

A I P P I — REPORTS

OAMI Trade Marks Group

Alicante, Spain, December 3, 1999

by Luis-Alfonso Durán

1. Introduction

The OAMI TRADE MARKS GROUP held its 3rd meeting in Alicante on December 3, 1999.

AIPPI was invited to attend. Other organizations present were: AIM, CNIPA, ECTA, EFPIA, ICC, INTA, LES, MARQUES, UNICE and UNION.

There was a representative from the European Commission and among other relevant officers of the OHIM they were the President, the two VicePresidents, the Directors of the Legal Department, and of the Administrative and Technical Services Department, the Heads of the Examination, Opposition, Legal and International Affairs Services.

The Agenda included among other topics information from the Office on the current activities in general, discussion about the opposition system, about the examination on absolute grounds of Community Trade Marks, and discussion about the re-establishment of the examination of seniority claims and the new revised application form.

In the following report I will summarize the most important questions discussed during that meeting.

2. Community Trade Mark filings

The President of the Office reported that during 1999 the number of filings has continued to increase and that the Office expected an increase of applications of about 35% over 1998, so that the total number of applications for 1999 would be of at least 42.000.

3. New building

It is not expected that the Office will move to the new building before June 2000.



4. Opposition proceedings

The VicePresident on legal affairs explained that the opposition rate continues to be slightly under 20% of the Community Trade Mark applications published.

The Opposition Division has rendered 1.100 decisions, 300 are on purely procedural issues and 800 on substantive issues, 350 refusing the Community Trade Mark

applications opposed partially, or totally, and 450 accepting the Community Trade Mark and refusing the opposition.

The number of appeals filed against decisions of the Opposition Division is of around 27% of the cases.

The Boards of Appeal have taken 15 decisions on opposition cases, 12 reversing the contested decision and 3 confirming it.

The VicePresident of the Office reported that the criteria followed in the opposition decisions follows the European Court of Justice decisions on CANON (on similarity of goods and services), PUMA (on similarity of signs), LLOYDS (general approach) and CHEVY (on reputation). Beyond that, a case by case analysis is made. For example, the medium attentive consumer for pharmaceutical products was different from the one for detergents.

5. Examination on absolute grounds

It was discussed the standard of examination on 30 marks. The VicePresident of the Office stated that out of 1.300 applications only 50 have been refused and that this rate was not very high according to his view, it could be said that the policy of the Office was actually very liberal.

This was not the feeling of the participants. One of them expressed their concern about the standards applied by the Office and by the level of consistency.

Another organization stated that the approach of this Office towards figurative marks was overly rigorous.

The VicePresident reported that registrability of 3D marks had to exist both at the time of filing and at the point of time of registration. This view was not shared by most organizations present since it favoured imitators.



6. Examination of seniority claims

A lengthy discussion took place in connection with the examination of seniority claims of Community Trade Mark applications that has been suspended by the Office for more than two years. The Office presented a paper on this issue.

The organizations present were not all in agreement. Some insisted that the Office should make an in depth examination according to the Regulation while others were not in favour of this.

The Office said that they will review their proposal, at the light of all comments made and will present a new one.

7. Observations

The Office presented a paper on observations basically establishing a term of 4 months from the publication of the CTM application in the Bulletin unless oppositions are received. In such case they will accept observations if they are received before the

termination of the opposition proceedings.

The Office proposes to accept observations in any of the eleven languages of the European Union.

Finally, the Office will only acknowledge receipt of the observations to "the observer", but the latter will not receive any further communication from the Office and specifically, they will not be informed of the further fate of the respective CTM application, since "the observers" are not considered to be parties in the proceedings.

Several associations, included AIPPI were not in favour of the language regime proposed by the OHIM and requested that the same rules applied for oppositions in connection with languages should be applied to observations.

8. Conversion of Community Trade Mark applications

The issue was raised that when the OHIM sends documents to national offices for converting a CTM into a national application, more documents that needed are being sent, and this has required, in some cases, to translate into the language of the corresponding country unnecessary documents, with the corresponding expense. The Office will check this matter.

9. Accession to TLT

The Office informed that Commission was in the process of preparing a proposal concerning the implementation of the TLT in the CTM Regulation.

10. Enlargement of the European Union

The Office informed that they are in contact with the Commission and with the countries candidates to access to the European Union on technical issues (access to data bases and mutual exchange of information) with a view to minimize conflicts arising out of the extension of CTMs to those countries when the accession would take place.

11. CTM on-line

The Office informed that a new product called "CTM ONLINE" is operational that allows consultation of the data base of the Office through Internet. Access to this system can be conducted through the OHIM website:

www.oami.eu.int

The next meeting will take place in July 2000.

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