



OAMI

news

1

2 0 0 2



Anna M. Birulés Bertran
Ministra de Ciencia y Tecnología

editorial

Constituye para mí un honor especial participar en la elaboración de este boletín que la OAMI publica coincidiendo con la Presidencia Española de la Unión Europea.

Han transcurrido ya más de cinco años desde la puesta en marcha de la OAMI. Cinco años que se han caracterizado por un funcionamiento eficiente y una gestión eficaz. Ya son 250.000 las solicitudes de registro recibidas, volumen que duplica el inicialmente previsto y que pone de manifiesto el éxito alcanzado.

Este éxito constituye un nuevo paso adelante en la protección de los derechos de nuestros emprendedores, fundamental para fomentar el espíritu emprendedor y la innovación en nuestra sociedad.

Durante este tiempo, la Marca Comunitaria ha continuado consolidándose como un instrumento necesario para el completo desarrollo del Mercado Único. Gracias a la normativa vigente, su titularidad otorga hoy una protección unitaria y favorece la protección en toda Europa de los valores empresariales implícitos en ella. La marca cobra así una relevancia esencial para representar y defender los activos ó propiedades inmateriales que constituyen el elemento medular del funcionamiento y valoración de las empresas y, en definitiva, para defender la innovación que se produce a través del conocimiento.

Este papel fundamental de la marca da mayor relevancia si cabe al éxito de la OAMI, la mayor agencia comunitaria. Éxito que es especialmente importante para la Presidencia Española de la Unión Europea, que entre sus objetivos se ha propuesto lograr una mejora significativa y constante del marco regulador del sistema de propiedad intelectual e industrial.

En esta línea, la aprobación del Reglamento de 12 de diciembre de 2001, sobre los dibujos y modelos comunitarios, dotará a la protección del diseño industrial en la Unión Europea de la armonización y la seguridad jurídica que venían reclamándose desde hace tiempo. A partir de su puesta en práctica, el régimen jurídico de las creaciones de forma alcanza el mismo rigor en la Unión que los signos distintivos.

La puesta en marcha del nuevo título en menos de un año es también un complemento necesario a la armonización del derecho interno de protección del diseño industrial. Y es, claramente, un importante reto a corto plazo para la OAMI.

Junto a él, el descenso en la presentación de solicitudes de marcas comunitarias supone también un nuevo reto que la OAMI debe ponderar adecuadamente para hacerlo compatible con la ampliación de la Unión o la implantación de las nuevas tecnologías.

También creo necesario resaltar la importancia que para todo nuestro tejido productivo tiene la OAMI, y en especial sus procedimientos, como punto de referencia de la normativa y funcionamiento del régimen jurídico de los títulos de propiedad industrial en España.

La aprobación en Diciembre de 2001 de una nueva Ley de Marcas es un ejemplo de ello. En su elaboración hemos tenido en cuenta, en todo momento, la regulación de la marca comunitaria y el funcionamiento de la OAMI. Así, la supresión del examen de oficio de anterioridades o la implantación del sistema multiclase son mejoras procedimentales que han sido contrastadas previamente con la experiencia de la OAMI. La protección adicional de la marca notoria y renombrada supone también un elemento de concordancia mutua que redundará en el fortalecimiento de la empresa europea y en la congruencia entre el sistema nacional español y el comunitario.

Las mismas circunstancias se están produciendo en la regulación del Diseño. Hemos iniciado la tramitación interna de una nueva ley española que actualiza la vigente y en la que, de nuevo, el sistema de Diseño comunitario es un elemento clave de referencia.

En definitiva, cada vez es más clara la vinculación entre el desarrollo equilibrado del Mercado Único con la protección de la innovación por medio de títulos adecuados y en sintonía con las regulaciones nacionales. Una vez más -también en propiedad industrial- un único mercado debe ir acompañado de títulos únicos y de una legislación más uniforme. Todo ello adaptado a las necesidades de los usuarios - que son cada vez más conscientes de la relevancia de los activos inmateriales y de su protección - y de impulsar la innovación y, por lo tanto, la competitividad y la calidad de vida de nuestros ciudadanos. En ello la OAMI lleva más de cinco años dando un buen ejemplo. Por eso, desde el Ministerio de Ciencia y Tecnología y desde la Presidencia de la Unión Europea les animamos a que continúen con el gran trabajo desarrollado hasta hoy.

