

Case T-128/99

Signal Communications Ltd

v

Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)

(Community trade mark — Word mark TELEYE — Application accompanied
by a claim of priority on the basis of the earlier mark TELEEYE —
Request for correction — Substantial alteration of the mark)

Judgment of the Court of First Instance (Fourth Chamber), 15 November
2001 II - 3276

Summary of the Judgment

1. *Community trade mark — Filing an application for a Community trade mark — Right of priority — Application for a trade mark accompanied by a claim of priority — Examination by the Office of whether all the requirements, both substantive and formal, have been satisfied*
(Council Regulation No 40/94, Art. 29)

2. *Community trade mark — Registration procedure — Withdrawal, restriction and amendment of trade mark applications — Request for correction of a mark — Request directly linked to a claim of priority — Effect on the examination of the request for correction*

(Council Regulation No 40/94, Arts 29 and 44(2))

1. In the case of an application for a Community trade mark accompanied by a claim of priority, made in accordance with Article 29 of Regulation No 40/94, the fact that the applicant's intention is to apply for registration of the same mark as that on which he relies for the purpose of claiming priority does not, as such, mean that there is no point in examining the claim of priority or that a claim of priority could never be rejected because the document evidencing the priority would be compelling for the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) as regards showing the applicant's intention. An application for a Community trade mark accompanied by a claim of priority cannot be accepted automatically on the basis of an absolute presumption that the applicant's intention is to apply for the same mark as that by reference to which he claims priority, but must be subjected to an examination in which the Office considers whether all the requirements, both substantive and formal, have been satisfied.
2. By providing for the possibility of amending a Community trade mark application at the request of the applicant in the cases set out in Article 44(2) of Regulation No 40/94 and under certain specific conditions in order, in particular, to correct errors of wording or of copying, or obvious mistakes, provided that such correction does not substantially change the trade mark, the Community legislature sought to achieve two aims. First, it wished to avoid the difficulties — including the need for the applicant to file a new application — which would be occasioned by an absolute prohibition of amendment of applications for a trade mark. Second, in limiting that possibility by requiring that the amendment should not substantially change the trade mark, the legislature meant to prevent the abuses that might result from a very liberal system of amendment and thus to protect the interests of third parties so far as the availability of signs is concerned.

(see paras 43-44)

Where the request for correction of the Community trade mark applied for is

directly linked to a claim of priority in the sense that the correction is intended to make the spelling of that mark coincide with that of the mark applied for earlier, this factor is one which must be taken into account in construing the requirement, mentioned above, that the

amendment should not substantially change the trade mark.

(see paras 48-49)