

## **THE TRADE MARK IN THE EUROPEAN COMMUNITY REGISTRATION AND PROCEDURE**

**Mihaela Teacă, Oana Mihăilă**  
**University of Oradea**  
**mihaela.teaca@yahoo.fr**  
**omihaila@uoradea.ro**

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The main legal provisions regarding the trade mark in the European Community can be found in the following three European regulations:

- Regulation nr. 40/94 of the Council – The basic Regulation or “ ECTR “ (European Community Trade Mark Regulation);
- Regulation nr. 2868/1995 of the Commission – The enforcement Regulation or “ERET”;
- Regulation nr.2869/1995 of the Commission on the taxes paid to the Office – the tax Regulation or “ TRET”

In addition to these Regulations, the Commission adopted on the 05<sup>th</sup> of February, 1996, regulation 216/1996 laying down the rules of procedure of the Boards of Appeal. The Office has also adopted various guidelines regarding proceedings and the President of the Office has adopted decisions and issued communications.

Trade mark is a sign used in business in order to distinguish the products or services of a particular company from those offered by another company and on which the owner has an exclusive right. The international classification of the products and services registered as trade marks has entailed the need to protect these marks. The European Community Trade Mark System (ECTS) involves a unique registration procedure which offers the owner exclusive rights within all the states of the European Union.

Product is any kind of item which may trade and service is the provision of activities in accordance with human needs.

The trade mark of a certain product or service can represent the image of a company and can become a currency value and benefit from protection. The person who doesn't request the protection of his/her trade mark may lose the right to use it in favor of other investors. The exclusive right on a particular trade mark can be obtained only by registration.

The European trade mark is a sign which identifies and distinguishes products or services from others of the same kind. This is available on the entire territory of the European Community and can be registered at OHMI according to the specific conditions stipulated by the Regulations regarding the European trade marks.

The community trade mark confers on its owner an exclusive right. The owner is entitled to prevent all third parties, who do not have his consent, from using in the course of trade the same or similar signs for identical or related goods as those protected by the trade mark.

The community trade mark has a unitary character.

Can be obtained a national registration but, if registration has previously been refused by the OHIM, it is likely that it will not succeed in those Member States where the Community trade mark application has not been considered to be eligible for registration.

The difference between a design and a trade mark is essential. A design is intended to determine the shape of a product, to decorate a product and a trade mark is applied to the product, but, the main function is to identify a particular trade origin in connection with specific goods and/or services.

The obligation to use a trade mark is a serious practice in the community in order to protect goods and services already registered.

A trade mark can be used at any stage, even before filling the application. However, this use does not guarantee the registration of the trade mark.

A trade mark in the E.U. is obtained by registration. The trade mark application entitles the applicant to file oppositions against subsequent trade mark applications which may be identical or similar to his trademark for identical or related goods or services. Additionally, a trade mark application may be transferred, involved in insolvency proceedings and licensed, among other possibilities.

A Community trade mark is a sign for identifying and distinguishing goods or services valid across the European Community, registered with the OHIM in accordance with the conditions specified in the community regulations.

The Trade mark system leaves the national trade mark systems of Member States unaffected. Business enterprises are free to file national trade mark applications. Earlier national trade marks constitute earlier rights against a community trade mark and vice versa. The Office does not examine such earlier rights of its own motion. Only the proprietor of the earlier right can raise this issue, either by filing an opposition within 3 months of the publication of the community trade mark application, or following the registration of the trade mark by filing an application for a declaration of invalidity on relative grounds

The Office can refuse a trade mark application if a ground for refusal exists only in part of the Community. For example, the trade mark consists of the designation of the product in one official language of a Member State of the E.U., the Office will refuse the trade mark application.

Earlier rights, raised in an opposition or in an application for a declaration of invalidity, prejudice the registration of a trade mark. The effects of this situation can not be exaggerated. An application must be refused because the mark constitutes a non distinctive or a descriptive or generic term in only one language of the Community, but these cases are not so frequent.

If an earlier right in only one Member State exists, it goes without saying that this right can not be invalidated by the later filing of a CTM by another person. The opposition or invalidity procedure before the OHIM will, in such cases, offer ample leeway for an amicable settlement

A trade mark application which has been refused, or a trade mark which has been declared invalid or revoked, may be converted into national trade mark applications in all the Member States of the European Community in which the ground for refusal does not apply.

A trade mark can be any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings

A sign may not be registered as a trade mark if an absolute ground for refusal applies namely if the sign: is devoid of any distinctive character; exclusively serves to designate the kind, quality, quantity, value, geographical origin or the time of production of the goods or other characteristics of the goods or service; has become customary in the current language and established practices of the trade; is contrary to public policy or to accepted principles of morality; is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.

Other absolute motives for refusal may relate to the shape of the goods, the origin of alcoholic beverages, agricultural products and foodstuffs, and certain official emblems.

If the trade mark is refused for registration on these reasons, it will not be published.

A mark should not be registered as a CTM if a relative motive for refusal applies.

An opposition must be filed within three months of the date of publication of the CTM application by the proprietor of the earlier right.

The following constitutes an earlier right: an earlier trade mark application, an earlier national trade mark or a national trade mark application filed or registered in a Member State of the European Union, an international registration under the Madrid Agreement or the Madrid Protocol with effect in a Member State of the European Union, a trade mark which is well-known in a Member State (within the meaning of the Paris Convention).

The trade mark application will be refused on the basis of an earlier mark, if it is identical to the earlier trade mark and the goods or services for which registration is applied for are identical to the goods or services for which the earlier mark is protected, if because of its identity or similarity to the earlier trade mark and the identity of similarity to the goods or services covered by the trade marks, there exists a confusion on the part of the public. Also, can be refused if the trade mark is identical or similar to an earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier mark has a reputation and where use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

If a good motive for refusal exists in any part of the European Union, the trade mark may not be registered. For example, if there is an identical national trade mark for the same goods or services in just one of the Member States, the trade mark will not be registered.

## **The procedure for the registration of a community trade mark**

The registration procedure of a European trade mark consists of a three-step examination as follows:

1. Examination of the solicitor's application which must include: the registration date, examination of the formalities, of the absolute refusal motivations and of the established research reports.
2. Publication of the request.
3. The opposition procedure.

The first part of the procedure starts with the receipt of the application and involves:

- examination as to whether or not a filing date may be accorded, the classification check of the goods and services designated in the application;
- sending the list of goods and services to the Translation Centre for Bodies of the European Union;
- the establishment of the Community search report, the transmission of the application to central industrial property offices in Member States, for searches in their national registers and the transmission of all reports to the applicant or his representative;
- examination.

The OHIM will not examine relative grounds for refusal. These may be raised only by third parties in opposition proceedings or in cancellation proceedings after registration of the trade mark.

The second part of the procedure is the publication of the application in part A of the community trade mark Bulletin, where the result of the examination by the OHIM has been positive.

The third part of the procedure is reserved for third parties to invoke their earlier rights in opposition proceedings. Opposition may be lodged within three months following the publication of the trade mark application.

Appeal proceedings constitute a special procedural phase. An appeal must be filed within two months of the notification of the decision. A decision which does not terminate proceedings as regards one of the parties can be appealed only together with the final decision, unless separate appeal is allowed in that decision.

The Boards of Appeal are competent for taking decisions regarding appeals.

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