

*THE EUROPEAN COMMUNITY
TRADEMARK
TWO YEARS LATER
TOKYO, February 3, 1.998*

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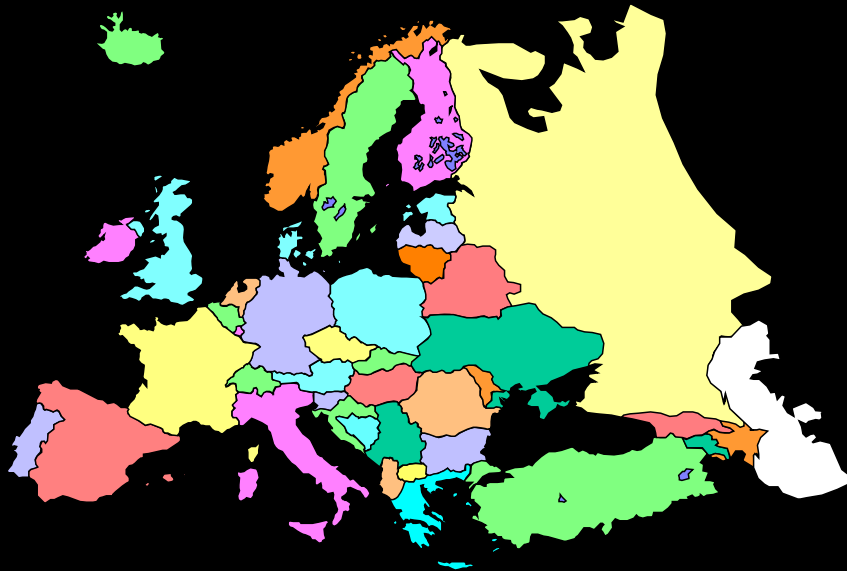
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08008 - Barcelona
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THE EUROPEAN COMMUNITY TRADEMARK

Two Years Later

EUROPE



EUROPEAN
UNION



Pop. 368,7 million

BACKGROUND OF COMMUNITY TRADEMARK

- General principle : Principle of free circulation of goods & services within the european union. (Art. 30 of Rome Treaty).
- Exceptions : National trademarks (Art. 36 of Rome Treaty).
- Exhaustion of trademark rights within european union.
- Need to create a european wide trademark proteccion.

WHAT IS A CTM

- Single application : CTM application.
- Filed before a single authority : OHIM (Office for the Harmonization in the Internal Market) Alicante (Spain).
- Through a single attorney : european trademark attorney.

WHAT IS A CTM

- In a single language :

from five



English



Spanish



French



German



Italian

WHAT IS A CTM

- Following a single prosecution.
- Obtaining a single registration : CTM.
- Enforceable through a single legal action :
Community Trademark Courts.

GOVERNING PRINCIPLES



1 - Coexistence

- National Trademarks
- International Trademarks
- Community Trademarks

GOVERNING PRINCIPLES

2 - Conversion



Community
Trademark



N
a
t
i
o
n
a
l

T
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a
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r
k
s



Benelux



Finland



Germany



Greece



Italy



Ireland



Spain

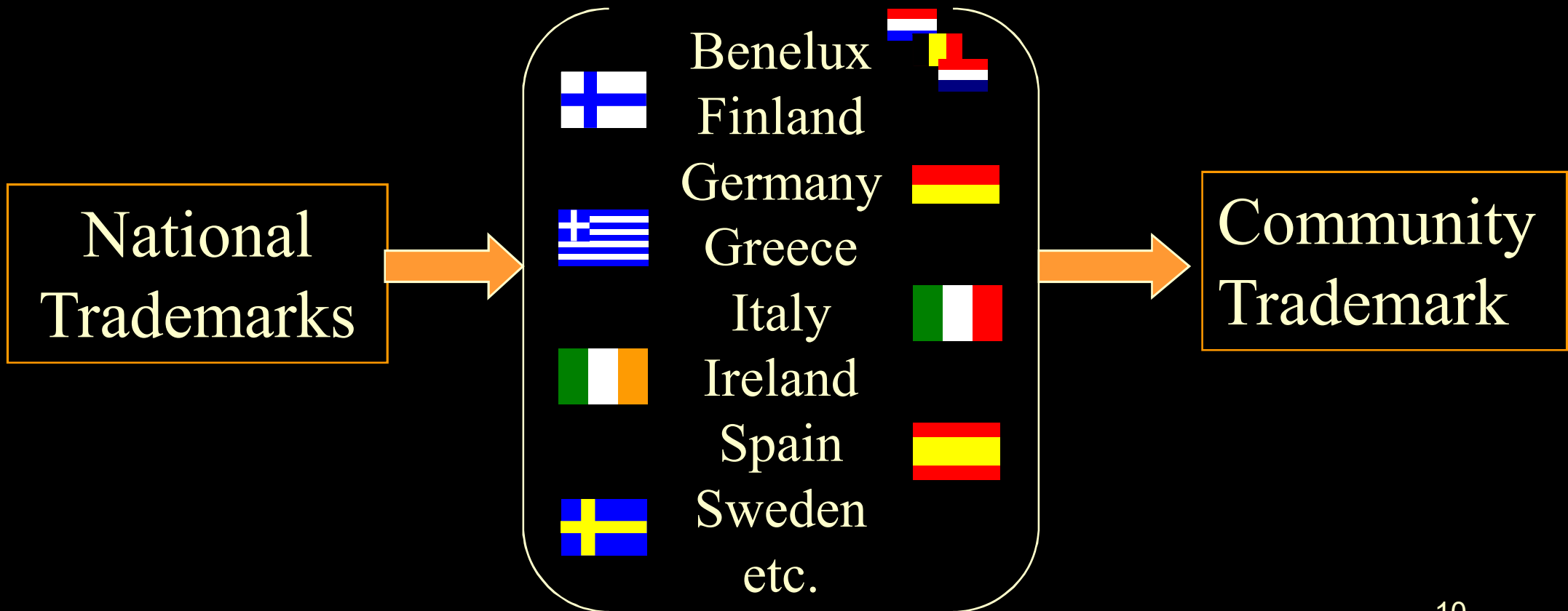


Sweden

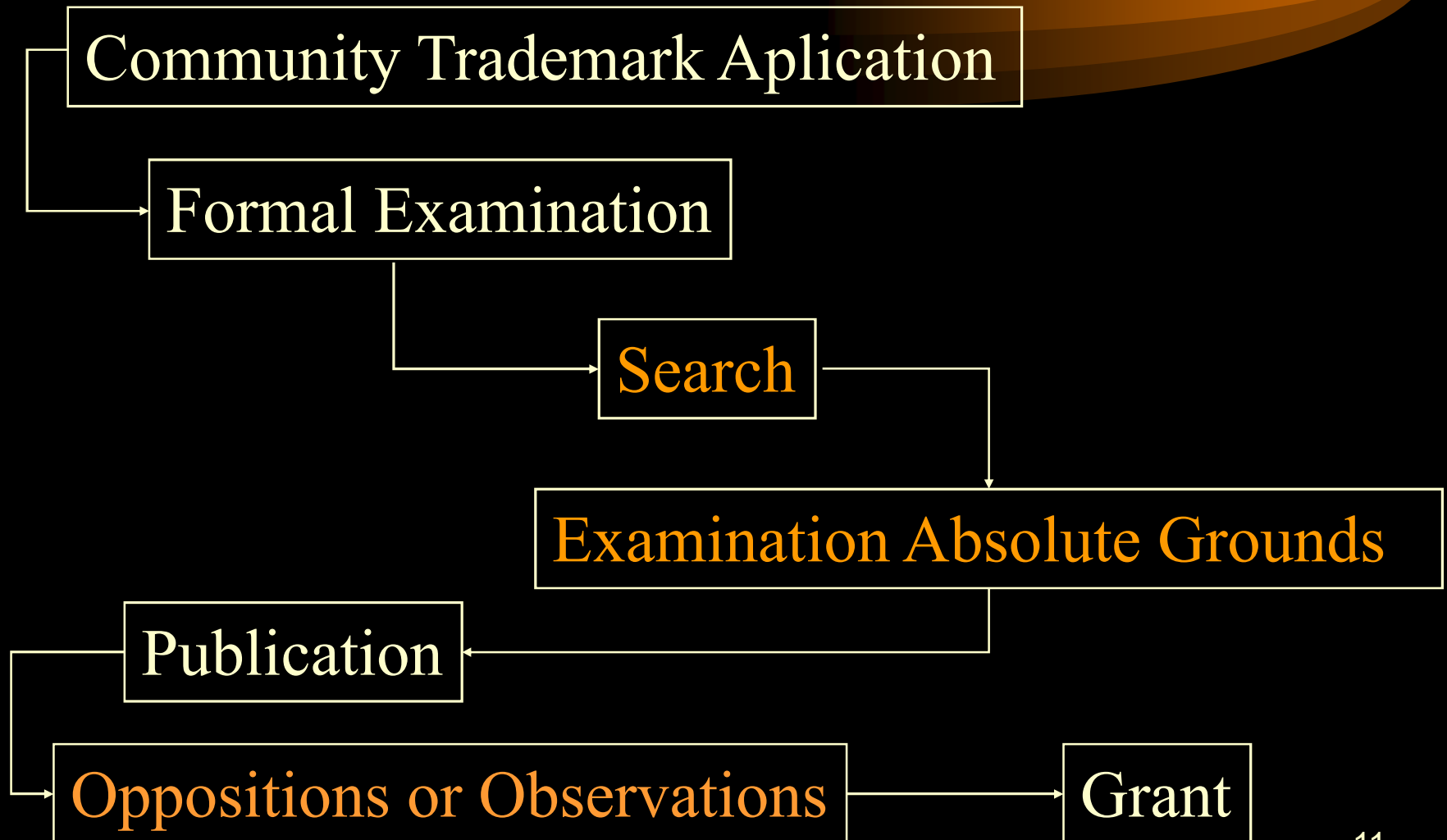
etc. ⁹

GOVERNING PRINCIPLES

3 - Consolidation prior rights : Seniority



REGISTRATION PROCEDURE



LINGUISTIC REGIME

- Filing and publication :

11 languages of EU



English *



Spanish *



French *



German *



Italian *



Danish



Dutch



Finish



Greek



Portuguese



Swedish

* Official languages of OHIM

LINGUISTIC REGIME



- Community Trademark :
Designation two languages
 - 1st Language : CTM Application
 - 2nd Language : One of the 5 OHIM languages
- Prosecution / Opposition / Nulity :
One of the two designated being official OHIM.

