



Hisamitsu Arai
Commissioner,
Japanese Patent Office

THE CURRENT SITUATION CONCERNING TRADE MARK ADMINISTRATION AT THE JAPANESE PATENT OFFICE

In November 1997, the Japanese Patent Office (JPO) organized seminars on the Community Trade

Mark (CTM) system in Tokyo and Osaka where President Jean-Claude Combaldieu and Vice-President Alexander v. MÜhlendahl introduced the CTM system to Japan and explained its operation. At the same time, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) and the JPO agreed to enter into a Memorandum of Understanding (MOU), which concerns cooperation between the two offices. Since its official opening in 1996, the OHIM has been achieving remarkable results under the spotlight of the whole world. The CTM system, a simple procedure which leads to a registration effective in all the Member States of the European Union, is an advanced system even on a world level and Japanese applicants will benefit greatly from using it.

In the two seminars, which attracted a large audience, the impressive speeches of President Combaldieu and Vice-President v. MÜhlendahl gained the interest of the audience. It is hoped the applications to the OHIM from Japan will increase dramatically in the future.

The efforts up until now of the OHIM in preparing and implementing the computerization of trade mark examination procedures deserves attention and we think that we can learn a lot from these developments.

The MOU was finally concluded on 12 March 1998. It establishes the basis of cooperation between the OHIM and the JPO. It is certainly an honor for us that we can begin cooperating with periodic meetings, exchanges of staff, information exchange and the exchange of technology. The essence of the MOU is mutual understanding and cooperation. For all of you to understand the current situation of Japan, I will explain the recent developments concerning the Japanese trade mark system.

Japan, in order to cope with the current globalization of economic activity, revised its Trade Mark Law in 1996 to join the Trade Mark Law Treaty, and in April 1997 the JPO put this revision into effect.

During 1997 the number of trade mark applications received by the JPO was about 133,000. The JPO, in order to secure a prompt and precise administration of such a huge number of examinations and trials/appeals, aims to shorten the "First Action" period for trade mark applications (the period from the date of filing to the date of first notification of reasons for refusal or decision of registration) to 12 months by the year 2000. In 2005, it aims to realize its second initiative, "Real Time Operation", which involves the processing of applications more promptly and smoothly during an even shorter examination period. In order to achieve these objectives, the JPO will carry out the Trade Mark Paperless Plan, deal with the increase in the examination staff, and other policies.

In respect of the Trade Mark Paperless Plan, we aim to realize an electronic application system which will allow the filing of an application from a personal computer, pursuing formality examination and substantive examination procedures. We are progressing with the development of this system with the aim of beginning its operation in January 2000.

In addition, we prepare to offer a list of trade mark applications, registered trade marks and a list of well-known/famous trade marks using the Internet from July 1998. We also plan to issue the Trade Mark Gazette through an electronic medium by the year 2000.

Moreover, the JPO is contributing to the WTO-TRIPS, WIPO and APEC discussions on the international harmonization of intellectual property rights. The JPO is also studying the participation in the Madrid Protocol Relating to the Agreement Concerning the International Registration of Marks.

It is expected that the cooperation between the OHIM and the JPO will not just contribute to the development of the trade mark systems of Europe and Japan but also contribute to the international harmonization of intellectual property rights on a world-wide level. In order to achieve this, we think that it is important to build a friendly relationship between the two offices.

DESDE EL 04/04/98 NUEVOS NÚMEROS TEL. Y FAX DE LA OAMI - NACH DEM 04/04/98
NEUE TELEFON- UND FAX NUMMERN DES HABM - FROM 04/04/98 OHIM HAS
NEW TEL AND FAX NUMBERS - A PARTIR DU 04/04/98 - NOUVEAUX NUMÉROS TEL. ET FAX
A L'OHMI - DAL 04/04/98 NUOVI NUMERI TEL E FAX DELL'UAMI
VER PÁGINA 4 / SIEHE SEITE 4 / SEE PAGE 4 / VOIR PAGE 4 / VEDERE PAGINA 4

PARTNERSHIPS AS PROPRIETORS OF COMMUNITY TRADE MARKS

The issue

Since the Office has very often been consulted on the possibility for a partnership to be proprietor of a Community trade mark (CTM), we find it necessary to give some information about this matter and explain why the Office has arrived at the position that a partnership can be proprietor of a CTM. Our analysis will be carried out by taking into account UK law. However, the findings can also be extended to partnerships established under other common law jurisdictions, such as the laws of the States of the USA, or under Canadian, Australian and South African law, as the principles underlying partnerships are essentially the same in all common law jurisdictions.

