



European Communities Trade Mark Association

Survey on the Calculation of the Starting Date for the 5 Years Use Requirement

A Survey conducted by the ECTA Harmonization Committee

This survey deals with the interesting question which date is decisive in the various Member States for the start of the use requirement.

We know that the five years use requirement is imbedded in the Community Regulation.

However, the date upon which one must rely for the starting date is not always easy to determine, especially for national trade marks which have been filed through the international Madrid system.

The European Court of Justice (ECJ) has dealt with this question in its decision dated 14 June 2007, Case C-246/05. According to the ECJ there is no general rule to calculate such a date. It rather depends on each country because the question of the starting date has not been harmonized within the Directive.

This starting date is rather difficult to establish. Furthermore the practice has changed throughout the years, for instance due to the fact that some countries (recently the Benelux) have decided to make a statement of grant of protection in relation to international trade marks.

The purpose of this survey is to set out the rules for establishing the relevant dates as well as the way to calculate and to find them. These rules are not only explained in relation to direct national trade marks, but also for trade marks filed through the international Madrid System. There are contributions from nearly all Member States of the European Union.

In order to give a first overview of the topic, the survey starts with reflecting the various questions and a short summary of the answers thereto. The second part contains detailed answers for the Member States in alphabetic order.

There are contributions from nearly all Member States of the European Union, except for Bulgaria, Lithuania and Slovakia which are currently not represented in the Harmonization Committee.

The Harmonization Committee hopes that this survey serves all colleagues in need of information as to when the use requirement starts in particular Member States of the European Union.



European Communities Trade Mark Association

Thanks to everybody who participated in compiling this survey, especially Ms. Riina Pärn who kindly provided answers for Estonia which is currently not officially represented in the Harmonization Committee.

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Vice Chair of the Harmonization Committee

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European Communities Trade Mark Association

Questionnaire:

1. Which date is generally decisive for the start of the 5 year's use requirement in your country?

a) Direct national trade marks

b) Trade marks filed through the Madrid system (IR marks)

2. Which provisions in your national laws deal with this issue?

a) Direct national trade marks

b) Trade marks filed through the Madrid system (IR marks)

3. Is a different date decisive if there have been any official refusals or oppositions by third parties?

a) Direct national trade marks

b) Trade marks filed through the Madrid system (IR marks)

4. Are there any further particularities with regard to the calculation of the 5 year's use requirement in your country?

a) Direct national trade marks

b) Trade marks filed through the Madrid system (IR marks)

5. Are there any national court decisions dealing with the issue of calculation?

a) Direct national trade marks

b) Trade marks filed through the Madrid system (IR marks)

6. Have there been any different rules in the past?

a) Direct national trade marks



European Communities Trade Mark Association

b) Trade marks filed through the Madrid system (IR marks)

1. Which date is generally decisive for the start of the 5 year's use requirement in your country?

a) Direct national trade marks

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| Austria | The registration date (starting date of the period). |
| Benelux | The registration date. |
| Bulgaria | ----- |
| Cyprus | The date of the registration of the Trade Mark in Cyprus. |
| Czech Republic | The registration date. |
| Denmark | The date of termination of the registration procedure, i.e. 2 months and 5 years after publication provided that no oppositions are filed. |
| Estonia | The registration date. |
| Finland | The registration date. |
| France | The date of publication of its registration in the official bulletin (BOPI). |
| Germany | The date of the (preliminary) registration of the mark with the German PTO. |
| Great Britain | The date of completion of the registration procedure. |
| Greece | The registration date. |
| Hungary | The registration date. |
| Ireland | The five-year non-Use period runs from completion of the registration procedure, which the Trade Mark Act 1996 describes as the date of publication of the registration. This should correspond to the time that certificate of registration issues but may be earlier. |
| Italy | The registration date. |
| Latvia | The registration date. |
| Lithuania | ----- |
| Malta | The date of publication of the registered mark in the Government Gazette. However, there is no case law on this matter. |
| Poland | The registration date. |



European Communities Trade Mark Association

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| Portugal | The date of the definitive grant of the registration (in practical terms, date of grant). |
| Romania | The date of the publication of registration. However, the effective date from which the 5 years are counted is not specified in any legal provision. Therefore, the starting date is interpretable. |
| Slovak Republic | ----- |
| Slovenia | The registration date. |
| Spain | The date of publication of the granting. |
| Sweden | The registration date. |

1. Which date is generally decisive for the start of the 5 year's use requirement in your country?

b) Trade marks filed through the Madrid system (IR marks)

