



European Communities Trade Mark Association

Survey Trade Mark Issues related to Non-EU States and Regions

A Survey conducted by the ECTA Harmonization Committee

The Harmonization Committee recently discussed various trade mark related problems which concern the relationship between certain EU Member States and Non-EU states or regions.

Among these issues were the consequences of the conversion of a CTM into a national trade mark if the Member State in question comprises regions which do not belong to the EU. For example, in the case of conversion of a CTM into a national Danish trade mark, does the Danish trade mark extend to Greenland although the CTM did not?

Another question of practical importance referred to are the consequences of a bilateral treaty between Germany and Switzerland. This treaty states that the use of a German trade mark in Switzerland is also considered as sufficient use in Germany. Does this imply that an opposition against a CTM could successfully be based on a German trade mark although this trade mark is only used in Switzerland, but not in any of the current EU Member States?

In order to go into these problems more deeply, the Harmonization Committee decided to conduct this survey which gives an overview of the situation in the various Member States. It reveals interesting trade mark related problems which refer to the relationship between the various EU Member States and Non-EU states and regions.

First of all, the survey covers the question whether the various Member States comprise any regions which do not or do not fully belong to the EU or which have their own trade mark system. Subsequently, it deals with the issue of conversion and seniority in these regions. Finally, the existence and scope of bilateral treaties with Non-EU states and further relevant trade mark issues are examined.

This survey is of particular interest with regard to Denmark, Finland, France, Germany, the UK, Italy and the Netherlands. These countries have relationships with certain regions or states which result in various problems and questions in the field of trade marks.

In some of these countries, the way to tackle these problems (in particular the question of conversion) is not yet certain. Nevertheless, the survey provides valuable answers and approaches for nearly all current EU Member States. We therefore trust that it proves useful for all trade mark practitioners and other interested persons, including OHIM representatives, who encounter the challenges covered in this survey.

On behalf of ECTA I wish to thank all former and present Members of the Harmonization Committee and also all other colleagues from the different countries who have taken to the time and effort to realize this project. Their assistance is very well appreciated.

Enjoy the reading!

February 2007

Carolin Kind

Vice Chair of the Harmonization Committee of ECTA



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1. Regions not or not fully belonging to the EU

- a- Are there any regions in your country which do not or not fully belong to the EU?
- b- Do CTMs have effect in those regions?

2. Regions with their own trade mark system

- a- Are there any regions in your country which have their own trade mark system?
- b- Do national trade marks registered in your country have effect in those regions?

3. Conversion and seniority

- a- How is conversion handled in those regions?
- b- How is seniority handled in those regions?
- c- Are there any decisions relating hereto?

4. Bilateral treaties

- a- Are there any bilateral treaties relating to trade mark law between your country and any non-EU Member States?
- b- If there are any such treaties, what do they provide for?
- c- Do they also apply to the CTM system?

5. Further trade mark issues

Are there any further trade mark issues in your country concerning the relationship between the CTM system and the trade mark system in regions or states which do not belong to the EU?



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1. Regions not or not fully belonging to the EU

a- Are there any regions in your country which do not or not fully belong to the EU?

| | |
|----------------|--|
| Austria | No |
| Belgium | No |
| Cyprus | No |
| Czech Republic | No |
| Denmark | Greenland and the Faroe Islands |
| Estonia | No |
| Finland | No. The province of Åland has a special position as to tax law but it belongs to the EU and provisions relating to inter alia trade mark law are applicable notwithstanding the autonomy status. |
| France | Yes, Saint Pierre et Miquelon |
| Germany | No |
| Greece | No |
| Hungary | No |
| Ireland | No |
| Italy | No. However, historically, Italy always had close relations with two minor independent regions: the Republic of San Marino and the Vatican City. These nations are not part of the EU but have a very close relation, socially and commercially speaking, with Italy. |
| Latvia | No |
| Lithuania | No |
| Luxembourg | No |
| Malta | No |
| Netherlands | Yes. The Kingdom of the Netherlands comprises The Netherlands, The Netherlands Antilles and Aruba. Only the Netherlands are member to the EU. |
| Poland | No |
| Portugal | No |
| Slovakia | No |
| Spain | No |
| Sweden | No |
| United Kingdom | Strictly speaking the United Kingdom comprises England, Scotland, Wales and Northern Ireland. Therefore in the UK there are no regions which do not fully belong to the EU. UK registrations also cover the British Indian Ocean Territory, the British Antarctic Territory, The Falkland Islands (Malvinas), Gibraltar and the Pitcairn Islands ("the overseas territories"), although none of these is constitutionally part of the UK. The Isle of Man and the Channel Islands (the Bailiwick of Jersey and the Bailiwick of Guernsey) are federated with the UK. They are not part of the EU. UK trade mark registrations extend to the Isle of Man. |



