absolute and relative grounds, as defined under articles 123 and 124 of the Greek Trademark Law.

In case the application fulfills the requirements set out by Greek Trademark Law, it is accepted. If the application does not meet the legal prerequisites, then the applicant is notified by the Greek Trademark Office in order to rectify or complete any irregularities or deficiencies detected. In this case, the applicant may revoke his/her application, limit the trademark, or submit his/her observation within one month. In the event of failure to reply or to comply, the application is rejected, and the applicant is informed of the decision. The applicant is then entitled to challenge the rejecting decision before the Administrative Trademark Committee within sixty (60) days (or ninety (90) days in cases of foreign entities) following the notification of such decision. The relevant Administrative Trademark Committee's decision is subject to further appeal before Greek Administrative Courts within sixty (60) days as of the notification of the decision to the applicant.

Furthermore, a third party with a legitimate interest has the right to oppose a trademark application by filing an opposition (*'anakopi'*) against a positive decision of the Trademark Office within three (3) months as of the publication of the said decision on the website of the

aforementioned Secretariat. In the context of defending his/her application against the opposition, the applicant may call on the opponent either to submit evidence of the use of the opposing trademark in respect of the relevant goods/services on which the opposition is based, during the five-year period preceding the date of the publication of the opposed application, or to prove the existence of other reasons for non-use.

### **TERM OF PROTECTION**

Under Greek law, trademark protection lasts for ten (10) years, commencing the day after the filing date. Trademarks can be renewed every ten (10) years following a relevant application and a renewal fee payment. If renewal is not requested within the specified period, a trademark can still be renewed up to six months after the expiration date, following payment of an administrative fine.

### **GREEK MARK**

Greek Trademark Law provides for a “**Greek Mark**”, which indicates the national origin of goods and services. The main purpose of this innovative is the reinforcement of the Greek market by increasing the demand for Greek products, avoiding consumers’ deception in relation to the origin of goods and services, protecting the producers’ interests against counterfeiting and unfair competition and, finally, strengthening the competitiveness of Greek enterprises.

The Greek Mark is statutory, awarded though on an optional basis if this is requested by an enterprise. It is also not linked to a claim of quality but of the nationality of the good/service and therefore it is compatible with the EU mark and does not, in any way, constitute a breach of competition rules.

A Greek Mark may be awarded for the following categories of goods/services:

- a. natural goods (agricultural, livestock products, raw materials)
- b. processed natural goods
- c. other (industrial or handicrafts) goods/services.

For the award of the Greek Mark, goods and services must meet the requirements of international, European and national provisions on characteristics, labeling, safety and consumer protection.

In addition, the domestic value added should be based on their production or processing. Especially for natural goods, the main criterion for awarding the Greek Mark is the production or rearing or harvesting, depending on the product, in the Greek territory. Regarding processed natural goods, a percentage of the mass of its ingredients or the mass of the basic raw material used must derive from Greece. For other (industrial - craft) goods and services, the basic award criterion is defined as the percentage of production costs incurred in the Greek territory, as specified in the award regulation for each good or service.

In order to be granted with the right to use the Greek Mark, the applicant shall file an application - written declaration, printed or electronically, and pay the relevant for each category of goods/services fees to the competent body in accordance with the Regulations for the Greek Mark award.

The right to use the Greek Mark is granted for an indefinite duration. During the entire period of the use, the beneficiary must comply with the award conditions, as they apply every time. Compliance with the conditions of use of the Greek Mark is ensured by means of extraordinary inspections carried out by the competent for awarding Body. Finally, the beneficiary pays an annual fee for use, otherwise the right is automatically revoked.

So far, there are in place regulations for the award of the Greek Mark to dairy products and alcoholic drinks, while regulations pertaining to olive oil and olives are expected shortly.

