

Designation of the CTM via the Madrid Protocol

The Community Trade Mark Office (OHIM) joined the Madrid Protocol on 1st October 2004, meaning that a Community Trade Mark (CTM) can now be designated in an International Registration so as to seek unitary trade mark protection for all the European Union countries.

If protection is desired in many European Union countries, then this may well be more economical than national designations.

How does OHIM handle the designation?

Unlike, for example, the United Kingdom or the United States, where a designation of that country is treated as far as possible like a nationally filed application, OHIM adopts a different system for designations under the Madrid Protocol compared with applications submitted directly to it.

When OHIM receives from the World Intellectual Property Organisation (WIPO) the details of the International Registration (assuming that a second language has been indicated for the proceedings before OHIM) it will republish the bibliographic details and the class numbers in the CTM Bulletin; the list of goods and services will not be republished.

After republication, OHIM will take the following steps:

- preparation of the search report(s);
- formalities examination, including seniority claims and regulations for use, if applicable;
- examination of absolute grounds and oppositions.

Objections and opposition

If there is objection on absolute grounds, then OHIM will issue a notice to WIPO setting a two month deadline for response. WIPO will forward the notice to the holder.

Responses have to be submitted directly to OHIM, via an authorised representative if the holder is not in the European Union.

Correspondence with OHIM on the absolute objections is as for a directly filed CTM application; only the final decision whether to accept or to refuse the mark will be notified to WIPO.

Examination must be completed within six months of republication, with either a provisional refusal or a *first* statement of grant being issued.

The opposition period is the three month period commencing after the expiry of six months following republication.

If the opposition is found admissible, then a notice of provisional refusal will be sent to WIPO.

The opposition will then follow the same procedure as one filed against a directly filed CTM application.

Concluding the application process

Four possible scenarios following the application process are given below:

1. No objections on absolute grounds and no opposition: a first (i.e. no absolute grounds objection) and second (i.e. no opposition filed) statement of grant of protection sent to WIPO and the second publication takes place - *the designation then has the same effect as a directly filed CTM*.
2. Objection on absolute grounds but no oppositions: proceedings continue before OHIM until a final decision is reached, at which point a statement is sent to WIPO. If the absolute grounds objection is waived, a second statement of grant is sent to WIPO and the second publication takes place - *the designation then has the same effect as a directly filed CTM*.
3. Opposition filed but no objection on absolute grounds: on final opposition decision a statement is sent to WIPO indicating the outcome; if the opposition is rejected in whole or in part then second publication takes place - *the designation then has the same effect as a directly filed CTM (with a narrowed down specification if the opposition has been partially successful)*.
4. If there is both opposition and objection on absolute grounds, then the opposition proceeds only as far as being examined on admissibility, with the opposition proceedings then being stayed until a final decision is reached on the absolute grounds objection.

If the objection on absolute grounds is confirmed, then a statement is sent to WIPO and the opposition proceedings are closed and the opposition fee is refunded. If the objection on absolute grounds is reversed, the opposition proceedings then recommence; on final opposition decision a statement is sent to WIPO indicating the outcome; if the opposition is rejected in whole or part then second publication takes place - *the designation then has the same effect as a directly filed CTM (with a narrowed down specification if the opposition has been partially successful)*.

Reimbursement of fees

The situation for a *directly filed* CTM is that there is a basic application fee and an additional class fee for each class beyond three, due within a month of filing, together with a grant fee and an additional class fee for each class beyond three, payable if the application is in order for registration to take place.

In the case of a CTM designated in an International Registration, the designation fees payable on application include the registration fees; if the designation of the CTM fails then there will be a refund equivalent to the amount payable as registration fees had the case been filed directly.

In the case where there is partial failure and there are fewer classes than originally paid for, then there will be a refund equivalent to the additional registration class fees no longer applicable.

Conversion

If the CTM designation is withdrawn, refused or ceases to have effect, it can be converted to national designations under the Madrid Protocol for the countries not giving rise to the refusal (except for Malta, which is not in the Madrid Protocol and so would need to be converted to a national application). If conversion is for a number of countries, this will be less costly than the other option of converting into nationally filed applications (which would be the only option for the conversion of a failed directly filed CTM).

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