

No. 92, December 15, 2004

**MERRY CHRISTMAS
AND
HAPPY NEW YEAR 2005**

1. LAW

European Court of Justice

- The Court of Justice has made available Practice Directions relating to direct actions and appeals.

Please refer to:

<http://europa.eu.int/eur-lex/lex/JOHtml.do?uri=OJ:L:2004:361:SOM:EN:HTML>

Trade Marks

OHIM

- Commission Regulation (EC) No 2082/2004 of 6 December 2004 amending Regulation (EC) No 216/96 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) has been published in the Official Journal of the European Union No L 360/8 dated 7 December 2004. This Regulation enters into force on the 27th of December 2004.

The Document can be retrieved at:

http://europa.eu.int/eur-lex/lex/LexUriServ/site/en/oj/2004/l_360/l_360200412_07en00080011.pdf

- Further to the adoption of Commission Regulation (EC) No 2082/2004 of 6 December 2004 and as per the communication published in the O.J. dated 9 December 2004, the amendments, as per Council Regulation (EC)

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No 422/2004 of 19 February 2004, to Articles 130 (Boards of Appeal) and 131 (Independence of the members of the Boards of Appeal) of Regulation (EC) No 40/94 on the Community trade mark enters into force on the date the Commission Regulation (EC) No 2082/2004 enters into force namely on 27th December 2004.

The communication can be retrieved at:

http://europa.eu.int/eur-lex/lex/LexUriServ/site/en/oj/2004/l_362/l_36220041209en00160016.pdf

Further to the above Regulations the following is made available on ECTA's website (www.ecta.org) in the member's only section:

- Compiled Regulation (EC) No 216/96 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market.
- Updated compiled version of Regulation (EC) No 40/94 on the Community trade mark.

2. OFFICE PRACTICE

- Decision No EX-04-5 of the President of the OHIM of 30 November 2004 concerning the days on which the OHIM is not open for the receipt of documents and on which ordinary mail is not delivered can be retrieved at:
<http://oami.eu.int/EN/office/aspects/pdf/ex04-5.pdf>
- As per Decision No EX-04-4 of the President of the OHIM of 25 November 2004, the following guidelines have been adopted:
 1. Part B, Chapter 13 (Madrid Protocol)
 2. Part E, Section 2, Conversion
 3. Part E, Section 5, LicensesThe decision can be retrieved at: <http://oami.eu.int/EN/office/aspects/pdf/ex04-4.pdf>
The Guidelines can be retrieved at: <http://oami.eu.int/en/mark/marque/direc.htm>

3. CASE LAW

Court of First Instance

Case No: T-8/03

Date: 13 December 2004

Parties: El Corte Inglés vs OHIM

Concern: Opposition by El Corte Inglés on the basis of various national trade mark registrations including two Spanish trademark registrations for the device mark EMIDIO TUCCI:

- No 1908876 – registered for “Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices” in class 3
- No 855782 – registered for “clothing including boots, shoes and slippers” in class 25

against CTM application No 203570 **Emilio Pucci device** applied for in class 3: “Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair

lotions; dentifrices” ; in class 18: “Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery”. In class 24 “Textiles and textile goods, not included in other classes; bed and table covers”. And in class 25 “Clothing, footwear, headgear”.

Grounds for opposition: article 8(1)(b) – likelihood of confusion; article 8 (5) reputation (in Spain) and article 8(2)(c) well-known.

The Opposition division refused the CTM application in relation to all goods except, “Umbrellas, parasols and walking sticks; whips, harness and saddlery” in class 18 and “Textiles and textile goods, not included in other classes; bed and table covers” in class 24. It was considered that the marks were visually and phonetically similar. The ground on reputation was rejected due to lack of evidence. However, it considered that there was sufficient evidence to demonstrate that the mark reached a substantial part of the Spanish public and to acquire a “higher than normal distinctiveness” in relation to clothing for men in Spain.

Both parties appealed and the Board of Appeal dismissed the appeal as far as the goods of classes 3, 24 and 25 are concerned as well as “Umbrellas, parasols and walking sticks; whips and saddlery in class 18. It however, annulled the decision as far as “leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins; trunks and travelling bags“ of class 18 are concerned.

Most relevant paragraphs:

The main discussion concerns the degree of similarity between the goods of classes 3 and 25 as registered by the earlier rights and the goods of classes 18 and 24 as applied for in the opposed CTM application.