The following heart-shaped flag device mark, accompanied by the words “Greek Mark” in English or in Greek, where applicable, serves as the Greek Mark:



## **CONTACT INFORMATION**

**POLITIS & PARTNERS**  
Law Firm

14, SOLONOS STR. Tel.: +30 210 7297252  
106 73 ATHENS Fax: +30 210 7251144  
GREECE Email: [info@egplaw.gr](mailto:info@egplaw.gr)  
Web: [www.egplaw.gr](http://www.egplaw.gr)

*\*\*For more information on Greek Trademarks, please contact Emmanouil Savoidakis via email at [esavoidakis@egplaw.gr](mailto:esavoidakis@egplaw.gr)*

## **V. Trademarks in Ireland**

### **TippMcKnight**

#### **LEGAL FRAMEWORK**

Irish Trademark law is governed by the Trade Marks Act 1996 which implemented the First Trademark Directive 89/104/EEC into Irish law, the Trade Marks Rules 1996 and the Trade Marks Amendment Rules 2010. These laws were amended by various acts and statutes, in particular by the Copyright and Related Rights Act 2000, the Patent (Amendments) Act 2006, S.I. No. 622 of 2007 European Communities (Provision of services concerning Trade Marks and Industrial Design) Regulations 2007 and the Intellectual Property (Miscellaneous Provisions) Act 2014. Ireland is also a Signatory of various International Treaties e.g. the Madrid Protocol, the Trademark Law Treaty and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). The Irish Patents Office is the Authority in charge of all trademark related matters.

#### **UNREGISTERED TRADEMARK**

Unregistered Trademarks are protected in Ireland by an action for passing off only. The registration of the trademark leads to a much better level of protection.

#### **DEFINITION OF A TRADEMARK UNDER THE ACT**

The Trademarks Act defines a ‘trademark’ as “Any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.” The act provides for a list of examples such as “words (including personal names), designs, letters, numerals or the shape of goods or their packaging”. Also smells, sound marks and tastes can be trademarks, although they are difficult to represent graphically.

#### **OWNERSHIP**

There are no restrictions on who can apply for and own a Trademark in Ireland. Both private individuals and companies can file an application to register a Trademark. The Trademark Act also provides for jointly owned Trademarks.

#### **Application**

The Irish Patents Office will examine an application to establish whether the requirements of the Trademarks Act and the Trademark Rules have been met. One of the substantive requirements is whether the mark is a trademark within the statutory definition, which requires

the mark to be capable of being represented graphically and of distinguishing the applicant's goods or services from those of others. There are some absolute grounds for refusal, which include an examination as to the distinctiveness and whether the mark is deceptive or contrary to law or public policy. If the registration requirements are met, the application is accepted and allowed to proceed to publication in the Patents Office Journal.

### **POTENTIAL OPPOSITION AND FINAL REGISTRATION**

With publication third parties can oppose the application within a three-month opposition period, before a trademark can proceed to registration. An opposition must be filed in writing and accompanied by the filing fee. If an opposition is filed, the applicant can give a counter-statement within another three-month period. As soon as a decision is taken, the Patents Office informs the parties hereof. If there is no opposition or decided in favour of the applicant, a registration certificate will be issued upon payment of the final registration fee. Registrations of trademarks under the Trademarks Act 1996 are granted for a period of 10 years from the filing date and can be renewed after that period.

### **REVOCAION FOR NON-USE**

A trademark must be put to genuine use in Ireland by the owner or with his consent in relation to the goods or services for which it is registered within five years of the date of publication of the registration, unless there are proper reasons for non-use. A mark may be revoked for non-use.

### **INFRINGEMENT PROCEEDINGS AND ENFORCEMENT**

Infringement proceedings by the trade mark owner cannot be brought prior to the date of publication of registration, but as the effective date of registration is the application date, damages for infringement can be claimed from this date. Both civil and criminal remedies are provided for in the Trademark Act, including damages, injunctive relief and fines or imprisonment.

### **CONTACT INFORMATION**

**TippMcKnight**  
solicitors

41 Fitzwilliam Place, Dublin 2  
tel: +353 1 254 3432 | email: [info@tipp-mcknight.com](mailto:info@tipp-mcknight.com)  
website: [www.tipp-mcknight.com](http://www.tipp-mcknight.com)

*\*\*For more information, please contact Ursula Tipp, Partner at TippMcKnight. She may be reached at [utipp@tipp-mcknight.com](mailto:utipp@tipp-mcknight.com) or via telephone at +353 1 254 3432.*

## VI. Trademarks in Mexico

CHACON & RODRIGUEZ ABOGADOS

### GOVERNING LAW

In Mexico, trademark protection is governed by the federal law named “Ley de la Propiedad Industrial” (Industrial Property Act) and its Regulations. The federal governmental agency in charge of trademark protection is the “Instituto Mexicano de la Propiedad Industrial” (Mexican Institute of Industrial Property, henceforth “**IMPI**”).

