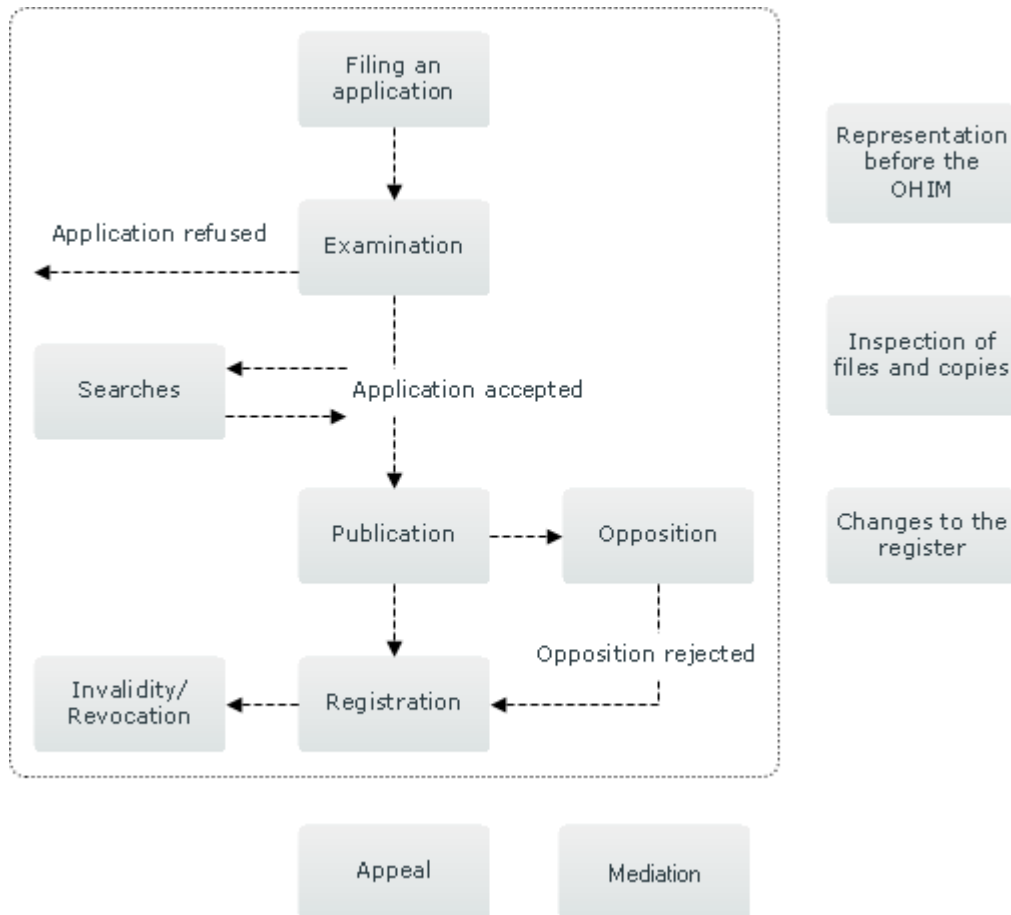


## The scheme of Community Trademark registration process at OHIM

OHIM's current target is to register straightforward CTM applications, for which no oppositions are filed, within 26 weeks

Basic information about each process appears if you position your cursor over the relevant box



## Classification

As your trade mark serves to identify the origin of your goods or services and to differentiate them from those of your competitors, the choice of the list of goods and services which must be included in a CTM application, together with the choice of the trade mark, determines the scope of protection.

The list of goods and services must be worded in such a way as to indicate clearly the nature of the goods and services, and to allow each item to be classified - preferably in only one class of the Nice Classification.

Please note that the original list of goods and services included in a CTM application cannot be extended but only limited. In other words, you may not add products or classes to the application originally filed.

