



European Communities Trade Mark Association

**ECTA - Harmonization Committee**

**Project (2): Conversion Issue relating to Seniority of Cancelled National Trademark**

## **Summary Report on the Survey regarding Conversion Issue relating to Seniority of a Cancelled National Trademark**

by Monika Wenz

**status: 13 10 08**

- 25 EU member countries are represented on the Committee at present (Lithuania and Slovakia are still missing)
- For the subject of this survey, for Benelux there is 1 reply.

With regard to Question

### **a) What is the priority date the national Trademark Office of the X Member State would grant to the national trademark resulting from the converted CTM. Is it the CTM application filing date OR the Seniority date?**

- the National Office (NO) of 1 country has not considered the matter as yet (Slovenia). The NO of another country (Bulgaria) has no practice up to now. The opinions in Bulgaria how to deal with the issue are different.
- The remaining 21 replies appear to be clearly splitted.
- 13 NOs grant or are supposed to grant the seniority date, of those the Finnish NO after own examination of the seniority claim.
- Of those 11 countries, 1 country, namely, Denmark, grants seniority of the interim period, that is, the period between lapse of the senior Danish Reg. and the conversion of the CTM merely for the mainland of Denmark, but not for Greenland and not for the Faeroe Islands.
- 2 further countries appear to grant the seniority date on a limited scale: Sweden only, if a CTM **registration** is converted and the CTM was registered **before** the Swedish Reg. lapsed; Cyprus supposedly only, if the seniority date is not earlier than 6 months before the CTM filing date.



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- 6 countries grant or are supposed to grant “merely” the CTM filing date, presumably the Paris Convention priority date, if claimed for the CTM (the latter was not explicitly inquired).

With regard to Question

**b) Does your national Trademarks Office keep records of the lapsed TM registrations on which a seniority claim was based**

- the NOs of 16 countries appear to keep electronic records and/or files on lapsed TMs. The Italian Office’s database includes lapsed registrations, however, without particular indication about it.
- The NOs of 2 countries keep records on “recently” lapsed TMs, namely UK and Finland. In Finland national archives keep the information.
- The NOs of 3 countries and the Benelux Office appear to keep no records on lapsed TMs. In France a search in the official Bulletin of INPI is possible by Reg. No. or Appl. No..

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A CTM can be converted into national trademark(s) in the EU Member States (Art. 108 f. CTMR). For the converted CTM, Seniority may have been claimed (Art. 34 f. CTMR) based on an earlier national trademark registration in X Member State and have been accepted by the OHIM. The earlier national trademark registration has lapsed due to non-renewal before the application for conversion of the CTM is filed. The questions are:

a) What is the priority date the national Trademark Office of the X Member State would grant to the national trademark resulting from the converted CTM. Is it the CTM application filing date OR the Seniority date?

b) Does your national Trademarks Office keep records of the lapsed TM registrations on which a seniority claim was based

Country	a)	b)
<b>Austria</b>	Pursuant to Art. 108 of the CTMR a national application resulting from the conversion of a CTM will enjoy the priority of the filing date of the CTM or of its priority date under Article 4 Paris Convention or that of a seniority claimed under Article 35 or 34 CTMR. This provision seems clear enough, but I understand that the examiners of the	As no such case has yet occurred, nobody at the Austrian Patent Office remembers what should happen to those files of trademarks which lapsed, but on the basis of which a seniority was claimed. The officials only vaguely remember that something special for these files



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	<p>Austrian Patent Office were instructed that they shall only grant the filing date or the priority date, but not the seniority date. This is definitely wrong and it seems that no such case has yet come up. However, in the given case I am quite sure that the Austrian Patent Office will have to follow the clear provisions of the CTMR in the end.</p>	<p>was decided and they promised me to find out what it was, but could not yet say. I will get this information within the next few days and will pass it on to you. At any rate I take from this attitude that until now nothing special has been done to these files and I will make sure that this is not so in the future. For the time being the problem is not yet critical, because it takes a long time until terminated files are destroyed so that all files of trademarks on which seniorities are based are still existing. It seems that there is no procedure to identify these files and to keep them separately in case a conversion should take place in the future. The best procedure may be that the OHIM should notify the respective national Intellectual Property Office of any accepted seniorities based on a national registration of the respective office. However, I am sure that the OHIM will not like this procedure, because it will mean more work. On the other hand, I do not see any possibility for the Austrian Patent Office – and naturally not for the other Intellectual Property Offices – to find out themselves whether seniorities were claimed and accepted. They could only do so by regularly checking the database of the OHIM which they would not like to do and obviously never did</p>
<b>Benelux</b>	<p>The Benelux Office for Intellectual Property (“BOIP”) stated that they will consider the CTM filing date as filing date for the national trade mark resulting from the converted CTM.</p>	<p>There is no register of lapsed trademarks with a seniority claim nor does de BOIP register any seniority claims in the trademark registry.</p>
<b>Bulgaria</b>	<p>No practice up to now. The opinions</p>	<p>Yes, our Trademark Office has</p>



