



External

INFORMATION NOTE ON THE NEW SEARCH SYSTEM

PREAMBLE

The revision of the Community Trade Mark Regulation by Council Regulation (EC) No 422/2004 of 19 February 2004 made national searches optional. The new Article 39 CTMR establishes that national search reports will be produced only on request of the applicant and that a separate search fee will have to be paid by applicants who wish to obtain national search reports. This change will apply to applications filed as from 10 March 2008. Community search reports and the associated warning letters will continue to be delivered as before.

CURRENT SYSTEM:

For marks with filing dates prior to 10 March 2008, the "old" system will apply which means that Community and national searches will be carried out in all cases without the obligation to pay a specific search fee. A period of 3 months is given to national offices to produce the search reports. Due to the fact that the applications must have a valid Nice classification and basic fee payment before searches can be initiated, many of these applications will still be searched and search reports transmitted to the applicant after the new system is in place, as long as the filing date is earlier than 10 March 2008

NEW SYSTEM:

1. Features:

For marks filed from 10 March 2008 and onwards (or for International Registrations, applications received by OHIM from WIPO after that date), the following will apply:

- Community search reports will be produced in all cases whereas national search reports will be prepared only on applicant's explicit request.
- A specific fee per participating national office (17 offices as of March 2008¹) must be paid for the request for national searches to be valid. The fee for the national searches is currently being reviewed and further information will be given on the OHIM website before the new system takes effect.
- National search reports will be prepared by the offices that have chosen to participate in the new system. The period given to the offices for producing searches is reduced from three to two months.
- A request for national searches implies that all participating national offices will carry out the search, all of which must be paid for (all-or-nothing policy which means that the applicant cannot select for the search only some countries among the participating offices and leave out others).
- The format of the search reports is harmonized.
- National search reports will have to comply with Rule 5a of Commission Regulation (EC) No 2868/95² regarding the following minimum contents:
 - (a) the name of the national office that carried out the search;
 - (b) the number of the trade mark applications or registrations mentioned in the search report;
 - (c) the date of application and if applicable date of priority of the trade mark applications or registrations mentioned in the search report;
 - (d) the date of registration of the trade marks mentioned in the search report;
 - (e) the name and contact address of the holder of the trade mark applications or registrations mentioned in the search report;

Austria, Bulgaria, Czech Republic, Denmark, Finland, Greece, Hungary, Ireland, Lithuania, Malta, Poland, Portugal, Romania, Slovak Republic, Spain, Sweden and United Kingdom.

² As modified by Commission Regulation (EC) No 1041/2005.

- (f) a representation of the trade marks applied for or registered mentioned in the search report;
- (g) an indication of the classes, according to the Nice Classification, for which the earlier national trade marks are applied for or registered or of the goods and services for which the trade marks mentioned in the search report are either applied for or registered.

2. How to file a national search request:

CTM application:

- The request can only be made at the same time as filing the application. OHIM's official application form as well as the e-filing forms will be modified to include this option.
- The payment deadline coincides with that of the application's basic fee, namely one month from the date of filing at OHIM. Late or missing search fee payments will be dealt with as if request for national searches had not been filed and only the Community search report will be prepared in such cases
- Payment can be made using any of the means of payment accepted by OHIM for CTM applications (currently bank transfer, current account or e-payment).

Madrid Protocol:

- The national search request must be filed directly at OHIM once the EC has been designated (national searches must not be requested through WIPO). There is no particular form for filing such request; the applicant has to transmit a letter containing a clear and unambiguous request for national searches which identifies the number of the International Registration designating the EC to which it refers.
- Holders of International Registrations designating the EC have a month from the moment the file is received by OHIM from WIPO to file a request for national searches and for payment of the fee. Late or missing search fee payments will be dealt with as if request for national searches had not been filed and only the Community search report will be prepared in such cases.
- Payment can be made using any of the means of payment accepted by OHIM for CTM applications (currently bank transfer, current account or e-payment).

3. When no national searches are requested:

CTM application:

A Community search report will be issued as soon as possible once the basic application fee has been validated and the application has not been withdrawn or rejected. The transmission of the search report will take place through SRO (Search Report Online) for MyPage clients or by mail to the applicant (or representative, if applicable).

Madrid Protocol:

In order not to block an International Registration while waiting for a potential request for national searches, the preparation of the Community search report will be launched immediately and the report will be communicated to the holder as soon as it is ready. In cases where the holder has requested National Searches, these will then be transmitted to the holder as soon as possible, after the above mentioned two month period. Transmission of the search reports will take place by mail or through MyPage.