When a CTM covers more than three classes of goods or services, an extra fee has to be paid for each additional class. Therefore, before filling in your CTM application form, we recommend that you consult the following different classification systems and tools:

### **EuroClass 2.0**

OHIM has launched a new improved version of its popular [EuroClass](#) tool, incorporating the functions of the now obsolete EuroAce and EuroNice applications.

### **Goods and Services**

Your trademark serves to differentiate your goods and services from those of your potential competitors in the marketplace, so when you file a trade mark application, it is important that you indicate very clearly for which goods and/or services your trade mark will be used.

### **Nice Classification**

To put it very simply, all of the goods and services that we can find in the global marketplace are categorised by 'classes', based on an international agreement with a somewhat complicated name: The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

Basically, if something exists and can be marketed, be it goods or be it services, it is in one of the Nice Classification's 45 classes.

Most people simply refer to it as the [Nice Classification](#), and it classifies goods into classes 1 to 34, and services into classes 35 to 45. Each class is represented by a class heading which gives general information about the type of goods or services covered.

For example, the Class 25 heading says: "Clothing; footwear; headgear", the Class 15 heading says "Musical instruments" and the Class 3 heading says "Bleaching preparations and other substances for laundry use; cleaning polishing, scouring and abrasive preparations; Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices".

When you make your trade mark application, the list of goods and services must be worded in such a way as to indicate clearly the nature of the goods and services, and to allow each item to be classified - preferably in only one class of the Nice Classification.

Also worth noting is that the original list of goods and services included in a CTM application cannot be extended but only limited. In other words, you may not add products or classes to the application originally filed.

At the time of filing, and included in the application fee, you can indicate any number of classes. However, if you choose more than three classes, a fee is payable for each class after the third one.

OHIM will apply the 10th edition of the Nice Classification as from 1 January 2012, according to a Communication of the President.

### **EuroClass**

To make it easier, OHIM offers you EuroClass, a useful tool to assist you when filing your trade mark and when trying to organise your goods and services into the correct classes.

This tool helps you with the classification of goods and services, allowing you to compare the content of the national classification databases and the acceptance of goods and services in twenty national trade mark offices.

If you select a term from the result list that is shown as accepted by OHIM for your trademark application, you can guarantee that it will be automatically accepted by OHIM.

EuroClass also provides translations for goods and services and again shows the acceptance by each office.

## **Filing a CTM application**

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Community trade mark applications may be filed online, by fax or by mail. A form is available for CTM applications made by fax or by mail.

**The minimum requirements to register a trade mark**

You need to complete the application form with

- name and address of the applicant
- indication of the first and second language
- a representation of the trade mark
- a list of goods and services for which the mark is to be registered
- payment of the fees
- signature

**Claiming priority**

If you qualify to claim priority under an earlier identical trademark you can claim it either in the CTM application or within a period of two months from the filing date of the CTM application making your CTM effective retroactively to the date of filing of the claimed trademark.

**Claiming seniority**

The Community trade mark has been designed to complement the national systems of protection. If applicants or proprietors of a Community trade mark already hold a prior identical national or international trade mark with effect in one or several Member States for identical goods and services, they may claim the seniority of that mark with the CTM application or within two months of its filing or anytime after registration of the CTM, preserving their prior rights even if they do not renew their earlier mark.

## Examination

On receipt of the CTM application, the OHIM issues a receipt and starts the examination procedure which includes the following steps:

- granting the filing date when the application meets the minimum requirements (name and address of the applicant, a representation of the trade mark, list of goods and services, payment of the basic fee)
- conducting a goods and/or services classification check
- conducting a formalities examination, which includes checking the signature, languages, owner and/or representative data, priority and/or seniority claims
- accepting or refusing the trade mark as a sign (examination for absolute grounds for refusal)
- sending the list of goods and services to the Translation Centre for Bodies of the European Union

If at any stage of the examination process a deficiency is detected, an objection letter will be sent to the applicant to remedy the deficiency within two months. If the deficiency is not remedied, the application will be provisionally refused or, if the deficiency concerns a priority or seniority claim, the claim will be refused. These refusals can be appealed before the Boards of Appeal of the OHIM.

