

Trade Mark Briefing Paper:

CTM Seniority

A seniority claim records, against a CTM, the earlier date from which rights in the same mark run in any EU member state.

Reasons for claiming seniority

- National registrations can be allowed to lapse;
- Saving renewal costs;
- Proprietor is deemed still to have the same rights as if the national mark was still registered.

Requirements for claiming seniority

- National mark must be in force at time claim is submitted;
- Identical trade marks;
- Owner of national mark and CTM must be the same;
- CTM goods must be identical to, or contained within, goods covered by national mark.

Timing of seniority claim

- At time CTM is filed or within two months of filing (puts potential opponents on notice of earlier rights in certain member states); or
- After the CTM has been registered (costs of making seniority claims not incurred until it is known CTM has achieved registration).

Lapse of national rights

- Seniority claim only becomes effective when the national registration ceases to have effect (lapses, or is surrendered).
- As each national registration comes up for renewal, a decision can be made as to whether to allow it to abandon. Considerations include:
 - *It may be advisable to maintain national marks in particularly important markets. In the UK, use of a UK trade mark registration cannot infringe another UK trade mark registration. UK trade mark registrations are needed as the basis for obtaining registrations in some jurisdictions e.g. Jersey.*
 - *Whether the CTM is well established (the owner of an earlier national right who has acquiesced in use of the CTM for five years is no longer entitled to attack the validity of the CTM).*
 - *If there was a partial seniority claim, and the national registration covers broader goods/services, whether protection for these is still needed.*
 - *Whether the owner of the CTM and the national right are still the same. If not, this should be corrected to preserve a valid seniority claim.*

Note if the national registration was revoked or invalidated, the seniority claim loses effect (and protection in the country will run from the filing date of the CTM).

Loss of CTM

- If the CTM ceases to have effect, the national registrations from which seniority was claimed will, if still in force, remain in effect as national marks.
- If the national registrations have lapsed, the CTM may be converted into national applications, with protection from the seniority dates where there is identity of goods.

For further information, please contact:

Bristol

Jane More O'Ferrall

T: +44 (0) 117 910 3200

janemof@haseltinlake.com

www.haseltinlake.com

