



OAMI

news

4

2 0 0 1



Gil Carlos Rodríguez Iglesias
*Presidente del Tribunal de Justicia
de las Comunidades Europeas*

editorial

El impacto creciente del Derecho comunitario en el Derecho de marcas tenía también que repercutir en la actividad del Tribunal de Justicia de las Comunidades Europeas, y es indudable que las marcas se han ido consolidando como un área importante dentro de su jurisprudencia. Hay que recordar a este respecto que anteriormente a la creación de la marca comunitaria el Tribunal de Justicia había desarrollado una significativa jurisprudencia en materia de marcas. En un primer momento debió precisar el alcance del Derecho de marcas en relación con la libre circulación de mercancías y, posteriormente, tuvo que resolver asuntos relativos a la interpretación de la Directiva 89/104 del Consejo, de aproximación de las legislaciones de los Estados miembros en materia de marcas.

Pero es sin duda la marca comunitaria la que tendrá un impacto cuantitativo mayor en el trabajo del Tribunal de Justicia y del Tribunal de Primera Instancia en los próximos años. El legislador comunitario consideró que la marca comunitaria debía ser salvaguardada mediante una tutela judicial adecuada que permita a las empresas confiar en el sistema de concesión y protección de los títulos exclusivos otorgados a sus signos distintivos mediante los que identifican sus productos o servicios.

Así, conforme al artículo 63 del Reglamento 40/94 del Consejo, sobre la marca comunitaria, es posible recurrir ante el Tribunal de Justicia contra las resoluciones dictadas por las salas de recurso de la OAMI en recursos *ex parte* contra las denegaciones de registro por uno de los motivos de denegación absolutos previstos en el Reglamento o en recursos *inter partes* relativos a conflictos entre marcas. Las competencias del Tribunal de Justicia para anular y revocar las resoluciones de las salas de recurso son ejercidas, en primera instancia, por el Tribunal de Primera Instancia, cuyas resoluciones son recurribles en casación ante el Tribunal de Justicia. Más de setenta recursos contra las resoluciones de las salas de recursos han sido ya presentados ante el Tribunal de Primera Instancia, y el próximo 20 de septiembre el Tribunal de Justicia dictará su primera sentencia en un recurso de casación relativo a la marca comunitaria (Procter & Gamble, "Baby-dry", asunto C-383/99 P).

Considerando que el nuevo contencioso sobre la marca comunitaria constituía un reto para ambos tribunales, en particular en términos cuantitativos, el Tribunal de Justicia comenzó su reflexión sobre la situación que provocaría la llegada de dichos asuntos poco después de la creación de la OAMI. Como resultado se presentaron al Consejo en 1999 una serie de propuestas. En estas propuestas el Tribunal ya observaba que la idea de que la credibilidad de la marca comunitaria dependerá, en particular, del tiempo necesario para la sustanciación de los recursos contenciosos parece razonable, aun cuando la rapidez en dictar sentencia no constituya, por sí sola, un factor decisivo. Hay que tener en cuenta que los recursos ante el Tribunal de Primera Instancia y el Tribunal de Justicia vendrán precedidos ya de un a veces largo procedimiento ante la OAMI.

A este respecto, las medidas propuestas por el Tribunal relativas al contencioso de la marca comunitaria se enmarcan en un esfuerzo generalizado para racionalizar los procedimientos, en la línea del documento de reflexión del Tribunal de Justicia sobre el «Futuro del sistema jurisdiccional de la Unión Europea», presentado al Consejo de Ministros de Justicia en el mes de mayo de 1999. Este esfuerzo general ya ha dado lugar a varias modificaciones recientes de los Reglamentos de Procedimiento del Tribunal de Justicia y del Tribunal de Primera Instancia. En lo que concierne a la marca comunitaria, en las propuestas específicas para hacer frente al creciente número de contencioso en materia de propiedad intelectual, se proponía, aparte del reforzamiento de los medios humanos con los que cuentan los servicios del Tribunal, el aumento del número de jueces del Tribunal de Primera Instancia y el filtrado de los recursos de casación en materia de marca comunitaria.

