



9th OAMI Users' Group Meeting
Alicante, 7 July 2003,
by
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Chairman Q85 (Community Trademark Committee)

The 9th OAMI Users' Group Meeting was held on 7 July 2003 in Alicante, Spain with representatives from AIM, AIPPI, BEDA, CNIPA, ECTA, EURATEX, FICPI, ICC, ICSID, INTA, MARQUES, UNICE, UNION, the Commission and the Office.

This unofficial Report of the meeting has been prepared for the purpose of information of AIPPI Members.

The headings are to facilitate reading only and may not be in accordance with the headings of the official agenda.

1. Opening of the meeting by the President of the Office

The President opened the meeting by welcoming BEDA as a new member of the Group, and by suggesting a new item to the agenda: 5bis "E-business projects of the Office".

2. Adoption of the agenda

The agenda was adopted with the amendment suggested by the President.

3. Adoption of the minutes of the 8th meeting

The minutes were adopted.

4. Current status of the activities of the Office in general

Filing figures

In 2002 the Office received approx. 45.000 CTM applications and expects an increase of 5-10% and thus forecasts to receive 49.000-50.000 CTM applications in 2003.

New Department Structure

The Office has reorganised by establishing the following four new departments

- Administration of Trademarks and Designs headed by V. O'REILLY
- Trademarks Department headed by H. JAKOBSEN
- Designs Department headed by P. MAYER
- Boards of Appeal headed by B. MACHADO

The Office is still working on the last details in implementing this reorganisation.

5. Legislation: CTM reform and improvement

Amendment of the CTMR

The Commissions original proposal to amend the CTMR (COM/2002) 767 final of 27 December 2002) has been amending during the Greek Presidency (in form rather than in substance), and the member states generally consider the amended version better than the original version.

The blocking point is the proposal by the Commission to abolish searches according to Art. 39 CTMR, where the majority of the member states are in favour of conducting searches.

The position of the Commission remains to abolish searches, but due to the resistance of the members states, the Commission is presently in the process of preparing an alternative proposal.

A possible alternative proposal could be to establish a voluntary search system, preferably outside the registration system, but the Commission stressed that any alternative to abolishing searches must be followed by an improvement of the search system in general.

It is the intention to finalise and adopt the proposal to amend the CTMR during the Italian Presidency, i.e. before the end of 2003.

Revision of the CTMIR

The Commission has not started its work on amending the CTMIR, but the Office informed that it has started collecting ideas for a proposal to amend the CTMIR, which it expects to submit to the Commission.

On the request of AIPPI, the Office agreed (and the Commissions consented) to consult the users before submitting its proposal for amending the CTMIR to the Commission. There was no indication as to when this will happen.

EC accession to the Madrid Protocol

In September 2003, Spanish is expected to become the third official language in the Madrid Protocol, following which the Commission hopes that the EC will be able to access the Madrid Protocol and thus establish the link.

The blocking point is (again) the language problem, but only one country seems to be against.

On the assumption that the EC will access the Madrid Protocol, the Office is in the process of preparing its systems, but does not expect to be ready before 1 November 2003.

5bis. E-business projects of the Office

The Office informed that it is presently considering establishing the possibility of

- looking on the entire file on-line
- e-mailing the examiner (as a logical consequence of the e-filing system)
- amending details on-line (e.g. a representatives change of address)
- substituting submitting documents by the Office looking in relevant (public or private) databases.

The users where generally supportive of the Office's considerations, but one organisation requested that the file is made available only to the applicant or his representative, and that documents evidencing priority and seniority claims were kept on record.

The B2B e-filing solution

Regarding batch-filing of applications (the B2B solution) the Office is presently liaising with the major suppliers of IP management software to find a solution, and hope that a solution regarding the filing of CTM applications will be available this autumn.

It is the intention of the Office to inform the users of future e-business projects on its website.

6. The Community trademark

Examination of seniority claims

By the end of August 2003 the Office expect to have worked down the old backlog of CTM's and CTM applications with unexamined seniority claims.

It is not the intention of the Office to publish amendments to CTM's following the examination of the seniority claims, and the valid status of a CTM will thus only be available from the file and not from the publication.

It was stressed by the users that in particular SME's must be able to rely on the decisions of the Office regarding seniority claims as a basis for giving up the corresponding national trademarks and it was requested that CTM-ONLINE reflects the result of the seniority examination. The Office promised to consider this request.

Processing of authorisations

The Communication of the President (No. 2/03 of 10 February 2003) on the processing of authorisations has given many users the wrong impression that the submission of authorisations is not required following the communication.

The Communication of the President relates only to how the Office is processing authorisations, and it is still required to submit authorisations, see Art. 89.1 CTMR and Rule 76 CTMIR – at least until the CTMR is amended as proposed by the Commission.

The Office had seen no practical problems as a consequence of the communication and refused to reissue same to clarify that the requirement to submit authorisations remains.

Guidelines on opposition proceedings

The Office has prepared a comprehensive set of substantive opposition guidelines and expects to submit same to the Administration Board in November 2003 for approval before publication on its website. The users have been given until 1 October 2003 to submit their comments.