NEW SCENARIO



Multiple Options

- National route
- CTM route
- Madrid protocol route
- Combinations
- Future link (CTM/Madrid)

NEW SCENARIO



Different prosecution systems → Different certainty

- National route

Deposit only (IT)

Deposit + Inf. Search (BX, AT)

Opposition only (DE, FR)

Ex officio exam. + oppos.

(ES, GB, PT, DK, FI, GR, IE, SE)

NEW SCENARIO



- CTM route : opposition only + partial inf. search
(CTM + nat. trademarks except IT, DE, FR)
- Madrid route : same as national.



ADVANTAGES
AND
DISADVANTAGES

ADVANTAGES

- Lower filing and prosecution costs.
- Prosecution in a single language.
- Easy registration
(no examination of prior rights “*ex officio*”).
- Lower use requirements.
- A single decision enforceable in all european union.
- Consolidate earlier national rights into a CTM
(Seniority).

DISADVANTAGES



- Registrability in all european union countries.
- Unitary grant or rejection.
- Lower legal certainty (no prior rights examination).
- Can be easily attacked (one sole opposition, nullity, cancelation).
- Cannot be divided.

QUESTIONS TO BE CONSIDERED



- Scope of protection.
- Urgency in obtaining a registration.
- Need to adapt trademark to each member state.
- Same or different ownership in each member state.
- Absolute grounds of non registrability in some member state.
- Relative grounds of non registrability in some member state.
- Need of protection in countries other than EU.
- Existence of own prior rights.

USEFUL ADVISES

- Search before filing (at least identical marks)
There are many marks.
- Look to informative searches by OHIM (but wait to decide until oppositions).
- Complete searches during prosecution (IT, FR, DE) when opposition are received.
- Try to settle during prosecution seeking global agreements.

USEFUL ADVISES

- Complete search after registration (IT, FR, DE).
- Cancel or settle with conflicting earlier rights even if they did not file an opposition.
- Watch new marks for opposition purposes.



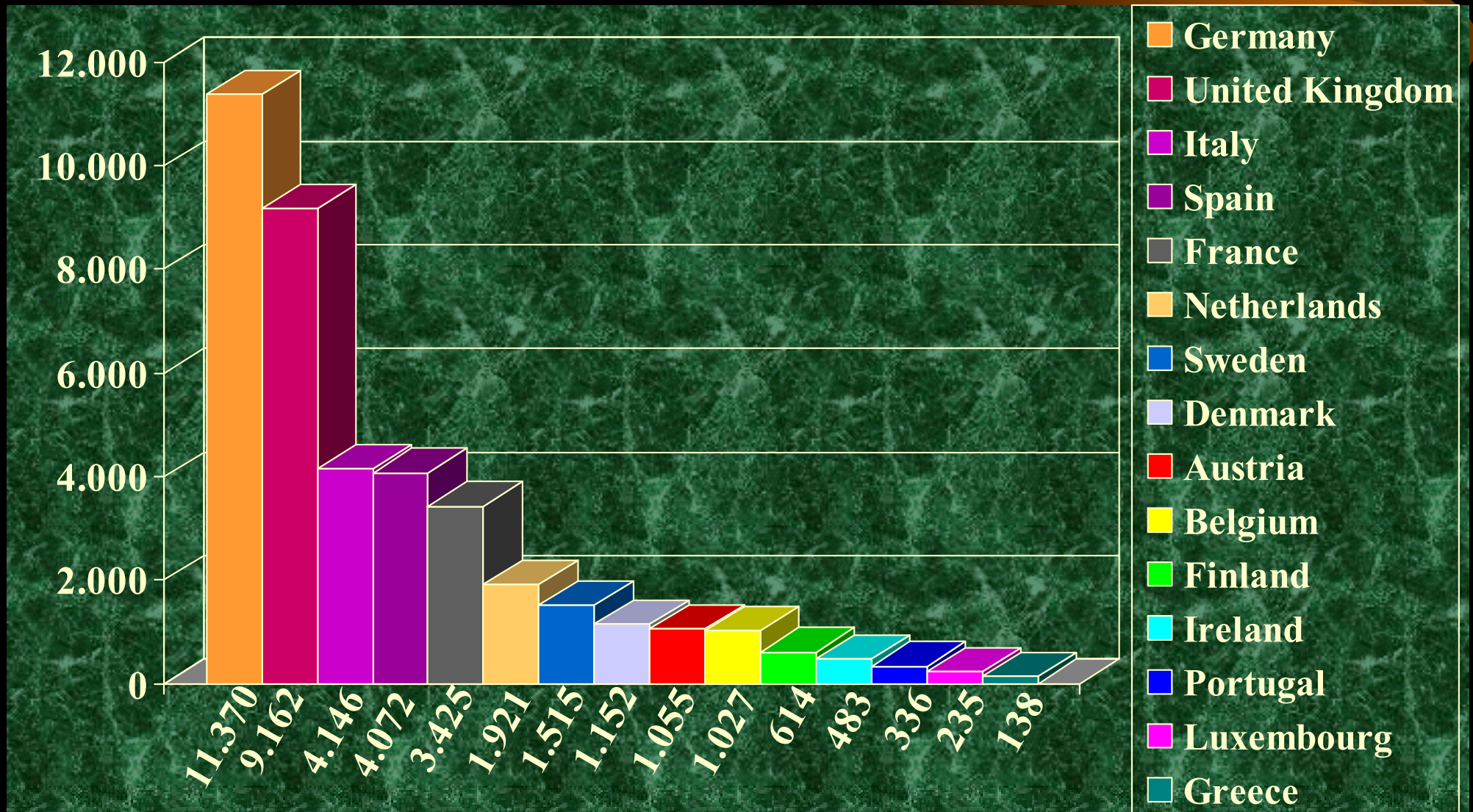
SOME CTM
FIGURES

CTM APPLICATIONS FILED BY EU

Source : OHIM.

