

TRADEMARKS

THE COMMUNITY TRADEMARK. Questions and answers

WHY A EUROPEAN COMMUNITY TRADEMARK ?

The 12 European States bound by the Treaty of Rome which instituted the European Economic Community (now called the European Community), «determined to take a new step in the process of European integration», decided, with the Maastricht Treaty of 7 February 1992, to establish a European Union.

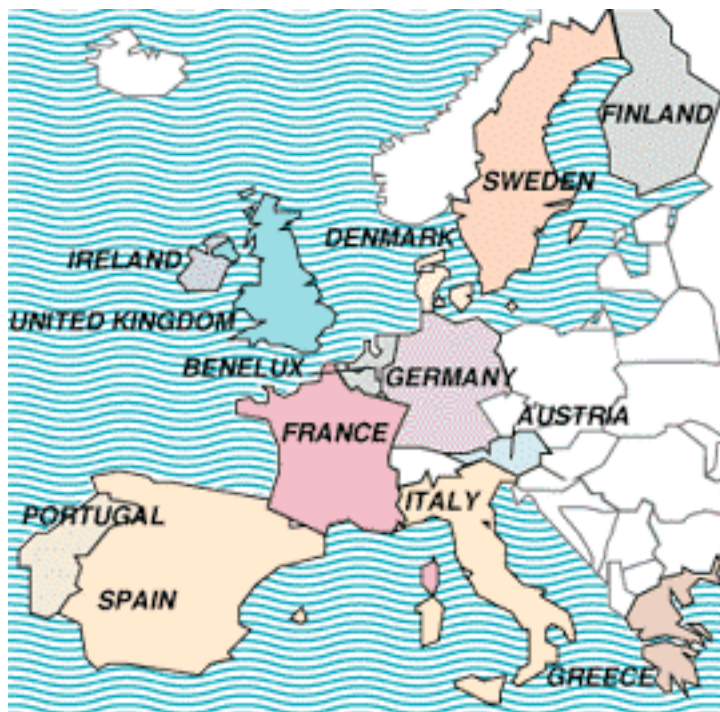
At the beginning of 1995, Austria, Finland and Sweden joined the 12 other States of the European Union : Belgium, Denmark, France, Germany, Greece, Ireland, Italy, Luxembourg, The Netherlands, Portugal, Spain, and the United Kingdom.

The European Union now represents a population of over 367 million inhabitants, a territory of 3.241.000 km², a Gross National product of 5816 billion dollars, that is, higher than that of the U.S.A. or that of Japan.

The objective and the advantage of a Community trademark are that businesses may identify their goods and services in an identical manner in the whole European Union territory by obtaining, through a single procedure before a European Trademark Office, registration of a trademark which will enjoy uniform protection and will be effective in the whole territory of one of the world's most important economic powers.

However, it was only after thirty years of incubation, on 20 December 1993, that the Regulation of the European Union Council on the Community trademark was adopted. The Implementation Regulation provides for the filing of Community trademarks from 1 April 1996.

NATIONAL TRADEMARKS



**15 States,
13* trademark laws;
13 National Offices;
13 procedures;
13 attorneys.**

***Belgium + Luxembourg + The Netherlands = Benelux, with one law and one Office in common**

EUROPEAN COMMUNITY TRADEMARK



**One Union of 15 States;
1 Community trademark regulation;
1 European Office;
1 procedure;
1 attorney.**

DOES THE COMMUNITY TRADEMARK EXCLUDE THE POSSIBILITY OF NATIONAL REGISTRATIONS ?

No. Community law does not go as far as to replace the trademark laws of member States, as there seemed to be no justification in forcing businesses to file Community trademarks, as National registrations are still necessary for those businesses who do not wish to use their marks on such a large scale.

However, the Community Directive of 21 december 1988 on the harmonisation of the national trademark laws of the member States led to the adoption of uniform provisions on the fundamental points, in particular, the conditions of acquiring and maintaining trademark rights.

WHO MAY FILE AN APPLICATION ?

The Community application is widely available. In particular, it can be made by any national of a member State of the Paris Union Convention or of the World Trade Organisation.

WHERE MAY THE APPLICATION BE FILED ?

- At the European Trademark Office, formally, the Office for Harmonisation in the Internal Market (Trade Marks and Designs), hereafter referred to as «the Office». This Office, which is a Community body with its own legal status, is based in Alicante (Spain).

or

- At the Trademark Office of any member State. In this case, the National Office will transmit the application to the Office within two weeks. The application date will be that on which it was filed at the National Office.

IS AN ATTORNEY NECESSARY ?

In principle, any person may act directly before the Office. There is therefore no obligation to be represented in order to file a Community trademark.

However, in all procedures other than the application, non-residents of the European Union must be represented before the Office, and, in view of the complexity of the formalities, residents may wish to be represented.

Only professional representatives that are entered on a list held by the Office, or lawyers, may act as attorneys.

WHY ELECT A FRENCH ATTORNEY AS YOUR EUROPEAN TRADEMARK ATTORNEY ?

French law requires a high degree of qualification from Industrial Property Attorneys (Conseils en Propriété Industrielle).

French and English are among the five official languages of the Office and are the two official languages of the Madrid Protocol.

In addition, although opposition proceedings have only recently been introduced in France, most French Attorneys are familiar with the complex trademark proceedings in other European countries, such as Germany and Spain, through the filing and prosecution of numerous international registrations claiming those EC countries which are members of the Madrid Agreement, on behalf of French clients.

WHAT ARE THE CONDITIONS FOR THE VALIDITY OF A COMMUNITY TRADEMARK ?

A Community trademark may consist of «any signs capable of being represented graphically», particularly words, including personal names, designs, letters, numerals, three dimensional trademarks and even sound marks.

