

# KEY ASPECTS OF THE OPPOSITION PROCEEDINGS AT THE LATVIAN PATENT OFFICE

Second WIPO Forum on Intellectual Property and SMSs for  
IP Offices and Relevant Institutions of OECD and EU  
Enlargement Countries

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# Legal basis

- Patent Law (1995)
- Law on Trademarks and Indications of Geographical Origin (1999)
  - last amendments entered into force on 1 May, 2004
  - relevant provisions concerning Community Trade Mark System
- Regulation of the Cabinet of Ministers on Industrial Designs (16 April, 2004)
  - replaced Law on Industrial Designs (1993)
- Regulation of the Board of Appeal of the Latvian Patent Office (1995)



# Opposition proceedings

- competent body - Board of Appeal of the Latvian Patent Office
  - established in 1995
  - main tasks:
    - examination of appeals against LPO decisions
    - examination of oppositions (*inter partes* proceedings)
- independent in its decision making; members are appointed by the Minister of Justice for a 3 year period
- currently 10 members
  - 6 members are from the experienced staff of LPO
  - 4 members are specialists in other fields



## Board of Appeal (1995-2003)

- 1460 appeals and oppositions filed
  - vast majority of appeals and oppositions filed with the Board of Appeal relate to trademark matters (about 98%)
- 1145 cases examined as to the substance
  - 246 appeals as to the decisions taken by LPO examiners
  - 899 oppositions
    - only 64 decisions appealed in court (7% of the total)
    - only 13 decisions annulled by court (20% of the total)
- considered by many practitioners in the field as effective and reliable system

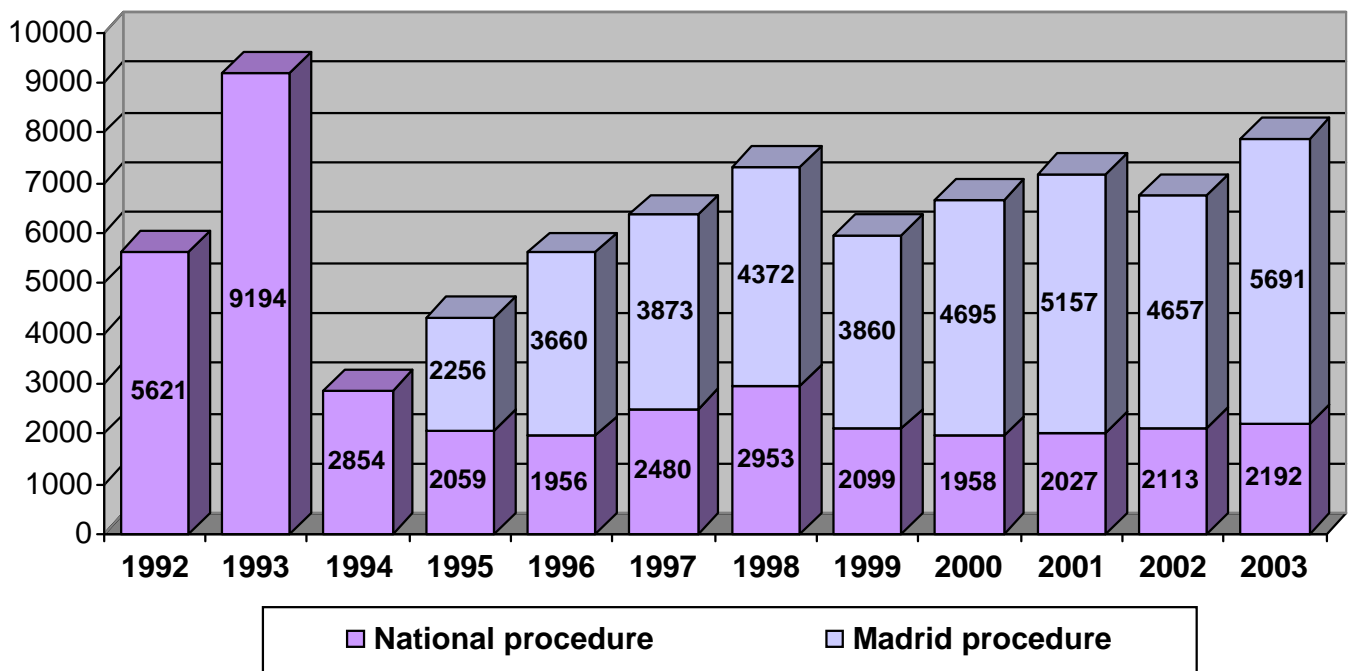


# Trademark Registration System

- Examination only on absolute grounds of refusal
  - Exceptions:
    - interests of the owners of well-known marks
    - bad faith
- Post-registration opposition procedure
  - Time limits (non extendable):
    - National marks - 3 months following the publication of trademark registration
    - International marks – 4 months following the publication of the notice of a trademark registration with respect to Latvia (territorial extension to Latvia) in the WIPO gazette of International Marks
- If opposition period missed, an action for the invalidation of trademark registration may be brought in the Riga Regional Court