Algunas de estas preocupaciones han tenido eco en el Tratado de Niza, firmado el 14 de febrero 2001 y aún no en vigor, que contiene ciertas modificaciones del sistema jurisdiccional comunitario que han de ser desarrolladas en el futuro a través de una reforma de su Estatuto.

Esperando el desarrollo de estas disposiciones, quiero manifestar aquí mi esperanza de que estas reformas

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)

permitan al Tribunal de Justicia y al Tribunal de Primera Instancia garantizar la tutela judicial adecuada para que la marca comunitaria, así como otros títulos de propiedad industrial de los que puedan

conocer en el futuro, cumplan plenamente en el marco comunitario europeo la función que les corresponde. Con respecto a las marcas, el Tribunal de Justicia ya destacó en su sentencia Hag II, de 17 de octubre de 1990, que

constituye "un elemento esencial del sistema de competencia no falseado que el Tratado pretende establecer y mantener", por lo que su garantía es, al mismo tiempo, consustancial al buen funcionamiento del mercado interior.

THREE-DIMENSIONAL TRADE MARKS

Article 4 of the CTMR states that "a CTM may consist of any sign capable of being represented graphically, particularly the shape of goods or of their packaging provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings".

A check of the Euromarc data base reveals that the main categories of 3-D marks filed at the Office include shapes of bottles, food containers, pieces of furniture, washing tablets, pharmaceutical products, tools of different kind, shoes, musical instruments and accessories, vehicles. Although each case must be assessed based on its own merit and all the relevant factors, such as the nature of the product and the relevant public, we can say that, for a 3-D mark to be found inherently distinctive, the shape considered as a whole must present some arbitrary, unusual and at the same time eye-catching feature.

Article 7.1.e(i),(ii) and (iii) CTMR refers to grounds for refusal which are specific to 3-D trade marks, stating that the following signs shall not be registered: signs which consist exclusively of:

- (i) the shape which results from the nature of the goods themselves;
- (ii) the shape of goods which is necessary to obtain a technical result;
- (iii) the shape which gives substantial value to the goods.

This means that, considered as a whole, in order for a 3-D mark to be objected under one of the above specific grounds for refusal all its elements must be exclusively dictated either by the nature of the goods, the need to obtain a technical result or concur to give a substantial value to the goods. However, although in some cases one can argue that the applied for shape is rather a design and should be protected as such (but we know that design protection at Community level is not available yet), the vast majority of 3-D marks filed at the Office do not fall within one of these exceptions. In fact, the Office interprets art. 7.1.e(ii) CTMR as meaning that the applied for shape must be the only possible shape to obtain a technical result and no alternatives be possible (in this respect, it will be interesting to see if the European Court of Justice will follow the opinion of the Advocate General in Case C-299/99 Philips

Electronics NV v. Remington Consumer Products Limited involving a shaver with three rotary heads arranged in the shape of an equilateral triangle. In his opinion of 23 January 2001, the Advocate General Ruiz-Jarabo Colomer concluded that "any shape the essential feature of which serves the achievement of a technical result must be regarded as a sign which consists exclusively of the shape of goods which is necessary to obtain such a result, irrespective of whether it is possible to achieve that result using other shapes". However, when, according to the Office, the relevant public is likely to perceive the overall shape as non distinctive for being primarily functional in nature, then the Office will reject the corresponding CTM application under art. 7.1.b, thus giving the applicant the possibility, arguments apart, to submit evidence of acquired distinctiveness.

A final remark. There are cases where the 3-D mark consists of a combination of elements, shape apart, which may include colours, logos, words, etc. The Office will consider the mark as a whole and accept it for publication provided the overall impression is one of sufficient, albeit reduced, distinctiveness.