Partnership defined

Section 1 of the UK Partnership Act of 1890, which also applies to Ireland by virtue of Article 73 of the 1922 Irish Constitution and Article 50(1) of the 1937 Irish Constitution, defines a partnership as a "relation which subsists between persons carrying on a business in common with a view to profit".

The legal basis: Articles 5 and 3 CTMR

Pursuant to Article 5(1)(a) of the Community Trade Mark Regulation (CTMR) "nationals of the Member States" who are "natural or legal persons, including authorities established under public law, may be proprietors of Community trade marks". This Article has to be read in conjunction with Article 3 CTMR which specifies that "For the purpose of implementing this Regulation, companies or firms and other legal bodies shall be regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue or be sued." According to Article 5 CTMR, a person who can be proprietor of a CTM, must be either a natural or a legal person.

Article 3 CTMR extends this capacity to certain entities ("companies", "firms", "other legal bodies") which, while they do not have legal personality in the strict sense, are to be regarded as legal persons.

It is clear that a partnership is not a natural person or a legal person. Thus, partnerships do not fall under Article 5 CTMR. The question therefore arises as to whether a partnership, as a "company", "firm" or "other legal body", can be regarded as a legal person under Article 3 CTMR. A "company", 'firm' or 'other legal body' can be regarded as a legal person if it has the capacity, in its own name, under the laws of the relevant State:

- to have rights and obligations of all kinds,
- to make contracts or accomplish other legal acts, and
- to sue or be sued.

Applying the criteria of Article 3 CTMR to partnerships

a) Partnerships are firms

The English text of Article 3 CTMR refers to "companies or firms and other legal bodies". The French text (like the Italian, Spanish and German texts) simply refers to "les sociétés et les autres entités juridiques." The insertion of the word 'firm', in the English language version must, therefore, be construed as having some special meaning, designed to take into account the special characteristics of the law in English-speaking jurisdictions.

It is evident that the insertion of the word "firm" is designed to take into account the special characteristics of partnership arrangements, particularly since, in English law, the word "firm" is synonymous with a partnership pursuant to Section 4 of the Partnership Act 1890: "Persons who have entered into a partnership with one another are for the purposes of this Act called collectively a firm, and the name under which their business is carried on is called the firm-name". In any event the terms "company", "firm" and "other legal bodies" overlap

to a large extent as they seek to cover the various entities ("legal bodies") established under the laws of the countries of the world which have no legal personality in the strict sense.

b) A partnership may make contracts or accomplish other legal acts in its own name

Where a partnership subsists, any act carried out in the context of, and related to the business of the partnership, automatically binds the partnership and all of its members. The power to bind the partnership as a collective is the distinguishing characteristic of a partnership. It is not necessary that the act in question is that of a member. The partnership will be bound in all of the following instances:

- Firstly, contracts may be made and other legal acts may be accomplished in the firm-name.
- Secondly, a contract made or other legal act, relating to the business of the firm, accomplished by a partner is deemed to be an act of the firm and all of its partners.
- Thirdly, a contract made or other legal act accomplished is deemed to be that of the firm even where the act in question is of an authorized person other than a partner.

c) A partnership may have rights and obligations of all kinds in its own name

The partnership has all the rights and obligations incidental to the business of the kind carried on by it. They depend on the nature of the business carried on by the firm, the customs and usages of the business, and whether or not it is a trading partnership. The explicit references to "partnership property," "partnership assets," and "money belonging to the firm" in the Partnership Act, clearly demonstrate that these rights and obligations exist in the name of the partnership. These rights and obligations may also be exercised by, or against, a partner

since partnership property is distinct from the property of its members.

d) A partnership may sue or be sued in its own name

Rule 1 of Order 81 of Rules of the Supreme Court provides that partners may sue or be sued in the name of the firm. Consequently an action may be brought in the name of the firm:

– on any matter arising out of a contract in the name of the firm or binding on the firm.

– for liabilities in tort, where the firm is liable to make good the loss to third parties, and/or is liable to the same extent as the partners.

