



ABSTRACT

IP TRANSLATOR CHANGES THE RULES OF THE GAMEN

Franck Soutoul, ECTA Member, European Trademark Attorney, INLEX IP Expertise, FR

I. INTRODUCTION

A French speaker talking about a British case. That's a real revolution! Why ?
The CIPA in a slogan and in terms of "revolutionary" trademarks . How?
IP TRANSLATOR was more an electroshock at the OHIM than a tsunami in the Community .Lost
in Translation in fact

II. THE ISSUE

A British examination that shifted towards a Community approach

The preliminary ruling

- . A three-steps waltz... but boiling down to one question
- but denied by both the OHIM and the Commission!

In one word : A SUPPOSEDLY NON-DETRIMENTAL RULING SINCE IT IS BENEFICIAL AS NOT PREJUDICIABLE TO THE ACCELERATION OF CONVERGENCE

The CJEU ruling: the 7 commandments

In one word : A DEBATABLE RULING SINCE THE "QUALITATIVE" NECESSITY (the literal and economic operator interest) IS STILL TIED TO THE "QUANTITATIVE" APPROACH (The OHIM and administrative institutions policies) AND NOT ENOUGH

III. BEFORE AND AFTER IMPACT OF THE OHIM, NATIONAL OFFICES and EU IP FIRMS

Comparative table of the 27 EU Member States and trends between the GENERAL and the LITERAL Has the ruling created harmony, division, or did it have no impact at all?

Specific impact for the OHIM : communication in three steps (two alone and one by convergence)

- . The Communication of 2003
- . The Communication of 2012
- . After the Communication of 2012

Before, at the national level

- . Offices using the same approach as the OHIM
- . Offices using a different approach to the OHIM



After, at the national level

- . Offices that changed or did not changed their approach
- . Effects of the changes on IP professionals (through our internal questionnaire)

Now, at a general level

- . The Common Communication of the Implementation of IP Translator by OHMI and EU Offices
- . The personal Transcript of the interpretation of IP translator by Mr Geoffrey Hobbs (UK)

IV. CONSEQUENCES ON THE DAILY WORK OF COUNSELS

Changes for the profession: our own experience through a few concrete items

- . Oppositions (relative grounds)
 - . Prosecution issues (filling, renewals, conversion of CTM into national TM)
- . Searches (scope of protection and isolated products/services)
- . Cancellation action for non-use

V. CONCLUSION

The next step! - Establishment of a legal federation to respond to the requirements of a strong trademark completing with 3 main criteria

The solution? - the North American method with an European touch to find “USA Versus USE”

First impressions from 4 agents in the U.S.A. on the CJEU ruling

Prime Minister David Cameron’s conclusion

Thank you for your attention and the new rules of the game in one idea/two ideas.