The court considers that the goods of classes 18 and 24 are not, in principle (refer also to § 44 and 46-55), sufficiently similar with those of classes 3 and 25 so as to conclude that there is a likelihood of confusion as to the commercial origin of the goods in the Public’s concerned mind even where the signs are similar. (45)

The court confirmed that opponent did not sufficiently evidenced that its marks acquired reputation. (73)

Outcome: The appeal is dismissed.

The decision can be retrieved at:

<http://curia.eu.int/jurisp/cgi-bin/form.pl?lang=en&Submit=Submit&docrequire=alldocs&numaff=&datefs=&datefe=&nomusuel=&domaine=INTE&mots=&resmax=100>

4. ECTA NEWS

11th OAMI Users Group Meeting

- On November 29, 2004, João Peireira da Cruz (Chairman of the OHIM Link Committee) and Sandrine Peters (ECTA-Legal Co-ordinator) attended the **11th OAMI Users Group Meeting** held in Alicante.

The following can be reported.

1. The main events, the Office has been faced with since the last OAMI User's Group Meeting (February 2004) are the enlargement to the 10 new member countries on May 1, 2004 and the accession of the EU to the Madrid Protocol as from October 1, 2004.
2. The OHIM is still waiting to be officially notified of the decision of the Court of First Instance No T-116/03 dated November 9, 2004 - Oreste Montalto vs Council – which annuls Council's decision dated May 23, 2002 nominating the President of the Boards of Appeal as well as the instructions from the Council as to further action to be taken in this matter.
3. The Office reviewed the current status of the activities of the Office in general and these can be summarized as follows:
 - On the Madrid Protocol:
 - In October 2004, the OHIM received 187 Madrid Protocol applications based on a CTM and expects to receive approximately 1,500 applications per year
 - Further, for the time being the OHIM has been notified by WIPO of 4 designations but 300 seem to be in the pipeline. The countries of origin are mainly, the US, Switzerland, Australia and the Benelux. It is hoped that 20% of trade mark applications covering the EU will be filed through the Madrid Protocol system in 2005.
 - The Office has reached its target in processing applications namely on formality checks, classification, examination, searches, publication, the rendering of decision by the opposition and cancellation divisions. Having eliminated the backlog on classification and nearly on examination, the Office has reached a normal workload in these fields.

However, the rendering of opposition decisions remains a problem. No amelioration is to be foreseen in 2005 in view of the amount of trademarks published in 2004 (namely about 70.000). The Office will nevertheless look into this matter. Its expectations for 2005 as far as oppositions are concerned is to render about 4.000 decisions and to remove old files (namely more than 15 months old) by January-February 2005.

Some figures on opposition:

- 18% of the published applications are effectively opposed (some of them are faced with multiple oppositions).
- 75% of these opposed applications are settled during the cooling-off period. On average cases remain in the cooling-off period about 235 days and in 90% of the cases, the cooling-off period, does not exceed 22 months.
- Presently there are about 6.600 oppositions in the cooling-off period and 3.400 in the adversarial proceedings where, on average, about 200 are under suspension.
- In adversarial opposition proceedings, once the case is ready for decision it takes about 500 to 600 days for the decision to be rendered.

- About 1.100 cases are appealed to the Board of Appeal.
- It has been drawn to the Office's attention that there seem to be failures in notifying oppositions. Indeed, it appears that some applicants become aware of the filing of an opposition by checking the Office's website and are not officially notified of these oppositions. The Office was unaware of the problem and promised to have a look into it.
- It has been asked to the Office whether they were considering permitting opposition decisions being taken by a single examiner in simple matters. The Office replied that they were looking into this matter but that it would nevertheless render the decisions in chronological order.
- The Office has been questioned on the status of the trade mark applications ready for registration and of which payment of the registration fees have been requested in May and June 2004.
The Office reported, that they are indeed faced with major IT problems in this connection, which does not permit them to proceed with the final registration and publication. Unfortunately, the Office is not yet in a position to say when the problem will be resumed and the trade mark applications finally registered.

4. User's Satisfaction Measurement

As reported in ECTA Flash 88, the Office has proceeded with a Pilot project on the "User satisfaction Questionnaire".

The Office asked the collaboration of 11 NGO's and received 39 completed questionnaires of which 9 were from ECTA. The results thereof are that the overall satisfaction is "just about adequate", and that the users do have two main concerns namely the speed of service (and harmonization) and the availability of the staff.

