



European Communities Trade Mark Association

Report of the 21st ECTA-OHIM Link Committee Meeting
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1 – Administrative matters

i) The Office and its administration

A study undertaken last year indicated that if all improvements to working methods that are foreseen would be successful, notably concerning automatization and the simplification of various services provided by OHIM, a reduction of its personnel by 120-130 people can be expected within the next few years (by 2011).

This should not only affect the trade mark department but administrative areas dealing for example with fee payments, the registry or the mail dispatch as well as other administrative areas.

OHIM confirmed that it will always employ the necessary human resources needed in order to provide the proper services.

ii) Brief overview of the latest statistics and Business situation

Results for 2007

- Trade Mark filings increased from 77,000 in 2006 to 88,000 in 2007 (including Madrid filings).

About 14% of filings are coming through Madrid.
75 to 77% of filings are made electronically.

- Oppositions increased from 14,100 in 2006 to 16,400 in 2007

It is to be noted, however, that the ratio of the number of oppositions vs the number of published trade marks remains the same – the increase is due to an increase in the number of published applications.

However, over the past 4-5 years the number of cases settled amicably has decreased from 75% to 70%.

- 1,950 Appeals were filed in 2007 and a record number of decisions have been rendered.

No backlog is to be noted in examination proceedings. Regarding oppositions, the Office has been able to cope with the new oppositions but was not able to reduce the backlog.

The number of opposition decisions taken increased from 4,200 in 2006 to 5,200 in 2007.

The Office made serious time frame improvements in 2007.

For instance, serious improvements in post registration services are to be noted as 97% of requests are dealt with within 14 days.

- The number of cancellation actions filed for trade marks increased to 600 in 2007.

- Design filings increased from 69,000 in 2006 to 77,000 in 2007.

Oppositions

1. On average a file stays in key-in/receipt, payment check and admissibility check for a total of 50 days. Regarding admissibility check: a new system has been put in place enabling a reduction from 40 days to 20 days in 2008 for 80% of the files.
2. Cooling-off: on average the cooling-off periods last for 250 days.
3. Exchange of observations: on average this period lasts for 250 days.
4. Decision: improvements have still to be made – on average this period lasts for 300 days (including any suspension).

Quality Measurement

OHIM has started to measure the quality of its work, and strives for a 5% error rate. An error is what is not done in accordance with instructions which may concern format, content or the outcome of the decision. These standards are publicly available in the Users Corners of the website. Every quarter the measurement is made public. The 5% target is not reached.

OHIM notes that the main problem today is the quality of the opposition decisions.

Appeals

The Boards of Appeal underwent some changes in 2007 due to an increase in the workload. For instance, the supporting staff of the Boards has been increased.

It is hoped that more than 1,800 decisions will be taken in 2008.

Paul Maier considers that the decisions are quite coherent and that they are of a good level.

Indeed, 80% of inter partes decisions are confirmed by the Luxembourg courts. In ex parte cases only 2 decisions were reversed by the CFI last year on substantive matters, namely decision No. T 441/05 – “I” IVG Immobilien AG and decision No. T 460/05 for the Bang & Olufsen 3D loudspeakers.

165 Board of Appeal decisions have been further appealed at the CFI. Already 30 decisions have been appealed in 2008.

The Boards of Appeal aimed to be more transparent; see for instance the 2006 Board of Appeal case law review (http://oami.europa.eu/en/office/diff/pdf/BOA_COMPILATION_2006.pdf) published in 2007. The Boards will do the same in 2008 and will improve their search tool.

Financial result

OHIM has a good financial result for the year 2007 and ends with a net profit of 62 million euros.

There is no sign of slowing down in the second half of 2007 and there seems neither to be no sign of weakening demands for 2008 as of to date.

It is to be remembered that all statistics are available on OHIM's website at:
<http://oami.europa.eu/en/userscorner/default.htm>
<http://oami.europa.eu/en/office/stats.htm>

At this stage ECTA and OHIM had an in depth and fruitful discussion on the importance of trade mark registrations being handled properly and in acceptable time frames.