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|-----------------------|--|
| Austria | The date of the registration at the International Bureau of WIPO. |
| Benelux | The date of the publication of WIPO in the WIPO Gazette of the statement of grant of protection issued by the BNL Office. |
| Bulgaria | ----- |
| Cyprus | The date of the notification in Cyprus. |
| Czech Republic | The date of the registration at the International Bureau of WIPO. |
| Denmark | Termination of the registration procedure, i.e. 2 months and 5 years after publication provided that no opposition are filed. |
| Estonia | The date of granting the legal protection in Estonia. Based on the mentioned provision of the Estonian Trade Mark Act and based on the European Court decision of 14 June 2007 in Case C-256/05 where the Court has come to the conclusion that the date of the completion of the registration procedure must be determined in each Member State in accordance with the procedural rules on registration in force in that State, "the date of granting the legal protection" in Estonia should be regarded as the date the registration procedure for the International trade mark is terminated in Estonia, i.e., 2 months after publication of the trade mark on the condition that no opposition is filed. |
| Finland | The date of legal force in Finland (in principle the registration date but it may be even a later point of time when the Trade Marks Office confirms the designation valid in Finland due to e.g. opposition procedures etc.). |
| France | In the absence of total or partial provisional refusal of protection: 4 |



European Communities Trade Mark Association

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| | <p>months after the notification of the IR mark to the French authorities or, if it is later, the date of expiration of the opposition term. The latter is calculated as follows: it starts with the 1st day of the month following the receipt of the WIPO Gazette at the French PTO and ends 2 months later.</p> <p>The date of recordal of the total or partial protection in France at the international register.</p> |
| Germany | The date of expiration of the 12 months period set forth in Art. 5(2) Madrid Agreement, i.e. the date of the international registration plus 12 months. |
| Great Britain | The date of the protected international trade mark (UK) becoming protected in the UK. |
| Greece | The date of the registration at the International Bureau of WIPO. |
| Hungary | The day following the expiry of the 12/18 month term (Agreement/Protocol) available for the Hungarian Patent Office (HPO) to issue a temporary refusal. |
| Ireland | The date of the publication of protection. |
| Italy | The date of the registration at the International Bureau of WIPO of the Italian designation in case of the subsequent designation. |
| Latvia | <p>The date of the international trade mark's legal force in Latvia.</p> <p>The Patent Office examines internationally registered trade marks to ascertain their compliance with requirements of Article 6 (Absolute Grounds for Refusal and Invalidation of Trade Mark Registration) and Article 8 (Well-known Trade Marks as Grounds for Refusal and Invalidation of Trade Mark registration) of the Law on Trade Marks and Geographical Indications. Opposition to the entry into effect of an international registration of a trade mark in Latvia may be filed within 4 months from the date of publication of a notice of trade mark registration with respect of Latvia (territorial extension to the Republic of Latvia) in the Official Gazette of international registration of trade marks. Within 3 months from the date of receipt of the provisional refusal the owner of the international registration is entitled to submit an appeal (a reply to opposition).</p> |
| Lithuania | ----- |
| Malta | Not applicable as Malta is not party to the Madrid system. |
| Poland | The date of publication of the trade mark registration in Poland in Official Journal of the Polish Patent Office after the examination by the examiner in Polish Patent Office. |
| Portugal | The date of the registration at the International Bureau of WIPO (in practical terms, date of the application). |



European Communities Trade Mark Association

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| Romania | Publication of the Registration or counting 12 months from WIPO's notification (just in case that no refusal was issued). However, the effective date from which the 5 years are counted is not specified in any legal provision. Therefore the starting date is interpretable. |
| Slovak Republic | ----- |
| Slovenia | The date of entry of the right in the register. |
| Spain | The date of the publication of the granting. |
| Sweden | The date of legal force in Sweden. |

2. Which provisions in your national laws deal with this issue?

a) Direct national trade marks

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|----------------|---|
| Austria | Section 33a of the Trade Marks Protection Act. |
| Benelux | Article 2.2 of the Benelux IP Convention. |
| Bulgaria | ----- |
| Cyprus | Articles 28 and 28A of the Trade Marks Law of Cyprus, Chapter 268. |
| Czech Republic | Section 13, paragraph 1 of Trade Mark Act No. 441/2003 Coll. (Collection of Law). |
| Denmark | Section 25 of the Danish Trade Marks Act. |
| Estonia | Article 53(1)(3) of the Trade Mark Act (stating the ground for filing the cancellation action on the basis of non-use). |
| Finland | Section 26 paragraph 2 of the Trade Marks Act (7/1964) . |
| France | Article R. 712-23 of the Industrial Property Code. |
| Germany | Sections 25, 43 (1) and 26(5) of the German Trade Marks Act. |
| Great Britain | Section 46(1)(a) of the Trade Marks Act 1994. |
| Greece | Article 17 paragraphs a and b of the Trade Mark Law Number 2239/1994. |
| Hungary | Article 18 of the Trade Marks Act. |
| Ireland | Section 51 of the Irish Trade Marks Act 1996 and Rule 41 of the Trade Mark rules, 1996, deal with Revocation of a registered Trade Mark due to non-use. |
| Italy | Article 24 of the Italian Trade Mark Law. |
| Latvia | Article 23 of the Law on Trade Marks and Indications of Geographical Indications. |
| Lithuania | ----- |



