

Differences between a CTM and an International Registration (IR) designating the EU

Legal and practical differences between routes	Direct CTM	IR designating the EU
Persons who can be proprietors	Art. 5 CTMR Any natural or legal person	Art. 2 (1) (i) MP National of a Contracting State, or domiciled in a contracting State or having an effective industrial or commercial establishment in a Contracting State of the Protocol
Languages	Art. 119 CTMR - 1st from the official languages of the EC; - 2nd from the 5 of OHIM (and different from the 1st) *	Art. 145 CTMR, R 126 CTMIR, R. 9 (5)(g)(ii) CR - 1st language = language of the IA which is always a language of OHIM; - 2nd from the 4 remaining languages of OHIM
Translations of list of goods and services	Art. 120, 121 CTMR, R. 85 (5) CTMIR In all official languages of the EC	Art. 152 CTMR Re-publication in Part M1 limited to Class numbers, no multilingual elements re-published and no translations needed
Priority	Art. 29 CTMR, R. 6 CTMIR A priority claim can be made in the CTMA or within a two-month period of the filing date	Art. 4 (2) MP, R. 9(4)(a)(iv) CR A priority claim (normally of the basic application) can be made at the moment of filing an international application
Seniority	Art. 34, 35 CTMR, R. 9 CTMIR At the moment of filing or within 2 months thereof. Seniority can also be claimed after registration of the CTM	Art. 34, 35 CTMR, R. 9 CTMIR At the moment of filing or within 2 months thereof. Seniority can also be claimed after registration of the CTM
How to file?	R. 80, 82, 83 CTMIR - forms mailed, faxed, delivered in situ - e-filing	R. 9(2)(a) CR WIPO MM2 or MM3 Forms sent - through an office of origin for IAs; - through the office of the Contracting

		Party or directly to WIPO in case of subsequent designation under the Protocol Means (mail, fax) according to OHIM's rules
Where to file?	Art. 25 CTMR - at OHIM; - at a national offices of an EU Member State, including Benelux	Art. 2(2) MP, R. 1 (xvi) CR - through an Office of Origin
Time limits for examination	No time limit for AG and RG examination	R. 112 (5) CTMIR, Art. 5 (2) (b) MP - 6 months for AG; - 18 months maximum for issuing provisional refusal on any grounds
Classification	Art. 28 CTMR, R. 2 CTMIR Examined by OHIM	R. 9 (4) (a) (xiii), 12, 13 CR Examined by the Office of Origin and the IB, accepted by OHIM
Formalities	Art. 36 CTMR, R. 9 CTMIR Examined by OHIM	Art. 3 MP, R. 9 CR Examined by the Office of Origin (not necessarily same typology of marks for example)
Absolute grounds examination	Art. 37 CTMR, R.11 CTMIR Ends by the publication of the CTMA in Part A of the Bulletin for opposition purposes	Art. 154 CTMR, R. 112-113, 116 CTMIR 6-month period to examine AG starts by re-publication in Part M of the Bulletin of the IR designating the EC. Ends by the sending of a first Statement of Grant of Protection or a Provisional Refusal on AG
Relative grounds examination	Art. 41- 42 CTMR, R. 15- 22 CTMIR - 3-month opposition period only opens as from publication of the CTMA if and when it has been accepted on AG - Proof of use: 5 years counted back from the publication of the CTMA	Art. 156 CTMR, R. 114-115 CTMIR - Fixed period to oppose from month 6 until month 9 of the first republication. Provisional refusal sent to WIPO based on existence of admissible opposition. Then, no difference in opposition procedure compared to direct route (except withdrawal of the IR done before the IB). - Proof of use: 5 years counted back from the opening of the opposition period (6 months after the first re-publication of the

	for opposition	IR designating the EC)
Publication	Art. 39 CTMR, R.12, 84 and 85 CTMIR CTM Bulletin: - Part A, CTMA (applications) - Part B, CTM (registrations)	R. 32 CR, Art. 152 CTMR - International Gazette (seniority details and refusals are only published there); - CTM Bulletin Part M at 2 different moments (second language only published there)
Rights conferred against third parties	Art. 9 (3) CTMR From the date of publication of the registration of the CTM - Reasonable compensation for matters arising after the publication of the CTMA in certain cases	Art. 151 (3) CTMR - From the date of the second re-publication of the IR designating the EC in the Bulletin - Reasonable compensation for matters arising after the first re-publication of the IR designating the EC in the Bulletin
Register, records and certificates of registration	Art. 120 CTMR, R. 24, 84 CTMIR CTM Register kept by OHIM	Art. 5 ter, 9 bis MP, R. 14 CR International Register kept by the IB
Inspection of files	R. 89 (2) CTMIR Inspection after publication of CTMA	R. 89 (2) CTMIR Inspection after re- publication of IR (before AG examination)
Use requirements	Art. 15, Art. 42 (2,), Art. 51 and Art. 57 (2) CTMR 5 years from Registration Date	Art. 160 CTMR 5 years from the date of the second re-publication
Dependence	N/A	Art. 6 (3) MP Dependence between the IR and the basic mark during 5 years from the date of the IR
Conversion	Art. 112 CTMR - conversion into national marks	Art. 159 CTMR, R 122, 123 CTMIR, Art. 2 (20) MP, R. 24 (2)(a)(ii), (6), (7) CR - conversion into national marks; - “opting back” into designations of Member States

Division	Art. 44, 49 CTMR, Rule 13a, 25a CTMIR Possibility of division of the CTMA or of the CTM	N/A
-----------------	--	-----

Abbreviations:

AG =Absolute grounds for refusal

Art. =Article

CR = Common Regulations

CTM = Community Trade Mark

CTMA = Community Trade Mark Application

CTMFR= Community Trade Mark Fee Regulation

CTMIR = Community Trade Mark Implementing Regulation

CTMR = Community Trade Mark Regulation

EN = English

EU = European Union

FR = French

IA = International Application

IB = International Bureau

IR =International Registration

MP = Madrid Protocol

MS = Madrid System

NA = Non Applicable

OHIM = Office for Harmonization in the Internal Market

RG = Relative grounds for refusal

R. = Rule

SP = Spanish

* 22 languages (Irish will be used as from 2012).