



European Communities Trade Mark Association

**Unofficial Report of the 15<sup>th</sup> Meeting of the OAMI Users Group**  
**Alicante, 3 March 2008**

**NGOs represented:**

AIM – APRAM – Business Europe – CNIPA – ECTA – EFPIA – FICPI – GRUR – ICC – MARQUES - UNION

This report will only deal with matters not already reported

- at the OHIM-Link meeting held on 15 February 2008, the minutes of which can be found on ECTA's website at: [http://www.ecta.org/com8\\_pp.php](http://www.ecta.org/com8_pp.php)
- and at the meeting with the Commission held on 29 February 2008, the minutes of which can be found on ECTA's website at: [http://www.ecta.org/position\\_papers/2008-02-Commission.pdf](http://www.ecta.org/position_papers/2008-02-Commission.pdf)

**1. User Satisfaction Survey 2007: Results, Follow-up**

a) Presentation of USS 2007 Results

A presentation of the 2007 User Satisfaction Survey Results was given. The results will shortly be made available on OHIM's website under the Users' Corner section.

It is to be noted that OHIM received an 8% response rate to the questionnaire. The result shows that in 2007 there was an increase in overall satisfaction. However, there was a general decrease in satisfaction with the e-business tools as far as speed is concerned.

b) OHIM Service Charter

A presentation was given on the OHIM Service Charter – [See ANNEX 1](#)

c) OHIM Quality Management system

Further to questions raised, OHIM indicated that the Quality criteria of decisions Service Standards are available on OHIM's website at: <http://oami.europa.eu/en/userscorner/cons.htm> by clicking on the links in the last column.

OHIM confirms that there are still problems in the Measurements but that they will work on it.

OHIM further indicated that they are presently, and have been for 3 months, systematically reviewing decisions taken by the examiners and that a report on this should be made available in April 2008.

It is to be noted that wrong decisions include matters such as cases where the examiner did not use the spell check or a specific template.

**6. Alterations to Legislation**

a) Commission's communication on CTM fees: current status & next steps

See minutes of the OHIM-Link meeting and of the meeting with the Commission of 29 February 2008.

- b) Optional Searches: current status & next steps

See minutes of the OHIM-Link meeting and of the meeting with the Commission of 29 February 2008.

## 7. E-business

A general presentation on the state of projects (including EuroRegister) was given.

See minutes of the OHIM-Link meeting.

Regarding the EuroRegister project, see also the presentation under [ANNEX 2](#)

## 8. The Community Trade Mark

- a) Specification of goods: Interpretation of “namely” in the specification of goods

Question:

Many US specifications used in CTM applications use this type of wording. It would be useful to know the exact OHIM interpretation of this, so that infringement can be evaluated and also because the UK always interprets “namely” as being a limiting factor, which seems not always to be consistent with OHIM. What exactly is the interpretation of OHIM of the word “namely” when used in the specification of goods?

Response:

Namely is a limiting term.

- b) Proof of acquired distinctiveness after *Europolis*

Question:

From this decision of the ECJ and the more recent CFI decision concerning the protection of a glass surface (CFI, Case T-141/06), it follows that acquired distinctiveness of a CTM should exist throughout the EU. The evidence concerning distinctive character acquired through use needs to be examined for each Member State separately. Is OHIM of the opinion that there is a need to actively prove acquired distinctiveness in the 27 Member States?

Response:

This question could be included in the study on the Trade Mark systems to be launched by the Commission.

It is OHIM's view that we should look at markets rather than on a country-by-country basis.

- d) Genuine Use

Question:

OHIM's position concerning genuine use within the meaning of Article 15 CTMR has been very clear so far: genuine use in one Member State constitutes genuine use in the Community, respecting Joint Statement no. 10. Are there any changes in this position, particularly after the extension of the EU with new Member States?

Response:

For the time being, OHIM will follow the Joint Statement unless case law provides for other guidelines.

Question:

Use of Class Headings and the enforcement of OHIM communication no. 4/03 – Proof of Use and Use Requirement.

Response:

OHIM confirms that there are some differences in practice in relation to other national offices. However, this is the way OHIM has always proceeded.

OHIM will discuss this further with the national offices at the liaison meetings.

- e) New CTM applications after the expiration of the non-use grace period

Question:

Does OHIM have a position with regard to this problem?