### WHAT IS THE STANDARD FOR WHAT MAY BE TRADEMARKED?:

According to the Industrial Property Act, a trademark is any visible sign that distinguishes products or services from others of the same type or class in the market. The signs that can be protected can be: (i) designations and visible shapes, (ii) three-dimensional shapes, (iii) trade names and corporate names and, (iv) the name of individuals, provided they are not confused with a registered trademark or published commercial name.

The Act also refers to specific items that cannot be registered as a trademark, some of them include: (i) animated or dynamic designations or shapes, even if they are visible signs, (ii) the technical names or common names of the products and services that are intended to be protected with the trademark, (iii) letter, digits or colors by themselves, unless combined with other distinctive elements, (iv) the translation to other languages of non-registrable words, (v) names, pseudonyms, signatures and portraits of individuals without the consent of such individuals, (vi) trademarks identical or similar to a confusing degree to others already registered or which were filed for registration in an earlier date for the same products and services.

Trademark types: nominative (name only), unnamed (image only, 3D (only the three-dimensional shape) and mixed (combination of name and/or image and/or 3D shape).

Other trademark types include:

Collective trademarks. Associations of producers, manufacturers, traders or services providers, which are duly incorporated, may apply for this registration to protect in the market the products or services of its members, with respect of products and services of third parties.

Notorious trademark. A trademark is notoriously acknowledged in Mexico, in case a determined sector of the public or commercial circles of the country knows the trademark due to the commercial activities in Mexico or abroad by a person that uses this trademark with

respect of its products or services or as a consequence of the marketing or publicity of such trademark.

Famous trademark. A trademark can be declared as famous, when it is known by the majority of the consumer public.

### **WHAT IS THE DIFFERENCE BETWEEN REGISTERED OR UNREGISTERED? ARE THERE MULTIPLE REGISTRY'S?**

According to the Industrial Property Act, any person such as industrials, merchants or service providers may use trademarks in the industry, in commerce or for the rendering of their services; however, the right to its exclusive use is only obtained by registering such trademark before the IMPI.

The IMPI has only one register for the trademarks, regardless of its type (“regular”, famous or notorious or collective trademark). The Trademark Consultation Service of the IMPI (Marcanet), however, also provides information of commercial notices and trade names.

Trademarks registrations in Mexico are granted for a 10-year term. The registrations can be subsequently renewed (as required) for 10 years of additional protection. Ideally, applications for renewal should be filed 6 months prior to the conclusion of the validity of the registration.

### **WHAT IS THE APPLICATION PROCESS?**

1. Submit the application to the IMPI
2. Publication in the Industrial Property Gazette (within 10 business days after filing of the application)
3. Opposition period (One month). The opposition does not suspend the registration procedure. IMPI will publish in the Gazette the list of applications in which an opposition writ was filed.
4. Reply to the opposition writ(s), if any (1 month after the publication of the opposition in the Gazette)
5. Examination of formalities and documentation
6. Fulfilling pending requirements according to the examination (if any). The IMPI grants a period of two months to provide the corresponding information/documents. An extension of two additional months to reply can be applicable.
7. Substantive examination. The IMPI grants a period of two months to reply to its findings (if any).

8. IMPI issues a trademark title or its refusal. Provided there are no requirements from the IMPI (arising from the examinations), it can grant a registration in four months from the date of filing.

## **CONTACT INFORMATION**



Av. Insurgentes Sur No. 1605 Piso 10 Módulo D  
Col. San José Insurgentes C.P. 03900, México, D.F.  
T +52(55) 5662•6840 / 5662•8365  
[www.chro.com.mx](http://www.chro.com.mx)

*\*\*For more information regarding the Mexican Trademark Process, please contact Ricardo Chacon at [rchacon@chro.com.mx](mailto:rchacon@chro.com.mx) or by phone at +52 (55)566 26840.*

## VII. Trademarks in The Netherlands

De Vos & Partners Advocaten N.V.

### **GOVERNING LAW**

A Benelux trademark is valid in the Benelux (Belgium, The Netherlands and Luxembourg). There is no separate Dutch trademark for The Netherlands. The Benelux trademark is governed by The Benelux Convention on Intellectual Property BCIP. Applications are filed via the Benelux Office for Intellectual Property (BOIP) in The Hague.