ECTA underlined that this is not only important for the applicant, who needs to be able to launch his good/services on the market as soon as possible and ascertain that he has an effective trade mark, and for the possible opponent, who needs to be able to enforce his earlier rights, but also for any third party that needs to have legal certainty on the situation in the registries.

2 – E-business Programmes

i) Current situation

Oppo Online

This tool should include the possibility of submitting proof of use and extending cooling off periods between the parties automatically and therefore solve the delay noticed presently in the communication by the Office of these extensions to the respective parties.

This should be alive in 2009.

Euromarc ++

This the internal managing tool regulating the CTM flow.

This project is considered as one of the two most important projects for 2008.

The Office is in the test phase and the tool should be alive mid 2008.

This tool will, amongst other things, include a new system for dealing with searches in order to reflect the changes to take place as from 10 March 2008.

CTM and RCD filings

The Office is presently rewriting the tool.

For CTM filings the new version should be ready by the end of 2008 and for RCD filings by the beginning of 2009.

For instance, regarding CTM e-filing, the improvements include:

- the availability of all information on one screen
- pop-up windows resizable
- new sections dealing with conversion and adding the possibility of new attachments (in PDF)
- My Page users will be able to choose their current account from a list of their existing
- The classification check with Euroace will be made directly and the applicant will be informed immediately

- Improvement of the save and restore options – it will be possible to save and return later to the application before submitting the application

Regarding RCD e-filings

- there will be a link between the information submitted and the back office, no retyping by the Office will be needed anymore, which will avoid some mistakes
- the save and restore options will be improved (see above for CTM e-filings)
- will include a credit card payment facility
- the attachment size will be increased to 5MB per design view
- the speed of the system will increase
- direct and automatic notification of the application number (as for CTMs)

There will be more similarities regarding the functionalities and the look & feel between the RCD and CTM e-filing systems.

Business to business system

OHIM underlined that large applicants only represent 5 applications a day for OHIM!

ECTA underlined that this is not an excuse not to consider them seriously.

ECTA further underlined that in order for these large applicants to make the investments to use the Business to Business system there is a need for a stable platform.

Finally, ECTA underlined the necessity to be more transparent on this subject.

New OHIM website

Should be alive in the second quarter of 2008.

New version e-communication

Could be ready by the second half of 2008.

New version Mypage

This project has been put on hold as there is some discussion on using a new architecture. In the meantime an audit has been launched to detect “quick wins”

e-caveat

The tool is expected to be ready by the end of 2008.

e-certificate

Automatic downloading of certificates from website.

The tool is expected to be ready by the fourth quarter of 2008 as far as CTM are concerned.

e-certification

There is the question of the usefulness of the documents produced. In order to resolve this question, OHIM will propose a range of solutions, from the pure

downloading by users of certified documents with a solid look & feel to real electronically certified documents (valid as long as they are kept in an electronic environment).

This tool should not be ready before 2009.

euroclass

In the second quarter of 2008, the tool should be extended to the Czech Republic and Portugal.

In the third quarter of 2008, the tool should further be extended to Poland, Finland, Hungary and **Germany**.

Also, contrarily to previous statements, Spain prefers not to be a party to this tool for the time being.

euroRegister (working name)

By the end of 2008 it should include the databases of: Benelux, Denmark, Italy, Portugal, United Kingdom, Czech Republic, WIPO and OHIM.

All other members of the EU should be included by the end of 2010.

Online inspection form

The Office is waiting to see the consequences of the online inspection of files before further developing this tool.

3 – Alterations to Legislation

- i) Commission's communication on CTM fees (Update on further developments/Impact assessment).

The Office is still waiting to hear the Commission's proposal on fee reduction.

The reason for the time taken in order to obtain this proposal is due to the impact assessment which has to be performed and the results of which are not to be expected before April or even later.

Drafting this impact assessment is difficult as they want to see what the impact on the national offices will be.

- ii) EU accession to the Hague Agreement – First impressions on the accession that became effective on 1 January 2008.

