

will remain valid even if it is issued in respect of a single Member State or part of it.⁵⁴⁰ Consequently, the use made by a licensee in respect of a part of a geographical area in a Member State, will be accredited to the CTM proprietor as far as the CTM use requirement is concerned.

VII. Key principles relating to precedence of CTM rights

1. Priority Right

Semantically, the term “Priority” means the right to precede others in order, rank or privilege.⁵⁴¹ The decisive factor in deciding which signs precede the other is a priority date recognized under the CTMR. Article 29 of the CTMR is a legal foundation of the CTM priority right, and is built on the corresponding provisions of the Paris Convention.⁵⁴² The Article stipulates that:

A person who has duly filed an application for a trade mark in or for any state party to the Paris Convention ... shall enjoy, for the purpose of filing a Community trade mark application for the same trade mark in respect of goods and services which are identical with or contained within those for which the application has been filed, a right of priority during a period of six months from the date of filing of the first application.⁵⁴³

Where a priority claim is made,⁵⁴⁴ the mark concerned may only become vulnerable to applications or registrations made before the priority date. Thus, under Article 31 of the CTMR, the date of priority counts as the “date of filing of the Community trade mark application for the purpose of determining which rights

540 Cf. Article 22(1) of the CTMR.

541 <<http://dictionary.reference.com/browse/priority>> (status: 30 July 2012).

542 i.e. Article 4 of the Paris Convention for the Protection of Industrial Property of March 20, 1883 as revised.

543 Article 29(1) of the CTMR.

544 Priority right must be specifically claimed by including in the CTM application a declaration of priority and a copy of the previous application (cf. Article 30 of the CTMR). Pursuant to article 33 of the CTMR, priority claim may also be based on exhibition. However, priority right based on exhibitions differs from the one stipulated under article 29 of the CTMR. Whereas the latter is based on registration or application for registration, the former is based on exhibition of goods bearing the mark at an official or officially recognized international exhibition. To rely on the exhibition priority, a CTM applicant has to submit to OHIM evidence regarding the first date of the exhibition of the goods bearing the mark or of the services rendered under the mark during the exhibition. Thus, a CTM applicant will be required to submit a certificate issued by the competent authority of the exhibition stating the date on which the goods bearing the mark or the services rendered under the mark was first exhibited in connection with the goods or services.

take precedence”. In the circumstances, under the CTM system, as under any other trademark system “based on a first-to-file approach, the determination of the filing date has an overriding significance for both the applicant and holders of other rights, since priority and other precedence rights stemming from that date will affect the availability of the protected sign to third parties”.⁵⁴⁵

2. Seniority right

The right to priority stipulated under the CTMR should not be confused with the concept of “seniority” which is actually another form of precedence of rights.⁵⁴⁶

Under the concept, an applicant for Community trade mark may claim seniority of a national mark registered in a member state pursuant to Arts 34 and 35 of the CTMR.⁵⁴⁷ Thus, “seniority is a mechanism which allows a trade mark owner to consolidate his existing trade mark registrations in Member States under the ‘umbrella’ of a CTM registration”.⁵⁴⁸ Seniority right is, nonetheless, used in the CTMR for ease of distinguishing priority rights claimable under the Paris Convention and those which are purely the creation of the Community law in its relation to trade mark law of the member states.⁵⁴⁹

F. CTM Application and Opposition proceedings

Article 6 of the CTMR identifies registration as a sole means by which CTMs may be obtained and protected.⁵⁵⁰ The mere use of a certain symbol as a trademark does not entitle the one who has adopted and used that symbol to

545 *Blueco Limited’s application* [1999] E.T.M.R. 398, para. 12.

546 Timing is a demarcating line between the two seemingly same rights. While priority right is enjoyable within a certain period of time, the seniority right is limitless. Seniority right continues to be available to a proprietor of Community trade mark even where the earlier national trade mark on whose basis seniority is claimable is surrendered or allowed to lapse (*cf.* Article 34(2)). Nevertheless, “failure to satisfy the requirements concerning the claiming of seniority of a national trade mark shall result in loss of that right for the application” (Article 36(6) of the CTMR).

547 These two provisions are discussed exhaustively in chapter 5 *infra*.

548 ANNAND, R. & NORMAN, H., “Blackstone’s Guide to the Community Trade Mark” 73 (Blackstone Press, London 1998).

549 The interface between the CTM system and the trademark system of the Member States is addressed under chapter 5 *infra*.

550 *Cf.* MARX, C., “Deutsches, europäisches und internationales Markenrecht“ (2nd ed.) 404 (Wolters Kruwer Deutschland GmbH, Köln 2007).