

Trademark seniority claims under EU law: Advantages and disadvantages

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Unique to European law, trademark seniority claims provide a practical and economical tool for trademark owners looking to consolidate national registrations. Nonetheless, seniority claims should be handled with caution to avoid irreversible consequences, as Pauline Pilaudeau explains.

Under European trademark law, seniority claims allow trademark owners to consolidate their trademark portfolios and reduce renewal costs. However, this approach presents significant risks, including the potential loss of earlier rights if the European trademark is successfully challenged.

First, what is a trademark seniority claim?

A seniority claim is a mechanism unique to European trademark law, which allows a European trademark (EUTM) to be associated with an older registered national trademark (or national designation of an international trademark). By linking the EUTM rights, in the relevant national territory, to the filing date of the earlier national trademark, the national trademark is "virtually" maintained in force by means of the EUTM, without it being necessary to renew the national title independently.

In the event of a later conflict, the rights holder can then act based on the EUTM, rather than national trademark law, while invoking the seniority claimed.

How does the trademark seniority system work?

The mechanism is provided for in Article 39 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 for claims in new EUTM applications, and in Article 40 for EUTMs that have already been registered.

It states clearly the effects and benefits of a trademark seniority claim under paragraph 3: *"Seniority shall have the sole effect under this Regulation that, where the proprietor of the EU trademark surrenders the earlier trademark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trademark had continued to be registered."*

• [How is it different to a priority claim?](#)

A trademark seniority claim should not be confused with a priority claim. Unlike the latter, seniority does not apply unitarily across the EU: rights dating back to an earlier date will only be valid for the territory of the member state of the old national trademark and will not apply to the other member states covered by the EUTM system. For example, if an EUTM claims the seniority of a German trademark dating back to 1 September 1994, the rights arising will only be valid from that date on German territory; in the other 26 EU member states, the rights arise only on the filing date of the EUTM itself.

• **Can you claim trademark seniority in multiple EU territories?**

An EUTM may claim the seniority of one or more national trademarks from the same or different member states. For example, the EUTM registration for 'Red Bull' (No. [000698720](#)) claims seniority over 118 previous national trademarks/designations across the territories of 25 member states.

• **What are the conditions for filing seniority claims?**

A trademark seniority claim must meet certain substantive conditions, namely:

- The registered owner of the EUTM and that of the old national trademark are identical;
- The old mark was registered at the time of filing of the EUTM application, and still in force on the day of filing of the seniority claim;
- The sign protected by the EUTM registration is identical to the national trademark;
- The trademarks designate identical products/services.

In the examination carried out by the European IP Office (EUIPO), only the identity of the signs is examined.

The trademark seniority claim must also meet formal conditions:

- It must be filed at the same time as the EUTM application, or within two months of that date (for EUTM applications), and indicate the EU member state(s) in which the older trademark is registered, the filing date and number of the relevant registration, and the goods or services for which the older trademark is registered;
- The supporting documents must then be submitted within three months of filing the seniority claim;
- For registered trademarks, the seniority claim may be filed at any time, and the supporting documents within three months of filing the claim application.

Major advantages of filing trademark seniority claims

• **Cost reduction: The main benefit of seniority claims**

Filing a trademark seniority claim based on an earlier national mark allows the latter to be associated with a more recent EUTM, by virtually tracing the trademark rights, in the relevant national territory, back to the date of the national mark. Since the older mark then survives through the EUTM, it is no longer necessary to keep the earlier national mark in force independently.

Therefore, the main benefit of seniority claims is economic since the renewal of the European title alone maintains all previous national rights.

While the savings may be negligible in cases where the seniority of a single trademark is claimed as, generally (depending on the country), national renewal fees are not very high, these costs can be particularly significant if the EUTM claims the seniority of many trademarks.

To take the example of the Red Bull EUTM mentioned earlier, which claims the seniority of 118 trademarks, the renewal of the single EUTM No. 000698720 allows 118 national rights to be maintained in force while saving the 118 corresponding renewal fees.

