

International and Regional IPR Mechanism for Improving the Access to the Global Market The Community Trade Mark and Community Design System

The Office for Harmonization in the Internal Market for Trade Marks and Designs

The Office for Harmonization in the Internal Market for Trade Marks and Designs (OHIM) in Alicante is an agency of the European Union with legal, administrative, technical and financial autonomy vis-à-vis the central EU Institutions. OHIM has its own budget and income and decides – in the scope of its tasks and under the control of its Administrative Board and Budget Committee and the European Court of Auditors - on its business plan.

OHIM's task is to grant trade mark and design titles of protection which are valid and enforceable throughout the whole EU territory in all 27 member states. Since 1996, it grants trade mark rights known as "*Community trade marks*" *CTMs*¹. Since 2004 the EU is member of the Madrid Protocol, so CTMs can be used as basis for International Registration and the EU can be designated as area of protection of an International Registration. Since 2003 OHIM also grants design rights, valid and enforceable throughout the European Union, known as "*Community designs*" "*RCDs*"².

To stay competitive in a globalised environment, businesses need PTOs - both national and international - that work diligently in the creation and protection of the IP assets. Therefore, quality, certainty and cost-effectiveness, accessibility and efficiency must be universally applicable to all legal systems and all public organisations dedicated to the protection and promotion of Intellectual Property.

Consequently, OHIM strives to be a quality-focused, highly productive, user-friendly, efficient and cost-effective organisation. In order to improve its performance OHIM will simplify procedures wherever possible and eliminate unnecessary bureaucracy.

The value of CTM and RCD

CTMs and RCDs are the gateway to the single market and OHIM is the one stop shop to register those rights which are valid throughout the European Union of 27 countries and almost 500 million people.

Trademarks play an important role in marketing and communication in order to identify products and services. Trade Marks are signs which distinguish the goods or services of one enterprise from those of another and secure that customers easily recognise and remember where the goods and services come from. Any sign which can be represented graphically, particularly words, designs, letters, numerals, the

¹ Legal basis: Council Regulation EC No 40/94, consolidated version no 207/2009 of 26 February 2009 on the Community Trade Mark– CTMR and Commission Regulation (EC) No 2869/95 of 13 December 1995 (CTMIR)

² Legal basis: Council Regulation EC No 6/2002 of 12 December 2001 on Community Designs (CDR) and Commission Regulation no 2245/2002 of 21 October 2002 (CDIR)

shape of goods or of their packaging, colours, sounds can be registered as a trade mark (Article 4 CTMR).

Designs protect the appearance of the whole or a part of a product resulting from the features of the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. As outward appearance plays an important role for the distinctiveness and value of products, protecting design rights becomes increasingly important.

How to register a trade mark or design?

Three alternative routes allow companies to obtain titles for protection of trade marks and designs within the European Union and to choose the scope of protection which fits their purposes best:

- The National Route (National Patent and Trade mark Offices, PTOs)
- The International Route (Madrid or Hague Agreement and Protocol via WIPO)
- The Community Route (OHIM)

Using the national route means:

- To file individual applications with a national trademark office anywhere in the world according to the national requirements. Although in the European Union Trade Mark Laws have been harmonized³, differences concerning procedures and examination practice still exist in the member states and may complicate application procedures.
- To pay a (different) fee at each National Office – several rights may be costly.
- To get protection according to the national law for one country only.
- To translate the list of goods and services in the different languages and to find varying applications of the Nice classification rules.
- To pay and instruct one or probably more lawyers.

Using the international route via the Madrid agreement or the Madrid protocol means:

- To obtain a basic trademark in one country.
- To pay a single fee to WIPO.
- To designate countries – more than 1 from Europe and from all over the world - which are member to the Madrid system, including OHIM (Community trade mark) for all 27 members of the European Union.
- To pay an additional individual fee to the designated national offices or/and OHIM, who will start individual examination procedures according to their national laws.
- To obtain a bundle of different national rights which are subject to the national laws in the designated country.
- To pay (probably) translation costs.

³ First Council Directive of 21 December 1988 to approximate the Laws of the member States relating to trade marks (89/104/EEC)

- To pay (probably) lawyers' fees in one or more countries, as in some countries you have to be represented by lawyers, and anyhow professional advice is to be recommended.

Using the Community route means:

- To file one application with one single Office, the OHIM, in one of the official languages of the EU.⁴
- To pay one single fee (for the time being 1050 € for application and registration, reduced by 150 € to 900 € when e-filing for a CTM; 350 € for a RCD).
- To get translation in all official languages of the EU done by OHIM, included in the fee.
- To obtain one title valid throughout all 27 member states. CTM and RCD are unitary rights, they are valid in the whole EU territory – however, if there are obstacles for granting protection in only one part of the Community, the right cannot be granted at all.
- To have recourse to the European Courts in Luxembourg.

Representation

CTM and RCD applications can be filed by any natural and legal person. There are no unnecessary formalities and applicants have the possibility of e-filing.

For applicants with domicile or principal place of business in the EU a representative is not compulsory. However, applicants from outside the EU need to designate a representative domiciled in the EU. Although the Office provides online information and help for the application and the following examination procedures, the professional advice of representatives who are well versed in questions of Intellectual Property may be helpful.