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
(MARCHÉS, DESSINS ET MODÈLES)

UAMI

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

ADOPTION OF THE REGULATION ON COMMUNITY DESIGNS

On 12 December 2001 the Regulation on Community designs¹ was adopted by the Council of the European Union.

Industrial designs surrounds us in every aspect of our lives and a Community design will provide protection for the appearance of products such as toys, shoes, furnishings, ceramics, clothing, jewellery, cars and many others. The design or shape of a product can be synonymous with the branding and imaging of a company and is frequently an asset with a monetary value that may well increase.

As with the Community Trade Mark, it is obvious that having an Internal Market without frontiers only makes sense if industrial property holders can obtain full unitary protection for all of that territory with as few administrative burdens as possible.

Although protection has been available at a national level for designs, the level and quality of the protection has varied greatly and this legislation will provide a clearer protection.

② The legislation introduces a double system of protection.

The "Unregistered Community Design" is a right that will come into existence automatically when the products incorporating the designs are made available to the public within the Community. This right will be

limited to three years and to forbidding the use of copies of original designs. It constitutes a vital element of protection for all industries such as clothing which renew their collections every season. They will therefore be protected against counterfeiting and other infringing copies without any formality or cost relating to registration involved for their designs in the entirety of the Union.

The second right introduced will be a "Registered Community Design Right". This will be an exclusive right on the basis of an application filed with the OHIM which will publish the designs once they have been registered. Registered designs will be protected for periods of five years up to a maximum of 25 years.

Advantages

The right granted by registration will be stronger than the unregistered Community design. The registered Community design will allow one to forbid completely the putting on the market of any design that does not produce a different overall impression. The registered Community design therefore allows an owner to exclude all later creations without having to prove that they are based on copies of his design.

A further important feature of the Regulation will be the possibility for the applicants for a registered Community design to defer its publication for up to 30 months. That means that creators and industries

can apply for the registered Community design and at the same time keep their designs secret until they are put on the market. Therefore potential competitors will not be allowed to look at their designs and the competitive edge of the applicant is maintained.

Applicants will also be entitled to combine in a single application multiple designs, which will greatly facilitate the protection of designs from industries which create ranges of goods such as the textile industry.

Timescale

The unregistered Community design right will come into force on 6th March 2002 (60 days after the date of publication of the Regulation in the Official Journal of the European Community). Therefore all new creations which are disclosed to the public as from that date will be protected automatically by that right in the entirety of the European union.

As to the registered Community design, the OHIM is actively preparing the necessary systems to begin receiving applications. However, this will not be earlier than the year 2003 as the Implementing and Fees Regulations are being drafted and is likely to be adopted in 2002 by the European Commission.

¹ COUNCIL REGULATION (EC) No 6/2002 of 12 December 2001 on Community designs, available at <http://oami.eu.int/en/aspects/default.htm>

VISITE DE LA DÉLÉGATION DU ROSPATENT À L'OHMI 13, 14 DÉCEMBRE 2001

Les 13 et 14 décembre 2001 une délégation russe au plus haut niveau s'est rendue en visite officielle à l'OHMI. Dirigée par M. Alexander Korchagin, directeur général de l'office fédéral russe (Rospatent), cette visite cherchait à resserrer les liens de coopération entre les deux organisations au moment où la Fédération de Russie s'appête à adopter une nouvelle législation en matière de propriété industrielle. Cet ensemble législatif renouvelé, contribuera à mettre en œuvre ses desseins stratégiques majeurs sur le plan économique: l'entrée dans l'Organisation Mondiale de Commerce (OMC) et l'établissement, la prochaine décennie, d'un espace économique commun avec l'Union Européenne.

La consolidation de l'économie de marché et la stabilisation de l'investissement en Russie restent, pour l'économie russe, des enjeux fondamentaux. S'il est vrai que l'ouverture et l'intégration internationale, dont l'économie russe a fait preuve ces dernières années, restent des faits indéniables, la réussite d'une telle transition reste étroitement liée à la capacité russe de capter les investissements étrangers directs. En effet, seule l'existence d'un cadre législatif stable ainsi que d'une pratique juridique fiable, dans le domaine de la protection des droits de propriété industrielle, pourront rassurer les investisseurs étrangers.

