

Trademarks

Contributing editors

Claus Eckhardt and Christine Fluhme



2019

GETTING THE
DEAL THROUGH 

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Trademarks 2019

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Claus Eckhardt and Christine Fluhme
Bardehle Pagenberg Partnerschaft mbB

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Preface

Trademarks 2019

Fifteenth edition

Getting the Deal Through is delighted to publish the fifteenth edition of *Trademarks*, which is available in print, as an e-book, and online at www.gettingthedealthrough.com.

Getting the Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique **Getting the Deal Through** format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on the Bahamas, Greece, Saint Lucia and Ukraine.

Getting the Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at www.gettingthedealthrough.com.

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Getting the Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. Getting the Deal Through would like to extend special thanks to the contributing editors Claus M Eckhardt and Christine Fluhme of Bardehle Pagenberg Partnerschaft mbd for their assistance with this edition.

GETTING THE
DEAL THROUGH 

London
September 2018

Cape Verde

Patrícia Rodrigues

RCF – Protecting Innovation SA

1 Ownership of marks

Who may apply?

Any person (individual, firm, or body corporate) with a legitimate interest may apply for the registration of a mark.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

The law defines a trademark as any visible sign used to distinguish the products or services of one person from the products or services of another person.

The following may be a mark: surname, geographical name, 'fancy' word or words, monograms, emblems, figures, digits, labels, combinations of colours, drawings, photographs, stamps and in general, all material visible signs.

Colours are registrable as a mark only when they are combined together or with graphics, wording or other elements in a particular and distinctive manner.

Collective marks may be registered in the form of association marks. An association mark is considered as a specific sign belonging to an association of natural or legal persons, the members of which use or intend to use the sign for products or services.

A certification mark is considered as a specific sign belonging to a corporate body that controls the products or services for which the sign is to be used or establishes the regulations the products or services for which the sign is used must comply with.

The registration of a collective mark may be applied for and obtained by:

- corporate bodies to which a guarantee or certification mark has been legally granted or attributed and that may apply it to specific and determined qualities of the products or services; and
- corporate bodies that supervise control or certify economic activities, to distinguish the products or services of their activities or as originating from certain regions, in accordance with their purposes and the respective statutes or by-laws.

3 Common law trademarks

Can trademark rights be established without registration?

A provisional protection is given to the trademark application. The total protection is given as from the grant of the trademark registration. Thus the trademark rights are not established without registration.

Only registration confers proprietary rights. The effect of registration therefore is attributive of ownership.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

It is not possible to foresee the time frame, since publication in the Official Bulletin takes a long time. The official fees for the publication of a trademark application amount to 6,500 Cape Verdean escudos and the official fees for the issuance of the Certificate of Registration amount to 2,500 Cape Verdean escudos plus 7,000 Cape Verdean escudos for each class designated by the trademark.

The requirements for filing a trademark application in Cape Verde are as follows:

- applicant's full name, nationality, occupation, address or place of business;
- list of products or services; and
- power of attorney signed by the applicant and legalised with a Hague Convention apostille.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The applicable classification is the 11th edition of the International Classification of Goods and Services under the Nice Agreement.

Multi-class applications are available.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

Examination is conducted only with compliance with the formal requirements. There is no examination as to prior third-party rights.

It is possible to file an appeal against the decision of the Cape Verde Patent and Trade Mark Office (PTMO). Article 161 of the Cape Verde IP Law foresees the filing of letters of consent in order to overcome an objection based on a third-party mark.

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

The registered trademarks must be used.

The registration of a mark may be cancelled if the mark is not used and there are no legitimate reasons for the non-use. If a registered mark has not been used without legitimate reason for five consecutive years, the registration of the same may be declared forfeited.

Every five years from the granting date it is necessary to file a declaration of intent to use. Those marks for which the declaration of intent to use has not been filed may not be invoked against third parties and forfeiture thereof shall be declared by the Institute of Industrial Property upon request of any interested party or whenever there is damage to third-party rights when granting other registrations.

If cancellation of the registration has not been requested or declared, the same shall be deemed again in full force provided that the owner thereof files the declaration of intent to use and produces evidence of use of the mark.

8 Appealing a denied application

Is there an appeal process if the application is denied?

There is a judicial appeal from the decisions of the Cape Verde PTMO determining the refusal of a trademark. The deadline for filing such an appeal is two months from the publication of the decision in the Industrial Property Official Bulletin.

9 Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Within two months after the publication (term extendable for one month), any third party considering itself prejudiced by the possible grant of the registration may file an opposition. The applicant may file a counter-statement within two months (term also extendable for one month).

