



European Communities Trade Mark Association

Report of the 15th ECTA-OHIM Link Committee Meeting
Alicante, 17 January 2005

PARTICIPANTS:

On behalf of the OHIM

Wubbo de Boer	President
Alexander von Mühlendahl	Vice President
Sylvie Mandel	Chairperson 1st Board of Appeal
João Miranda de Sousa	Director of the General Affairs and External Relations Department
Etienne Sanz de Acedo	Head Operations of the General Affairs and External Relations Department
Hans Jakobsen	Director of the Trade Marks Department
Benoit Lory	Head of Production Service Trade Marks Department
Patricia López Fdez De Corres	Head of Quality/training Sector, Production Service, Trade Marks Department
Paul Maier	Director Designs Department
Fernando Martinez Tejedor	Deputy Directed ATMDD
Gordon Humphreys	Head of Register & Related Databases Services ATMDD
Bente Waldstrøm	Project Manager Quality Management Department

On behalf of ECTA

João Pereira da Cruz	Chairman ECTA – OHIM Link Committee
Mireia Curell	ECTA First Vice-President
Sandrine Peters	ECTA Legal Co-ordinator
Dietrich Ohlgart	Chairman and representative of the Law Committee
Keith Hodgkinson	Representative of the Design Committee
Nikolas Lyberis	Representative of the Harmonization Committee
Fabio Angelini	ECTA Member
Luis-Alfonso Duran	ECTA Member
Clarke Graham	ECTA Member

1 – General Issues: The Office and its administration

The Office reports as follows:

- **Registered Community Designs**

About 54.000 applications have been filed in 2004.

- **Community Trade Marks**

About 60.000 applications have been filed in 2004.

There is currently no backlog in the formality process of Community Trade Mark applications.

- **Opposition Division**

The Office has received about 10.500 new oppositions in 2004 and rendered nearly 3.600 decisions.

3.200 files are awaiting a decision.

- **Cancellation Division**

The Office received nearly 300 new cases in 2004 and rendered about 250 decisions.

- **Board of Appeal**

The Board of Appeals does not yet have clear statistics for the year 2004. However, it seems that about 1.150 new appeals have been received, and that about 1.000 decisions have been rendered in 2004.

After the Court decision in the case MONTALTO vs. OHIM, for the time being, Ms Kerstin SUNDSTRÖM is the interim President until the appointment of a new President.

For further details on the filing and registration of Community Trade Marks and Registered Community Designs, please refer to the [OHIM's website](#).

- **Financial outcome**

The Office made a profit of €16.1 million in 2004.

- **e-business programmes**

In 2004, the OHIM launched:

- CTM-Online, in June
- the new e-business platform in December

2 – Community Trade Marks

Examination

i) Issuance of registration certificates

The OHIM is currently issuing registration certificates within a 1 month turnaround time.

Regarding those CTM registrations which were encountering delays in the issuance of the registration certificate (see the OAMI User's Group meeting report published in ECTA Flash 92), the Office currently has some new IT programmes under development and it is hoped to have the CTMs concerned published in the Bulletin starting from the end of January 2005 which will permit the relevant registration certificates to be issued.

Any user who is still missing a registration certificate after that is asked to contact the Office who will be pleased to assist in obtaining it as soon as possible.

ii) Standard class headings

ECTA drew attention to the fact that class headings are not always translated into the standard class headings of the Nice Classification.

The Office is aware of the problem which is due to the fact that most of the translations are made automatically and the translation programme does not always recognize the official Nice wording versus a similar translation.

The Office is in the process of introducing new IT programmes and it is expected that in the next version of the EUROACE programme these differences will have been overcome.

iii) Trilateral list of goods/services

- ECTA asked whether it would be possible to obtain a copy of the Trilateral list of goods/services as agreed between the USPTO, the Japanese PTO and the OHIM.

The Office indicated that the trilateral list of goods/services is available on the websites of the [USPTO](#) and the [Japanese PTO](#).

Unfortunately the bilateral (USPTO and OHIM) list of goods and services is not available.