The full survey is expected to take place in Spring 2005 and will not only cover the Community trade marks but also the Registered Community Designs.

Further to the user's concerns, it was explained that the following measures have taken or are to take place:

- An increase from 6 to 9 persons at the information desk of the Office.
- The publication of the name and phone numbers of the examiners on the Office's website.
- To create information points in the different departments (details to be made available on the Office's website).
- As per ECTA Flash 91, the Office has created a new special unit called the "Customer Care Unit" responsible for dealing with complaints. Complaints will be dealt with and response will be given within 15 days.
- It is intended to have a monthly publication on the Office's website giving information on the quality and speed of actions taken by the various departments of the Office.

5. E-Business

- Current situation:
 - In July 2004, the new CTM-Online has been launched and further developments namely, the introduction of information relating to both

incoming and outgoing registration processes and further search criteria have been made reality on November 29, 2004.

- In principle, as from 7 December 2004, a new CTM e-filing system will be launched which will provide the definitive filing application number immediately and an acknowledgement of receipt the same day of filing. It will further be linked to the EuroAce Classification database, which includes about 20.000 expressions of goods/services.

The use of the EuroAce classification will guarantee to the applicant the correct classification and all those applications (filed electronically or not) including the EuroAce expressions will no longer be examined on classification.

- "My-page", allowing, among others, users to keep in mind all earlier searches should be launched by the end of this year.

- 4 projects for 2005
 - Availability of the search reports on-line – most probably as from January 2005.
 - RCD on-line – expected to be ready by the summer 2005
 - On-line access to CTM-files – expected to be ready by mid 2005
 - E-opposition
- Projects beyond 2005
 - e-payment – to be ready by the latest at the time of the renewals of CTMs
 - e-person – to be ready by the latest at the time of the renewals of CTMs
 - RCD e-filing improvements
 - E-renewal

6. Status on the Business to Business developments

Today only one software company has proceeded with the necessary developments enabling the Business to Business filing process of CTMs and has proceeded with some tests.

7. The Community Trade Mark

- The draft amendments to the Implementing Regulation
 - The Commission's representative explained that it was still under discussion in the Trade mark and Design Committee, the next meeting of which will be held on January 17, 2005.
 - Despite the Office's arguments, there was nearly unanimity through the NGO's that there should be no limit to the extension possibilities of the Cooling-off period.
 - It was confirmed that the Implementing Regulation should permit on intermediate steps in the decision process – please refer to the proposed new rule 20.4 CTMIR (and Article 57.2 of the CTM Regulation).

- A lot of concerns have been raised by various NGO's regarding the proposed rules on conversion. The Office as well as the Commission's representative have taken note of the concerns and promised to take them into consideration whenever appropriate.
- Priority and Seniority documents

The Office has informed NGO's that it is intended to further alleviate the documents to be provided for supporting priority and seniority claims. Indeed, whenever official databases will be available it will no longer be necessary to provide supporting documents.

The NGO's have raised their concerns as regards the evolution of these databases and the fact that the information therein might not be kept for ever.

The Office pointed out that, the current documents in the files only show that at the time for claiming seniority, the claim was valid but does not mean that it is still valid at the time it is looked upon.

8. Case Law

- The Office confirmed that it will provide users with a practical note further to the Heidelberger Bauchemie GmbH case (No C-49/02 dated June 24, 2004) on Combinations of colours marks that it made further to the Libertel Case. Despite the fact that a final position has not been taken yet it can be said that the Office will apply the requirements set by the case and will probably enable already registered marks to be amended so as to comply with the requirements as laid down in the decision.
- Interpretation of Article 73 of Community trade mark regulation further to ECJ decision No 447/02.
The Office confirmed that it has already slightly changed the Office's practice so as to ensure that applicant be well informed of all reasons for an examiner to object to the application and giving him the opportunity to comment on it.

9. Community Design

The filing of Community Designs is increasing and where the Office was receiving about 44 designs a day in 2003 it is currently receiving on average 57 designs a day.

Today, 44 design applications have been refused for registration.

The applications are mainly originating from Germany (25%), Italy (15%), the US (9,6%) and United Kingdom (9,12%). It is to be noted that if the US is still in the third position, in 2004, applications originating from the US have decreased by about 25 %.

