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## editorial

“Harmonization in the internal market.” Unattainable goal? No. Difficult? Yes. Nonetheless, for more than 20 years visionary individuals within the European Union have stayed the course in taking on a myriad of issues. Trademark owners continue to cheer them on, hoping for an easy, cost effective and reliable means to protect their marks. Much remains to be done, however.

Consider for instance the 1988 Directive to “approximate” the trademark laws of the EU member states. The Directive was a significant step forward in harmonizing the laws of thirteen jurisdictions, each rich in its own culture and jurisprudence. While trademark laws may have been approximated, convergence of examination practices has been much slower. Witness the differences in examination practice for what is allowed for geographical names, surnames, and alpha-numeric marks.

These issues have persisted, even with the establishment of the Community Trade Mark System under the 1993 Regulation. Variation in examination standards affects a trademark owner’s decision as to whether to apply for a CTM, go the national route, or use the Madrid System. It is worth remembering that the Directive’s objectives were to: (1) attain identical conditions in each member state for obtaining and continuing to hold a registered trademark; (2) reduce the number of registered or protected trademarks; and (3) facilitate the free circulation of goods and services. Out of this effort should come increased uniformity in trademark office practice and increased certainty for trademark owners as to what marks will be registered.

In the meantime, clashes continue between national laws and practice and evolving interpretation of both the Directive and the CTM Regulation. Decisions from the European Court of Justice will assist in aligning standards on issues such as distinctiveness, dilution, color and other non-traditional marks. The process is long and arduous.

All this is not to deny that some significant milestones have been passed. Take for instance the recent action by OHIM with regards to “retail service” marks. Following the 1999 decision by the OHIM Board of Appeal overturning an examiner’s decision that the retail service mark Giacomelli Sport was ineligible for registration, OHIM faced the problem of implementing the Board’s decision while most member states failed to recognize such marks. Thus, protection of marks for retail services throughout the EU looked uncertain at best. INTA has long held the view that marks for retail services should be registrable and encouraged discussion of the issues involving the UK Trade Marks Registry and OHIM in particular. The UK Office in August 2000 took the initiative and announced that it had changed its practice. By March 2001, OHIM, after extensive consultation with the trademark community and member states, also announced that it would begin to accept applications for registration of retail services. Recently, the Benelux Office began to accept such applications. INTA will continue to encourage other national offices to open their doors to retail services.

Another major hurdle for harmonization and for the CTM System will be the impact of new countries joining the EU. I am pleased that INTA has been invited to participate in discussions with OHIM and European Commission officials, in particular making available INTA resources to research the issue of how to address the problem of trademark applications filed in bad faith in different jurisdictions.

To finish on a personal note, I was delighted to be present, representing INTA, at the last OAMI Group meeting in Alicante at the beginning of the year. Much constructive discussion and exchange of information took place. Willingness to discuss the issues, to exchange ideas for solutions and to work with the trademark community will result in real progress towards harmonization of law and practice within the EU.

### 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  
(MARCQUES, DESSINS  
ET MODÈLES)

### UAMI

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

## OPPOSITION: BILAN SUR LES QUATRE ANNÉES D'ACTIVITÉ.

Mai 1997-mai 2001, quatre années d'activité de la Division d'Opposition. Quatre ans et quelques milliers d'oppositions plus tard, quel bilan peut-on tirer ?

Au regard de l'évolution de son activité, la Division a reçu depuis le 20 mai 1997 quelques 39.000 oppositions. En valeur absolue, chaque année est marquée par une augmentation constante et continue du nombre d'oppositions : 830 en 1997, 10.532 en 1998, 10.658 en 1999, 11.495 en 2000. Il est prévisible que pour l'année 2001 nous recevions autour de 12.500 oppositions. Cette augmentation est également sensible lorsque l'on compare le ratio demandes publiées / oppositions reçues. Ce ratio était de 24,8% en 1997, il est maintenant de 28,1% de 2001.

Si l'activité globale n'est pas encore complètement stabilisée et que le nombre de dossiers en cours de traitement est en augmentation continue, le ratio «nouveaux dossiers / dossiers clôturés» est quant à lui passé de 23% en 1998 à 85% en 2000. A l'heure actuelle, 62% de tous les dossiers reçus ont été traités.

Cette augmentation de la productivité a été rendue possible d'abord grâce à un accroissement rapide du personnel de la Division. De 14 personnes en 1996, ce chiffre est passé à 30 en 1997, puis à 84 en 1999, pour s'établir en mai 2001 à 102 personnes dont 35 juristes, 27

assistants et 40 secrétaires. L'Office ayant développé des accords de coopération avec les Offices nationaux des Etats membres, la Division compte également 1 juriste détaché de l'Office britannique.

