

EUROPEAN COMMUNITY TRADEMARK

The European Commission has very recently approved a number of changes to the Rules governing the Community Trademark system. The precise date on which these changes take effect is not yet known. However, it is anticipated that these changes will be implemented shortly.

This newsletter is being provided for information only; no action is required at this time.

We list below a summary of the most important changes:

1. *Ownership of Community Trademark Registrations*

Presently, to be an owner of a Community Trademark Registration, the Applicant must be domiciled a) in one of the European Union countries or b) in a country which is a member of the Paris Convention or in a country which is a member of the WTO or c) in a country which has reciprocal agreements with the European Union. In the future the ownership requirement will be broadened to include any natural legal person/body irrespective of their country of domicile.

2. *Authorisation*

It will no longer be necessary to provide an Authorisation of Agent unless this is specifically requested by the Community Trademarks Office.

3. *Division*

It will, in future, be possible to divide an application so that the divisional application, which will be for a limited range of goods and/or services, can proceed to registration whilst the parent application is dealt with separately. For example, division may be of benefit if the application is the subject of an objection which relates to some, but not all, of the goods or services on the application.

It will also be possible to divide a registration into two or more registrations, provided that there is no overlap of goods and services between the divisional registrations.

4. *Further Processing*

When certain deadlines for responding to official actions have been missed inadvertently, it will be possible to complete the missed actions provided that a penalty fee is paid and the action is completed within two months of the missed deadline. However, this provision will not apply to the filing of applications *per se*, the filing of applications claiming priority after the priority period has expired, failure to pay the filing fees, the opposition period, appeals to the Court of Justice and applications for *restitution in integrum*.

5. *Enlarged Board of Appeal*

An Enlarged Board of Appeal will be established to try to bring uniformity to appeal decisions by the Community Trademark Office.

6. *Trademark Searches and Application Fees*

It is intended that the filing fees for Community Trademark applications will remain the same as at present when a further 10 countries join in May 2004.

At that time these 10 countries will decide whether or not they will carry out searches of their National Register against each new Community Trademark application. These searches are presently carried out by all of the current member states of the European Union with the exception of France, Germany and Italy.

This arrangement will run for a period of 4 years.

Thereafter, it is likely that the searches carried out by the national offices will become optional and at the applicant's discretion and cost.

If you require any 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.

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