Situation on December 15, 1997

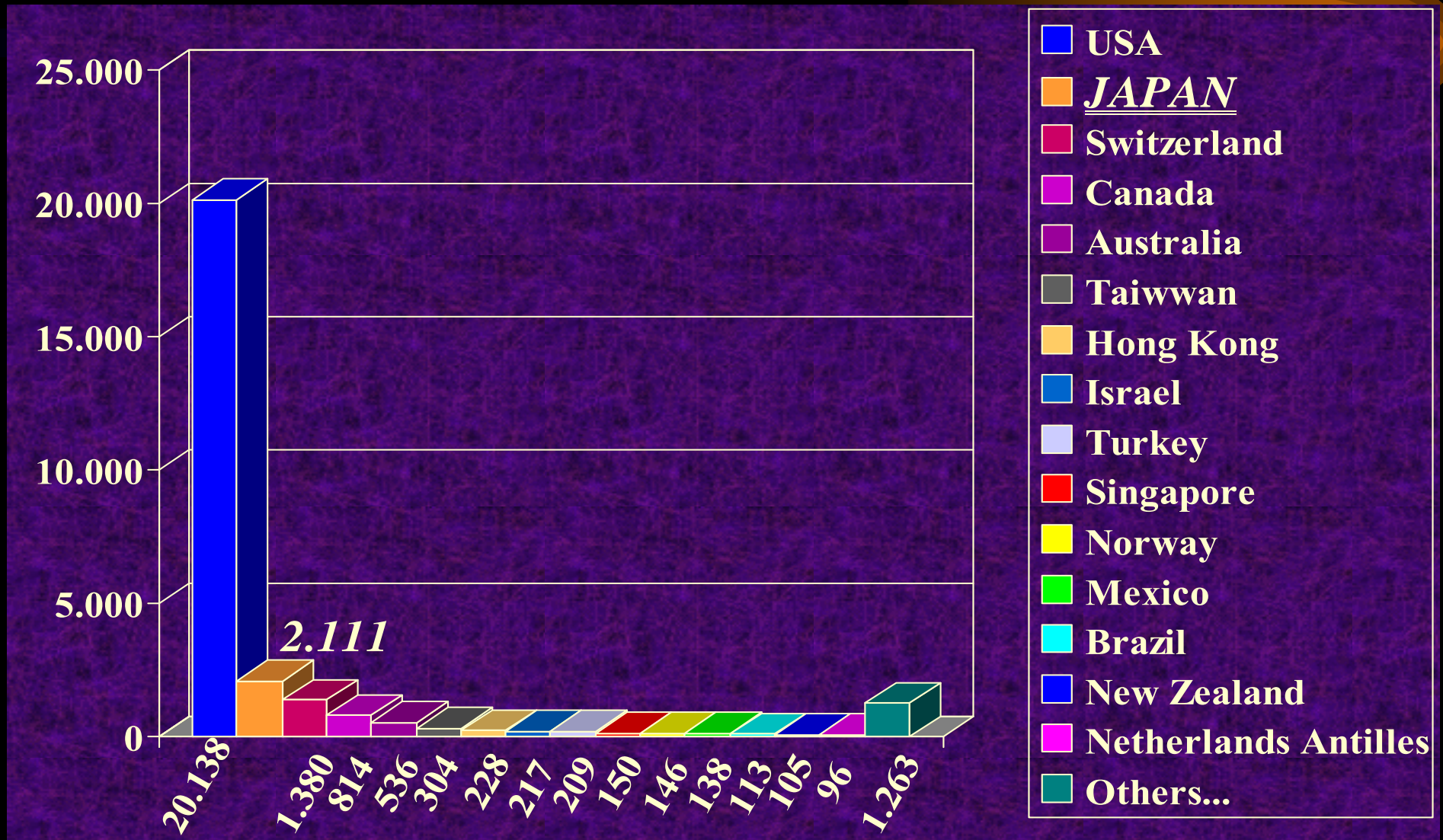
NATIONALS



CTM APPLICATIONS FILED BY NON EU NATIONALS

Source : OHIM.

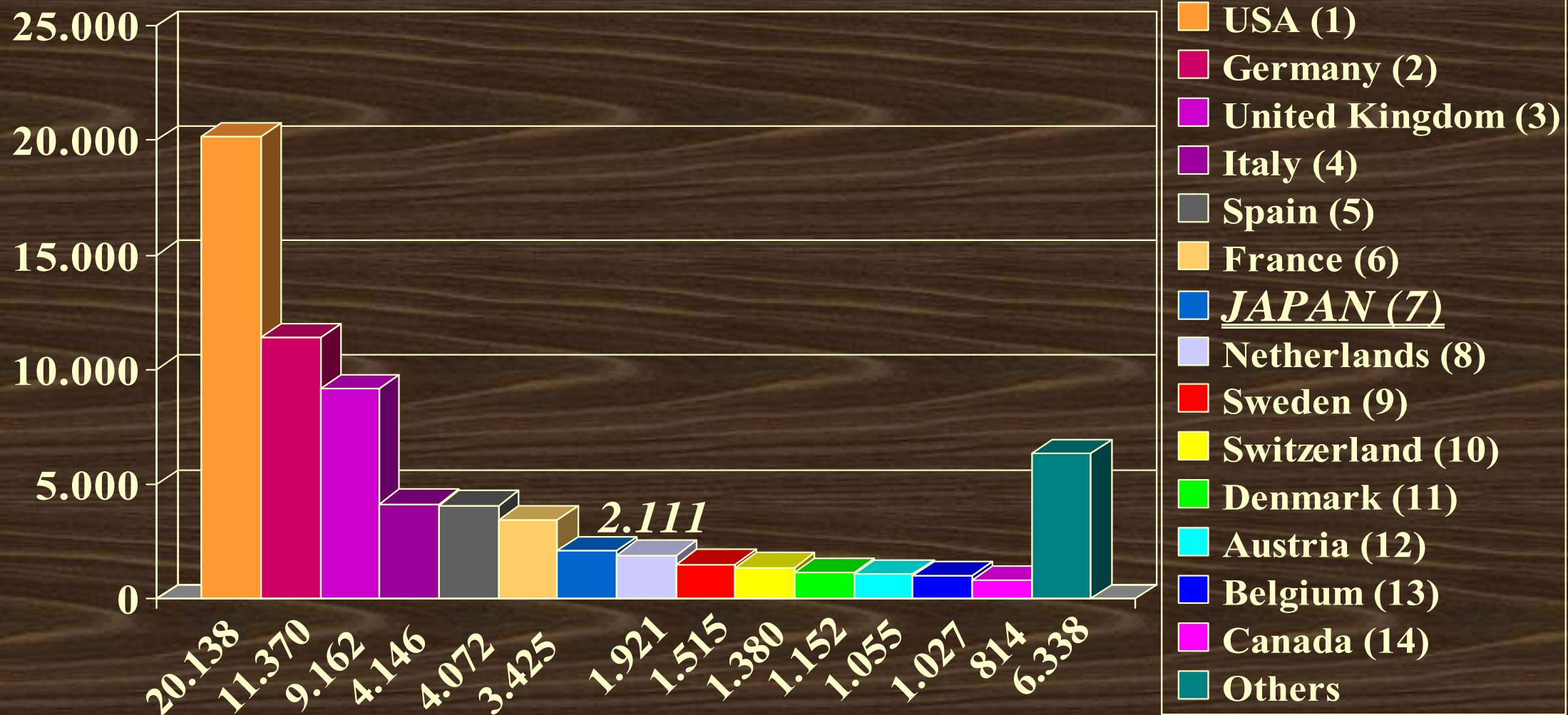
Situation on December 15, 1997



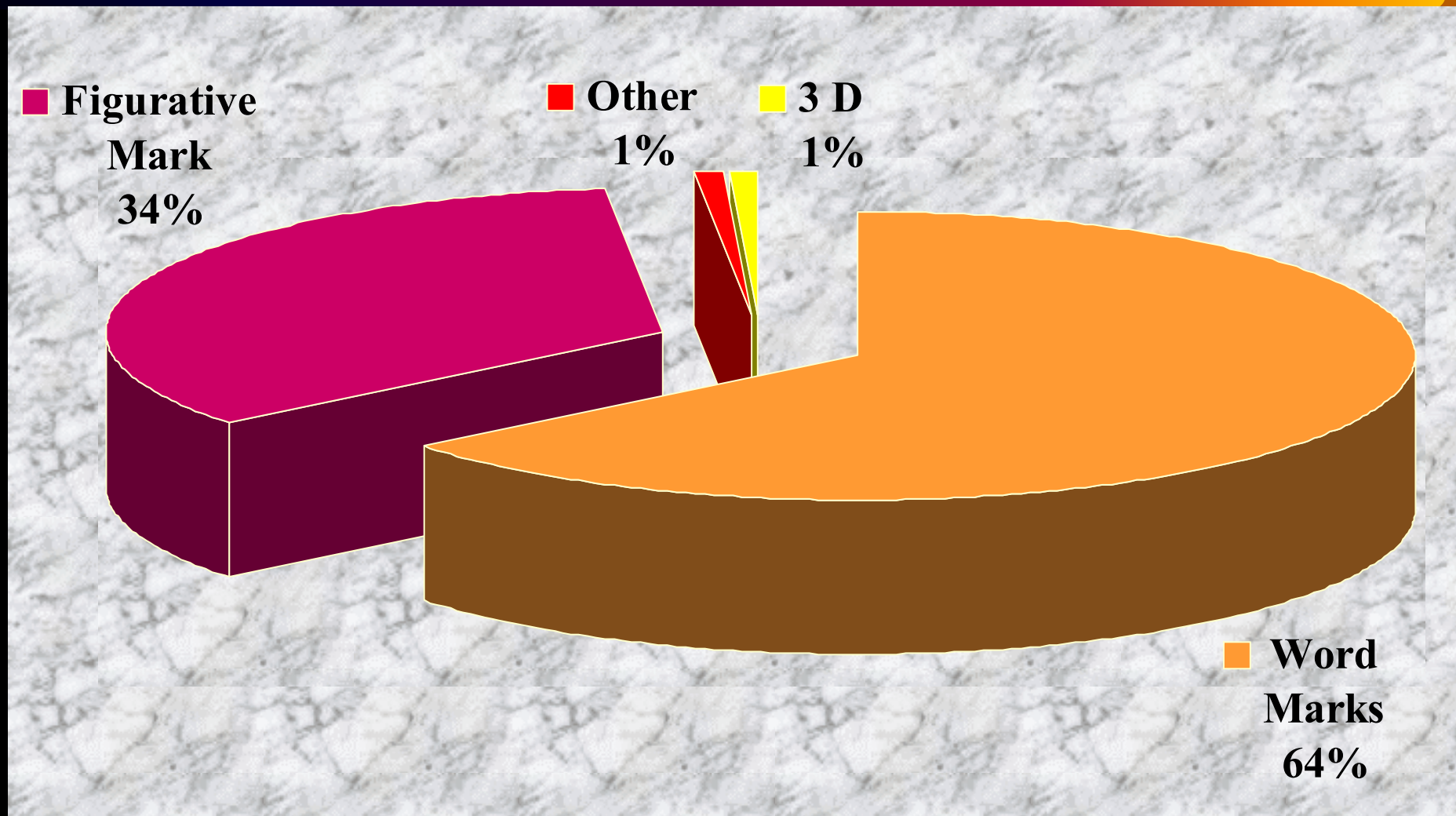
CTM APPLICATIONS PER COUNTRY OF ORIGIN

Source : OHIM.