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1.1. Regions not or not fully belonging to the EU

b- Do CTMs have effect in those regions?

| | |
|----------------|--|
| Austria | Not applicable |
| Belgium | Not applicable |
| Cyprus | Not applicable |
| Czech Republic | Not applicable |
| Denmark | No |
| Estonia | No |
| Finland | Yes |
| France | No |
| Germany | Not applicable |
| Greece | Not applicable |
| Hungary | Not applicable |
| Ireland | Not applicable |
| Italy | There are no explicit provisions in any of these countries' laws stating that CTMs have effect also in the Republic of San Marino or in the Vatican City. Therefore, a clear and unequivocal interpretation of the protection of CTMs cannot be given. As far as Vatican City is concerned, the "acta apostolicae sedis", as the prior "Law on sources of Law", states that the Vatican State shall apply Italian legislation that is in force at the date of the law's signature. Hence, since the "acta apostolicae sedis" was signed in 1995, a wide interpretation of this provision infers that the EU Regulation 40/94 regarding Community trade marks is also included in that provision. As for the Republic of San Marino, even if following a literal interpretation, the legislative texts only seem to refer to the national trade marks. Article 43 of the previous "Agreement of Amity and Good Neighbourhood" states that "the trade marks registered and protected" in the two countries are mutually recognized. Therefore, depending on the case and on the interpretation of the provision, on the one hand, if we consider the registration in Italy as a basic requirement for mutual protection, CTMs should not have any effect in the Republic of San Marino, while, on the other hand, since a CTMs are protected in Italy, they should be protected in San Marino as well. |
| Latvia | Not applicable |
| Lithuania | Not applicable |
| Luxembourg | Not applicable |
| Malta | Not applicable |
| Netherlands | No, CTMs have effect in neither The Netherlands Antilles nor Aruba. |
| Poland | Not applicable |
| Portugal | Not applicable |
| Slovakia | Not applicable |
| Spain | Not applicable |
| Sweden | Not applicable |

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| United Kingdom | In the Isle of Man, a CTM has effect. In Jersey, CTMs are recognized and are given effect internally although this domestic law cannot actually extend the CTM territorially. In Guernsey, a registration corresponding to a CTM can be obtained by means of a separate application based upon it. |
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2. In which parts is the exam divided?

(specify which parts the examination consists, i.e. oral, practical case, written test)

| | |
|----------------|--|
| Austria | No |
| Belgium | No |
| Cyprus | No |
| Czech Republic | No |
| Denmark | No |
| Estonia | No |
| Finland | No. |
| France | No |
| Germany | No |
| Greece | No |
| Hungary | No |
| Ireland | No |
| Italy | The Republic of San Marino has its own Industrial Property law since 2005. |
| Latvia | No |
| Lithuania | No |
| Luxembourg | No |
| Malta | No |
| Netherlands | The Netherlands Antilles and Aruba have their own trade mark systems. |
| Poland | No |
| Portugal | No |
| Slovakia | No |
| Spain | No |
| Sweden | No |
| United Kingdom | Jersey and Guernsey both have their own trade mark system. |



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2. Regions with their own trade mark system

b- Do national trade marks registered in your country have effect in those regions?