If no problems arise during the examination, or once the objections are successfully dealt with, the trade mark is published after the Office has received the translations into all official languages of the EU from the Translation Centre in Luxembourg. The OHIM does not inform the applicant of the publication date and Bulletin reference. Users wishing to know when their CTM application is published, can use the CTM Watch e-mail "alert" service, available via [MYPAGE](#).

If the CTM application is refused, it will not be published. You can consult the refused CTM applications [online](#).

For further information, please see the guidelines on examination.

### **Third party observations**

After the publication of a Community trade mark application, third party observations can be filed (Article 40 CTMR) which may relate to the existence of an absolute ground for refusal (Article 7 CTMR).

Once regular observations are received, the Office will issue a receipt to the person making the observations ("observer") and the observations will be communicated to the applicant. The observer will thereafter not receive any further communication from the Office. Specifically, he will not be informed about the outcome of any re-examination of the application. Observers wishing to be informed of the further fate of the respective CTM application will however be able to access information about the status of an application via the Office's Internet site ([oami.europa.eu](http://oami.europa.eu)) and its free online access to CTM applications and registrations via CTM-ONLINE.

The Office will consider in its re-examination of CTM applications that have not been opposed only such observations that are received within the opposition period (three months from the day of publication).

For more information, please consult the [communication No 2/09 of the President of the Office concerning observations under Article 40 of the Community Trade Mark Regulation](#)

## **Publication of the CTM application**

Once the CTM application is accepted, it will be published in Part A of the Community Trade Marks Bulletin. Publication takes place as soon as the national office and OHIM search reports have been issued to the applicant.

The publication of the application in Part A of the Bulletin opens the three month period for filing an opposition.

After the publication of a Community trade mark application, third party observations can be filed which may relate to the existence of an absolute ground for refusal (see Examination section).

In addition, publication of the CTM application in Part A of the Community Trade Marks Bulletin permits file inspection to be requested.

The following, if applicable, are found under each application published:

- file number of the application
- filing date of the application
- date of publication of the application in the CTM Bulletin
- reproduction of the trade mark
- collective mark
- three-dimensional mark/ hologram / sound mark/ olfactory mark/ colour mark/ other
- description of the trade mark
- indication of colour(s)
- figurative elements (Vienna Classification)
- disclaimer
- acquisition of distinctive character by use
- name, address and nationality of the applicant
- name and address of the representative
- language in which the application is filed and second language
- goods and services protected (Nice Classification)
- country, date and number of the application for which priority is claimed
- name of the exhibition and date of the first display (priority under Article 33 of the Community Trade Mark Regulation (CTMR))
- seniority: country; (a) registration number; (b) registration date; (c) filing date; (d) date of priority
- transformation: number of the international registration designating the European Community cancelled; (a) date of the international registration or (if applicable) of the subsequent designation; (b) date of priority of the international registration (if applicable)

## Searches

The Community search report is drawn up from OHIM's database and lists any identical or similar earlier Community trade marks (including International Registrations designating the EU). When the new application has been published, proprietors of the earlier trade marks or trade mark applications cited in the report are informed by letter about the new application. This is called a "surveillance letter".

Community search reports and surveillance letters are sent as a service that is included in the application procedure and, as such, are covered by the basic application fee.

When the national search option is selected by the applicant, OHIM requests the production of national search reports from the relevant participating national offices, who remain responsible for the content of these reports.

The results of the search reports as well as the surveillance letters are for information only, i.e. the citation of a given trade mark should not be considered to constitute a finding that a conflict in fact exists. Such a conclusion can only be reached if and when an opposition is filed and decided upon.

The purpose of the search reports is to give the applicants the possibility of withdrawing their applications after analyzing the report contents. The surveillance letters inform proprietors about new, similar trade marks and they can then decide whether or not to file an opposition. For further information consult the [FAQ about searches](#).

