

take precedence”. In the circumstances, under the CTM system, as under any other trademark system “based on a first-to-file approach, the determination of the filing date has an overriding significance for both the applicant and holders of other rights, since priority and other precedence rights stemming from that date will affect the availability of the protected sign to third parties”.<sup>545</sup>

## 2. Seniority right

The right to priority stipulated under the CTMR should not be confused with the concept of “seniority” which is actually another form of precedence of rights.<sup>546</sup> Under the concept, an applicant for Community trade mark may claim seniority of a national mark registered in a member state pursuant to Arts 34 and 35 of the CTMR.<sup>547</sup> Thus, “seniority is a mechanism which allows a trade mark owner to consolidate his existing trade mark registrations in Member States under the ‘umbrella’ of a CTM registration”.<sup>548</sup> Seniority right is, nonetheless, used in the CTMR for ease of distinguishing priority rights claimable under the Paris Convention and those which are purely the creation of the Community law in its relation to trade mark law of the member states.<sup>549</sup>

## ***F. CTM Application and Opposition proceedings***

Article 6 of the CTMR identifies registration as a sole means by which CTMs may be obtained and protected.<sup>550</sup> The mere use of a certain symbol as a trademark does not entitle the one who has adopted and used that symbol to

545 *Blueco Limited's application* [1999] E.T.M.R. 398, para. 12.

546 Timing is a demarcating line between the two seemingly same rights. While priority right is enjoyable within a certain period of time, the seniority right is limitless. Seniority right continues to be available to a proprietor of Community trade mark even where the earlier national trade mark on whose basis seniority is claimable is surrendered or allowed to lapse (*cf.* Article 34(2)). Nevertheless, “failure to satisfy the requirements concerning the claiming of seniority of a national trade mark shall result in loss of that right for the application” (Article 36(6) of the CTMR).

547 These two provisions are discussed exhaustively in chapter 5 *infra*.

548 ANNAND, R. & NORMAN, H., “Blackstone’s Guide to the Community Trade Mark” 73 (Blackstone Press, London 1998).

549 The interface between the CTM system and the trademark system of the Member States is addressed under chapter 5 *infra*.

550 *Cf.* MARX, C., “Deutsches, europäisches und internationales Markenrecht” (2nd ed.) 404 (Wolters Kluwer Deutschland GmbH, Köln 2007).

obtain a CTM protection by way of a registration in respect of that particular trade symbol.

### *I. CTM application*

Some preliminary issues regarding an application for a CTM, such as a right to apply for a CTM, an entitlement to file a CTM application as well as the languages to be used in respect of such an application, may be highlighted.

In line with Article 5 of the CTMR, any person, whether natural or legal, has a right to become a proprietor of the CTM. Such a person cannot be disqualified from owning a CTM on the ground that he/she/it is not a citizen or resident of the European Union.<sup>551</sup> The determination of the question, whether a particular body is a legal person entitled to own a CTM under the CTMR depends on how such a legal body is treated under a national law creating it. Thus, nothing will bar a legal person such as a company or a firm from owning a CTM, provided that a respective legal person enjoys under the national law, the right to conclude contracts, to sue and to be sued as well as to discharge any other legal obligations in its own name.<sup>552</sup>

However, as regards a right to file a CTM application, the CTMR employs a different approach in two alternative ways. Any properly qualified trade-mark lawyer and a professional representative registered with OHIM is competent to file a CTM application, provided that he has secured a proprietor's power of attorney as an evidence of consent to such a representation. Similarly, a trademark proprietor may not need to be represented before OHIM if he has knowledge and skills needed for the processing of a CTM application, provided that, where a person concerned is not an EU citizen, he fulfils the condition of having business establishment in the EU. Thus, firms established outside the EU and, which have no business dealings within the EU, are incapable of filing a CTM application on their own.<sup>553</sup>

A CTM application has to comply with the language requirement stipulated under Article 119 of the CTMR. Essentially, any application tendered before

551 Prior to the amendment made to Article 5 of the CTMR by Council Regulation (EC) No 422/2004 of 19.2.2004, not every natural or legal person could own a CTM. Proprietorship of the CTM was dependent on various factors such as nationality and place of domicile of the natural or legal persons concerned. For a detailed account on the legal position before the 2004 amendment, see MÜHLENDAHL, A., et al, "Die Gemeinschaftsmarke" 21 and 22 (Staempfli Verlag AG, Bern 1998).

