An Introduction to EU Trade Marks

Why Register a Trade Mark?

Customers can identify you because of your trade mark - it distinguishes your products or services from those of your competitors. Trade marks can become very valuable business assets by virtue of consumer recognition of the reputation and quality they come to represent.

In some countries, some unregistered rights may be accrued through regular use and reputation, but these rights can be difficult and expensive to establish if you are unfortunate enough to have to rely upon them. Trade mark registration is a more effective system for owners to acquire clearly recorded, exclusive rights.

Why Choose an EU Trade Mark?

Trade marks may be registered at national level throughout the EU, but if you do business in more than one Member State, multiple applications can be time consuming and expensive. Many businesses prefer the streamlined application process and subsequent easy management of a unitary right obtained by registering an EU Trade Mark, which affords protection in all current and future EU Member States with unitary effect through a single registration and single administration for record keeping and renewal.

Applying for a European Union Trade Mark

The European Intellectual Property Office (EUIPO) based in Alicante, Spain, administers the EU Trade Mark Register. An application for an EU Trade Mark must include a number of details including the Applicant’s name and address details, a description of the Trade Mark being sought, and a categorized list of the goods and/or services for which Trade Mark registration is sought.

The cost of filing an EU Trade Mark application through Hanna Moore + Curley, covering one class of goods or services, would be €1700 + VAT with a further €100 + VAT being payable in respect of a second class and a further €200 + VAT being payable in respect of each additional class. Further costs may arise in prosecuting an application to registration. The amount of these costs will be determined by what, if any, objections are raised by the administering office and require to be overcome. Also, these costs do not include dealing with any opposition(s) that may be filed against your application.

The application goes through a process involving several steps to registration.
Examination

EUIPO examine all applications to ensure that each Trade Mark is sufficiently distinctive to distinguish between the origin of goods, or services, of one trader from competitors. A trade mark cannot be registered if it consists exclusively of a sign which is descriptive of the product itself, deceptive, or contrary to the law or accepted principles of morality in any part of the European Union.

Opposition

Once an Application has been accepted by EUIPO, it is published. This initiates a three month period in which third parties can ‘oppose’ or seek to block the application. Proprietors of earlier trade mark rights within the European Union can oppose an EU Trade Mark Application based on their earlier rights.

If your Application is not subjected to any Oppositions, or successfully overcomes them, your EU Trade Mark is registered and this registration is published. A registration certificate is issued from EUIPO.

If an Application is refused as a result of a successful Opposition, the Application may be converted into national applications covering those countries where the prior right, upon which the Opposition is based, does not apply. For example, if the Opposition is based on an earlier German trade mark registration, the EU Trade Mark Application can be converted into national applications in the other Member States.

Using an EU Trade Mark as a base for further International registrations

Once an Application to register a trade mark has been filed at EUIPO, the EU Trade Mark Application can be used as a basis for securing an International Registration covering additional countries around the globe. Note that not every country worldwide participate in the International Registration (Madrid) System. However, many countries do including the US, China, Russia and Australia (see our separate Introduction to International Registration for more detail). The cost of obtaining the International Registration can be significantly less than the cost of obtaining individual national trade mark registrations in each country.

Duration of EU Trade Marks

In order to maintain your EU Trade Mark Registration it is necessary to pay a renewal fee every ten years.

Watching competitor activity

Since EUIPO does not examine EUTM applications for possible conflict with earlier trade marks, owners of existing EU and national trade marks must be in a position to protect their own interests by opposing conflicting EU Trade Mark Applications. It is strongly advised that trade mark proprietors monitor the EUTM Register in order to be aware of applications for trade marks which may conflict with their own. Hanna Moore + Curley provide a watching service and we should be pleased to provide a quote upon request.

Intellectual Property services

Hanna Moore + Curley provide professional services covering all areas of intellectual property, including advice on trade mark selection, use and protection; prosecution of trade mark applications, including dealing with official objections and Opposition; advice on litigation, licensing and assignment, as well as searching for potentially conflicting applications; renewal of existing registrations and management of trade mark portfolios.

“Brexit”

The UK voted to leave the EU in a referendum on 23rd June 2016. It is anticipated that it could take at least two years for the UK to formally leave the EU. After this point, applications for new EU Trade Marks and Community Registered Designs will no longer cover the UK. Applicants needing protection in the UK will need to file separate national applications. We expect that continuity for existing EU Trade Mark and EU Design registrations in the UK will be maintained by some form of re-registration procedure, but provisions for this are not yet in place.

For any further specific questions, please contact any of our European Patent Attorneys at Hanna Moore + Curley.

This information in this document is necessarily of a general nature and is given by way of guidance only – it does not constitute legal advice. Hanna Moore + Curley accepts no responsibility for any damage or loss suffered as result of any inadvertent inaccuracy. Specific legal advice should be sought on any particular matter.

EUROPEAN PATENT AND TRADE MARK ATTORNEYS

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