



2000

OAMI

OFICINA DE
ARMONIZACIÓN DEL
MERCADO INTERIOR
(MARCAS, DIBUJOS
Y MODELOS)

HABM

HARMONISIERUNGSAMT
FÜR DEN BINNENMARKT
(MARKEN, MÜNSTER,
UND MODELLE)

OHIM

OFFICE FOR
HARMONIZATION
IN THE INTERNAL
MARKET
(TRADE MARKS
AND DESIGNS)

OHMI

OFFICE DE
L'HARMONISATION
DANS LE MARCHÉ
INTÉRIEUR
(MARQUES, DESSINS
ET MODÈLES)

UAMI

UFFICIO PER
L'ARMONIZZAZIONE
NEL MERCATO INTERNO
(MARCHI, DISEGNI
E MODELLI)



Occupation of the Office's new building located in the Agua Amarga area to the south of the city of Alicante will begin on 1 July next.

For the present, this will not affect the Office's postal address, since the Mail Division will remain at the current seat at Avenida de Aguilera 20 until the end of September. The post box for the receipt of overnight correspondence will remain in operation at Avenida de Aguilera 20.

Occupation of the Agua Amarga building will likewise not affect the Office's telephone and fax numbers or electronic mail addresses, all of which will remain the same indefinitely.

The removal will be carried out over two consecutive weekends. It has been organised in such a way that it will not affect the Office's activities. The staff will leave their current workstations on the Friday evening and go to the new building on the follow-

ing Monday morning. Members of staff will, from the very first, be able to continue their tasks at their usual pace and without, therefore, affecting the Office's productivity.

The working days between the two weekends during which staff are to be moved will be used to transfer the general archives, stores and other items for common use.

The new seat will be fully occupied by 10 July, with work proceeding at full capacity.

Characteristics of the new building

The building comprises almost 40 000 m². It was purpose-built for the OHIM by a consortium of Spanish public authorities, and tailored to the needs of our Organisation. It is located on a site of 26 000 m², donated to the Office by the host state authorities. The site is situated in a newly developed •••

••• services area close to the airport and just a few metres from the Mediterranean Sea.

The building is divided into three parts:

- A main block, with 5 office floors and nominal capacity for 400 people, as well as three basement floors with stores, auxiliary services and technical installations, and a ground floor comprising a restaurant for 280 place settings and a cafeteria.
- An annex, housing the rooms to be used for public hearings as well as the meeting and training rooms.
- Two pavilions adjoining the Boardroom, plus the reception area for the public and for the receipt of applications.

The building, completely overlooking the bay of Alicante, was designed to take maximum advantage of natural light and the local scenery. Efforts were made to combine the transparency and grace inherent in modern buildings with the institutional aura that must be conveyed by the seat of a public organisation. From the aesthetic point of view, the

result has been generally praised by all those who have had an opportunity to visit it.

The building is equipped with the latest internal telecommunications network, geared to cope without difficulty with the future requirements of an office like the OHIM which processes a large volume of files exclusively by electronic means, files in which colour images are an essential component.

The various kinds of technical equipment required by the Office's complex functioning have been installed. The construction work took into account the latest developments in construction engineering, particularly in terms of the resistance of the structure and air-conditioning systems.

Layout of the office following the removal

Because of the Office's considerable growth, the building now being inaugurated is already insufficient to house all the staff. Therefore the provisional

premises at Avenida de Aguilera 20 (to date the main seat), at Calle Castellar 3 and at Calle Italia 32 will remain in use. This situation will continue until Phase II of the building planned for the Agua Amarga site is completed. Work on this is already in progress.

The Office units have been distributed between the various available premises in such a way as to disrupt as little as possible the functioning of the Organisation. The Administrative and Technical Services Department, the Legal Department, the Technical Cooperation Division, the Opposition Division and the Cancellation Division will be at the Agua Amarga building. The Examination Division, the Boards of Appeal and the Trade Mark Logistics Service will be housed in the building on the Avenida de Aguilera. The premises at the Calle Castellar and the Calle Italia will comprise support units which, because of their functions, are fully autonomous. They include the Technical Service of the Vice-Presidency for Legal Affairs and the Trade Mark File Documentation Service.

2

INTA DENVER MEETING, MAY 2000

With its setting against the backdrop of the beautiful Rocky Mountains, Denver had all the makings of a perfect venue for this year's annual INTA (International Trademarks Association) meeting. This year saw some 6000 professionals from more than 120 countries coming together for the largest meeting of the worldwide trade mark community.

Besides a number of working and educational sessions—held in conjunction with the various committee meetings—there were over 100 exhibition booths on display at this year's annual meeting. These stands offered exhibitors a real opportunity to present their services, conduct business-related meetings and—more generally—network.

For both the Office and INTA, Denver was a "first": the first time that OHIM had exhibited at an INTA meeting and the first time that INTA had held bilingual conference sessions in English and Spanish.