Duration of Protection

Once registered, a CTM is protected for 10 years from the filing date. Rights are enforceable as from the publication of the registration. A CTM can easily and repeatedly be renewed for another 10 years without limitations. Renewal fees are 1500 €, which are reduced to 1350 € when using the e-renewal tool⁵.

Design rights are protected for 5 years from the filing date, renewal may be asked for once or several times for 5 years up to a maximum of 25 years. The individual renewal fee is between 90 and 180 €, depending on the period.⁶ The longer you want to protect your design, the more you have to pay for renewal.

⁴ A second language, which must be one of the official languages of the Office (English, German, French, Italian, Spanish) must be indicated with the application for eventual opposition – and invalidity procedures.

⁵ <http://oami.europa.eu/ows/rw/pages/QPLUS/forms/electronic/fileRenewalCTM.en.do> ;

⁶ <http://oami.europa.eu/ows/rw/pages/QPLUS/forms/electronic/fileRenewalRCD.en.do> .Renewal fee (Article 13(1) of Regulation (EC) No 6/2002; Article 22(2)(a) of Regulation (EC) No 2245/2002) per design, included or not in a multiple registration:

Doing e-business with OHIM

The Office's investments in e-Business tools allow it to work with companies from all over the world via the Internet, so that geography and time will become more and more irrelevant when doing business with OHIM.

One of the main objectives of OHIM is to make applications and interactions with the Office for the customer as easy as possible – and use the help of up to date computer tools and WEB services where ever possible. All necessary information about trade mark and design applications and procedures can be found on OAMI online.⁷ Doing e-business with the Office is supported by detailed explanations, help files and demonstrations on OHIM's webpage – and in addition to speeding up procedures in may cases reduced fees save money.

OHIM has a policy of openness and transparency. A range of search tools allows a fast and user-friendly lookup of Community trade marks and designs, and provides information about classifications or help in the search for representatives. CTM-online⁸ and RCD - online⁹ provide ready access to information on Community trade mark (CTM) and Community design (RCD) applications and registrations including online access to CTM files¹⁰. OHIM currently provides access to all non-confidential correspondence exchanged between the Office and the CTM owner and/or their representative via the Online Access to the CTM Files service – available through the “search trade marks” link.

Apart from the legal texts governing CTM and RCD applications, OAMI online provides a lot of valuable information which can be printed or downloaded. There are also a number of “how – to” videos demonstrating the Office's e-Business tools and other online tutorials which can help to answer most questions in relation to the use of the e- systems. For most of the tools OHIM provides a demonstration in which customers can “click” through the main steps, for example of the e-filing process¹¹.

Especially when deciding on the list of goods and services the Office provides additional and useful information with its databases EUROCLASS, EUROLOCARNO and EURONICE¹².

EUROACE is a database with descriptions of goods and services that are immediately accepted by the office. By using these expressions the applicant can be assured that the office will raise no objections, therefore greatly reducing the application processing time as there would be no need for the applicant to respond to

-
- (a) for the first period of renewal: € 90
 - (b) for the second period of renewal: € 120
 - (c) for the third period of renewal: € 150
 - (d) for the fourth period of renewal: € 180

⁷ <http://oami.europa.eu/ows/rw/pages/index.en.do>

⁸ <http://oami.europa.eu/ows/rw/pages/QPLUS/databases/searchCTM.en.do>

⁹ <http://oami.europa.eu/ows/rw/pages/QPLUS/databases/searchRCD.en.do>

¹⁰ http://oami.europa.eu/en/database/tm_help.htm#2700

¹¹ <https://secure.oami.europa.eu/ctm/efiling/displayform.htm?result=init&reloadable=YES&lang=EN>

¹² <http://oami.europa.eu/ows/rw/pages/QPLUS/databases/euroace.en.do> ;
<http://oami.europa.eu/ows/rw/pages/QPLUS/databases/eurolocarno.en.do>

official correspondence. All expressions are in accordance with the 9th edition of the International classification of goods and services established by the Nice Agreement.

EURONICE is a translation database for the description of goods and services which contains translations of the most frequently used expressions by Community trade mark applicants to describe the goods and services covered by their marks. This database currently contains about 17,000 expressions represented in the 22 official languages of the EU.

The **TMview** programme, which is currently being developed, aims to create a common trade mark search engine tool to allow users to consult registers of the EU national offices as well as OHIM's trade mark register. A test or "Beta" version of TMview was launched in November 2009, with the full release planned for 2010¹³.

SME in action

To improve information especially for the SME's, OHIM has created a special section on its webpage which is called "SME in action"¹⁴. Interested SME can find comprehensive Quick Guides to Intellectual Property, Designs and Trade Marks with all the relevant information, as well some reports of SMEs on how they are using the Community trade mark and design to help them to be successful in the European market. These reports show that IP rights are important and valuable for everybody – not only for the big players, but especially for small and medium enterprises. Indeed, the majority of CTM and RCD owners are persons or legal entities who own 1 to 5 rights – those who have up to a hundred or even more are quite rare...

¹³ www.tmview.europa.eu

¹⁴ <http://oami.europa.eu/ows/rw/pages/OHIM/multimedia/SME/SMEsinAction.en.do>