

***GUIDELINES FOR EXAMINATION IN THE  
OFFICE FOR HARMONIZATION IN THE  
INTERNAL MARKET (TRADE MARKS AND  
DESIGNS) ON COMMUNITY TRADE MARKS***

***PART B***

***EXAMINATION***

***SECTION 2***

***FORMALITIES***

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## 1 Introduction

Every Community trade mark (CTM) application must abide by certain formality rules. The purpose of these Guidelines is to lay down Office practice in relation to those formality rules.

## 2 Filing of Applications

### 2.1 Applicants

Article 5 CTMR

Any natural or legal person, including authorities established under public law, may apply for a CTM, irrespective of their nationality or domicile.

### 2.2 Where a Community trade mark application can be filed

Article 25(1) CTMR  
Rule 82 CTMIR  
Decision EX-05-3 and EX-11-3 of the President of the Office

The applicant may file the application for a CTM directly at OHIM, at the central industrial property office of a Member State or at the Benelux Office.

CTM applications may be sent to OHIM electronically (through e-filing), by fax, by regular mail or private delivery services, or handed in personally at the reception desk of the Office.

## 3 The Fees

Articles 2, 7 and 8 CTMFR  
Article 27 CTMR  
Rule 4 and Rule 9(5) CTMIR  
Decision EX-96-1, amended in 1996, 2003 and 2006; Decision EX-11-3 of the President of the Office

### 3.1 Fees in general

For the application of a CTM the following fees are applicable:

Trade Mark	Basic Fee up to 3 Classes	Additional Class Fee
E-filed	EUR 900	EUR 150
Paper filed	EUR 1 050	EUR 150
Collective	EUR 1 800	EUR 300

The fee must be paid in Euros. Payments made in other currencies are invalid and will entail a loss of rights. There is no reduction in the fee for filing a collective mark electronically.

For more information on fees, please refer to the Guidelines, Part A, General rules, Section 3, Payments of fees, costs and charges.

### **3.2 Basic fee deficiency**

If the basic fee is not paid within one month from the date the Office received the application, the provisional filing date will be lost (see below under paragraph 4, Filing Date).

However, the filing date can be maintained if the applicant provides evidence that the payment was made to a bank or a transfer order was placed in a Member State and within the one-month time limit and the applicant pays a surcharge of ten per cent.

However, the surcharge need not be paid if the applicant provides evidence that the payment was initiated more than ten days before expiry of the one-month time limit.

### **3.3 Class fee deficiency**

Where the application covers more than three classes of goods and/or services, an additional class fee is payable for each additional class.

- Where the fees paid or the amount covered by the current account is less than the total sum of fees due for the classes selected in the application form, a deficiency letter will be issued setting a two-month time limit for payment. If payment is not received within the time limit specified, the application will be deemed to be withdrawn for the classes not covered by the fee paid. In the absence of other criteria to determine which classes are intended to be covered by the amount paid, the Office will take the classes in the order of the classification (starting with the lowest); the application will be deemed to have been withdrawn with regard to those classes for which the class fees have not been paid (in full).
- Where additional class fees become payable following the rectification of a classification deficiency, a deficiency letter will be issued setting a two-month time limit for payment. If payment is not received within the time limit specified, the application will be deemed to have been withdrawn for those classes resulting from the re-classification not covered by the fees actually paid. In the absence of other criteria to determine which classes are intended to be covered by the amount paid, the Office will take the classes in the order of the classification (starting with the lowest); the application will be deemed to have been withdrawn with regard to those classes for which the class fees have not been paid (in full).

### **3.4 Fee refunds upon withdrawal**

The application fee and / or class fees will not be refunded when the applicant withdraws or limits its application. For more information on this see the Guidelines, Part A, General rules, Section 3, Payment of fees, costs and charges.

## **4 Filing Date**

Article 25(3), Articles 26 and 27 CTMR  
Rule 9(1) CTMIR

### **4.1 Filing date requirements**

When an application is received at the Office by any means other than e-filing, a provisional filing date is accorded and the Office immediately issues a receipt with this provisional filing date. After one month and payment of the fee, the filing date is accorded, provided the application fulfils the following requirements:

- the application is a request for the registration of a CTM;
- the application contains information to identify the applicant;
- the application contains a representation of the trade mark;
- the application contains a list of goods/services.

If any of the above requirements are not met, a deficiency letter will be sent out requesting the applicant to provide the missing item within a time limit of two months from notification of the deficiency letter. This time limit is not extendable. If the deficiency is not remedied, the CTM application will be 'deemed not filed' and all fees already paid will be reimbursed and the case closed. If the missing information is provided within the time limit set in the deficiency letter, the filing date will be changed to the date on which all mandatory information is complete, including the payment.

In some cases, applicants file more than one representation of the mark (in this context see below under paragraph 9.1.3, Three-dimensional marks and paragraph 10, Series marks). As the application does contain a representation of the mark, this is not to be considered a filing date deficiency. Rather, the applicant is required to indicate which of the representations filed should be used as the representation of the CTM application; this should be done via a deficiency letter, and the Office will set a two-month time limit for the applicant to specify the correct representation.

### **4.2 Applications filed electronically**

For electronically filed CTM applications, the system issues an immediate automatic filing receipt that appears on the screen of the computer from which the application was sent. This receipt will contain the provisional filing date and should be saved or printed by the applicant as the Office will routinely not send an additional receipt.

### **4.3 Applications filed through national offices (intellectual property office of a member state or Benelux Office)**

If a CTM application is filed at the central industrial property Office of a Member State or at the Benelux Office for Intellectual Property, it will have the same effect as if it had been filed at OHIM on that same day, provided that it is received at OHIM within two months from the date it was filed at the National Office.

If the CTM application does not reach OHIM within two months, it will be deemed to have been filed on the date that it is received by OHIM.

### **4.4 Applications received directly at OHIM**

If an applicant files a CTM application at OHIM, the filing date will be the reception date provided that the application is complete.

### **4.5 List of goods and services**

Article 26 and Article 43(2) CTMR

The presence of a list of goods and services is a filing date requirement. A reference in the respective field on the CTM application form to a previous CTM may be used to indicate the list of goods and services.

The scope of protection defined by the original list of goods and services cannot be extended. If an applicant wants to protect additional goods or services after filing, a new application must be filed. For further information on the classification of goods and services please refer to the Guidelines, Part B, Examination, Section 3, Classification.

## **5 Signature**

Rules 80(3) and 82(3) CTMIR

Application forms lodged by fax, post, private delivery service or personal delivery must be signed either on the form itself or on an accompanying letter. The signature may be that of the applicant or the representative. If an application communicated to the Office is not signed, the Office shall invite the party concerned to correct the irregularity within a two-month time limit. If the deficiency is not remedied within the time limit, the application will be rejected.

If an application is filed electronically, the indication of the name of the sender is deemed to be equivalent to a signature.

## **6 Languages / Translations**

Articles 119, 120 and Article 43(2) CTMR



Communication 4/04 of the President of the Office

A CTM application may be filed in any of the official languages of the European Union. A second language must be indicated on the application form, which must be one of the five languages of the Office, namely, English, French, German, Italian or Spanish.

A different language version of the application form from the language chosen as the first language may be used. However, the application form must be completed in that first language, including the list of goods and services, indication of colour(s), mark description and disclaimer, where appropriate.

## 6.1 First and second languages

All information on the application form must be in the first language, otherwise, a deficiency letter is sent. If the deficiency is not remedied within two months, the application will be rejected.

The second language serves as a potential language for opposition and cancellation proceedings. The second language must be different from the language selected as the first language. Under no circumstances can the choice of first and second language be changed once filed.

When filing the application, the applicant may provide a translation into the second language of the list of goods and services and where relevant any mark description, disclaimer and colour indication. Where such a translation is provided, the applicant is responsible for ensuring that the translation corresponds to the first language and the Office will not check this. It is very important for the applicant to ensure the accuracy of the translation as, in particular the translation provided by the applicant may be used as basis for translation of the application into all the remaining languages of the European Union (see paragraph 6.3 Reference language for translations below).

## 6.2 The correspondence language

The correspondence language is the language used in correspondence between the Office and the applicant in examination proceedings until registration of the mark. If the language that the applicant has selected as the first language is one of the five languages of the Office, then this will be used as the correspondence language.

Only where the language selected as the first language is not one of the five languages of the Office can the applicant indicate that it wants the correspondence language to be the second language. This request can be made on the application form by ticking the respective box or can be requested later on, either by explicit request, or implied by sending a communication to the Office in the second language. However, such a request will be refused where the Office has already issued a deficiency or objection letter in the first language.

In cases where the applicant selects one of the five languages of the Office as the first language but then indicates that the second language is to be the correspondence language, the Office will change the correspondence language to the first language and inform the applicant.

Example		
First language selected	Second language selected	Correspondence language selected
French	English	English
The correspondence language will be changed to French.		

For more information on languages, please refer to the Guidelines, Part A, General rules, Section 4, Language of proceedings.

### 6.3 Reference language for translations

The list of goods and services are translated into the official languages of the EU. The source language for translations is defined the reference language. If the first language of the application is one of the five languages of the Office, it will always be the reference language.

If the first language of the application is not one of the five languages of the Office and the applicant has provided a translation of the goods and services in the second language, the reference language will be the second language. If no translation is provided, the first language will be the reference language.

### 6.4 Translation of multilingual elements


Multilingual elements contain information on the application which needs, in principle, to be translated. These elements are mark descriptions, colour indications and disclaimers.

If a translation of goods and services is supplied in the second language, the Office will check that all relevant multilingual elements (mark description, colour indication, disclaimer, in more detail, see paragraph 6.4 below) have also been translated; However, the accuracy of the translation will not be checked by the Office. If the applicant has only provided a partial translation, a deficiency letter will be sent to the applicant, requesting that the additional translations are provided within two months from notification of the deficiency. If the applicant fails to provide the omitted translations, then all translations provided by the applicant will be disregarded and the Office will proceed as if no translation had been provided. Translations of simple colours will be added by the Office.

Before sending the application for translation, the Office will ensure that the information contained in the multilingual elements is correct and acceptable. The details can be seen below in the relevant paragraphs on colour indications, mark descriptions and disclaimers (paragraphs 11, 12 and 13 respectively). Furthermore, before requesting translation of an application, 'non-translatable elements' will be identified as such by putting them into inverted commas (""), as agreed as a formatting rule with the Translation Centre for the Bodies of the European Union (CdT).


The following elements are **not** to be translated and will be put into inverted commas:

1. mark descriptions: where the acceptable mark description refers to a verbal element of the mark, this element should not be translated:

Mark description	Mark
<p style="text-align: center;">CTM 10 003 317</p> <p>The word “Rishta” in a stylised script on a diamond shaped background with a shadow effect and the words “Premium Quality” in a smaller font on a rectangular block positioned above the word “Rishta” and below the upper point of the diamond shape.</p>	

(For information on the examination of mark descriptions see paragraph 12 below.)

2. colour indications: where the colour indication includes a reference to an international coding system (e.g. “Pantone”), this must be identified with inverted commas, as it should not be translated:

Colour indication	Mark
<p style="text-align: center;">CTM 10 171 452</p> <p>Blå (“Pantone 3115”), Grå (“Cool Grey 9”).</p>	

(For information on the examination of colour indications see paragraph 11 below.)

3. disclaimers: if a word element of the mark is disclaimed, this word element should be identified with inverted commas, as it must not be translated:

Disclaimer	Mark
<p style="text-align: center;">“socks”</p>	<p style="text-align: center;">DOODAH SOCKS</p>

(For information on the examination of disclaimers see paragraph 13 below.)

## 6.5 Restriction of goods and services

Rule 95(a) CTMIR

If the first language of the CTM application is one of the five languages of the Office, a restriction in examination proceedings can only be accepted in the first language of the application.