- The Office indicated that there is no legal obligation to have the agreed list of goods and services validated by the WIPO as it is a non-legislative process.

iv) Letters dealing with the same matter for two separate trade marks

ECTA raised the problem of the fact that when a letter dealing with the same matter but for two or more separate trade marks is sent to the Office, there is sometimes a time difference of from one to two months in handling the different cases.

The Office is aware of this difficulty and has taken some steps to avoid it as much as possible. For instance, examiners have been asked, when similar applications are filed nearly together, to regroup them into the hands of one examiner, and users are hereby urged not to hesitate when filing such applications to indicate to the Office the fact that a series of similar marks is being filed and that they should therefore be handled by a single examiner.

v) *Repercussions of*

- The Heidelberger case (C-49/02 dated)

The Office confirmed that a practice note on the implications of this case should eventually be made available on the website, but no indication has been given as to when (please refer to the OAMI user's group meeting report published in ECTA Flash 92).

- The MGM case (T-342/02) -

ECTA asked whether, in view of the amendments to Articles 108 and 109 of the CTM Regulation 40/94 which deal with Conversion and which entered into force after the MGM case had been decided, the Office would change its practice and take into consideration all earlier rights claimed as the basis for an opposition when giving its decision?

The Office informed ECTA that it will not change its practice and that it will still render its decisions on the basis of the "killing right". How the Office defines which is the killing right is clarified in the Decision.

- The Carpol case (T-164/2)

The Office is appealing the case to the European Court of Justice and considers that new evidences cannot be supplied after the 2 months period starting at the end of the cooling-off period in accordance with Rules 16 and 20 of the CTM Implementing Regulation.

Furthermore, the Board of Appeal should not be used as a remedy for what has been missed in opposition proceedings and consequently new evidence should not be accepted at the Board of Appeal level.

This reasoning could however be different if, for example, supplementary documents might be required following further discussions on the first set of evidence.

- The Storck case (T-402/2)

This decision related to the geographical extent of the evidence of acquired distinctiveness and the Office referred to the "Practice note on evidence of use" which is available on its [website](#). The Office confirmed that acquired distinctiveness has to be demonstrated. If, for example, the application related to a word mark in Finnish, then the evidence of acquired distinctiveness should relate to Finland.

Further, on word marks, the Office only raises objections regarding descriptiveness in the official languages of the EU and not regional – non official – languages.

Regarding 3D marks or the like, acquired distinctiveness does not have to be shown on a country by country basis but on a market by market bases (i.e. Scandinavian – Central European – South European – West/East European).

Ms Mandel further indicated that proving acquired distinctiveness in most of the EU would be sufficient.

vi) Communication No. 11/04 of the President of the OHIM of 21/10/2004

The OHIM confirmed that the aim of the communication it had made to applicants about the outcome of the examination proceedings is for information purposes only.

vii) Criteria of the examination on absolute grounds further to decision T-393/02 on the shape of a bottle

The Office confirmed that it does take precedents into consideration; for example, the fact that the mark that had been objected to had already been registered in various EU national jurisdictions. However, such information could only be considered as evidence and would not be binding.

vii) Conversion cases

It appears that according to Greek law (and possibly also Lithuanian Law), when converting a CTM in Greece, the applicant is obliged to appoint an agent who must translate all the documents supplied by the OHIM to the Greek Office. ECTA asked whether, when sending documents to the Greek Office, the OHIM could limit itself to sending only those documents which were strictly necessary.

The Office promised to look into this matter and to take action such as, for example, through issuing an internal practice note to the examiners that, when dealing with the notification of these conversion requests, they should only send such information as was necessary.

ix) Request of change of name (in the case of owners of various CTMs)

ECTA drew the Office's attention to a real practical problem encountered by applicants who, when notifying changes of name for only for part of their trade mark portfolio, found that the Office had recorded the changes for the whole portfolio.