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	are different.	taken a decision to keep such records.
<b>Cyprus</b>	<del>is normally the CTM application filing date. However, if the Seniority date is an earlier date (maximum 'a six months' earlier date) from the CTM application filing date, Cyprus would grant the Seniority date.</del> amended on November 27, 2007 to read: It is the SENIORITY DATE.	Our national Trademarks Office keeps only a general record of all the lapsed TM registrations which includes also the lapsed TM registrations on which a seniority claim was based.
<b>Czech Republic</b>	The national Trademark Office does not have to make a decision in respect of the priority date as the seniority issue is dealt with by OHIM. The seniority documents together with any supporting documents eg. Registration or Renewal Certificates are sent directly to OHIM who subsequently decides on the priority date.	The national Trademark Office does not keep a record of lapsed TM registrations on which a seniority claim is based.
<b>Denmark</b>	It is the priority date of the seniority right. However, if the Danish registration on with the seniority was based has ceased to exists prior to the conversion, the resulting Danish registration will not give protection for Greenland and the Faro Island in the period in which the (basis) Danish registration was not in force.	All trademark rights on the register and in force on Jan 1, 1982 have been digitalized and the essential data including the list of goods are kept on electronic media- and are accessible on-line ( <a href="http://www.pvsonline.dk">www.pvsonline.dk</a> ).
<b>Estonia</b>	The Seniority date.	The Estonian Patent Office keeps records on TM registrations which are basis for the CTM Seniority, the relevant database enables to receive information on the lapsed TM registrations.
<b>Finland</b>	CTM application filing date unless the applicant refers to the Seniority and may prove that Seniority has been valid at the filing date of the CTM. If the applicant refers to the Seniority then the Finnish Trademarks Office would examine the claim and if it is found acceptable then it would be the	Not in the sense that there is a "seniority" section of the Register that can be inspected, but on one hand the Trademarks Office will hold records of recently lapsed registrations and on the other hand National Archives would maintain information of 'older'



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	Seniority date.	lapsed registrations which could be used to verify a seniority claim in cases of any doubt.
<b>France</b>	This case never occurred in France. According to the INPI (Annick Berguerand) the priority date could be the CTM application filing date, with a mention, in the publication of the corresponding national trademark	The corresponding national TM registrations are recorded in our "BOPI" (Bulletin officiel de la propriété industrielle)
	<p><u>Remarks by Helga Pernez:</u> The above replies were obtained from the French PTO by Pascale Bouts who helped me with the matter. From my point of view it is not surprising that such cases never occurred in France. In fact, when an CTM application claims a national seniority which is about to lapse, this means that the national mark enjoys a rather old priority. This is then often also the case for the same mark (of the same owner) in other countries. Therefore there should not be too many problems when applying for the said TM as CTM. For the moment no provisions in French TM Law allow a transformed CTM to reinstate the national seniority. In French TM Law, once a registration has expired, it is not possible to have a new registration (or re-registration) enjoy the same priority. In order to retrieve a national expired registration, one must search in the official publications (BOPI) with the application number (which is kept after registration) for TMs not older than 1992 and with the registration number for older TMs. The online TM service of the French PTO (ICIMARQUES) does not keep trace of expired TMs. However, if TMs are cancelled voluntarily or by Court decisions, they will appear in ICIMARQUES (with the mention of cancellation) as long as their 10 years validity has not ended.</p>	
<b>Germany</b>	I discussed the issue with the person in charge for converted CTMs in the German Patent and Trademarks Office (at present a Mrs. Rabisch-Tredi - telephone No. +49 89 2195 4538). She could not remember so far to have dealt with such a case but informed me that she would have no problem in accepting the seniority for the converted mark of a non-renewed Reg. upon OHIM's transmittal of an application for conversion of a CTM with a seniority accepted by the OHIM.	<p>The data bank "DP-Info" of the German Patent and Trademarks Office reflecting all entries of the electronic German TM Register keeps records "forever" of national registered marks even after non-renewal. I will still find out since when this has been the case because I doubt that this was the case already on April 1, 1996.</p> <p>At any rate, a privately owned German TM institute "Schutz-Marken-Dienst" has kept records since the 80s of non-renewed German TM Regs. The fee is moderate for obtaining such information.</p>