| | |
|----------------|---|
| Austria | Not applicable |
| Belgium | Not applicable |
| Cyprus | Not applicable |
| Czech Republic | Not applicable |
| Denmark | Not applicable |
| Estonia | Not applicable |
| Finland | Not applicable |
| France | Not applicable |
| Germany | Not applicable |
| Greece | Not applicable |
| Hungary | Not applicable |
| Ireland | Not applicable |
| Italy | The San Marino trade mark system is linked to the Italian law in accordance with the "Agreement of Amity and Good Neighbourhood", signed by the two nations in 1939 and incorporated into the new law (see Article 59(4) law of May 25, 2005, No. 79). Under this agreement, the two states mutually recognize the trade marks registered and protected in the other country. |
| Latvia | Not applicable |
| Lithuania | Not applicable |
| Luxembourg | Not applicable |
| Malta | Not applicable |
| Netherlands | No, national trade marks registered in the Netherlands have effect in neither The Netherlands Antilles nor Aruba. |
| Poland | Not applicable |
| Portugal | Not applicable |
| Slovakia | Not applicable |
| Spain | Not applicable |
| Sweden | Not applicable |
| United Kingdom | In the Channel Islands and Gibraltar not without "re-registration". In Jersey, only the owner of a UK or CTM registration may apply for registration. In Guernsey, Intellectual Property legislation enables a first registration of trade marks via the Intellectual Property Office. Trade marks registered in the UK, Europe or under the Madrid International System can also be registered at the Intellectual Property Office of the Bailiwick of Guernsey. |



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3. Conversion and seniority

a- How is conversion handled in those regions?

| | |
|----------------|--|
| Austria | Not applicable |
| Belgium | Not applicable |
| Cyprus | Not applicable |
| Czech Republic | Not applicable |
| Denmark | A national Danish trade mark application/registration which is converted from a CTM application/registration is presumably valid in Greenland and the Faroe Islands from the date of filing of the Danish application. |
| Estonia | Not applicable |
| Finland | Not applicable |
| France | If a Community trade mark application is converted into a French application, this application will be examined by the French Trade mark Office as a national application. Then, the converted trade mark will be valid in Saint Pierre et Miquelon as all the French trade marks. In case of a conversion, the trade mark is valid in Saint Pierre et Miquelon as from the registration of the French trade mark. |
| Germany | Not applicable |
| Greece | Not applicable |
| Hungary | Not applicable |
| Ireland | Not applicable |
| Italy | There are no specific legislative provisions regarding conversion for CTMs in any of the two States. |
| Latvia | Not applicable |
| Lithuania | Not applicable |
| Luxembourg | Not applicable |
| Malta | Not applicable |
| Netherlands | Not applicable |
| Poland | Not applicable |
| Portugal | Not applicable |
| Slovakia | Not applicable |
| Spain | Not applicable |
| Sweden | Not applicable |
| United Kingdom | A UK national trade mark application converted from a CTM application or registration is presumably valid in the overseas territories as defined above (except for Gibraltar). In Gibraltar and the Channel Islands a separate registration procedure would be required. |



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3. Conversion and seniority

b- How is seniority handled in those regions?

| | |
|----------------|---|
| Austria | Not applicable |
| Belgium | Not applicable |
| Cyprus | Not applicable |
| Czech Republic | Not applicable |
| Denmark | Seniority claimed from a Danish trade mark registration would not include any trade mark rights in Greenland or the Faroe Islands. |
| Estonia | Not applicable |
| Finland | Not applicable |
| France | As the territory of Saint Pierre et Miquelon was not concerned by the Community application the seniority of the Community application can probably not be claimed as far as this territory is concerned. |
| Germany | Not applicable |
| Greece | Not applicable |
| Hungary | Not applicable |
| Ireland | Not applicable |
| Italy | There are no specific legislative provisions regarding seniority in any of the two states. |
| Latvia | Not applicable |
| Lithuania | Not applicable |
| Luxembourg | Not applicable |
| Malta | Not applicable |
| Netherlands | Not applicable |
| Poland | Not applicable |
| Portugal | Not applicable |
| Slovakia | Not applicable |
| Spain | Not applicable |
| Sweden | Not applicable |
| United Kingdom | It is uncertain whether seniority claimed from a UK trade mark registration would be deemed to include any trade mark rights in the overseas territories. |



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3. Conversion and seniority

c- Are there any decisions relating hereto?