### ***What can be registered as a Benelux trademark?***

According to article 2.1. BCIP the names, drawings, imprints, stamps, letters, numerals, shapes of goods or packaging and all other signs (sounds and colors) that can be represented graphically and that serve to distinguish the goods or services of an undertaking shall be considered as being individual trademarks. However, signs consisting solely of a shape which results from the nature of the goods, which gives a substantial value to the goods or which is necessary to obtain a technical result cannot be considered as being trademarks.

The BOIP shall refuse on absolute grounds to register a sign which, according to article 2.11 BCIP; (i) cannot constitute a trade mark (see article 2.1. BCIP); (ii) is devoid of any distinctive character; (iii) consists exclusively of a sign that may serve to designate characteristics of the goods or services; (iv) consists exclusively of signs or indications that have become customary in the language or practices of trade; (v) is against the principles of morality or public policy; (vi) is of such nature that it will deceive the public; (vii) contains specific misleading geographic indications.

### ***Opposition and invalidation***

Trademark owners can oppose to a pending application at the BOIP (article 2.14 BCIP). The fee for filing an opposition is € 1.040,=. A trademark holder can file opposition against a pending application for:

- Identical trademarks filed for identical goods or services;
- Identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark;
- Similar trademarks filed for goods or services that are not similar, which enjoy a reputation in the Benelux territory, where use without due cause of the later mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier mark.

After registration the owner of an earlier trademark can start court proceedings to request the invalidation of a later registered trademark. This action can be based on the following (article 2.28 BCIP):

- The registration of a sign which cannot constitute a trademark
- The registration of a trademark which is devoid of any distinctive character;
- The registration of a trademark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or performance of the service, or other characteristics of the goods or services;
- The registration of a trademark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- Trademark registered in bad faith;

### ***Registration and costs***

The applicant has to include a graphical representation of the trademark, describe the sort of mark, describe what colors or other distinctive elements the mark consists of and describe the goods and services based on the Nice Classification.

The BOIP charges a fee for trademark applications. The fee for an individual Benelux trademark registration (up to three classes) is € 248,=. Per extra class a fee of € 39,= is charged.

### ***Duration***

Registration is valid for 10 years and may be renewed for further periods of 10 years when the renewal fee is paid. The BOIP will notify the trademark owner that the registration needs to be renewed. A trademark can be renewed from six months prior to the expiry date, and up to six months after the expiry date.

Renewal fees are € 268,= for an individual mark, up to three classes. An additional fee of € 48,= is charged for every additional class.

### ***Scope of protection***

According to article 2.20 BCIP a registered trademark shall provide its holder with an exclusive right. The exclusive right to a trademark shall permit its holder to prohibit any third party, without its consent, from:

- Using in the course of trade a sign that is identical to the trademark for goods or services that are identical to those for which the trademark is registered;

- Using in the course of trade a sign in respect of which, because it is identical or similar to the trademark and the goods or services covered by the trademark and the sign are identical or similar, there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the trademark;
- Using in the course of trade a sign which is identical or similar to the trademark for goods or services which are not similar to those for which the trademark is registered, where the trademark enjoys a reputation in the Benelux territory, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark;
- Using a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the provisional action distinctive character or the repute of the trademark.

### ***Enforcement***

A trademark holder can file proceedings before one of the Dutch District Courts based on the location of the defendant or the place where the infringement took place. There is no court exclusively for Benelux Trademark cases.

When a trademark holder has an urgent case (e.g. an ongoing infringement) the trademark holder can file summary proceedings to get a preliminary injunction to stop the infringement. A hearing can be planned (depending on the case and urgency) within a few weeks. Two weeks after the hearing a judgement will follow.

Proceedings on the merits can be initiated to get final injunctions and payment of damages or profits. These proceedings can take quite some time, mostly over a year. That is why proceedings on the merits are often combined with summary proceedings to first get a preliminary injunction.

In case of trademark infringement cases the winning party is entitled to compensation of costs. Dutch courts use guidelines for these cost awards. Depending on the complexity of the case, this varies from € 6.000,= to € 15.000,= for summary proceedings, to between € 8.000,= and € 25.000,= for main proceedings.

### **EU Trademark & International Trademark**

Next to the Benelux trademark there is also the possibility to register a EU trademark or an International trademark. Both trademarks differ from the Benelux trademark in application, scope and enforcement and will hereafter be shortly addressed.