C'est pourquoi les autorités publiques russes s'engagent à présent dans la réfor-

me du cadre juridique qui régit la protection des droits de propriété industrielle depuis 1992. Forte d'une expérience de huit ans dans l'application du cadre juridique existant, l'office russe est au cœur des nouvelles propositions législatives récemment présentées devant la Duma (chambre basse du Parlement). Celles-ci reflètent à la fois le rapprochement avec les pratiques administratives et juridiques européennes et la nécessaire compatibilité avec les dispositions des accords sur les ADPIC (TRIPS).

Dans ces conditions, l'activité de l'OHMI dans la gestion de la marque communautaire ne pouvait qu'intéresser les membres de l'of-

ficé russe. Notamment, le caractère résolu- ment tourné vers le marché de ce système ain- si que les pratiques administratives et les nou- velles technologies employées dans sa gestion. Pendant ces deux jours les représentants russes se sont donc familiarisés avec le fonctionne- ment de notre office et ont établi des contacts en vue de la mise en œuvre d'initiatives de co- opération entre l'OHMI et l'office russe.

Lors de son allocution devant le Busi- ness Club au moment de la Conférence

sur l'investissement en Russie, le 2 oc- tobre de 2001 à Bruxelles, le Commis- saire européen Chris Patten a salué l'énorme potentiel de l'économie russe en terme de développement écono- mique, créativité et innovation. Néan- moins, les difficultés récurrentes de cet- te économie à attirer l'investissement étranger y ont été également soulignées. Afin d'y remédier, le Commissaire euro- péen a encouragé la poursuite des ré- formes en cours tout en préconisant

l'adoption, entre autres, d'un haut degré de protection des droits de propriété in- tellectuelle.

En tant qu'agence technique communau- taire spécialisée dans le domaine de la propriété industrielle, l'OHMI apportera sa contribution à une meilleure connais- sance du système de la marque commu- nautaire ainsi qu'à la mise en œuvre d'une protection efficace des DPI en Fédéra- tion de Russie.

STATISTICS (SITUATION AT THE BEGINNING OF FEBRUARY 2002)

COMMUNITY TRADE MARK APPLICATIONS

BREAKDOWN BY COUNTRY

	1996 - 2001	%	2002 (31.01)	%	Total	%
TOTAL WORLD	249.454	100	3.603	100	253.057	100
	1996 - 2001	%	2002 (31.01)	%	Total	%
TOTAL EUROPEAN UNION	154.103	61,78	2.411	66,92	156.514	61,85
BELGIQUE/BELGIË [BE]	3.627	1,45	65	1,80	3.692	1,46
DANMARK [DK]	3.910	1,57	75	2,08	3.985	1,57
DEUTSCHLAND [DE]	41.693	16,71	573	15,90	42.266	16,70
ELLAS/GREECE [GR]	646	0,26	13	0,36	659	0,26
ESPAÑA [ES]	15.700	6,29	294	8,16	15.994	6,32
FRANCE [FR]	14.919	5,98	309	8,58	15.228	6,02
IRELAND [IE]	2.337	0,94	28	0,78	2.365	0,93
ITALIA [IT]	17.705	7,10	301	8,35	18.006	7,12
LUXEMBOURG [LU]	1.208	0,48	27	0,75	1.235	0,49
NEDERLAND [NL]	6.528	2,62	74	2,05	6.602	2,61
ÖSTERREICH [AT]	3.682	1,48	60	1,67	3.742	1,48
PORTUGAL [PT]	1.522	0,61	29	0,80	1.551	0,61
SUOMI/FINLAND [FI]	2.354	0,94	37	1,03	2.391	0,94
SVERIGE [SE]	5.549	2,22	62	1,72	5.611	2,22
UNITED KINGDOM [GB]	32.723	13,12	464	12,88	33.187	13,11
	1996 - 2001	%	2002 (31.01)	%	Total	%
TOTAL OUTSIDE EUROPEAN UNION	95.351	38,22	1.192	33,08	96.543	38,15
Amongst which						
UNITED STATES OF AMERICA [US]	64.978	26,05	787	21,84	65.765	25,99
JAPAN [JP]	7.391	2,96	62	1,72	7.453	2,95
SWITZERLAND [CH]	4.862	1,95	61	1,69	4.923	1,95
CANADA [CA]	3.263	1,31	48	1,33	3.311	1,31
AUSTRALIA [AU]	2.270	0,91	25	0,69	2.295	0,91
TAIWAN [TW]	1.602	0,64	28	0,78	1.630	0,64