Given that partnership property is distinct from its members, a writ of

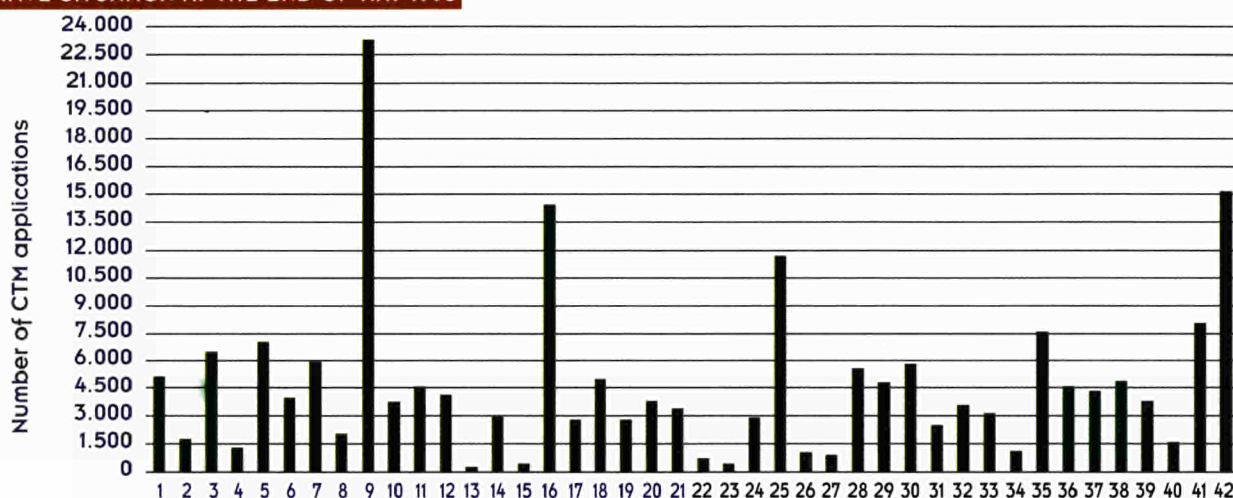
execution may not be issued against any partnership property for a partner's separate judgment debt, except on a judgment against the firm.

5. Conclusion

Partnerships fall under Article 3 CTMR and may therefore be proprietors of CTMs.

COMMUNITY TRADE MARK APPLICATIONS. BREAKDOWN ACCORDING TO THE INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES

CUMULATIVE SITUATION AT THE END OF MAY 1998



CLASSES OF THE NICE AGREEMENT CONCERNING THE INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES

STATISTICS OF COMMUNITY TRADE MARKS. COMMUNITY TRADE MARK APPLICATIONS. BREAKDOWN PER COUNTRY

SITUATION AT THE END OF MAY 1998

	1996+1997	%	1998 (31.05.98)	%	Total	%
TOTAL WORLD	70.248	100	12.224	100	82.472	100
TOTAL EUROPEAN UNION	41.771	59,46	7.739	63,31	49.510	60,03
BELGIQUE/BELGIË [BE]	1.061	1,51	227	1,86	1.288	1,56
DANMARK [DK]	1.179	1,68	206	1,69	1.385	1,68
DEUTSCHLAND [DE]	11.625	16,55	1.669	13,65	13.294	16,12
ELLAS [GR]	150	0,21	28	0,23	178	0,22
ESPAÑA [ES]	4.262	6,07	795	6,50	5.057	6,13
FRANCE [FR]	3.501	4,98	834	6,82	4.335	5,26
IRELAND [IE]	499	0,71	98	0,80	597	0,72
ITALIA [IT]	4.281	6,09	991	8,11	5.272	6,39
LUXEMBOURG [LU]	249	0,35	46	0,38	295	0,36
NEDERLAND [NL]	1.977	2,81	390	3,19	2.367	2,87
ÖSTERREICH [AT]	1.071	1,52	202	1,65	1.273	1,54
PORTUGAL [PT]	344	0,49	93	0,76	437	0,53
SUOMI/FINLAND [FI]	640	0,91	112	0,92	752	0,91
SVERIGE [SE]	1.568	2,23	346	2,83	1.914	2,32
UNITED KINGDOM [GB]	9.364	13,33	1.702	13,92	11.066	13,42
TOTAL OUTSIDE EUROPEAN UNION	28.477	40,54	4.485	36,69	32.962	39,97
Amongst which=						
UNITED STATES OF AMERICA [US]	20.508	29,19	3.001	24,55	23.509	28,51
JAPAN [JP]	2.137	3,04	311	2,54	2.448	2,97
SWITZERLAND [CH]	1.419	2,02	208	1,70	1.627	1,97
CANADA [CA]	818	1,16	143	1,17	961	1,17
AUSTRALIA [AU]	551	0,78	104	0,85	655	0,79
TAIWAN [TW]	311	0,44	94	0,77	405	0,49

Statistics Relating to Community Trade Mark Applications

	1998 (up to 05.06.98)	1996+1997	Total
Filing dates accorded	14.173	62.617	76.790
Classification done	14.510	50.611	65.121
Applications published	20.110	11.633	31.743
Oppositions filed	2.950	765	3.715
Contested applications	2.239	580	2.819
Appeals	80	21	101

Other OHIM Figures

NUMBER OF PROFESSIONAL REPRESENTATIVES	5.262
NUMBER OF CURRENT ACCOUNTS	543
OHIM PERSONNEL	343

"MERGER" OF RECEIPT AND FILING DATE

Pursuant to Rule 5 of the Implementing Regulation (IR) the Office is obliged to issue a receipt for each Community trade mark (CTM) application received as soon as possible. Under current practice, such receipts are issued within five working days of the date of actual receipt.