| | |
|----------------|----------------|
| Austria | Not applicable |
| Belgium | Not applicable |
| Cyprus | Not applicable |
| Czech Republic | Not applicable |
| Denmark | No |
| Estonia | Not applicable |
| Finland | Not applicable |
| France | No |
| Germany | Not applicable |
| Greece | Not applicable |
| Hungary | Not applicable |
| Ireland | Not applicable |
| Italy | No |
| Latvia | Not applicable |
| Lithuania | Not applicable |
| Luxembourg | Not applicable |
| Malta | Not applicable |
| Netherlands | Not applicable |
| Poland | Not applicable |
| Portugal | Not applicable |
| Slovakia | Not applicable |
| Spain | Not applicable |
| Sweden | Not applicable |
| United Kingdom | No |



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4. Bilateral treaties

a- Are there any bilateral treaties relating to trade mark law between your country and any non-EU Member States?

| | |
|----------------|---|
| Austria | Treaties with the former USSR, the former Republic of Yugoslavia and China (none of them of major practical relevance). |
| Belgium | No |
| Cyprus | No |
| Czech Republic | No |
| Denmark | No |
| Estonia | No |
| Finland | Yes, between Finland and Iceland respectively China and Republic of Korea (entered into force 1925; 1967 and 1979). |
| France | No |
| Germany | Yes. Many of them, however, are not particularly relevant in this respect (for example treaties on the mutual protection of trade marks or treaties on the re-establishment of trade marks in the name of German citizens which were cancelled after the second world war). |
| Greece | No |
| Hungary | No |
| Ireland | No |
| Italy | Except for the already mentioned "Agreement of Amity and Good Neighbourhood" between Italy and the Republic of San Marino, Italy has signed several bilateral agreements (with developing countries in particular) concerning economic development, which mention trade marks among the objects of the agreement. However, these are nothing more than a declaration of will without any real consequence on Italian trade mark law. |
| Latvia | No |
| Lithuania | No |
| Luxembourg | No |
| Malta | No |
| Netherlands | No |
| Poland | No |
| Portugal | Yes. At least the following bilateral treaty appears to be still in force: Agreement between Portugal and Switzerland of 16 September 1977 on protection of indications of origin, appellations of origin and similar designations. Before Portugal joined the EU, similar bilateral treaties had been signed at least with Spain (1970) and Hungary (1981). An agreement of the same type was established between Portugal and the Czechoslovakian Republic in 1986. Based on said bilateral treaty, the Supreme Court of Justice ordered the refusal of the registration of the trade mark BUDWEISER, due to the protection given to the Czech geographical name Ceskobudejovický Budvar. |

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| Slovakia | No |
| Spain | No |
| Sweden | The only treaties concerning trade marks that Sweden is a member of except for the CTM system are the Paris Convention and the Madrid Protocol. |
| United Kingdom | Special provisions apply to the islands of Grenada, St Helena, Solomon Islands, Tuvalu and Vanuatu as well as Anguilla, Antigua & Barbados, Bahamas, Bermuda, Cayman Islands, Dominica, Fiji, Gibraltar, Guyana, Kiribati, Montserrat, St Kitts & Nevis, St Lucia, Sierra Leone, Virgin Islands and Western Samoa. |



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4. Bilateral treaties

b- If there are any such treaties, what do they provide for?

| | |
|----------------|---|
| Austria | Not applicable |
| Belgium | Not applicable |
| Cyprus | Not applicable |
| Czech Republic | Not applicable |
| Denmark | Not applicable |
| Estonia | Not applicable |
| Finland | These treaties may not have any major practical relevance nowadays. |
| France | No |
| Germany | An important bilateral treaty is the treaty between Germany and Switzerland concerning the mutual protection of patents, designs and trade marks which dates from April 13, 1892 and which was amended on May 26, 1902. According to the treaty between Germany and Switzerland mentioned above, the valid use of a trade mark in the one country is considered as valid use in the other country, even if there is no use at all in the other country. Whether the use in Switzerland is actually sufficient is determined by German law. It is worth mentioning that not only German and Swiss citizens can rely on this treaty, but also the persons which are treated equally according to Articles 2 and 3 of the Paris Convention (decision of the German Federal Patent Court of November 15, 1999; I ZR 114/97; "Playboy" - BGHZ 143, 303). Citizens of the states which have signed the Paris Convention can therefore rely on use in Switzerland if they have to prove use of an international trade mark in Germany. |
| Greece | Not applicable |
| Hungary | Not applicable |
| Ireland | Not applicable |
| Italy | There are no specific provisions in relation to trade mark law. |
| Latvia | Not applicable |
| Lithuania | Not applicable |
| Luxembourg | Not applicable |
| Malta | Not applicable |
| Netherlands | Not applicable |
| Poland | Not applicable |
| Portugal | These treaties basically contain provisions for the protection of certain indications of origin, appellations of origin and similar designations on a reciprocity basis. |
| Slovakia | Not applicable |
| Spain | Not applicable |
| Sweden | Not applicable |