Situation on
December 15, 1997



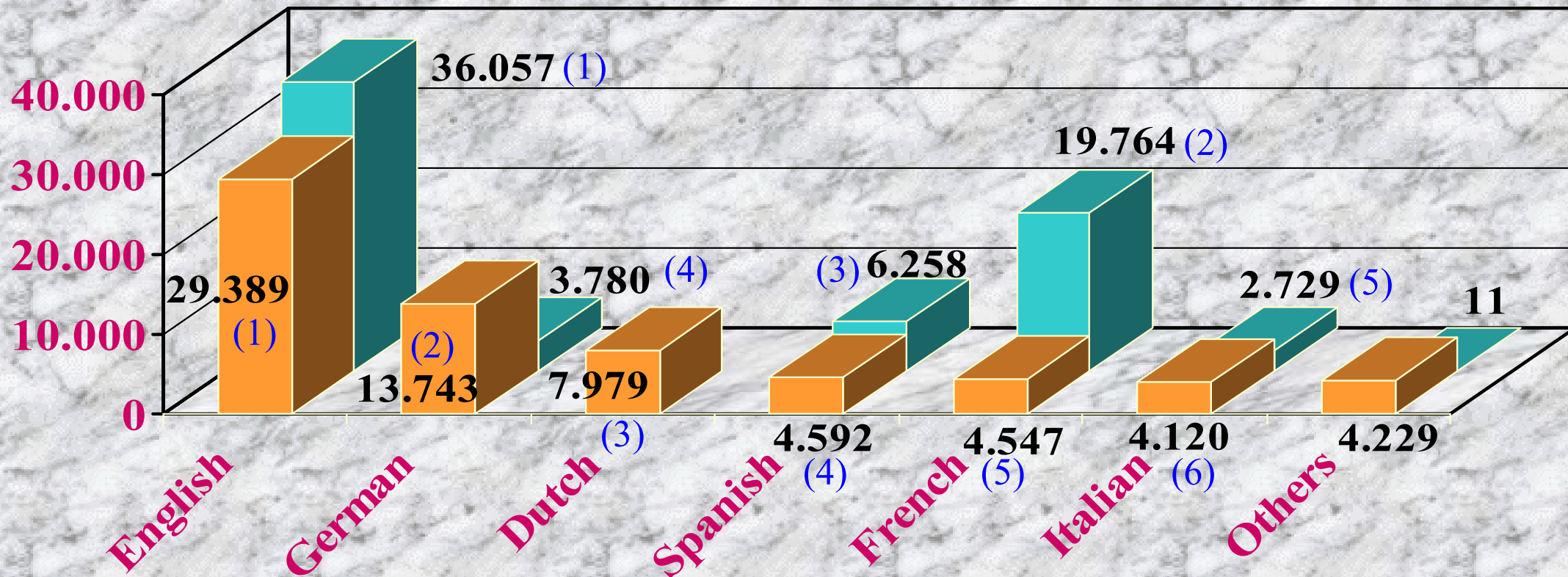
BREAKDOWN BY CTM NATURE



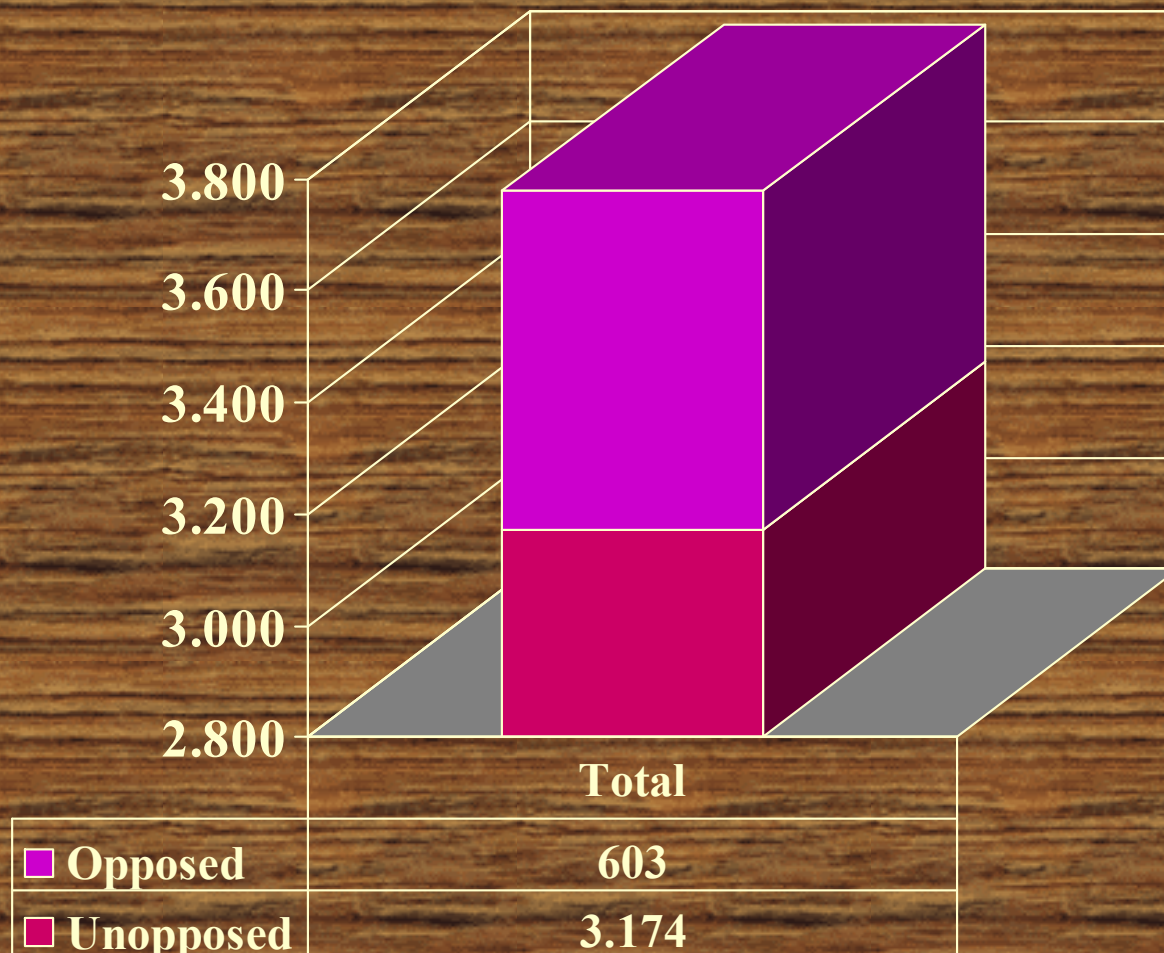
BREAKDOWN BY APPLICATION LANGUAGES

First Language

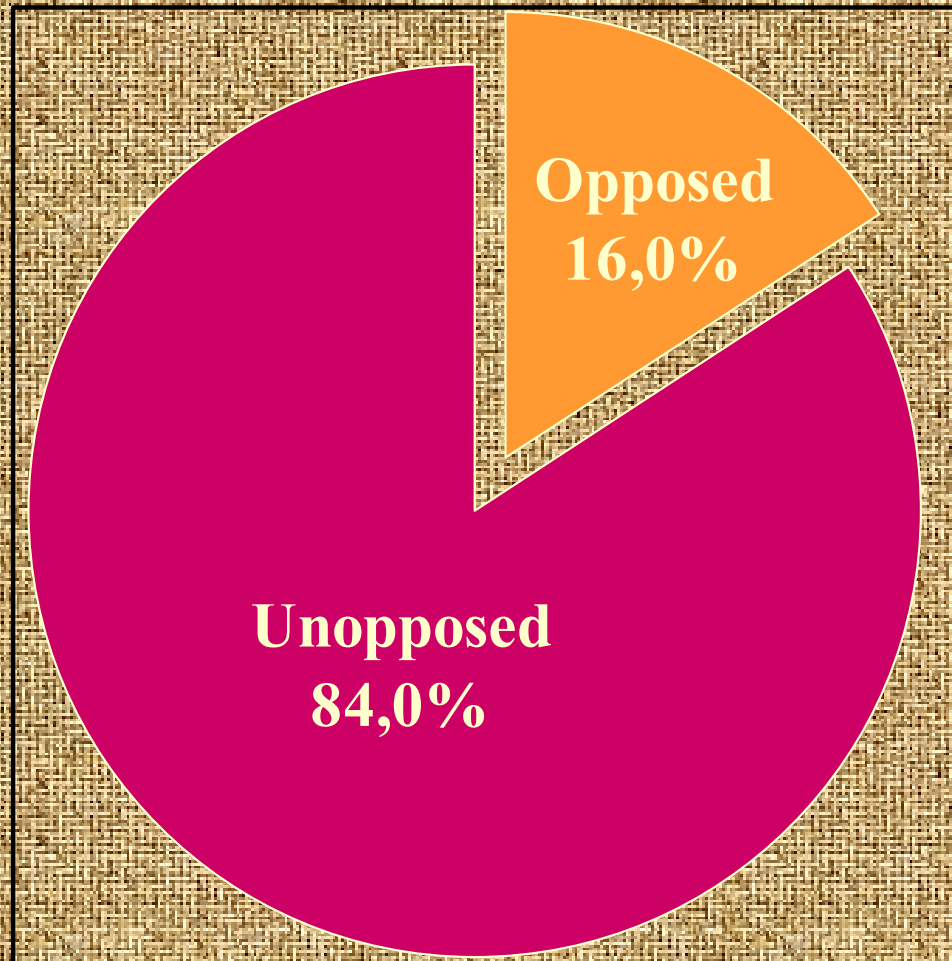
Second Language



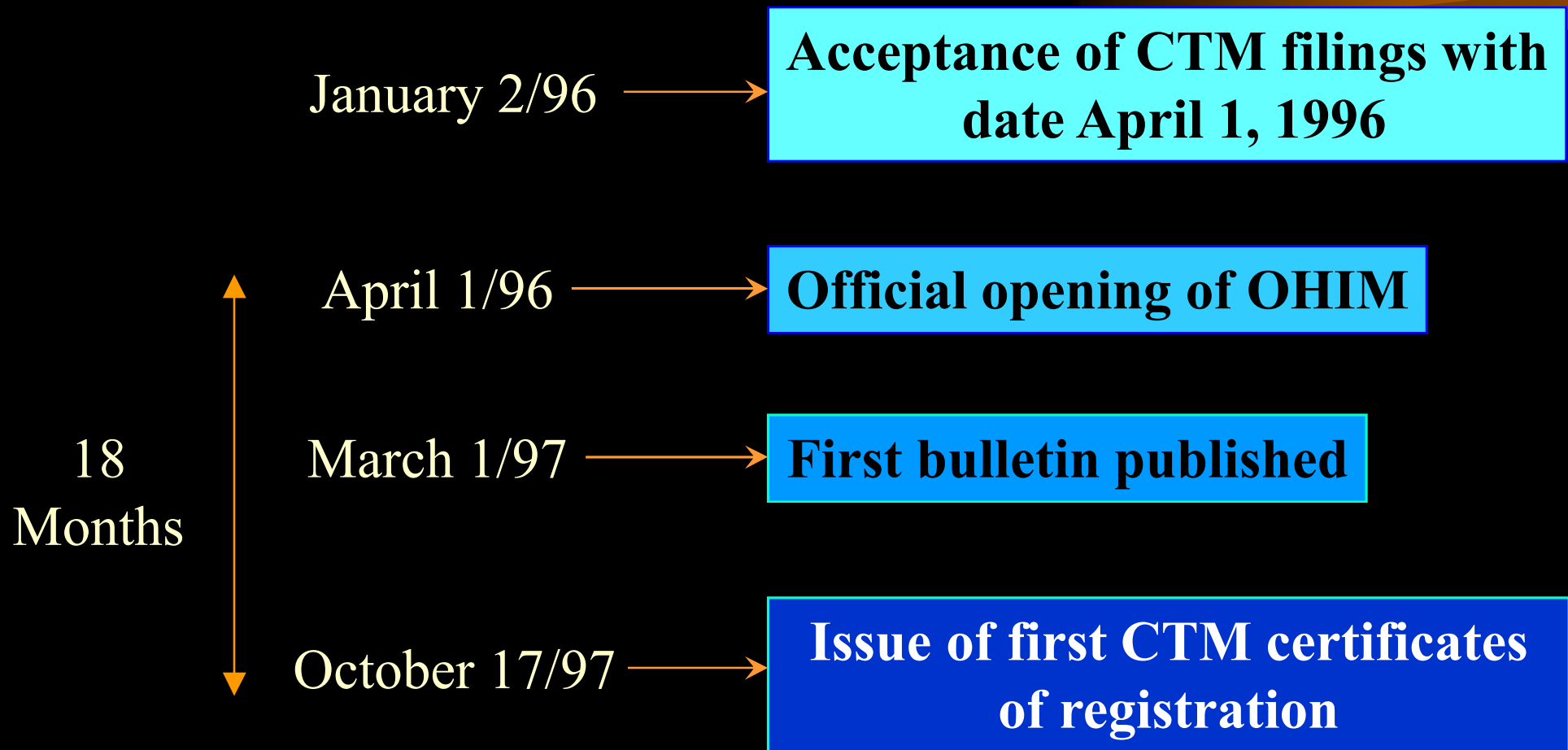
NUMBER OF OPPOSED AND UNOPPOSED CTM APPLICATIONS



CTM OPPOSITION RATE



TIME TABLE



CTM N°2



OHIM - OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
QAMI - OFICINA DE ARMONIZACIÓN DEL MERCADO INTERIOR

TRADE MARKS
AND
DESIGNS
MARCAS,
DISEÑOS
Y MODELOS

CERTIFICATE OF REGISTRATION

This Certificate of Registration is hereby issued for the Community trade mark identified below. The corresponding entries have been recorded in the Register of Community Trade Marks.

CERTIFICADO DE REGISTRO

Se expide el presente certificado de registro para la marca comunitaria que se identifica a continuación. Las menciones y los datos relativos a tal marca han sido inscritos en el Registro de marcas comunitarias.

N° 000000002

ECTA

Registered/Registrada 13/09/1997

The President / El Presidente



OHIM - OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
QAMI - OFICINA DE ARMONIZACIÓN DEL MERCADO INTERIOR

TRADE MARKS
AND
DESIGNS
MARCAS,
DISEÑOS
Y MODELOS

450 13/10/1997
210 000000002
220 01/04/1996
442 10/03/1997
546
531 27.5.1
732 EUROPEAN COMMUNITIES TRADE MARK ASSOCIATION
8th Floor
Albany House
81 Albany
LONDON WC2B 4BN
GB
740 Iain Alfonso Durán Mayo
Prado de Guzmán, 1071, Pta.
08008 Barcelona
ES
270 EN ES
511

ES - 16 - Publicaciones y otro material impreso.

ES - 41 - Servicios de educación y formación, todos ellos relacionados con los derechos de propiedad intelectual e industrial y su legislación, organización y dirección de convenciones, congresos, conferencias y seminarios, publicación de libros e impresos.

ES - 42 - Servicios prestados por una asociación a sus miembros incluyendo la prestación de asesoramiento, información y servicios relacionados con la propiedad intelectual e industrial y su legislación.

DA - 16 - Publikationer og andre tryksager.

DA - 41 - Tjenesteydelser vedrørende undervisning og uddannelse med henblik på intellektuel og industriel ejendomsret samt lovgivning, fremtidsforskning og ledelse af selskaber, kongresser, konferencer og seminarer, udgivelse af bøger og andre tryksager.