Pendant cette même période la Division d'Opposition a créé puis consolidé sa pratique. Etablir une nouvelle procédure dans un contexte nouveau demande un investissement humain très important et d'une haute qualité. La formation interne donnée au personnel, les outils informatiques mis à sa disposition, l'expérience qu'il a acquise dans un environnement de «gestion de l'urgence» et sa motivation ont également contribué très fortement à dégager les principes les plus importants pour l'application de l'article 8 du règlement sur la marque communautaire et à maintenir les délais dans des limites acceptables par les usagers du système communautaire.

Au-delà de tous ces chiffres bruts, il semble que la procédure d'opposition, bien que complexe dans sa mise en application avec toutes ses séries de délais et d'obligations imposées aux parties, ait rencontré son public. En effet, l'une des grandes forces de cette procédure est la fameuse «Cooling-Off Period». Il s'agit de cette possibilité donnée aux parties de négocier à moindres coûts dans le temps qui leur est nécessaire. L'Office n'a alors pour seul pouvoir que le contrôle de la durée de cette période transitoire. Le succès de cette option

se reflète par un seul chiffre : 70% des dossiers clôturés à ce jour l'ont été à l'amiable. L'Office n'a donc eu à statuer que dans 30% des cas, soit dans 4.700 dossiers, par une décision portant sur la forme (10%) ou sur le fond (90%). Le pourcentage d'appel devant les Chambres de Recours sur ces décisions s'élève à 26%.

L'information donnée par l'Office sur l'opposition à travers son site Internet est également un élément apprécié par les usagers. Les directives de procédure et surtout toutes les décisions prises par la Division d'opposition sont en lignes et disponibles pour le public.

Il est évident que des améliorations restent à mettre en place. La préoccupation principale porte actuellement sur l'augmentation du nombre total de dossiers en cours de traitement. Cette hausse a une implication directe et évidente sur l'allongement moyen de la durée de la procédure qui est actuellement de 18 mois. Ce prolongement est peu sensible pour les délais fixés en cours de procédure mais il est de plus en plus courant qu'une procédure fasse l'objet de plusieurs séries d'échanges d'observations entre les parties ou d'extension de délai. En effet, la durée d'une procédure et le nombre d'échanges est avant tout déterminé par les parties ainsi, pour exemple, il existent encore quelques (peu) oppositions reçus en 1997 se trouvant toujours en phase de «Cooling-Off».

## LA «VENTE AU DÉTAIL» DÉSORMAIS ADMISE

Suite à une communication n°3/01 du Président de l'Office du 12 mars 2001, l'Office reconnaît désormais les services fournis en relation avec la vente au détail des produits. Ce texte que vous pouvez trouver sur notre site Internet <http://www.oami.eu.int> précise la nouvelle pratique de l'Office à l'égard de cette formulation fréquemment utilisée dans les libellés des produits ou services des demandes de marques communautaires. Il en résulte qu'une marque communautaire peut désormais être valablement enregistrée pour des "services de vente au détail" (classe 35).

Cela constitue un changement important dans la pratique d'examen de l'Office. Auparavant, ce dernier suivait la déclaration conjointe du Conseil et de la Commission des Communautés européennes n° B.2 qui refusait de traiter l'activité de la vente en détail comme un service (JO OHMI 1996, p. 607, 613). Certaines circonstances parmi lesquelles la décision de la deuxième chambre de recours dans l'affaire «Giacomelli» (R 46/1998-2) du 17 décembre 1999, le changement d'approches de la part de certains offices des Etats membres ainsi que l'évolution de la réalité économique ont conduit

l'Office à reconnaître au rang de services les prestations diverses offertes en accompagnement de la vente au détail de produits.

Cette nouvelle approche ne s'applique pas seulement aux nouvelles demandes de marques communautaires. La Communication précise que l'Office en fera également bénéficier les demandes de marques communautaires en cours d'enregistrement dans les conditions suivantes:

- les demandes non encore examinées qui incluent les services de vente au détail ne feront l'objet d'aucune objection;
- la procédure suivie à l'égard des demandes ayant fait l'objet d'un examen défavorable varie selon qu'elles ont fait ou non l'objet d'une décision de rejet:
  - dans l'hypothèse où l'Office a seulement invité le demandeur à remédier à une telle irrégularité (conformément à la règle 9, paragraphe 3 du Règlement d'exécution), l'Office retirera de son propre chef son objection initiale sans qu'aucune action ne soit requise de la part du demandeur;
  - dans l'hypothèse en revanche où l'Office a déjà pris une décision de rejet total ou partiel de la

demande, le demandeur doit faire recours devant la chambre de recours dans la mesure où le délai de recours n'est pas expiré. Il sera automatiquement fait droit au recours au moyen de la révision préjudicielle.