COMING SOON... WWW.EURO.EU

The European Parliament and the Council have recently given their first-reading approval to the proposal for a Regulation on the implementation of the new Internet Top Level Domain ".EU", which is expected to increase Europe's visibility in the cyberspace. A final agreement on the amendments proposed by the Parliament should be reached soon, so that the Regulation can be adopted next autumn. The new domain name would therefore enter into force during 2002, at the same time than the Euro.

In the current situation of the Internet, where new generic Top Level Domains (TLD) have recently been approved by

ICANN (.info, .biz, .aero, .coop, .name, .pro...), a TLD like ".EU" can only be successful if it provides some added value which leads firms and individuals to register their name under ".EU" rather than under ".com", ".biz", or others.

Which is the added value that ".EU" intends to provide? The answer is *trust*. Whereas in the "real" world trust is ensured by trade marks, labels, standards..., the lack of confidence among consumers in the cyberspace is the main obstacle to the development of electronic commerce (e-commerce). Accordingly, the ".EU" TLD has been conceived as a tool to accelerate e-

commerce in Europe and especially among small and medium sized enterprises.

One of the amendments proposed by the European Parliament (which still needs to be agreed with the Council), requests that undertakings be at least legally established within the Community in order to apply for a ".EU" TLD, which implies that they are bound to respect the European directive on electronic commerce. Another amendment of the Parliament requests that on-line traders applying for a ".EU" will have to adhere to a specific code of conduct for on-line trade and to an on-line extrajudicial dispute resolution scheme.

The Registry shall be a not-for-profit organisation, operated in the public interest, and will be entrusted with the organisation, administration and management of the ".EU" TLD. The Commission will designate it after the completion of a tendering procedure that will include publication of a call for expressions of interest in the Official

Journal of the European Communities. Any decision taken by the Registry shall be subject to the jurisdiction of the Member State of establishment of the Registry.

The Registry shall enjoy independence from the persons or entities acting as Registrars and shall abide by the principles of transparency, neutrality and non-

discrimination in its dealings with them. The Registry shall not act as a Registrar.

The Commission shall adopt a public policy framework concerning the implementation of the ".EU" TLD, having consulted the Registry and the appropriate committee. In order to prevent and resolve conflicts between domain names

STATISTICS (SITUATION AT THE BEGINNING OF AUGUST 2001)

COMMUNITY TRADE MARK APPLICATIONS

BREAKDOWN BY COUNTRY

	1996 - 2000	%	2001 (31.07.01)	%	Total	%
TOTAL WORLD	200.598	100	29.862	100	230.460	100
TOTAL EUROPEAN UNION	123.589	61,61	19.049	63,79	142.638	61,89
BELGIQUE/BELGIË [BE]	2.940	1,47	406	1,36	3.346	1,45
DANMARK [DK]	3.143	1,57	440	1,47	3.583	1,55
DEUTSCHLAND [DE]	33.408	16,65	5.118	17,14	38.526	16,72
ELLAS/GREECE [GR]	498	0,25	92	0,31	590	0,26
ESPAÑA [ES]	12.274	6,12	2.176	7,29	14.450	6,27
FRANCE [FR]	11.748	5,86	1.977	6,62	13.725	5,96
IRELAND [IE]	1.853	0,92	281	0,94	2.134	0,93
ITALIA [IT]	14.135	7,05	2.291	7,67	16.426	7,13
LUXEMBOURG [LU]	929	0,46	195	0,65	1.124	0,49
NEDERLAND [NL]	5.422	2,70	686	2,30	6.108	2,65
ÖSTERREICH [AT]	2.971	1,48	420	1,41	3.391	1,47
PORTUGAL [PT]	1.225	0,61	206	0,69	1.431	0,62
SUOMI/FINLAND [FI]	1.871	0,93	316	1,06	2.187	0,95
SVERIGE [SE]	4.590	2,29	611	2,05	5.201	2,26
UNITED KINGDOM [GB]	26.582	13,25	3.834	12,84	30.416	13,20
TOTAL OUTSIDE EUROPEAN UNION	77.009	38,39	10.813	36,21	87.822	38,11
Amongst which						
UNITED STATES OF AMERICA [US]	53.796	26,82	7.116	23,83	60.912	26,43
JAPAN [JP]	5.058	2,52	689	2,31	5.747	2,49
SWITZERLAND [CH]	3.843	1,92	637	2,13	4.480	1,94
CANADA [CA]	2.558	1,28	430	1,44	2.988	1,30
AUSTRALIA [AU]	1.866	0,93	282	0,94	2.148	0,93
TAIWAN [TW]	1.263	0,63	225	0,75	1.488	0,65

