

Chapter 4: Overview of the European Community Trade Mark System

A. Introductory remarks

The Community Trade Mark Regulation (CTMR) was enacted in 1993²³² to establish the European Community Trade Mark (CTM) system, which became operational on April 1, 1996. The system permits a single registration to be obtained in respect of a trade mark application processed by a single office that makes a single process resulting in a single registration covering the whole territory of Europe.²³³ The CTM can only be obtained by registration.²³⁴

In this Chapter, some detailed issues relating to the life of a CTM, from the application stage throughout the granting of a registration and thereafter, are discussed. The chapter can, ideally, be divided into two main parts. The first part is devoted to substantive issues, whereas the second is directed to procedural issues. Central for the substantive part are some issues relating to a CTM registration such as the requirements of graphical representation and the condition that a sign must be distinctive in order to avoid being refused registration based on absolute grounds for trademark refusal. The substantive part addresses also some relative grounds for trademark refusal as well as the CTM infringement and the limitations posed against the CTM rights. The same part outlines some duties in relation to CTM and defines some key terms which are useful for the determination of precedence of trademark rights in the context of a CTM proprietorship. The second part of the chapter covers issues relating to the procedure for filing CTM applications, opposition against CTM registration and a Search procedure (as a means by which earlier trademark rights may be discovered). An analysis in the second part extends to some legal issues that may lead a CTM being cancelled either through revocation or invalidity proceedings. The second part concludes with a discussion on how international trademark registrations with effect in the Community are handled.

232 As Council Regulation (EC) No 40/94 published in OJ L 11, 14.1.1994, p. 1. This Regulation was repealed and replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version).

233 The rights attached to the CTM are rights in *rem*. Cf. Article 19(1) of the CTMR.

234 Cf. Article 6 of the CTMR.

To give life to the discussion contained in the chapter, a brief introduction is offered on the office charged with a primary duty to ensure that the substantive principles and the procedure outlined in the CTMR are observed during the processing of CTM applications as well as opposition and cancellation proceedings.

B. Office responsible for CTM system

Article 2 of the CTMR establishes the office for the harmonisation in the internal market (trademark and designs), (hereinafter the Office or OHIM), as the chief office responsible for community trade mark registrations. As a body of the Community, OHIM enjoys a legal personality entitling it to acquire or dispose of real or movable property and be party to judicial proceedings while enjoying the most “extensive legal capacity accorded to legal persons” in each of the Member States.²³⁵ It carries out community objectives, which are in line with community law governing the internal market. OHIM is therefore expected to guide the national authorities as to how the community law in relation to trade mark registration is to be translated and carried out.

Within OHIM’s functional structure established under Article 130 of the CTMR, five units are directly responsible for decisions affecting CTM registrability, namely, the examination, opposition, cancellation, administration and appellate divisions. Examiners, in the examination division, are responsible for examining absolute grounds for trademark refusal,²³⁶ whereas the Opposition Divisions are responsible for decisions on oppositions against CTM registration.²³⁷ The Cancellation Divisions are responsible for all decisions regarding application for revocation or application for declaration of invalidity.²³⁸ An Administration of Trade Marks and Legal Division is responsible for deciding on all legal issues that do not fall within the competence of the above three divisions. Thus, the Administration Division is particularly responsible to take decisions on procedural matters.²³⁹ It is also duty bound to take decisions in respect of administrative issues such as those regarding “entries in the Register of Community trade marks”.²⁴⁰ At the top of these four divisions are the Boards

235 *Cf.* Article 115 of the CTMR.

236 *Cf.* Article 131 of the CTMR.

237 *Cf.* Article 132 of the CTMR.

238 *Cf.* Article 134 of the CTMR.

239 KITCHIN, D., et al, “Kerly’s Law of Trade Marks and Trade names” (4th ed.) 95 (Sweet & Maxwell, London 2005).

240 GASTINEL, E. & MILFORD, M., “The Legal Aspects of the Community Trade Mark”