WIPO received 54 EU designations in January but OHIM has not seen any of them yet as none of them has yet been published.

4 – Community Trade Marks

A – The Community Trade Mark

i) Colour marks

On the filing forms and on CTM Online, applicants are only asked to indicate the colours claimed. However, it is observed that in some marks the representation has many colours, but only a part of them are claimed. Rule 3.5 stipulates that "the colours making up the mark shall also be indicated in words". In the light of this provision, is it possible to only claim part of the colours shown in the mark? If so, the parts to which these colours apply should be specified by submitting a description of the mark according to Rule 3.3.

According to OHIM there is no legal basis for requesting that applicants indicate which colours apply to which part of the mark. Rule 3.5 obliges the colours making up the mark to be indicated in words.

Further, the description is always accompanied by the representation of the mark where all the colours are depicted.

ii) Deficiency Notices on goods and services - Status on the improvement of the classification process, quality and consistency as discussed at the last meeting.

OHIM started to measure the quality of classification one year ago.

In the beginning a 10% error rate was shown, which has now already been reduced to 7%.

The Office is working to create awareness among the examiners and noted that the main problems lie in the incorrect use of the Euroace tool and the lack of consultation of the reference materials available.

The Office therefore provides education and is evaluating the possibility of creating a special classification unit.

iii) Classification

As regards the classification process, it would seem that current OHIM practice only provides for two classification opportunities. If the reply to the first objection does not satisfy the examiner, it must be understood that the second notification (requesting clarification, re-classification or amendments) will be final, given that if the examiner continues to deem the reply inadmissible, we are faced with a total or partial refusal, depending on the case, making it necessary to appeal.

Is this correct? If so, it seems that applicants/representative should be advised properly of this practice.

The Office confirmed that as a matter of principle it does not like refuse an application on a classification issue.

As to the number of opportunities to defend, this depends on the objection and on the response provided by the applicant. If the applicant does not provide anything new in his response, the exchange of views stops.

The Office confirmed that there is no a priori rule on how many times an applicant can provide arguments.

The Office further confirmed that some examiners telephone applicants in order to settle the case.

iv) Searches

1. Status on the changes to take place as from 10 March 2008 including the decision of the OHIM Budget and Finance Committee on the fees for searches.

As of to date it seems that 17 countries perform searches . It is to be noted, for instance, that Benelux will be out but that Malta will be in.

The OHIM Budget Committee decided to increase to 16 euros the amount to be paid to the national offices providing searches.

In the light of this decision and in order to keep the income and outcome of the searches equal, the Commission proposed and discussed on 15 February setting the level fee for the searches at the same amount and therefore increasing the search fee from 12 to 16 euros.

This was not accepted by the working group on comitology (which includes representatives of the member states and who provide an opinion): 2 countries said no and 14 only were in favour; the others abstained.

The next possible step could be that the Commission takes it to the Council for decision, but we do not know yet whether it will do so. Would this be done, a decision would not take place before 10 March 2008.

2. Has OHIM reconsidered the possibility of, as from 10 March 2008, requesting searches subsequent to the filing of the application?

OHIM has no decision power on this matter.

3. In principle, the information notices from OHIM on the publication of younger CTM applications (Art. 39 (6) CTMR) are a very helpful tool.

However, in recent months members observed that they receive these notices in respect of non-renewed CTMs.

This is a waste of both time and money, which could be spent otherwise, eg for an IT link between the publication database and the CTM database. In that context it is quite likely that non-renewed CTMs are mentioned in OHIM's search reports, which of course distorts the actual search result.

OHIM agrees with the way of doing but underlined the fact that we should not omit the grace period and that they need some time to process the searches, which means that they need a 10 month gap.

v) Disclaimer

A member noted that OHIM recently registered a CTM (No. 550 0624 dated 13/11/06 – mobil.info) with a disclaimer requested at the time of filing.

Does this mean that there is a change in practice at OHIM regarding the acceptance of disclaimers?

