

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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For further information please contact editorial@gettingthedealthrough.com

Publisher
Tom Barnes
tom.barnes@lbresearch.com

Subscriptions
James Spearing
subscriptions@gettingthedealthrough.com

Senior business development managers
Adam Sargent
adam.sargent@gettingthedealthrough.com

Dan White
dan.white@gettingthedealthrough.com



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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

São Tomé and Príncipe

Patrícia Rodrigues

RCF – Protecting Innovation SA

1 Ownership of marks

Who may apply?

Any person (individual, firm or corporate body) 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: a surname, a geographical name, a 'fancy' word or fancy words, monograms, emblems, figures, digits, labels, combinations of colours, drawings, photographs, stamps and in general all material visible signs. Service marks may be registered.

The following are not registrable:

- 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 geographic, manufacturing plant, workshop or business origin of the goods or services concerned;
- insignia, flags, coats of arms, 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 for the use of which 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 being contrary to good morals, law or public policy; and
- the name or portrait of a person without such person's consent.

3 Common law trademarks

Can trademark rights be established without registration?

Provisional protection is given to a trademark application. Total protection is given upon granting 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?

If no opposition is filed against the trademark application and if the application is filed with all the required documents, it usually takes eight months to obtain a trademark registration, plus another eight months to obtain the registration certificate.

The requirements for filing a trademark application in São Tomé and Príncipe are as follows:

- the applicant's full name, nationality, occupation, address or place of business; and
- a list of products or services.

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.

There is a multi-class registration system in São Tomé and Príncipe.

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?

If the opposition period lapses without any opposition having been filed or the opposition proceedings have been terminated, the application will be examined as to form, registrability per se and prior conflicting registrations. The filing of letters of consent is foreseen in the IP Law of São Tomé and Príncipe.

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?

Any interested person may request from the Patent and Trademark Office (PTO) the cancellation of a trademark registration for a product or service for which it was registered, owing to the fact that the trademark was not used by the holder of a registration or by a licensee during an uninterrupted period of five years.

However, the trademark registration will not be cancelled if it is proved that its non-use was due to particular circumstances and that there was no intention to abandon or not use the products or services that the registration covers.

8 Appealing a denied application

Is there an appeal process if the application is denied?

An appeal can be lodged at the court of first instance against the decision of the PTO. Any of the parties can appeal against the sentence to the court of second instance.

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?

The IP Law of São Tomé and Príncipe foresees that the deadline to file an opposition against a trademark application is three months counted from the publication of the application in the Official Bulletin.

Cancellation of a trademark can be sought in the following circumstances:

- the person in whose name the registration of a mark was made was not entitled to acquire it;
- the registration concerns a mark that was not registrable;
- the grant of the registration infringes third-party rights based on priority or other legal title;
- the mark being the subject of the registration wholly or partly is an imitation, translation or reproduction of a mark that is well known in São Tomé and Príncipe and is used for the same or similar articles, and there is danger of confusion;
- the mark being the subject of the registration is graphically or phonetically identical or similar to an earlier mark being highly renowned in São Tomé and Príncipe, irrespective of the goods or services for which it is applied, if use of the later mark without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark; or
- the grant of the registration infringed provisions requiring authorisation or consent, and this has not been given.

A brand owner that does not yet have its trademark protected in São Tomé and Príncipe cannot oppose a bad-faith application.

The 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?

According to the new IP law of São Tomé and Príncipe, the duration of registration of a trademark is 10 years from the granting date. Marks are indefinitely renewable for further 10-year periods.

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.

Legal action against infringement of a trademark can be brought before the courts and it is possible to include claims for damages. The proceedings may be initiated by seizing the infringing goods at the customs houses if they are imported. Criminal penalties are set by the court (within the limits fixed in the Industrial Property Code), as is compensation for damages. An action for infringement may also be initiated by means of a complaint filed with the General Inspectorate of

Economic Activities requesting the preliminary seizure of the infringing goods, subject to the discretion of the public prosecutor, who may subsequently bring a criminal action against the infringer.

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?

Any change in ownership of a mark must be in writing and registered in the application submitted to the director of industries. This change is only effective against third parties after registration.

However, a change in ownership of a trademark registration is not valid if it is likely to deceive or cause confusion, particularly with regard to the nature, origin, method of manufacture, adaptation, the characteristics of the product or the use intended, or the products or services for which the mark is intended to be used.

Any licence contract concerning the registration of a mark or a trademark application must provide effective control of the licensor on the quality of products or services for which the mark is used, otherwise it will not be considered valid.

13 Assignment

What can be assigned?

The property of a trademark can be totally or partially assigned. The assignment must be recorded in order to have an effect towards third parties. If recordal of the assignment is requested by the assignor, the assignee should also be a signatory of the assignment document, or should issue an express statement that he or she accepts the assignment.

14 Assignment documentation

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

The requirement for registration of an assignment is a deed of assignment in Portuguese, signed by the assignor and the assignee and certified by a notary public.

15 Validity of assignment

Must the assignment be recorded for purposes of its validity?

The recordal of the assignment is required for it 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?

Security interests are recognised and they must be certified by a notary public. They must be recorded for purposes of validity in São Tomé and Príncipe.

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 optional. Possible marking is 'Marca Registrada', MR or ®.

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 its trademark rights to be enforced against an alleged infringer. 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 there are no trademark enforcement proceedings established in the criminal law of São Tomé and Príncipe. However, the Civil Procedure Code is 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, performed without the consent of the owner of a registered mark, are deemed to be infringements:

- use in the course of trade in São Tomé and Príncipe 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 São Tomé and Príncipe of any sign that, owing to the identity or similarity of that sign and the mark or 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 of the owner to prevent a third party from using in the course of trade his or her own name or address, or any indication of 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 the use is in accordance with honest practices and good customs in industrial and commercial matters.

20 Burden of proof

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

The burden of proof lies with the plaintiff, who must prove 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 and the licensee can only intervene if the registered user agreement (licence to use) is recorded before said 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 São Tomé and Príncipe territory may be taken into account.

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 typical range of costs. They depend mainly on the professional fees that are charged.

26 Appeals

What avenues of appeal are available?

An appeal against the decision of the Patent Office can be lodged at the court of first instance. Any of the parties can appeal against the sentence to the court of second instance.

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 proceedings by responding to the complaint and submitting evidence.



Patrícia Rodrigues

mail@rcf.pt

Rua do Patrocínio, 94
1399-019 Lisbon
Portugal

Tel: +351 213 9073 73
Fax: +351 213 9787 54
www.rcf.pt

28 Remedies

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

The IP Code contains provisions regarding 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?

ADR techniques are not available in São Tomé and Príncipe.

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 Paris Convention applies to this matter.

The owner of a mark that is well known in São Tomé and Príncipe, even if 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 with a reputation in São Tomé and Príncipe have extra protection: the owners of such a mark 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.

Getting the Deal Through

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