



European Communities Trade Mark Association

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Confirmation by mail.

Antwerp, 2 November, 2004

Dear Mr. Jakobsen,

Concern: Draft for Part E.5, Licences, of the Guidelines concerning proceedings before the OHIM.

We refer to previous correspondence in this matter and more specifically to our letter dated 29 September 2004.

As you know the Design and Law Committees were to meet during ECTA Council meeting in Copenhagen on October 21 and 22, 2004 where they further discussed the guidelines.

We hereby would like to provide you with the following additional comments on the guidelines:

1. When commenting at the bottom of page 3, the top of page 4, on the consequences of recording a license in the Guidelines, clear reference should be made to Rule 36.2 of Implementing Regulation 2868/95 of 13 December 1995, according to which when a license has been registered, the proprietor of the Community trade mark cannot surrender his mark without the consent of the licensee or before three months have elapsed from the date on which said proprietor has informed the licensee of his intention.

2. Further down on page 4 it is mentioned that the holder of an unregistered license may nevertheless avail himself of the rights set out in the CTMR. The references to article 22 are incorrect. Indeed, paragraph 2 of this article sets out the rights not of the licensee but of the proprietor of the CTM. And paragraph 3 of this same article refers not to the rights of an unregistered licensee but, on the contrary, to the rights of the holder of an exclusive license to bring court action to defend the licensed CTM in the event that the proprietor fails to do so.

Mention, however, is not made of the key rights that the holder of an unregistered CTM license has, for example, to file opposition (article 42.1 of the CTMR) and to file both absolute and relative invalidity actions as well as revocation actions (article 55.1, subparagraphs a, b and c).

The Guidelines could mention, instead of the incorrectly cited ones, the above rights, which may be exercised without any need to record a license (for example, the right of the licensee to lodge an opposition or an invalidity action on the basis of a licensed trademark), which in some cases do not exist under the national laws of some EU member states.

3. Regarding the statement made on page 11 of the Guidelines to the effect that "where the request for registration of the license is signed by the representative of the proprietor who has already been designated as the representative for the CTM in question, the requirements relating to signature and authorizations will be fulfilled." In this regard, we believe that it should be clarified as to whether those requirements will likewise be considered fulfilled in the event that the signer is a representative for the CTM proprietor but not the recorded representative for the CTM in question.

4. At the bottom of page 11 - top of page 12 of the Guidelines, although it is clearly specified what would happen in the event that the OHIM were to have any doubts as to the veracity of the documents submitted by the licensee when petitioning the registration of the license, no conclusion is drawn in relation to the likely case in which the OHIM becomes convinced of the veracity and authenticity of the license submitted as evidence. While it may be assumed that the proprietor of the CTM will not be able to refuse the registration of the license petitioned by the licensee, this should nevertheless be expressly stated to avoid problems.

5. Lastly, as for the forms, we believe that there is missing a draft notification referring to the refusal of a petition to register a license that clearly contravenes an earlier-registered right. We say "clearly" since the contravention would come to light simply by reading the information indicated on the petition to register the license, such as, for example, an indication relating to the exclusive nature of a license, without it being necessary for the Community Trademark Office to closely study the license. It would be logical for the OHIM to refuse to register an exclusive license when another already stands as registered. Thus, unless expressly regulated elsewhere, this practice could be reflected in the Guidelines.

We hope these additional comments are helpful and remain.

Yours sincerely



Max OKER-BLOM
President of ECTA



Sandrine PETERS
ECTA Legal Co-ordinator
On behalf of the Law and Designs Committees