The opposition or the cancellation of a trademark can be requested in the following circumstances:

- marks containing false indications or being apt to deceive the public with regard to the nature, characteristics, or utility of the products or services for which the mark is to be used;
- marks containing false indications as to the geographical, manufacturing plant, workshop, or business origin of the goods or services concerned;
- insignia, flags, coats of arms or official seals adopted by the state, an international organisation or any other public body whether national or foreign, without the consent of the competent authorities;
- firm names, business names, or insignia not owned by the applicant for registration or the use of which by the applicant is not authorised;
- marks being an entire or partial reproduction or imitation of a mark previously registered in the name of another party for the same or similar goods or services, if this may lead to confusion or error in the market;
- expressions and designs that are contrary to good morals, law or public policy; and
- the name or portrait of a person without such person's consent.

A brand owner that does not yet have its trademark protected in Cape Verde cannot oppose a bad-faith application.

Costs associated with a third-party opposition or cancellation proceeding are given upon request.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

The duration of registration of a trademark is 10 years from the granting date and is indefinitely renewable for further 10-year periods.

The registration of a mark may be cancelled if the mark is not used and there are no legitimate excuses for the non-use. If a registered mark has not been used without legitimate reason for five consecutive years, the registration of the same may be declared forfeited.

The evidence of use can be, for example, original or certified copies of invoices proving the use of the products featuring said trademarks in Cape Verde, booklets and pamphlets distributed in this country or local publicity.

11 The benefits of registration

What are the benefits of registration?

Only registration confers exclusive rights to a mark.

Only registration confers proprietary rights. The effect of registration, therefore, is attributive of ownership.

The following acts performed without the consent of the owner of a registered mark are deemed infringement:

- use in the course of trade in Cape Verde of any sign that is identical or confusingly similar to the registered mark for goods or services being identical or similar to those for which the mark is registered; and
- use in the course of trade in Cape Verde of any sign that, due to the identity or similarity of that sign and the mark or the affinity between the goods or services, creates in the consumer's mind a risk of confusion, including the risk of association of the sign with the mark.

The following acts performed by a person with the intention to cause damages or to obtain illegal benefits shall be deemed a criminal offence punishable with imprisonment of up to three years or a fine:

- entirely or partially counterfeiting or in any way reproducing a registered mark without the consent of its owner;
- imitating a registered mark, either entirely or in any of its characteristic elements;
- using counterfeit or imitated marks;
- using, infringing or imitating a well-known mark or a highly renowned mark whose registration has been applied for in Cape Verde;
- displaying on his or her products a registered mark belonging to another party; and
- using one's own registered mark on products belonging to other parties in such a way as to deceive the customer with regard to the origin of the products.

Further, any person who sells, offers for sale or brings into the trade goods with a mark that is counterfeit, imitated or used under the circumstances as mentioned here while being aware thereof, commits a criminal offence punishable by imprisonment of up to one year or a fine.

A person who, with the intention to prepare to commit any acts as mentioned above, manufactures, imports, obtains or keeps for him or herself or another party signs constituting registered marks commits a criminal offence punishable by imprisonment of up to one year or a fine.

12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

The holder of a registration may invoke the rights conferred by registration against the licensee who infringes any provision of the licence

agreement, in particular with regard to its validity, the identity of a trademark, the nature of the products or services for which the licence is granted, the area or territory covered by the same, and the quality of the manufactured products or services provided by the licensee.

The recordal of the licence is required in order to be valid.

13 Assignment

What can be assigned?

A registered mark may be assigned with or without the goodwill of the business. An assignment is to be registered in order to be effective as against third parties.

The requirements for registration of an assignment are as follows:

- deed of assignment in Portuguese, signed by the assignor and the assignee, legalised with a Hague Convention apostille; and
- power of attorney in Portuguese, signed by the assignee, legalised with a Hague Convention apostille.

14 Assignment documentation

What documents are required for assignment and what form must they take?

The requirements for registration of an assignment are the following:

- deed of assignment in Portuguese, signed by the assignor and the assignee, legalised with a Hague Convention apostille; and
- power of attorney in Portuguese, signed by the assignee, legalised with a Hague Convention apostille.

15 Validity of assignment

Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required in order to be valid.

16 Security interests

Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

The IP Code of Cape Verde does not establish the procedures of the recordal of the security interests. However, the PTMO recognises them and they must be legalised by a Cape Verde consulate. They must be recorded for purposes of validity in Cape Verde.

17 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

Marking is not compulsory. As long as the registration of a mark is in force, the owner thereof may use on the goods distinguished by the mark the words 'Marca Registada', the letters MR, or the symbol ®. False marking may be punished by a fine.

18 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

The owner of a trademark can ask for enforcement of the rights of its trademark against an alleged infringer. There are no specialised courts for this matter, and the criminal law of Cape Verde does not establish the trademark enforcement proceedings. However, the same rules of enforcement as for other kinds of rights are applicable.

19 Procedural format and timing

What is the format of the infringement proceeding?

