

European Community Trademark Basics

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- **What is a community trademark**

The community trademark was established by the European Union to provide a unified trademark for the entire European Community. Once acquired, the mark covers all 15 countries of the European Union. The mark is used to enforce trademark rights in the entire region.

- **When was OHIM, the Community Trademark Office, established**

Since January 1, 1996, the OHIM has been accepting applications and somewhere in the neighborhood of 20 to 25,000 applications were received by the time the office officially opened on April 1, 1996. Approximately 1/3 of these applications were from the United States. There has been some hesitance on the part of the business community to accept the European Trademark. The concerns include the limited enforcement in specific courts, limited court jurisdiction, uncertainty about how marks will be treated, the concern about the application rising or falling based on a single application.

- **How can rights be enforced?**

The regulations provide for the enforcement of the mark in courts designations by member states. Venue for an enforcement action is in such a court in the country in which the defendant resides. However, in the event that neither the plaintiff nor the defendant have an office in the state, the only of jurisdiction is likely to be in Spain. Spain has a significant interest in providing a forum that will be respected in the European Union and abroad.

- **What are the Costs?**

Since the government cost for a basic filing is 975 ECU's (approximately \$1,300) and includes up to three classes of goods or services, the use of the European Mark is definitely beneficial when the consideration involves merchandising properties or other properties that cover more than one class. If the application is permitted to be registered, a registration fee of 1100 ECU is charged by the OHIM. These costs are exclusive of attorneys fees. Budgeting \$5,000 for each CTM application is a reasonable approach. Unknown cost factors include the possibility of opposition proceedings described below.

- **The Application**

The application consists generally of six pages (or more) which for the most part is self explanatory. As with applications elsewhere, the information required is deceptively simple. The identification of goods should be carefully considered. The identification of goods may need to be translated into the working language.

- **Procedure in the OHIM**
- **Filing by fax, or hard copy or on disk**

The filing of a Community trademark can be by fax, hard copy or on disk. OHIM provides a computer

program which places the application on electronic media. However, the initial program released does not have the ability to print out the entire application, and the only way the application may be printed out is individual screens. Since the filing can be by fax, the original signature of the applicant is not required. If the application is filed by fax, the rules provide for submitting the filing within 30 days thereafter. Note that the filing fee generally must be in ECU's and not in other currencies.

Confirmation of a fax filing is made by return fax. Prosecution of the application must be done by a European lawyer or European trademark agent authorized to practice before the European Trademark Office.

- **Languages**

The office will accept applications in eleven languages of the European community. However, a second language must also be designated which is one of the five official languages of the office. Those language are English, Spanish, French, Italian and German. In the event that oppositions are filed, they are likely to be in the second language. Many practitioners have suggested that if you file the application in a language which is not widely used, such as Dutch, Finish or Greek, it is highly likely that further correspondence will be in the second language. In filing in a particular language, the only matter which is required to be in that particular language is the identification or description of the goods and services. This identification and description is then translated by the office during the publication time, into 5 languages.

- **Examination**

The application is examined for absolute grounds of rejection, but not "relative" grounds. Absolute grounds for rejection are those which prevent registration despite the existence of rights of any third party. Only during the opposition period, can relative grounds be raised.

- **Searches**

Once examination for absolute grounds are completed, the mark is sent out to the various countries for a search. Searches are not conducted in Germany, France and Italy. The search reports are provided to the applicant who can amend the application as appropriate. A search is conducted by OHIM, however, of marks which have been registered by OHIM or for which an application is pending. The owners of the marks are then

- **Payment of filing fee**

The filing fee is 975 ECU for the first three classes or European Currency Units. Currency in other form is not required. If the filing is from the United States, one must obtain a foreign current draft in ECU's. Most banks in the United States are not yet equipped to either write drafts or wire funds in this currency.

- **Publication**

The mark is published in the Gazette of the Community Trademark Office.

- **Opposition period**

An opposition may be filed by a party who has priority rights or seniority rights. Priority rights exist based on a prior Community mark. Seniority rights exist based on rights based on a prior national registration. Opposition may be effected both as a result of registrations, and also based on common law rights to the extent that they are recognized in a member country. Trade name and company names may be the basis for filing oppositions.

- **Comparison with United States Registrations**

- A federal registration covers the entire country; the European mark covers the entire community.
- State common law rights can be the basis of an opposition or cancellation preventing acquisition of a registration; rights acquired under the law of a member state of the Community mark can be the basis of a valid opposition preventing registration of the mark.
- State law registrations are generally based on use; national registrations in Europe generally need not be based on use.
- Enforcement can be in any court, whether state or federal; enforcement of community mark is limited to those designated by member states.
- Cost is very expensive compared to US registration, however, less costly if registration of several countries is contemplated. Also, cost becomes reduced in relationship to the cost per class if a multiple class application is filed.

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***Domestic and International Copyright and Trademark Law;
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