The OAMI Enlargement working group was established to examine the legal implications of the enlargement first on the Community Trademark System but now also on the Community Design System. On its 3rd meeting held on 26 March 2003 in Brussels, the provisions of the draft Accession Treaty on the CTM and CD Systems were presented.

The Enlargement of the European Union with ten new member states was agreed upon in December 2002. Also the formal Accession Treaty has now been drafted and agreed upon, and is expected to be available in the 21 official languages of the enlarged European Union in April 2003.

The legal implications of the enlargement at least for the CTM System are already known from the enlargement negotiations and from the so called European Common Positions. As the Community Design Regulation, however, was adopted after the date before which all community law should be accepted by the new member states, the legal implications of the enlargement for the CD System have remained open. Further, regarding the CTM System the exact wording of the amendment to the CTMR has not been known.

These questions are now answered by the draft Accession Treaty, which amends the regulations by including a new Art. 142a CTMR and a new Art. 110a CDR relating to the enlargement. These
amendments of the regulations will take effect as from the accession date, 1 May 2004. Full text of
the provisions is available on the website of the Office.

The new Art. 142a CTMR amends the CTMR to implement the legal implications of the
enlargement on the CTM System as reported in AIPPI Newsletter No. 4. Taking into consideration
that the contents of the provision has been negotiated as part of a package deal, the Commission
seems to have done a good job ending up with a reasonably precise wording not leaving to much
room for ambiguities.

According to the new Art. 110a CDR, all unregistered and registered CD’s, including all CD’s
applied for before the accession date, are automatically extended to the territory of the new
member states. “New” grounds for non-registration and invalidity, i.e. grounds excluding
registration or for which a protected CD may be declared invalid only after accession, cannot be
invoked against an automatically extended CD, and “earlier rights” in a new member state confer
on their owners only the right to exclude the use of an automatically extended CD in the relevant
member state, but not the right to claim invalidity thereof.

Special attention should be paid to Art. 110a.5 CDR according to which “….a design which has not
been made public within the territory of the Community shall not enjoy protection as an
unregistered Community design”. This provision does not relate to the enlargement but apparently
is an attempt to solve the ambiguity in certain language versions of Art. 11.2 CD on whether an
unregistered CD is established by disclosure of the design internationally or only within the
Community. However, this is an inappropriate way to solve an ambiguity, which should have been
left with the ECJ to solve, and the attempt may create more problems than it solves.

Bad faith applications
The risk of trademark applications being filing with the trademark offices of the new member states in bad faith of identical or confusingly similar CTMs and vice versa has been discussed at length. So far the number of (known) bad faith applications has been very limited, and the reports from the NGO’s at the meeting did not change this picture.

The Office has been the driving force in a substantial effort to create transparency in which trademarks are filed in the EU and in the new member states to prevent bad faith applications, and announced at the meeting that a further tool, namely the Trademark Consultation System, is now available from the database section of the website of the Office. Using the Trademark Consultation System it is possible to search in the CTM register and in the national trademark registers of Czech Republic, Estonia, Hungaria, Slovenia and Slovakia at the same time.

Further, having consulted the member states the Office has made a Bad faith case study, which is available from the enlargement section of website of the Office. The Bad faith case study explores the criteria for determining if a trademark application has been made in bad faith and may serve as a guideline for the Office as well as for the trademark offices of the member states irrespective of the fact that they are not bound by the document.

For the complete presentation please visit: http://oami.eu.int/en/enlargement/private/working.htm