

# Special ECTA Flash

European Communities Trade Mark Association

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## TRADE MARKS – The Community Trade Mark

Commission Regulation (EC) No. [1041/2005](#) of June 29, 2005 amending Regulation (EC) No. 2868/95 implementing Council Regulation (EC) No. 40/94 on the Community trade mark has been published in the Official Journal L172/4 of July 5, 2005 and will enter into force on July 25, 2005.

This Commission Regulation entails the introduction of various amendments to CTM Regulation No. 40/94 as provided by Regulation No. 422/2004 of 19<sup>th</sup> February 2004 (O.J. EC L 70 of 9 March 2004) and will also provide for some other ameliorations.

We hereby outline the **main** changes:

### 1. Representation of the Trade Mark

Rule 3 § 5 – Colour marks (see also New Rule 12.c)

The amended Rule provides that:

*“Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a **reference to a recognized colour code may be added.**”*

Consequently, the indication of an international recognized colour code is optional.

Rule 3 § 6 – Sound marks

The amended Rule provides that:

*“Where registration of a sound mark is applied for, **the representation of the trade mark shall consist of a graphical representation of the sound, in particular a musical notation;** where the application is **filed through electronic means, it may be accompanied by an electronic file containing the sound.** The President of the Office shall determine the formats and maximum size of the electronic file.”*

### 2. Searches – *All provisions relating to searches will only enter into force as from 10 March 2008.*

- New Rule 5(a) provides for a standard form with minimal information that should contain search reports.

- According to Amended Article 39, the national searches become optional and will be subject to an additional fee – Amended Rule 10.

### 3. Division of an application or registration

According to New Articles 44(a) and 48(a), it is possible to proceed with a division of a CTM application or registration. New Rules 13(a) and 25(a) provides for the procedure and conditions for applying for a division.

According to Rule 13(a)3: it is not possible to request for a division of a CTM application at any time namely:

- “(a) the period before a date of filing has been accorded;*
- (b) the period of three months following the publication of the application provided for in Article 42 (1) of the Regulation;*
- (c) the period after the date of issue of the notification to pay the registration fee referred to in Rule 23 (1)”*

Furthermore, according to Article 44a.2.(a)

*The declaration of division shall not be admissible:*

- (a) if, where an opposition has been entered against the original application, such a divisional application has the effect of introducing a division amongst the goods or services against which the opposition proceedings are finally terminated otherwise;*

Finally, according to § 4 of both Articles concerned, the request for a division of a CTM application or registration will be the subject to a fee.

### Opposition

The whole TITLE II – Procedure for opposition and proof of use has been revised with the exception of Rule 21 – Multiple oppositions. Indeed, the whole section has been revised so as to put it in line with the practice and make it much clearer.

The following can be pointed out:

- Under Amended Rule 15.1. it has now been clearly specified that the earlier marks or earlier rights on which an opposition is based all need to belong to the same proprietor or proprietors. If an earlier mark and/or an earlier right has more than one proprietor (co-ownership), the opposition may be filed by any or all of them.
- New Rule 16a provides that:
 

*“Any notice of opposition and any document submitted by the opposing party, as well as any communication addressed to one of the parties by the Office prior to the expiry of the period referred to in Rule 18 – Rejection of notice of opposition as inadmissible - shall be sent by the Office to the other party for purposes of informing of the introduction of an opposition.”*
- Amended Rule 18.1 provides for a maximum total period by which an extension of the cooling-off may be requested. The cooling-off periods extension will not be able to be requested after a 24<sup>th</sup> months. In such circumstances only suspension of the opposition proceedings will remain possible.

- According to amended Rule 18.5, the opposition filing fees are not only refunded should the CTM application be withdrawn before the end of the cooling-off period but also when the CTM has been limited before the expiry of the cooling-off period and where the limitation has led to the conclusion of the opposition proceedings whatever the limitation has been.
- According to amended Rule 20.3 dealing with the Examination of the opposition, if an applicant submits no observations, the Office shall, and no longer may, base its ruling on the opposition on the evidence before it.
- According to amended Rule 20.4 dealing with the Examination of the opposition, applicant and opponent are only given one term to provide the relevant observations.
- According to amended Rule 22.1, proof of use will only be admissible if the applicant submits such a request within the period specified by the Office to the applicant to file observations.

