

THE EUROPEAN COMMUNITY TRADEMARK (CTM) SYSTEM

Changes to the CTM system will come into force on 25 July 2005.

The main changes are:

- ***Division of a CTM application or registration***

As with UK practice, provision for dividing an application or a registration is being introduced. Thus, for example, if an application is opposed or an existing registration is challenged for some, but not all, of the goods/services covered by it, then the applicant/registered proprietor will be able to divide the application/registration upon payment of a fee so that the unobjectionable goods/services are unaffected by the challenge.

- ***Opposition***

Proof of Use

If an application has been opposed on the basis of prior registration(s) that have been registered for more than 5 years preceding the publication date of the opposed application, then the applicant can request that the opponent file evidence to show that their earlier registration(s) have been used in that 5 year period, and are therefore valid and enforceable. Under the current system, the applicant can make this request at any stage during the opposition proceedings. Under the new rules, this request must be made within a specific deadline which will be set by the CTM office and will be the same deadline for the applicant to file their observations in defence of their application.

Cooling-Off Period

If the parties are negotiating a settlement during an opposition, it is possible to postpone the date of commencement of the adversarial part of the proceedings. Both parties must agree to this extension of the “cooling-off” period. Under the current regime, extensions of the “cooling-off” period can be sought indefinitely. In order to try to focus the parties in working towards a settlement, the CTM office will now only allow “cooling-off” periods to exist for a maximum of 26 months from the date of their notification of admissibility of the opposition. If no settlement is reached by the end of this 26 month period, then the adversarial part of the proceedings will commence and the parties will be set deadlines for filing their evidence and observations in support of their case. It will, however, be possible to suspend the proceedings (if both parties agree) once the adversarial part of the proceedings has commenced.

- *Continuation of Proceedings*

If a deadline for responding to a CTM office deadline has been inadvertently missed then under specific, and very limited, circumstances, it may be possible for the CTM office to accept late submissions providing that these are filed within 2 months of the missed deadline and accompanied by a penalty fee. This provision is available only in very limited scenarios such as responses to an examination report and this facility will not, for example, be available in opposition proceedings or when filing applications claiming priority. We do not recommend that “continuation of proceedings” be relied upon in day to day practice, and we strongly recommend that all clients issue us with instructions in good time so that we can meet initial deadlines set by the CTM office.

- *Assignments*

Under the new rules, there will be no official fee to pay in order to transfer ownership of a trademark application or registration.

If you have any questions or need further information, please do not hesitate to contact Ian Buchan, Sanjay Kapur or John Peacock.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

Please note that all our Newsletters can be found on our website at www.eric-potter.com.

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