In cases where the first language of the application is not one of the five languages of the Office, a restriction in examination proceedings can only be accepted in the second language if the second language has been indicated as the correspondence language.

Example of acceptable restriction request	
1st language NL	2nd language EN
A restriction sent to the Office in English would be accepted provided that English has been indicated as the correspondence language of the application.	

Example of unacceptable restriction request	
1st language IT	2nd language EN
A restriction sent to the Office in English would not be accepted, as in this case Italian is one of the five languages of the Office and is therefore the only language in which a restriction will be accepted.	

## 7 Owner, Representative and Address for Correspondence

### 7.1 Applicant

Articles 3, 5 and 92 CTMR Rule 1(1)(b), Rules 26 and 76 CTMIR
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Any natural or legal person, including authorities established under public law (e.g. a university) may be the proprietor of a CTM. Filings in the name of a legal entity in the process of foundation will be accepted.

In a CTM application the applicant must state its name, address, nationality and the State in which it is domiciled or has its seat or establishment. The Office strongly recommends indicating the State of Incorporation for US companies, where applicable, in order to differentiate clearly between different owners in its database. Names of natural persons must be indicated by the person's family name and given name(s). The names of legal entities shall be given in full and only its legal forms may be abbreviated in a customary manner, e.g. PLC, S.A. If the legal form is not specified or is incorrectly indicated, a deficiency letter requesting this information will be issued. If the missing or the correct legal form is not given, the application will be rejected.

The address should contain, if possible, the street, street number, city/town or state/county, postal code and country. The applicant should indicate only one address, but if there are several the first one listed will be recorded as the address for service, unless the applicant specifically designates a different one.

If the applicant has been given an ID number by the Office in a previous case, it will be sufficient for it to indicate that number together with the name of the applicant.

For more information on communication with the Office, please refer to the Guidelines, Part A, General rules, Section 1, Means of communication, time limits.

## 7.2 Representative

If the applicant has its domicile, principal place of business or a real and effective industrial or commercial establishment in the EU, there is no obligation for it to be represented.

If the applicant does not have its domicile, principal place of business or a real and effective industrial or commercial establishment in the EU, regardless of its nationality, representation must be sought to act for it in all proceedings except the filing of the CTM application and the payment of the application fee. Every representative in the sense of Article 93 CTMR, who files an application with OHIM is placed on the Representative database and given an ID number. If the representative has been allocated an identification number by the OHIM, it is sufficient to indicate only that ID number and the name.

For more information on representation, please refer to the Guidelines, Part A, General rules, Section 5, Professional representation.

## 7.3 Change of name / address

The name and address of the applicant may be amended. A change in the name of the applicant is a change that does not affect the identity of the applicant, whereas a transfer is a change in the identity of the applicant.

## 7.4 Transfer of ownership

Article 17(5), Articles 24 and 87 CTMR Rule 31(8) and Rule 84(3)(g) CTMIR
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CTM registrations and applications may be transferred from the previous proprietor/applicant to a new proprietor/applicant, primarily by way of assignment or legal succession. The transfer may be limited to some of the goods and/or services for which the mark is registered or applied for (partial transfer). Upon request, transfers of registered CTMs are entered in the Register and transfers of CTM applications are noted in the files.

For more information on the recording of transfers of ownership see the Guidelines, Part E, Register Operations, Section 3, CTMs as Objects of Property, Chapter 1, Transfer.

## 8 Kind of Mark

The CTM regulation distinguishes between two kinds of marks: individual and collective.

## 8.1 Individual marks

Article 5 CTMR

Any natural or legal person, or person assimilated to these persons under the national law applicable to them, including authorities established under public law, may be the proprietor of a Community individual trade mark, irrespective of their nationality.

## 8.2 Collective marks

Article 66-68 CTMR  
Rules 3 and 43 CTMIR

### 8.2.1 Character of collective marks

A collective mark is a specific type of trade mark which indicates that the goods or services bearing that mark originate from members of an association, rather than just one trader. Collective does not mean that the mark belongs to several persons (co-applicants / co-owners) nor that it designates / covers more than one country.

Collective marks can be used to publicise products which are characteristic of a particular region, and may be used together with the individual mark of the producer of a given good. This allows members of an association to differentiate their own products from those of competitors.

For further information as to the substantive requirements of Community collective marks please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal and Community Collective Marks.

### 8.2.2 Applicants for collective marks

Associations of manufacturers, producers, suppliers of services, or traders which under the terms of the law governing them have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue or be sued, as well as legal persons governed by public law, may apply for a collective mark. There are essentially two criteria to be met. Firstly, the applicant must be an association or a public body and secondly it must exist as an entity in itself.

For further information as to the substantive requirements of Community collective marks please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal and Community Collective Marks.

### 8.2.3 Documents to be filed

In addition to the information to be filed when applying for an individual trade mark, applications for a Community collective trade mark require regulations governing use of the mark. These regulations shall specify:

1. the name of the applicant and its office address;
2. the object of the association or the object for which the legal person governed by public law is constituted;
3. the bodies authorised to represent the association or the said legal person;
4. the conditions for membership;
5. the persons authorised to use the mark;
6. where appropriate, the conditions governing use of the mark, including sanctions;
7. if the mark designates the geographical origin of goods or services, authorisation for any person whose goods or services originate in the geographical area concerned to become a member of the association.

### 8.2.4 Examination of formalities relating to collective marks

#### 8.2.4.1 Regulations governing use not submitted

If the regulations are not submitted with the application, a deficiency letter will be sent, setting a time limit of two months to provide them.

If the regulations are not submitted within this two-month time limit, the application will be rejected.

#### 8.2.4.2 Regulations governing the use submitted but with deficiencies

If the regulations have been submitted but fail to specify the required information as listed at paragraph 8.2.3 above, a deficiency letter will be sent, setting a time limit of two months to provide the missing information.

If the deficiency is not remedied within this two-month time limit, the application will be rejected.

### 8.2.5 Changes of the kind of mark (from collective to individual)

If a natural person has applied for a collective mark by mistake, i.e. they have erroneously entered / selected the kind of mark as 'collective' on the application form, they may change the mark from collective to individual, since collective marks cannot be granted to natural persons. The fee surplus will also be refunded.

Where a legal person claims to have applied for a collective mark by mistake, the amendment will also be allowed and the fee surplus refunded. However, the filing of a collective mark would not be seen as an obvious error, and the amendment request would be rejected, where there are indications that the applicant intended to apply for this kind of mark, for example:

- the mark representation includes the words 'collective mark';

- or the name of the applicant states that it is an association;
- or regulations of use of the collective mark are submitted.

## 9 Mark Type

Articles 4 and 26, Article 7(1)(a) CTMR Rule 3 CTMIR
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The categorisation of marks serves a number of functions. Firstly, it establishes the legal requirement for the mark to be represented; secondly, it can help the Office understand what the applicant is seeking to register; and finally, it facilitates research in the OHIM database.

A trade mark may consist of any sign capable of being represented graphically. It is a requirement of filing that there is a representation of the mark on the application form. The mark must be represented graphically and this representation cannot be replaced by a description of the mark. If the applicant fails to graphically represent its mark, a deficiency letter is sent and a filing date will not be recorded (see above under paragraph 4, Filing Date).

Where the application contains a representation of the mark without specifying the desired mark type, the Office will, based on the representation provided and any mark description, accord the appropriate mark type and inform the applicant in writing, setting a two-month time limit for observations.

Where the applicant has selected a mark type which does not correspond to the mark representation, together with any mark description provided, the mark type will be corrected following the indications set out below under paragraph 9.9, Correction of the mark type.

The examples of mark types in these Guidelines are given only in the context of formalities issues without prejudice to the outcome of the examination proceedings.

Verbal elements consist of letters in the alphabet of any official EU language and keyboard signs. Where a mark, other than a word mark, contains any such verbal element that is visible from the representation, it must be included in the respective field. This allows for the mark to be searched within the database and also forms the basis of the language check for marks that is carried out in all official languages of the EU.

### 9.1 Word marks

A word mark is a typewritten mark with elements including letters (either lowercase or uppercase), words (either in lowercase or uppercase letters), numerals, keyboard signs or punctuation marks written across a single line. The Office accepts the alphabet from any official EU language as a word mark. A mark consisting of text written across more than one line will not be categorised as a word mark, as these marks are considered to be figurative.






Examples of acceptable word marks	
CTM 6 892 351	europadruck24
CTM 6 892 806	TS 840
CTM 6 907 539	4 you
CTM 2 221 497	ESSENTIALFLOSS
CTM 0 631 457	DON'T DREAM IT, DRIVE IT
CTM 1 587 450	?WHAT IF!
CTM 8 355 521	ΕΙΔ ΕΛΛΗΝΙΚΟ ΙΝΣΤΙΤΟΥΤΟ ΔΙΑΤΡΟΦΗΣ (Greek)
CTM 8 296 832	Долината на тракийските царе (Cyrillic)

## 9.2 Figurative marks


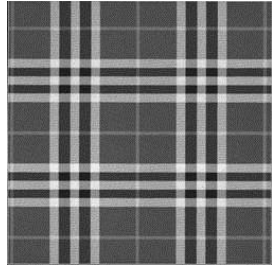
A figurative mark is a mark consisting of:

- exclusively figurative elements,
- a combination of verbal and figurative or otherwise graphical elements,
- verbal elements in non-standard fonts,
- verbal elements in colour,
- verbal elements on more than one line,
- letters from non-EU alphabets,
- signs that cannot be reproduced by a keyboard,
- combinations of the above.

Marks depicting a pattern are 'figurative' marks in accordance with Office practice.

Examples of figurative marks	
CTM 1 414 366 Purely graphic element with no colour	
CTM 9 685 256 Purely graphic element in colour	
CTM 4 705 414 Combination of graphic element and text in standard font, no colour	

Examples of figurative marks	
<p>CTM 9 687 336</p> <p>Combination of stylised font and figurative elements, no colour</p>	
<p>CTM 4 731 725</p> <p>Combination of stylised font and figurative elements in colour</p>	
<p>CTM 9 696 543</p> <p>Verbal element in stylised font with no colour</p>	
<p>CTM 2 992 105</p> <p>Verbal elements in stylised font with no colour</p>	
<p>CTM 9 679 358</p> <p>Verbal elements in different fonts in colour</p>	
<p>CTM 9 368 457</p> <p>Verbal elements only, over more than one line</p>	
<p>CTM 9 355 918</p> <p>Slogan in two different fonts, letters in different sizes, on more than one line, and in colour</p>	
<p>CTM 9 681 917</p> <p>Verbal element in non-EU alphabet (Chinese)</p>	

Examples of figurative marks	
CTM 0 015 602	
CTM 7 190 929	

### 9.3 Three-dimensional marks

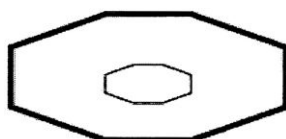
Article 43(2) CTMR  
 Rule 3(4) CTMIR  
 Communication 2/98 of the President of the Office

A three-dimensional mark is a mark consisting of a three-dimensional shape (including containers, packaging and the product itself). The photographic or graphic representation may consist of up to six perspectives of the same shape which must be submitted in one single JPEG file in the case of e-filed applications or on one single A4 sheet in the case of paper-filed applications. While up to six perspectives may be filed, a single view of the shape is sufficient where the shape to be protected can be ascertained from that single view.

In some cases, applicants file different perspectives of a three-dimensional object on several sheets of paper (e.g. one page per picture/perspective). In such a case, a deficiency should be raised, setting a two-month time limit for the applicant to indicate which of the representations filed should be used as the representation of the CTM application.