#### 4. Renewal

Amended Rule 30 provides for a simplification of the renewal formalities.

#### 5. Transfers

Paragraphs 3 and 4 of Rule 31 have been dropped and fees are no longer to be paid when applying for the recordal of a transfer.

#### 6. Licences

Further to the amendment of Rule 33.1 which now refers to Rule 31.5, no proof of the licence is needed if the request for recordal is filed or co-signed by the trade mark holder himself. However, should it be requested by the licensor, some proof of the licence is to be submitted.

#### 7. Conversion

Amended Article 108 already entered into force as from March 2004. Amended Rules 44 – 45 and 47 clarify the procedure further. Amended Rule 45.4 provides for:

*“If the Office or a Community trade mark court has refused the Community trade mark application or has declared the Community trade mark **invalid on absolute grounds** by reference to the language of a Member State, **conversion shall be excluded under Article 108 (2) of the Regulation for all the Member States in which that language is one of the official languages**. If the Office or a Community trade mark court has refused the Community trade mark application or has declared the Community trade mark invalid on absolute grounds which are found to apply in the whole Community or on account of an earlier Community trade mark or other Community industrial property right, conversion is excluded under Article 108 (2) of the Regulation for all Member States.”*

## **8. Appeals**

According to amended Article 50.1, the Continuation of the proceedings as provided by Article 78a is not applicable to the deadlines to file observations as provided by Article 61.2.

Further amended Article 50.1 provides that:

*“Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74 (2) of the Regulation.”*

## **9. Revocation of a decision or entry in the Register**

According to new Rule 53a in combination with Article 77a, the Office will, on its own motion or pursuant to corresponding information by the parties involved into the proceedings of concern, be able to revoke a decision or an entry. Affected parties may be provided with observations before the revocation is implemented.

## **10. Use of registered mail**

Amendment to Rule 62 leads to the fact that not all decisions and communications other than for appeal, summonses and other documents as determined by the President of the Office shall no longer be done by registered mail with advice of delivery but by ordinary mail.

Further, according to new paragraph 5 of Rule 62, “Notification by ordinary mail shall be deemed to have been effected on the 10<sup>th</sup> day following that of its posting”.

## **11. Extensions of time limits**

Further to the amendment of Rule 72.2, a postal strike in a Member State other than Spain will no longer lead to an extension of the time limits.

Further to the amendment of Rule 72.4, in exceptional occurrence such as a natural disaster or if a strike interrupts or dislocates proper communication from the parties to the proceedings and the Office and vice-versa it may only lead to an extension of the time limits for the parties having their residence or registered office in the State concerned or who have appointed a representative with a place of business in the State concerned, unless it being Spain where it then applies to all parties.

## **12. Authorizations**

Further to the entry into force of amended Article 89 and amended Rule 76.1, professional representatives will have to provide the Office with an authorization only should the Office expressly request it, or, where there are several parties to the proceedings in which the representative acts before the Office, and that the other party expressly asks for it.

## **13. Annexes to written communications**

New Rule 79a provides that:

*“Where a document or an item of evidence is submitted in accordance with Rule 79 point (a) – communications in writing - by a party in a proceeding before the Office involving more than one party to the proceedings, the document or item of evidence, as well as any annex to the document, **shall be submitted in as many copies as the number of parties to the proceedings.**”*

#### **14. Notifications by fax**

Amended Rule 80.3 provides that where a communication has been sent by telecopier electronically, the indication of the name of the sender shall be equivalent to the signature and the effective signature is not needed.

#### **15. Apportionment and fixing of costs**

The amount of the representation costs to be paid by the losing party has been reviewed in Rule 94.d.

