



European Communities Trade Mark Association

**Harmonization Committee
Survey on
“Priority of the Conversion (Converted Marks) in the New Member States”**

Summary of the answers:

The purpose of this survey was to find out whether the new member states all deal in the same manner with the priority of converted marks in cases in which the CTMs antedate the date of access of the new member state to the EU.

The answers of the Committee Members of or for the new member states, as per copies enclosed, are split. While the answer for Lithuania is still missing,

- a) 7 countries accept as earliest filing/priority date of a CTM converted into a national trademark the date of access of the country to the EU, namely, May 1, 2004. These countries are: Cyprus, Czech Republic, Estonia, Latvia, Malta, Poland, Slovenia.
- b) 4 countries (Hungary, Bulgaria, Romania, Slovakia) appear to accept the original filing/priority date of the CTM converted into a national TM. However, with regard to national trademark rights existing before this country's access to the EU, the national TMs based on converted CTMs are treated like all other CTMs valid in that country as of the date of access which is for Hungary and Slovakia May 1, 2004, for Romania and Bulgaria January 1, 2007.

From the above arises the question whether the OHIM, e.g. in invalidity proceedings, will use an unitary modus operandi with regard to priority of national TMs of the new member states converted from CTMs existing before that date country acceded the EU or will have to take into account the different national regulations.

July 28, 2008

Monika Wenz
Harmonization Committee Chair



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Country: Bulgaria

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
Yes, in the Law on Marks and Geographic Indications /LMGI/
2 – If so, please indicate the legal provisions that are applicable.
<p>Art. 72c of the Law on Marks and Geographic Indications</p> <p>Art. 72c (new, State Gazette No. 73/2006, in force as of the date of accession of the Republic of Bulgaria to the European Union) (1) The applicant for or proprietor of a Community mark may request the conversion of his Community mark application or Community mark into a national mark application for registration in the Republic of Bulgaria, subject to the provisions of Articles 108 to 110 of the Regulation.</p> <p>(2) Where the Office for Harmonization in the Internal Market (Trade Marks and Designs) allows the request referred to in paragraph (1) and forwards it to the Patent Office, the latter shall consider the request in accordance with this Law, provided that, within two months following the date of receipt of the conversion notification, the applicant furnishes:</p> <ul style="list-style-type: none"> (i) a Bulgarian translation of the documents; (ii) a representation of the mark; (iii) a document certifying payment of the filing and examination fees. <p>(3) The filing date of the application referred to in paragraph (1) shall be the filing date or priority date, as appropriate, of the Community mark application.</p>
3 – In the case of a Community trademark filed before January 1, 2007, does the NPTO consider the filing date to be valid.
Yes, according to Art. 72c (3) of the LMGI the filing date of the application shall be the filing date or priority date of the Community application.
5 – If the NPTO accepts the priority of the Community trademark (prior to January 1, 2007), what effects will this have in relation to national trademarks filed or registered after the country filing date and before January 1, 2007?



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The effect will be the same as the effect of all other Community Trademarks, valid on the Bulgarian territory after January 1, 2007 in respect to the national trademarks filed and registered before January 1, 2007.

Country: Cyprus

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?

No, it does not.

2 – If so, please indicate the legal provisions that are applicable.

3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?

Yes. Our firm has also done some.

4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?

The relevant laws of Cyprus do not provide anything about this. There is no case law either. I talked also to the Legal Advisor of the Cyprus Trademarks Office. According to him, the Office will accept the 1st of May 2004 as the relevant date and not the filing date.

5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?



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Country: Czech Republic

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
Yes.
2 – If so, please indicate the legal provisions that are applicable.
Act No. 441/2003 Coll., sections 50 and 51 deal with the issue of conversion of CTMs.
3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?
Yes.
4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?
The NPTO recognizes the filing date, however, any trademark filed prior to 1.5.2004 is effective in the territory of the Czech Republic and, therefore, has a priority as of 1.5.2004.
5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?
As stated under No. 4 the Czech NPTO accepts a priority of CTMs as of 1.5. 2004.



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Country: Estonia

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
2 – If so, please indicate the legal provisions that are applicable.
3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?
The case law of Estonia sets the priority of the national trademark to the day of accession, for instance a CTM application filed at OHIM on 19 June 1998 (TM "TAZZO & D'ORO & device) has been converted into national Estonian application with the date of filing of 1 May 2003 (and not the original date of filing).
4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?
5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?

Country: Hungary

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?



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No.
2 – If so, please indicate the legal provisions that are applicable.
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3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?
Yes, our law firm handles such cases, however, all of them have a later priority date than May 1, 2004.
4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?
The Hungarian Patent Office considers the filing date to be valid.
5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004? For easy reference please refer to the example given on the 3 rd paragraph of the above text.
We have had no such case, yet and we are not aware of such Office practice, either. However, in the sense of the Accession Treaty, we suppose (and this has been confirmed by the HPO informally, as well) that the owner of a converted CTM will not be entitled to exercise its trademark rights against an identical national trademark, if the priority of latter is earlier than the day of accession. The HOP would in such case ex officio take into consideration that the trademark is a converted trademark.

Country: Latvia

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
Latvian national legislation stipulates specific rules governing the conversion of Community Trademarks.



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2 – If so, please indicate the legal provisions that are applicable.

Latvian Law on Trademarks and Indications of Geographical Origin (with amendments of 08.11.2001 and 21.10.2004) contains the following provisions regarding the Community Trademarks:

Article 39⁵. Transformation of a Community Trademark into a Trademark Application in Latvia

(1) If from the Office for Harmonization in the Internal Market (trademarks and designs) is received an application for the transformation of a Community trademark registration or application into a trademark application in Latvia (application for conversion), forwarded to the Patent Office pursuant to the regulations of Article 109, Paragraph 3 of the Council Regulation No 40/94, the Patent Office shall immediately invite the submitter to fulfil within three months the conditions envisaged in Article 110, Paragraph 3 of the Council Regulation No 40/94, as well as to pay the fee prescribed in Article 10, Paragraph 9 of this Law.