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| United Kingdom | In Grenada, St Helena, Solomon Islands, Tuvalu and Vanuatu, only the owner of a UK trade mark registration is allowed to register a trade mark. In Anguilla, Antigua & Barbados, Bahamas, Bermuda, Cayman Islands, Dominica, Falkland Islands, Fiji, Gibraltar, Guyana, Kiribati, Montserrat, St Kitts & Nevis, St Lucia, Sierra Leone, Virgin Islands and Western Samoa, in addition to local registration, it is possible to apply for a registration based on a UK trade mark. Such applications can be made at any time during the life of the UK trade mark. The registrations expire with the UK trade mark. |
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4. Bilateral treaties

c- Do they also apply to the CTM system?

| | |
|----------------|--|
| Austria | Probably not |
| Belgium | Not applicable |
| Cyprus | Not applicable |
| Czech Republic | Not applicable |
| Denmark | Not applicable |
| Estonia | Not applicable |
| Finland | Because the treaties were concluded before Finland became a Member State of the European Community and a significant number of years before the Community trade mark system and Madrid Protocol came into force, these treaties do not contain any provision in this respect, neither have these bilateral treaties been updated in this respect. Therefore these treaties may not be considered to have any major practical relevance nowadays. |
| France | Not applicable |
| Germany | Probably not because according to the principles of Public International Law, bilateral treaties only bind the countries which have signed it. This view is shared by the law books which state that the treaty mentioned above does not apply to the question of use of Community trade marks in Germany (Sack FS Piper 1996, p. 624; Ingerl/Rohnke, § 26 para.149). They argue that the principles of use which have been established for the Community trade mark are not subject to the disposition of the Member States by way of bilateral treaties. |
| Greece | Not applicable |
| Hungary | Not applicable |
| Ireland | Not applicable |
| Italy | Not applicable |
| Latvia | Not applicable |
| Lithuania | Not applicable |
| Luxembourg | Not applicable |
| Malta | Not applicable |
| Netherlands | Not applicable |
| Poland | Not applicable |
| Portugal | This will depend on the rule in question. We are not aware of any court judgement deciding or elaborating on this specific question. |
| Slovakia | Not applicable |
| Spain | Not applicable |
| Sweden | Not applicable |
| United Kingdom | Not applicable |



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5. Further trade mark issues

Are there any further trade mark issues in your country concerning the relationship between the CTM system and the trade mark system in regions or states which do not belong to the EU?

| | |
|----------------|--|
| Austria | No |
| Belgium | No |
| Cyprus | No |
| Czech Republic | No |
| Denmark | No |
| Estonia | No |
| Finland | No |
| France | <p>In France, there are two kinds of overseas regions :</p> <p>1. DOM (overseas departments): Guadeloupe, Martinique, Guyana, Reunion). They automatically belong to the EU.</p> <p>2. TOM (overseas territories): French Polynesia, Wallis & Futuna, French Austral and Antarctic territories, New Caledonia and Mayotte. These territories were out of the CTM system until 2001. Now, the CTM system is valid in these territories.</p> <p>Saint Pierre et Miquelon used to have the status of an EU ultra-outlying region until 2001 and therefore was included in the EU. Now, the status of Saint Pierre et Miquelon has changed and it no longer belongs to the EU.</p> |
| Germany | No |
| Greece | No |
| Hungary | No |
| Ireland | No |
| Italy | No |
| Latvia | No |
| Lithuania | No |
| Luxembourg | No |
| Malta | No |
| Netherlands | No |
| Poland | No |
| Portugal | No |
| Slovakia | No |
| Spain | Spain does not have any regions which do not belong to the EU and therefore there are no trade mark issues to deal with. The only country with a close relation with Spain is Andorra, but there are no bilateral treaties or particularities regarding trade marks. |
| Sweden | No |
| United Kingdom | No |