### **Community search report**

This report is drawn up from OHIM's database of prior CTM applications and registrations and prior International Registrations designating the EU, taking into account the filing date, the trade mark name, the figurative elements of the mark (if applicable) and the classes of goods and services according to the [Nice Classification](#)

All figurative elements need to be classified in order to perform a search. For this, the OHIM uses a modified version of the Vienna classification of figurative elements called the [OHIM Vienna Classification Manual](#). This manual is based on WIPO's latest version of the Vienna Classification for figurative elements which has been adapted to OHIM's specific needs (for example, it includes the creation of some new codes).

Regarding goods and services, please note that only the Nice classes and not the particular goods or services are considered for these searches. The search engine performs cross searches between classes when similarities are considered to exist between them.

The Community search report lists the cited trade marks using the INID codes following the WIPO standard. Representations of figurative marks are for the time being not included in the search reports but can be found in the [online database](#) for Community trade marks.

### **National search reports**

National offices participate on an optional basis in the national search system. Following Rule 5a CTMIR, the search reports should contain some minimum compulsory elements. The format, however, may differ from one office to another. In any case, both format and contents remain the responsibility of the issuing office and in this respect, the role of the OHIM is limited to the reception of these reports and their transmission together with the Community search report. Each national report identifies the issuing office and any further inquiry can be addressed directly to the national office.

The national searches are optional which means that they will be prepared only if an applicant makes a request at the time of filing and pays the appropriate fee. If national searches are requested, this will automatically extend to all participating national offices.

## Opposition



'Opposition' is a procedure that takes place before OHIM when a third party requests the Office to reject a Community trade mark application (CTMA).

Once published there is a three-month opposition period. If no oppositions are filed during this period, the application proceeds to registration.

In general terms, an opponent must have rights in an earlier trade mark or other form of trade sign. The grounds on which an opposition may be made (called 'relative grounds for refusal') are indicated in [Article 8](#) of the Regulation. For an opposition to be successful, the trade mark applied for must be found to be incompatible with such rights. Any proceedings start with a period during which parties can negotiate an agreement, the so-called "cooling-off" period. During this period the parties are given the possibility of terminating the proceedings without incurring additional costs.

When an opposition is filed, the proceedings will include an exchange of observations from both the opponent and the applicant (the 'parties'). After considering these observations, and if agreement has not been reached between the parties, the Opposition Division of OHIM will decide either to reject the contested application totally or in part. If the opposition is not well founded it will be rejected. If the CTMA is not totally rejected, and provided there are no other oppositions pending, it will proceed to registration.

The decision of the Opposition Division is subject to appeal by any of the parties. The appeal is decided by OHIM's Boards of Appeal. A further appeal can be made to the Court of First Instance of the European Communities (CFI) and ultimately to the Court of Justice of the European Communities (ECJ).

### **How to file an opposition**

Oppositions against Community trade mark applications may be filed online, by fax or by mail. Should you wish to file an opposition by fax or by mail a form is available.

The use of the form for the Notice of Opposition is not compulsory. However, the correct use of the form normally ensures that the Notice of Opposition will not face any deficiency. In that case, reading the relevant [explanatory notes](#) is highly recommended. They will guide you through the completion of the Notice of Opposition form and provide indications on how to submit it, what fees are due and how to pay them.

### **General outline of opposition proceedings**

- [filing of the notice of opposition](#)
- [admissibility check](#)
- [the "cooling-off" period](#)
- [the adversarial part of the proceedings](#)
- [request for proof of use](#)
- [end of the proceedings](#)
- [opposition against international registrations designating the EC](#)

## **Registration**

An application will be registered when the following conditions have been met:

- The examination of the trade mark has raised no objections or the objections raised have been waived; and
- Either no opposition has been filed, or any oppositions filed have been rejected.

### **Publication**

The registered trade mark will be published in Part B of the Community Trade Marks Bulletin, and OHIM will send the applicant a link in order to download a certificate in PDF format.