Following publication of the guidelines as amended to take into consideration the comments of the users, it is the intention of the Office to revise the guidelines at two years intervals. Between revision of the guidelines important changes in the practice of the Office will be communicated to the users either by a Communication of the President, through this Group or otherwise.

The guidelines are in practice the internal opposition guidelines of the Office being made transparent to the users.

Oppositions based on more than one earlier right

When an opposition is based on more than one earlier right, the Office takes only into consideration the strongest of the earlier rights (and even not necessarily all identical marks of earlier rights) when rendering its decision in the opposition.

This practice gives rise to uncertainty in determining in which member states the applicant having lost the opposition is entitled to convert his CTM application to national trademark applications.

The Office supported its practice by the fact that the main purpose of the opposition is to have the application rejected on whichever basis, and that the applicant still has the possibility to withdraw the CTM application before a decision in the opposition is rendered, and subsequently convert to national trademarks applications in all or selected member states.

The question has now been submitted to the CFI in Case T-342/02.

Guidelines on renewals

The Office expects to submit the final guidelines on renewal to the Administration Board in November 2003 for approval before publication on its website.

New case law of the ECJ and CFI affecting the practice of the Office

The Office considers the decisions rendered by the ECJ and CFI since the last meeting of this Group to be in line with the practice of the Office.

Regarding the decision in the Sieckmann-case (ECJ Case C-273/00) the Office noted that smell marks will be registrable only upon improvements in technology enabling a graphical representation of the marks.

Regarding the decision in the Libertel-case (ECJ case C-104/01) the Office noted that so many conditions for the registration of colour marks are laid down by the ECJ, that they will be difficult to meet in practice. The Office expects to issue a Communication from the President on how to deal with colour marks in the future following the decision in the Libertel-case.

7. The Community design

Filing figures

To date the Office has received 4525 RCD applications which corresponds to an average of 37,4 applications per day. 52% of the applications received are applications for a single design whereas 48% of the applications are for multiple designs. Each application contains an average of 4,15 designs.

According to the market study carried out before the CD System came into force, the Office expected to receive between 27 - 32.000 RCD applications in 2003. On the basis of the applications received so far, the Office forecasts to receive between 27 - 39.000 RCD.

The same positive tendency is not seen by the national offices of the member states, where the number of design applications have decreased by in some member states more than 50%.

The borderline between the CTMR and CDR: are logos designs?

It was noted that a substantial number of the published RCD are logos, which are (also) trademarks.

The Office stressed that it is applying the CDR without regard to whether a design may also be a trademark, and refrained from commenting on whether a RCD or a CTM is the better protection for a logo.

Filing receipts

The Office informed that its target is to send out of filing receipts within three weeks from receipt of the applications. The users requested that the applicants reference for each single design in an application being referred to in the filing receipt and in other communications from the Office.

Guidelines on examination

The Office has received comments on its guidelines on examination and will amend the guidelines where necessary and appropriate.

Guidelines on invalidity

Invalidity guidelines are in the process of being drafted, and the Office expects to send the draft guidelines in consultation in September 2003.

EC accession to the international registration system for designs

The Commission informed that USA is expected to take the necessary steps to prepare for an accession to the international registration system for designs, whereas Japan is not yet prepared to take such steps.

Before the end of 2003 the Commission will prepare a proposal on whether the EC shall access the international registration system for designs or not, and the US position will be an important factor in this respect.

Search facility for the RCD database and the e-filing system

The on-line search facility for the RCD database (the Bulletin) and the e-filing facility was demonstrated.

8. Enlargement of the European Union

State of preparations

There was no substantial new developments to report regarding the enlargement, and on this basis it was decided not to have new meeting in the OAMI Enlargement Working Group unless need arises.

Possible fee increase following the enlargement

Irrespective the open question on whether the searches according to Art. 39 CTMR will be abolished or not, the Commission has stated in the Budget Committee of the Office and repeated to this Group that the fees of Office will not be raised to maintain the search system.

Other matters

As another matter of costs control, the Commission expect to have found a solution so that the Office does not need not to translate into Maltese.

9. Miscellaneous

Code of conduct for professional representatives

In its document on the functioning of the system of representation according to Art. 89 CTMR (COM(2002) 766 final of 27 December 2003) the Commission suggest establishing a voluntary code of conduct of the professional representatives before the Office.

FICPI urged the Commission to reconsider its position, and introduce a requirement of a national harmonised examination to be entered on the list of professional representatives, and left open the question of whether it is possible to separate such requirement from the qualification to represent before the national offices of the member states.

Irrespective hereof, FICPI declared its willingness to participate in preparing a code of conduct and suggested the epi code of conduct (having been considered by the Commission and the CFI) as the starting point.

The Commission stressed that a harmonised examination is not in the plans of the Commission and that a voluntary code of conduct is what is on offer.

New forms of the Office

The Office introduced the new simplified forms. A formal communication will follow when the forms are available for use. Supplementary to the forms the Office is working on harmonised attachments to the forms.

Searches of rights according to Art. 6ter

On request the Office informed that its source for searching rights according to Article 6ter Paris Convention is a CD-ROM, which is available from WIPO at a price of CHF 100.

Next Meeting

Next meeting of the OAMI Users' Group will be held on 16 February 2004.

Copenhagen, 9 July 2003