• **Streamlined formalities: Practical benefits for portfolio management**

In addition to the economic benefits, trademark seniority claims also hold practical advantages by reducing the administrative formalities of trademark portfolio management. Rather than having to renew and maintain a set of older prior trademarks, the earlier national rights are maintained via the single EUTM renewal.

The risk of abandoning the older, independent national rights

While the seniority claim presents significant financial and practical advantages in terms of portfolio and cost management, the practice of abandoning independent national titles does not come without risks, as any event affecting the EUTM will impact the national right. For example:

• **Challenges to seniority**

A third party could bring an action for invalidity, based on relative grounds, against a trademark registered after the old national trademark, but before the European trademark, or an action for infringement for acts committed after the registration of the old national trademark, but before the filing of the European trademark.

In such cases, if the old national title allowing action has not been renewed independently, it would be appropriate to invoke the later EUTM claiming the seniority of the national trademark.

It is highly likely that the opposing party's first line of defence would be to attempt to challenge the rights of the holder and, consequently, the claim of seniority; in particular, by:

– **Challenging the validity of the trademark seniority claim of the EUTM:** If there are irregularities (e.g. the designated signs/products are not identical). If the seniority claim is cancelled and the old trademark has not been maintained through the national route, then the right lapses.

– **Challenging the validity of the trademark seniority (i.e., the validity of the old right):** Article 39(4) EUTMR provides that *"The seniority claimed for the EU trademark shall lapse where the earlier trademark the seniority of which is claimed is declared to be invalid or revoked. Where the earlier trademark is revoked, the seniority shall lapse provided that the revocation takes effect prior to the filing date or priority date of that EU trademark."*

Thus, even if the independent national right is no longer in force due to its non-renewal at national level, it remains possible to contest its validity by an action for nullity or an action for forfeiture for non-use, provided that the ground for nullity or forfeiture existed on the day of the claim of seniority.

It is important to be particularly vigilant about the use of the older trademark in the relevant territory, therefore, and according to the conditions for establishing evidence of use. If the old trademark was vulnerable to an action for revocation for lack of use on the day of the seniority claim, and use was subsequently made in another member state, then this use will not allow the old trademark to be maintained for a national right, even though it might be sufficient to demonstrate the use of an EUTM.

– **Challenging the validity of the EUTM:** The obstacles that may stand in the way of (or call into question) an EUTM registration are more numerous than for national title due to its unitary effect. Thus, an obstacle existing in one member state (whether it is an absolute ground for invalidity or the existence of an earlier right) will be sufficient to undermine the entire EUTM registration, whereas such an obstacle would not normally impact a national registration in another country.

If the older national trademark has been lapsed in favour of the EUTM and that EUTM has been successfully challenged, then the invalidity of the EUTM will also impact the older national trademark. (The same applies to any action for revocation for non-use.) If the renewal deadline for the old trademark has expired (including the grace period), it will not be possible to reactivate the national right, meaning it will be definitively lost.

The benefits of maintaining national registrations

By maintaining national registrations, rights holders can mitigate these risks. For example, the Red Bull EUTM (No. 000698720) mentioned above may claim seniority over 118 national trademarks, but these are also maintained in force through national channels.

Weighing up the pros and cons

Although the trademark seniority claim mechanism allows for financial savings and easier portfolio management, it comes with the significant risk of losing earlier national rights and should be approached with caution.

For individuals, start-ups and small- and medium-sized enterprises, the potential benefits of the seniority system – to save national renewal fees and administrative formalities – are already negligible, since most will own comparatively small trademark portfolios.

Whereas multinationals with large portfolios (and dedicated renewals budgets) may find a real economic interest in the system. Given the risks, however, they will likely also maintain old trademarks through their national renewals.

Indeed, while seniority can be a useful tool to help strengthen and consolidate European trademark rights, we recommend maintaining national registrations in the most important territories and, in particular, for 'core' trademark rights.

To find out more about trademark protection in Europe, including strategies for trademark seniority claims, speak to your Novagraaf attorney or contact us below.

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