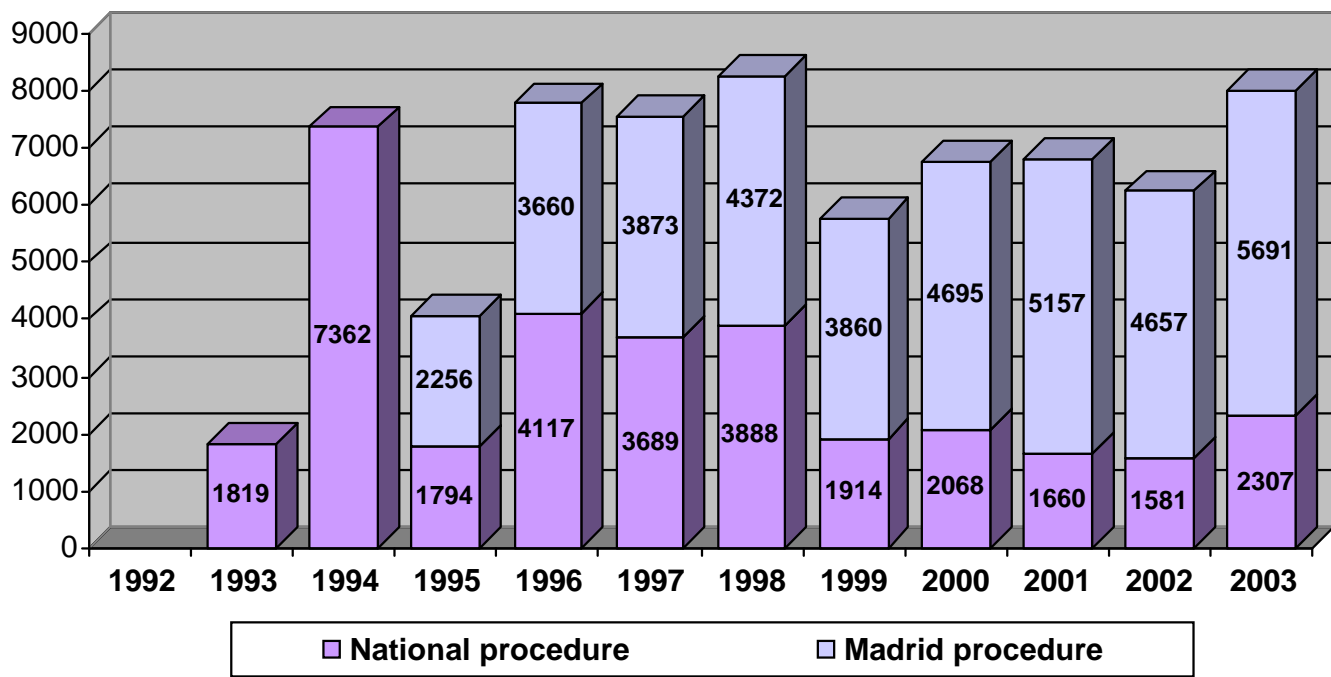


# Trademark applications





# Trademark registrations





# Registrations and oppositions

- about 15-16% of all trademark applications are registered by domestic applicants the majority of which (about 70%) belong to the range of small and medium-sized enterprises
- in 2003 about 25% of all oppositions were filed by domestic entities

	1999	2000	2001	2002	2003
Registered trademarks	5774	6763	6817	6238	7998
Oppositions	159	118	140	123	142
% of the total registrations	2.8	1.7	2.1	2	1.8





# Opposition procedure

- opposition must be filed in writing
- admissibility check: prior to any communication with the owner of the contested trademark
  - opposition fee – 120 LVL (about 180 EUR)
  - if admissible, the opposition communicated to the owner of the contested trademark or to his representative
- *inter partes* proceedings
  - adversarial principle observed throughout the examination of the case
- the opposition case is examined by no less than three members, at least one of whom must have legal qualification; the Boards are composed by rotation
- oral hearings



# Opposition procedure

- decisions:
  - invalidation or partial invalidation of granted rights, rejection of opposition, termination of proceedings, etc.
  - operative part of the decision announced to the parties at the end of hearings
  - full decision communicated to the parties within one month
- any party adversely affected by a decision may appeal in court (3 month period)
  - administrative court (since 1 February 2004 when the new Administrative Procedure Law entered into force)



# Oral hearings

- Advantages:
  - More flexibility in presenting the evidence, arguments, comments
  - “face to face” factor
  - more convenient for non-specialists in the Industrial Property field to defend their rights
- Disadvantages:
  - oral hearings prolong proceedings
  - legally important facts may appear even at the hearing that sometimes leads to the suspension of proceedings



