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THE PROTECTION OF TRADEMARKS: SECURING ON A LOCAL/INTERNATIONAL AND EUROPEAN LEVEL

GENERAL INFORMATION

The procedure for the registration of a trademark in Cyprus is relatively straightforward. As a starting point, an advocate in Cyprus may be appointed through a power of attorney as agent with respect to the registration of trademarks via form ES1 to enable him to act further. Although a preliminary search of the register can first be conducted to ascertain the ability to register the trademark, the process formally commences through the submission of a relevant application in the Registrar of Trademarks.

Notice of filing is provided by the Registrar, usually 2-3 weeks post filing. The class in which registration will be made has to be determined and the international system of classification is followed. The application is assessed according to legislative criteria, including the requirement for the mark to maintain a distinctive character, it must not deceive and it must not resemble marks already registered or pending registration on the basis of the principle of priority.

A registered trademark may be assigned to a person who may register his title as assignee with the registrar. Also, a person may become the registered user of a trademark, though this use of the mark is considered to be use of the proprietor of the mark and such right is not assignable.

Any natural person or legal entity is entitled to apply.

The Trademarks Law (Cap. 268 as amended by the Laws 63/1962, 69/1971, 206/1990 and 176(I)/2000) defines a 'mark' as a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. In order to be registrable, a trademark must contain or consist of at least one of the following essential features:

- name of the company /individual or firm represented in a special or particular manner;
- signature of the trademark applicant or a predecessor in its business;
- one or more invented words;
- one or more words that have no direct reference or quality of the goods, and are not, according to ordinary signification, a geographical name or surname or;
- any other distinctive mark.

A trademark cannot be registered if:

- it is likely to deceive or cause confusion;
- it is contrary to public law or morality;
- it contains any scandalous design or
- it would otherwise not be entitled to protection in a court of justice



- it is identical to another already registered trademark
- it closely resembles another already registered trademark

A. LOCAL REGISTRATION

1. Three relevant forms shall need to be completed. By means of the first form (ES1) the attorney is empowered to act on the behalf of the Applicant Company who wishes to protect the trademark with regards to the procedure of registration (similar to a Power of Attorney). Provided that the interested party provides all the relevant information of the company concerned, as registered office address, registration number etc., the attorney shall be able to fill in this form and have the interested party execute it. As a formal representative, the attorney shall then be the authorised person to proceed with the registration of the trademark.
2. Another two forms should be completed (ES2 and ES3, both available in the Registrar of Companies website), containing information on the company and a manifestation of the trademark and submit them altogether to the Registrar of Companies. The ROC will then inform the applicant on whether the trademark is acceptable to be registered and if the response is affirmative, a fee should be subsequently submitted to have the notice of the registration of the trademark published in the Official Gazette of the Republic of Cyprus.
3. Two months after the notice is published in the Gazette, the Applicant Company shall receive a notification from the ROC to pay an additional fee which shall be indicated at the time in order to have the certificate of registration issued.

It is worth noting that the procedure is quite time consuming and the time frame from the date of submission of the application until the Applicant Company actually receives a certificate of registration can be up to 3 years. However the trademark is protected automatically from the moment that the application is accepted, despite the fact that the actual certificate might be issued later.

Once the trademark is registered, it is essential to ensure registration renewal after 7 years lapse, counting from the day of submission of the form (and not actual receipt of the certificate). After the first renewal is made, it is up to the Applicant Company to renew same every 14 years, for as long as one wishes to do so.

B. INTERNATIONAL REGISTRATION

The international registration of Trademarks is secured under the Madrid Convention to which Cyprus is a party, as well as many other countries around the world.

However if the Applicant Company is interested in protecting IP rights in more than one jurisdiction, special care should be taken in order to ascertain all jurisdiction are members of the Convention. If the jurisdiction of interest is not a party, local registration in that jurisdiction shall be the only choice, which of course guarantees only local protection.

The local procedure shall need to be followed as a first stage therefore the three pre- mentioned ROC forms will have to be filled in which are hereby attached. Further to submission, the Applicant Company shall wait to hear from the ROC on whether the Trademark is acceptable to be registered and if the reply is affirmative it shall be given a notification and a relevant reference number.

This number shall be kept as it will be useful for the procedure to follow.



The Applicant Company shall then proceed to fill in the relevant WIPO (World Intellectual Property Organisation) which is available online at www.wipo.int. Each case is based on its own merits so there is no standard information to be completed.

Page 7 of the application requires calculation of the relevant submission fee in support of the application. This can be done in the WIPO website quite easily.

Once the form is completed, the Applicant Company should proceed and send everything to the relevant department of the ROC which deals with international registration of trademarks. If all is in order, the form shall be sent to the WIPO directly by the ROC. The procedure is rather time consuming but expected to take less than 3 years which is the time frame on local level.

C. EUROPEAN REGISTRATION

A Community Trademark (CTM) is a trademark valid across the EU (all 28 Member States) registered with OHIM in accordance with the provisions of the CTM Regulations.

A CTM grants its proprietor an exclusive right to prevent unauthorized use of the mark in trade without his/her consent.

Registration is valid for 10 years and can be renewed indefinitely for periods of 10 years thereafter.

CTMS shall be put to genuine use in the European Union within a period of five years following registration. Genuine use may be found when the mark has been used in only one part of the Community or it shall be revoked.

The purpose of this legal briefing is to provide a general guideline on the subject and not to be considered, in any way, as legal advice. It is advisable to seek professional and legal advice on this subject before proceeding with any general information provided to you. For further clarifications and advice please contact us at legal@economideslegal.com.

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