Further, amended Rule 94.3 provides that:

*“Where the amount of the costs has not been fixed pursuant to Article 81 (6), first sentence, of the Regulation, the request for the fixing of costs shall be accompanied by a bill and supporting evidence. **For the costs of representation referred to in paragraph 7 (d) of this Rule, an assurance by the representative that the costs have been incurred shall be sufficient. For other costs, it shall be sufficient if their plausibility is established.** Where the amount of the costs is fixed pursuant to Article 81 (6), first sentence, of the Regulation, representation costs shall be awarded at the level laid down in paragraph 7 (d) of this Rule and irrespective of whether they have been actually incurred.”*

Also to be noted the entry into force of amended Article 81.6 which provides that:

*“6. The opposition Division or Cancellation Division or Board of Appeal shall fix the amount of the costs to be paid pursuant to the preceding paragraphs when the costs to be paid are limited to the fees paid to the Office and the representation costs. In all other cases, the registry of the Board of Appeal or a member of the staff of the Opposition Division or Cancellation Division shall fix the amount of the costs to be reimbursed on request. The request is admissible only within two months of the date on which the decision for which an application was made for the costs to be fixed became final. The amount so determined may be reviewed by a decision of the Opposition Division or Cancellation Division or Board of Appeal on a request filed within the prescribed period.”*

#### **16. Decisions taken by a single member of the Cancellation Division**

Amended Rule 100 provides with a list of decisions that can be taken by a single member by the Cancellation Division allowed further to the amendment of Article 29, namely:

- (a) decisions on the apportionment of costs;*
- (b) decisions to fix the amount of the costs to be paid pursuant to Article 81 (6), first sentence, of the Regulation;*

- (c) *decisions to close the file or not to proceed to judgment;*
- (d) *decisions to reject an opposition as inadmissible before expiry of the period referred to in Rule 18 (1),*
- (e) *decisions to stay proceedings;*
- (f) *decisions to join or separate multiple oppositions pursuant to Rule 21 (1). “*

Further, Commission Regulation (EC) No. [1042/2005](#) of June 29, 2005 amending Regulation (EC) No. 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) has been published in the Official Journal L172/22 of July 5, 2005 and will enter into force on July 25, 2005. The Regulation provides, amongst others, for the fee for continuation of proceedings as per Article 78(a) of the CTMR (400 Euro) and the fee for the declaration of division of a registered Community trade mark as per Article 48a(4) or an application for a Community trade mark as per Article 44a(4) (250 Euro).

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The Compilation of CTM Regulation No 40/94, Implementing Regulation No 2868/95 and Fee Regulation No 2869/95 taking into consideration and highlighting the latest amendments are available on ECTA's website in the member's only section at: [http://www.ecta.org/regulations\\_tm.php](http://www.ecta.org/regulations_tm.php)

N.B. The following Rules of the CTMIR have also been amended but not reported above as the amendments are considered of minor importance:

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|----------------------|----------------------|-------------------|
| (1) Rule 1(1)        | (15) Rule 26(2)(d)   | (38) Rule 65(1)   |
| (2) Rule 3§2         | (17) Rule 28(c-d)    | (39) Rule 66(1)   |
| (3) Rule 4           | (19) Rule 31(3)(4)   | (43) Rule 79      |
| (5) Rule 6(1)        | (20) Rule 32(4)      | (46) Rule 81      |
| (6) Rule 8(2)        | (22) Rule 34         | (47) Rule 82      |
| (7) Rule 10          | (23) Rule 35(3)      | (48) Rule 83      |
| (8) Rule 12(c)       | (24) Rule 36(1)(c)   | (49) Rule 84      |
| (9) Rule 13 (c)      | (25) Rule 38.1.3     | (50) Rule 85(1)   |
| (10) Rule 15.2.3.4 – | (26) Rule 39         | (51) Rule 89.1.2. |
| Rule 16 – Rule       | (27) Rule 40.1.4.5.6 | (52) Rule 91      |
| 17 – Rule 18 –       | (31) Rule 51         | (54) Rule 98      |
| Rule 19 - Rule       | (32) Rule 53         | (56) Rule 101     |
| 20.1.2.5.6.7 –       | (34) Rule 59(4)      | (57) Rule 114     |
| (13) Rule 24(2)      | (35) Rule 60         | (58) Rule 122.1.c |
| (14) Rule 25(1)(c)   | (36) Rule 61.1.3.    |                   |