552 Cf. Article 3 of the CTMR.

553 Cf. Articles 92 and 93 of the CTMR.

OHIM must bear one of the office's five languages, namely, Italian, Spanish, German, French and English. The rule is that in addition to the language in which the application is submitted, a CTM applicant has to choose an alternative language, which may be used in other proceedings relating to the CTM such as opposition and cancellation proceedings. A CTM application may, nevertheless, be tendered in a language other than OHIM's official languages provided a translation in one of the office's working language is made. It may thus be pointed out that the language's rules under the CTMR are flexible. For instance, a language in which the CTM application was filed may still be used for some proceedings before OHIM such as opposition, revocation, or invalidity, where the CTM proprietor is the only party to the proceedings.<sup>554</sup>

## 1. Procedure and contents

A CTM application may be filed either at OHIM or at the central industrial property office of a Member State or at the Benelux Trade Mark Office. It is left open for the applicant to decide where to lodge his CTM application. Applications submitted to central offices of the Member States have the same status as those filed directly at OHIM in Alicante, Spain. According to Article 27 of the CTMR, an application filed at the national industrial office or at the Benelux Trade Mark Office will acquire as its filing date the date on which all documents required by law to be included in the CTM application were filed at a relevant office provided that the application fee was paid within a month preceding the date when that application fulfilled the legal requirements. Unless applications, other than those filed directly at OHIM, are forwarded to OHIM within two weeks and, in any case, within a period not exceeding two months, such applications will be deemed to have been filed on the date on which the application reached OHIM.<sup>555</sup>

A CTM application must contain some information prescribed under Article 26 of the CTMR: a formal request for registration of a trade symbol as a CTM; identity of the applicant; information regarding the goods and services in respect of which registration of the trade symbol is requested; as well as a graphical representation of the trade symbol concerned.

As far as the identity of the CTM applicant is concerned, it suffices to point out that both natural and artificial persons may become proprietors of a CTM and hence entitled to file a CTM application. Whereas names, addresses and

554 Cf. ECJ, Case C-361/01 *P Kristina KIK* [2003] ECR I-08283, para. 17.

555 Cf. Article 25 of the CTMR.

nationalities of the CTM applicants may serve to prove the applicants' identity, names of legal persons are indicated by their official designations and those of natural persons are indicated by their surnames and given names.<sup>556</sup>

Since the principle of trade mark certainty dictates that a CTM protection should only be in respect of goods and services specified in the application,<sup>557</sup> a CTM applicant must expressly identify the goods and services which he intends to market or to offer using the mark applied for. He does so by classifying the goods and services in accordance with the "common classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended".<sup>558</sup> Moreover, in addition to paying a basic CTM application fee, the applicant is supposed to pay a "class fee for each class exceeding three to which the goods and services belong".<sup>559</sup>

Representation of the mark applied for is likely to be very easy, especially where the applicant is not interested in securing CTM registration in respect of some isolated graphical features or colours, in which case the mark will be reproduced in normal scripts. This kind of reproduction may involve "typing the letters, numerals, and signs in the application".<sup>560</sup>

## 2. Search procedure

Article 38 CTMR provides for search procedure. The function of the search reports is to inform the applicant about prior rights which may conflict with the sign for which he has applied, so that he may take appropriate action even before publication. These search reports may result in the applicant withdrawing the application, if he finds there are clearly conflicting marks which will prevent him from obtaining a CTM registration and from using the mark in all Member States.<sup>561</sup> Alternatively, he may amend the application, for instance by restricting the specification of goods and services in order to avoid a conflict of goods. Finally, he may take the matter up with the owner of the prior conflicting marks in order to seek an agreed solution.

