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EU Enlargement: Its Effect on Protection of Trademarks in Europe and Measures to be Undertaken to Protect Existing Trademark Portfolios

by Diane L. Gardner

The European Union (EU) will enlarge with the acceptance of 10 new Member States on May 1, 2004. The new Member States include:

Cyprus (Greek-controlled)	Czech Republic
Estonia	Latvia
Lithuania	Malta
Poland	Slovakia
Slovenia	Hungary

Unfortunately, trademark piracy is widely prevalent in some of these countries. Moreover, this enlargement of the EU will have special effects on European Community Trade Mark registrations (CTMs), which are unitary trademark registrations that cover all of the EU Member States. Thus, it may be necessary for you to take action soon to safeguard trademark portfolios in new and established EU countries. Two basic steps to consider:

- Trademark portfolios should be *extended very soon* to the future EU Member States as individual national applications.
- Any foreseeable *new CTM applications should be filed before October 31, 2003.*

Automatic Extension

CTM registrations/applications having a priority date through April 30, 2004 will be automatically extended to be effective in the new Member States without additional cost or formality.

The Effects of Prior Rights: Danger of Oppositions/Denial of Use

Owners of identical or similar trademarks registered or filed in the 10 new Member States will be

able to oppose only those conflicting CTM applications that are filed after October 31, 2003.

If a CTM registration has been granted, the right to use the registered CTM still may be denied in those acceding States where older national rights pre-exist. The mere existence of a CTM registration is no defense to trademark infringement of pre-existing national rights that may be present in one or more acceding States.

Unscrupulous opportunists currently may be in the process of filing applications for perceived valuable trademarks in the new Member States, in order to take advantage of these very situations.

Timely extension of trademark portfolios to future EU Member States as individual national applications may prevent third party national applications from barring the use of a CTM registration or hindering the registration of a new CTM application (with a priority date later than November 1, 2003).

Moreover, *any intended new CTM application should be filed before October 31, 2003* so as to avoid the increased potential for opposition by third parties holding pre-existing trademark rights in new Member States.

Upon your request, we will be glad to provide detailed advice on the EU enlargement and possibilities as to how to expand trademark protection to the new countries. If you have any questions regarding the information contained herein, please do not hesitate to contact us for additional details.

If you have any questions regarding the EU enlargement and how it effects your trademark, or trademark law in general, please contact any of the Paul Hastings attorneys listed below:

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