



Seniority claims: how to decide which route to take

Claiming seniority is a peculiarity of the European Union trade marks (EUTM) System. The proprietor of a EUTM application or registration, who also owns an earlier national trade mark registration for an identical trade mark in an EU member state, can incorporate the earlier date of the national mark into the EUTM. The result of this is that the national registration can be allowed to lapse but the rights will be deemed to continue as part of the EUTM. The rights of the EUTM will date back to the filing date of the national registration, insofar as that particular country.

Example

A EUTM registration which claims seniority from a German registration dated 31 January 1992 will create a prior date under the EUTM in Germany: it will not create an earlier date for the EUTM as a whole. So a EUTM claiming several seniority rights may be effective from different dates in different countries.

When are claims appropriate?

Seniority is only possible if the trade marks are identical, the registered proprietors are identical and there is identity or direct overlap in the specifications of goods. Specifications of the national registrations can be wider or narrower than the EUTM, but if it is wider, seniority can only be claimed for the goods/services falling within the scope of the EUTM.

Seniority claims are particularly useful in countries where there may be limited or low levels of use. However until better tried and tested in court, retaining national rights in key territories may be advisable.

What are the advantages?

- a) No need to incur renewal costs of individual national registrations.
- b) No need to use a mark in each country to ensure the validity of the national registration (use of a trade mark in a handful of countries will normally be sufficient to maintain a EUTM registration for all countries of the EU, subject to certain conditions).
- c) No need to record changes of name or address against each national registration once

seniority claims have become active, saving further substantial costs. There are safeguards which ensure that, should a EUTM expire, or be cancelled, seniority rights can be re-claimed in the national registries, effectively re-instating the benefit of the original registrations.

When do claims become effective?

On expiry of the relevant national registration, not at the time the claim is made. This is often overlooked, as is the necessity to ensure that the ownership of any national registrations is kept the same as the EUTM until the national registrations expire, to meet the identity requirements. If either the national registration or the EUTM is assigned without the other, that essential link will have been severed and, what was formerly an effective and valid claim to seniority will become ineffective and invalid.

Taking action

Where not already claimed, a seniority right should be claimed shortly before the expiry date of the relevant national registration but allowing enough time for the claim to be processed. As the European Union Intellectual Property Office does not fully examine or guarantee the validity of seniority claims, obtaining a certified copy of each national registration from the appropriate national patent & trade mark office is strongly recommended. This will verify the details of the national registration and will act as an official record of the details of the registration, after it has lapsed and been removed from the national register.

Further advice

At Barker Brettell LLP all our Trade Mark Attorneys have many years' experience in preparing and filing seniority claims. We will use our experience to provide a strategy insofar as possible seniority claims available to you, which will give advantages in terms of both portfolio management and cost savings.

We can advise you more on these issues, as well as on any of the other aspects of intellectual property. Barker Brettell LLP offers a full range of intellectual property services, and we are always happy to take the time to tailor our services to your needs.