

### Enlargement of the EU - Effect on Community Trade Marks, Community Designs & European Patents

The European Union (EU) enlarged on 1st May 2004 when Cyprus, Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia joined: it enlarged again on 1st January 2007 when Bulgaria and Romania joined.

There is no effect on the European Patent system as this is not in fact an EU organisation; there is not, as yet, a Community Patent giving unitary patent rights for the EU. All the EU countries are members of the European Patent Convention (EPC). Please see our separate sheet European Patents: The Basics for more details.

This sheet considers in detail how the enlargement will affect Community Trade Marks (CTMs) and Community Designs (CDs).

#### Official languages

Czech, Estonian, Hungarian, Latvian, Lithuanian, Maltese, Polish, Slovak and Slovenian became official languages of the European Union on 1st May 2004, and Bulgarian and Romanian from 1st January 2007, and so details of trade marks are published in these languages in addition to the previously existing official languages.

#### Automatic extension of existing CTMs & CDs

Without any formalities all CTMs and CDs registered or applied for before 1st May 2004 were automatically extended to the 2004 enlargement countries, and those registered or applied for before 1st January 2007 were extended to Bulgaria and Romania. In practice, because of the political situation there, the extension to Cyprus is only effective for the southern (Greek) part. Unregistered CDs are automatically extended as well.

Extended CTMs and CDs cannot be invalidated because of an absolute ground for objection that arises simply because of a new member state joining (for example in the case of the CTMs a mark being descriptive in the language of a new member state). Also, extended CTMs cannot be invalidated on the grounds of earlier national rights registered, applied for or acquired in a 2004 new member state prior to 1st May 2004 and in Bulgaria or Romania prior to 1st January 2007. This provision is not really relevant to CDs as absolute novelty applies.

Accession of the new member states is unlikely to affect the examination of CD applications, as the grounds for non-registrability will remain the same.

#### Clashes between extended CTMs or CDs and earlier rights in the new member states

There may be "earlier" rights (such as a registered trade mark or a trade mark application applied for before 1st May 2004 in a 2004 enlargement country or before 1st January 2007 in Bulgaria and/or Romania, an unregistered trade mark, copyright, prior design (which is, however, undisclosed at the date of the filing of a registered CD and so does not destroy the CD's novelty etc.)) for the same or a confusingly similar mark or design in a new member state which conflicts with an extended CTM or CD.

Provided that the "earlier" rights were acquired in good faith, whether their date is earlier or later than the CTM or CD, those rights can be used to oppose the use of the extended CTM or CD in that new member state. However the owner of the earlier right cannot oppose pending CTM applications on the basis of those rights (with a special exception: see below) nor request invalidation of the extended CTM.

#### CTMs filed in the six months before enlargement

Exceptionally CTMs filed between 1st November 2003 and 30th April 2004 can be opposed (but not invalidated) by holders of earlier rights in the 2004 new member states, and likewise for CTMs filed between 1st July 2006 and 31st December 2006 by holders of earlier rights in Bulgaria and Romania, provided that the earlier rights were acquired in good faith and the earlier right has an earlier application date (or priority date or acquisition date if applicable) than the application date (or priority date if applicable) of the CTM application.

### New absolute grounds

The enlargement of the European Union increases the chances that a mark may be inherently unregistrable; for example a new official language may give rise to descriptiveness objections that would have not arisen before.

CTM applications filed before a given accession date will not be refused on grounds that arise merely because of the accession of a new member state on that accession date.

If the use of the mark is descriptive, non-distinctive or generic in a new member state, then a CTM or CTM application already existing at the relevant accession date cannot be utilised to stop that use in the new member state concerned.

Applications filed on or after a given accession date will be refused on grounds arising from the new member states who acceded on that date.

### Enforcement of CTMs and CDs in the new member states

Enforcement of automatically extended CTMs and CDs was possible in the 2004 new member states as from 1st May 2004 and in Bulgaria and Romania as from 1st January 2007. If action is defended on the basis of earlier rights, these rights would need to date back to before 1st May 2004, as regards the 2004 new member states and before 1st January 2007 as regards Bulgaria and Romania.

### CTMs as earlier rights in the new member states

From a given accession date, automatically extended CTMs constitute earlier rights against applications or registrations in the relevant new member states having a filing or priority date on or after the accession date concerned.

Thus automatically extended CTMs must be raised as a basis for refusal and admitted as grounds for oppositions and invalidations as regards nationally filed applications and designations of International Registrations.

### Seniority

This is a system whereby the rights in existing national trade mark registrations are able to live on in a CTM (in the same ownership, for the same mark and covering at least the same goods/services for which seniority is to be claimed). The national registrations can then be allowed to lapse.

Seniority for existing registrations in the enlargement countries can be claimed from the relevant accession date. The new member states have to incorporate the appropriate provisions in their legislation to allow for seniority claims and the continuance of the trade mark rights after the national registrations have lapsed.

### Conversion

A CTM may fail because of factors that do not apply to all the member states, for example descriptiveness in one country or successful opposition on the basis of prior rights covering some, but not all, of the EU.

In this situation the trade mark owners may wish to convert the CTM into national applications for the unaffected countries. The new member states are required to amend their trade mark legislation so as to allow for conversion.

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