

European Union Trade Marks

European Union trade marks (previously called Community trade marks) are registered rights which have unitary effect throughout the whole of the European Union. EU registered trade marks cannot be subdivided, assigned or otherwise divided on a state-by-state basis, but only as a European Union wide right. However they can be licensed on and individual national basis.

Since their inception in 1996, European Union trade marks have been extremely successful, and are now the first choice for protection of marks in Europe, largely supplanting in importance the previous system of filing individual national trade mark applications in individual EU member states.

What can be protected?

Any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings can be registered as EU registered trade marks, provided they are capable of being represented in a manner which enables the clear and precise subject matter of the protection to be determined.

The majority of EU registered trade marks are product brand names, and company names. However, there are also registrations for colours, smells, sounds, and three-dimensional shapes.

What is excluded from protection?

Trade marks cannot be registered for the following:

- signs which are not capable of distinguishing the goods or services of one undertaking from those of another;
- trade marks which are devoid of any distinctive character;
- trade marks which consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

- signs which consist exclusively of the shape or another characteristic, which results from the nature of the goods themselves;
- signs which consist exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result;
- signs which consist exclusively of the shape, or another characteristic, which gives substantial value to the goods.

This means that items such as an engine camshaft, or a set of saw tooth blades would not be registrable as EU trade marks. However, articles such as packaging, bottles and the like are registrable as trade marks.

Scope of rights

Trade marks are registered in respect of a description of goods and services. One proprietor can register a trade mark for some goods, whilst another proprietor can register the same trade mark for other goods, without the two registrations necessarily conflicting each other, provided the goods of the first registration are not identical or similar to the goods of the second registration.

Even where the same mark is registered by two different owners for the same goods or services, these can still coexist on the EU trade marks register if there is consent between the two owners.

Duration

EU registered trade marks are perpetual rights, which means they have no maximum term or scheduled expiry. However to maintain an EU trade mark requires payment of an official maintenance fee every 10 years.

Further, any mark which has not been used within the European Union for a continuous period of 5 years or more is vulnerable to be revoked upon application by any third party, on the grounds of non-use, even if the maintenance fees are paid up to date.

Use of a trade mark must be made in the European Union, in order to maintain a valid registration.

Application procedure

A pre-filing search is always recommended to see if the mark is available for registration and use. However such a search is not essential in every case. The search can identify whether there are any third party rights which could cause problems in using the mark, and whether there will be any problems in registering the mark.

Single application relates to an individual mark to be registered. Each application can specify as many goods and services as required. Goods and services fall into different classifications according to an international classification system.

In general, the specification of goods and services should include as many goods as you are using the mark on, or intend to use the mark on. Goods cannot be added to the specification after filing, although individual descriptions of goods can be deleted from the application.

After filing the application, the EU intellectual property office examine the mark for intrinsic registrability, to ensure that it is capable of distinguishing the goods and services of the applicant from those of other undertakings.

Assuming examination by the office for intrinsic registrability is successful, as is the case with the majority of EU trade mark applications, the mark is laid open to opposition from third parties for a 3 month period.

If no oppositions are received, the mark will proceed through to registration within a few weeks thereafter. However if an opposition is received, the application then goes into the official opposition procedure.

Third party opposition procedure

During the opposition period, third parties have an opportunity to oppose registration based upon intrinsic grounds, and/ or relative grounds, that is, relative to other earlier rights which those third parties may hold. More than one person can oppose a registration, acting either jointly or independently. Typically, oppositions occur in round 15 to 20% of EU trade mark applications.

If one or more oppositions are received, the application enters a formal opposition procedure. Typically, oppositions are based upon prior rights of third parties who already have identical or similar marks registered, that is, relative grounds. To successfully oppose a registration, an opponent must have an earlier application or registration for an identical

or similar mark, in respect of identical or similar goods or services, or a relevant earlier right.

The opponent files their grounds of opposition, which sets out their objection to registration, including details of any prior rights which they are citing against the application. The applicant can either withdraw from the opposition, in which case the mark does not proceed through to registration, or can amend the specification of goods and services to remove any conflicting goods or services, in which case the mark may proceed through to registration for the remaining goods and services where there is no conflict.

It may be possible to overcome a valid or strong opposition by negotiating a coexistence agreements with an opponent, setting out the respective usage and registration of the mark by each party, and which allows the application to proceed to registration either for all or some of the goods and services applied for.

Once any grounds of opposition are overcome, or an agreement has been arrived at with the opponent to allow the mark to proceed by consent, the mark proceeds through to registration.

However if there is an opponent with strong prior rights, for example an earlier identical or similar registered mark for identical or similar goods or services, who maintains their grounds of opposition, and who will not come to a coexistence agreement or give consent to registration, and their grounds of opposition cannot be overcome, then the application may be rejected.

In that event, a European Union trademark application can still be split into one or more individual national trade mark applications which can be prosecuted separately, and which may or may not succeed individually, depending upon the geographical scope of the third party prior rights present in the opposition.

Instructions

To register your trade mark, we will need the following information:

- Details of the mark, whether it is a word, or other graphic sign or logo, including a copy of the sign or logo;
- A list of goods and/or services for which you are already using the mark, or intend to use the mark, and for which the mark is to be registered for;

FRANKS & CO

Patent & Trade Mark Attorneys

- Details of the owner (applicant) including name, address, country of incorporation and type of legal person (limited company, limited liability partnership, individual etc.)

Further advice

For further information, or to file a registered Community design, please contact one of our offices.

Franks & Co

15 Jessops Riverside

Brightside Lane

Sheffield

S9 2RX

T: +44 (0)114 249 9888

F: +44 (0)114 249 9666

E: franksco@franksco.com

Franks & Co (South)

Carlton House

26 Billing Road

Northampton

NN1 5AT

T: +44 (0)1604 632436

F: +44 (0)1604 626128

E: northampton@franksco.com

Franks & Co (Mancunium)

Cheadle Place, Cheadle Point

Stockport Road, Cheadle

Manchester

SK8 2JX

T: +44 (0)161 820 2891

F: +44 (0)114 2499666

E: manchester@franksco.com

www.franksco.com

Copyright © Franks & Co Limited 2016. Information in this document is necessarily of a generalised nature by way of guidance only. It should not be relied upon as definitive legal advice, and as such, Franks Co accept no responsibility for any actions taken or not taken as a basis of the information in this document. For specific legal advice, please contact one of our offices.