

The Basics

In order to obtain trade mark protection in the various European Union (EU) countries, you used to have to obtain separate trade mark registrations in those countries, with a Benelux registration covering Belgium, The Netherlands and Luxembourg. However, under the Community Trade Mark system, the proprietor of a Community Trade Mark (CTM) now has a single registration, enforceable throughout the EU. National trade mark systems still operate alongside the CTM system and the national systems may remain the most suitable option for some applicants, or else the International Registration system. However, the CTM system is much cheaper than obtaining and renewing up to 27 separate national registrations to cover the EU member states. The CTM system is administered by the Office for Harmonisation in the Internal Market (Trade Marks & Designs) - OHIM, based in Alicante, Spain.

Who can apply?

Any natural or legal person can apply for a CTM registration.

How do I apply?

Applications can be filed either direct at OHIM, or through the Trade Mark Registry of an EU member state.

Any applicant, proprietor or opponent who is not an EU resident must be represented professionally by either a European trade mark attorney, or by a legal practitioner qualified and working in one of the member states.

An application can be filed in any EU language. All applicants must also choose a second language from the five working languages of OHIM (English, French, German, Italian and Spanish) and this second language can be used:

- by OHIM if the application was not filed in one of the five working languages,
- by an opponent.

It is also possible to apply for a Community Trade Mark via the Madrid Protocol (International Registration) system if certain conditions apply: please see our information sheet on the Madrid Protocol for details. Although the general principles detailed in this sheet apply to the designation of the European Community under the Madrid Protocol, there are some procedural differences, particularly relating to the sequence of examination and opposition, and these are dealt with in a separate information sheet.

What can be applied for?

Any sign capable of distinguishing goods or services is registrable. This includes the shape of goods, their packaging, their colour and probably audible signs as well.

Not registrable are:

- descriptive marks (unless they have become distinctive through use in a substantial part of the EU),
- shapes which result from the nature of the goods,
- shapes which are necessary to obtain a technical result,
- shapes which add substantial value to the goods,
- marks which are words or devices used in the trade to indicate particular goods,
- marks liable to mislead the public on their nature, quality or geographical origin,
- marks contrary to public policy,
- marks protected by Article 6ter of the Paris Convention (national flags and emblems etc.),
- marks which would be considered offensive or blasphemous in any country of the EU.

Remember that there are **23** different official languages of the EU:

<i>Bulgarian</i>	<i>Finnish</i>	<i>Italian</i>	<i>Romanian</i>
<i>Czech</i>	<i>French</i>	<i>Latvian</i>	<i>Slovak</i>
<i>Danish</i>	<i>German</i>	<i>Lithuanian</i>	<i>Slovenian</i>
<i>Dutch</i>	<i>Greek</i>	<i>Maltese</i>	<i>Spanish</i>
<i>English</i>	<i>Hungarian</i>	<i>Polish</i>	<i>Swedish</i>
<i>Estonian</i>	<i>Irish</i>	<i>Portuguese</i>	

and so descriptiveness etc. in even one language can give rise to an official objection.

One application can cover any number of classes. There is an additional fee for each class claimed over a total of three. The International (Nice) Classification system is used.

Examination and search

OHIM only examines on **absolute** grounds, as listed above. Examiners can insist that an applicant disclaims exclusive rights to non-distinctive elements within a mark, where it is felt that inclusion of that element could give rise to real doubts as to the scope of protection. If a prior CTM registration or application is found, then both the applicant for the mark being examined and the owner of the mark found are notified. It is up to the owner of the prior registration or application to oppose the CTM application.

It is possible to request (at extra cost) that searches for possibly conflicting prior marks be carried out by **some** of the national offices. However many national offices (including those in the United Kingdom, France, Germany and Italy) do not carry out searches, and the search reports carried out by those who do are of limited value because of the lack of detail. If a conflicting mark is found, only the applicant for the mark being examined is notified. Proprietors of earlier marks are expected to keep a look out for marks that may conflict with their registrations.

For there to be a conflict, there must be a likelihood of confusion on the part of the public due to the similarity of the marks and/or goods/services.

Opposition

If a directly filed application passes OHIM examination on absolute grounds, it is advertised for opposition purposes. The opposition period lasts for three months. For CTM designations of International Registrations it is possible that the opposition procedures could commence before objections on absolute grounds are resolved.

Oppositions can be filed by:

- proprietors of earlier applications/registrations (both CTM and national marks),
- owners of unregistered marks of more than local significance, if the law of their state gives them the right to prevent use of the CTM applied for,
- proprietors of marks that fall under Article 6bis of the Paris Convention, i.e. well-known marks.

The losing party in any opposition may have to pay some of the other side's costs.