Would OHIM accept this disclaimer? What is the value of this mark according to OHIM? Is the protection linked to the graphical presentation only, as the disclaimer states that « aucun droit n'est revendiqué sur les mots 'mobile' et 'info' »?

OHIM confirmed that there is no change in practice but that they do accept voluntary disclaimers except when this makes no sense, as for example when the disclaimer refers to an element that is not included in the mark..

vi) Article 7.1.(g) trade marks of such a nature to deceive the public

It is some applicants' impression that the Office hardly ever applies this absolute ground for refusal.

Further, it seems that when rejecting some trade marks for some goods and services on the grounds of Article 7.1.(c), the Office accepts other goods and services falling under 7.1.(g).

For example, in R746/2005-4, CTM No. 3.958.477 "TIKKA TIKKA", which in Finnish means "dart game", was rejected for goods in classes 29 and 30 and granted for goods in class 28 for games other than "dart games". It seems obvious that if the mark is descriptive for dart games, it is deceptive for games that are not dart games.

The same criterion was applied in R285/2006-4 "BUSINESS SIGNATURE", where CTM No. 4.303.962 "BUSINESS SIGNATURE" was rejected for "apparatus for recording, transmission or reproduction of sound or images, etc." for being descriptive, but was granted for "recording discs, when for these products it should be considered deceptive.

In fact, in many cases, an expression that is too descriptive to be protected when applied to some goods, automatically becomes deceptive when applied to goods that do not have such characteristics.

We discussed this issue with respect to the EUROPIG decision (T-207/06 - Europig v OHIM 14.06.2007) at the last OHIM-Link meeting. Also, it has been included in ECTA's programme for Killarney.

What are OHIM's views on this continued problem?

The Office noted that there cannot be any automaticity in this regard. It is not the case that because a trade mark is descriptive for some goods that it is deceptive for other goods.

The Office, however, confirms that only few marks are refused for deceptiveness.

Regarding the TIKKA case, it is the Office's opinion that the mark was indeed descriptive for the goods rejected but not deceptive for the others. This is obvious in this case that it is not deceptive to use the mark TIKKA for a football.

vii) Limitation of Goods and Services

Some applicants seem to be confused with the following practice:

In case R556/2005-1 OHIM did not accept the restriction "pharmaceutical goods available only under prescription".

However, in decision R391/2003-2 rendered by the Opposition Division, in §20 the Office accepts that there is a difference between the goods because the pharmaceutical goods of one mark are sold under prescription while not those of the other mark.

Is there not a contradiction?

The Office underlines that the wording used in the limitation of a list is not the same as the concept used as an argument when taking a decision. Limitations of list of goods and services have to conform to the ECJ jurisprudence in the POSTKANTOOR decision (C-363/99) which foresees that goods cannot be registered only if they do not have a particular characteristic. Neither can the method of selling the product be an element of the list of goods and services.

However, the arguments can be used in order to defend a case, such as whether a good is made available only under prescription or not..

- viii) Opposition and Examination Guidelines and the possibility of having an unofficial but regularly updated version of the guidelines on OHIM's website.

Update on developments since the last meeting and further to the adoption of the Opposition Guidelines.

The President adopted the guidelines after having consulted the Administrative Board.

The Office hopes to put online, by the end of the month, a manual of Trade Mark Practice which contains 96-97% of the content of the guidelines as per today. For the rest, it will already contain some changes that have taken place since the adoption of the guidelines.

The Office is aiming to avoid the use of practice notes and gives preference to a single document that would always provide the present situation – including all modifications.

- ix) Communications in Opposition proceedings

1. Some members noted that too often OHIM sends notifications and the like stating that other documents are enclosed. However, there are no enclosures, or the enclosures are the wrong ones. One of the latest example is in opposition no. B782997, where a letter from the counter party was not included, though stated in the notification.
2. Some members are also confused with some communications, such as for example in the opposition no. B 1229410 where the opponent received a communication stating that he had to substantiate all earlier rights before a certain date. As copies of relevant registration certificates and translations of these documents had already been filed when this communication was received, it is not easy to understand what else to substantiate. The communication is dated 5 November 2007. Since then, the opponent has sent several faxes to the relevant person with OHIM and asked for clarification. A response is still awaited at the date of drafting this agenda.