The rights conferred by a Community trade mark prevail against third parties from the date of publication of registration of the trade mark. Reasonable compensation may, however, be claimed in respect of matters arising after the date of publication of a Community trade mark application. A court may not decide upon the merits of the case until the registration has been published.

### **Certificate of registration**

The PDF certificate provided by OHIM contains:

- the date of filing the application
- the file number of the application
- the date of the publication of the application
- the name and address of the applicant
- the name and business address of the representative, unless the representative is an employee. If there is more than one representative, only the name and business address of the first named representative, followed by the words "and others", will appear. If an association of representatives has been appointed, only the name and address of the association will appear
- a reproduction of the mark. If the mark is in colour, this will be indicated unless the applicant has said that they do not wish to claim protection for the colour. If the applicant has filed a description of the mark, this will also be included in the certificate
- a list of the goods and services covered by the mark
- the language in which the application was filed and the second language which the applicant indicated in the application
- the date of registration of the mark in the Register and the registration number.

If they formed part of the application the certificate may also contain the following:

- claims of priority
- claims of exhibition priority
- claims of seniority of an earlier registered trade mark as referred to in Article 34 CTMR
- a statement that the mark has become distinctive through the use which has been made of it, as referred to in Article 7(3) CTMR
- a declaration by the applicant disclaiming any exclusive right to some element of the mark as referred to Article 37(2) CTMR
- an indication that the mark is a collective mark
- a statement that the application results from a transformation of an international registration designating the European Community pursuant to Article 156 CTMR, together with the date of the international registration pursuant to Article 3(4) of the Madrid Protocol or the date on which the territorial extension to the European Community made subsequently to the international registration pursuant to Article 3 ter (2) of the Madrid Protocol was recorded and, where applicable, the date of priority of the international registration.

### **Further copies of the certificate**

The Office will provide certified or uncertified copies of the certificate of registration, on payment of a fee.

### **Making changes to the CTM after the registration**

Certain changes can be made to a registered CTM. These include:

- correction of mistakes and errors in the Register and in the publication of the registration
- alteration of the registration, such as limitation of the goods and services
- division of a registration
- change of the name or address of the proprietor of the Community trade mark or of their registered representative
- claiming seniority after registration of the Community trade mark.

## **Invalidity and revocation**

Throughout the life of a Community trade mark, the rights of its proprietor may be revoked or declared invalid. OHIM has exclusive jurisdiction with regard to direct revocation or invalidity applications. Courts in Member States of the European Union, however, may revoke or declare a

Community trade mark invalid when the issue is put to them as a counterclaim in an infringement action based on the Community trade mark. The more generic term 'cancellation' is used as a general reference to both the revocation and invalidity proceedings.

### **Application for revocation**

An application for revocation is an action filed by third parties, requesting that the rights of the proprietor of the Community trade mark be revoked, because:

- he has failed to put the trade mark to genuine use during the five years following registration or for a period of five consecutive years and there are no proper reasons for non-use; or
- as a consequence of action or lack of action by the proprietor, the Community trade mark has become generic in respect of the goods and services it is registered for
- ; or
- in consequence of the use made of the Community Trade Mark by its proprietor, the Community trade mark is liable to mislead the public.

Applications for revocation of Community trade marks can be filed by fax or by mail using our paper form with reference to the explanatory notes.

**Application for a declaration of invalidity** This is an action that may be filed by third parties and can be based on two different types of grounds for invalidity: absolute and relative grounds.

A CTM may be declared invalid by invoking absolute grounds in the following cases:

- where the CTM was registered in spite of the existence of one or more absolute grounds for refusal as determined under [Art. 7 CTMR](#)
- where the applicant acted in bad faith\* when filing the application. This mainly concerns cases where the applicant was pursuing illicit aims in filing the application for the trade mark.

