



December 1st, 2009

COMMUNITY TRADEMARKS AND NATIONAL TRADEMARKS : COEXISTENCE AND CONFLICTS

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Coexistence and conflicts between Community Trademarks and National Trademarks





CTM = one single mark covering 27 Member States

namely :

Austria, Benelux [Belgium, Netherlands, Luxemburg], Denmark, Finland, France, Germany, Greece, Ireland, Italy, Portugal, Spain, Sweden, United Kingdom, as from origin : April 1st 1996

Poland, Hungary, Czech Republic, Slovakia, Slovenia, Lithuania, Latvia, Estonia, Cyprus (Greek part only), Malta : as from May 1st 2004

Bulgaria, Romania : as from May 1st, 2007



3



4



Territories also covered :

French overseas : *Martinique, Guadeloupe (including St Barthélemy and French part of Saint Martin, French Guiana, Réunion, Mayotte, French Polynesia ...*

Spanish and Portuguese Islands : *Canary Islands , Ceuta and Melilla, Azores, Madeira.*

Some British Territories : *Gibraltar, Isle of Man, Jersey ...*

Territories not covered :

Switzerland, Liechtenstein, Norway, Monaco, Greenland, Netherland Antilles, British Virgin Islands ...



The CTM system is not intended to replace the national trademark regimes.

The co-existence with National Rights in the Member States is a principle. No superiority of one upon another.

All European legislations harmonized

Examination of validity made in accordance with all Member States standards (in theory) – distinctiveness / descriptiveness appreciated in all languages spoken in the EU – Public order / morality.

But still, scope of CTM construed differently in each Member State (class headings, level of distinctiveness ...)





COEXISTENCE

Forced co-existence :

Extension of CTM to new Member States

Safeguard of acquired rights :

a CTM that was extended to a new Member State must co-exist with a national mark that was in force in said country at the date when the CTM was extended ; the owner of the local right may even obtain in Court an injunction to prevent the CTM from being used in the said jurisdiction (art. 107 & 142 bis (5) CTMR).



COEXISTENCE

Forced co-existence :

Extension of CTM to new Member States

Ex : enlargement of EU to Bulgaria on May 1st, 2007.

A CTM filed on April 1st, 1996 extends to Bulgaria on May 1st, 2007, but is not enforceable against a Bulgarian registration dated 2004.

The Bulgarian registration cannot either ground an invalidation action against the CTM, but in case of infringement, art. 107 CTMR authorizes a Bulgarian Court to restrict use of the CTM in Bulgaria (provided that the earlier mark was filed in good faith)





COEXISTENCE

Forced co-existence :

Foreclosure : a CTM owner that has tolerated the use of a registered infringing national mark cannot take any action after a five-year period has elapsed.



COEXISTENCE

Deliberate co-existence of CTM and National mark owned by the same registrant:

A company owns a series of National Registrations in a number of EU Member States as well as a CTM, for the same mark and the same goods / services.

May appear pointless (double use) and expensive (double cost at the time of renewal),

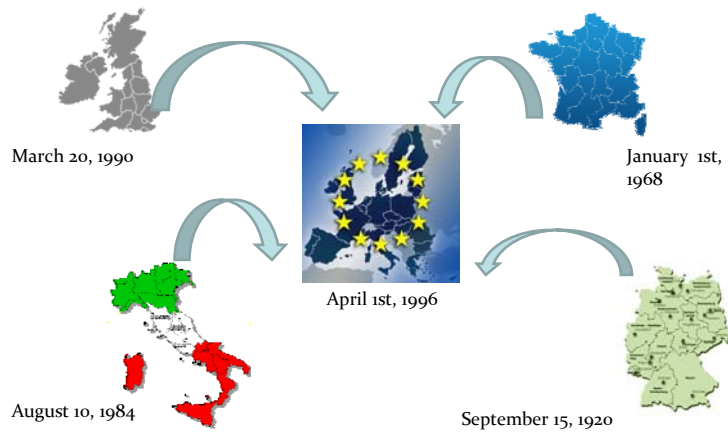
so ...





SUBSTITUTION

Seniority claim : a national registration may be “incorporated” in a CTM, and then allowed to lapse.



11



SUBSTITUTION

Seniority claim : a national registration may be “incorporated” in a CTM, and then allowed to lapse.

- conditions (same mark, goods, owner)
- can be filed at the time of filing or after registration (pros and cons)
- effects (seniority preserved, possibility to drop national marks)
- possible risk (no restoration procedure in case of invalidation of the CTM Registration, forum shopping issues)



12



CONFLICTS

Conflicts with National Rights

Oppositions / Invalidation actions based upon one national right : may lead to the rejection or invalidation of the entire CTM.

This is the most important disadvantage of the CTM

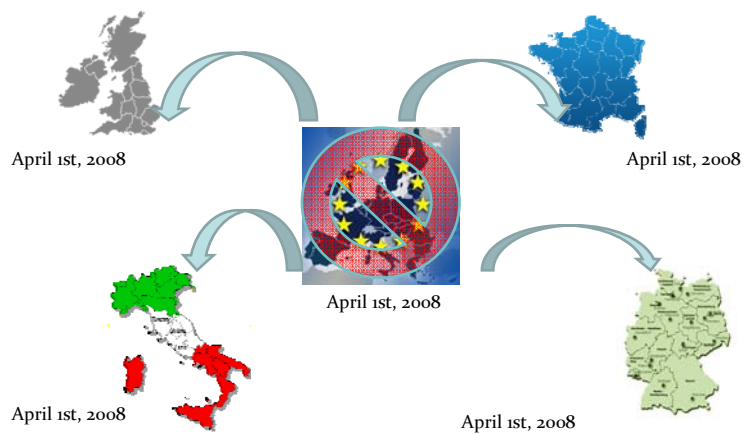
To counterbalance : Conversion of CTM into National / into WIPO



13



Conversion of a refused/withdrawn CTM into National applications.



14



CONFLICTS

Conflicts with National Rights

Example : CTM Appln. For “PSSG” in classes 09, 41 and 42 – partial opposition directed against a part of classes 09 and 42 only, based upon earlier National Spanish Registration for PSS & device, successful.

-Divisional application in respect of accepted goods and,

-Conversion in respect of rejected goods, in all Member States where the Opponent does not have any rights.

But conversion is expensive, and no guarantee that the mark will be accepted in all Member States ...



15



Designation of EU through a Madrid Protocol application :

Advantages :

Cost :

- filing : 875 € vs. 900 €

- renewal : 1205 € vs. 1350 €

Conversion easier and cheaper



16



Designation of EU through a Madrid Protocol application :



Disadvantages :

Opposition term : 9 months rather than 3

Central attack : if the home registration that grounds the IR is cancelled within a five year period from the IR filing, the same collapses .

No Certificate of Registration issued

No pre-filing advice from European attorney on validity



17



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18