556 Cf. Rule 1 of the CTMIR.

557 Cf. GASTINEL, E. & MILFORD, M., "The Legal Aspects of the Community Trade Mark" 98 (Kluwer Law International, The Hague 2001).

558 Cf. Rule 2(1) of the CTMIR and Article 28 of the CTMR.

559 Cf. Rule 4 of the CTMIR and Article 26(3) of the CTMR.

560 Cf. Rule 3(1) of the CTMIR.

561 Cf. KITCHIN, D., et al, "Kerly's Law of Trade Marks and Trade names" (4th ed.) 117 (Sweet & Maxwell, London 2005).

It may be deduced from the provisions of Article 8(1) that the search for earlier rights will be carried out in respect of identical trademarks for identical goods or services; similar trademarks for identical goods or services; similar trademarks for similar goods or services; and identical trademarks for similar goods or services.<sup>562</sup> While the search report may form the basis for an opposition against a CTM registration, the opposition and cancellation divisions are not obliged to observe the outcome of the search.<sup>563</sup> Similarly, the search report may not serve as a conclusive evidence as to whether or not a certain trade mark has a reputation in the community within the ambit of Article 8(5) of the CTMR.<sup>564</sup>

Before the revision of the Council Regulation (EC) No 40/94<sup>565</sup> by the Council Regulation (EC) No 422/2004 of 19 February 2004,<sup>566</sup> Article 39 of the revised Regulation required a mandatory national search to be carried out by the central industrial property office of all Member States participating in the system. For CTMs filed on or after 10 March 2008 (the date when the revisions of the Article came into force), the national search is no longer mandatory, but remains optional depending on the willingness of the CTM applicant to have a search conducted.

The old search system applied to all CTM applications made before 10 March 2008. Upon receipt of an application, OHIM was required to adhere to three basic steps, namely, to accord a filing date to a CTM application; to draw up “a Community search report citing those earlier Community trademarks or Community trademarks applications discovered”<sup>567</sup> and to transmit a copy of the CTM application to the national trademark office of each Member State participating in the search system.<sup>568</sup> The national office had to conduct a search

562 KOOIJ, P.A.C.E. van der, “The Community Trade Mark Regulation: An Article by Article Guide” 80 (Sweet & Maxwell, London 2000).

563 Cf. Articles 132 and 134 of the CTMR.

564 KOOIJ, P.A.C.E. van der, “The Community Trade Mark Regulation: An Article by Article Guide” 80 (Sweet & Maxwell, London 2000).

565 OJ L 11, 14.1.1994, p. 1.

566 Some weaknesses inherent in the old search system led to the revision of Article 39 of the Council Regulation (EC) No 40/94. Lack of uniformity of national search reports is mentioned in the Commission report on the operation of the system of searches resulting from Article 39 of Council Regulation (EC) No 40/94. Cf. Commission document COM (2002) 754 final, available at <<http://oami.europa.eu/pdf/mark/ec1.pdf>> (status: 30 July 2012).

567 The discovered earlier CTMs are those “which may be invoked under Article 8 against the registration of the Community trade mark applied for”. Cf. Article 39(1) of the Council Regulation (EC) No 40/94 as it stood before 10 March 2008.