A CTM may be declared invalid by invoking relative grounds in the following cases:

- where the same relative grounds for refusal as determined under [Art. 8 CTMR](#), may be invoked, i.e. the same grounds for which a notice of opposition may be filed
- where another earlier right exists in a Member State which permits the use of the trade mark in question to be prohibited. This concerns, in particular, rights to a name, rights of personal portrayal, copyright and industrial property rights.

Applications for declaration of invalidity of Community trade marks can be filed by fax or by mail using our paper form with reference to the explanatory notes.

### **Revocation or invalidity request against International Registrations designating the EC**

When a revocation or invalidity request is filed against an International Registration designating the EC, any reference in OHIM's cancellation guidelines to Community trade marks must be read to include International Registrations designating the EC.

\*The term bad faith is not defined in Community trade mark law. In its case-law, the Cancellation Division has stated, *inter alia*, that bad faith can be considered to mean "dishonesty which would fall short of the standards of acceptable commercial behaviour" ([decision of the Cancellation Division of 10 October 2004, CTM ER No 2386126](#)). In particular it has been held that bad faith is the opposite of good faith, generally implying or involving, but not limited to, actual or constructive fraud, or a design to mislead or deceive another, or any other dishonest motive. Conceptually, bad faith can be understood as a dishonest intention at the time of filing.

## **Appeal**

Anyone who is adversely affected by a decision can file an appeal. A party is only 'adversely affected' when it has not obtained an order it requested. This means that, for example, in the case where a party, possessing several earlier rights, opposes a CTM application, it is only 'adversely affected' if the Opposition Division rejects the opposition. A party is not 'adversely affected' if the Opposition Division allows the opposition, basing itself only on one of several earlier rights (Judgment of the General Court in the [Case T-342/02](#), MGM/Moser Group Media, S.L.).

As a general rule, only a decision terminating proceedings can be appealed. An interim decision is normally not open to appeal, unless the decision allows for a separate appeal.

The decision must be in connection with the proceedings foreseen in the Community Trade Mark Regulation or the Community Design Regulation. Decisions of the Office with respect to access to documents are not open to appeal before the Boards of Appeal.

If you wish to file an appeal you can use our [paper form](#). See also in this context the [explanatory notes](#).

### **Mediation**

After filing an appeal, and upon payment of the appeal fee, the parties can request mediation. The mediation procedure allows the parties to come together and reach an amicable settlement before a formal decision from the Boards is necessary. Full details of the procedure are available on the Mediation page of the OHIM website

### **Time-limit and form of an Appeal**

A distinction must be made between the Notice of Appeal (NoA) and the Statement of Grounds (SoG)

The Notice of Appeal must be filed within two months after the notification of the contested decision. As in any other proceedings before the Office, there is no obligation to use the official form 'Notice of Appeal' which is provided by the Office, however, use of this form is recommended since it helps to avoid making mistakes which may result in the inadmissibility of the appeal.

The Notice of Appeal must contain the particulars of the appellant, the number of the contested decision or any other reference which allows for an immediate identification of the contested decision, as well as the extent of the appeal. Additionally, the appeal fee must be paid and received by the Office within that two-month time-limit. The Notice of Appeal may also contain the Statement of Grounds. The Statement of Grounds can also be filed separately within four months after notification of the contested decision.

Both, Notice of Appeal and Statement of Grounds must be filed in writing and must be in the language in which the contested decision was taken. They can be sent by normal mail, by courier service, by fax or be delivered by hand.

### **Revision**

Once the Statement of Grounds is received, the Registry of the Boards submits the Appeal (Notice of Appeal and Statement of Grounds) to the department which rendered the contested decision. In ex-parte cases, ie. cases which involve only one party, the department whose decision is contested will rectify its decision if it considers the appeal admissible and well founded. If it does not consider the appeal admissible or well founded it remits the case back to the Boards of Appeal.

