

To give life to the discussion contained in the chapter, a brief introduction is offered on the office charged with a primary duty to ensure that the substantive principles and the procedure outlined in the CTMR are observed during the processing of CTM applications as well as opposition and cancellation proceedings.

B. Office responsible for CTM system

Article 2 of the CTMR establishes the office for the harmonisation in the internal market (trademark and designs), (hereinafter the Office or OHIM), as the chief office responsible for community trade mark registrations. As a body of the Community, OHIM enjoys a legal personality entitling it to acquire or dispose of real or movable property and be party to judicial proceedings while enjoying the most “extensive legal capacity accorded to legal persons” in each of the Member States.²³⁵ It carries out community objectives, which are in line with community law governing the internal market. OHIM is therefore expected to guide the national authorities as to how the community law in relation to trade mark registration is to be translated and carried out.

Within OHIM’s functional structure established under Article 130 of the CTMR, five units are directly responsible for decisions affecting CTM registrability, namely, the examination, opposition, cancellation, administration and appellate divisions. Examiners, in the examination division, are responsible for examining absolute grounds for trademark refusal,²³⁶ whereas the Opposition Divisions are responsible for decisions on oppositions against CTM registration.²³⁷ The Cancellation Divisions are responsible for all decisions regarding application for revocation or application for declaration of invalidity.²³⁸ An Administration of Trade Marks and Legal Division is responsible for deciding on all legal issues that do not fall within the competence of the above three divisions. Thus, the Administration Division is particularly responsible to take decisions on procedural matters.²³⁹ It is also duty bound to take decisions in respect of administrative issues such as those regarding “entries in the Register of Community trade marks”.²⁴⁰ At the top of these four divisions are the Boards

235 Cf. Article 115 of the CTMR.

236 Cf. Article 131 of the CTMR.

237 Cf. Article 132 of the CTMR.

238 Cf. Article 134 of the CTMR.

239 KITCHIN, D., et al, “Kerly’s Law of Trade Marks and Trade names” (4th ed.) 95 (Sweet & Maxwell, London 2005).

240 GASTINEL, E. & MILFORD, M., “The Legal Aspects of the Community Trade Mark”

of Appeal, which are responsible for deciding appeals resulting from, inter alia, the examiners' decisions as well as appeals against the decisions of Opposition Divisions and Cancellation Divisions.²⁴¹ An appeal involving a complex legal problem will normally be submitted before the enlarged Board of Appeal.²⁴² While the Boards of Appeal are the final decision making authority within the organisational structure of OHIM, their decisions can only be challenged before the Court of Justice of the European Union (CJEU) (formerly designated as the European Court of Justice (ECJ)) and the General Court (GC) attached to the CJEU (formerly known as the Court of First Instance (CFI)).²⁴³ Article 257 of the Treaty on the Functioning of the European Union (TFEU) provides for the possibility that the Boards of Appeal become judicial chambers attached to the GC, "maintaining their seat in Alicante but outside OHIM's structure".²⁴⁴

C. Subject matter of CTM protection

Article 4 of the CTMR states, in relation to a definition of a CTM, that a sign which a trademark may consist of is "any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings".

Article 4 of the CTMR, therefore, incorporates graphical representation and distinguishing capability of a sign as formal and substantive requirements for CTM registration.

The definition under Article 4 of the CTMR complies with the minimum registration requirements enshrined in Article 15 of the agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). By stipulating that "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark", Article 15 TRIPS accommodates the substantive and

52 (Kluwer Law International, The Hague 2001).

241 Cf. Article 135 of the CTMR.

242 Cf. Article 135(2) & (3) of the CTMR.

243 Cf. Articles 251 and 256 of the TFEU

244 BENDER, A. and KAPFF, P. von, "Born to be free – the Community Trade Mark in Practice", 32(6) IIC 625, 626 (2001), footnote 6.