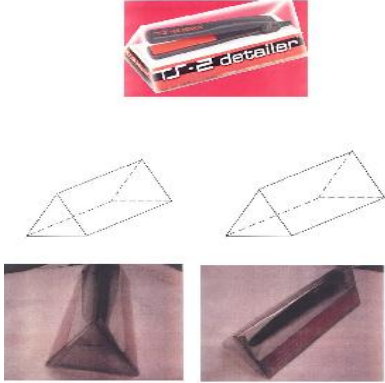
Applicants applying for registration of a three-dimensional mark must make a corresponding indication in the application. If no mark type is indicated and only one view of the object has been provided and the mark description – if any – does not say that the mark filed is three-dimensional, the Office will treat it as a figurative trade mark.



#### Example



No mark type was selected for this sign and no mark description was provided. The Office will treat this as a figurative mark.

<b>Examples of acceptable representations of three-dimensional marks</b>	
<p>CTM 4 883 096</p> <p>Four different drawings of the same object</p>	
<p>CTM 4 787 693</p> <p>Six photographs of the same object from different perspectives, with text</p>	
<p>CTM 30 957</p> <p>Two photographs in colour showing different perspectives of the same object</p>	
<p>CTM 8 532 475</p> <p>Six views in colour showing six different perspectives of the same object</p>	

<b>Examples of marks that are not acceptable as three-dimensional marks</b>	
<p>CTM 6 910 021</p> <p>Five views, but not showing the same object</p>	

Examples of marks that are not acceptable as three-dimensional marks	
<p>CTM 7 469 661</p> <p>No text in addition to the representation of the mark is allowed (text below the photo of the bottle)</p>	
<p>CTM 9 739 731</p> <p>The first and third bottles show two different perspectives of the same bottle, both with a grey lid. The second bottle has a blue lid, and is therefore a different object to those pictured in the first and third bottles. The fourth image is completely different, showing two bottle tops and a label. Of the four perspectives, only the first and third are views of the same object.</p>	

Where views of different objects on one A4 sheet or in one JPEG are filed for the application of a three-dimensional CTM, the deficiency cannot be remedied since the deletion of one or more of these different objects would mean a considerable alteration of the mark representation (see below under paragraph 18, Amendments to the CTM application). In this case, the application must be rejected as the representation does not show a single three-dimensional shape.

## 9.4 Sound marks

Article 4 CTMR; Decision EX-05-3 of the President of the Office

A sound mark must be represented graphically using the standard methods for reproducing sound graphically, in particular musical notation. A description of the sound in words is not sufficient (see decision of 27/09/2007, R 708/2006-4, 'TARZAN YELL'). The lyrics of a song combined with musical notations and the tempo is acceptable. A sonograph alone is not an acceptable graphical representation of a sound mark if it is not accompanied by an electronic file containing the sound. Where the sound applied for cannot be depicted in conventional musical notation, for example the roar of a lion, a sonograph together with a sound file is the only means of representing the mark.

### 9.4.1 Electronic sound file

The attachment of an MP3 sound file is optional where musical notation has been provided and this is only possible in e-filings. The Office will not accept the filing of an electronic sound file on its own, since a graphical representation is required. Where an application does not include a graphic representation of the mark, a filing date deficiency will be raised (for more information on filing dates, see paragraph 4 of these Guidelines).

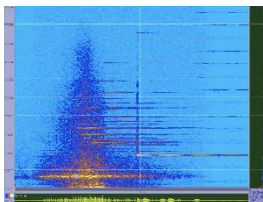


The sound file must be in MP3 format and its file size cannot exceed two megabytes. Office requirements do not allow the sound to stream or loop. Any other attachments or attachments that do not comply with these criteria shall be deemed not to have been filed.


### 9.4.2 Musical notations

The applicant may file musical notation alone. This will satisfy the requirement for graphically representing the mark. In these cases an electronic sound file may be attached, but this is not mandatory.

### 9.4.3 Sonographs

The applicant cannot file a sonograph alone (see decision of 27/09/2007, R 708/2006-4, 'TARZAN YELL'). In these cases an electronic sound file is mandatory, since the Office and third parties cannot deduce the sound from the sonograph alone. Any colours used in a sonograph are not part of the mark, as the applicant is applying for a sound mark. Therefore, no colour indication is to be recorded and where such indication is provided, it will be deleted by the Office.

Examples of acceptable sound marks	
CTM 8 116 337 Sonograph that was accompanied by a sound file	
CTM 9 199 134 Sonograph that was accompanied by a sound file	
CTM 1 637 859 Musical notation	

Examples of acceptable sound marks	
CTM 6 596 258  Musical notation including musical directions	





## 9.5 Colour per se

Colour *per se* means that trade mark protection is sought for one or several colours, regardless of any specific shape or configuration. What is protected is the shade of colour(s) and in the case of more than one colour, also protected is the ratio in which the colours are distributed. The representation of a colour per se mark must consist of a representation of the colour or colours without contour. Where there is more than one colour, the proportion of each colour must be specified in the mark description field. If this has not been done in the application, the Office will notify the deficiency, allowing two months for the information to be provided.


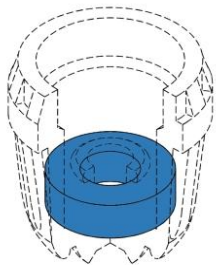
If the representation contains other matter, such as words or images it is not a colour per se mark but a figurative mark. For information on the Correction of the mark type, see paragraph 9.9 of these Guidelines.

When applying for a colour per se mark, the provision of a mere sample of the colour on its own is not sufficient; the colour or colours that are the subject of the mark must be described in words in the 'Indication of Colour(s)' field. Furthermore, internationally recognised colour codes are highly recommended to be provided in addition (see judgment of 06/05/2003, C-104/01, 'Libertel', paras 31-38). For more on indication of colour see paragraph 11 of these Guidelines.

An application for a colour per se mark may be represented by showing the colour or colours as they will be applied to something, an example of which can be seen below (see also judgment of 12/11/2013, T-245/12, 'Dégradé de verts', paras 38 to 39). In such cases, a mark description is required in order to clarify the nature of the mark.

Examples of acceptable colour per se marks	
CTM 962 076 <u>Colour indicated:</u> Brown	
CTM 31 336 <u>Colour indicated:</u> Lilac/violet  <u>Description:</u> Lilac/violet, single colour as shown in the representation. The values (specific coordinates in the colour space) for the present mark are: L => 53,58 /- 08; A => 15,78 /- 05; B => 31,04 /- 05. The mark can be located in Pantone's Process Book between the shades with number E 176-4 and E 176-3.	
CTM 8 298 499 <u>Colours indicated:</u> Green, Pantone 368 C, anthracite, Pantone 425 C, orange, Pantone 021 C  <u>Description:</u> The trade mark consists of the colours green: Pantone 368 C; anthracite: Pantone 425 C; orange: Pantone 021 C, as shown in the illustration; the colours are applied to a basic component of the exterior of vehicle service stations (petrol stations) in the ratio green 60%, anthracite 30% and orange 10%, creating the impression of a green and anthracite-coloured petrol station (green predominating) with small orange accents.	
CTM 4 381 471 <u>Colours indicated:</u> Blue (Pantone 2747 C) and silver (Pantone 877 C)  <u>Description:</u> Protection is claimed for the colours blue (Pantone 2747 C) and silver (Pantone 877 C) juxtaposed as shown in the representation of the colour mark applied for. The ratio of the colours is approximately 50%-50%.	



Examples of acceptable colour per se marks	
<p>CTM 2 346 542</p> <p>Colours indicated:</p> <p>RAL 9018</p> <p>NCS S 5040G50Y + RAL 9018 1: 4</p> <p>NCS S 5040G50Y + RAL 9018 2: 3</p> <p>NCS S 5040G50Y + RAL 9018 3: 2</p> <p>NCS S 504050Y + RAL 9018 4: 1</p> <p>NCS S 5040G50Y.</p>	
<p>CTMA 9 869 256</p> <p><u>Colours indicated:</u> Blue RGB 46-122-184</p> <p><u>Description</u> The Mark consists of the colour blue, defined as RGB: 46-122-184, as applied to a seal in a pneumatic valve cap as depicted in the illustrative representation attached to the application.</p>	

## 9.6 Holograms

Holograms are particularly difficult to graphically represent as a paper representation does not allow the image to 'change' as it would naturally on holographic paper. However, with a clear mark description and enough views of the mark, a hologram can be graphically represented. Therefore, where a hologram is applied for more than one mark representation can be filed provided all different views are on one single A4 sheet in the case of paper filings or in one single JPEG file in the case of e-filing.

## 9.7 Smell / Olfactory marks

Smell or olfactory marks are not currently acceptable. This is because a graphical representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (see judgment of 12/12/2002, C-273/00, 'Sieckmann'). As in the case of all the other types of marks, a mark description cannot replace the graphical representation. Although it may be graphic, a description of a smell is neither clear, precise nor objective and therefore no filing date can be attributed because the mark cannot be graphically represented. Such cases (see also decision of 04/08/2003, R 120/2001-2 'The taste of artificial strawberry flavour') will not be rejected but rather deemed not filed.

## 9.8 Other marks



Other marks must contain an indication in the mark description of what is meant by 'other'. 'Other' marks can be, for example, animated marks (movement marks), position marks or tracer marks (coloured stripes or threads applied to certain products).

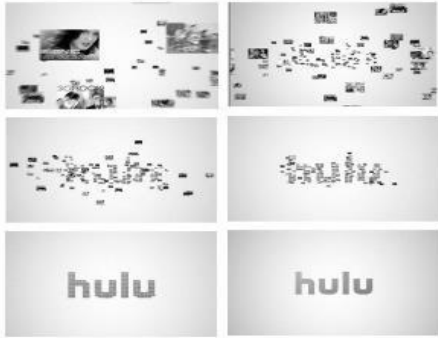
### 9.8.1 Animated marks (movement)

The number of mark representations is practically unlimited as long as they are all on one single A4 sheet in the case of paper filings or in one single JPEG document in the case of e-filing. The mark representation must be accompanied by a mark description explaining the animation.

The representations together with the mark description must clearly explain the movement that is to be protected. Where the movement cannot be perceived (e.g. the representations are out of sequence), or the mark description does not match the sequence of representations, the Office will issue a deficiency allowing two months for the representations and / or description to be clarified. If the deficiency is not remedied within the time limit, the application will be rejected.

Where the representations include colour, the colour(s) used must be indicated in words.

