

Seniority

A Community Trade Mark ("CTM") may be applied for at least partly so as to consolidate existing national registrations. Can the relevant national registrations safely be allowed to lapse as soon as a Community Trade Mark registration has been granted? We consider that the corresponding national registrations ought to be maintained for at least five years after the grant of a Community Trade Mark registration, even if the seniority of the existing national registrations has been claimed.

WHAT IS A SENIORITY CLAIM?

A seniority claim is a system whereby the owner of a CTM or a CTM application or a CTM designation can claim the prior rights of his existing national registrations in the European Union if the national registrations are allowed to lapse. Please note however:

- Seniority can be claimed only for goods/services in the national registration that are also in the CTM;
- The mark in the CTM and the national registration must be identical;
- The CTM and the national registration must be in the same ownership; ownership by a related company is not sufficient;
- If the national registration ceases before the CTM is granted that seniority is lost.

How is it claimed?

Details of the national registrations are submitted to the Community Trade Mark Office (or in some cases, via the World Intellectual Property Organization). Usually the Community Trade Mark Office will itself check the data from the websites of the national trade mark offices but sometimes they will request supporting documentation.

Has seniority been claimed in a CTM application?

Details of the national registrations (two letter country code, registration number and registration date) for which seniority has been claimed appear at the end of the data contained in the Community Trade Mark Registration Certificate, at reference number 350.

Details of the seniority also appear on the Community Trade Mark Office website.

When can seniority be claimed?

Seniority can be claimed on or just after the filing of a CTM or CTM designation, or else after the grant of a CTM or protection for a CTM designation.

Although the costs in claiming seniority can be substantial, especially when there are a considerable number of national registrations involved, it is usually desirable to claim seniority on application, especially if the prior rights are substantial, as this

may act as a deterrent to those who might have contemplated opposing the application had they not been made aware of the prior rights, and also to those who might have considered bringing a cancellation action after grant.

CTM applications or registrations can claim seniority from national registrations in the Member States which have recently joined the EU. The seniority claim can only be filed once the Member State has joined the EU. As before, for CTM applications, seniority needs to be claimed on or just after filing. For CTM registrations and protected CTM designations, the seniority claim can be filed at any time.

What is the value of a seniority claim?

The utilisation of seniority, as opposed to the claim to seniority, is a matter for national law, rather than Community Trade Mark legislation.

For example, a Community Trade Mark registration or CTM designation may claim seniority of various national registrations, which subsequently are allowed to lapse if the Community Trade Mark registration is registered or protection is granted for a CTM designation. Although the CTM legislation says that one can convert the CTM registration into national applications, claiming the relevant seniorities, so keeping in effect the national dates, conversion applications are governed by national law. The validity of such seniority claims is not

clear, and may well have to await the decision of the national Courts.

Another factor is that the Community Trade Mark Office accepts the seniority claims without much more than a cursory formalities examination; the acceptance of the seniority claim is therefore no guarantee that it will be found valid if it subsequently has to be relied upon.

Why is it recommended that national registrations be maintained for at least five years after the grant of a CTM?

If there is an owner of a similar CTM or national trade mark which is earlier than your CTM registration/designation, and that owner knows of your use of the later CTM registrations and for five years fails to take action against it on the basis of his earlier trade mark, then he is held to have lost his opportunity, unless your later CTM was applied for in bad faith.

Thus, provided that your CTM is being extensively used, it will be difficult for third parties to take action against it after five years. So once a CTM has been registered at least five years, seniority will have less importance for a well used mark.

Why claim seniority?

- It may prevent unwarranted oppositions and cancellation actions (see "When can seniority be claimed?" above).
- Especially if national registrations are allowed to lapse quite soon after the grant of the CTM, the seniority may be required in opposition and similar proceedings, where an earlier date than the CTM may be required, in order to defeat a trade mark which has a date earlier than the CTM, but later than the relevant national right.
- It may give additional weight to the registration.

Should national registrations be maintained?

The decision to allow a national registration to lapse should be made carefully; among the points to consider are:

- Is the mark very important? It would then be sensible to maintain both the national registrations and the CTM.
- Is a given national registration the basis of an ongoing action e.g. an opposition or an infringement action? If so, the registration should be maintained.
- Does the national registration contain goods/services which are of importance which are not in the CTM? It may have been that the CTM had to be narrowed down because of opposition or threat of opposition on the basis of third party rights in some but not all the EU countries.
- In the United Kingdom and Ireland it is possible to include slight variants of a mark in one registration. Are all the variants important, and are they all covered by CTMs, or should the national UK and/or Irish registrations be maintained? •Trade mark protection in some countries is obtained by registering United Kingdom trade mark registrations there. It may not always be possible to obtain protection by registering CTMs there. Even if one can this may result in the loss of prior rights.
- The geographical coverage of national registrations may be greater; for example a Danish national trade mark registration covers Greenland and the Faroe Islands; a CTM does not.
- Are there contractual obligations attached to the national registration? For example have they been licensed or used as security for a loan?

Please get in touch with your usual contact at Mewburn Ellis LLP for further information and advice.

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