About 77% of the community design applications are originating from the EU where only 63% for the community trade marks.

Invalidations:

- 12 decisions have been rendered today and none have been appealed. In 8 cases, the design registration has been declared invalid.
- In total, 58 requests for invalidation have been filed (1 out 1.000 registrations)

It has been suggested to the Office to provide a summary of the decisions available in all the languages. The Office promised to consider this suggestion.

Regarding the problem of signs applied under the community trade mark system and the community design system, the Office confirmed that they only apply the law and permit the registration under both systems. However, the Office is working in ameliorating the search availabilities of these signs namely by adding the Vienna classification for community trade marks and permitting the search on verbal elements of registered community designs.

The Office further informed the NGO's that it has set up a user's group to help the Office to develop the search system of RCDs the first meeting of which was held last September.

10. Other legislative issues

- Reimbursement of registration fees for international registrations designating the EU. The Office confirmed having amended the draft Guidelines in this connection so as to permit the reimbursement of these fees in all circumstances where the mark is washed out before "registration".
- The Commission's representative informed NGO's that the Trade Mark and Design committee unanimously agreed on the draft rules of the procedure of the Board of Appeals and the final text will now be prepared for adoption.
- It has been confirmed that discussions on lowering the official fees are going on and the budget department of the OHIM made its first proposals to the Commission last month. The Office suggested lowering the application, registration and renewal fees as well as the "Madrid Fees". To raise somewhat the opposition and invalidation/cancellation filing fees and provide a discount fee for e-filings.
- In connection with Directive 2004/48/EC adopted on 29 April 2004 on the enforcement of intellectual property rights, the Commission's representative informed NGO's that the Commission will provide a statement as to the interpretation of what is an IP right as per article 2 of the Directive, most probably by the end of the year.
- Commission's representative confirmed Commission's intention to work on the creation of a "judicial panel" at the European level dealing only with trademark cases in accordance with Articles 225, 225a and 229a (amended or inserted by the Nice treaty) of the EC treaty.

The "judicial panel" consists of a special chamber of the CFI. The decisions of the chamber can be appeal to the CFI and in very rare circumstances can further be appealed to the ECJ.

For a better understanding of what consists a Judicial Panel please refer to two Proposals on the Community Patent Jurisdiction:

http://europa.eu.int/comm/internal_market/en/indprop/patent/index.htm

An important difference with a "Community Trade Mark and Design Court" could be that the "Community Patent Court" will also deal with civil law litigation.

Please note this being an unofficial report to provide members with the information as soon as possible and ECTA will provide you the official report made by the OHIM upon receipt.

Reported by João Peireira da Cruz, Chairman of the OHIM Link Committee, Portugal and Sandrine Peters, ECTA Legal Co-ordinator

SPAIN - Technical Seminar on the Madrid System

On 15 and 16 November 2004, the World Intellectual Property Organization (WIPO) and the Spanish Patent and Trademark Office (SPTO) organised in Madrid a Technical Seminar on the Madrid System with the participation of Ernesto Rubio, Assistant Director General of the WIPO, and Teresa Mogín Barquín, Director of the SPTO.

Indepth information on the system, as well as strategies for its efficient use were presented. The Seminar concluded with useful practical exercises and a final presentation by Ernesto Rubio on the Perspectives for the Future Development of the Madrid System. The WIPO's objectives are to increase the number of contracting parties, to increase the volume of activity, to modernise the managing of the system and to offer additional services.

Last but not least, Ernesto Rubio informed of the WIPO's wish to modify the legal frame of the Madrid Protocol according to its article 5.2. e) in respect of the refusal and invalidation of effects of International Registration, and also in respect of article 9 sexies relating to the safeguard clause. Any modification would require an unanimous decision of the Assembly. There are studies in course at the WIPO and a working party will be set to start discussions as from July 2005. NGOs will be invited as observers in the working sessions and ECTA will be one of them. The Assembly will convene at the end of 2006.

Reported by Mireia Curell, ECTA First Vice-President

- On January 17, 2005, the **OHIM Link Committee** is meeting **OHIM officials** in Alicante (Spain).

5. COMMUNICATIONS

- COMMISSION REGULATION (EC) No 1891/2004 of 21 October 2004 laying down provisions for the implementation of Council Regulation (EC) No 1383/2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, is now available at ECTA's website in the member's only section: www.ecta.org.