DA - 42 - Tjenesteydelser leveret af en sammenslutning til dens medlemmer, herunder rådgivning, information og tjenesteydelser vedrørende intellektuel og industriel ejendomsret samt lovgivning.

DE - 16 - Veröffentlichungen und andere Druckerezeugnisse.

DE - 41 - Dienstleistungen in den Bereichen Schulung und Ausbildung betreffend die Rechte an geistigem und gewerblichem Eigentum sowie die entsprechende Gesetzgebung, Organisation und Durchführung von Tagungen, Kongressen, Konferenzen und Seminaren, Veröffentlichung von Büchern und anderen Druckerezeugnissen.

DE - 42 - Dienstleistungen eines Verbandes für seine Mitglieder einschließlich Beratung, Information und Dienstleistungen auf dem Gebiet geistiger und gewerblicher Eigentumsrechte und der entsprechenden Gesetzgebung.

EL - 16 - Δημοσιεύσεις και άλλο έντυπο υλικό.

EL - 41 - Υπηρεσίες εκπαιδευσης και κατάρτισης, σχετιζόμενες με τα δικαιώματα πνευματικής και βιομηχανικής ιδιοκτησίας, και με τη νομοθεσία, οργάνωση και διεξαγωγή συνελεύσεων, συνεδρίων, διασκέψεων και σεμιναρίων, έκδοση βιβλίων και έντυπου υλικού.

EL - 42 - Υπηρεσίες που παρέχονται από τις ενώσεις στα μέλη τους συμπεριλαμβανομένης της παροχής συμβουλών, της ενημέρωσης και των υπηρεσιών που συνδέονται με τα πνευματικά και βιομηχανικά δικαιώματα και τη νομοθεσία.

EN - 16 - Publications and other printed matter.

EN - 41 - Education and training services, all relating to intellectual and industrial property rights and the law organising and conducting conventions, congresses, conferences and seminars, publication of books and printed matter.

EN - 42 - Services rendered by an association to their members including provision of advice, information and services relating to intellectual and industrial property and the law.

FR - 16 - Publications et autres imprimés.

FR - 41 - Services d'enseignement et de formation, tous liés aux droits de propriété intellectuelle et industrielle et à la législation; organisation et tenue de conventions, congrès, conférences et séminaires, publication de livres et imprimés.

N° 000000002

2/3



OHIM - OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
QAMI - OFICINA DE ARMONIZACIÓN DEL MERCADO INTERIOR

TRADE MARKS
AND
DESIGNS
MARCAS,
DISEÑOS
Y MODELOS

FR - 42 - Services rendus par une association à ses membres, y compris la fourniture de conseils, d'informations et de services liés à la propriété intellectuelle et industrielle et à la législation.