The Office confirmed that this should not happen.

Withdrawals and extensions are to be dealt within 1 week and all other communications within 3 weeks.

Also as to the notifications, the Office underlines that this is a standard letter only and that perhaps this should be made clearer.

x) I. Automatic extensions in opposition proceedings

One of our members has been told that OHIM, on the basis of a Communication by the President (9/2007) apparently grounded on article 119(2) CTMR and unpublished, justifies the grant of automatic extensions of time in opposition proceedings without due cause and without informing the other party to the proceedings.

In particular, this practice of granting automatic extensions has been applied by OHIM even when the party is the opponent and had already failed (according to Rule 19) to substantiate the opposition, and after OHIM had given it extra time to remedy such failure.

Moreover, when the opponent asked for a further extension, this was granted and as a result, a clever opponent may block registration of a CTM even on the basis of a bogus right for more than one year. (Reference to this case can be provided if necessary.)

As we see it, there are at least 2 issues we would like to be discussed:

1. How should OHIM apply Rule 19? In other words, since the details indicated in Rule 19 are extremely important for the applicant to understand the merits of the opposition and or make a decision as to the viability of the CTM application, should OHIM insist that the time limits set by OHIM are of the essence and therefore, save for absolute exceptional circumstances, failure to timely comply should not be allowed to be remedied?

The Office confirmed that there is no automatic extension and that requests are to be made by the parties.

Only in exceptional circumstances will the Office provide for some extension on its own initiative.

Indeed, as a matter of principle, OHIM has no means to extend deadlines.

2. Does article 119.2 CTMR, which only seems to give the President administrative powers for the functioning of the OHIM, also grant him the power to derogate or change terms set by the CTMR and/or IR?

This article should never be invoked by the examiner or OHIM in these circumstances. No automatic extensions are possible. They also indicate that reinstatement of terms are accepted only for equity reasons.

- II. We drew the Office's attention to a criticism from a member that is worth thinking about. In some cases, Communication No. 1/06 by the President of the Office of 2 February 2006 on extensions of the cooling-off period establishing a new procedure, according to which if both parties request extension it will be granted automatically for 22 months, has led to unnecessary delays in the handling of the opposition by the parties.

This situation is aggravated by the new practice in opposition proceedings established by Communication No. 5/07 by the President of the Office of 12 September 2007, according to which *“In order to avoid repetitive joint requests to continue suspensions every two months, the Office will now ex officio grant the second request for suspension for a period of one year.”* That is, if the cooling-off period is extended, then the parties request suspension of the proceeding, it will go on for 34 months, i.e. almost three years, added to the 3½ years the Office takes to prosecute a complicated opposition (without extensions or oppositions). That makes a total of 6½ years. This is excessive and this practice does not motivate the parties to negotiate. It obligates them to monitor extremely long time periods and it is damaging for third parties both nationally and on a Community level.

Additionally, the new practice concerning opposition proceedings (inter partes) seems to be inconsistent with OHIM’s practice in ex parte proceedings where it is practically impossible to obtain more than two extensions (totalling four months).

OHIM does not see this delay and does not consider it to be true. Indeed, the average cooling-off period is not growing.

xi) Admissibility check

Now oppositions will be considered admissible if all absolute and relative requirements for admissibility are complied with for at least one of the earlier rights.

The new practice creates a situation of uncertainty for opponents who are obligated to double-check to see if the opposition is admissible for all of the earlier rights. For example, the opposition may be declared to be admissible insofar as it refers to the least lethal mark and the opponent may not find out until later that it is not admissible for the most solid mark.

The purpose of the admissibility check is to verify that the opponent clearly identified the earlier rights on the basis of which the opposition is filed.

It is only at the time of substantiating the opposition that the opponent has to evidence the earlier rights.