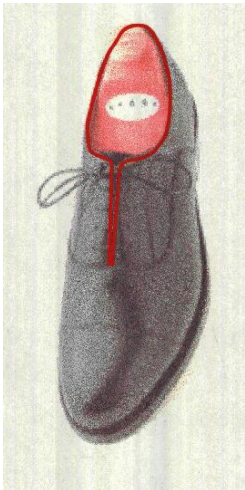
<b>Examples of acceptable animated marks (movement)</b>	
<p style="text-align: center;">CTM 5 338 629</p> <p><u>Description:</u> The mark is an animated sequence with two flared segments that join in the upper right portion of the mark. During the animation sequence, a geometric object moves up adjacent to the first segment and then down adjacent to the second segment, while individual chords within each segment turn from dark to light. Stippling down in the mark is for shading only. The entire animated sequence has a duration of between one and two seconds.</p>	 <p><u>Representations:</u> Mark representation in black and white and shades of grey only; no colour indication.</p>
<p style="text-align: center;">CTM 9 742 974</p> <p><u>Description:</u> The mark comprises a moving image consisting of a toothbrush moving towards a tomato, pressing onto the tomato without breaking the skin, and moving away from the tomato.</p>	 <p><u>Representations</u></p>


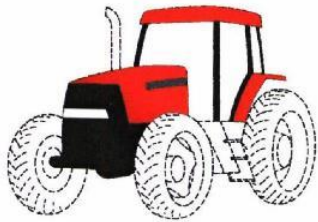
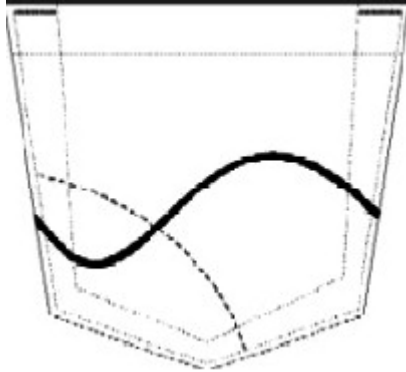
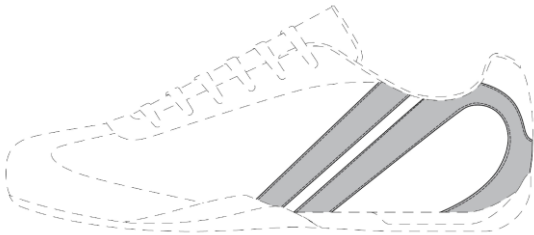
Example of an unacceptable animated mark (movement)	
<p style="text-align: center;">CTM 7 227 218</p> <p><u>Description:</u> The mark consists of a moving image mark, consisting of an animated sequence showing a series of rectangular video screens of varying sizes, with or without discernible images contained therein, that fly inward in whirlwind fashion, as if from the viewer's location, toward the center of the viewer's screen, where they coalesce to form a word.</p>	 <p style="text-align: center;">Mark where the movement cannot be grasped from the images and the description does not change this.</p>

### 9.8.2 Position marks

A position mark is a sign positioned on a particular part of a product in a constant size or particular proportion to the product. The sign must be represented graphically. As the applicant is aiming to protect the placement or 'position' of the mark, a mark description detailing its positioning is a formality requirement. The mark description must also contain an indication that it is a 'position mark' and, where a representation in colour is filed, the colour(s) used must be indicated in words.

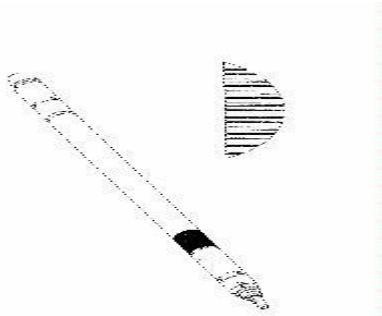

Insofar as a position mark covers some goods for which the positioning is clear and other goods for which the positioning would not be clear, a formality deficiency must be notified in respect of those goods on which the mark could not (clearly) be positioned in the way specified in the mark description. The applicant is given two-months to amend the application. If the application is not limited to such goods for which the positioning is clear, the application must be rejected for those goods and/or services for which the positioning is doubtful / impossible.

Examples of acceptable position marks	
<p style="text-align: center;">CTM 4 717 914</p> <p><u>Colour indication:</u> Red</p> <p><u>Description:</u> Red edging 2mm in width, running along the edge of the ankle opening and the lace-up section.</p>	

Examples of acceptable position marks	
<p style="text-align: center;">CTM 3 799 574</p> <p><u>Colour indication:</u> Green (Pantone 347 C)</p> <p><u>Description:</u> Green ring positioned between the lamp base's electric connectors.</p>	
<p style="text-align: center;">CTM 9 045 907</p> <p><u>Colours indicated:</u> Red, black and grey</p> <p><u>Description:</u> The mark consists of the combination of the colours red, black and grey as applied to the exterior surfaces of a tractor, namely red as applied to the bonnet, roof and wheel arches, light and dark grey as applied to the bonnet in a horizontal stripe and black as applied to the front bonnet grill, chassis and vertical trim – as depicted in the illustrative representation attached to the application.</p>	
<p style="text-align: center;">CTM 6 900 898</p> <p><u>Description:</u> Two Curves Crossed in One Point Design inserted in a Pocket; the mark consists of a decorative stitching made of Two Curves Crossed in One Point Design inserted in a Pocket; one of the curves is characterized by an arched form, drawn with a fine stroke, while the second one is characterized by a sinusoidal form, drawn with a thick stroke; the unevenly broken lines represent the perimeter of the pocket to which the applicant makes no claim and which serves only to indicate the position of the mark on the pocket.</p>	
<p style="text-align: center;">CTM 8 586 489</p> <p><u>Description:</u> The trademark is a position mark. The mark consists of two parallel lines positioned on the outside surface of the upper part of a shoe. The first line runs from the middle of the sole edge of a shoe and slopes backwards towards the instep of a shoe. The second line runs parallel with the first line and continues in a curve backwards along the counter of a shoe to the heel of a shoe and ends at the sole edge of a shoe. The dotted line marks the position of the trademark and does not form part of the mark.</p>	


Position marks are not acceptable if the description shows that the position may vary – e.g.: ‘The mark consists of [description of the device] applied to the outside of the

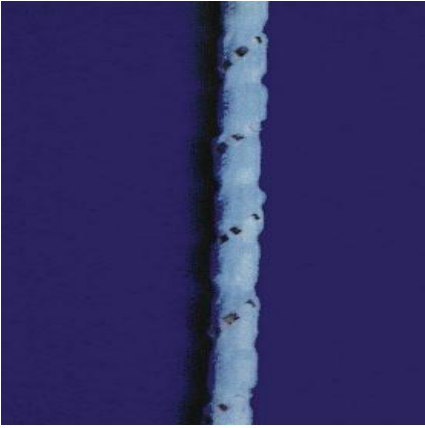
goods'. The position of the mark must be clearly defined and evident from the representation and description.

<b>Examples of unacceptable position marks / descriptions</b>	
<p>CTM 8 682 213</p> <p><u>Description:</u> Trademark protection is claimed for a stripe positioned on the casing of a soil displacement hammer (so-called displacement mole), the stripe being shown in the isometric overall view of the soil displacement hammer as a black, circular band, which is set off from the other parts of the casing by means of the pattern visible in the additional view, which shows an enlarged (semi-circular) detail of this stripe in a side view of the soil displacement hammer, the pattern being formed by a multitude of circular grooves; the stripe is positioned on a section of the casing, which, viewed from the cone point of the soil displacement hammer, equals the second quarter of the total length of the soil displacement hammer; other forms visible in the representation and/or arrangements are not part of the mark.</p>	<p>Depiction together with description do not clearly define what the sign is and how it is to be placed on the goods:</p>  <p>(It is unclear from the representation from which perspective a semi-circular detail should be visible.)</p>
<p>CTM 8 316 184</p> <p><u>Description:</u> The trade mark is a positional trade mark whereby a narrow copper ring made of copper is positioned and visible between two metal layers at the upper rim of the body of a pot or pan.</p>	<p>Sign which is defined in relation to specific goods – the sign is objectionable for other goods, if the positioning on those other goods is unclear.</p>  <p>(Sign objectionable for 'cooking utensils', as their shape can vary and the positioning would be unclear for anything but a pot or pan)</p>

### 9.8.3 Tracer marks

Tracer marks are coloured lines or threads applied to certain products. These marks are popular in the textile industry. Other examples are coloured lines on hoses or cables. The mark description should indicate that the mark is a 'tracer mark' and any colours, must be indicated in words.

<b>Examples of acceptable tracer marks</b>	
<p>CTM 7 332 315</p> <p><u>Description:</u> The trade mark consists of a pipe, tube or extruded profile with continuous thin black horizontal lines set at an equal distance apart on the exterior of the pipe, tube or extruded profile, between two parallel red lines running along the length of the pipe, tube or extruded profile.</p>	

Examples of acceptable tracer marks	
<p style="text-align: center;">CTM 3 001 203</p> <p><u>Colours indicated:</u> Gold on a light background</p> <p><u>Description:</u> Golden band incorporated into a light-coloured functional band, in particular a lead band, for curtains, drapes, table covers and similar goods as an identifying marking.</p>	

## 9.9 Correction of the mark type

### 9.9.1 General rules

Where the indication of the mark type in the application is clearly wrong or where there is an obvious contradiction between the mark type selected and the representation, including any mark description, the Office will correct the mark type and inform the applicant, giving a two-month time limit for observations. If there is no response, the correction made by the Office is considered accepted by the applicant. If the applicant disagrees with the amendment, the Office will restore the original indication of type of mark, however, the application may then be rejected as the nature of the mark is not clear.

### 9.9.2 Examples of recurring mark type deficiencies

#### 9.9.2.1 Word marks

Where the mark type chosen is 'word', but the mark is actually a 'figurative' mark such as in the examples in paragraph 9.2 above (representation in several lines, stylised fonts etc.), the Office will correct the mark type and update the figurative image in the system. The Office will send a letter to the applicant informing them of the amendment and setting a two-month time limit for observations. If the applicant does not reply within the time limit, the amendment will be deemed to have been accepted. If the applicant files observations objecting to the amendment, and the Office disagrees with the observations, the mark type will be changed back to 'word' mark, but the application will be rejected.



## 9.9.2.2 Figurative marks

If no mark type has been indicated at all and the mark is clearly figurative corresponding to the examples given above, the type of mark is introduced by the Office and an explanatory letter sent.

Sometimes 'figurative' marks in colour are erroneously filed as 'colour marks'. Furthermore, the differences in typology of the miscellaneous marks within the EU Member States may lead to a mark type deficiency, in particular with regard to marks combining a word and a figurative element which are often incorrectly filed as 'other' rather than as 'figurative' marks. In such cases, the Office will correct the mark type to 'figurative' and inform the applicant, setting a two-month time limit for observations.



Example 1

A *figurative* mark applied for as a *colour per se* mark.

The Office will change the mark type from *colour per se* to *figurative* and send a letter confirming the amendment. If the applicant disagrees, they may submit observations. If the Office disagrees with the observations, it will restore the original indication of the mark type, but the application will then be rejected. If however there is no response within the time limit, the change of mark type will be considered as accepted and the application will proceed.

Example 2

The following marks applied for as mark type 'other':

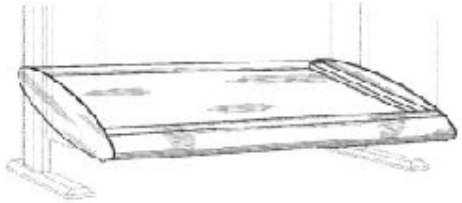
CTM 9 328 121	
CTM 9 323 346	

When the applicant has chosen as the type of mark 'other', instead of ticking 'figurative', and has added in the explanatory field of the 'other mark' terms like 'text and logo', 'marque sémi-figurative', 'marca mixta', 'Wort-Bild-Marke', or even 'colour per se' (because its mark contains elements in colour), but the mark applied for is clearly a figurative trade mark as defined above, the Office will change the mark type from *other* to *figurative* and send a letter to the applicant informing them of the amendment and giving two months for observations to be filed. If the applicant does not reply within the two-month time limit, the change of mark type will be deemed to have been accepted and the application will proceed. If the applicant files observations

objecting to the amendment, and the Office disagrees with the observations, the Office will restore the original indication of the mark type, but the application will then be rejected.

### Example 3

In some cases, marks may be filed as, for example, 'figurative', but the representation and/or mark description show that a three-dimensional mark is intended.

<p>CTM application 10 318 897</p> <p><u>Mark type chosen:</u> Figurative</p> <p><u>Description:</u> The mark consists of a shape for a shelf for the goods. The ends of the shelf have an elliptical shape. The front edge of the shelf has a tapered shape. The portion of the mark shown in dotted lines is not part of the mark and serves only to show positioning or placement of the mark</p>	
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In this case the mark description which refers to 'a shape for a shelf' is contradictory to the mark type 'figurative'. Therefore, the applicant was requested to amend the mark type to 'three-dimensional' or to delete the mark description.

## 10 Series Marks

In all applications for no matter which kind or type of mark, protection can only be sought for one single trade mark. Unlike some national systems, the CTM Regulations do not allow for series marks. When different versions of a trade mark are required, a separate CTM application is required for each of those versions.

