



European Communities Trade Mark Association

Antwerp, 12 March 2007

**ECTA COMMENTS ON
GUIDELINES CONCERNING PROCEEDINGS BEFORE THE OHIM
PART M, INTERNATIONAL MARKS**

GENERAL COMMENTS:

ECTA considers that the Guidelines are very clear and very thoroughly written. Of necessity they contain a large amount of fine details, but the clear layout makes it easy to find the answer to a particular question and the table of contents is well laid out and not difficult to follow. ECTA congratulates the authors.

ECTA's specific comments are set out below. However, it is not clear whether the authors have taken into account all of ECTA's comments of October 2004 on the first draft of these Guidelines, so we attach a copy of these.

SPECIFIC COMMENTS:

SECTION 1: THE OHIM AS OFFICE OF ORIGIN

1.2.5 Identity with the basic mark

Page 10, para 6: It is stated that OHIM treats marks which do not consist of Latin characters as nothing else than figurative marks, except for Greek characters. But what about Cyrillic characters?

Paragraph 1.3. Forwarding of the international application

Page 12: It is stated that the examiner will give two months to remedy the deficiency. On the next page it is stated that the examiner must forward the application within two months to WIPO.

ECTA suggests that the examiner give only one month to remedy the deficiency, in order not to risk being late in forwarding the application to WIPO.

ECTA likewise considers it very good that the Guidelines encourage examiners to solve any problems on the phone.

SECTION 2: THE OHIM AS DESIGNATED OFFICE

5.- Relationship to the Madrid Agreement

Page 20, para 2: Although the initial part says "If a subsequent designation is presented at the Office in its capacity as the Office of the Contracting Party of the holder, only States which are bound by the Protocol may be designated..", the last line of this paragraph reads "This applies even if the office of origin is only bound by the Agreement..". This does not seem to make much sense, as OHIM cannot be designated if the office of origin is only bound by the Agreement.

2.- The international registration or subsequent designation of the EC

Page 22, para 3: reads: "The 18-month period starts on the day on which the notification of the designation is received by the OHIM. The OHIM will receive designations electronically. It will be indicated in MPS and the Standard Letters as the "notification date". In case of substantial type of corrections by WIPO, the 18 month deadline starts running again as from the new notification date". ECTA believes that the word "substantial" is somewhat vague and could give rise to uncertainty, unless what is substantial and what is not is clearly defined.

3.4. Searches

Para 25, para 3: "The search reports will be sent directly to the holder..." ECTA suggests these being sent to the representative before WIPO whenever one has been appointed. This will avoid confusion on the part of the holder of the registration unexpectedly receiving the search reports.

4.2. Absolute grounds examination

Page 28, para 1: "The international holder is nevertheless informed..." ECTA suggests these being sent to the representative before WIPO whenever one has been appointed. This will avoid confusion on the part of the holder of the registration unexpectedly receiving this communication.

6.1. No opposition and AG Ok (First statement of grant of protection sent)

Page 30, para 3: It is stated that the holder of the IR is sure that the designation of EC can no longer be **refused at all**. However, it is understood that the designation of EC can be **cancelled**, as any other CTM registration. This fact should also be mentioned.

SECTION 3: Conversion, transformation, replacement

4.2. Procedure

Page 50, para 2: It is not clear how OHIM will keep a register of replaced Community Trade Marks. The purpose of replacement is to avoid renewals of the “replaced” registration. As a consequence the CTM will not be renewed after the five year dependency period.

In addition to the above specific comments, a few typographical errors have been noticed which are listed in the Annex hereto, and ECTA has also taken the liberty of including in the Annex some proposals for amending the English language.

6.3.2. Receipt and information of the international holder

Page 31: “The examiner will also send a copy of the opposition notice to the holder...” ECTA suggests these being sent to the representative before WIPO whenever one has been appointed. This will avoid confusion on the part of the holder of the registration unexpectedly receiving this communication.

As a general remark, regarding all kind of communication OHIM is willing to send directly to the holder, ECTA suggests these being sent to the representative before WIPO whenever one has been appointed.

Indeed, this will avoid confusion on the part of the holder of the registration unexpectedly receiving these communications. On occasion instead of an appointed representative, a specific address for correspondence has been indicated and these should be used in such cases as well.

We hope you will find our comments useful.

If you have any questions in this regard or if we can assist you in any other way, please feel free to contact us.



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