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<b>Greece</b>	The priority date would be the CTM application filing date	No, the Greek Trademark Office does not keep separate records for the above trademarks. However, their particulars (such as filing and registration date, initial and subsequent registered proprietors etc.) once entered into the Registry they remain accessible in the Official Books of the Registry even after expiration of the respective right.
<b>Hungary</b>	<p>The HPO confirmed that it is not a problem that the national trademark will be expired at the date of filing the request for conversion, if the national trademark was valid at the date of priority of the CTM.</p> <p>As a consequence, the priority date of the converted CTM would be considered as the Seniority date of the national trademark.</p> <p>The HPO underlined that the seniority has to be claimed before the conversion, since there is no possibility to claim the seniority if the CTM has been already converted into a national trademark.</p>	All lapsed, deleted trademarks remain in the electronic databases and also the complete files of the trademarks are kept at the HPO. However, there is no such special record that would refer to lapsed TM registrations on which a seniority claim was based.
<b>Ireland</b>	<p>The question is what is the priority date of the Irish application. The short answer is that there is no priority date and that the filing date of the Irish application should be the same as the seniority date of the CTM.</p> <p>I am assuming that the national trade mark registration was an Irish registration and that the CTM has been converted to a national application in Ireland. I am also assuming that the CTM has been registered and that it did not have any priority date. In this case, the CTMR states: Article 108(3). The national trade mark</p>	<p>he Irish legislation on the issue, Trade Marks Act, 1996 (Community Trade Mark) Regulations, 2000 (S.I. No. 229 of 2000) states in Regulation 3:</p> <p>Where the Controller receives a notification under Rule 28(3) of the Community Trade Mark Rules [<i>the CTM Implementing Regulation</i>] pursuant to Article 34 or 35 of the Community Trade Mark Regulation of a seniority claim based on an earlier registered trade mark, the Controller shall note the</p>



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	<p>application resulting from the conversion of a Community trade mark application or a Community trade mark shall enjoy in respect of the Member State concerned the date of filing or the date of priority of that application or trade mark <b><u>and, where appropriate, the seniority of a trade mark of that State claimed under Article 34 or 35.</u></b></p> <p>Therefore, the seniority date applies to the Irish application which results from the conversion of the CTM.</p> <p>The effect of seniority is defined in the CTMR as</p> <p style="padding-left: 40px;">Article 34(2). Seniority shall have the sole effect under this Regulation that, where the proprietor of the Community trade mark surrenders the earlier trade mark or allows it to lapse, he <b><u>shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.</u></b></p> <p>Thus the effect of seniority is different to the effect of priority, which is stated in Article 31 CTMR as being:</p> <p style="padding-left: 40px;">The right of priority shall have the effect that the date of priority shall count as the date of filing of the Community trade mark application <b><u>for the purposes of establishing which rights take precedence.</u></b></p> <p>In this case, the Irish application does not have a priority date at all. Rather,</p>	<p>said seniority claim and such claim is hereby prescribed as a matter to be entered in the register.</p> <p>Therefore, the Irish Patents Office should make a note on the register entry in respect of the Irish registration that it has formed the basis of a seniority claim. In practice, the register entries for lapsed Irish registrations, with the exception of some registrations which lapsed many years ago, are available online at the Irish Patents Office website. However, there does not appear to be an obligation on the Irish Patents Office to maintain register entries for such lapsed Irish registrations.</p>
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	<p>the Irish application should be deemed to have a filing date which is the same as the seniority date. The filing date of the CTM is irrelevant. When the Irish application reaches registration, the rights in that registration will take effect from the filing date of the Irish application, which is the same as the seniority date.</p> <p>We note that we have not encountered this particular set of circumstances in practice but nonetheless, this is how we believe it should be treated by the Irish Patents Office.</p> <p>For your information, the Irish legislation on the issue, Trade Marks Act, 1996 (Community Trade Mark) Regulations, 2000 (S.I. No. 229 of 2000), states in Regulation 11:</p> <p style="padding-left: 40px;">A trade mark application resulting from the conversion of a Community trade mark application or Community trade mark shall maintain the <b><u>date of priority</u></b> of the said Community trade mark application or said Community trade mark and, where appropriate, <b><u>the seniority</u></b> of an earlier registered trade mark claimed under Article 34 or 35 of the Community Trade Mark Regulation.</p> <p>This does not refer to the filing date of the CTM being maintained as regards the Irish application. However, in our experience, the filing date of the CTM is deemed to be the filing date of the Irish application (unless, of course, seniority applies).</p>	
<b>Italy</b>	The priority date would be the CTM application filing date.	The Italian PTO data base includes also the lapsed registration, but there is not any