The mark must be distinctive and not misleading (absolute conditions) and must not violate prior national rights or Community trademark rights (relative conditions).

CAN THE SENIORITY OF NATIONAL TRADEMARKS BE CLAIMED ?

Yes. The owner of a trademark which is already registered in a State of the European Union who files an identical trademark for the purposes of obtaining a Community trademark, for identical goods or services, or for goods and services included in the specification of the prior National trademark, may claim the seniority of the prior trademark for the Community trademark for those member States where it has been registered.

This seniority claim may be made when the Community trademark application is made, or after its registration. The seniority of National trademarks can thus be maintained, without it being necessary to renew them.

CAN THE PRIORITY OF A NATIONAL APPLICATION BE CLAIMED ?

Yes. The applicant of a Community trademark may claim the priority of a first application of the same trademark, filed in a member State of the Paris Union Convention, or of the World Trade Organisation, less than six months before the application of the Community trademark.

WHAT IS THE REGISTRATION PROCEDURE ?

- EXAMINATION

The Office verifies that the application is admissible and that there are no absolute grounds for refusal.

- SEARCHES

The Office carries out a search amongst Community trademarks. The National Offices of those States which advised of their decision to carry out a search on their National Registers, will communicate the results within three months from the date of their receipt of a copy of the Community application. These searches are then sent to the applicant.

- PUBLICATION

One month at least must pass between the receipt of the searches by the applicant and the publication of the application. The Office then informs the owners of the Community trademarks mentioned in the search of the publication of the Community trademark application.

- OPPOSITIONS

Within three months following the publication of the application, the owners of prior Community trademarks or of opposable prior National rights may file oppositions to registration before the Office.

- APPEALS

Appeals may be made against the decisions of examiners, and against the decisions of the opposition, trademark administration and cancellation divisions, before Boards of Appeal, the decisions of which may also be appealed against before the Court of Justice.

- LANGUAGES

An application may be made in any one of the 11 official languages of the Union : Danish, Dutch, English, Finnish, French, German, Greek, Italian, Portuguese, Spanish or Swedish. The application and all the pertinent information contained in the publication are published in all of these languages. The languages of the Office are limited to five : English, French, German, Italian and Spanish.

The applicant must obligatorily nominate a second language, which must be one of the Office's five official languages, and which can be used in opposition, revocation and cancellation proceedings.

WHAT IF REGISTRATION IS REFUSED ?

If the application is rejected or withdrawn, or if the Community trademark ceases to be effective, its owner may ask for its transformation into a National trademark, which will benefit from the application date of the Community trademark.

WHAT IS THE DURATION OF THE REGISTRATION ?

10 years from the application date, renewable for further periods of 10 years.

WHAT ARE THE RIGHTS CONFERRED BY THE REGISTRATION ?

Registration confers the right to forbid use and to oppose registration as a trademark of an identical or similar sign for similar or identical goods or services and even for goods and services which are not similar when the Community Trademark has a reputation in the Union.

However, due to the principle of exhaustion, the owner of a Community trademark may not oppose the use of his trademark on goods which have been put on the European market by himself or with his consent.

Actions for infringement of a Community trademark and counter-claims for revocation or invalidation are of the exclusive jurisdiction of the «Community Trademark Courts», which are National Courts and Tribunals of first and second instance that must be designated by the member States on their territory.

The competent Court is that of the domicile or of the establishment of the defendant, or failing that, of the domicile or the establishment of the plaintiff, or failing that, a Spanish Court. The action may also be brought before the Court of a member State on the territory where the infringement was committed.

The owner of a Community trademark must remain vigilant, as if the use of a younger Community trademark is tolerated for a period of five years, its invalidation can no longer be requested, and its use cannot be opposed.

WHAT ARE THE RISKS OF NON-USE OF THE TRADEMARK ?

A Community trademark which remains unused for more than five consecutive years is vulnerable to a revocation action which may be presented before the Office by any individual or legal entity.

But actual use, even in one country of the Union only, will avoid the risk of revocation.

MUST TRANSFERS OF OWNERSHIP AND LICENCES BE RECORDED ?

Yes, as these legal acts are only opposable to third parties in all the member States if they have been recorded on the Community Trademark Register. The unitary nature of the Community trademark excludes the possibility of transfer of ownership for a part of the Union, contrary to licences.

WHAT IS THE COST OF A COMMUNITY REGISTRATION ?

The major taxes are :

ECU

- application tax up to three classes
(including 10 national searches at 25 ECU) 975
- opposition tax : 350
- registration tax up to three classes : 1100

To these taxes may be added the fees of an attorney and the reimbursement of opposition costs by the losing party.

CHOOSING A COMMUNITY APPLICATION OR NATIONAL APPLICATIONS?

The national application is preferable for those trademarks destined for a national market, or for a limited number of States of the Union. It should certainly be chosen if an insurmountable obstacle has been identified, even in a single State. It may also be preferable for language reasons.

Otherwise, a Community application could be preferable due to its major advantages linked with its unitary nature :

- one application,
- one procedure
- uniform protection

on the whole Union territory, acquired at a cost and within a time frame which should not be superior to those for obtaining comparable geographical protection by way of national applications and procedures, the risk of refusal for registration being lessened by the possibility of transformation into National applications.

THE EUROPEAN FLAG : HOW MANY STARS ?



The European flag was created by the European Council in 1955, who drafted the following symbolic description : «on a background the colour of a Western blue sky, the stars representing the peoples of Europe form a circle symbolising union. They always number 12, the symbol of perfection and abundance». The number of stars therefore is linked neither to the number of member States, nor to the European Council nor to the Community which adopted this flag in 1986.

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