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	1996 - 2001	2002 (31.01)	Total
Filing dates accorded	237.937	4.528	242.465
Number classifications checked	223.973	3.845	227.818
Applications published	190.742	3.235	193.977
Oppositions received	47.024	1.356	48.380
Contested applications	35.089	646	35.735
Appeals received	3.414	128	3.542
Registered Trade Marks	38.504	35.807	74.311
Published Registered Trade Marks	132.218	3.214	135.432
Requests for cancellation	360	9	369

OTHER OHIM FIGURES

	ON 15-02-02
Number of professional representatives	6298
Number of current accounts in use on the 31 st of March:	905
OHIM Personnel	680

OAMI NEWS LEGAL QUESTION

What is now the situation with regard to the registrability of three-dimensional trade marks consisting of the shape of goods after the decisions of the Court of First Instance in the TABS cases?

The OHIM has already accepted three-dimensional trade marks, the most common forms being containers and shapes of products. However, "simple" or "ordinary" shapes have consistently been refused. This policy which has been expressed publicly in a Communication of the President¹ has now been confirmed by the Court of First Instance in a series of judgments of 19 September 2001 relating to washing and detergent tablets ("taps²").

The shape of goods is listed specifically in Article 4 of the CTMR as eligible for trade mark protection provided that the sign is capable of being represented graphically and of distinguishing the goods and the services of one undertaking from those of another.

Trade marks consisting of shapes are further directly addressed in Article 7(1)(e) CTMR. This paragraph excludes registration of signs which consist exclusively of the shape of the goods, including that of their presentation or packaging, in three distinct cases:

- natural shapes: necessary forms without which the good would not exist (e.g., a football or a tomato);
- functional shapes: the essential features of the shape are attributable to the achievement of a technical result (e.g., the handle of a cup);
- ornamental shapes: in this case the shape influences decisively the decision to purchase (e.g., the form of a crystal vase).

Article 7(1)(e) CTMR has only very rarely been applied by the Office.

Refusals of three-dimensional marks are almost exclusively based on lack of distinctive character, i.e. on Article 7(1)(b) CTMR. This provision refers to the concrete distinctive character of the sign in relation to the goods and services applied for, and thus calls for an assessment of the relevant consumer's perception in relation

to the product. In the "taps" judgments, the Court reiterated that distinctiveness of a three-dimensional trade mark, just as is the case for other types of marks, has to be assessed in the light of the different categories of goods and their specific features in each instance.

As regards the average consumer behaviour when confronted with three-dimensional marks, the Court of First Instance confirmed the view of the Office to the extent that the consumer is not used to perceiving the shape of a good as a trademark. While the consumer normally recognises the source of the product by word or figurative elements attached to it, the shape itself will typically be regarded as a neutral element or one aimed at obtaining a technical or esthetical advantage.

Consequently, for the packaging and in particular the shape of goods such as "taps" to function as trademarks, they must be apt to create associations in the mind of the consumer which evoke the origin of the good so that the consumer will recognise it solely on account of its particular shape.

In this respect, the Office has always maintained the view that the degree of distinctiveness is the same for all marks, including three-dimensional marks consisting of the shape of the goods or their packaging. Commonplace shapes, such as those of the "taps" in the recent cases, which consist of ordinary geometrical forms e.g. round, square, rectangular, triangular, with or without colours (added as individual "pixels" or as coloured layers or inserts) do not display any kind of "special feature" capable of attracting the consumers' attention. The Court of First Instance has now confirmed that these shapes lack the minimum of distinctive character that is required and are therefore not registrable.

¹ Communication of the President No 2/98 of 8 April 1998 concerning the examination of three-dimensional marks, available on www.oami.eu.int.

² "Taps" (3-D) - T-335/99; T-336/99; T-337/99; T-117/00; T-118/00; T-119/00; T-120/00; T-121/00; T-128/00; T-129/00. All judgments can be found on our web-site, www.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

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

OAMI News is a newsletter which is distributed bi-monthly free of charge