## EU Trademark

An EU trademark is valid in the European Union for the entire European market. Applications are filed via the European Intellectual Property Office (EUIPO) in Spain. One application will take effect in all EU countries which makes this a cost efficient way to register a trademark in 28 countries at once, instead of having to register in all these countries separately. The EUIPO fee for a EU trademark are € 850,= for registration in one class.

The downside to this is that the trademark must be distinctive in all EU countries and that opposition in one EU country can jeopardize the trademark for all EU countries. Which will result in costly procedures to convert the EU trademark to national trademarks.

In The Netherlands the District Court in The Hague has the exclusive jurisdiction regarding EU trademarks.

## International Trademark

An International trademark covers the countries that are affiliated with the Madrid Protocol. One can request protection in all affiliated countries or opt for a number of countries. International applications are filed via the Benelux Office for Intellectual Property (BOIP). Therefore an international trademark application must be based on an earlier Benelux or EU trademark. Once the BOIP preformed all checks, the application is send to the World Intellectual Property Organization (WIPO), who will further process the application. The fees for application depend on the number of countries and classes chosen by the applicant.

## CONTACT INFORMATION

**DE VOS & PARTNERS**  
ADVOCATEN

\*\*For more information please contact Dennis van Beem at [DvanBeem@devos.nl](mailto:DvanBeem@devos.nl).

## VIII. Trademarks in Nigeria

### AEC LEGAL

#### **GOVERNING LAW**

**Legal framework** - Nigerian Trademark law is governed by the Trademarks Act TI 3 L.F.N 2004 and Trademark Regulations 1967. The government body with authority over all trademark related matters is the Trademarks, Patents and Design Registry under the Commercial law Department of the Federal Ministry of Industry, Trade and Investment.

**Scope of protection** - While registration of trademarks is not necessary in Nigeria, it is advised to do so as where an action is instituted for trademark infringement, an unregistered trademark is only protected by an action for passing off. Registering a trademark serves as constructive notice to the public of the existence of the trademark.

**Subject matter** - Trademark protection generally covers any word, phrase, symbol, design, or combination of words, phrases, symbols or designs identifying and distinguishing the source of goods of one party from another. In Nigeria, protection covers trademarks of the following nature:

- The name of company, individual or firm represented in a particular manner
- An invented word or words
- A word or words with no direct reference to the character or quality of the goods and not in relation to a geographical name or surname.

A trademark may be registered in any colour. However, where coloured, protection is limited to that distinct shade. If registered in black and white, it is protected in all colours.

#### **TRADEMARK REGISTRATION**

Trademark Application is made to the Trademark Registrar (Trademarks, Patents and Design Registry) under the Commercial law Department of the Federal Ministry of Industry, Trade and Investment.

Once the necessary fees are paid, the Trademark Registrar will issue the applicant with an Acknowledgement Letter proving the date of execution. A preliminary search is to be conducted as to the distinctiveness of the registration. This is to ensure that no prior identical marks or designs have been registered. Where the trademark is found and acceptable and without any preexisting identical designs, the applicant is issued a letter of acceptance.

The application and registration process ideally take three to four months for registration of trademark in Nigeria. Where a trademark is sought to be registered, there is a probationary period of two months within which a trademark may be opposed. Where there are no objections, the Trademark Registrar issues a certificate of registration which would indicate the date of initial filing as the date of registration.

Where members of the public object to the registration of the trademark, the Trademark Registry will issue a Notice of Refusal requiring the applicant to provide reasons why the mark should- be registered.

The Trademark Registrar may also out rightly refuse to register a trademark where it is not distinctive, it is deemed to be scandalous or deceptive or it contains some prohibited words.

In addition, the Trademark Registrar reserves the right to withhold approval of a trademark where the applicant is not the true proprietor, where the application is made in bad faith, where the trademark is identical to an existing one or where the trademark contains restricted. Approval may also be withheld where the mark is in contention and approval may only be given where the right to the trademark has been settled by either the Trademark Registrar or by a court on appeal from the Trademark Registrar.

### **TENURE OF TRADEMARK PROTECTION**

Trademarks registered in Nigeria are valid for an initial period of 7 (seven) years. Subsequently, they are renewable for 14 (fourteen) year periods. An application for renewal must be made at least 3 months from the expiration date.

A trademark may be revoked where it has gone without use for a period of at least five years. It may also be revoked where it contravenes a condition which affected its registration or due to a lack of renewal.