Despite the fact the Office is of the opinion that for legal reasons they are bound to proceed with the recordal for the whole portfolio, they promised to reconsider their practice without however making any firm promises of an effective change in it.

x) Update on the adherence of the EU to the Madrid Protocol

The Office stated that there were no real developments, but indicated that:

- The Office is aware of 856 EU designations through the Madrid Protocol system. 197 originated from the US, 115 from Switzerland, 54 from Australia, 60 from the Benelux and 60 from the UK.

The Office has already been notified of 82 designations by WIPO.

The first 75 EU designations will be published in the Bulletin of 24 January 2005

- The Office has received 481 requests for international applications on the basis of CTMs of which 466 had already been processed and 400 notified to WIPO.

The main languages of filing are:

203 in English
124 in German
25 in Spanish
49 in French
18 in Italian

60 requests are under examination and 13 are awaiting the registration of the CTM

x) *International trade marks and seniority*

The Office is of the opinion that an international trade mark cannot be based on a national trade mark which has been the subject of a seniority claim and which has not been renewed as it is no longer a registration on the national register. It is the Office's opinion that the effects of the seniority do not go beyond the CTM Regulation. However, this is a question to be interpreted by the national Offices rather than by the OHIM.

ECTA referred to Article 34.2 of the CTM Regulation which provides that:

“Seniority shall have the sole effect under this Regulation that, where the proprietor of the Community trade mark surrenders the earlier trade mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.”

However the Office pointed out that this Article specifically states: “...under this Regulation...”

Opposition

i) *Unilateral limitation of goods and services*

The Office confirmed that it was aware of delays in notifying both limitations of goods and services as well as observations filed by parties in opposition proceedings. It further indicated that communicating this information in a reasonable time period is one of the targets for 2005.

ii) *Backlog in rendering opposition decisions*

The backlog in this area was reduced in 2004 by approximately 1.000 files and the Office confirmed its intention to continue to reduce this backlog.

It further indicated that currently there remain only 29 files older than 15-16 months and decisions in these cases are expected to be taken by the end of January. By the end of March it is hoped that there would be no files older than 12 months.

iii) Possible failures in notifying oppositions

The Office confirmed having solved its technical problems in this matter. Should applicants still notice some failures they are asked to inform the Office thereof.

iv) Handling of communications in chronological order

The Office confirmed that in the future they will be working in a strictly chronological order. It is however true that some old complicated files that were put on the side for various reasons in the past still remain but this should be resolved during Januar 2005 see *(ii)* above.

iv) Changing the status of a party

ECTA raised the question of what happens when one party does not reply or “disappears” in opposition proceedings.

The Office confirmed that it applied Rule 20.3 of the CTM Implementing Regulation in such a situation, namely it took a decision “*on the basis of the evidence before it*”. Furthermore, if there is no evidence that one of the parties does not exist anymore, there is nothing the Office can do.

The Office however indicated that there is a case currently pending at the Court of First Instance where the earlier right on the basis of which the opposition had been filed was not renewed and where the losing party only noticed this failure after the decision by the Board of Appeal had been taken.

vi) Request to pay the registration fee when the application has been rejected

The Office indicated that this happens, on average, in 2-3 cases a year, and in such a case, it revokes the decision to register.

This approach will further be clarified when the amendments to the CTM Implementing Regulation have entered into force and when, in accordance with Article 77a CTMR and Rule 53a IR, the Office will officially be able to revoke decisions ex-officio within a 6 month period.

vii) Inconsistency in dealing with extensions of time for the filing of observations

The Office said that this should not occur, and that examiners should follow what is laid down in the Opposition Guidelines.