568 The copy of the CTM application is only sent to the trademark offices of the Member States which informed OHIM of their decision to operate a search in their registers of

and submit a search report to OHIM within three months from the day it received a copy of CTM application. The national search report fulfils two connected objectives: it reveals earlier national rights or national trademark applications which can be invoked against registration of the CTM.<sup>569</sup>

According to the provisions of the revised Article governing the new search procedure, the search system is still very important: OHIM, upon according a filing date to the application, draws up a Community search report the same way it used to do in the old search system.<sup>570</sup> Unless “at the time of filing a CTM application, the applicant requests that a search report also be prepared by the central industrial property offices of the Member States”, OHIM is no longer obliged to send a copy of CTM application to the national trade mark office of the Member States.<sup>571</sup>

The new search system has made national searches optional. In order for a national search to take place three main conditions have to be fulfilled:

- Application for national search must be made together with the application for CTM registration.
- A request for a national search is only possible in the Member States which had informed OHIM that a national search report in respect of CTM application will be conducted by their central industrial property offices.<sup>572</sup> Opting for a national search implies that all participating national offices will carry out the search. The applicant cannot decide to opt for few countries among the current 16 participating offices.
- The national search fee has to be paid within the time limit for the payment of the filing fee. This time limit is one month. If the optional search fee is not paid in time, the national search cannot be conducted.

However, some obligations that OHIM had in the old search system still apply in the new search system with slight modifications. For instance, under the old system OHIM had to transmit to the CTM applicant a Community search report and the national search reports, still it does the same under the new system. The only difference is the time limit within which OHIM has to transmit such reports.

trademarks in respect of CTM. *Cf.* Article 39(2) of the Council Regulation (EC) No 40/94 as it stood before 10 March 2008.

569 *Cf.* Article 39(3) of the Council Regulation (EC) No 40/94 as it stood before 10 March 2008.

570 *Cf.* Article 38(1) of the CTMR.

571 *Cf.* Article 38(2) of the CTMR.

572 By March 2008, only 16 European countries operated a national search in respect of CTM applications. These are Austria, Bulgaria, Czech Republic, Denmark, Finland, Greece, Hungary, Ireland, Lithuania, Poland, Portugal, Romania, Slovak Republic, Spain, Sweden and United Kingdom.

Since the old search system allowed the national offices to submit search reports to OHIM within three months, OHIM could transmit the search reports to the applicant within three months as well. However, where the optional search is preferred and granted under the new system, the national office has the maximum duration of two months within which it has to submit to OHIM the national search report. OHIM has therefore to transmit such national search reports immediately to the CTM applicant after receiving them.<sup>573</sup>

Thus, both new and old search systems oblige OHIM to inform the proprietors of any earlier CTM rights or earlier CTM applications of the fact that a Community search report in respect of CTM application similar to, or closely resembling, theirs has been published.<sup>574</sup> Publication of the CTM application is mandatory under Article 39 of the CTMR. Such publication allows proprietors of earlier rights to challenge registration of the published CTM application on the basis of relative grounds for trademark refusal.

## *II. Opposition against CTM registration*

Where, in the opinion of OHIM, a particular sign has met the requirements of the CTMR,<sup>575</sup> such a sign will be registered as a CTM, provided no objection against its registration has been raised, or where such objection has been raised, it has not been successful, or has been withdrawn; and the registration fee has been paid.<sup>576</sup>

Opposition is a procedure which enables proprietors of earlier trademark rights to oppose registration of junior marks. The opposition proceedings are therefore “concerned with the ability of an applicant to acquire proprietary rights in the mark for which he sought registration”.<sup>577</sup> Oppositions may generally be based on relative grounds for trademark refusal mentioned under Article 8 of the CTMR. While third parties are not entitled to institute opposition proceedings before OHIM, they may still raise an objection against CTM registration. As a

573 See article 38(6) of the CTMR (new system) and Article 39(5) of the Council Regulation (EC) No 40/94 as it stood before 10 March 2008 (old system), respectively.

574 Cf. Article 38(7) of CTMR.

575 These requirements include those respectively described under Articles 4, 7, 8, 25 and 26 of the CTMR; namely, subject matter of the CTM registration, absolute grounds for refusal of registration, relative grounds for refusal of registration and conditions with which applications must comply.

576 Cf. Article 45 of the CTMR.

577 PHILIPS, J., “Trade Mark Law: a Practical Anatomy” 425 (Oxford University Press, Oxford 2003).