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		particular indication about it (i.e. NOT RENEWED).
<b>Latvia</b>	According to Art. 39 <sup>5</sup> entitled "Transformation of a Community Trademark into a Trademark Application in Latvia" of "The Law on Trademarks and Indications of Geographical Origin" of the Republic of Latvia (with the changes of 08.11.2001 and 21.10.2004) " The application for a trademark registration, based upon the application for the conversion, <b>shall keep the application date</b> and the priority date (if the priority has been accorded), <b>as well as the seniority date</b> , if the seniority has been accorded with respect to Latvia, of the relevant Community trademark. " However, the Patent Office of Latvia has had no such cases till now.	At the beginning the Patent Office of Latvia kept all the records about lapsed trademarks (including those for which seniority has been claimed). However, now OHIM does not sent any notification of the seniority claims. Thus, currently the Patent Office does not have any information on trademark registrations on which a seniority claim was based, as the Office does not trace whether any trademark has been granted seniority
<b>Lithuania</b>		
<b>Malta</b>	In the circumstances, the priority date should be that of the CTM Application filing date in my view, and I believe the local Trademark Office would concur on this.	Not as far as we are aware.
<b>Poland</b>	If a request for conversion is filed after the expiry of the national trademark most probably the Polish Patent Office will not grant Seniority date and the date of application for CTM will be the date of application for the trademark	The Polish Patent Office keeps all records of all trademarks, also of those that lapsed.
<b>Portugal</b>	I am not aware of a specific case where this problem has been dealt with. In my opinion article 108(3) of CTMR clearly states that the national application <u>shall enjoy seniority as claimed under article 34 or 35</u> . This provision is binding on the National Offices therefore the seniority date should be entered in the Register.	The official records of lapsed registrations are kept, as far as I know. In any case the official file may not be necessary to evidence the past existence of a registration. There are other sources of information to consider:  - the evidence required to claim seniority at OHIM -



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		<p>Rule 8(1 and 2) of CTMIR</p> <ul style="list-style-type: none"> <li>- the information sent by OHIM to National Offices</li> <li>- Rule 8(3)</li> </ul>
<b>Roumania</b>	Since there are no provisions in this respect, I suppose that the priority date the PTO should grant to the national trademark resulting from the converted CTM is the Seniority date.	The Romanian PTO usually has in its data-base all the lapsed trademarks, therefore I think they will be able to keep also the information in respect with the lapsed TM registrations on which a seniority claim was based.
<b>Slovakia</b>		
<b>Slovenia</b>	Due to the fact that seniority is claimed very rarely, Slovenian Member has so far no experience with this issue.	Due to the fact that seniority is claimed very rarely, Slovenian Member has so far no experience with this issue.
<b>Spain</b>	Seniority date	No, they do not keep records since some months ago they are deleting lapsed TM registrations from their databases although they keep the corresponding files.
<b>Sweden</b>	If the CTM was registered before the national Swedish registration lapsed, the priority date is the filing date of the first Swedish registration upon which seniority was claimed.	The Swedish Patent and Registration Office keeps all relevant data such as filing date and filing number, registration date and registration number, seniority and priority dates etc. of all national trademarks in their record. If the trademark is older than the computerised system, it is possible to look into the paper file
<b>UK</b>	The seniority date. The UK Office will rely on the data recorded/ published by OHIM for this purpose.	Not in the sense that there is a "seniority" section of the Register that can be inspected, but there remain records of recently lapsed registrations which could be use to verify a seniority claim in any particular case if there was any doubt.