### Example 1

A *word* mark filed as 'BRIGITTE brigitte Brigitte' will **not** be 'interpreted' as 'the word "Brigitte", written either in uppercase letters or in lowercase letters or in 'normal' script'; it will be seen as the word mark containing the female name 'Brigitte' three times.

### Example 2

A *word* mark filed as 'Linea Directa / Direct Line / Ligne Directe' will **not** be 'interpreted' as 'the term "direct line", either in Spanish or in English or in French'; it will be seen as a word mark containing all three language versions in the same sequence as applied for. No deficiency letter will be sent and no changes to the mark will be accepted.

### 10.1 Multiple figurative representations

In an application submitted through e-filing the reproduction of the mark must be uploaded as a single JPEG file. When the paper application form is used, the mark reproduction must be attached on a single A4 sheet.



The A4 sheet or JPEG file shall only contain the one representation of the mark as applied for and no additional text whatsoever.

When a paper-filed application contains more than one A4 sheet showing different marks, albeit very similar ones, the Office issues a deficiency letter requesting the applicant to choose one mark from among the different variations. If the applicant wants to protect the others as well, it will have to file a new application for each of the other marks it wishes to register. When there is no response to the deficiency letter within the time limit set therein, the application will be rejected.

Where an application, filed electronically or on paper, contains a JPEG file or an A4 sheet showing what might be seen as more than one mark representation, the combination as a whole of all those variations, as they appear on that one page, will be deemed as the mark for which protection is sought. Changes to the mark representation are not allowed.



Since the JPEG document attached to the above application contained all of the above images on a single page, the entirety of variations of logos and colours and texts is deemed one single trade mark.

## 11 Indication of Colour

Rule 3(5) and Rule 80 CTMIR

Word marks and sound marks cannot be in colour, since it is the word(s) and the sound(s) that are protected even if a sonograph is represented in colour.

Figurative, three-dimensional, holograms and other marks can be applied for in colour or without colour.

When a mark is to be registered in colour, a coloured mark representation must be filed with the application and the colours used indicated in words. An international colour code such as a *Pantone* number can be added to the colour indication, although it cannot replace the indication in words (e.g. green, blue, red).

Where a coloured representation is supplied, the Office considers that the applicant implicitly claims colour and the application is therefore considered to be for registration of a mark in colour. It is not possible to change the application to a black and white mark (see decision of 25/08/2010, R 1270/2010-4, 'Form von Prüfköpfen (3D MARKE)'). The only option for the applicant is to file a new application with a black and white representation.

If in an application for a mark in colour the colours grey, black and white are used other than for contrasting or delimiting, these must also be claimed.

Expressions like 'multicolour', 'of various colours', 'in any possible combination' or 'in any proportion' are not acceptable (see decision of 25/08/2010, R 1270/2010-4, 'Form von Prüfköpfen (3D MARKE)').

Where the indication of colour(s) has been omitted, the Office shall propose the colour(s) to the applicant, setting a two month time limit for response. If no reply is received before expiry of the time limit, the insertion of the colour(s) indicated by the Office will be deemed to have been accepted. If the applicant disagrees with the insertion of the colours, the Office will delete the indication. However, in such cases if the applicant fails to indicate acceptable colours, the application will be rejected.

If it is not possible to establish the colour(s), the Office will request that the applicant provide the colours. If the applicant fails to submit an acceptable colour indication within the time limit of two months, the application will be rejected (Rules 9(4) and 3(5) CTMIR).

If the application contains a colour claim but no mark representation in colour has been received, there is a formal discrepancy between the black and white trade mark applied for and the colour(s) claimed. Any colour indication will be corrected by the Office (i.e. to black, white and/or grey) and the applicant will be informed.

The **only exception to this rule** is when the application is filed by fax, in which case the applicant can (on its own motion) send a representation in colour by post within one month of sending the application. This one-month time limit cannot be extended. When the representation in colour is received within this time limit, the original representation in black and white will be substituted by the new representation in colour. If the applicant does not send the representation of the mark in colour, the Office will not request it. If a colour representation is not submitted within the one-month time limit, any colour indication will be corrected to black, white and/or grey as appropriate and the applicant will be informed. The colour claim should not be deleted as the applicant has provided a colour claim, which has been corrected by the Office.

Black, grey and white are considered 'colours'. The indication of the colours made by the applicant ('black and white' or 'black, grey and white' etc.) is subject to the same rules as with any other colour indications described above.

When the mark representation is filed by other means than fax and in black and white – including grey – it cannot be altered into a mark in colour even if the black and white mark was filed along with a colour claim, a colour indication and /or a description referring to colours.

It is to be noted that indications like 'transparent' or 'without colour', 'colourless' are not indications of colours and shall not be used. When a mark representation shows, for

example, a 'colourless' object made of glass or a similar material before a coloured background, the mark description is the appropriate place to explain that the object in question is colourless and shown in front of a coloured background which is not part of the mark. A transparent object can still be in colour like a standard wine bottle which is often green and usually transparent. Where the applicant considers 'transparent' an important feature of its mark, it shall add a mark description to this end.

Examples of colour indications	
<p style="text-align: center;">CTM 10 275 519</p> <p><u>No colour indication</u></p> <p>No colour indication required. However, black and white may be claimed by the applicant if these colours are to be considered a feature of the mark.</p>	
<p style="text-align: center;">CTM 8 401 572</p> <p><u>Colour indication:</u> Cream, blue, orange, brown, red, pink, yellow, <b>black</b>, green, maroon</p> <p>Black must be indicated as the application is for a mark in colour and black is not only used for contrasting and delimiting, i.e. black is also used for the tail, eye, nose and ears.</p>	
<p style="text-align: center;">CTM 10 456 762</p> <p><u>No colour indication</u></p> <p>No colour indication required. However, black, white and grey may be claimed if these colours are to be considered a feature of the mark.</p>	
<p style="text-align: center;">CTM 9 732 793</p> <p><u>Colour indication:</u> Red, orange, yellow, mint green, sea green, blue, purple, pink</p> <p>Black should be claimed in this application as this is a mark in colour and black is used other than for contrasting and delimiting, i.e. for the letters.</p>	
<p style="text-align: center;">CTM 10 336 493</p> <p><u>Colour indication:</u> Morado, azul, amarillo, blanco, naranja, rojo y negro</p> <p>Black is claimed, however, the Office would accept the colour indication without black as it is used only for delimiting – around the words 'POP-UP!'</p>	

In cases where the colour indication includes information that is not relevant to this field, but is relevant to another field of the application, the Office will move the text to the relevant field and inform the applicant. Examples of this are where the colour indication includes a mark description, disclaimer or list of goods and services.

## 12 Mark Descriptions

### Rule 3(3) CTMIR

A mark description is mandatory for CTM applications that have the mark type 'other'. This is because an explanation of what is meant by 'other' is required to clarify the scope of protection (define the nature of what is to be protected). If the description is missing or is unclear, a deficiency will be raised. If it is not remedied, the mark will be rejected.

Likewise, where colour *per se* combinations are applied for, the specification of the ratio of the colours must be provided.

Word marks cannot have a mark description; if a description is included, it will be removed by the Office and the applicant will be informed. No time limit for observations will be set, as a mark description is not foreseen for word marks.

For the remaining mark types, a mark description is not mandatory, but it may be useful in assisting the Office to determine the nature of the mark or clarify the representation. If the description does not match the representation of the mark, the applicant will be asked to delete or amend it. The representation cannot be changed to match the mark description.

Where the CTM application is intended to be used as the basis for an international application, the applicant should consider including a mark description in its CTM application as a description is a formality requirement in some countries. For more details, see the Guidelines, Part M, International marks.

A mark description can only define what can be seen in the mark representation or heard in a sound mark. It must not contain an interpretation of what is meant by a certain combination of letters or graphic elements or what the designer had in mind or an indication that the mark will only be used in certain Member States etc. Nor is it possible to state in a mark description that the mark can contain, for example, the colours blue and green or red and yellow; the description should state either blue/green or red/yellow – namely what can be seen in the coloured mark representation.

The representation of the mark together with a description, if any, must be sufficient for the Office to see and understand what is being sought to be registered.

Where a mark consists of or includes letters from a non-EU alphabet and the applicant provides a transliteration or translation together with a transliteration of the term in the mark description, this is acceptable.

When a mark description is deleted, the applicant will be informed. In no case can the mark representation be changed to match the mark description.

Where the mark description does not match the representation of the mark, the Office will raise a deficiency and the applicant will have two months to remedy. If the deficiency is not remedied:

1. the office will reject the CTM application for 'colour *per se* combinations' and 'other' marks which require a mark description to explain the scope of protection;

2. in all other cases, as the description is not mandatory, the Office will delete it.



Where the mark description includes information that is not a relevant description and the information is not relevant to any other field on the application form (e.g. the text interprets the meaning/symbolism of the mark or indicates in which Member States the mark will be used), the Office will delete the mark description and inform the applicant, without setting a time limit for observations.

Where the mark description includes information that is not a relevant description and the information is relevant to another field the Office will move the text to the relevant field and inform the applicant without setting a time limit for observations.


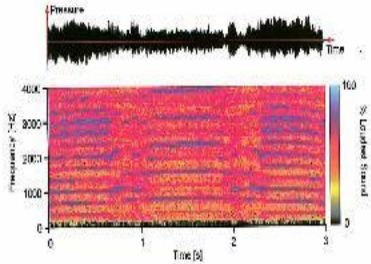


Examples of this are where colours are mentioned in the mark description field, they are valid as colour indication and will be keyed-in in the relevant field for the indication of colours.. Where goods and services are mentioned in the mark description field rather than in the field for goods and services, the Office will delete them from the mark description and if the goods and services are not already covered in the specification, the Office will inform the applicant that it may add the goods and services.

This principle applies *mutatis mutandis* in all cases where necessary information on the mark is included in the wrong field of the application.

A mark description can be amended or added after the filing of the mark in order to more clearly describe the content of the mark, e.g. the movement depicted. However, such an amendment must not alter the nature of the mark substantially. An amendment of the description is not possible after registration.

Examples of accepted mark descriptions	
<p>CTM 1 915 248</p> <p><u>Mark type:</u> Figurative</p> <p><u>Description:</u> Trade mark consisting of the word 'ALBALUNA' written in special lettering, in which the letter 'L' is superimposed on the outline of a quarter moon.</p>	
<p>CTM 2 023 950</p> <p><u>Mark type:</u> Figurative</p> <p><u>Description:</u> The trade mark consists of the word 'AIA' in red, stylised uppercase lettering, with the letter I surmounted by a red circle, inserted in a white oval delimited by a green rectangular frame, the whole outlined by a gold border.</p>	

Examples of accepted mark descriptions	
<p style="text-align: center;">CTM 8 837 502</p> <p><u>Mark type:</u> Other (Position)</p> <p><u>Description:</u> The position mark consists of a logo comprising a rectangle with rounded corners with an encircling light-coloured border and the two light-coloured letters PP arranged next to one another on a dark background. The logo is displayed on a screen during the broadcasting of a television programme or other programme in the upper right-hand corner of the screen.</p>	
<p style="text-align: center;">CTM 6 453 104</p> <p><u>Mark type:</u> Three-dimensional</p> <p><u>Description:</u> Three-dimensional trade mark consisting of a bottle shape which is wider in the centre than at the base. This bottle has a distinctive spiral decoration made up of a golden dotted line, interrupted by golden butterflies; at the end of the line, at the front, there are two butterfly figures, one large and one small, in red with a black and gold double outline. Below these two figures is the word 'BELLAGIO' in uppercase white letters with a red outline; below this are the words 'The Beautiful Life' in gold. The bottle is closed with a burgundy red cap on which there are several aligned golden butterflies.</p>	
<p style="text-align: center;">CTM 1 027 747</p> <p><u>Mark type:</u> Other (position)</p> <p><u>Description:</u> Red stripe placed longitudinally along an item of footwear partly covering the rear area of the sole and partly the rear area of the item of footwear. Any moulding seen on the sole or on the rear part of the item of footwear and/or production characteristics are not part of the trade mark.</p>	
<p style="text-align: center;">CTM 7 332 315</p> <p><u>Mark type:</u> Other (tracer mark)</p> <p><u>Description:</u> The trade mark consists of a pipe, tube or extruded profile with continuous thin black horizontal lines set at an equal distance apart on the exterior of the pipe, tube or extruded profile, between two parallel red lines running along the length of the pipe, tube or extruded profile.</p>	