Armed with portable computers, information package diskettes and brochures, three OHIM members of staff accompanied Vice-president for Legal Affairs, Mr A. von Mühlendahl, to Colorado's capital city. The purpose of OHIM's stand at this year's meeting was to increase public awareness of the Office's activities and, more generally, to expound the advantages of the CTM.

The INTA meeting attendees, although still drawn in great majority from the U.S. and Canada, are nonetheless increasingly representative of Latin America, Europe, the Indian sub-continent, Asia and Australasia. It was, therefore, hardly surprising that the range of questions received at the OHIM stand also reflected such a diverse interest base. With over 600 visitors to our stand in three days, it was pleasantly surprising to find how well informed and genuinely interested many people were in the activities of our Office. In particular, trade

mark agents and lawyers were interested in receiving additional information on the Office's current policy on matters such as direct filing of applications by non-EU nationals, retail service marks, opposition, seniority, transfers and licences. In addition, some professionals wanted to hear what the CTM offers over and above the Madrid Arrangement and Protocol.

Our overall impression was that the Office's presence at the INTA meeting was an extremely useful exercise. This is an almost unique opportunity for the Office to meet face-to-face with actual and potential clients around the globe. Trade mark professionals from all over the world appear keen to learn more about the CTM so they can maximise efficiency of industrial property risk management portfolios and become better advisors. This can only be to the benefit of both the Office and its users.

NOMINATION DU NOUVEAU PRÉSIDENT DE L'OHMI

Le 2 mai 2000 le Conseil des Ministres de l'Union européenne a nommé Monsieur Wubbo de BOER comme Président de l'Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) pour la période du 1er

octobre 2000 au 30 septembre 2005.

Né en 1948 aux Pays Bas, Monsieur de BOER est actuellement directeur général de l'Aviation civile. Après des études juridiques à l'Université d'Amsterdam où il s'est

spécialisé dans la propriété intellectuelle, il a mené une carrière de haut fonctionnaire dans différents ministères notamment au Ministère des affaires économiques où il a exercé de nombreuses responsabilités comme directeur général.

STATISTICS (SITUATION AT THE END OF MAY 2000)

COMMUNITY TRADE MARK APPLICATIONS

BREAKDOWN BY COUNTRY

	1996-1999	%	2000 (30.04.00)	%	Total	%
Total world	143.062	100	18.596	100	161.658	100
	1996-1999	%	2000 (30.04.00)	%	Total	%
Total European Union	87.715	61.31	11.907	64.03	99.622	61.63
Belgique/België [BE]	2.197	1.54	238	1.28	2.435	1.51
Danmark [DK]	2.326	1.63	297	1.60	2.623	1.62
Deutschland [DE]	23.476	16.41	3.306	17.78	26.782	16.57
Ellas/Greece [GR]	339	0.24	44	0.24	383	0.24
España [ES]	8.836	6.18	1.192	6.41	10.028	6.20
France [FR]	8.367	5.85	1.095	5.89	9.462	5.85
Ireland [IE]	1.124	0.86	161	0.87	1.385	0.86
Italia [IT]	9.922	6.94	1.339	7.20	11.261	6.97
Luxembourg [LU]	624	0.44	110	0.59	734	0.45
Nederland [NL]	3.848	2.69	508	2.73	4.356	2.69
Österreich [AT]	2.223	1.55	268	1.44	2.491	1.54
Portugal [PT]	850	0.59	135	0.73	985	0.61
Suomi/Finland [FI]	1.357	0.95	173	0.93	1.530	0.95
Sverige [SE]	3.225	2.25	440	2.37	3.665	2.27
United Kingdom [GB]	18.901	13.21	2.601	13.99	21.502	13.30
	1996-1999	%	2000 (30.04.00)	%	Total	%
Total Outside European Union	55.347	38.69	6.689	35.97	62.036	38.37
Amongst which =						
United States of America [US]	39.044	27.29	4.601	24.74	43.645	27.00
Japan [JP]	3.861	2.70	386	2.08	4.247	2.63
Switzerland [CH]	2.663	1.86	325	1.75	2.988	1.85
Canada [CA]	1.725	1.21	241	1.30	1.966	1.22
Australia [AU]	1.241	0.87	207	1.11	1.448	0.90
Taiwan [TW]	899	0.63	97	0.52	996	0.62

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	2000 (02.06.00)	1996-1999	Total
Filing dates accorded	23.764	132.780	156.544
Number classifications checked	20.125	126.970	147.095
Applications published	19.810	98.583	118.393
Opposition	5.133	21.024	26.157
Contested applications	3.783	15.754	19.537
Appeals	539	1.132	1.671
Registered Trade Marks	15.194	59.147	74.341
Published Registered Trade Marks	18.108	55.513	73.621
Requests for cancellation	41	79	120

OTHER OHIM FIGURES

	ON 10-06-00
Number of professional representatives	5.554
Number of current accounts	801
OHIM Personnel	531

IF THE REFUSAL OF A CTM APPLICATION IS BASED ON LACK OF DISTINCTIVENESS AND/OR ON DESCRIPTIVENESS OF THE SIGN IN A PART OF THE COMMUNITY, MUST THE EVIDENCE OF ACQUIRED DISTINCTIVENESS REFER TO THAT PART OF THE COMMUNITY?