IT - 16 - Pubblicazioni e altri stampati.

IT - 41 - Servizi di istruzione e di formazione professionale, tutti concernenti i diritti di proprietà intellettuale ed industriale e le leggi in materia; organizzazione e direzione di riunioni, congressi, conferenze e seminari, pubblicazione di libri e stampati.

IT - 42 - Servizi resi da un'associazione ai suoi membri tra i quali la fornitura di consulenza, informazioni e servizi concernenti la proprietà intellettuale ed industriale e le leggi in materia.

NL - 16 - Publicaties en andere drukwerken.

NL - 41 - Onderwijs en opleiding op het gebied van intellectuele en industriële eigendomsrechten en wetgeving; het organiseren en leiden van conventies, congressen, conferenties en seminars, het uitgeven van boeken en drukwerken.

NL - 42 - Dienstverlening door een organisatie aan haar leden, waaronder het geven van advies en informatie en het verlenen van diensten inzake intellectueel en industrieel eigendom en wetgeving.

PT - 16 - Publicações e outros impressos.

PT - 41 - Serviços de educação e formação relacionados com os direitos de propriedade intelectual e industrial e o seu próprio lei; organização e condução de convenções, congressos, conferências e seminários, publicação de livros e impressos.

PT - 42 - Serviços prestados por uma associação aos seus membros, incluindo a prestação de assessoria, informações e serviços relacionados com a propriedade intelectual e industrial e o seu próprio lei.

FI - 16 - Julkaisut ja muut painotutheet.

FI - 41 - Henkilöiden ohjauksen ja koulutuksen lisäksi laeisiin liittyvät opetus- ja koulutuspalvelut, kokousten, kongressien, konferenssien ja seminaarien järjestäminen, kirjojen ja painotutheiden julkaiseminen.

FI - 42 - Jäsenistön jäsenilleen toimimat palvelut, mukaan lukien henkilöiden ohjauksen ja koulutukseen liittyvä neuvonta, tiedotus ja palvelut.

SV - 16 - Publikationer och andra trycksaker.

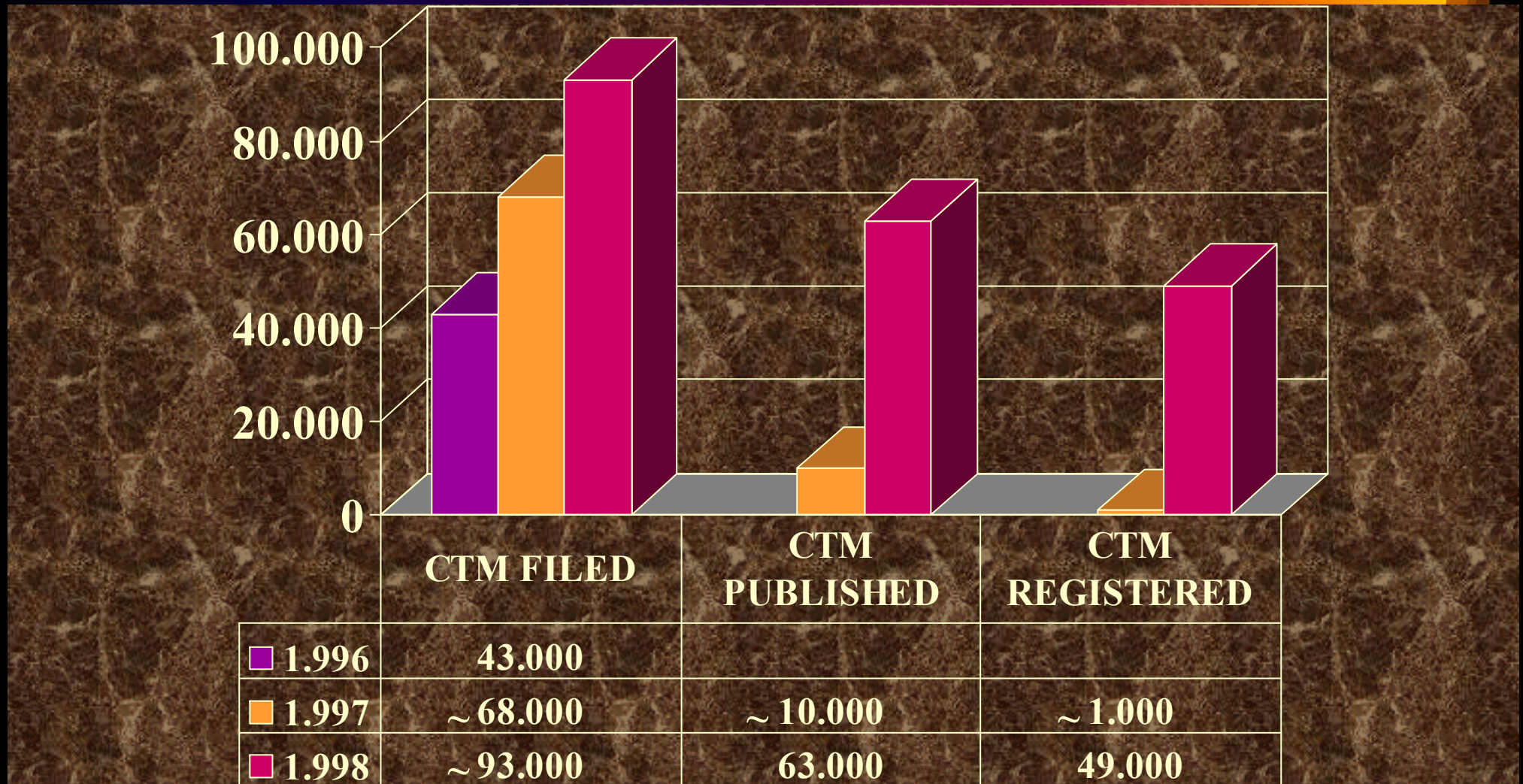
SV - 41 - Undervisnings- och utbildningstjänster på området för immateriella och industriella rättigheter och lagstiftning; organisation och ledning av sammankomster, kongresser, konferenser och seminarier, utgivning av böcker och trycksaker.

SV - 42 - Tjänster tillhandahållna av en förening till dess medlemmar, inklusive rådgivning, information och tjänster rörande immateriella och industriella rättigheter och lagstiftning.