Examples of accepted mark descriptions	
<p style="text-align: center;">CTM 2 818 334</p> <p><u>Mark type:</u> Other (movement)</p> <p><u>Description:</u> Two hands form a 'T', in which, from the position of the viewer, the right hand, stretched out flat with fingertips pointing upwards (so that only the narrow edge of the hand is visible) moves from the upper left of the image to the centre, while the left hand, also stretched out flat with fingertips pointing upwards and viewed from the side, moves from the upper right of the image to the centre; both hands then meet in the centre of the image with the upwards-pointing fingertips of the right hand touching the surface of the left hand roughly in the centre; the viewer therefore sees a side view of the descending left hand coming to rest on the fingertips of the ascending right hand; as a result of this movement, the viewer is able at this point to recognise the letter 'T'.</p>	
<p style="text-align: center;">CTM 5 090 055</p> <p><u>Mark type:</u> Sound</p> <p><u>Description:</u> The marks consists of the yell of the fictional character TARZAN, the yell consisting of five distinct phases, namely sustain, followed by ululation, followed by sustain, but at a higher frequency, followed by ululation, followed by sustain at the starting frequency, and being represented by the representations set out below, the upper representation being a plot, over the time of the yell, of the normalised envelope of the air pressure waveform and the lower representation being a normalised spectrogram of the yell consisting of a three dimensional depiction of the frequency content (colours as shown) versus the frequency (vertical axis) over the time of the yell (horizontal axis) the mark also being reproduced in the attached electronic file containing the sound.</p>	
<p><u>Mark type:</u> Figurative</p> <p><u>Description:</u> The mark consists of three blue shapes and three red shapes, facing in opposite directions.</p>	
Example of a mark description which would not be accepted	
<p><u>Mark type:</u> Figurative</p> <p>Mark Description: The mark consists of two hands grasping the air.</p>	

## 13 Disclaimer

Article 37 CTMR  
Rule 1(3) CTMIR

A disclaimer is a statement by the applicant that they disclaim any exclusive right to an element of the trade mark representation which is not distinctive.

An applicant cannot disclaim use of its trade mark on a particular good or service in its specification. If the applicant wishes to reduce the scope of the goods and services that the CTM application has protection for, it will need to request a restriction to the list of the goods and services.

Typically, elements which designate the kind, quality, quantity, value or geographical origin of goods or services need not be disclaimed. Similarly, ordinary words which would be common to many marks (the, of, etc.) or other non-distinctive matter (borders, commonplace shapes of containers, etc.) do not need to be disclaimed. Where a trade mark consists of a combination of elements each of which in itself is clearly not distinctive, there is no need for a disclaimer of the separate elements. For example, if a periodical had as its trade mark 'Alicante Local and International News', the individual elements within it would not need to be disclaimed.

This is not a mandatory field on the application form. The Office inserts the wording requested as a disclaimer whereas no additional requested information will be added in this field.

Example of an acceptable disclaimer		
Mark	Goods	Disclaimer
DOODAH SOCKS	Class 25	'socks'

Examples of unacceptable disclaimers		
Mark	Goods and services	Disclaimer
DOODAH SOCKS	Classes 1 to 45	The mark will not be used in Germany
DOODAH SOCKS	Socks in Class 25.	The applicant disclaims any use of the mark for men's socks
This is not a disclaimer, but a limitation of the goods, and the text will be deleted.		
Gelamondo	Goods in Class 30: Ice cream; ice-cream products; ice cream drinks; ice-cream cakes; ice cream mixes; instant ice cream mixes; ice; binding agents for ice.	Disclaimer Softeis (Soft ice-cream)
This is not a disclaimer and the text will be deleted.		



Disclaimers may be added to the trade mark application at a later stage, if appropriate (e.g. if the application is being opposed and the parties agree on a disclaimer to reach a friendly settlement).

More on disclaimers can be found in the Guidelines, Part C, Opposition, Section 2, Identity and Likelihood of Confusion, Chapter 4, Distinctiveness.

If the disclaimer is objectionable on formality grounds, a deficiency letter will be sent to the applicant to remedy the deficiency. If the deficiency is not remedied, the disclaimer will be deleted.

## 14 (Convention) Priority

Articles 29 and 31 CTMR  
Rules 6 and 9 CTMIR  
Decision EX-03-5 and Decision EX-05-05 of the President of the Office

The right of priority shall have the effect that the date of priority shall count as the date of filing of the Community trade mark application for the purposes of establishing which rights take precedence.

The principles of priority were first laid down in the Paris Convention for the Protection of Industrial Property of March 20, 1883, several times revised and last amended in 1979 and ratified by many Contracting States. Article 4 of this Convention – with regard to trade marks – corresponds to Article 29 CTMR.

The ‘convention priority’ right is a right limited in time, which is triggered by the first filing of a trade mark. It may be claimed during the six months following the first filing, provided the country of first filing was a party to the Paris Convention or to the WTO, or a country with a reciprocity agreement (cf. Rule 101 CTMIR – reciprocity findings by the Commission).

The below mentioned States and other entities are not members of any of the relevant conventions nor do they benefit from reciprocity findings. Therefore, priority claims based on filings in these countries will be **rejected**.

Independent States (not member of PC, WTO or reciprocity agreement):

- Afghanistan (AF)
- Aruba (AW)
- Cape Verde Islands (CV)
- Cook Islands (CK)
- Eritrea (ER)
- Ethiopia (ET)
- Kiribati (KI)
- Marshall Islands (MH)
- Micronesia (Federated States of) (FM)
- Nauru (NR)
- Palau (PW)
- Somalia (SO)

- Tuvalu (TV)
- Western Samoa (WS).

Other entities (not member of PC, WTO or reciprocity agreement):

- Abkhazia
- American Samoa (AS)
- Anguilla (AI)
- Bermuda (BM)
- Cayman Islands (KY)
- Falkland Islands (FK)
- Guernsey (Channel Island) (GC)
- Isle of Man (IM)
- Jersey (Channel Island) (JE)
- Montserrat (MS)
- Pitcairn Island (PN)
- Saint Helena (SH)
- Somalia (SO)
- Turks and Caicos Islands (TC)
- (British) Virgin Islands (VG).

A priority claim of a previous CTM is acceptable if that CTM was granted a filing date. A priority claim of an international registration is not acceptable. This is because the principle of first filing applies (Article 29(4) CTMR – see paragraph 14.1 below) and the priority claim can only be based on the relevant basic mark.

The applicant may claim the priority of one or more previous trade mark applications, namely a national (or Benelux) application filed in or for a State party to the Paris Convention, a Member of the TRIPS Agreement, a State for which the Commission has confirmed reciprocity, or a CTM application. See paragraph 14.1 'Principle of first filing' for information on applications which claim priority of more than one earlier application.

Any filing that is equivalent to a regular national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority. A regular national filing means any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application may be.

The priority right claimed must always be an earlier application and cannot bear the same date as the CTM application.

Priority claims may be filed either in the CTM application or subsequent to the filing of the application, in which case the applicant must submit the declaration of priority, indicating the date on which and the country in which the previous application was made, within a time limit of two months from the filing date.

The claim may be implicit so the submission of the priority documents (within the time limit of two months) will be construed as a declaration of priority. Simple filing receipts containing the country and the date of the earlier application are accepted.

If the mark concerned is a logo in colour, the submission of colour photocopies concerning the earlier filing is mandatory.

Within three months of the receipt of the declaration of priority at OHIM, the applicant must provide the Office with the file number(s) of the previous application(s).

Priority will be granted if the following requirements are met:

1. the mark in the earlier application and the CTM applied for are the same;
2. the goods and services are identical or are contained within those of the earlier application (it is sufficient that one good or service is the same);
3. the proprietor is the same;
4. the filing date of the CTM is within 6 months of the filing date of the earlier application;
5. the priority must be claimed with the application or within 2 months from the filing date.

It is possible to claim both priority and seniority based on the same prior application/registration if the first filing was registered in due time.

### **14.1 Principle of first filing**

The previous application must be a first filing. The Office will therefore check on the certificate that there was no priority claim made on the prior application and no seniority claim made for the CTM application for a mark with a filing date prior to that of the priority mark. The Office will equally check that the CTM application is filed no later than six months from the date of filing of the earlier application.

Where priority of more than one earlier application is claimed, the goods and / or services covered by each of those applications must be different in order for the principle of first filing to be met. For examples please see paragraph 14.7.1 below.

### **14.2 Triple identity**

The Office will check that the CTM application and the priority documents contain the same mark, refer to the same applicant and have at least one good or service in common.

#### **14.2.1 Identity of the marks**

The Office and a number of trade mark offices of the European Union have agreed on a common practice under the European Trade Mark and Design Network concerning the identity of trade marks filed in black and white and / or greyscale as compared to those filed in colour. The offices have concluded that, a trade mark filed in black and white and / or greyscale is, for the purposes of assessing priority, not identical to the same mark filed in colour unless the differences in colour or in the shades of the grey are so insignificant that they could go unnoticed by the average consumer (see judgment of 19/01/2012, T-0103/11, 'justing, para. 24, judgment of 20/02/2013, T-378/11, 'Medinet' and judgment of 09/04/2014, T-623/11, 'Sobieraj (MILANÓWEK CREAM FUDGE)'). An insignificant difference between two marks is one that a reasonably observant consumer will perceive only upon examination of the marks side by side.

The principle described above applies to all cases where marks are compared for the purpose of priority claims. In relation to word marks, the mark applied for will in most cases be deemed to be the same as the earlier mark where there is a difference only in respect of type face or where one mark is in uppercase letters and the other in lowercase. Furthermore, a difference in punctuation or the addition of a space separating two words will not usually prevent the marks from having identity (see decision of 9/10/2012, R 797/2012-2, 'Water Jel' and decision of 15/07/1998, R10/1998-2 'THINKPAD').

The Office will also check the mark type of the earlier application, because a different mark type may mean that the CTM application is different from the earlier mark. For example, a figurative mark is not the same as a three-dimensional mark, or a position mark. However, a word mark can be considered to be the same as a figurative mark if standard type is used in the figurative mark (see the examples below at paragraph 14.8.2).

In assessing the marks, the Office will also consider any colour indication in the earlier application.

#### 14.2.2 Identity of the goods and services

The Office will check that there is at least one corresponding good or service in the lists covered by the first filing and the CTM application. The examination will not extend to all the goods and services covered under the lists and it will not be limited to class numbers only.

#### 14.2.3 Identity of the owner

Priority can be claimed by the applicant of the first application or its successor in title. In the latter case, the transfer must have taken place prior to the filing date of the CTM application and documentation to this effect must be provided. The right of priority as such may be transferred independently of whether or not the first application as a whole is transferred. Priority can therefore be accepted even if the owners of the CTM application and the earlier right are different, provided evidence of the assignment of the priority right is supplied; in this case, the execution date of the assignment must be prior to the filing date of the CTM application.

Subsidiary or associated companies of the applicant are not considered the same as the CTM applicant.

Where the applicant of the first application states that it has changed its name since the first filing and files the CTM application under its new name, the applicant is considered to be the same person.

For the distinction between a change of name and a transfer, see the Guidelines, Part E, Register Operations, Section 3, CTMs as Objects of Property, Chapter 1, Transfer.