European Communities Trade Mark Association

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| Malta | Section 42 of the Trade Marks Act. |
| Poland | Article 169.1.1 of the Law on Industrial Property. |
| Portugal | Article 268 Number 4 and Article 269 Number 1 of the Industrial Property Code. |
| Romania | Law Number 84/1998, Article 45 paragraph 1. |
| Slovak Republic | ----- |
| Slovenia | Article 120 of the Slovenian IP Act . |
| Spain | Article 39 of the Trade Marks Law. |
| Sweden | Trade Mark Law Number 1960:644 paragraph 25 a. |

2. Which provisions in your national laws deal with this issue?

b) Trade marks filed through the Madrid system (IR marks)

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|----------------|---|
| Austria | Section 32(2) of the Trade Marks Protection Act in connection with Section 33 of the Trade Marks Protection Act. |
| Benelux | Article 2.2 of the Benelux IP Convention and Article 1.8 of the implementation regulations. |
| Bulgaria | ----- |
| Cyprus | Article 28 and 28a of the Trade Marks Law of Cyprus, Chapter 268. |
| Czech Republic | Section 13, paragraph 1 of the Trade Mark Act Number. 441/2003 Coll. (Collection of Law). |
| Denmark | Section 51 of Section 25 of the Danish Trade Marks Act. |
| Estonia | Article 53(1)(4) of the Trade Mark Act (stating the ground for filing the cancellation action on the basis of non-use). |
| Finland | Trade Marks Act (7/1964) Section 26 paragraph 2 and Section 56e. |
| France | Article R. 712-23 CPI. |
| Germany | Sections 115(2), 116 and 117 of the German Trade Marks Act. |
| Great Britain | Article 13(2) of the Trade Marks (International Registration) Order 1996, as amended by various subsequent statutory instruments. |
| Greece | Article 17 paragraph a and b of Trade Mark Law No. 2239/1994. |
| Hungary | Article 76/N (7) of the Trade Marks Act. |
| Ireland | Section 58-59 of the Irish Trade Marks Act, 1996, deals with Madrid Protocol Marks. WIPO'S Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol can be used as guidelines. |
| Italy | Article 24 of the Italian Trade Mark Law. |
| Latvia | Articles 37 and 23 of the Law on Trade Marks and Indications of |



European Communities Trade Mark Association

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| | Geographical Indications. |
| Lithuania | ----- |
| Malta | Not applicable as Malta is not party to the Madrid system. |
| Poland | Article 1528 of the Law on Industrial Property which refers to Article 169.1.1. |
| Portugal | Articles 268 Number 4 and 269 Number 5 of the Industrial Property Code. |
| Romania | Article 45 paragraph 1 of the Law number 84/1998. |
| Slovak Republic | ----- |
| Slovenia | Article 120 of the Slovenian IP Act. |
| Spain | Article 39 of the Trade Marks Law. |
| Sweden | Trade Mark Law Number 1960:644, paragraph 25 a. |

3. Is a different date decisive if there have been any official refusals or oppositions by third parties?

a) Direct national trade marks

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|----------------|--|
| Austria | No. |
| Benelux | No. |
| Bulgaria | ----- |
| Cyprus | No. |
| Czech Republic | No. |
| Denmark | 5 years from the date of the final opposition decision, or 5 years from the final appeal decision or final court decision. The date is not published but must be calculated. However the Danish Trade Mark usually issues an official confirmation of the date of termination of the registration procedure. |
| Estonia | No. |
| Finland | No. However, there may still be space for interpretation. |
| France | No. |
| Germany | Where an opposition has been lodged against the preliminary registration of a German Trade Mark, the decisive date for the start of the 5 years use requirement is the date of completion of the opposition procedure, Art. 26 (5) German Trade Marks Act. The date of completion of the opposition procedure is recorded in the Register and published later on, Section 25 No. 22 lit. b and Section 28(1) Marken V (Regulation on the execution of the Trade Marks Act). The decisive date can thus be verified easily. |



European Communities Trade Mark Association

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| Great Britain | No difference with direct national trade marks, as the decisive date is the date of completion of the registration procedure. The registration procedure is not complete until any official refusals and oppositions have been resolved. The date of completion of the registration is published in the register. |
| Greece | No. |
| Hungary | No. |
| Ireland | No. |
| Italy | No. |
| Latvia | No. |
| Lithuania | ----- |
| Malta | No. |
| Poland | No. |
| Portugal | No. |
| Romania | Yes. Any definitive decision in respect with the final registration of the Trade Mark (they are all published in the National Bulletin). |
| Slovak Republic | ----- |
| Slovenia | No. |
| Spain | No. As the obligation starts only with the publication of the granting, there is no need for a difference. |
| Sweden | No. |