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	1996 - 2000	2001 (03.08.01)	Total
Filing dates accorded	189.530	30.891	220.421
Number classifications checked	175.311	29.955	205.266
Applications published	140.107	30.414	170.521
Oppositions received	33.515	8.184	41.699
Contested applications	25.439	5.853	31.292
Appeals received	2.368	711	3.079
Registered Trade Marks	93.714	22.378	116.092
Published Registered Trade Marks	89.987	22.698	112.685
Requests for cancellation	193	101	294

OTHER OHIM FIGURES

	ON 15-08-01
Number of professional representatives	6143
Number of current accounts in use on the 31 st of March:	866
OHIM Personnel	693

registration and intellectual property rights, the Commission shall adopt a policy to prevent speculative and abusive registration of domain names, as well as a policy for the extra-judicial settlement of conflicts, without prejudice to any court proceeding. Both of them shall conform to best practices including the recommendations of the World Intellectual Property Organisation (WIPO). The Parliament has proposed (but it is still under discussion) that the policy to prevent speculative and abusive registration of domain names should be based on the principle that an entity wishing to register must have the related rights on the registered names.

Registration will be made, in principle, on a first-come, first-served basis, but with the possibility of a "sunrise period", i.e., a short period after the application for a ".EU" TLD has been lodged, within which holders of prior rights recognised in law and public policy would be given the possibility to register their names.

It is widely accepted that a Community trade mark is a prior right which would allow its holder to claim rights to the corresponding ".EU" TLD. Therefore, there is room for OHIM participation in the ".EU" process, at least by ensuring access to its list of registered CTMs. *Affaire à suivre...*

LEGAL QUESTIONS

HOW CAN THE SENDER OF AN ELECTRONIC FAX DEMONSTRATE THAT THE FAX WAS RECEIVED BY THE OFFICE ON A CERTAIN DATE?

④ The practice of the Office regarding the proof of receipt of telefax transmissions is to accept a fax transmission report as valid evidence of transmission to the Office, if it contains the sender's name and fax number, the recipient's name and fax number, the date and time of beginning and end or duration of transmission, the number of pages sent and the "OK" confirmation of the transmission.

This practice has been confirmed by the Boards of Appeal in numerous decisions (see, *inter alia*; decisions of 8 July 1998 – Case R 10/97-3 – ALL AMERICAN PLAN, of 19 April 1999 – R 197/1998-3 – TESTEQUITY; of 9 September 1999 – Case R 2/1999-3 – DishDrawer; and of 15 December 2000 – Case R 834/1999-2 – Fig. Mark. TOUCHTUNES).

The Office applies the same requirements to faxes sent electronically directly from

the PC workstation of the sender. It is desirable, although not indispensable, that, additionally, every transmission report includes a reference to the document transmitted either by reproducing its first page or by providing an identification number, which allows the document to be traced back through the electronic system.

It should be recalled that faxes sent by the Office are dispatched electronically on the basis of Decision N° EX-97-1 of the President of the Office of 1 April 1997 determining the form of decisions, communications and notices from the Office (OJ OHIM 1997, 423). In turn, users of the CTM system may also send their faxes to the Office electronically, provided that, in case that evidence of a fax transmission is needed, it must be secured in the same way as is the case with traditional faxes.

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:
+ 34-965 139 175

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