(2) If the submitter has not paid the prescribed fee (supplementary fee) in due time, the application for the conversion shall be deemed to have not been submitted, and the submitter shall be notified accordingly in writing.

(3) In starting the examination of the application for the conversion, the Patent Office shall verify at first if there are no obstacles for the realization of the conversion as referred to in Article 108, Paragraph 2 of the Council Regulation No 40/94. Pursuant to Article 110, Paragraph 1 of the Council Regulation No 40/94 the Patent Office can request from the Office for Harmonization in the Internal Market (trademarks and designs) submission of the necessary supplementary information on the circumstances that refer to the aforementioned obstacles for the realization of the conversion. If pursuant to the regulations of Article 108, Paragraph 2 of the Council Regulation No 40/94 the conversion shall not be allowed, the application for conversion shall be rejected and the applicant shall be notified accordingly in writing.

(4) If there are no obstacles for the realization of the conversion as referred to in Article 108, Paragraph 2 of the Council Regulation No 40/94, the application for the conversion shall be deemed to be an application for trademark registration in Latvia. For examination of such application the procedure for the preliminary examination of the application and the examination of a trademark, as well as other provisions for trademark registration procedure shall be applied, account shall be taken of the requirement of Article 110, Paragraph 2 of the Council Regulation No 40/94.

(5) The application for a trademark registration, based upon the application for the conversion, shall keep the application date and the priority date (if the priority has been accorded), as well as the seniority date, if the seniority has been accorded with respect to Latvia, of the relevant Community trademark.

3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?



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There are a number of practical cases in Latvia of the conversion of Community Trademarks into national trademarks.
4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?
May 1 st , 2004 is considered to be the filing date.
5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?
Convention priority for CTM applications filed before May 1 st , 2004 is not accepted.

Country: Malta

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
NO
2 – If so, please indicate the legal provisions that are applicable.
N/A
3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?
YES
4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?



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YES
5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?
N/A

Country: Poland

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
NO
2 – If so, please indicate the legal provisions that are applicable.
n/a
3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?
No. According to the information of the Polish Patent Office, up to the end of August 2006 there have been 113 requests filed for conversion. There was not issued any decision regarding these cases yet.
4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?
The Polish Patent Office decided to apply by analogy the principle under Article 142a CTMR (now Article 159a). This means that a converted CTM enjoying a filing date prior to 1 st May 2004 will, in Poland, have the filing or priority date of 1 st May 2004.



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5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?
n/a

Country: Romania

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
<p>For this moment, there are no provisions in this respect.</p> <p>There is a project for the amendment of the present Law, which must be submitted for the debates in Parliament, but we do not know when the Law will come in force.</p> <p>The project contains an Article concerning the conversion of a CTM but the text specifically sends to the CTM Regulation, art. 108-110.</p>
2 – If so, please indicate the legal provisions that are applicable.
3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?
<p>We already had some cases in this respect, but they were not yet concluded, since PTO did not reach to any conclusion upon conversion procedure, due to the lack of any legal provisions in force.</p>
4 – In the case of a Community trademark filed before January 1, 2007, does the NPTO consider the filing date to be valid or is the date according January 1, 2007?
<p>Since they did not issue any decision in respect with a conversion of a CTM, it is difficult to give you a straight answer.</p> <p>However, since the unitary system conferred by a CTM registration must be kept, we believe that the CTM filing date must be taken into consideration.</p>
5 – If the NPTO accepts the priority of the Community trademark (prior to January 1, 2007),



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what effects will this have in relation to national trademarks filed or registered after the country filing date and before January 1, 2007?

I suppose that the problem which may arise from this situation refers to a possible conflict that might emerge between owners and which must be solved in Court.

In this case we should take into consideration the date when the right upon a registration became effective therefore the date should be considered as being January 1, 2007.

Country: Slovakia

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?

Slovak Trade Mark Act explicitly states (§ 36b) that
“(3) The application resulting from the conversion of a Community trade mark application shall be assigned the date of filing and the date of priority of that application, where appropriate, the seniority of a trade mark claimed under Article 34 and 35 of the council regulation”.

2 – If so, please indicate the legal provisions that are applicable.

See 1

3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?

4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?

5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?

Either CTMs or national trade marks converted from CTMs having priority/filing dates falling prior to May 1, 2004, may not be enforced against Slovak trade marks having priority date/filing date falling prior to May 1, 2004, i.e. they may not be claimed against rights existing on the Slovak territory prior to the accession of the Slovak Republic to the EU.



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Country: Slovenia

1 – Does your national legislation stipulate specific rules governing the conversion of Community Trademarks?
2 – If so, please indicate the legal provisions that are applicable.
3 - Have there been any practical cases in your country of the conversion of Community trademarks into national trademarks?
4 – In the case of a Community trademark filed before May 1, 2004, does the NPTO consider the filing date to be valid or is the date according May 1, 2004?
In the situation where a CTM was filed before the accession of our country to the EU, i.e. before May 1, 2004, and subsequently converted to a Slovenian application, its priority is the date of May 1, 2004, i.e. the date when the Slovenia became a member of the EU. If a CTM was applied for after May 1, 2004, then the priority date of the converted CTM is its date of filing with the OHIM.
5 – If the NPTO accepts the priority of the Community trademark (prior to May 1, 2004), what effects will this have in relation to national trademarks filed or registered after the country filing date and before May 1, 2004?