



European Union trade mark registration

European trade mark protection

In addition to national trade mark registration systems, trade mark protection can be obtained through the whole of the EU by way of a single European Union trade mark (EUTM) registration. The opportunity of having a single registration to cover the whole area clearly gives advantages in terms of both portfolio management and cost savings, over a basket of independent national registrations.

Even if you only need for protection in part of the EU, the 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 make significant cost savings by filing a EUTM instead of separate national applications.

Where will the mark be protected?

An EUTM extends to the following territories:

Austria, Benelux (Holland, Belgium and Luxemburg), Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Malta, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the UK.

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

How do I get one?

An application can presently be filed direct at the European Union Intellectual Property Office (EUIPO).

An application is filed for a trade mark in respect of specific goods/services. It is examined as to registrability and searches for earlier identical/similar trade marks are automatically conducted of the EUTM. The EUIPO will not refuse to register a trade mark because it conflicts with another trade mark unless an opposition is filed.

Once the application has successfully completed the examination stages, it will be published for 3 months in case any third parties want to object to the same.

Subject to clearing this hurdle, the application goes forward to registration and the certificate is issued. The registration is then effective throughout the whole of the EU.

When are the disadvantages?

Applications are open to opposition from the owners of prior EUTM rights and prior national rights in the EU. As a EUTM is a unitary right, earlier rights in one EU Member State are sufficient to defeat the application as a whole. However, should this happen it would be possible to 'convert' the application into national applications in the elected countries of interest, maintaining the filing date of the EUTM application.

When should I apply for a trade mark?

As soon as you know which trade mark you want to use. A trade mark does not already have to be in use to be registered. In fact it is very important to have your interest in the mark registered as soon as possible to prevent a third party from beating you to it. You should also obtain advice on clearing a trade mark prior to use and registration.

Use of an EUTM registration – pan-European trading interests.

An EUTM registration allows a trade mark owner to carry on activities throughout the EU without consideration of national borders and this European-wide right can be maintained without the need for the trade mark to be used in every country. 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 of the case, 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.

Why use Barker Brettell LLP?

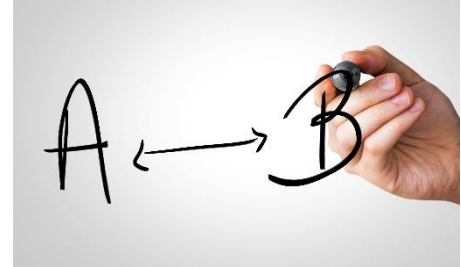
At Barker Brettell LLP all our trade mark attorneys have many years' experience in preparing and filing trade mark applications including dealing with trade mark offices around the world. We will use our experience to provide you with the broadest trade mark protection we can, in order to create a sphere of protection around your trade mark which would be difficult for a third party to successfully break.

We can advise you more on these issues, as well as on any of the other aspects of intellectual property as Barker Brettell LLP offers a full range of intellectual property services and we are always happy to take the time to tailor our services to your needs.

Therefore, it is important to bear in mind that a EUTM registration is only appropriate for trade marks that are to be put to use in a European context and not for marks which are only likely to be used in one EU territory.

Why should I use a trade mark attorney when I can file an application myself?

Trade mark applications must be filed to cover the exact goods/services the trade mark will be used in connection with. This may seem simple however, it is very important that you obtain advice to ensure you are including all of the correct goods/services you provide. Furthermore, it is important that you are seeking protection for the correct trade mark and variations of the same. When considering what to file for as a trade mark, significant commercial awareness and strategic insights are invaluable and our Attorneys pride themselves on their knowledge in this respect.



Valuable time and money can be saved by seeking advice on such matters prior to filing an application as a trade mark which does not cover the right goods/services or does not sufficiently portray how the mark will be used, can be worthless. The scope of a Trade Mark cannot be broadened once filed therefore if additional goods/services are required after, a new application would need to be filed.

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