

**BALKAN LEGAL FORUM 2006
BUCHAREST, ROMANIA**

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**THE EUROPEAN COMMUNITY TRADEMARK
(„CTM“)**

legal sources:

- Council Regulation (EC) No 40/94 of December 1993 on the Community trade mark (**CTMR**)
- Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (**CTMIR**)

legal sources:

- Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (**CTMFR**)
- Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)

main issues:

- material law
- formal law concerning proceedings before OHIM
- formal law concerning proceedings before national CTM courts

specific characteristics of CTM

- **unitary character:** valid as a whole in all EU member states
- **co-existence with NTM:** CTM does not prevail over national NTM, NTM-systems continue existing, prior NTM prevail over younger CTM and vice versa

specific characteristics of CTM

seniority:

- identical application as earlier NTM
- priority date of the earlier NTM may be claimed only with effect for this member state (=seniority)

filing of an application

- via national office or directly at OHIM
- e-filing recommended (lower fees!)
- application form
- language
- fees to be paid within one month after the filing date (application fee 3 cl. € 750/900, registration fee 3 cl. € 850, additional class fee € 150 per class)

filing of an application

representation:

- not required for natural/legal persons domiciled/established in the EU
- required for non-EU natural/legal persons
admission as representatives: all representatives allowed to act in trademark matters before national trademark offices of EU member states

filing of an application:

examination ex officio:

- formal requirements check (all necessary indications)
- application fee paid
- filing date granted
- classification of good/services
- absolute grounds

filing of an application:

- publication in OHIM Official Journal
- publication date
- 3 months time limit for third parties to:
- observations on absolute grounds
- opposition on relative grounds
- if nothing happens: registration

opposition

Reasons

Relative grounds

Identity (Art. 8(1)(a) CTMR)

identical signs + identical goods/
services

Likelihood of confusion

(Art. 8(1)(b) CTMR)

identical signs + similar
goods/services

similar signs + identical goods/services

similar signs + similar goods/services

„Weapons“

Earlier rights

Earlier registration or application

- CTM
- NTM
- Benelux mark
- International mark (in EU)

opposition

Reasons

Relative grounds

Mark filed by an agent

(Art. 8(3) CTMR)

Mark filed by an agent or representative without consent of the owner

Other rights (Art. 8(4) CTMR)

Right to file an opposition in accordance with national law

„Weapons“

Earlier rights

Mark (registered or not) in any country of the world

Non registered mark

Other signs used in the course of trade (not local)

(Depending on national law)

opposition

Reasons

Relative grounds

Reputation (Art. 8(5) CTMR)

identical/similar signs + different goods/services

Taking unfair advantage of/be detrimental to reputation/distinctiveness

„Weapons“

Earlier rights

Registered mark with reputation

opposition

formal requirements:

- time limit three months from publication for filing the opposition and for paying the opposition fee (€ 350,-; receipt!)
- writing
- obligatory indications (use form!)
- representation only mandatory for non EU-natural/legal persons

opposition

formal requirements:

- language: opposition must be filed in a language of the application which is also language of the OHIM: English, French, German, Italian and Spanish
- documents must be translated!

opposition

next steps:

- OHIM notifies opposition to applicant
- two months „cool off“ period (extendable on request by both parties)
- further observations: two months time period for opponent, two months time period for applicant, another two months for the applicant to reply (extendable if the party concerned gives reason)

opposition:

proof of use:

- can be requested by applicant
- if opponent's trademark is more than 5 years old
- opponent must proof genuine use of his trademark by appropriate evidence (advertisements, brochures, business paper, witnesses, „Google-Check“)
- if proof fails, opposition is rejected

opposition

- decision
- costs:

winning party has right to cost recover

opposition division fixes the amount on request (two months time limit)

maximum rates (Rule 94 Implementation Regulation)

cost decisions are directly enforceable in member states

cancellation

can be filed AFTER registration:

- absolute grounds
- relative grounds as opposition
- other relative grounds (name, portrayal, copy right, other IP rights)
- revocation (lack of use, common word, misleading character)

cancellation

who can file?

- absolute grounds: every natural and legal person
- relative grounds: holder of a prior right, 5 year acquiescence period

appeal

- to be filed before the Boards of Appeals within two months from notification of decision + fees (€ 800)
- grounds of the decision within four months from notification
- against decisions on absolute and relative grounds
- suspensive effect
- possibility of revision of the decision by the first instance within one month

appeal

- against decisions of the Boards of Appeal
- an action may be brought before the ECJ in Luxemburg (CFI)
- two months time limit
- CFI/ECJ may annul or alter the contested decision

effects of enlargement

- two more languages for application but no new OHIM languages
- automatic extension of CTM to RO and BG
- „grandfathering“ of existing CTM
- respect of earlier rights in RO and BG
- possibility to prohibit use of younger CTM only in territory of affected new member state
- exceptional opposition against applications filed between 01/06/2006 and 31/12/2006

Thank you for your attention!

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