# Grounds for Opposition

Opposition may be filed by an interested person on the grounds of earlier:

- trademark rights (double identity / likelihood of confusion)
- well-known trademark rights (likelihood of confusion or, with respect to non similar goods/services, likelihood of connection+ detriment to the interests of the owner of the well known mark)
- commercial rights (i.e., rights pertaining to a trade name which is used in an identical or similar business sector)
- unregistered marks and other signs used in commerce, e.g. domain name
- other industrial property rights



# Grounds for Opposition

- **personal rights** (i.e., rights pertaining to the forename, surname, pseudonym, portrait or facsimile of a person well-known to the general public, unless this person has been deceased for 50 or more years)
- **copyrights**

Opposition may also be filed:

- against trademarks registered by agents without the consent of the owner
- on absolute grounds of refusal
- against trademark applied for registration in bad faith



# Grounds for Opposition

As from the 1 May 2004 the opposition may also be based on:

- earlier Community Trade Mark
- earlier Community Trade Mark registered for dissimilar goods/services but having a reputation in Community
  - unfair advantage or detriment of reputation of this earlier mark has to be proven



# Well-known marks

Examples of trademarks recognised by the Board of Appeal as well-known in Latvia

NIKE  
HUGO BOSS  
CARTIER  
VOGUE  
BACARDI  
NIVEA

McLAREN  
MOULIN ROUGE  
PLAY BOY  
SANOFI  
PROZIT





# Well-known marks

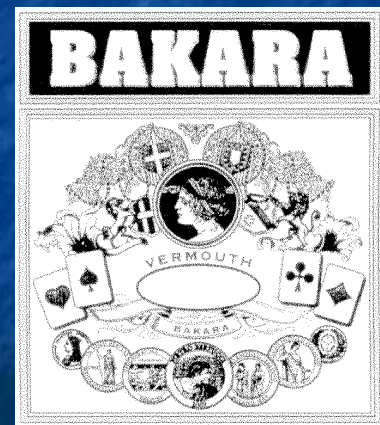
- earlier marks
- contested trademarks:

**BACARDI**

(9 figure marks)

- for alcoholic beverages

**BAKARA**



Oppositions satisfied





# Well-known marks

- earlier well-known mark
- contested trademark:

**CARTIER**

- for jewellery, watches

Opposition satisfied

**K Art J**

- for precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments



# Bad faith

- earlier well-known mark
- contested trademarks:

**PLAY BOY**

- for magazines, entertainment services

Oppositions satisfied

**PLAY&BOY**  
**PLAYYY BOYY**

- for entertainment services, provision of food and drink, hotels etc.



## Proof of use: key aspects

- very important tool of defence
- effective system to avoid groundless oppositions
- if actual (genuine) use not proven - opposition rejected
  - the number of oppositions rejected on this ground is growing
- however, trademark registration may be revoked only in court proceedings



## Proof of use: legal grounds

*Law on Trademarks and Indications of Geographical Origin, Article 19(7)*

Were the opposition is fully or, *inter alia*, based on an earlier trademark, that has been registered no less than five years previously, the owner of the opposed mark is entitled to request that the opponent provide obvious and sufficient evidence that this earlier trademark has been actually used within the meaning of Article 23 of this Law



## Definition of actual use

*Law on Trademarks and Indications of Geographical Origin, Article 23(4)*

Actual use shall be construed as the use of trademark in the course of trade, with the purpose of gaining or maintaining a certain market position for the respective goods or services



# Procedural aspects

Request to furnish the proof of use:

- only on the initiative of the contested trademark owner
- no time limits set
  - request to submit the proof of use may be expressed even during the oral hearing until the examination of opposition on the substance is not finished
- only for registered trademarks



# Proof of use: evidence

- Evidence must show:
- how the earlier trademark has been used
    - the same mark or mark in a form differing in individual non-essential elements
  - time of use
    - the last five years prior to the examination of the opposition
  - place of use
    - use of a trademark on goods or their packaging in Latvia
  - extent of use
    - solely for export purposes is accepted
    - actual (genuine) use within the meaning of Article 23(4)
    - merely sporadic use not sufficient



# Post-registration opposition system

- Advantage:
  - shorter way from the trademark application to registration
    - percentage of opposed trademarks is relatively small
  
- Disadvantage:
  - less legal certainty as to the acquired exclusive rights





## Necessary improvements

- activate dissemination of information and knowledge to the public as to the importance of protection of IP rights
  - main target group: small and medium-sized enterprises
- promotion of activity and ability of rights owners to defend their rights using the opposition system
- shortening of the opposition proceedings
  - currently it takes in average 8 months from the filing of opposition to the hearing of case
- improvement of the Trademark Search System
- freely accessible trademark database on the Internet

Thank you for your  
attention!