3. Is a different date decisive if there have been any official refusals or oppositions by third parties?

b) Trade marks filed through the Madrid system (IR marks)

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|----------------|---|
| Austria | No. |
| Benelux | The date of the publication of WIPO in the WIPO Gazette of the statement of lifting of the refusal issued by the Benelux Office. If different grounds for refusal were applicable and they have been lifted at different moments, the last publication by WIPO in the WIPO Gazette of the statement of the lifting of the refusal of the Benelux Office counts as date of registration. |
| Bulgaria | ----- |
| Cyprus | No. |
| Czech Republic | No. |
| Denmark | The date of the final opposition decision or the date of the final appeal or |



European Communities Trade Mark Association

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| | <p>court decision. The date is not published but must be calculated. However the Danish Trade Mark usually issues an official confirmation of the date of termination of the registration procedure.</p> |
| Estonia | <p>The International mark is published for the opposition purposes after the conclusion of the examination procedure, therefore, any official refusals do not affect the starting date as mentioned hereinabove in point 1(b). However, the oppositions by third parties affect the starting date, since the date of granting the legal protection for the International mark in Estonia is decisive, i.e., as a result of the opposition procedure in favour of the owner of the International mark, the International registration is granted protection only once the decision of the opposition becomes effective (provided that no appeals are filed), i.e., the date which is decisive while calculating the start of the five-year use requirement period.</p> <p>The register does not publish the date when the opposition decision comes into effect. The publication date of the International Registration and the note of contesting if the opposition procedure is pending may be only viewed in the register. Once the opposition procedure is terminated and the decision is made in favour of the owner of the International Registration accepting to register the International mark in Estonia, the register does not reflect any more the note of contesting nor does it reflect the note that the trade mark was ever under the opposition procedure. Therefore, the separate request addressed to the register would help to verify the issue if any opposition was filed, and would help to specify which date is actually decisive for the start of the five-year use requirement period (since the date may vary if any opposition was filed or not).</p> |
| Finland | No. However, there may still be space for interpretation. |
| France | No. |
| Germany | <p>In place of the dates of the preliminary registration or the date of the actual completion of the opposition proceedings, the decisive dates in respect of IR marks filed through the Madrid system are as follows:</p> <p>(I) Generally, the time limit set forth in Art. 5 (2) of the Madrid Agreement (to give notice of a refusal of protection to the International Bureau) of one 12 months from the date of the international registration or of the request for extension of protection made in accordance with Article 3ter is relevant for the calculation of the starting date for the 5 years use period. The 5 years use period is calculated from the expiry date of the 12 months period in Art. 5(2) Madrid Agreement, Art. 115 (2) German Trade Marks Act. In practise, this means that the holder of an IR extending to German can usually rely on a 6-year term following the date of the international registration within which to put the mark into use in</p> |



European Communities Trade Mark Association

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| | <p>Germany.</p> <p>(II) In cases where proceedings before the German PTO for reason of absolute grounds for refusal or opposition proceedings are still pending after expiry of the 12 months notification period in Art. 5(2) Madrid Agreement, the “decisive date” for the beginning of the 5 years use period is shifted to the date of receipt of the German PTO’s final notification concerning the grant of protection by the International Bureau, Section 115 (2) German Trade Marks Act – cf. German Federal Supreme Court (BGH) GRUR 1995, 583 – MONTANA.</p> <p>(III) As to former GDR Trade Marks and international trade marks designating the territory of the former GDR which were registered either with the former PTO of the GDR or internationally before the accession of the GDR-territory to the Federal Republic of Germany, the 5 years use period commenced on October 3, 1990 in respect of these marks, see Section 10 of the annex to the Reunification Treaty.</p> |
| Great Britain | <p>The date on which marks filed through the Madrid system become protected is as follows:</p> <p>(I) In cases where the period of 18 months from the date on which the notification of the request for extension was sent to the United Kingdom expires without any notice of provisional refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period, the trade mark which is the subject of the request for protection shall be protected as a protected international trade mark (UK) on the expiry of that 18 month period (see Article 12(1) of the Trade Marks (International Registration) Order 1996 as amended by Articles 9(1) and (2) of the Trade Marks (International Registration)(Amendment) Order 2002).</p> <p>(II) Subject to paragraph (i) above, in cases where particulars of an international registration have been published in the UK in respect of all or some of the goods or services comprised in the international registration and the period for giving notice of opposition expires without notice of opposition having been given in respect of any of the goods or services specified in the notice published and without notice of refusal not based on an opposition having been given and not withdrawn, the trade mark which is the subject of the international registration in question shall thereupon be protected as a protected international trade mark (UK) in respect of those goods or services (see Article 12(1A) of the Trade Marks (International Registration) Order 1996 as amended by Articles 9(1) and (2) of the Trade Marks (International Registration)(Amendment) Order 2002).</p> <p>(III) Subject to paragraph (i) above, where particulars of an international registration have been published in respect of all or some of the goods or services comprised in the international registration and on expiry of the</p> |



European Communities Trade Mark Association

period for giving notice of opposition notice of opposition has been given in respect of some only of the goods or services specified in the notice published and no notice of refusal not based on an opposition has been given and not withdrawn in respect of the remaining goods or services specified in that notice, the trade mark which is the subject of the international registration in question shall thereupon be protected as a protected international trade mark (UK) in respect of those remaining goods or services (see Article 12(1B) of the Trade Marks (International Registration) Order 1996 as amended by Articles 9(1) and (2) of the Trade Marks (International Registration)(Amendment) Order 2002).

