



TRADEMARKS IN THE EUROPEAN UNION

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The trademark is nowadays an essential element of business strategy. They offer fixed references to consumers, in markets often saturated with greatly similar products and services. Thus, they cultivate consumer loyalty, being the only element distinguishing the products that consumer is looking for.

Previously, when an entrepreneur from beyond the European Union wished to protect his products' and services' trademark, he had to register that trademark in each and every European State in which he sought protection. Thus, he found himself forced to repetitively fulfill formalities which were more often than not essentially the same: a most fastidious procedure.

In the current context of market globalization, the European Union recently abrogated the condition of nationality for natural or legal persons holding trademarks, thus allowing foreign entrepreneurs access to the **community trademark**. Indeed, since February 19th 2004, a single process of trademark registration with the *Office for Harmonization in the Internal Market* (O.H.I.M.) has been made available to foreign entrepreneurs, that allows the registration a trademark and affords protection throughout the 25 countries making up the Union: Germany, Austria, Belgium, Cyprus, Denmark, Spain, Estonia, Finland, France, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxemburg, Malta, the Netherlands, Poland, Portugal, the United-Kingdom, the Czech Republic, Slovakia, Slovenia, and Sweden.

The registration process for a community trademark is advantageous to an entrepreneur seeking to attain a global protection throughout all member States of the European Union since it simplifies the preliminary procedures et markedly reduces the related costs.

Moreover, to be valid, the community trademark must, as with national trademarks, respect certain conditions:

- It must not be descriptive, generic, misleading, contrary to public order and to accepted standards of good behaviors, constitutive of an official emblem or insignia;
- It must constitute a sign able to assume a distinctive function and be susceptible to graphical representation (colour, slogan, form of the product, conditioning, designs, pictograms, portraits of persons, signatures, combination of letters, a number, a letter, sound marks...);
- It must be available.

1. Registration

The application for registration requires the identification of the applicant, the list of the products or services for which registration is requested (in conformity with international classification set out in the Nice Agreement), a depiction of the trademark, indication of the filing language (Spanish, German, English, French, or Italian) and a second language the applicant accepts as eventual language for contentious proceedings.

The application is then filed either with the Office, or with a member State's central intellectual property service or the Benelux trademarks office, both of which will forward the application to the Office within 2 weeks of filing.

The applicant must, within a month of the application's filing, pay a tax in the amount of 900 € for three classes (750 € in case of electronic filing), to which is added, if applicable, a further tax of 150 € for each additional class of products or services.

The Office then dresses up a **community research report** in which it mentions the community trademarks or community trademarks applications susceptible to be opposed to the application.

It informs thereof the applicant as well as any anterior rights' holders, in order that these later may form opposition by filing, with the Office, written observations specifying the grounds on which the proposed trademark should be declined registration.

Starting on March 10th 2008, the applicant will also be able to conduct an optional national research, for which the report will be subject to a specific tax (Regulation of February 19th 2004).

If the filing is in order, the application for registration is published in the Community Trademarks Bulletin no later than a month after the communication of the anteriority research report, the whole subject to a further tax of 850 € for three classes, also with added costs of 150 € for each additional class.

Nevertheless, third parties holding certain anterior rights (as well as licensees thus allowed) may file with the Office a written request setting out the grounds of opposition to the registration of the concerned trademark:

- in case of identity between the designated signs and objects;
- in case of a risk of confusion through the use of a sign similar for products identical or similar to the designated ones;
- when the applicant could unduly profit from the distinctive character or the renown of an anterior trademark (for different products or services);
- in case of a fraudulent application.

Opposition is open to the holder of an anterior trademark filed or registered on the national or community level, on the international level if the trademark has an effect in a member State, to the holder of a notorious trademark or that of an unfilled trademark which is used in the course of business and which range is beyond a local scope.

2. Rights Granted by the Community Trademark

When a trademark is published in the Community TradeMarks Bulletin, it confers to its holder an exclusive property right under national law.

It allows the holder to forbid third parties from using his trademark without his consent for a ten-year period beginning at the filing of registration's date and renewable indefinitely by increments of ten-year periods.

However, a community trademark's exclusivity may, on one hand, be limited in case of a conflict with certain existing signs, taking into account that, on the other hand, *"the rights conferred by the community trademark do not allow its holder to prevent its use for products that were marketed in trade within the Community, under this trademark, by the holder or with his consent [our translation]"* (exhaustion of rights theory).

Finally, the holder of a community trademark that tolerates, for a period of five consecutive years, the use within the Community of a posterior community trademark cannot, if he was aware of this use, request its nullity nor oppose its use on the basis of his anterior trademark.

In conclusion, the major advantage of the community trademark consists in a single filing of application valid for every country within the Union: a salutary simplification within the context of the Common Market and intra-community free trade.

Furthermore, the filing of a trademark registration thus becomes less costly for the entrepreneur looking to obtain protection more comprehensive than the registration of a national trademark in each of the 25 countries of the Union.

Aurélie Boulet
Attorney at law
AVENS
Lehman & Associés
Lawyers in Paris
www.avens.fr

www.LecoursHebert.com

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Mr. Alain P. Lecours
LECOURS, HEBERT LAWYERS INC.
354, rue Notre-Dame Ouest
Bureau 100
Montréal, QC Canada H2Y 1T9
Téléphone : (514) 344-8784
Télécopieur: (514) 344-9790
Lecours@LecoursHebert.com

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