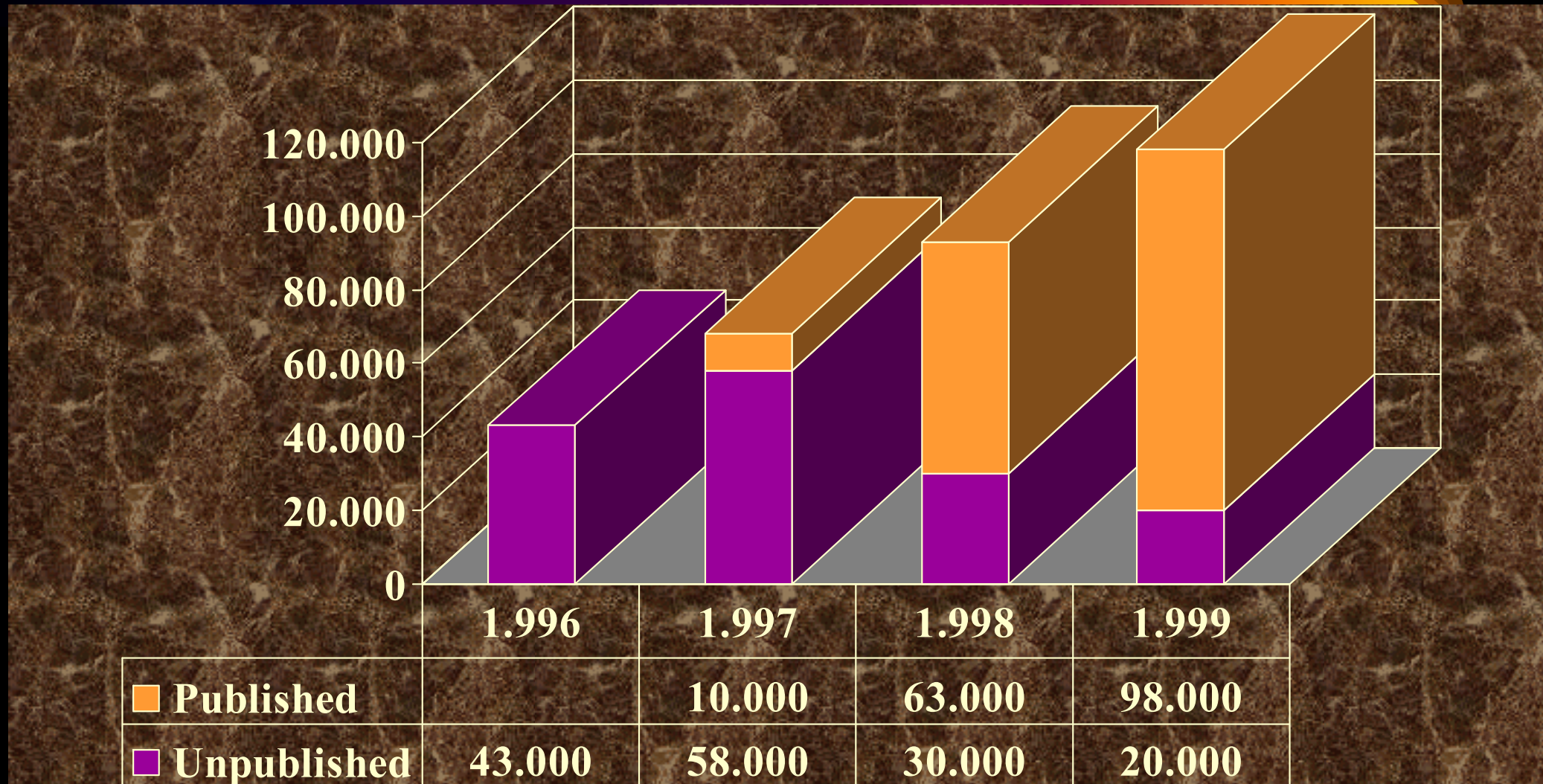
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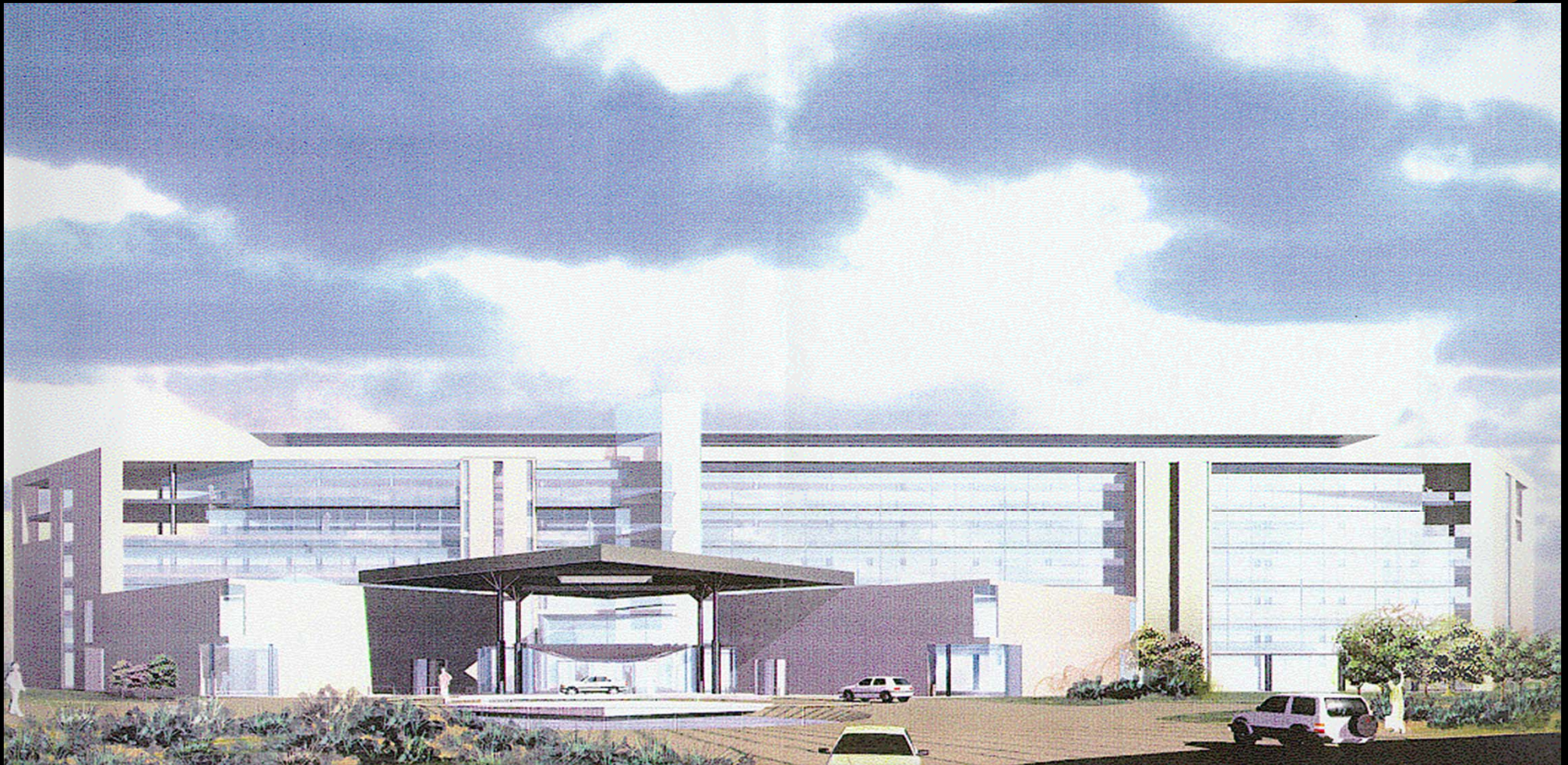
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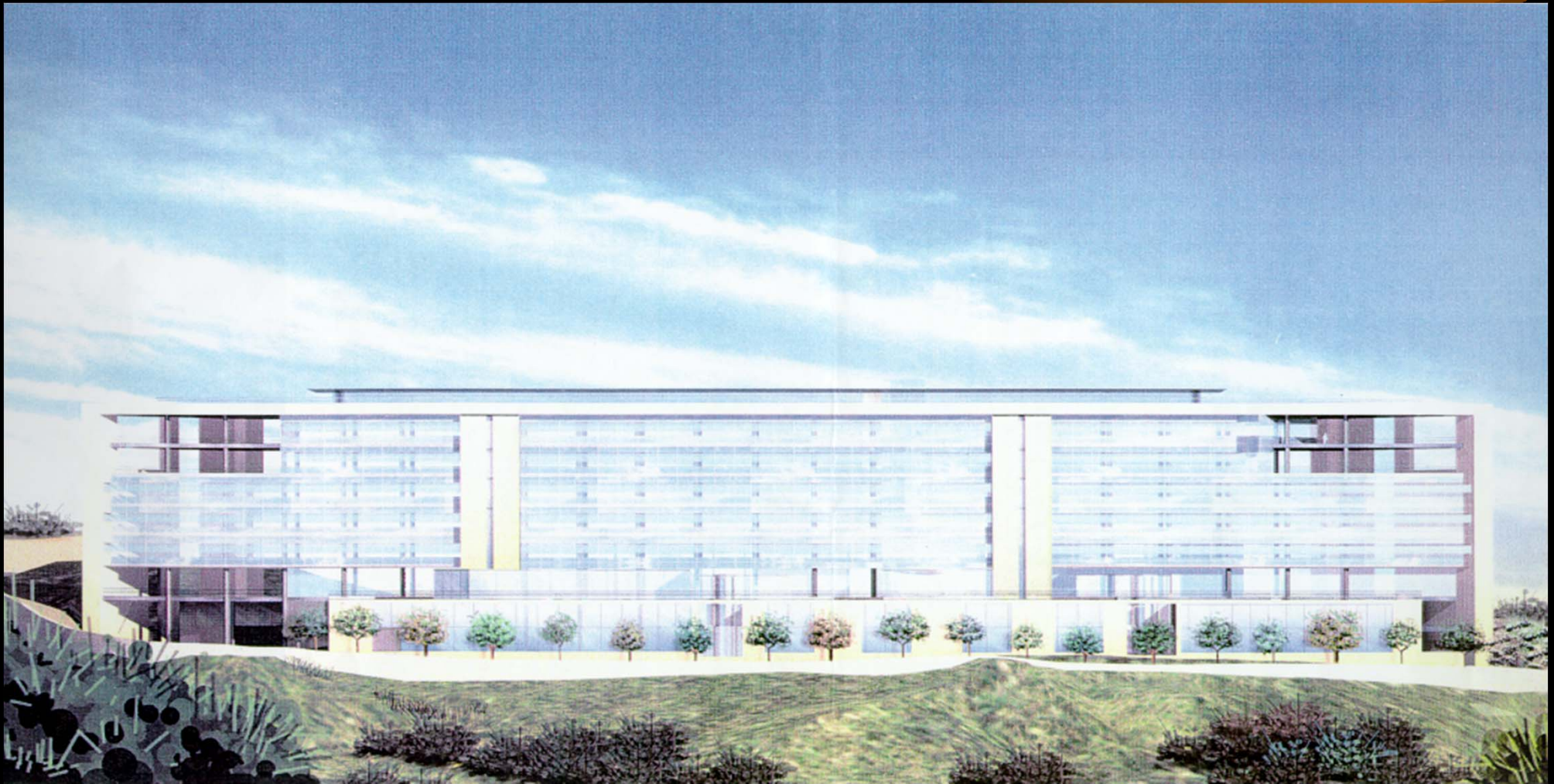
FORECASTS FOR COPING WITH THE BACKLOG



