

## **CTM TO JOIN MADRID PROTOCOL**

From **1 October 2004**, the Community Trademark (CTM) system will become part of the International Registration system (via the Madrid Protocol).

As of this date, the CTM Office (OHIM) will accept International Registrations which designate the CTM system, in order to obtain protection in all 25 members of the European Union.

Applications for International Registrations designating the CTM system must still be sent to the WIPO International Bureau (which administers the International Registration system) via one of the National Offices of a territory which is a Contracting Party to the Madrid Protocol. These applications will be recorded by WIPO and then, where the CTM system has been designated, they will forward the details to the CTM Office, where the application will undergo the same examination procedure as that applicable to “direct” CTM applications.

The CTM Office is confident that it will be able to meet the examination deadline (18 months) required by the Madrid Protocol system.

Should a CTM designation within an International Registration encounter official objections, or third party oppositions, it will still be necessary to appoint an attorney, authorised to act before the CTM Office, in order to deal with the objections/oppositions. Eric Potter Clarkson has several such Authorised Representatives.

Conversely, owners of existing CTM registrations, and applicants for new CTM applications, will be able to apply for an International Registration, based on the CTM registration or application, via the CTM Office. This will then enable protection to be sought in any of the territories which are an existing Contracting Party to the Madrid Protocol.

Additionally, as of 1 October, it will be possible to extend existing International Registrations to cover the CTM system.

### **Recommendation**

Despite this new development, we recommend that protection via the CTM system should be obtained through direct filing at the CTM Office, rather than utilising the International Registration system. This is primarily because:

1. The CTM designation within an International Registration cannot have a claim of goods or services wider than what is claimed by the base national

registration or application. If this is based from a territory which does not permit wide claims of goods or services (e.g. USA), the resulting infringement rights within the European Union will be restricted accordingly.

The CTM Office permits applications that are filed directly with it to contain wide claims of goods and services.

2. International Registrations are subject to the “*central attack*” rule. If the base national registration upon which the International Registration stands is cancelled (or partially cancelled) during the first 5 years of the International Registration, the cancellation (or partial cancellation) will automatically extend to all of the designated territories. Likewise, if it is based on a national pending application, and that application fails (or partially fails), the resulting International Registration will fail (or partially fail) in all of the designated territories. There is, however, provision for “transforming” such cases into separate national filings, retaining the original filing date – but additional costs would be incurred.
3. There are ownership restrictions for International Registrations which would not apply to CTM applications filed directly with the CTM Office. Essentially, the owner of an International Registration must either (i) be a national (or company) domiciled in a territory which is a Contracting Party to the Madrid Protocol, or (ii) have a real and effective commercial or industrial establishment address in such a territory. Without either of these, it is not possible to own an International Registration.
4. When designating a CTM in an International Registration, all of the CTM official fees (including the final registration fee) have to be paid in advance. These will not be refunded if the CTM designation is refused (e.g. because of a successful opposition). At present about 20% of all CTM applications fail to qualify for registration.

For further information in this matter please contact Ian Buchan, Sanjay Kapur or John Peacock in our Nottingham Office.

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](http://www.eric-potter.com).

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