### **CONTACT INFORMATION**



\*\*For more information contact Febuk Uya via email at [febuk@aeclegal.com](mailto:febuk@aeclegal.com)

## **IX. Trademarks in Portugal**

### **ANTAS DE CUNHA ECIJA**

#### **GOVERNING LAW**

In Portugal the entity that handles all matters related to trademarks is the Instituto Nacional de Propriedade Intelectual – INPI. The Portuguese IP system is regulated by the Industrial Property Code, which was approved by Decree-Law 36/2003 (as amended).

#### **PREREQUISITS TO OBTAINING TRADEMARK PROTECTION**

In Portugal, a trademark can include anything that can be represented graphically, the applicable law states that a trademark may consist of a sign or set of signs that can be graphically represented, words (including a person's name), drawings, letters, numbers and sounds or the shape of the product or its respective packaging, provided that it adequately distinguishes the goods and services of one company from those of others.

The following marks cannot be registered:

- Marks that are devoid of distinctive character;
- Signs that exclusively consist of a shape that: a) is imposed by the nature of the product itself; b) is necessary to obtain a technical result; or c) confers a substantial value on the product;
- Signs that exclusively comprise indications that may serve in trade to designate the type, quality, quantity, purpose, value, geographic origin, period or means of production of the product or rendering of the service, or other characteristics thereof;
- Trademarks that consist exclusively of signs or indications that have become customary in everyday language or in good-faith and established commercial practices; and
- Colours per se, except when they are combined with each other or with graphics, words or other elements in a particular and distinctive way.

#### **REGISTERED AND UNREGISTERED MARKS**

Trademark protection is acquired through registration and the law provides that the rights that arise from a mark belong to whoever applies to register that mark first. Apart from cases of unfair competition and bad faith, the law sets down four situations in which the owner of an earlier unregistered mark can oppose to a previously applied registration. A trademark registration can last indefinitely, provided that it is renewed every 10 years. The registration confers on the owner the right to prevent third parties from using an identical or similar sign without its consent in economic activities for goods or services that are identical or similar to

those for which the trademark was registered and which may risk confusion or association in the mind of consumers.

## **APPLICATION PROCESS**

Portugal uses the first-to-file system, so registration is granted to whoever files the application first and in accordance to the requirements set forth on the Code. The application must also be accompanied by a graphical representation of the sign (if applicable) or, if the trademark is a sound mark, the respective musical phrases. If an application claims a certain combination of colours, the graphical representation must include the claimed colours or else it will be assumed as a black and white graphical representation.

After filing of the application, INPI carries out a brief examination of the formal elements of the application and if no irregularities are found, the application is published in the *Industrial Property Bulletin*. After that, the following phases occur:

1. **Opposition Phase** – Following the publication of the application, there is a two-month period (extendible by one month) in which any third party may file an opposition to the application. If an opposition is filed, INPI notifies the applicant, which has two months (extendible by one month) in which to file a reply.
2. **Examination Phase** – Once the opposition and reply deadlines have expired, the examiner initiates the substantive examination, which must include an analysis of:
  - the absolute grounds for refusal;
  - the relative grounds for refusal; and
  - any oppositions, replies and statements filed by the parties.Registration will be provisionally refused if the examiner finds grounds for refusal. The applicant is then notified of the provisional refusal and must reply within one month (extendible by one month). If the objections to the registration are upheld, the refusal decision becomes final. If, following the applicant's reply, the refusal is considered unsubstantiated or the objections raised are resolved, the decision to grant the trademark will be issued within one month counting from the date on which the reply was filed.
3. **Registration** – If an opposition is filed or the applicant is notified of a provisional refusal, after the periods and formalities identified the final decision is notified immediately to

the applicant. Regardless of that, it is mandatory that the registration is published in the *Industrial Property Bulletin*.

### **CONTACT INFORMATION**

ECIJA

*\*\*For more information regarding the Portuguese Trademark Portuguese Trademark process, please contact Joao Peixe at [jpeixe@adcecija.pt](mailto:jpeixe@adcecija.pt) or by phone at +351 213 192 080.*

## **X. Trademarks in Romania**

### **BSMP**

#### **GOVERNING LAW**

In Romania, the national authority handling matters in connection to trademarks is *Oficiul de Stat pentru Inventii si Marci* (“**OSIM**”). As a principle, the intellectual property rights over a trademark shall be protected in Romania by registration with OSIM. On what concerns the governing law, on one hand Law no. 84/1998 on trademarks and geographical indications (as well as implementing regulations) is applicable. On the other hand, European regulations (such as EU Regulation no. 2017/1001), as well as various international conventions and treaties are incident in Romania.