Note that opposition can only be based on prior rights, and not on absolute grounds. So an opposition cannot be on the basis, for example, that a mark is descriptive. Nor can it be on the ground that a mark was applied for in bad faith - this is an absolute ground.

A feature of the CTM system is that if an application is successfully opposed by someone on the basis of a right in any EU country, you cannot get a CTM registration at all. Instead, if you wish to maintain protection in the other EU countries of interest you will have to apply for separate national registrations (possibly

via the Madrid Protocol in the case of a failed designation of the CTM) in any other EU countries that are available, by conversion of the CTM application so as to retain the original filing (or priority date if applicable) of the CTM application. Please see our information sheet entitled "CTM - Oppositions" for more details.

Observations

After publication of an application, third parties can file "**observations**" that the mark is not acceptable on absolute grounds. If it is felt that an observation is well-founded, the Examiner shall issue an objection, and may eventually refuse the application. Applicants will be given copies of observations filed and the opportunity to respond.

Seniority

If you already own a national registration(s) and/or designation(s) of an International Registration in one or more EU countries and then obtain a CTM registration for the same mark covering all EU countries, the date of registration of your original registration(s)/designation(s) may provide an early date of proof of ownership of the mark in the corresponding countries.

It is preferable to indicate this position within **two months** of the filing date of the CTM application, although seniority can also be claimed after registration. Please see our information sheet entitled "CTM - Seniority" for more details.

Use

A CTM registration must be put to "**genuine use**" in any country of the EU within **five years** of registration.

If it is not used for a continuous period of **five years**, the registration may be cancelled for non-use.

However, a reasonable level of genuine use of the CTM in only **one** EU country may be enough to constitute use and ensures the protection of the mark throughout the EU.

Exhaustion of rights

The right of a CTM proprietor to sue for infringement is "**exhausted**" in respect of goods which have been put on the market anywhere in the EU by the owner of the CTM or with his consent.

Invalidation

A CTM may be invalidated if it is shown that it should not have been registered on absolute or relative grounds.

However, the validity of a CTM cannot be attacked by the owner of a prior right if he has acquiesced to the use of the CTM for **five years**.

Assignment

As it is a unitary registration, a CTM cannot be assigned for part of the EU. However a CTM can be assigned separately for

some or all of the goods or services for which it is registered. An assignment needs to be registered at OHIM if it is to be effective in relation to third parties.

Licensing

A CTM can be licensed for the whole or part of the EU and may be licensed for some or all of the goods or services for which it is registered.

A licence needs to be registered at OHIM if it is to be effective in relation to third parties.

Registration periods and renewal

A CTM registration lasts for **10 years** from its application date and is renewable indefinitely for terms of **10 years**.

European Union/European Community

European Community (EC) relates to the single market aspect of the European Union (EU), the latter additionally including common foreign and security policies in its scope. Therefore European Community is the official expression used in relation to the unitary trade mark rights that cover the EU countries.

Current members of the EU

Austria	Latvia
Belgium	Lithuania
Bulgaria	Luxembourg
Cyprus (South)	Malta
Czech Republic	Netherlands
Denmark	Poland
Estonia	Portugal
Finland	Romania
France	Slovakia
Germany	Slovenia
Greece	Spain
Hungary	Sweden
Ireland	United Kingdom
Italy	

For information on the impact of EU enlargement on the Community Trade Mark and general intellectual property rights in Europe, see our sheet *Intellectual Property: Enlargement of the EU - effect on Community Trade Marks, Community Designs and European Patents*.

Gibraltar and Jersey

A CTM Registration automatically provides trade mark protection in the Falkland Islands, Gibraltar and in Jersey without the requirement that it be registered in those countries. some or all of the goods or services for which it is registered. An assignment needs to be registered at OHIM if it is to be effective in relation to third parties.

This information is simplified and must not be taken as a definitive statement of the law or practice. For more information on Mewburn Ellis LLP and other intellectual property matters, please contact us or visit our website at www.mewburn.com. Mewburn Ellis LLP is a Limited Liability Partnership registered in England (no. OC306749). Registered Office at 33 Gutter Lane, London EC2V 8AS

London

33 Gutter Lane
London
EC2V 8AS

Tel: 020 7776 5300

Fax: 020 7776 5399

Bristol

22-24 Queen Square
Bristol
BS1 4ND

Tel: 0117 945 1234

Fax: 0117 926 5692

Manchester

Bridgewater House
Whitworth Street
Manchester M1 6LT

Tel: 0161 247 7722

Fax: 0161 247 7766

Cambridge

Newnham House
Cambridge Business Park
Cambridge CB4 0WZ

Tel: 01223 420383

Fax: 01223 423792