In inter-partes cases, ie. cases which involve more than one party, the department whose decision is contested will rectify its decision if it considers the appeal admissible and well founded as long as the other party accepts the rectification. The department whose decision is contested has one month to

decide on the Revision, however, it may refuse revision at an earlier date. If the department whose decision is contested does not consider the appeal admissible or well founded it remits the case back to the Boards of Appeal.

#### **Examination of the Appeal: Ex-Parte Cases**

In an ex-parte case, the file is immediately submitted to the Chairperson of the competent Board who will designate a Rapporteur. If the Rapporteur considers it expedient, he or she will contact the appellant with any important questions regarding the appeal. Otherwise, a draft decision will be prepared which will be discussed by the Board. Once a decision is rendered, it is notified to the party.

#### **Examination of the Appeal: Inter-Partes Cases**

In Inter-partes cases there is a slightly different procedure. The respondent is allowed to file a response, and in accordance with the Rules of Procedure of the Boards of Appeal, an ancillary appeal. If a response is filed, a reply can be submitted and if a reply is submitted, a rejoinder may be submitted.

Only after the termination of the written part of the proceedings is the file submitted to the Chairperson of the competent Board who will designate a Rapporteur. If the Rapporteur considers it expedient, he or she will contact the appellant with any important questions regarding the appeal. Otherwise, a draft decision will be prepared which will be discussed by the Board. Once a decision is rendered, it is notified to the parties.

#### **Decisions of the Boards of Appeal**

The Board can either exercise any power within the competences of the department which was responsible for the contested decision or it can return the case to that department. In examination cases, the Board may re-open the examination on any absolute ground of refusal provided that [Article 75 CTMR](#) is respected.

#### **Composition of the Boards**

A Board deciding on an appeal is composed of three Members. In certain specific cases, decisions can be taken by the Grand Board or by a single Member.

#### **Composition of the Boards: The Grand Board**

The Grand Board consists of nine Members and is chaired by the President of the Boards of Appeal. A Board can refer a case to the Grand Board if it believes that this is justified by the legal difficulty or importance of the case or by special circumstances, such as when Boards of Appeal have issued diverging decisions on a point of law raised by that case.

For the same reasons, the Presidium of the Boards of Appeal can refer to the Grand Board a case allocated to a Board. Additionally, a Board can refer a case allocated to it to the Grand Board if it believes that it must deviate from an interpretation of the relevant legislation given in an earlier decision of the Grand Board. See also [Article 6s](#) of Decision of 12 December 2006 of the Presidium of the Boards of Appeal on the organisation of the Boards, the Grand Board and the devolution of cases to a single Member.

#### **Composition of the Boards: Single Member Board**

A Board or where such competences have been delegated to its Chairperson, the Chairperson of the Board, may devolve the case to a single Member. Such a decision can be taken where the case concerns a decision closing the proceedings following agreement between the parties, decisions on the award of costs and the admissibility of the appeal.

### **An Appeal against a decision of the Boards of Appeal**

Once the Board has rendered a decision, any party adversely affected can file an action before the General Court. Such an action must be lodged within a time-limit of two months after the notification of the decision of the Boards of Appeal.

## **Mediation**

### *About mediation*

OHIM offers a mediation service in inter partes proceedings, following the decision of the first instance and in parallel to appeal proceedings (which shall then be suspended, when appropriate), allowing the parties to reach an amicable settlement without the requirement of a decision from the Boards on the substance.

Mediation talks will normally be held in Alicante and the service itself is offered free of charge. However, in order to avoid the contested decision becoming final, the party being adversely affected by the decision must, within the two months following the notification of the contested decision, file an appeal and pay the appeal fee of EUR 800. A one-off fee of EUR 750 is charged in the event that the parties wish to hold the mediation talks in Brussels in order to cover the traveling expenses of the mediator.

It is the role of the mediator to bring the parties together and assist them in finding common ground on which a potential settlement may be made, but not to act as judge nor to offer opinions on the rights and wrongs of each party's arguments.

Detailed documentation on all aspects of the mediation process can be accessed from this page by clicking on the links below.