

March 2008

## New Community Trade Mark Search Procedures

A Change in the rules covering applications for Community Trade Marks (CTMs) has meant that national searches as part of the examination process are now optional from **10 March 2008**.

From that date, national search reports will be produced only on request of the applicant under an all-or-nothing principle and on payment of an extra fee. Currently 17 member states supply search reports as part of the CTM examination process and requesting these 17 national search results will now add approximately 200 Euros to the CTM application cost.

Results of searches of prior CTMs will still be delivered as before at no extra cost.

OHIM has indicated that under the new regime these optional national searches will be produced within 2 months rather than the current 3 months. Furthermore, unlike the current situation where member states issue their search reports to different standards, the new search results are promised to be issued to the same standard. It remains to be seen what this uniformed standard will be.

While some applicants carry out searches in EC member states before filing their application and so may not feel the need to pay the new fee, for those who do not, the national searches conducted as part of the CTM examination process were an important safeguard.

In particular, as it is up to the owners of prior national rights to file an opposition to a CTM application, it is possible a CTM application can proceed to registration despite there being serious prior national registrations, primarily because the owners did not become aware of the CTM being filed and therefore did not oppose. Consequently, and in the absence of national searches, the validity of a CTM registration is far less certain.

As a result, **Harrison Goddard Foote** has chosen to adopt the default setting of including the optional request for national search reports when filing new CTM applications after 10 March 2008, thus incurring additional official fees of approximately 200 Euros.

However if the applicant does not require the national searches to be conducted, we can reverse the decision within one month of the filing date. Within our letter reporting the filing of a new CTM application, we will identify this one month deadline and invite the applicant to instruct us before this due date if they do not wish to incur the cost of the new optional national searches.

It is unfortunate that OHIM have chosen to charge extra for the national search results, at a time when it was felt their overall official fees may in fact be reduced. However in view of the importance of conducting prior national searches, either prior to filing or as part of the CTM examination process, we believe it is prudent for these national searches to be requested as part of the CTM examination, unless instructed to the contrary by the Applicant.

If you have any outstanding questions with regard to this change in OHIM's practice, then please do not hesitate to get in touch with your HGF attorney or email [info@hgf.com](mailto:info@hgf.com).

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