(IV) Subject to paragraph (i) above, where particulars of an international registration have been published in respect of all or some of the goods or services comprised in the international registration and within the period for giving notice of opposition notice of opposition has been given in respect of all or some of the goods or services specified in the notice published but subsequently a final decision is made that the notice of provisional refusal given as a result of that opposition is notice of provisional refusal given as a result of that opposition is withdrawn, or is withdrawn in respect of some of the goods or services in respect of which protection in the United Kingdom has been requested, the trade mark which is the subject of the international registration in question shall thereupon be protected as a protected international trade mark (UK) in respect of the goods or services specified in the notice published other than those in respect of which a notice of refusal (whether based on an opposition or otherwise) continues to subsist. For these purposes a final decision shall be regarded as being made where the registrar, or the appointed person or the court on appeal or further appeal from the registrar, decides whether the refusal shall be upheld, in whole or in relation to some only of the goods or services in relation to which protection in the United Kingdom is requested, and any right of appeal against that decision expires or is exhausted. See Articles 12(1C) and 12(1D) of the Trade Marks (International Registration) Order 1996 as amended by Article 9(1) of the Trade Marks (International Registration)(Amendment) Order 2002).

When a trade mark becomes protected pursuant to the above, the registrar in the UK is supposed to publish a notice which includes the number of the international registration in respect of that trade mark and the date on which protection is conferred (See Articles 12(3) of the Trade Marks (International Registration) Order 1996 as amended by Articles 9(1) and (3) of the Trade Marks (International Registration)(Amendment) Order 2002). However, as a matter of practice, the date on which protection is conferred in the United Kingdom is not included as a specific entry on the



European Communities Trade Mark Association

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| | register. |
| Greece | No. |
| Hungary | Yes. The date of the Hungarian Patent Office's resolution withdrawing the temporary refusal or issuing only a partial final refusal. This date is published in the register. |
| Ireland | The date of publication of the registration is the decisive date. |
| Italy | No. |
| Latvia | No. |
| Lithuania | ----- |
| Malta | Not applicable as Malta is not party to the Madrid system. |
| Poland | No. |
| Portugal | No. However, it may happen that after the period of five years has elapsed counted from the date of the international Trade Mark (application), the latter has not yet been the subject of a definitive decision in Portugal, in view of the fact that a judicial appeal is still pending. Although it can be argued whether or not this fact constitutes a just reason for the non-use of the mentioned Trade Mark in Portugal, this situation is not provided for by law. |
| Romania | Yes. Publication of the final notification attesting the registration (verified in WIPO's database and official bulletin). |
| Slovak Republic | ----- |
| Slovenia | No. |
| Spain | No. As the obligation starts only with the publication of the granting, there is no need for a difference. |
| Sweden | No. |

4. Are there any further particularities with regard to the calculation of the 5 year's use requirement in your country?

a) Direct national trade marks

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| Austria | The trade mark owner can not avoid the cancellation of his trade mark if use is commenced after the expiry of the five years period, but before the application for revocation is made, providing that the applicant informed the trade mark owner about the non-use of the relevant trade mark or the trade mark owner relied on his trade mark against the applicant and the application for revocation is filed within 3 months thereafter. |
| Benelux | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the |



European Communities Trade Mark Association

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| | filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Bulgaria | ----- |
| Cyprus | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Czech Republic | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Denmark | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Estonia | The registration of a trade mark shall not be cancelled on the basis of non-use if the use is commenced after the expiry of the five-year period and prior to filing of the action. Any such commencement of use of the mark shall be disregarded if the use of the mark is commenced after the end of the five-year period and within three months prior to filing of the action and if the owner of the mark commenced preparations for the use of the mark only after the owner became aware of the intention of filing the action (Articles 53(2) and 53(3) of the Trademark Act). |
| Finland | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| France | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Germany | The registration of a Trade Mark shall not be revoked on non-use grounds if use is commenced or resumed after the expiry of the five year period and before the application for revocation is made PROVIDED THAT any such commencement or resumption of use after the expiry of the five year |