The change in the admissibility check practice adopted a year ago is that the relative admissibility check for all but one earlier right is done at the time the file has to be substantiated. At the first level only an absolute check is done and the relative check only for one right as if one is OK then the opposition is admissible (all other rights are checked at the time the opposition is to be substantiated).

xii) Obligation to file two copies of documents in inter partes proceedings (Rule 79a IR)

This provision establishes that where a document or an item of evidence is submitted in accordance with Rule 79 point (a) by a party in a proceeding before the Office involving more than one party to the proceedings, the document or item of evidence, as well as any annex to the document, shall be submitted in as many copies as the number of parties to the proceeding.

When documents cannot be filed by fax due to the large quantity, they are filed in hand at OHIM, which is presumed to be a “paperless Office”. However, Rule 79a does not establish any sanction when the evidence is not filed in duplicate. The

Communication by the President establishes the penalty of declaring the evidence inadmissible so it is ignored.

May we suggest that OHIM implement the e-filing as soon as possible of all types of documents, thus avoiding problems caused by fax and the bother and inconvenience of having to file documents in hand at OHIM in Alicante.

This problem should be solved at the time the Oppo-Online tool will be alive. ECTA urged that this tool be finalized and underlined the necessity to allow the zip facility to file documents.

- xiii) Evaluation of distinctive character of earlier registrations in opposition proceedings

The Office sometimes evaluates the distinctiveness of earlier rights, depriving them of any effect even if they have been registered.

For example, in R106/2000-2 the Office granted Community Trade Mark No. 758.334 GSM OFFICE in spite of the opposition of French Trade Mark No. 1.576.650 GSM arguing that GSM does not have distinctive character. This is a "de facto" invalidation of a national registration.

It seems that this is not of the competence of OHIM, which cannot even "ex officio" invalidate a CTM unless an invalidation action is undertaken by a third party.

The Office stated that there is no de facto invalidation of national trade marks foreseen in the CTMR and that they do not de facto invalidate national marks. Each office takes its own decision when examining trade marks and this autonomy of the decisions is an essential element of the trade mark system in Europe. However, they agreed that the way people use the argument of the outcome of an earlier decision in another office can indeed influence the examiner.

They nevertheless specified that each case is specific.

- xiv) Standard letters in Opposition proceedings

Could OHIM consider modifying its standard letters so as to make aware both opponents and applicants that all supporting documents should be translated in the language of the proceedings? While for many this duty should be, by now, engrained in their daily practice, it still happens that some forget and then say "but OHIM did not tell me...".

The Office indicates that the relevant information is contained in the annexed explanatory note sent to the opponent. It is true that nothing is said to the applicant, but they consider the regime as slightly different.

Is it OHIM's role to do this?

- xv) Right of defence

ECTA draws the Office's attention to the fact that in some cases, the Office accepts arguments in its decisions when the party has not been able to reply or file observations.

For example, in R0654/2005-1, the Office decided that the proof of use submitted did not correspond to the trade mark as registered - "REPORT" - because it included other elements. The party involved had to go to an appeal to argue that the additional elements were descriptive (COLOURS, ALCALINO, etc) and therefore did not change the nature of the mark as registered.

The Office agreed that should this effectively be the case, it is clearly not acceptable.

This question will be entered in the quality criteria check.

The Office further indicated that there is no requirement to go back to the applicant on various occasions.

xvi) Conversion cases

Update on possible developments since the last meeting, namely on the documents provided by OHIM to the national offices. Greek problem.

Not settled, to be pursued.

xvii) CTM registration certificates including non-Latin wording

Update on possible developments since the last meeting.

A global solution can only be provided when the OHIM system is transferred to their new technology, which will not take place before 2010.

In the meantime a semi-manual solution will be used, which should be alive within the next 6 to 7 months.

xviii) Similarities and differences between the Opposition and Cancellation procedures

Update on possible developments since the last meeting, namely on the possibility to have a Practice Note **showing in parallel** the similarities and differences between the two procedures.