3 – E-business: CTM Online

i) Recording Licenses

The Office confirmed that due to technical problems, requests to record licences and the like were not published, with the result that the information cannot be retrieved on CTM-Online. The Office hopes to solve this publication problem in 2005 and ECTA asked whether, in the meantime, it should be possible to provide the information already on CTM-Online.

ii) Change of name or assignment

ECTA asked the Office to provide for a history of changes of name and assignment in CTM-Online, and the Office promised to look into this possibility.

iii) Links to the Opposition Division

The Office drew user's attention to the fact that only the first opposition was to be found on the general information page of a specific CTM. Users wishing to have information about any possible additional oppositions filed for a specific CTM should click on the "+" sign on the blue bar including the word "Opposition".

iv) Online consultation of Community trade marks (devices)

Some users seem to encounter difficulties in viewing the reproduction of figurative marks when consulting CTM-Online. The Office had checked on this and confirmed that there was no such problem from their side, and it invited anyone encountering this problem to check with their IT department because there could possibly be problems arising on their side due to the browser used, the quantity of bytes allowed by the computer etc. In the event of continued problems users were urged to contact the IT department of the Office so as to try to find out the source of the problem.

v) Searches on CTM-Online

Some ECTA members had expressed their concern at not being able to proceed with searches on the basis of the ID number of the trade mark holder or a representative.

The Office indicated that following the introduction of CTMs filed through the Madrid Protocol system, where trade mark holders and representatives do not have ID numbers, their search possibilities had been slightly changed. Users wishing to search on the basis of ID numbers, should be aware that this was only possible for CTMs filed at the OHIM. To proceed, in the advanced CTM-Online search, users were advised to select "CTM" in the field "Trade Mark basis", then on the new screen in the field "Representative", either "name" or "ID number" could be selected.

vi) EUROACE

EUROACE is aimed at being a multi linguistic classification built on the basis of English including

- the trilateral agreed classification,

- the Nice classification, and
- other expressions determined by the practice of the Office.

Currently, EUROACE contains the 8th Edition of the Nice Classification in the 7 languages validated by the Office, the trilateral list in English and other expressions determined by the practice of the Office in English. New versions of the EUROACE are already planned and by the end of the year all entries should be available in all the EU languages, including those of the new Member States.

v) *E-opposition*

It is planned that e-opposition and more particularly the filing of an opposition, as well as “My Calendar” should be up and running by the summer. Communications with the parties via e-mail will be developed as a second step.

4 – Community Designs

i) *Search facilities*

The development of an on-line RCD search system is progressing well and it is planned to unveil the project on 25 February, 2005. The first test with chosen users is planned to take place in April, and it is hoped that a version in English can be launched in May, with the version in all languages available by the end of the first semester.

The search database will offer a 2 level search and will include the Vienna and Locarno classification logos and graphical elements as well as the verbal elements included in the designs..

ii) *Design Application No. 814351-0001*

Article 7.1 of the Design Council Regulation 6/2002 provides that:

“For the purpose of applying Articles 5 and 6, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Articles 5(1)(a) and 6(1)(a) or in Articles 5(1)(b) and 6(1)(b), as the case may be, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.”

The Office considers that in view of the underlined wording, when the sign is published as a CTM, it is very likely that it be considered to destroy the novelty required of the design. This is what the Office found in now several cases. It is indeed difficult to imagine a case in which such publication cannot be considered to have “become known in the normal course of business to the circles specialised in the sector concerned”.

5 – Enlargement

i) Update

There was nothing really new to be reported under this heading on top of the information that can be retrieved in the news on possible new Member States joining the EU.

ii) Community Trade mark Courts in the new EU Member States

The Office has provided ECTA with an updated list of the trade mark courts of first and second instance in the various Member States which can be retrieved on ECTA's website under the OHIM-Link report section.

iii) Update on searches

Applicants should currently be receiving the first search reports from those new Member States that have decided to undertake searches namely, Lithuania, Poland, Check Republic, Slovakia and Hungary.

v) Update on the staff

The Office is still in the process in hiring people from the new Member States and making further reserve lists.

The latest selection procedure has allowed finding a Latvia national, which was the only nationality that had not been covered by earlier procedures. Very soon the Office will thus have collaborators from every Member State.

v) Sharing of information with the new EU Member States

The Office shares information equally with all the EU Member States including the new Member States.

Despite the fact that the Office has reminded the courts of their obligation to inform it of relevant court decisions, there seem to be no developments in the exchange of this information.