European Communities Trade Mark Association

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| | period but within the period of three months before the making of an application for revocation shall be disregarded unless preparations for the commencement or resumption have begun before the proprietor became aware that an application for revocation on grounds of non-use might be made, see Section 49(1) German Trade Marks Act. |
| Great Britain | The registration of a trade mark shall not be revoked on non-use grounds if use is commenced or resumed after the expiry of the five year period and before the application for revocation is made PROVIDED THAT any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made (see Section 46(3) Trade Marks Act 1994. |
| Greece | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Hungary | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Ireland | Article 12 of the Harmonisation Directive does apply in its entirety. Use three months prior to application for cancellation is discounted where preparations for the commencement of resumption occur only after the proprietor becomes aware that the application for revocation may be filed. |
| Italy | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Latvia | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Lithuania | ----- |
| Malta | Cancellation of a trade mark on the basis of non-use is possible if use is |



European Communities Trade Mark Association

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| | commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Poland | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Portugal | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Romania | The preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated, within 3 months prior to the filing of the cancellation: The cancellation is possible; the use is not taken into consideration. |
| Slovak Republic | ----- |
| Slovenia | No. |
| Spain | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Sweden | In Sweden it is possible to cancel a trade mark if the trade mark holder commences use after the use of the five year period but within three months before the cancellation action, if the trade mark holder has commenced use of the mark because he became aware that a cancellation action was about to be filed. |

4. Are there any further particularities with regard to the calculation of the 5 year's use requirement in your country?

b) Trade marks filed through the Madrid system (IR marks)

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| Austria | The trade mark owner can not avoid the cancellation of his trade mark if use is commenced after the expiry of the five years period, but before the application for revocation is made, providing that the applicant informed the trade mark owner about the non-use of the relevant trade mark or the trade mark owner relied on his trade mark against the applicant and the |
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European Communities Trade Mark Association

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| | application for revocation is filed within 3 months thereafter. |
| Benelux | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Bulgaria | ----- |
| Cyprus | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Czech Republic | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Denmark | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced before the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Estonia | The registration of a trade mark shall not be cancelled on the basis of non-use if the use is commenced after the expiry of the five-year period and prior to filing of the action. Any such commencement of use of the mark shall be disregarded if the use of the mark is commenced after the end of the five-year period and within three months prior to filing of the action and if the owner of the mark commenced preparations for the use of the mark only after the owner became aware of the intention of filing the action (Articles 53(2) and 53(3) of the Trade Mark Act). |
| Finland | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| France | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Germany | Same as above, see Sections 107, 49 (1) German Trade Marks Act. |



European Communities Trade Mark Association

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| | However, the start of the 5 years non-use period is calculated in accordance with Section 115(2) German Trade Marks Act. |
| Great Britain | As above per direct national trade marks (see Article 13 of Trade Marks (International Registration) Order 1996, as amended by various subsequent statutory instruments). |
| Greece | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Hungary | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Ireland | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Italy | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Latvia | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Lithuania | ----- |
| Malta | Not applicable as Malta is not party to the Madrid system. |
| Poland | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Portugal | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a |



European Communities Trade Mark Association

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| | cancellation action might be initiated. |
| Romania | The preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated, within 3 months prior to the filing of the cancellation: The cancellation is possible; the use is not taken into consideration. |
| Slovak Republic | ----- |
| Slovenia | No. |
| Spain | Cancellation of a trade mark on the basis of non-use is possible if use is commenced after the five years period and within 3 months prior to the filing of the cancellation action, provided that the preparations for use commenced after the trade mark owner became aware of the fact that a cancellation action might be initiated. |
| Sweden | In Sweden it is possible to cancel a trade mark if the trade mark holder commences use after the use of the five year period but within three months before the cancellation action, if the trade mark holder has commenced use of the mark because he became aware that a cancellation action was about to be filed. |

5. Are there any national court decisions dealing with the issue of calculation?

a) Direct national trade marks

| | |
|----------------|---|
| Austria | The case on which ECJ-246/05 was based is still pending. |
| Benelux | No. |
| Bulgaria | ----- |
| Cyprus | No. |
| Czech Republic | No. |
| Denmark | No. |
| Estonia | No. |
| Finland | None aware of. |
| France | Earlier court decisions were integrated in the Intellectual Property Code by the decree Number 2004-199 of February 25, 2004. |
| Germany | None aware of, but the date is clear from the legislation. |
| Great Britain | None aware of, but the date is clear from the legislation. |
| Greece | No. |
| Hungary | No. |



European Communities Trade Mark Association

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| Ireland | No. |
| Italy | No. |
| Latvia | No. |
| Lithuania | ----- |
| Malta | No. |
| Poland | No. |
| Portugal | No. |
| Romania | Since the Romanian Law does not contain certain provisions regarding the moment from which the period of five years non-use starts, the Court practice is unitary regarding this issue. However, the mainly opinion in Court's decisions is that the term must be counted from the date when a definitive decision in respect with the final registration of the Trade Mark is issued. This is also the proposed calculation mentioned in the amended TM Law project. |
| Slovak Republic | ----- |
| Slovenia | No. |
| Spain | There have been some surprising interpretations of the dies a quo, e.g. calculating as of the date of renewal, of change of ownership. All specialised authors agree, however, on the fact that such decisions (passed by non-specialised courts, before Spain had them) are wrong. |
| Sweden | None aware of. |