Pursuant to Articles 26 and 36 of the Community Trade Mark Regulation (CTMR) and Rule 9 (1) IR the Office is further obliged to attribute a filing date for all CTM applications which fulfil the minimum requirements (request, representation of the mark, list of goods and services, indication of applicant, payment of the basic application fee within a month from the date of receipt). Under present practice the Office issues such filing date attributions by separate letter addressed to the applicant or his representative within two months from the date of filing and, when the payment accompanies the application, even before that time, usually within a few weeks.

After having consulted the international NGOs with whom the Office cooperates the Office has decided to "merge" these two operations: very soon, the receipt will also contain a "provisional" filing date attribution in the following manner:

- Where the minimum requirements for the attribution of a filing date are met, the receipt issued by the Office within the first few days after the actual filing will state that the receipt date is also the filing date under Article 27 (3) CTMR and Rule 9 (1) IR provided that the basic application fee is paid within one month from the receipt date.
- Where the minimum requirements for the attribution of a filing date are not met, the Office will continue to issue a receipt as was previously the case and will deal with the filing date issue by a separate action.

- The Office will debit current accounts in accordance with current practice, i.e. generally at the end of a period of one month after the date of filing the application unless the applicant has requested an immediate debit. The applicant or his representative will be informed of the debiting in the usual manner by receiving an account statement, whereas the Office will no longer send a separate filing date attribution letter.

- When payments are made other than by debiting a current account, i.e. by cheque or money transfer, the Office will cash the cheque or credit the account with the money received. As in the case of debiting current accounts, the Office will not inform the applicant or his representative of the timely payment and will no longer send a filing date letter.

- Where payment of the basic application fee is not made in due time, i.e. within one month from the receipt of the application, the Office will inform the applicant or his representative accordingly pursuant to the applicable provisions of Rule 9 IR.

The new practice will facilitate the task of applicants or their representatives in handling applications. It will also facilitate the tasks of the Office because in the overwhelming majority of cases no separate filing date communication will be required, whereas of course the checking of whether the basic application fee has been paid will continue to be necessary.

The new Office practice will not delay the issuing of receipts; rather, these will continue to be issued within five working days from receipt.



DESDE EL 04/04/98 NUEVOS
NÚMEROS TEL. Y FAX DE LA OAMI

NACH DEM 04/04/98
NEUE TELEFON- UND FAXNUMMERN
DES HABM

FROM 04/04/98 OHIM
HAS NEW TEL AND FAX NUMBERS

A PARTIR DU 04/04/98 -
NOUVEAUX NUMÉROS TEL. ET FAX À
L'OHMI

DAL 04/04/98 NUOVI NUMERI TEL
E FAX DELL'UAMI

USEFUL NUMBERS

- Standard telephone number:
+ 34 965 13 9 100
 - General information telephone number:
+ 34 965 139 243; + 34 965 139 272
 - General information fax number:
+ 34 965 139 173
- Explanations concerning the application form, questions concerning the registration procedure (priority, seniority, fees, etc.), CD-ROM giving details of the CTM applications, request of documents/literature (leaflets, application forms including electronic filings, authorisations, opening of current accounts, reference guide to official texts, places where to buy the Official Journal of the Community, etc.).
- Fax for CTM applications and any correspondence relating to such applications, as well as for all other proceedings relating to CTMs (opposition, appeal, request of certified copies, etc.):
+ 34 965 131 344
 - Telephone information concerning means of payment: + 34 965 139 340
Opening of current accounts, bank transfers, payments by cheques, etc.
 - Telephone information about representation:
+ 34 965 139 117
List of professional representatives, new entries, allocation of ID numbers, authorisations, etc.
 - Telephone information concerning publications:
+ 34 965 139 102
Information on OHIM's Official Journal, the Bulletin of CTM, etc.
 - Telephone number of the Registry of the Board of Appeal :
+ 34 965 139 399
 - WEB Site : Europa Server
<http://europa.eu.int/agencies/ohim/ohim.htm>