

currently 27 EU Member States.⁷³⁹ However, applying for Community trade mark protection in the course of an international registration is attractive: the international registration route is less costly than applying for a Community trade mark and provides for the possibility to opt back to a designation of individual EU Member States via the Madrid System should the Community trade mark application fail, cf. Art. 154(1)(b) CTMR. The proprietor can thus secure protection of the internationally registered trade mark in the EU while using the administrative advantages of the Madrid System.⁷⁴⁰

5.6.2.3 Community Trade Mark Registration

The Community trade mark (CTM) system, in force since April 1, 1996, allows for trade mark protection in all (currently 27) Member States of the European Union by means of one single registration with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) in Alicante, Spain.

Particulars of the formal requirements of a trade mark registration with OHIM are laid down in the Regulation implementing the Community trade mark Regulation (Implementing Regulation).⁷⁴¹ Unlike all other communication with OHIM, the CTM application can be filed with either the respective national office or with OHIM. In order to secure the desired filing date, the basic fee and, if applicable, a class fee for each class exceeding three must be paid within one month from handing in the application, Art. 4 Implementing Regulation. Community trade mark applications with OHIM may be filed electronically, which is not only the fastest, but also the cheapest filing method: whereas the current basic fee for standard paper filing is EUR 1050, it is EUR 900 in case of e-filing.⁷⁴²

According to Art. 29-32 CTMR, proprietors of older trade marks or applications made in or for a Member State of the Paris Convention or the Agree-

739 Cf. above at 5.4.1.

740 *Hasselblatt* (ed.), *Münchener Anwaltshandbuch Gewerblicher Rechtsschutz*, § 37 at no.s 11 and 81.

741 Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark.

742 Commission Regulation (EC) No 355/2009 of 31 March 2009 amending Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) and Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, Art. 1 (1).

ment establishing the WTO may, in order to file a Community trade mark application, claim priority during six months from the date of filing of the first application. This requires that the later application is made for the same mark and for either identical goods or services or goods or services comprised by the first application. The effect of the priority right is that the application of the Community trade mark is deemed to have been made on the priority date for the purposes of establishing which rights take precedence, Art. 31 CTMR.

A particularity of the Community trade mark system is the option to claim seniority of an earlier national trade mark for purposes of a respective Community trade mark application according to Art. 34 and 35 CTMR. Provided that the desired Community trade mark is identical with the older national mark and the goods or services applied for are identical with or contained within those for which the earlier national mark has been registered, the proprietor is, even if the earlier national mark is surrendered or has lapsed, deemed to continue having the same rights as if the earlier mark had continued to be in force, Art. 34(1) and (2) CMTR. The option to claim seniority aims at inducing proprietors of national trade marks to surrender these rights in favour of corresponding Community trade marks.⁷⁴³

Apart from general registration requirements such as payment of fees, OHIM particularly examines title, classification of the goods and services according to the Nice Classification and absolute grounds for refusal of trade mark protection, Art. 26(1), 27 and 36 CTMR. Both natural and legal persons may apply for a Community trade mark, as both are allowed to be trade mark proprietors, Art. 5 CTMR. If the aforementioned requirements are met, OHIM issues a Community search report containing older Community trade marks or applications which may be used to challenge the application at hand as relative grounds for refusal of trade mark protection. The application itself is published, at the earliest, one month after OHIM has transmitted the search report to the applicant, Art. 39(6), 40 CTMR.

Third persons then have the opportunity to make observations based on absolute grounds for refusal of trade mark protection (which OHIM examines *ex officio*) or to file an opposition based on relative grounds for refusal, Art. 41-43 CTMR. Depending on the outcome of such proceedings, the application

743 *Marx*, Deutsches, europäisches und internationales Markenrecht, at no. 1221.