Response:

Please refer to point 4.3.3. of the cancellation guidelines, which states that:

“Where the proprietor of a CTM makes repeated applications for the same mark with the effect of avoiding the consequences of revocation for non-use of earlier CTMs, whether in whole or in part, the proprietor is acting in bad faith. “

- f) Opposition

Question:

Generally speaking, users have noted an improvement in the time limits for various proceedings before the Office. Nevertheless, the time taken (especially in opposition proceedings) remains too long: delays in communicating the observations of the adverse party, failure to notify the other party, when a party requests an extension of a deadline in order to submit observations or evidence, delays in taking the decision.

Response:

OHIM is aware of the problem and will work on improvements.

See also the minutes of the OHIM-Link meeting for this question and other questions.

Question:

The obligation to submit two copies of documents in *inter partes* proceedings.

Response:

OHIM drew the audience's attention to the fact that the documents could also be provided on a CD-Rom as long as it is in a standard format.

Question:

OHIM's practice for opposition proceedings for pharmaceutical trade marks - difference in treatment between pharmaceutical marks and other marks.

Response:

OHIM does not consider that it deals with pharmaceutical trade marks and other marks differently.

Question:

Problem of retrieving the costs awarded at the end of opposition proceedings.

Response:

See the minutes of the OHIM-Link meeting and of the meeting with the Commission.

g) OHIM database for similar/dissimilar goods and services

Question:

Last year discussions were pending about the development of such a database. What is the current status? Would such a database be accessible for users?

Response:

OHIM started to work on this database but finally decided to rethink how to do so in the future, which has caused some delay.

The Office will create this database in order to help examiners and will make it available to the public, but does not know when.

h) Requests for Extensions

Question:

OHIM's response to the request for an extension can be late and is sometimes even received after the expiration of the deadline. In such situations it seems to be common practice that, if the extension is refused, the time between the request and the answer received will be allowed as an additional period after the expiration of the deadline. Is this understanding correct? Is it possible to speed up the process of answering extension letters?

Response:

The Office is giving priority to this matter and confirms the understanding regard the additional period after the expiration of the deadline should the notification not be issued in due time.

i) Guidelines

Question:

It is necessary to inform about changes in Office practice before these changes enter into force.

Response:

The Office agrees and this should be done in the future.

j) Seniority

Question:

Experiences of OHIM with seniority claims and notification to the national offices.  
Can users rely on the accepted seniority claim and not renew the respective mark?

Response:

The answer from OHIM is yes.

However, the Office cannot guarantee that national offices will keep these non-renewed marks on their register.

k) Translations

Question:

Different opinions of OHIM and WIPO in respect of the translation of list of goods of CTMs with designations to Madrid Protocol countries.

Response:

OHIM confirms that not all wordings accepted by them are accepted by WIPO. However, all wordings accepted by WIPO (in EU designations) are accepted by OHIM.

m) Infringement of IPRs

Question:

Possibility of including a link to the Customs Application for action for products that infringe IPRs, and the possibility of putting a similar link into the CTM Application Form.

Response:

OHIM will discuss this internally.

n) Oral hearings

Question:

It is felt that in certain matters, particularly in *inter partes* proceedings, if both parties request it, an oral hearing could positively influence the decision-making process of OHIM. Why is OHIM so reluctant to accept oral hearings and would they be willing to be more open?

Response:

OHIM confirms that it reviews its position regularly bearing in mind users' positions, but it has not yet felt the need to change its position in this matter.

## 9. The Community Design

a) Update

See the minutes of the OHIM-Link meeting.

b) Hague System

See the minutes of the OHIM-Link meeting.

## 10. Boards of Appeal

a) Update

See the minutes of the OHIM-Link meeting.

b) Kaul

Question:

This ECJ decision explains how the BoA should deal with additional evidence submitted for the first time before the BoA. Has this decision changed the BoA's practice and, if so, to what extent? Has this decision affected the position of the Opposition Division towards additional evidence provided by the opponent after having filed its statement of grounds?

Response:

The Offices stated that it has to apply Rule 50 CTMIR. It will not accept completely new evidence; it will be necessary to argue why such evidence should be accepted.

## 11. Miscellaneous

- a) OHIM's new website  
It should be launched in June 2008.
- b) OHIM Cooperation Programmes
  - o Cooperation with NGOs  
See presentation under [ANNEX III](#)
  - o China project  
See presentation under [ANNEX IV](#)
- c) Accessibility policy of OHIM examiners  
See the minutes of the OHIM-Link meeting
- d) Customer Care Unit update  
See presentation under [ANNEX V](#)

Please note that this is an **unofficial** report to provide members with information as soon as possible. ECTA will provide members with the official report made by the OHIM upon receipt thereof.

Reported by Sandrine Peters, ECTA Legal Coordinator