We note that this matter will also be dealt with by Vincent O'Reilly at ECTA's next Annual Meeting.

The Office indicated that they will not issue a Practice Note in this matter but a table –. There is no commitment about when the table will be published.

xix) Withdrawals

We do not seem to have seen a Practice Note on this matter, namely on the withdrawal of CTMs during an appeal period.

The Office confirmed that there is no Practice Note on this matter but that it has been included in the following documents:

- *Opposition Guidelines - Part C-Part 1 on procedure*
- *Part E – section 3 para. 3*

A further discussion took place on whether a CTM rejected in an opposition division and at appeal level can still be withdrawn before the expiration of the deadline to appeal at CFI level.

The Office confirmed this possibility, as a decision only becomes final at the expiration of the appeal deadline.

xx) Legal form

According to Rule 1.1.B of the CTM implementing regulation, the Office has to request and provide for the legal form.

The Office understands that this can cause a problem in certain circumstances and is therefore applying a more flexible attitude consisting in that should the applicant indicate that it does not want the legal form to be part of the company name, the Office will add the information regarding the legal form in a different field but this will not be visible in CTM Online.

B – The CTM as an EU designation under the Madrid Protocol system

xxi) EU designations of International Registrations – date of publication of EU designations

Update on possible developments since the last meeting – has the required IT development been made and as from when will the second notification include the date of publication of the EU designation?

Once the amendments regarding the searches take place, this problem will also be settled, namely during the second half of 2008.

xxii) Search reports for CTM extensions under the Madrid Protocol and Notifications of Oppositions against CTM extensions under the Madrid Protocol

The minutes of the last meeting (see http://www.ecta.org/position_papers/2007-OHIM-Link-9-07.pdf) state that:

“Search reports for CTM extensions under the Madrid Protocol and Notifications of Oppositions against CTM extensions under the Madrid Protocol

Update on possible developments since the last OAMI Users Group meeting and the comments provided by the NGOs including ECTA.

OHIM confirmed having received comments from ECTA, AIM and INTA.

OHIM has decided:

- to send the searches, notifications of cited CTMs to the WIPO representative;*
- to send notifications that need a reply (e.g. request to indicate a second language...) to the WIPO representative mentioning that an EU representative needs to be appointed and to reply;*
- to consider that when receiving a communication from an EU representative, it is to be assumed that it is the EU appointed representative.*

These principles will be implemented soon, namely as soon as the relevant standard letters and other internal processes have been adapted.”

Experience shows that these principles are not effectively applied.

The Office confirms that there is a decision and that it will implement it. However, it took some time to adopt the necessary IT system.

Everything should be put in place very soon and a communication in this regard will be provided.

5 – Designs

i) RCD Renewal Guidelines

Status further to the comments provided.

The Office confirmed having received various comments and having amended the draft guidelines accordingly when the comments were wise.

The Office is now waiting for the necessary translations and the document will be submitted to the Administrative Board next April for its opinion.

As soon as the document is translated it will be made available online

ii) e-filings (to be treated as point 2 of the agenda)

When filing an RCD online, the corresponding web page continues to indicate the following:

“Users are informed that filing of an application via RCD e-filing may encounter technical difficulties, particularly in case of large applications (see helpfile for more technical information). The Office is working to improve this situation. In case of encountering such difficulties, users are recommended to use the alternative means of filing provided by the Regulations.”

We understand that the online development of this service is not at its full potential and does not inspire confidence. When does OHIM expect to ensure the same reliability as that which the trade mark system offers?

See point 2.i. above

Is it then the Office's intention to lower fees for online filings as for Community trade marks?

Yes, but not immediately.

iii) Community designs database

The official Community designs database (which can be accessed online) has been improved, bringing it into line with the format used for trade marks. Some information has been updated for the very first time. Would it be possible to have a drive towards creating a link to possible cancellation proceedings, making it possible for documents in that file to be consulted online?

The Office confirms having a project to extend the online access to files to RCDs.

This should not take more than 2 years.

