



European Communities Trade Mark Association

Antwerp, 28 June 2007

**ECTA's OBSERVATIONS ON  
THE DOCUMENT PREPARED BY VINCENT O'REILLY IN RELATION  
TO PROFESSIONAL REPRESENTATION AND MADRID DESIGNATIONS OF THE EC**

**Preliminary remark**

As expressed earlier during the meeting of the OHIM Users Group on 9 March 2007, ECTA once again thanks the OHIM for raising the issue on the problem of its direct communication with applicants.

ECTA voicing, among other things, the views of professional representatives would, however, like to raise again a preliminary remark on the comments provided by the OHIM regarding the reference to "unexpected services from representatives."

Indeed, ECTA considers that referring to this possibility as part of the discussion on how best to communicate with the users is totally inappropriate. By doing so, the Office is interfering in the "representative-client" relationship. It is up to the client to choose the most suitable representative according to its needs and expectations; clearly, a client not wanting a specific service is free to inform its appointed representative accordingly or to change representative.

The OHIM should only address its own relations with the users of the system that include both direct applicants and their representatives.

**Observations on the other points raised in the subject text**

ECTA believes that it is the legal aspect of the subject matter and the needs of the users that should prevail when considering these issues rather than the "convenient administrative arrangements for the office".

Also as the OHIM recognizes under point 3.3.0 "Absolute grounds and oppositions" the issue here is of the most importance.

1. Rule 17 (notification of provisional refusal) of the Common Regulation under the Madrid Agreement and Protocol provides that:

*(a) A notification of provisional refusal may comprise a declaration stating the grounds on which the Office making the notification considers that protection cannot be granted in the Contracting Party concerned ("ex officio provisional refusal") or a declaration that protection cannot be granted in the Contracting Party concerned because an opposition has been filed ("provisional refusal based on an opposition") or both.*

In view of this Rule it is clear that absolute grounds and oppositions notifications should be made by national/regional offices through WIPO.

2. Nothing is said in Rule 17 in relation to formal deficiencies (such as seniorities...) or to searches. However, ECTA understands that Rule 17 should be applied mutatis mutandi in these cases as well.

In the event that WIPO were not willing to intervene in regard to these searches, for doing so is not provided for under Rule 17, ECTA believes that the results of these searches should be sent to the WIPO representative or, if there is no representative, to the applicant directly.

Obviously, in the event that there is a designated representative before the OHIM, any communication and other incidents arising during the prosecution of the international trade mark at the OHIM should be sent directly to said representative.

From a practical standpoint, the direct transmittal to the applicant of the search results and of other communications could give rise to the missing of relevant information or even to the missing deadlines. Indeed, the OHIM does not know whom to address the letter within the applicant company and the automatic transmittal of this communication to said company does not in any way guarantee that it will reach the proper person, and even if it does, it might arrive too late.

ECTA trusts that these observations prove useful and that the OHIM will take them into account.

Yours sincerely,



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President



Doris Bandin  
Chair of the Law Committee