Only registration confers exclusive rights to a mark.

The following acts done without the consent of the owner of a registered mark are deemed infringement:

- use in the course of trade in Cape Verde of any sign that is identical or confusingly similar to the registered mark for goods or services being identical or similar to those for which the mark is registered; and
- use in the course of trade in Cape Verde of any sign that, due to the identity or similarity of that sign and the mark or the affinity between the goods or services, creates in the consumer's mind a risk of confusion, including the risk of association of the sign with the mark.

The exclusive right to a mark does not include the right for the owner to prevent a third party from using in the course of trade his or her own name or address, or any indication concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the services, or any other characteristics of goods or services, or even the mark itself if this is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part, provided that in any such case such use is in accordance with honest practices and good customs in industrial and commercial matters.

Not considered as infringement is the use of a protected mark for goods that have been brought into trade under the mark by the owner or with his or her consent in Cape Verde, unless there are legitimate grounds that justify that the owner of the mark opposes the further commercialisation of the goods, in particular if the condition of the goods has been altered or deteriorated after they were brought into trade.

Only registration confers proprietary rights. The effect of registration, therefore, is attributive of ownership.

The law provides for the seizure by the customs authorities during importation or exportation of products and goods directly or indirectly bearing trademarks or names illegally used or applied, or bearing false indications or appellations of origin.

The following acts done by a person with the intention to cause damages or to obtain illegal benefits shall be deemed a criminal offence punishable with imprisonment of up to three years or a fine:

- entirely or partially counterfeiting or in any way reproducing a registered mark without the consent of its owner;
- imitating a registered mark, either entirely or in any of its characteristic elements;
- using counterfeit or imitated marks;
- using, infringing or imitating a well-known mark or a highly renowned mark whose registration has been applied for in Cape Verde;
- displaying on his or her products a registered mark belonging to another party; and
- using his or her own registered mark on products belonging to other parties in such way as to deceive the customer with regard to the origin of the products.

Further, any person who sells, offers for sale or brings into trade goods with a mark that is counterfeit, imitated or used under the circumstances as mentioned here while being aware thereof, commits a criminal offence punishable with imprisonment of up to one year or a fine.

A person who, with the intention to prepare to commit any acts as mentioned above, manufactures, imports, obtains or keeps for him or herself or another party signs constituting registered marks commits a criminal offence punishable with imprisonment of up to one year or a fine.

The law provides for the seizure by the customs authorities during importation or exportation of products and goods directly or indirectly bearing trademarks or names illegally used or applied, or bearing false indications or appellations of origin.

20 Burden of proof

What is the burden of proof to establish infringement or dilution?

The burden of proof lies with the plaintiff, who has the burden of proving that its mark has been infringed.

21 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

Both the trademark owner and the licensee may seek remedies. The trademark owner must have the mark registered before the Trademarks Office in Cape Verde and the licensee can only intervene if the registered user agreement (licence to use) is recorded before the office.

22 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

Only activities that take place in the Cape Verde territory may be taken into account. However, this is not applicable to goods made outside the country from the moment that they are imported into Cape Verde.

23 Discovery

What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Adverse or third parties (including state entities) may be required to submit documents or exhibit goods. If they resist, a court order may be sought.

24 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

Unfortunately there is no typical time frame for infringement or dilution actions. They are lengthy and can last for years.

25 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

There is no published schedule of official fees of infringement or dilution action in Cape Verde.

26 Appeals

What avenues of appeal are available?

An appeal against a decision of grant or refusal may be lodged with the competent court or arbitral court within two months from the date of publication of the decision in the Industrial Property Bulletin. An appeal may be lodged by the applicant in the case of refusal by the opposing party in the case of rejection of opposition, or by any interested party in the case of a grant.

27 Defences

What defences are available to a charge of infringement or dilution, or any related action?

The defendant or alleged infringer has the legal right to participate in the proceeding by responding to the complaint and submitting evidence.

28 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The IP Law contains provisions regarding the penalties imposed on an infringer but is silent regarding the apportionment of monetary relief. Injunctive relief is available permanently if there is an immediate danger to the complainant.

29 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

The IP Code establishes that the parties can choose arbitration to resolve all IP conflicts. However, the code does not give details of the procedure to be followed in the arbitration proceedings.

30 Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

The owner of a mark that is well known in Cape Verde, even if it is not registered, may oppose the registration of an identical or similar mark for the same or similar goods or services, provided that he or she applies for registration of the mark. Marks having a reputation in Cape Verde are further protected in that the owners of such marks may oppose the registration of an identical or similar mark, even if registration is applied for in respect of different goods or services, if use of the mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the renowned mark.

The evidence required includes market studies that reveal the reputation of the mark to the relevant public, costs with marketing companies, sales volume, and other factors relevant to the reputation of the mark.



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