Regarding the link to possible cancellation proceedings making it possible for documents in that file to be consulted online, the Office indicated that these proceedings are not yet digitalized and that they will first have to be digitalized in order to make them available online.

No deadline can be given as to when this will be possible.

iv) Priority certificates

It appears that some design examiners require certified copies of the priority certificates to be filed when, on the application form, "exact photocopies" had already been submitted (to quote the terminology used in Decision EX-03-5). Could the Office please look into this?

The Office confirmed that some examiners should be more strict and that they will keep on improving.

6 – OHIM Performance: remarks and suggestions

i) My Page

a) It is to be noted that in general it works well. However, when a renewal is filed the programme works very slowly when you go from one page to another.

b) When will the payment of the registration fee be possible through My Page?

The Office indicated that at this stage there is no plan to modify My Page in the short or mid term.

However, the Office will proceed with an audit on the weaknesses of the system. If serious weaknesses are found, the Office will remedy them.

The registration fee will be introduced later.

ii) Accessibility of Examiners

Although this has been discussed previously, it is worth noting that you can hardly ever find an examiner when you telephone OHIM. Is it still the policy of OHIM to discourage telephone inquiries to examiners?

The Office confirmed that it will further proceed with e-mails rather than telephone calls. However, this does not mean that the Office discourages its examiners to proceed with telephone calls.

iii) Delays in dealing with correspondence

There are still problems deriving from delays by OHIM to deal with correspondence, evidence, restrictions, etc., which are communicated too late to the other party. Sometimes the response is that you can check the evolution of the file through the e-inspection of the file. However, this is not an admissible answer as, on the one hand, it is the obligation of OHIM to communicate the developments of the case and send copies of documents to the other party and not for the party to check it itself. Also, there are sometimes official deadlines to respect even though the situation of the file has changed.

As reported above, the Office has some objectives in this matter, namely to deal with these communications within a 1 to 3 week term.

As mentioned before this should not happen and the Office will continue its efforts to eliminate these delays.

iv) Registration certificates

Quite mysteriously, registration certificates sometimes contain mistakes in the address of the applicant or its legal form, its name or others, when initially the data reported was correct. Could the Office please clarify why this happens? Examples have been given to OHIM.

Thanks to the example provided by ECTA, OHIM has been able to understand the origin of the problem. However, this has not been settled yet but the Office will work on it.

Based on the examples provided it is evident, that the mistakes are due to human errors when key-in of the owners and representatives data are done. The Office will do its best to avoid these human errors in the future.

v) Customer Care Unit

To what extent is the Customer Care Unit used to complaining to OHIM? Could we have statistics/information in this regard as well as a time frame to obtain satisfaction?

A presentation will be made at the OAMI Users' Group of 3 March 2008 in this connection.

vi) Decisions and communications of the President

OHIM recently changed the classification of the Decisions and Communications of the President, namely from a chronological order to a "subject" order. While the new way of presentation may be useful, the old system was very convenient as well. Would it be possible to have both classifications available?

The Office has been made both presentations available since mid February 2008.

7 – Any other business

i) Enforcement of cost decisions

Some members still have difficulties understanding why cost decisions from OHIM (eg the opposition division) are not equally enforceable in all member states.

A survey carried out by the Professional Affairs Committee of ECTA considered the following solutions:

Option I: Losing party must also pay costs for enforcing OHIM's decision nationally.

Option II: Abolish decisions on costs.

Option III: Introduce downpayment of such costs when procedure starts.

Option IV: OHIM should publish a list of "non-payers".

What are the views of OHIM in this matter and would it be possible to have its support in order to positively raise this issue with the Commission?

OHIM has no formal position at present. It will explore how the issue could be addressed in the upcoming study by the Commission.

ii) Symposium of Judges

Would it be possible for ECTA to attend these meetings as observer?

The Office would be in favour but some judges are absolutely against it.

Alternatively the Office is willing to establish some platform where judges, applicants, practitioners, etc. could meet each other.

Reported by Sandrine Peters, ECTA Legal Coordinator