6 – Miscellaneous

i) Alterations in the legislation

There were no specific developments in this matter and the OHIM has not yet been able to meet with the new Commissioner despite having invited him.

ii) Harmonization between trademarks at national level and at the OHIM

The OHIM has regular meetings with the national Offices where various discussions take place, *inter alia* on Absolute Grounds of Refusal.

Furthermore, the Office indicated that it invites people from the national offices to join their staff for a 2-3 year period and it is hoped that in this way when they revert to their national Offices their experience will help in the

harmonization process. Presently there are about 20 people who are benefiting from this opportunity.

ECTA indicated that they too have a Harmonization Committee and would be pleased to help the OHIM and the National Offices in their harmonization process should they feel it helpful.

iii) Harmonization of the decisions of the Boards of Appeal

Further to the entry into force on 27 December 2004 of the amendments to the Commission Regulation (EC) No 216/96 laying down the rules of procedure of the Boards of Appeal of the OHIM (see the compiled version on [ECTA's website](#)), and the relevant articles (130-131) of CTM Council Regulation 40/94 (see compiled version on [ECTA's website](#)) Mrs. Mandel confirmed that new standard letters have been prepared which will be made available to the users once translated.

Furthermore, as provided by Article 8.2 of this Commission Regulation No 216/96, the parties should each be entitled to two rounds for filing observations. Ms Mandel invites any party that does not wish to take advantage of this second round to inform the relevant Board of Appeal as soon as possible so as to accelerate the procedure.

The Presidium will meet in February. As stated above, the acting President, until further election, is Ms Kerstin SUNDSTRÖM. The members of the Presidium have already started to draft the rules as per Article 1.5-6 of Commission Regulation 216/96 and these should be finalized by the end of February.

It was noted that since the amendments to Commission Regulation 216/96 entered into force late in 2004, namely on 27 December 2004, and so as to avoid any mistakes, all appeals filed as from 27 December 2004 and which are due to be dealt with according to the new rules, will be numbered as if they were filed in 2005.

Ms Mandel drew ECTA's attention to the fact that there will in practice be no decision rendered by a single-member panel. Indeed, decisions that could be handed down by a single member are currently rendered within a one-month period. If, on the other hand, they were referred to a single-member panel, the decision would take much longer to be produced because according to Article 1(c).3 of Commission Regulation 216/96, the decision to refer the case to a single-member panel must first be communicated to the parties.

iv) Request for a correction letter in the case of a mistake by the office

The Office confirmed that the examiners do have the possibility of proceeding with corrections ex-officio. The fact some may always ask users to write a letter further to a phone call is only for safety reasons.

v) Opposition forms

The Office confirmed having prepared new forms and were waiting for them to be translated in order to make them available to the users.

The Office wished to remind users that the use of their forms is not mandatory and that users may use their own forms and add any necessary information such as reference to the new Member States should they feel it necessary.

vi) Office study on oral hearings

The Office confirmed its practice not to appoint any oral hearings. The only one that has taken place so far was the “Hollywood” case at the Board of Appeal level.

The Office further indicated that in the few cases where this point had been raised at the European Court of Justice, the Court had confirmed the Office’s practice.

vii) (Legalization of) certified copies

The Office indicated that according to the Permanent Representative of the EU commission in Madrid, legalization of certified copies should no longer encounter delays and invited users still having problems to contact the Office.

Further, the Office is pleased to announce that since the last User’s Group meeting of November 2004, the Office has been able to reduce the turnaround for obtaining certified copies to 5 working days.

viii) Qualification for design and trade mark work

The Office confirmed that it had established 2 different lists of representatives: one for those representatives only qualified to do design work and the other for those qualified for both design and trade mark work.

When the IT development on e-agent is finalized (possibly at the beginning of 2006) users would be able to obtain the information on-line. In the meantime they should check with the Office directly.

ix) Communications with the Office

The Office indicated that all telephone numbers of the examiners should be made available on the website by the end of January.

Reported by Sandrine Peters, ECTA Legal Co-ordinator