5. Are there any national court decisions dealing with the issue of calculation?

b) Trade marks filed through the Madrid system (IR marks)

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| Austria | OPM (Supreme Patent and Trade Mark Board) of 9 February, 2005 (Om 20/04) and ECJ C246/05 (preliminary ruling of 14 June 2007). In addition, the case on which ECJ-246/05 was based is still pending. |
| Benelux | No. |
| Bulgaria | ----- |
| Cyprus | No. |
| Czech Republic | None aware of. |
| Denmark | No. |
| Estonia | No. |
| Finland | None aware of. |



European Communities Trade Mark Association

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| France | Earlier court decisions were integrated in the Intellectual Property Code by the decree Number 2004-199 of February 25, 2004. |
| Germany | See 3 b ii) above. |
| Great Britain | None aware of. |
| Greece | No. |
| Hungary | No. |
| Ireland | No. |
| Italy | No. |
| Latvia | No. |
| Lithuania | ----- |
| Malta | Not applicable. |
| Poland | Case Number VI SA/ Wa 2180/05. |
| Portugal | No. |
| Romania | Since the Romanian Law does not contain certain provisions regarding the moment from which the period of five years non-use starts, the Court practice is not unitary regarding this issue. However, the main opinion in Court's decisions is that the term must be counted from the date when a definitive decision in respect with the final registration of the Trade Mark is issued. This is also the proposed calculation mentioned in the amended TM Law project. |
| Slovak Republic | ----- |
| Slovenia | No. |
| Spain | There have been some surprising interpretations of the dies a quo, e.g. calculating as of the date of renewal or change of ownership. All specialised authors agree, however, on the fact that such decisions (passed by non-specialised courts, before Spain had them) are wrong. |
| Sweden | None aware of. |

6. Have there been any different rules in the past?

a) Direct national trade marks

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| Austria | The 5 years use requirement was first introduced in Austria in 1977 and become applicable 5 years thereafter. Prior to 1977 no use requirement for trade marks existed. |
| Benelux | Before January 1, 2004 the date taken into account was the filing date. Use had to start within 3 years after filing and should not be stopped for |



European Communities Trade Mark Association

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| | an uninterrupted period of 5 years. |
| Bulgaria | ----- |
| Cyprus | No. |
| Czech Republic | Not recently. |
| Denmark | No. |
| Estonia | No. |
| Finland | None aware of. |
| France | Before the entering into force of the harmonized Law (December 28, 1991) instituting opposition proceedings, the date taken into account was the filing date. |
| Germany | The 5 years use requirement was first introduced in German law in 1967 by way of a revision of the then Warenzeichengesetz (WZG – Old German Trade Marks Law dating back to 1894) and the introduction of the new Sections 5(7) and 11(1) No. 4 WZG. Before 1967 there was no “use requirement” for Trade Marks (Warenzeichen) in German law. |
| Great Britain | The Trade Marks Act 1994 was enacted to implement Council Directive No 89/104/EEC harmonising the laws of the member states. The provisions of section 46(1) as set out above have remained in their present form since the initial enactment. Prior to the enactment of the Trade Marks Act 1994, direct national trade marks and service marks were governed by the Trade Marks Act 1938 (as amended by the Patents, Designs and Marks Act 1986), with section 26(1)(b) of that act dealing with removal of marks from the register for non-use. S.26(1)(b) stated that the mark could be removed in relation to some or all of the goods/services for which it is registered if, up to the date of 1 month before the date of the application for removal, a continuous period of five years or longer had elapsed during which the mark was a registered mark and during which there was no bona fide use in relation to those goods/services by any proprietor of it for the time being. It had sometimes been assumed under this old act that the five year period dated to the original application date, even though this might be unfair on the proprietor. However, the point was finally settled the other way by the BON MATIN case [1989] RPC 537. It is worth noting that, under the old act, what were then called “rectification” proceedings were unusual because the burden of proof of non-use was on the applicant rather than the proprietor. |
| Greece | No. |
| Hungary | No. |
| Ireland | Under the 1963 Trade Marks Act, non-use was dealt with under Section 34(1)(b) of Part A of the Act. This allowed for the removal of a |