### **14.3 Priority requirements not satisfied**

If the priority claim does not satisfy any of the above requirements, the applicant will be invited to remedy the deficiency or make observations within two months. If the deficiency is not remedied, the Office will inform the applicant that the priority right is lost and that it may request a decision on this loss of rights (details see below under paragraph 14.7, Treatment of priority examination deficiencies).

### **14.4 Priority documents not provided**

If the priority documents are not submitted with the application, the Office will check on the National office website to determine if the relevant information can be found online. If the information to grant the priority claim cannot be found online, the Office will send a letter to the applicant requesting it. The applicant will be given a time limit of two months to remedy the deficiency; as a rule, this time limit will not be extended. Usually, the deficiency letter will be issued before expiry of the original time limit to submit the priority documents (three months from date of receipt of the priority claim). In this case, the two-month deficiency time limit will be calculated from the date of expiry of the original time limit for submission of the priority documents. In accordance with Decision No EX-03-5, certified copies are not necessary. Simple filing receipts that do not contain all the necessary information for examining the priority claim (e.g. they only contain class numbers for the goods and services of the prior application and not the full text version indicating all the goods and services) are not acceptable.

### **14.5 Language of previous application**

If the language of the previous application is not one of the official EU languages, the Office will invite the applicant to file a translation within three months. The time limit for filing the translation may be extended at the request of the applicant. An extension in this case may be for up to two months.

### **14.6 Priority date check after changing of the filing date**

If the CTM application has a filing date change, the Office must check that the new filing date is still within six months of the priority claim.

### **14.7 Treatment of priority examination deficiencies**

If the first application is not identical to the CTM application, the filing number of the first filing is not indicated, the priority is claimed out of time (i.e. after the six-month period or later than two months after the filing of the CTM application), or the priority documents are not acceptable (i.e. as to country of first filing and triple identity requirements), the applicant will be notified by a deficiency letter, and a two-month time limit to make observations or remedy the deficiency will be set.

If a translation must be requested, the Office will notify the applicant by sending a deficiency letter and set a three-month time limit.

If there is no response or if the deficiencies are not remedied within the time limit, the Office will notify the loss of right to the applicant and set a two-month time limit during which the applicant may request a formal, appealable decision on the loss of right.

If the applicant formally requests a decision within the time limit, the Office will issue a formal decision on the loss of right.

If the priority is claimed later than two months after the filing date of the CTM application or if the CTM application is filed after the six-month priority period, the applicant will be notified and a time limit for observations will be set. Where there is no reply and the deficiencies are not remedied, the Office will inform the applicant of the loss of the priority right and the possibility to request a formal (i.e. appealable) decision on the loss of the priority right.

## 14.8 Examples of priority claims

### 14.8.1 First filing

In the example below, priority cannot be claimed from a first filing in Somalia, since Somalia is not a Member State of the Paris Convention or the World Trade Organisation and has no reciprocity agreement confirmed by the EU Commission. Therefore, the first filing in Italy is the one considered for the priority claim; the other filing cannot be taken into consideration.







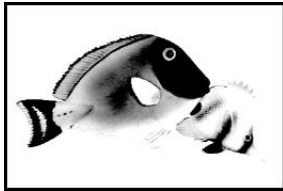
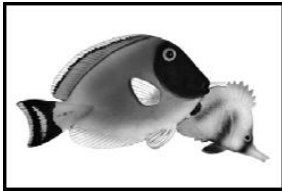


First filing	Country	Goods/services	CTM filed	Goods/services
5 April	<b>Somalia</b>	Cars, T-shirts		Cars, T-shirts
7 July	Italy	Cars, T-shirts	2 October	Cars, T-shirts











In the example below, the two earlier trade mark applications were filed for exactly the same goods. The priority claim based on the Greek application has to be rejected since the trade mark was applied for in Spain before; thus the Greek application is no longer a first filing.

First filing	Country	Goods/services	CTM filed	Goods/services
<b>6 April</b>	Spain	Cheese, wine		Cheese, wine
<b>7 April</b>	Greece	Cheese, wine	4 October	Cheese, wine





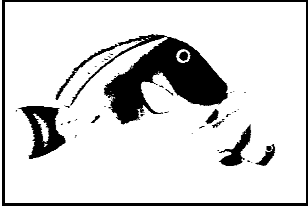
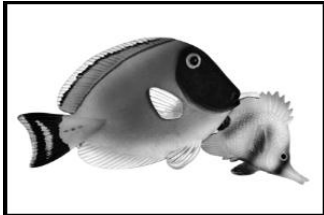
### 14.8.2 Comparison of the marks

Examples of acceptable priority claims	
CTM application (word mark) EVAL	Priority claim (word mark) <b>EVAL</b>
CTM application (word mark) Luna	Priority claim (word mark) <i>Luna</i>

Examples of acceptable priority claims	
CTM application (figurative mark) 	Priority claim (figurative mark) 
CTM application (figurative mark) 	Priority claim (figurative mark) 
CTM application (figurative mark) 	Priority claim (figurative mark) 
CTM application (figurative mark) 	Priority claim (figurative mark) 
CTM application (figurative mark) 	Priority claim (figurative mark) 

Examples of unacceptable priority claims	
<p>CTM application (colour per se)</p> 	<p>Priority claim (colour per se)</p> 
<p>CTM application (word mark)</p> <p>Chocolate Dream</p>	<p>Priority claim (word mark)</p> <p>Chocalate Dream</p>
<p>CTM application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>CTM application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>CTM application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>CTM application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 









Examples of unacceptable priority claims	
<p>CTM application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>CTM application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>CTM application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 

Further examples with regard to word marks			
First trade mark	CTM application	the same	not the same
Word mark Percy & Reed	Word mark Percy + Reed		X
Word mark Percy & Reed	Word mark Percy and Reed		X
Word mark Percy & Reed	Word mark <b>Percy &amp; Reed</b>	X	
Word mark Percy & Reed	Word mark Percy & REED	X	
Word mark Percy & Reed	Word mark PERCY & REED	X	

Further examples with regard to word marks			
First trade mark	CTM application	the same	not the same
Word mark Percy & Reed	Word mark <i>Percy &amp; Reed</i>	X	
Word mark POPEYE	Word mark POPeye	X	
Word mark POPEYE	Word mark PopEye	X	
Word mark POPEYE	Word mark POP-EYE	X	
Word mark: POPEYE	Word mark: POP EYE	X	
Word mark POPEYE®	Word mark POPEYE	X*	
Word mark POPEYE	Word mark POPEYE!?		X
Word mark <b>POPEYE</b>	Word mark <b>POPEYE-</b>	X	

\* The symbols ™ and ® are not considered parts of the mark.

Examples regarding identity between figurative signs as compared to word marks			
First trade mark	CTM application	the same	not the same
Word mark Percy & Reed	Figurative mark Percy & Reed (figurative mark in standard type face)	X	
Word mark Percy & Reed	Figurative mark Percy & Reed (words distributed over several lines)		X
Word mark Percy & Reed	Figurative mark Percy & Reed (colour claim)		X

Further examples with regard to figurative marks			
First trade mark	CTM application	the same	not the same
			X
			X
		X	

\* The symbols ™ and ® are not considered parts of the mark.

### 14.8.3 Comparison of the goods and services

The first example below is the most standard situation: The prior application corresponds fully to the CTM application.

First filing	Country	G&S	CTM filed	G&S CTM
5 April	UK	Hats, shoes	1 October	Hats, shoes

In the next example, both priority claims can be accepted since application number XY 1234 is the first filing with respect to ‘cars’ and application number XY 1235 is the first filing with regard to ‘airplanes’.

First filing	Country	JP application No	G&S	CTM filed	G&S CTM
5 April	Japan	XY 1234	Cars		
5 April	Japan	XY 1235	Airplanes	2 October	Cars, airplanes

In the next example, the priority claim concerns ‘hats’ and ‘shoes’ which are common to the first filing and the CTM application. No priority will apply with respect to ‘bags’.

First filing	Country	G&S	CTM filed	G&S CTM
5 April	USA	Cars, hats, shoes	1 October	Hats, shoes, bags



In the last example, priority is claimed for first filings in France, Canada and China. The CTM application has been filed within six months of each of the first filings and the priority claims will be accepted, although with regard to ‘hats’ the Canadian application does not constitute a first filing (‘hats’ appear in the French application which had been

filed before). Comparing the dates and the lists of goods and services of the three priorities, the priority claims will be accepted.

First filing	Country	G&S	CTM filed	G&S CTM
5 April	France	Hats, shoes		
6 April	Canada	Cars, hats, beer	5 October	
7 April	China	Wine, telecommunication services		Hats, shoes, cars, beer, wine, telecommunication services

#### 14.8.4 Priority claims based on series marks

A series of trade marks means a number of trade marks which resemble each other as to their material details and differ only as to matters of non-distinctive character. Whereas the Community Trade Mark Regulation does not allow for the filing of series marks, some national Offices (e.g. the United Kingdom, Australia etc.) do, and such a series of marks filed in one single application can contain numerous very similar marks. When the first filing consists of a series mark, two or more slightly different mark representations will be seen. The priority claim is acceptable with regard to the one reproduction which is identical to that showing the mark applied for as a CTM.

Examples of priority claims based on series marks		
First filing	CTM	Priority claim acceptable
Series of marks 		Yes
Series of marks Café@Home CAFÉ@HOME Café@Home CAFÉ@HOME	CAFÉ@HOME	Yes

#### 14.8.5 Claiming priority for three-dimensional or 'other' marks

Some national IP offices do not allow the filing of more than four representations in the case of three-dimensional or other marks.

If a CTM application claims priority of such a first filing, and six (or more, in the case of 'other' marks) depictions/perspectives of the mark are filed with the CTM application, the marks in question will still be considered identical if the presentations of the first filing coincide with a part of what was sent for the CTM application and if the object is doubtlessly the same.

#### 14.8.6 Priority claims involving collective marks

Priority can be claimed from a collective mark when applying for an individual Community trade mark and vice versa.

## 15 Exhibition Priority

Article 33 CTMR; Rule 7 CTMIR
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Exhibition priority entails claiming as priority date of the CTM application the date on which the goods or services covered by the CTM application were displayed at an officially recognised exhibition under the mark as filed. The applicant can claim exhibition priority within six months of the first display. Evidence of the display must be filed.

Like 'convention priority', exhibition priority can be claimed either in the application or subsequently to the filing of the CTM application. Where the applicant wishes to claim an exhibition priority subsequent to the filing of the application, the declaration of priority indicating the name of the exhibition and the date of first display of the goods or services must be submitted within a time limit of two months of the filing date.

Within three months of the receipt of the declaration of priority the applicant must provide the Office with a certificate issued at the exhibition by the responsible authority. This certificate must state that the mark was in fact used for the goods or services, the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of the first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the authority.

Priority can only be granted where the application for a CTM is filed within six months of first display at an exhibition recognised for this purpose, namely a world exhibition within the meaning of the Convention of 22 November 1928. These exhibitions are very rare and Article 33 does not protect the display at other, national exhibitions. The exhibitions can be found on the website of the Paris Bureau International des Expositions: <http://www.bie-paris.org/site/en/>.

As to the triple identity of the trade mark, applicant and list of goods and services, the same criteria apply as for 'convention priorities' mentioned in paragraph 14 above.

If there is no objection from the Office, the priority claim will be noted on the file and appear in the online database. No express confirmation will be sent to the applicant.

The claim may be implicit. Where there is no indication of the claim in the application, the submission of the exhibition priority documents (within the time limit of two months) will be construed as a declaration of priority.

## 16 Seniority

Article 34 CTMR  
Rules 8, 28 and Rule 96(2) CTMIR  
Communication 2/00, Decision EX-03-5 and Decision EX-05-05 of the President of the Office

The proprietor of an earlier trade mark registered in a Member State, including a trade mark registered in the Benelux countries, or registered under international arrangements having effect in a Member State, who applies for an identical trade mark for registration as a CTM for goods or services which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the CTM application the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.

