

brief guide to community trade marks

Since 1996 it has been possible to file a single application, through the Office for the Harmonisation of the Internal Market (OHIM), for a European Community Trade Mark (CTM) which gives Trade Mark protection in all twenty seven member states of the European Union.

Advantages of a CTM

- Substantial cost savings, not only on application but also for subsequent renewals.
- It is possible to maintain the validity of the registration through use in only one of the member states.
- A prior UK application is not required
- No official examination with respect to prior rights
- Provides protection in all 28 EU states

Disadvantages of a CTM

- During official examination an application may be objected to on absolute grounds resulting in the rejection of the entire application
- There is increased risk of opposition as prior rights in any country can provide the basis for opposition

It is possible to appeal when an application encounters difficulties, to convert it to a series of national applications in those countries where the grounds for refusal or opposition do not exist.

Registration is for an initial period of ten years with

further ten year periods available, upon renewal, in perpetuity.

The registration must be put to genuine use in at least one EU country within 5 years of registration. If it is not it may be cancelled for non-use.

It is possible to assign a CTM registration in totality to a third party but it cannot be split by territory. It is, however, possible to grant a licence for use in only part of the Community.

In circumstances where the holder's rights are being infringed the enforcement of such rights fall under the jurisdiction of the defendant's country of domicile or place of business. If this is not appropriate the plaintiff's place of business is used. Appeals are possible to the Court of Justice of the European Union.

Filing a CTM application is open to anyone regardless of domicile or place of business and it is possible to include the European Community as a party to an International application through the Madrid Protocol or to base the international application on an existing CTM registration.

The examination of the application by OHIM covers absolute grounds, for example distinctiveness, but ignores relative grounds such as conflicts with prior rights.

Whilst the official checks for conflicts with prior CTM registrations the results are not used as grounds for official objection; it is up to the owners of such rights to file any opposition if they wish.

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