European Communities Trade Mark Association

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| | registration on the grounds that up to the date one month before the date of application for removal a continuous period of 5 years or longer elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to the goods by the registered proprietor. It was not necessary for the applicant to prove absence of intention to use. This was dealt with in the case of Beecham Group Ltd v. Goodalls of Ireland Ltd. |
| Italy | Before the reform of the Italian Trade Mark Law in 1992, the Law provided for three years use requirement. |
| Latvia | No. |
| Lithuania | ----- |
| Malta | Until January 1, 2001 the matter was not specifically regulated in our law. |
| Poland | No, however the most recent amendments to the Law on Industrial Property have specified the date from which the period of five years should be counted. Namely, a phrase “after the date of granting the right of protection” was added. |
| Portugal | The Industrial Property Code of 1940 (Decree Number 30 679 dated August 24, 1940) set forth that Trade Marks had to be used after a period of three years had elapsed counted from the date of grant. |
| Romania | The previous Trade Mark Law Number 28/1967 did not contain any stipulations in this respect and, because of this, the sanction of mark cancellation could be applied by the Courts only after five years from the moment when the new law 84/1998 came into force. This means that in Romania, the first cancellation action could be filed after the date of July 23, 2003. |
| Slovak Republic | ----- |
| Slovenia | Yes. The period of the five years was accounted from the date on which the entry of the mark in the register has become final. |
| Spain | The 1988 and 2001 laws make the same provisions. The old Statute of 1929 only mentioned the obligation to use within five years, without clearly establishing the respective date. |
| Sweden | Not recently. |

6. Have there been any different rules in the past?

b) Trade marks filed through the Madrid system (IR marks)

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|---------|---|
| Austria | The 5 years use requirement was first introduced in Austria in 1977 and become applicable 5 years thereafter. Prior to 1977 no use requirement for trade marks existed. |
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European Communities Trade Mark Association

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| Benelux | Before January 1, 2004 the date taken into account was the date of the registration of the international mark. |
| Bulgaria | No answer as there is currently not any committee member from this country. |
| Cyprus | No. |
| Czech Republic | ----- |
| Denmark | No. |
| Estonia | <p>The regulation of the question under the old Estonian Trade Mark Act (effective until April 30, 2004) should be regarded having regulated in a different way.</p> <p>Since the equality principle was and is imposed towards the International marks and national marks, while under the old Trade Mark Act just the date of entry of a mark in the register was decisive (i.e., no particular provisions with respect to the International marks were regulated), thus, the date of the registration at the International Bureau of WIPO or the date of subsequent designation was decisive.</p> |
| Finland | None aware of. |
| France | Before the entering into force of the harmonized Law (December 28, 1991) instituting opposition proceedings, the date taken into account was the date of registration of the international mark. |
| Germany | Prior to the enactment of the new German Trade Marks Act (MarkenG) in 1995 similar provision to those in Sections 43, 115 MarkenG [see 3 b i) and ii) above] were contained in Sections 10 and 2(4) of the "Verordnung über die internationale Registrierung von Fabrik- oder Handelsmarken" (Regulation on the International Registration of Trade Marks). |
| Great Britain | Prior to amendment by the Trade Marks (International Registration) (Amendment) Order 2002, the provisions of section 12 of the Trade Marks (International Registration) Order 1996, as to the date on which the trade mark which is the subject of the international registration becomes protected, differed slightly to the provisions set out above. |
| Greece | No. |
| Hungary | No. |
| Ireland | No different rules in the past. |
| Italy | Before the reform of the Italian Trade Mark Law in 1992, the Law provides for three years use requirement. |
| Latvia | No. |
| Lithuania | ----- |



European Communities Trade Mark Association

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| Malta | Not applicable as Malta is not party to the Madrid system. |
| Poland | The practice was that the date when the examiner work was completed was regarded as the date of issuing on decision on extension of the international registration to Poland. However the said date was not published it was assumed that the term within which a mark has to be put to use starts to be counted from the expiry date of the term for issuing a decision on refusal of granting protection in Poland in respect of that international mark (that is, within one year of the notification date). Currently, the date is clearly specified in Article 15215 of the Law on Industrial Property, which provides the term mentioned in Article 169.1.1 starts to be counted from the date of publishing information about granting protection in the Official Journal of The Polish Patent Office. |
| Portugal | The Industrial Property Code of 1940 (Decree Number 30 679 dated August 24, 1940) did not expressly set forth any provision in respect of this matter, thus there were doubts concerning the system applied thereto. In any case, the Portuguese authorities tended to consider that the three-year period was counted from the date of grant of the international trade mark in Portugal. |
| Romania | The previous Trade Mark Law Number 28/1967 did not contain any stipulations in this respect and, because of this, the sanction of mark cancellation could be applied by the Courts only after five years from the moment when the new law 84/1998 came into force. This means that in Romania, the first cancellation action could be filed after the date of July 23, 2003. |
| Slovak Republic | ----- |
| Slovenia | Yes. The period of the five years was accounted from the date on which the entry of the mark in the register has become final, meaning that no further legal remedy is available and no proceedings are pending against this registration. |
| Spain | The 1988 and 2001 laws make the same provisions. The old Statute of 1929 only mentioned the obligation to use within five years, without clearly establishing the respective date |
| Sweden | Not recently. |