

European Union Trade Marks



► **Inside**

What is a European Union Trade Mark?

How to obtain a European Union Trade Mark



Introduction

A European Union trade mark ("EUTM") is a single trade mark registration that provides trade mark protection in 28 of the European Union territories. This will change to 27 territories if/when the UK leaves the EU.

What is a European Union trade mark?

A European Union trade mark ("EUTM") is a single trade mark registration that provides trade mark protection in 28 of the European Union territories.

What are the benefits of a European Union trade mark?

As the Applicant only needs to file a single EU trade mark application instead of a bundle of national applications, each of which would attract both official application and attorneys' fees. An EUTM is the most cost effective way of securing trade mark protection throughout the EU. Broadly speaking, the cost of filing an EUTM is about the same as filing two or three national applications. An EUTM also greatly facilitates administrative matters as only one office needs to be contacted in respect of any assignment, licence or renewal of the trade mark.

Should I conduct a search?

As a matter of course, well-advised businesses conduct a number of searches before adopting a new trade mark. The purpose of a trade mark search is to ensure that there are no identical or similar trade marks already on the trade mark register covering identical or similar goods or services to the trade mark ("Earlier Marks"). If there are, the Proprietor of any such Earlier Mark may be able to bring proceedings for trade mark infringement and/or passing off if you use the trade mark. "Common Law" searches should also be conducted for company names, domain names and in journals and trade directories in the relevant business sector.

If the trade mark search identifies a risk, then an assessment needs to be made as to whether such risk constitutes a serious commercial threat. If so, an alternative trade mark may need to be sourced and the search procedure repeated.

Application process

In order to obtain an EUTM registration, an application has to be filed at the European Union

Intellectual Property Office ("EUIPO") based in Alicante, Spain.

For trade mark purposes, all possible goods and services are sub-divided into 45 "classes". Within the trade mark application form, the Applicant must identify the classes to be protected. The higher the number of classes applied for, the greater the scope of protection afforded by registration. It should, however, be borne in mind that the cost of applying for the trade mark increases commensurately with each class since an additional fee per class is payable. Also, applying for a greater number of classes may give rise to problems in obtaining registration due to the increased likelihood of encountering conflicting Earlier Marks.

Once the application has been filed, the EUIPO will provide an application date and number. The application date is of particular importance as the trade mark becomes enforceable from this date if the application is successful. You should be aware that the trade mark cannot be used in trade mark infringement proceedings until the registration has been published. That stated, an unregistered trade mark can be used to oppose applications filed by third parties after the application date which are the same or similar to the trade mark.

The EUIPO's first consideration is whether the trade mark is actually capable of constituting a registered trade mark. A trade mark has to be a sign capable of being a badge of origin which serves to distinguish the goods or services of one undertaking from those of other undertakings (one business and another). This is generally not a contentious question as a trade mark can be in the form of a word, logo, image, photograph or 3D shape, but also a colour, sound, moving image or smell where they are capable of adequate description.

Although the trade mark may be capable of constituting a trade mark, it may not be registrable as one. The EUIPO will not allow an application to proceed to registration for a number of reasons, the main grounds being that the trade mark applied for is not considered distinctive, is only descriptive of the goods and/or services to be provided under the trade mark or the specification is not sufficiently precise.

The EUIPO also conducts a search for earlier conflicting national trade marks and EUTMs. It



contacts the national registries of each EU country to request national searches and then informs the Applicant of the results of those searches in order to alert the Applicant to identical or similar Earlier Marks which might give rise to problems. The EUIPO does not, however, alert the owners of the Earlier Marks located in the national searches. The EUIPO also conducts a search of its own register and if it locates any earlier conflicting EUTMs it informs both the Applicant and the Proprietors of those trade marks who may raise objections if they so wish.

If the EUIPO raises any objections to the application, then, depending on the nature of these objections, they can often be overcome by either legal argument or by the filing of evidence (particularly if the trade mark is already in use). Once these objections are overcome, then the trade mark will proceed to advertisement. However, if the objections are not overcome then the trade mark will be refused.

Advertisement is when the trade mark application is advertised in the official publication, "the Official Journal." Once advertised, third parties will have three months from the date of that advertisement to oppose the application by filing a Notice of Opposition. Oppositions can only be brought by an Opponent who has an Earlier Mark.

If an opposition is filed and is successful then the trade mark will be refused.

If no Notice of Opposition is filed, or if any such opposition is overcome, then the trade mark will proceed to registration upon payment of the registration fee.

How long does the process take?

If the EUIPO raises no objections then registration can be achieved within a little over 8 months. If objections or delays occur then the process can take substantially longer.

How long does a registration last?

An EUTM is valid for an initial period of 10 years. However, provided that renewal fees are paid every 10 years, an EUTM can provide perpetual protection.

International dimension

Intellectual property rights are jurisdictional in nature and an EUTM will not protect the trade mark outside of the EU. Should you require trade mark searches/applications for non EU countries, then these can be provided through our network of worldwide contacts.

Please request a copy of our client guide on International trade mark filing.

What is the cost?

The official fee for filing an EUTM is €850 for the first class, €50 for the second class and then €150 per additional class. This firm's fees are available on request.

Once a trade mark application has been filed, additional costs will be incurred. However, these are largely dependent on the extent of objections (if any) raised by EUIPO and/or third parties to the application.

For further information on this subject, please contact the following members of the Lewis Silkin Trade Mark and Portfolio team:

Dominic Farnsworth

Partner

T + 44 (0) 20 7074 8088

dominic.farnsworth@lewissilkin.com

Steven Jennings

Trade Mark Counsel

T + 44 (0) 20 7074 8203

steven.jennings@lewissilkin.com

European Union Trade Mark Application Procedure

