ENLARGEMENT OF THE EU - EFFECT ON EUROPEAN UNION TRADE MARKS & COMMUNITY DESIGNS

The European Union (EU) enlarged again on 1st July 2013 when Croatia joined. This sheet considers in detail how the enlargement affects European Union Trade Marks (EUTMs)* and Community Designs (CDs). (Note that references to EUTMs include designations of the EUTM under the Madrid Protocol (International Registration.).)

OFFICIAL LANGUAGES

Croatian became an official language of the European Union on 1st July 2013, and so details of trade marks are now published in this language in addition to the previously existing official languages.

AUTOMATIC EXTENSION OF EXISTING EUTMs & CDs

Without any formalities all EUTMs and CDs registered or applied for before 1st July 2013 were automatically extended to Croatia on that date. Unregistered CDs were automatically extended as well.

Extended EUTMs and CDs cannot be invalidated because of an absolute ground for objection that arises simply because of Croatia joining (for example in the case of the EUTMs a mark being descriptive in Croatian). Also, extended EUTMs cannot be invalidated on the grounds of earlier national rights registered, applied for or acquired in Croatia prior to 1st July 2013. This provision is not really relevant to CDs as absolute novelty applies.

ACCESSION OF CROATIA IS UNLIKELY TO AFFECT THE EXAMINATION OF CD APPLICATIONS, AS THE GROUNDS FOR NON-REGISTRABILITY WILL REMAIN THE SAME.

CLASHES BETWEEN EXTENDED EUTMs OR CDs AND EARLIER RIGHTS IN CROATIA

There may be “earlier” rights (such as a registered trade mark or a trade mark application applied for before 1st July 2013 in Croatia, 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 Croatia which conflicts with an extended EUTM or CD.

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

EUTMs FILED IN THE SIX MONTHS BEFORE ENLARGEMENT

Exceptionally EUTMs that were filed between 1st January 2013 and 30th June 2013 can be opposed (but not invalidated) by holders of earlier rights in Croatia, provided that the earlier rights were acquired in good faith and the earlier right has an earlier application date (or priority date if applicable) than the application date (or priority date if applicable) of the EUTM application.

NEW ABSOLUTE GROUNDS

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

EUTM applications that were filed before 1st July 2013 will not be refused on grounds that arise merely because of the accession of Croatia on that date.
If the use of the mark is descriptive, non-distinctive or generic in Croatia, then an EUTM or EUTM application already existing at 1st July 2013 cannot be utilised to stop that use in Croatia.

APPLICATIONS FILED ON OR AFTER 1ST JULY 2013 WILL BE REFUSED ON ABSOLUTE GROUNDS ARISING FROM CROATIA.

ENFORCEMENT OF EUTMs AND CDs IN CROATIA

Enforcement of automatically extended EUTMs and CDs has been possible in Croatia as from 1st July 2013. If action is defended on the basis of earlier rights, these rights would need to date back to before 1st July 2013.

EUTMs AS EARLIER RIGHTS IN CROATIA

From 1st July 2013, automatically extended EUTMs have constituted earlier rights against applications or registrations in Croatia having a filing or priority date on or after 1st July 2013.

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

SENIORITY

This is a system whereby the rights in existing national trade mark registrations are able to live on in a EUTM (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 Croatia can now be claimed. Croatia has had to incorporate the appropriate provisions in its legislation to allow for seniority claims and the continuance of the trade mark rights after the national registrations have lapsed.

CONVERSION

An EUTM 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 EUTM into national applications (or designations of an International Registration as regards a failed EU designation (except that it is not possible to designate Malta and so conversion would have to be for a national application)) for the unaffected countries that are of interest to them. Croatia has been required to amend its trade mark legislation so as to allow for conversion.

PREVIOUS ENLARGEMENTS IN 2004 AND 2007

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.

The changes and procedures that took place when Croatia joined the EU are the same as those that arose with previous enlargements, apart obviously from the different dates and language involved.

*previously known as Community Trade Mark (CTM)