This very question was the key issue of the *OPTIONS* case recently decided by the Court of First Instance of the European Communities (CFI) in its judgement of 30 March 2000, in Case T-91/99, *Ford Motor Co. v. OHIM*.

The background to that dispute was the following: Ford Motor Company filed an application at the Office requesting the registration of the sign *OPTIONS* for "insurance, warranty, financing, hire-purchase and lease-purchase services" in class 36. The application was refused by a decision of the Examination Division which considered the sign applied for as devoid of any distinctive character and descriptive in English and French. The applicant appealed and in the grounds of its appeal produced evidence to show that the sign *OPTIONS* had been used in Belgium, Denmark, the Netherlands, Portugal, Sweden and the United Kingdom. Use was not, however, claimed in respect of France. The appeal was dismissed by a decision of the Second Board of Appeal on the ground that, even if the sign at issue had become distinctive through use in the UK, it would not be inherently distinctive in France as use of the sign in France had not been claimed.

The decision was appealed to the CFI on the basis of a single plea, namely the infringement of Article 7(3) of the CTMR. In support of that plea, the applicant argued that there is no requirement in Article 7(3), or anywhere else in the CTMR, for distinctiveness through use to be shown

throughout the Community. It would therefore be sufficient, in order to overcome an objection of non-registrability under Article 7(1)(b) and (c) CTMR, to demonstrate distinctiveness acquired in a substantial part of the Community. According to the applicant, this principle also applies where, as in the case at issue, the objection of non-registrability concerns only part of the Community and no distinctiveness is demonstrated with regard to that part.

The CFI in its judgement of 30 March 2000, did not share the applicant's opinion on the interpretation of Article 7(3) CTMR. Contrary to the applicant's assertions, the CFI stated that where the refusal of registration of a CTM is based on lack of distinctiveness and on descriptiveness of a trade mark in part of the Community (Article 7(1)(b) and (c) in conjunction with Article 7(2) CTMR), any challenge to that refusal of registration, based on the ground of distinctiveness acquired through use, necessarily requires that acquisition of distinctiveness be demonstrated with regard to that part of the Community where distinctiveness was denied.

The Court referred to the principle of the unitary character of the Community trade mark established in Article 1(2) CTMR, and held that the principle requires that, in order to be accepted for registration, a sign must possess distinctive character throughout the entire Community.

The CFI's decision confirms the Office's practice in all cases where an objection to the registration of a sign is based on lack of distinctiveness, descriptiveness or generic character in part of the Community. Indeed, even prior to the CFI's decision, for the refusal to be overcome on the ground of acquired distinctiveness pursuant to Article 7(3) CTMR, the Office as well as its Boards of Appeal have always required that distinctiveness be demonstrated with regard to the part of the Community concerned by the objection.

Details of the Office's approach to acquired distinctiveness may be found in a Practice Note available on the Office's website (oami.eu.int). The decisions of the Boards of Appeal, including the decision referred to above, are similarly available on the Office's website.

USEFUL NUMBERS

Switchboard telephone number:
+ 34-965 139 100

General inquiries telephone number:
+ 34-965 139 243 and + 34-965 139 272

General inquiries fax number:
+ 34-965 139 173

The Office's Internet site: oami.eu.int

Requests for literature (leaflets, standard forms, official texts, places where to buy Office publications, etc.), questions concerning the filing of applications, questions concerning procedure (fees, priority, seniority, etc.).

Fax number for the filing of any correspondence relating to community trade marks, (applications, letters to examiners, oppositions, cancellations, appeals, Register matters, etc.):
+ 34 -965 131 344

CTM applicants and proprietors and their representatives are strongly urged to use exclusively the above fax number where faxes arrive at an automatic fax server which does not involve any printing and physical handling of documents, for all communications relating to proceedings before the Office. This will facilitate and accelerate the handling of incoming faxes, whereas the sending of such communications to other fax numbers in the Office will require additional operations and creates substantial administrative burdens.

Telephone number for obtaining information concerning means of payment:
+ 34-965 139 340

Opening of current accounts, bank transfers, payments by cheques, etc.

Telephone number for obtaining information about professional representatives:
+ 34-965 139 117

List of professional representatives, new entries, allocation of ID numbers, authorisations, etc. Obtaining information in relation to copies from the file and extracts from the register:
+ 34-965 139 633

Obtaining information in relation to transfers, licences, conversions:
+ 34-965 139 515 and + 34-965 139 175

Telephone number for obtaining information concerning from the files or from the Register:
+ 34-965 139 175

Telephone number for obtaining information concerning subscriptions to our publications:
+ 34-965 139 102

OHIM's Official Journal, the Bulletin of CTMS (paper and CD-ROM), EUROM, etc