Pour des raisons de sécurité juridique, l'Office recommande toutefois aux déposants, qui souhaiteraient utiliser l'option qui leur est désormais offerte, d'indiquer les produits concernés par les services de vente au détail qu'ils revendiquent. Cela leur permettrait:

- d'une part, d'éviter des oppositions intempestives basées sur des marques ou autres signes antérieurs exploités en relation avec des produits différents;
  - d'autre part, de bénéficier d'une protection ayant une certaine consistance. En effet, en dehors de circonstances très particulières, la Communication précise que l'Office considère que «le risque de confusion est improbable entre les services de vente au détail» et des "produits particuliers...".
- Pour plus d'informations, il est renvoyé à la communication qui est publiée sur notre site Internet (<http://www.oami.eu.int>).

## CTM INFRINGEMENT: VIAGRA vs VIAGRENE

U.S. Drug Company Pfizer Inc is the proprietor of the trade mark VIAGRA, which as is well known to everybody, is an anti-impotence drug, which has been available since 1998. This word was registered as a UK trade mark and also as a Community trade mark in respect of "pharmaceutical and veterinary preparations and substances". The VIAGRA tablets are blue and take the shape of a diamond and contain a substance called sildenafil, which is useful in the treatment of

a form of impotence in males known as erectile dysfunction.

Pfizer discovered that British-based Eurofood-Link (UK) Ltd was planning to launch a beverage named VIAGRENE. The visual appearance of this beverage called to mind the VIAGRA tablets (the same blue colour and the same diamond shape affixed onto the container). This was also aimed at stimulating the libido of men and women by incorporating

a natural herb, which was thought to act directly upon the reproduction organs.

Pfizer has argued before the High Court that this future use would infringe their rights conferred by their UK and CTM registrations. The Court has effectively concluded that there is a likelihood of confusion between the two marks in view of the following similarities respectively between the goods and the marks:

## STATISTICS (SITUATION AT THE BEGINNING OF JUNE 2001)

### COMMUNITY TRADE MARK APPLICATIONS

#### BREAKDOWN BY COUNTRY

	1996 - 2000	%	2001 (31.05.01)	%	Total	%
<b>TOTAL WORLD</b>	<b>200.598</b>	<b>100</b>	<b>21.562</b>	<b>100</b>	<b>222.160</b>	<b>100</b>
	1996 - 2000	%	2001 (31.05.01)	%	Total	%
<b>TOTAL EUROPEAN UNION</b>	<b>123.589</b>	<b>61,61</b>	<b>13.656</b>	<b>63,33</b>	<b>137.245</b>	<b>61,78</b>
BELGIQUE/BELGIË [BE]	2.940	1,47	277	1,28	3.217	1,45
DANMARK [DK]	3.143	1,57	306	1,42	3.449	1,55
DEUTSCHLAND [DE]	33.408	16,65	3.733	17,31	37.141	16,72
ELLAS/GREECE [GR]	498	0,25	66	0,31	564	0,25
ESPAÑA [ES]	12.274	6,12	1.519	7,04	13.793	6,21
FRANCE [FR]	11.748	5,86	1.430	6,63	13.178	5,93
IRELAND [IE]	1.853	0,92	201	0,93	2.054	0,92
ITALIA [IT]	14.135	7,05	1.633	7,57	15.768	7,10
LUXEMBOURG [LU]	929	0,46	145	0,67	1.074	0,48
NEDERLAND [NL]	5.422	2,70	463	2,15	5.885	2,65
ÖSTERREICH [AT]	2.971	1,48	306	1,42	3.277	1,48
PORTUGAL [PT]	1.225	0,61	118	0,55	1.343	0,60
SUOMI/FINLAND [FI]	1.871	0,93	229	1,06	2.100	0,95
SVERIGE [SE]	4.590	2,29	462	2,14	5.052	2,27
UNITED KINGDOM [GB]	26.582	13,25	2.768	12,84	29.350	13,21
	1996 - 2000	%	2001 (31.05.01)	%	Total	%
<b>TOTAL OUTSIDE EUROPEAN UNION</b>	<b>77.009</b>	<b>38,39</b>	<b>7.906</b>	<b>36,67</b>	<b>84.915</b>	<b>38,22</b>
Amongst which						
UNITED STATES OF AMERICA [US]	53.796	26,82	5.248	24,34	56.044	26,58
JAPAN [JP]	5.058	2,52	476	2,21	5.534	2,49
SWITZERLAND [CH]	3.843	1,92	474	2,20	4.317	1,94
CANADA [CA]	2.558	1,28	304	1,41	2.862	1,29
AUSTRALIA [AU]	1.866	0,93	204	0,95	2.070	0,93
TAIWAN [TW]	1.263	0,63	160	0,74	1.423	0,64

### OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	1996 - 2000	2001 (31.05.01)	Total
Filing dates accorded	189.530	22.530	212.060
Number classifications checked	176.185	21.301	197.486
Applications published	140.107	22.544	162.651
Oppositions received	33.515	5.604	39.119
Contested applications	25.439	3.935	29.374
Appeals received	2.368	557	2.925
Registered Trade Marks	93.802	15.810	109.612
Published Registered Trade Marks	89.987	17.108	107.095
Requests for cancellation	193	74	267

### OTHER OHIM FIGURES

	ON 15-06-01
Number of professional representatives	6091
Number of current accounts in use on the 31 <sup>st</sup> of March:	856
OHIM Personnel	692

• similarity of goods: Deputy High Court Judge Simon Thorley considered that "whilst superficially different", the goods do "have similarities in that both are designed to appeal to those suffering from impotence".

• similarity of marks: Since the mark Viagrene contains the first five letters of

VIAGRA its use as an aphrodisiac would call to mind the trade mark VIAGRA.

This decision is of interest as it may be the first CTM infringement that has been sanctioned by a national Court. It contains in particular a paragraph explaining how the unitary character and the Community

wide effects of a Community trade mark are particularly attractive. In this connection it was rightly considered in the judgement that, as the defendant was a UK based company, the Court had the power to hear and determine an allegation of infringement wherever that occurred within the EC.

## LEGAL QUESTIONS

### IN WHICH CIRCUMSTANCES CAN A SIGN APPLIED FOR AS A CTM BE DEEMED DETRIMENTAL TO THE REPUTE OF AN EARLIER IDENTICAL MARK?

According to Article 8(5) CTMR, the proprietor of an earlier reputed (national or Community) trade mark can oppose the registration of a similar or identical sign that is to be registered for dissimilar goods or services, where the use without due cause of the sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

The Third Board of Appeal of the Office has recently been called upon to give an interpretation of this provision. Indeed, in Case R 283/1999-3 (HOLLYWOOD v. HOLLYWOOD) the Board had to decide whether to allow an opposition lodged on the basis of a reputed national mark for chewing gums against a CTM application regarding an identical sign for cigarettes and other tobacco products. Among many other interesting questions, the case put forward the issue of under which circumstances the use of the sign applied for might be detrimental to the repute of the earlier mark.

In its decision of 25 April 2001, the Board found that the evidence adduced by the owner of the earlier mark showed that (a) the message transmitted to the public by way of advertisement, referred to health, dynamism and youth, and (b) this had created an "image" associated to the mark that is known by a significant part of the public concerned by the goods covered by that mark. Once having defined the image associated with the earlier mark, the Board went on to examine whether the use of the contested sign for cigarettes would have been detrimental to that image.

The Board considered that the requirement consisting of damage to reputation is

fulfilled where the earlier reputed mark is sullied or debased by its association with something unseemly. This may happen when the mark is used, on the one hand, in an unpleasant, obscene or degrading context or, on the other hand, in a context that is not inherently unpleasant but which proves to be incompatible with the trade mark image. In both cases there would be a comparison which is harmful to the trade mark's image, what is known as dilution by tarnishment. The Board arrived to the conclusion that a trade mark is tarnished in this way when the consumer's ability to associate it with the goods or services for which it is registered is reduced by the fact that:

- a) it is linked with goods of poor quality or which evoke undesirable or questionable mental associations which conflict with the associations or image generated by legitimate use of the trademark by its proprietor;
- b) it is linked with goods incompatible with the quality and prestige associated with the trademark, even though it is not per se a matter of unseemly use of the trademark;
- c) its word or figurative element is amended or altered in a negative way.

The foregoing considerations led the Board to conclude that the registration of a Community trade mark for products, such as cigarettes, that are generally associated with something that is harmful to health, would be detrimental to the image of health, dynamism and youth associated by a significant part of the relevant public with the earlier national mark.

The decision of the Boards of Appeal can be found in the Office's web-site, [oami.eu.int](http://oami.eu.int).

## 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](http://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.

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