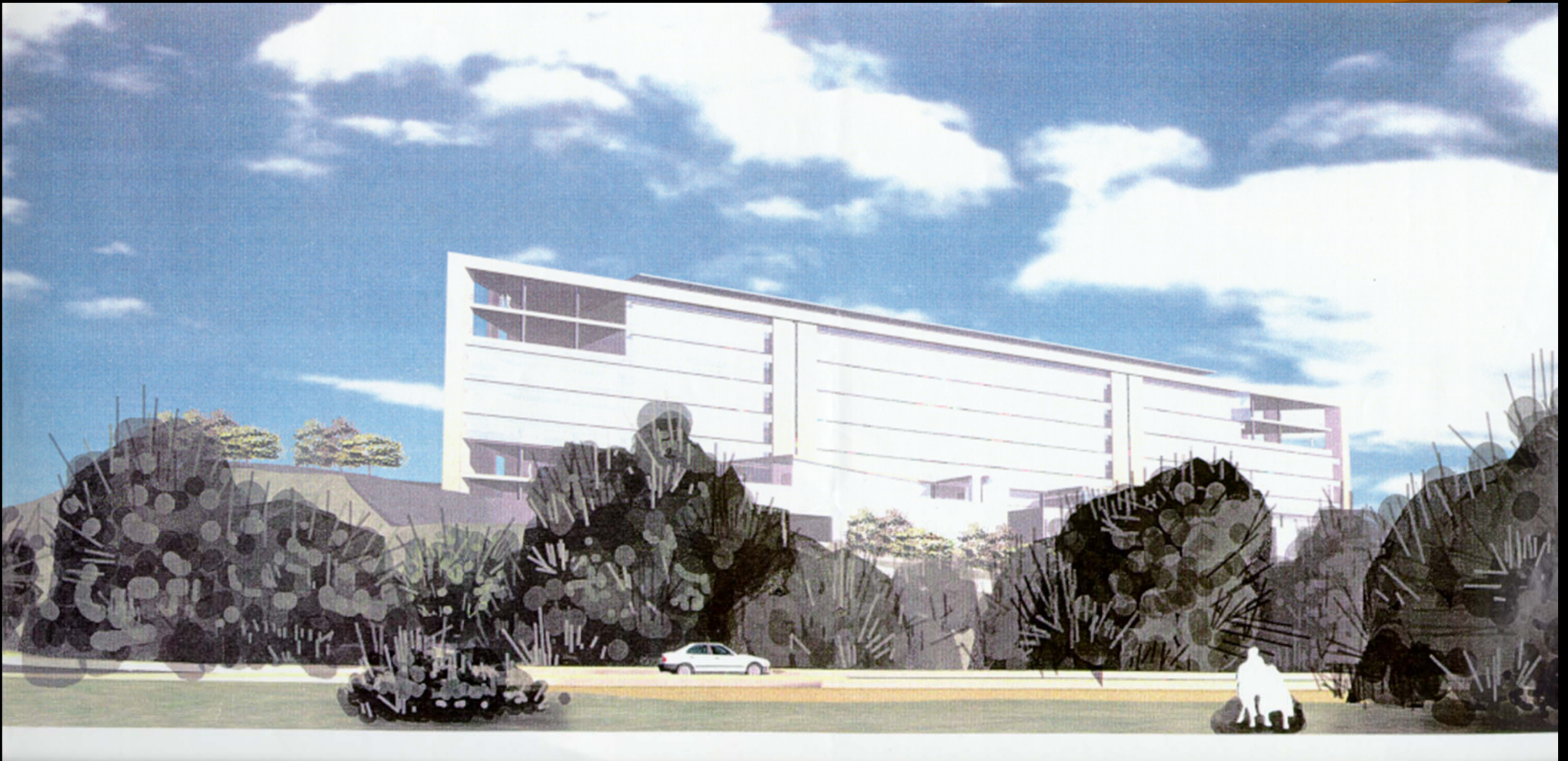
NEW PROJECTED OHIM BUILDING



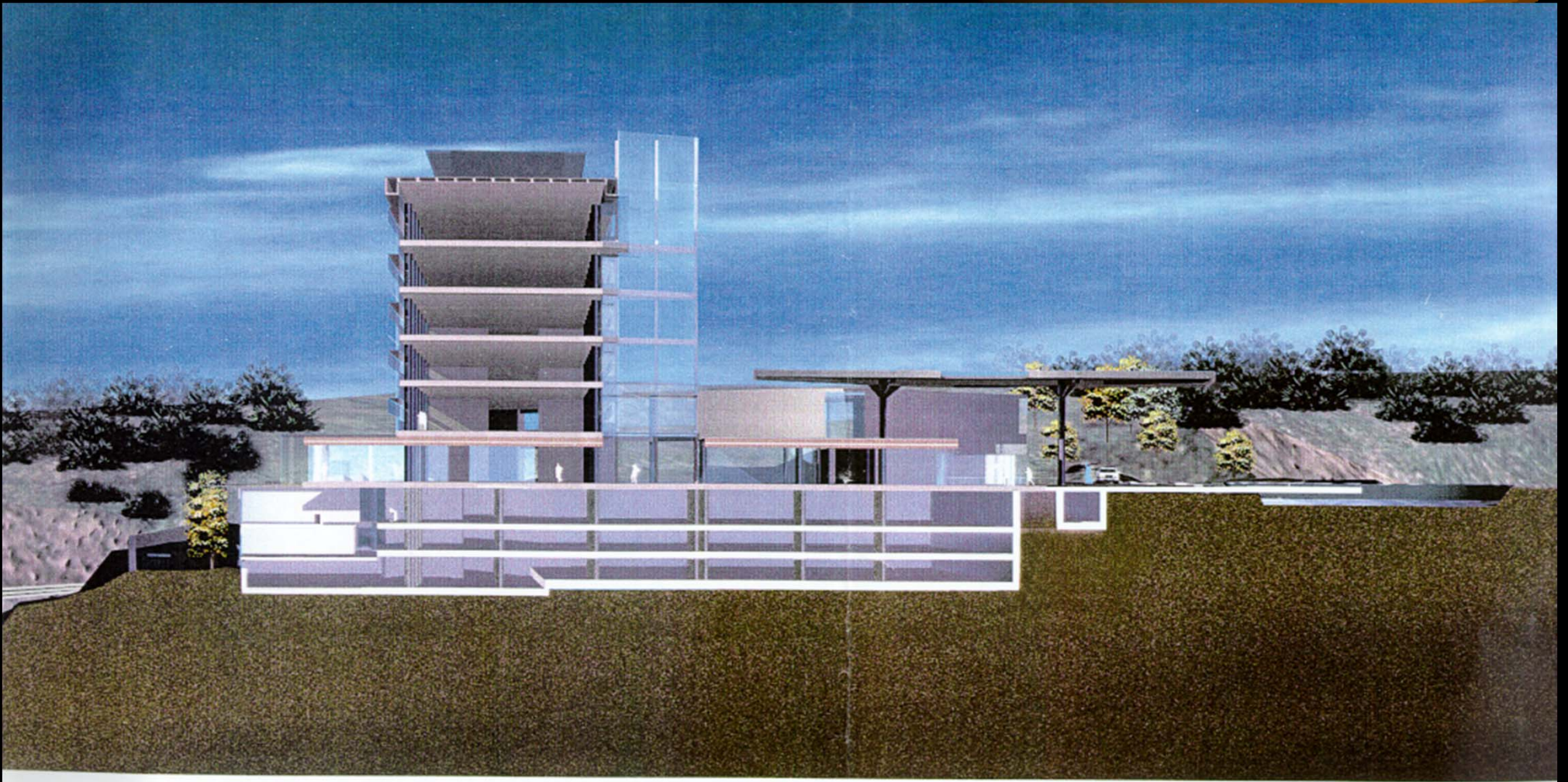
NEW PROJECTED OHIM BUILDING



NEW PROJECTED OHIM BUILDING



NEW PROJECTED OHIM BUILDING

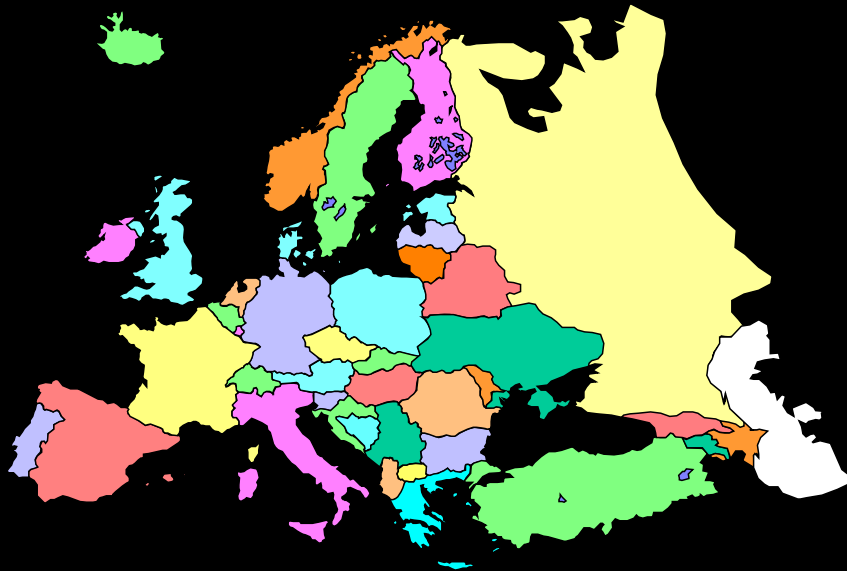


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