Seniority has the sole effect that where the proprietor of a CTM surrenders the earlier trade mark for which seniority has been claimed or allows it to lapse, it shall be deemed to continue to have the same rights as it would have had if the earlier trade mark had continued to be registered.

This means that the CTM application represents a consolidation of earlier national registrations. If an applicant claims seniority for one or more earlier registered national marks and the seniority claim is accepted, the applicant may decide not to renew the earlier national registrations but still be in the same position as if the earlier trade mark had continued to be registered in those member states where the earlier marks were registered.

Seniority under Article 34 CTMR must be claimed with the application or within two months from the filing date of the CTM application. The documents in support of the claim must be provided within three months of the claim. The seniority claim may be implicit. If the applicant sends only the documents concerning the earlier registrations within two months from the filing date of the CTM application, the Office will construe this as a seniority claim concerning these earlier registrations.

Seniority may be claimed not only for earlier national registrations, but also for an international registration with effect in an EU country. No seniority claim is possible, however, for an earlier CTM registration or local registrations, even if the territory is part of the European Union (e.g. Gibraltar).

### 16.1 Harmonised seniority information

In order to be able to properly manage seniorities, all seniority entries in the system need to have the same format as that is used in the databases of the National offices.

To enhance harmonisation between OHIM and participating IP offices, a list with the required format for seniorities has been established. This list provides a description of the format / formats used in each of the national offices, insofar as this has been determined.

Therefore, when checking seniority, the Office must verify if the format of the seniority in the system corresponds to the format used at the national level.

## 16.2 Seniority examination

A valid claim consists of:

1. the Member State or Member States of the EU in or for which the earlier mark, for which seniority has been claimed, is registered;
2. the filing date of the relevant registration;
3. the number of the relevant registration;
4. the goods or services for which the mark is registered.

Pursuant to Decision No EX-05-5 of 01/06/2005, the proprietor is not required to file a copy of the registration if the required information is available on the website of the respective national offices. If the copy of the registration is not submitted, the Office will first search for the necessary information on the respective website and only if the information is not available there will it ask the proprietor for a copy by means of a deficiency letter. Pursuant to Article 3 of Decision No EX-03-5, the copy of the relevant registration must consist of a copy (simple photocopies suffice) of the registration and / or renewal certificate or extract from the Register, or an extract from the relevant national Gazette, or an extract or printout from an official database. Extracts and printouts from private databases are not accepted. Examples of extracts that are not accepted are DEMAS, MARQUESA, COMPUSERVE, THOMSON, OLIVIA, PATLINK or COMPUMARK, SAEGIS.

Seniority may only be claimed for an earlier **registration**, not for an earlier application.

The Office must check both that the earlier mark was registered at the time the CTM application was filed and that the earlier registration had not lapsed at the moment the claim was made (on the duration of protection of national marks see the Guidelines, Part C, Opposition, Section 1, Procedural matters).

If the earlier registration had lapsed at the moment the claim was made, seniority cannot be claimed, even if the relevant national trade mark law provides for a six month grace period for renewal. While some national legislation allows for a 'grace' period, if the renewal is not paid, the mark is considered to be not registered from the day it was due for renewal. Therefore, the claim is not acceptable, unless the applicant shows that it has renewed the earlier registration(s).

In the context of an **enlargement** of the EU, the following details have to be born in mind. Where a national trade mark of, or an international registration with effect in, a new Member State was registered before the seniority claim is made, **seniority may be claimed even though the priority, filing or registration date of the CTM to which the seniority claim relates predates the priority, filing or registration date of the national mark/IR with effect in the new Member State**. This is because the CTM at issue only has effect in the new Member State from the date of accession. The national trade mark/IR with effect in the new Member State for which seniority is claimed is therefore 'earlier' than the CTM within the sense of Article 35 CTMR, **provided** the national trade mark/IR with effect in the new Member State enjoys a priority, filing or registration date **prior to the accession date**.

Examples of acceptable seniority claims for new Member States			
CTM	Filing date	Seniority claim country	Filing date of earlier right
2 094 860 TESTOCAPS	20/02/2001	Cyprus	28/02/2001
2 417 723 PEGINTRON	19/10/2001	Hungary	08/11/2001
352 039 REDIPEN	02/04/1996	Bulgaria	30/04/1996
7 073 307 HydroTac	17/07/2008	Croatia	13/10/2009

**Explanation:** In all cases, although the filing date of the CTM application is earlier than the filing date of the mark for which seniority is claimed, as all countries concerned acceded to the European Union after the filing date of the CTM application (i.e. on 1 May 2004 for Cyprus and Hungary and on 01/01/2007 for Bulgaria and Romania) and it is from that date that the CTM application has protection in those Member States, seniority can be claimed for any national marks filed prior to the date of accession.

If the claim to seniority is in order, the Office will accept it and – once the CTM application has been registered – inform the relevant central industrial property office(s) of the Member State(s) concerned (Rule 8(3) CTMIR).

Seniority can also be claimed after the CTM is registered under Article 35. For further details, see the Guidelines, Part E, Register Operations, Section 1, Changes in a registration.

### 16.3 Identity of the marks

Examination of seniority claims is limited to the formal requirements and to the identity of the marks (see Communication of the President No 2/00 of 25/02/2000).

As regards the triple-identity requirement (same owner, same mark, same goods and services), it is for the applicant to make certain that these requirements are met. However, the Office will examine only whether the marks are the same.

The comparison of the mark representations for the purposes of seniority claims is the same as that for priority claims detailed above at paragraph 14.2.1.

### 16.4 Goods and services

Applicants may claim seniority for part of the goods and services of the earlier registration(s). Effectively the claim to seniority will be valid to the extent that there is an overlap between the goods and services of the CTM application and the registration relied on. The applicant is not required to specify those goods and services, but may simply claim 'seniority for all the goods which are found in the earlier mark to the extent they are also found in the CTM application' (generic seniority claim).

### 16.5 Treatment of seniority examination deficiencies

If the claim is not valid, if the earlier registration is not identical to the CTM application, if the seniority is claimed out of time (i.e. after the two-month time limit following the filing of the CTM application), or the seniority documents are not acceptable and the relevant information cannot be found online, the Office will issue a deficiency letter.







If the deficiencies are not remedied within the time limit set by the Office, the applicant will be notified in writing of the loss of right. At the same time the applicant is informed that it can ask for a formal decision within two months of the notification.

If within the time limit the applicant formally requests a decision, the Office will issue a formal decision on the rejection of the seniority claim.

## 16.6 Examples of seniority claims

Example of an acceptable seniority claim	
CTM application (word mark)  CELOTAPE	Seniority claim (word mark)  Celotape
CTM application (word mark)  Daisys Gingerbread	Seniority claim (word mark)  Daisy's Gingerbread

Examples of unacceptable seniority claims	
CMTA: 9 817 735 (figurative mark) 	Seniority Claim (figurative mark) 
CTM application (word mark) Great changes in education PLC	Seniority claim (word mark) Grate changes in education PLC
CTM application 8 786 485 (figurative mark) 	Seniority claim (figurative mark) 

For further examples of acceptable and unacceptable seniority claims, see paragraph 14.8.2 above.

## 17 Transformation

Transformation is a legal feature introduced in the Madrid Protocol to soften the consequences of the five-year dependency period between the international registration and the basic mark. In the event that the international registration designating the EU is cancelled at the request of the Office of origin in respect of all or some of the goods and services, the holder of the international registration may file a CTM application for the registration of the same mark in relation to the goods and services that have been cancelled. That application shall be treated as if it had been filed on the date of the designation of the EU in the international registration and shall enjoy the same priority, if any. For more details on transformation, see the Guidelines, Part M, International marks.

## 18 Amendments to the CTM application

Articles 43 and 44 CTMR  
Rule 3 and Rule 13(a) CTMIR

The applicant may at any time withdraw its CTM application or restrict the list of goods and services covered by it. Other changes are only foreseen to correct certain mistakes.

Any change requested on the same day of filing of the CTM application will be accepted.

This part of the Guidelines will only describe the Office practice concerning amendments of the mark representation. For further details on withdrawal or restrictions, see the Guidelines, Part B, Examination, Section 1, Proceedings.

### 18.1 Amendments to the representation of the mark

The Office practice on amendments of the mark representation is very strict. The two conditions for allowing a change to the mark once filed are cumulative:

- the mistake must be obvious, **AND**
- the amendment must not substantially change the mark as filed.

Even if the amendment is not a substantial one, if the mistake is not obvious the Office will not accept the amendment.

In cases where the desired positioning of a mark is not obvious, the representation of the mark shall indicate the correct position by adding the word 'top' to the reproduction of the sign. Where the application is filed by electronic means, the unusual positioning may be indicated in the mark description.

In cases where the desired positioning of a mark is not obvious (e.g. a mark containing a verbal element is filed in a vertical position) and there is no indication of the intended positioning in the application, the applicant will be allowed to amend the position of the mark upon request. This is because the unusual positioning of the mark will be considered an obvious mistake.



If a priority or seniority claim is filed at the same time as the CTM application, an obvious error may be proven by comparing the 'correct' mark in the claim with the mark on the CTM application. However, if the priority or seniority claim is filed after the CTM application, no evidence from these claims can be taken into account.

If the mistake is obvious, the mark must then be assessed by the next criterion, namely whether the requested change substantially alters the mark as filed.

Example of an acceptable amendment	
CTM 546 010 Mark filed as 'TOPFLOW'	Proposed change 'TOP FLOW'
In the application form the applicant claimed priority for the mark 'TOP FLOW', meaning that it was obvious that a typographical error had been made. The amendment was not considered to be a substantial alteration of the mark as the addition of a space between the words 'TOP' and 'FLOW' does not alter the meaning and pronunciation of the mark and the visual impact of the amendment is low (decision of 05/08/2002 R 851/1999-2 – 'TOP FLOW')	

Examples of unacceptable amendments	
CTM 321 109 Mark filed as 'RANIER'	Proposed change 'RAINIER'
This change will not be allowed since the correction shows the addition of another letter 'I' which would substantially change the mark as filed. 'RANIER' and 'RAINIER' are two different words.	
CTM 6 013 668 Mark filed as 'ELECTROLITIC BOLUS'	Proposed change 'ELECTROLITYC BOLUS'
This change will not be allowed as the correct English spelling for this word is 'ELECTROLYTIC'. Consequently the mark as filed had 1 erroneous letter whilst the amendment proposal would have 2 erroneous letters. This would substantially alter the mark and therefore is unacceptable.	

In the case of figurative elements, only elements of minor importance can be amended and this will be dealt with on a case-by-case basis. Giving a 'fresh look' to a figurative mark (this is a frequent practice in the industry to adapt the appearance of a figurative mark to current design and fashion trends from time to time) will not be allowed.

CTM 6 538 524 CTM as filed 	Proposed change 
The applicant filed a priority claim with the CTM application which showed that the first filing consisted of the single representation of the mark. In addition, the CTM application contained a mark description that described the single representation and not the two images that had been filed. Therefore, the mistake was considered to be obvious. The amendment request was however rejected as the amendment would substantially change the mark from that which was filed.	

Notwithstanding the aforementioned principles and examples, any alteration of the mark that would be allowable after registration will also be allowable in respect of a CTM application.

Regarding alterations of a registered CTM, please refer to the Guidelines, Part E, Register Operations, Section 1, Changes in a registration.

## **19 Conversion**

Articles 112(1) and 113(1) CTMR Rule 44(1)(f) CTMIR
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The applicant of a CTM application or proprietor of a registered CTM may request the conversion of their CTM application or registered CTM. For more information on conversion see the Guidelines, Part E, Section 2, Conversion.