#### **WHAT IS THE STANDARD FOR WHAT MAY BE TRADEMARKED?**

It is worth mentioning that, according to Romanian legislation, both individuals and legal entities may apply for registration of trademarks in Romania. The registration with OSIM ensures the right of exclusive use of the trademark for specific goods and/or services, as they are provided by Nice Classification, for a period of 10 years (which may be renewed with successive periods of 10 years).

There are various signs which may be registered as trademarks, such as: words, including personal names, drawings, letters, numbers, figurative elements, three-dimensional forms, especially the form of the goods or their packaging, combinations of colors, as well as any combinations of these signs. On a side note, several signs are expressly excluded from registration with OSIM, such as:

- Trademarks deprived of distinctive character;
- Trademarks comprising exclusively signs or indications currently used in common language or within fair and continuous commercial practice;
- Trademarks comprising exclusively signs or indications that may be used in trading to designate the species, quality, quantity, destination, value, geographical origin or the time of manufacturing the good or of rendering the service or other characteristics;
- Trademarks consisting exclusively in the shape of the good, which is determined by the nature of the good;
- Trademarks misleading the public with respect to the geographical origin, quality or nature of the good or service;
- Trademarks contrary to morality or public order;

- Trademarks which comprise, without the consent of the owner, the image or the name of a person who is notorious in Romania.

A trademark is also refused for registration if it is identical or similar to a previous trademark and the goods or services for which the registration was applied for are identical or similar with those for which the previous trademark was protected. It is worth mentioning that the rights over a trademark may be transferred entirely or in part, onerously or free of charge.

### **WHAT IS THE DIFFERENCE BETWEEN REGISTERED OR UNREGISTERED? ARE THERE MULTIPLE REGISTRY'S?**

In Romania, there is only one national registry for trademarks, managed by OSIM. Besides the registered trademarks, protection is also ensured for notorious trademarks, representing trademarks widely known in Romania within the targeted segment of public for the goods or services to which the sign applies, without being necessary the registration in Romania in order to be opposed. Both registered and notorious trademarks may be opposed in order to impede the registration of an identical or similar sign as trademark used for identical or similar goods/services (for notorious trademarks even in case of goods and/or services which are different, if it leads to a connection between the goods/services for which the sign is used and the holder of the notorious trademark). In case of notorious trademarks, the notorious character must be proved by the person invoking it.

**WHAT IS THE APPLICATION PROCESS?** Regarding the application process in Romania, it is worth mentioning that the application file for trademark registration with OSIM is quite accessible, containing the following items:

1. Express request for the registration of a trademark;
2. Information regarding identification data of the applicant and, if case, of the representative;
3. A sufficiently clear graphic representation of the trademark to be registered;
4. The list of goods/services for which the trademark shall be applicable, in accordance with Nice Classification;
5. Proof of payment of the relevant fees.

After submitting the application file with OSIM, in a period of 1 month, OSIM shall examine if all required documents were submitted and shall establish a filing date to the request. The request for registration is electronically published within 7 days as of the submission date with OSIM.

In a period of 2 months as of the publication date of the request for registration, any interested person may file an opposition in certain cases provided by Law no. 84/1998. In case of opposition, a special commission from OSIM is the competent body, having the possibility to admit or reject the opposition. The endorsement of the special commission shall be taken into consideration for the examination of the material conditions.

In a period of 6 months as of the publication date of the request for registration, OSIM shall examine the fulfillment of the material conditions. If fulfilled, OSIM shall decide the registration of the trademark and shall issue the registration certificate in this respect. If not fulfilled, OSIM renders to the applicant a period of 3 months in order to present a point of view or to withdraw the request for registration.

### **CONTACT INFORMATION**



Phone: +4 0311 027 961 | Fax: +4 0311 000 140 | E-mail: [office@bsmp.ro](mailto:office@bsmp.ro)

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Magheru One Building, 1-3 Magheru Blvd, 5th floor, 1st District, 010321, Bucharest, [www.bsmp.ro](http://www.bsmp.ro)

***\*\*For more information regarding the Romanian Trademark Process, please contact Anda Calin at [anda.calin@bsmp.ro](mailto:anda.calin@bsmp.ro) or by phone at +4 0311 027 961***