



## EUTM v national applications

**When deciding whether to file a European Union trade mark (EUTM) application or one or more individual national applications, the following factors should be considered:**

### Costs

Even if you only need protection in part of the EU, a EUTM may still represent a financially attractive alternative to national registrations as the cost of a EUTM may be no more than the cost of two national registrations. It is possible to save £30,000 or more by using the EUTM system instead of filing separate national applications.

Savings will also be made every ten years upon renewal of the trade mark, as instead of paying costs to renew a number of national registrations you only need to renew one EUTM.

### Extending protection

An EUTM will automatically extend to provide protection in any country which may join the EU at a later date, subject to certain conditions.

### Examination

The European Union Intellectual Property Office (EUIPO) does not examine applications for conflict with any earlier trade marks, although the owners of any earlier EUTMs considered by the EUIPO to be identical/similar will be told of the Application.

Some EU national trade mark registries will still refuse an application if there already exists an earlier identical/similar mark on the register.

### Timescale

A straightforward EUTM application will take around six months from start to finish. Some national trade mark registries are equally as quick at dealing with an application, for example, Benelux, whereas others are not so quick, i.e. Italy.

### One trade mark

A EUTM gives you the opportunity of having a single registration which covers all EU countries, as opposed to a collection of independent national registrations, which has advantages in terms of portfolio management and costs.

### Enforcement and infringement

By successfully bringing trade mark infringement proceedings on the basis of an EUTM, it is

possible to obtain a pan-EU wide injunction. In contrast, proceedings brought on the basis of a national right, will result in an injunction which only applies in that territory and so multiple proceedings have to be issued in different jurisdictions (subject to you having national rights) to obtain wider relief.

Also, depending on the circumstances of the case, it may be preferable to bring legal proceedings in one EU country as opposed to another. With a EUTM, there is a greater flexibility as to where an infringement action can be brought, known as forum shopping.



### Use

A EUTM registration allows a trade mark owner to carry on activities throughout the EU without consideration of national borders. However, use in a single EU member state may not be enough to maintain a EUTM registration.

The courts are increasingly expecting a community trade mark to be used in more than one territory of the EU in order to demonstrate that a mark has been put to genuine use, although each case depends on the relevant facts and circumstances of the matter. For example, the characteristics of the market concerned, the nature of the goods or services protected by the trade mark, the territorial extent and scale of use as well as its frequency and regularity. It is up to the national courts to decide whether, taking into account all the circumstances including the characteristics of the relevant market, the nature of the goods and services, the territorial extent and the scale of the use as well as the frequency and regularity, the use is enough to establish or sustain pan-European market presence.



In principal, it appears that use in one member state of the EU in respect of a EUTM registration, even if such use is substantial, may not be enough to substantiate the registration as the use is not European in nature.

In contrast, if you have a bundle of national registrations, each mark **must** be used in the country where the same is registered in order to ensure that the registration remains valid.

## Unitary right

*Whilst being a unitary right brings about a number of advantages, this unitary nature does bring about some disadvantages.*

*Earlier national rights in one EU Member State are sufficient to defeat an European-wide EUTM application. If you are aware of any such marks, it may be better to proceed with applications in those countries where there is no conflict.*

*It is not possible to assign a EUTM for nominated EU countries; the mark can only be assigned in its entirety. In contrast, you can choose to assign some or all of your national registrations as you see fit.*

*In order for a EUTM to remain valid it should be used in pan-European trade in at least two or (preferably) more EU territories to constitute genuine use of the mark in the EU.*