

European Union - Community trade marks (CTMs)

If you are interested in selling your products or offering services in a number of countries that are members of the European Union, you may find that the CTM system offers you the best route for securing protection of your trade mark.

Trading in Europe?

A CTM will give you rights throughout all 28 countries that currently belong to the European Union. As or when the EU expands in size, your registered CTM will give rights in the new accession states as well.

A list of countries that are currently members of the European Union can be found [here](#).

What rights does a CTM give?

The main function of a validly registered CTM is to give you the right to take action anywhere within the EU to prevent others from using a trade mark in a way that is likely to mislead or confuse the public into wrongly believing that their goods or services are connected with or originate from you or your company. A validly registered CTM can be used to prevent others not only from using the same mark as yours, but also any similar mark where the use of that mark is liable to cause confusion. Marks that are well known or that have a reputation in a particular field can also benefit from enhanced protection, enabling the owner

of the earlier mark to take action to prevent others from using or registering the same or a similar mark where the use of the later mark would damage or take unfair advantage of the reputation or distinctiveness of the earlier mark.

Cost-effectiveness of the CTM system

Provided that a CTM is registered with little or no difficulty, it will be the most cost-effective system of securing protection in all of the EU member states. Under the CTM system, the first three classes of goods and/or services are included in the initial basic cost of the application. Additional classes beyond three may be included in a CTM application on filing upon payment of an extra charge for each additional class.

Keeping your CTM registration valid

A registered CTM has to be used within five years from the date of registration (or during any successive 5 year period), or it becomes susceptible to revocation. However, it is not necessary for a CTM to be used in all 28 EU member states: genuine use in as little as one or two EU member states should be sufficient to avoid the registration being revoked.

How will I know if I will succeed in registering my trade mark as a CTM?

The short answer to this is that it is impossible to know for sure whether a CTM application will be successful. An earlier conflicting right in just one EU member state could be enough to prevent you from registering your CTM. However, we can carry out searches prior to filing, which may disclose potential problems.

Conversion

A CTM application or registration may be converted into national trade mark applications which bear the same date as the CTM application. This is a useful option if the CTM application is refused following an opposition based on rights in only one or several EU countries.

Searching

Carrying out a search in all 28 EU member states for earlier rights is, for most people or companies, likely to be prohibitively expensive. However, we do strongly recommend searching in each country at an early stage before launching the product or service in that country.

We are happy to discuss searching **strategies** to suit your purpose and budget.

For instance, it is possible to carry out searches on earlier identical marks only in some or all EU countries.

Alternatively, or in addition, full “availability” searches can be carried out in the countries of most interest to you. Of course, the downside of limited searching is that the searches may not disclose all relevant earlier marks, but often a balance will have to be struck between cost and risk.

Filing a CTM application: the process

Timescale

If a CTM application proceeds smoothly without encountering any objections or opposition, a CTM is likely to be approved for registration around six months from the date of filing.

The basic requirements

An application to register a CTM should identify the mark and the goods and/or services of interest. Applications cannot be broadened after filing, so it is important that all goods and services of interest to you now or in the foreseeable future are included in the application.

We can assist you in drawing up a suitable specification of goods and / or services and advise you of the appropriate class(es) to which they belong.

Examination and publication

The application is then examined to check that the mark is distinctive and is not objectionable on any other relevant grounds. If the application does meet with an objection on any ground, we will be notified and will provide you with information, advice and assistance in order to try to overcome the objection and secure acceptance of the application.

The next major step is for the CTM to be published for opposition purposes. All accepted CTM applications are open to opposition for a period of three months. During the opposition period, anyone who considers that they have earlier rights can oppose your application. If no opposition is received by the Community Trade Marks Office, the mark will then be registered and we shall send you the registration certificate.

Oppositions

If your application is opposed, we will write to tell you and will provide you with information about the grounds of opposition. We will also provide advice on the strength of the opposition as we view it, along with recommendations on how to proceed. We will also consider whether it could be possible to settle the opposition amicably and can assist you in negotiations with the opponent and the preparation of a settlement agreement, if appropriate.

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Need advice?

For more information, please contact email@carpmaels.com.

Carpmaels & Ransford (Trade Marks) LLP is a leading firm of European trade mark attorneys based in London. For more information about our firm and our practice, please visit our website at www.carpmaels.com.

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