

Preparation for seventeenth session of SCT

Contribution from OHIM

I. New types of marks

A. Methods of representation and description of new types of marks

All Community trade marks (CTMs) must be capable of being represented graphically.

For 3-D marks, the representation must consist of a photographic reproduction or a graphic representation. Up to six different perspectives may be provided.

Where registration in colour is applied for the representation must consist of the colour reproduction of the mark. The colours making up the mark must be indicated in words. A reference to a recognised colour code may be added and this is recommended.

For sound marks the representation must consist of a graphical representation, in particular musical notation. Where the application is filed electronically it may be accompanied by an electronic file containing the sound.

There are no specific rules for other types of new mark. Movement marks have been accepted. However, case law has repeatedly found that smell marks cannot be represented graphically.

Applicants are free to describe the marks as they choose provided the description is in conformity with the representation.

B. Established trade mark principles and new types of marks

As far as distinctiveness is concerned the jurisprudence relating to CTMs makes no distinction between traditional and new types of marks.

CTMs may not be accepted where they consist exclusively of either:
the shape which results from the nature of the goods themselves, or
the shape of goods which is necessary to obtain a technical result, or
the shape which gives substantial value to the goods.

II. Opposition proceedings

The CTM system provides for a pre-registration opposition procedure. Opposition is possible within a non-extendible period of three months following the publication of the application. Publication takes place after *ex officio* examination for formal deficiencies and consideration of any absolute grounds for refusal. There is no *ex officio* examination of any relative grounds.

Opposition is filed in respect of less than 20% of the applications published.

Opposition may be based only on a limited number of earlier rights. Absolute grounds cannot be the basis of an opposition. Essentially opposition is limited to earlier identical or confusingly similar trade marks, or trade mark like rights, having their effect in the European Communities. Principally these are CTMs, national marks and international marks designating the EC or any of its member states.

The procedure involves exchanges of evidence and argument between the parties within a regulated system of time limits. Decisions are taken by OHIM where the process does not result in agreement between the parties. About 80% of oppositions are settled without the need for an OHIM decision.

III. Post registration proceedings

Cancellation is not undertaken *ex officio*. It must be initiated by an interested party. In addition to the relative grounds available in opposition proceedings absolute grounds and additional relative grounds may form the basis for cancellation proceedings. A CTM may be declared invalid where the use of such trade mark may be prohibited pursuant to an earlier right and in particular:

- a right to a name,
- a right to a personal portrayal,
- a copyright, or
- an industrial property right.