



### THE KANGAROO GROUP VISITS THE OHIM IN ALICANTE

On 18<sup>th</sup> and 19<sup>th</sup> April 2002 the Kangaroo Group visited the Office for Harmonisation in the Internal Market (OHIM) in Alicante, Spain. The participants included Members of the European Parliament as well as industry representatives. The Kangaroo Group is an organisation of Members of the European Institutions and representatives of the business community with the task of creating a European Home Market for citizens and companies.

The Kangaroo Group considers the community patent and the protection of intellectual property a key component for the creation of a European Home Market.

The OHIM is an institution, which is essential for the furthering of this goal. It is well respected by industry and is in high demand as can be seen by the large number of registered trade marks.

The Kangaroo Group had the opportunity to hold in-depth discussions on intellectual property and in particular on trademarks with OHIM President Wubbo de Boer, and Vice Presidents Alexander von Mühlendahl and Alberto Casado.

The community patent, which has already been approved by the European Parliament, was also discussed. At the Group's Alicante visit the representative of the Spanish Government made it clear that Spain expects to get this important piece of legislation adopted by the Council of Ministers before the end of the Spanish EU Presidency. The remaining contentious point is the language problem: in how many official languages should the community patent operate?

*On Tuesday, 23<sup>rd</sup> April 2002 the Frankfurter Allgemeine Zeitung published an article on the Kangaroo Group's visit to Alicante.:*

*"The EU trademark office is a success story" said Karl von*

*Wogau, conservative MEP and President of the Kangaroo Group.*

*Kangaroo Group members were surprised to learn that the OHIM is the only European agency to have made a considerable profit since 1997. The agency is also innovative in trying to be a paperless office: by means of electronic filing all incoming letters are turned into bits and bytes.*

*The Frankfurter Allgemeine Zeitung (FAZ) also interviewed Wubbo de Boer, the head of the OHIM.*

*FAZ: Why are trademarks important to firms? Companies use trademarks to raise awareness of their goods. This way companies can increase their market share.*

*FAZ: Are trademarks also good news for consumers? Yes, indeed. They serve to distinguish products and ensure a consistent level of quality.*

From 1<sup>st</sup> January 2003 onwards it will be possible to register a community design with the OHIM. This will constitute an important step in creating a single market for intellectual property.

*Georg Mattheus  
Press Officer*



#### 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)

## 2<sup>ND</sup> TRADEMARK TRILATERAL COOPERATION MEETING



On the 2<sup>nd</sup> and 3<sup>rd</sup> of May, the second Trademark Trilateral Cooperation Meeting, between OHIM, the United States Patent and Trademark Office (USPTO) and the Japanese Patent Office (JPO), took place at OHIM in Alicante.

The one and a half day meeting provided for an exchange of information and views on a number of topics relating mainly to classification and information technology issues. Such a forum for discussion among the JPO, USPTO and OHIM clearly demonstrated that there is great merit in presenting the works

and tasks being undertaken by each office in view of ascertaining specific areas of common understanding and future cooperation. The ultimate aim of such collaboration is to foster the means of ensuring and facilitating user friendly and practical services for our clients.

Bearing this objective in mind, mutual interest was expressed in working on several areas, such as assessing the possibility of standardising identifications of goods and services based on the Nice Classification.

In terms of the Vienna Classification for figurative elements of trade marks there also exists

potential benefits from enhancing the common knowledge of the practices applied by the three offices.

Two common projects will as such be launched with regard to these classification matters.

As concerns information technology, many similar projects have been developing over the last few years, particularly in relation to the evolution of the Internet. Both the USPTO and JPO have successful e-filing systems in place and by the end of this year OHIM's "CTM Application" will also be up and running allowing trade mark applications to be filed electronically. With the ongoing progression of services that can be provided via the Internet it was also agreed that significant gains may be brought for our clients by pursuing an active and cooperative trilateral dialogue. In this sense a technical cooperation project will also be launched in the coming weeks.

In appreciation of the open exchange of information and views that were held among the delegations, a clear agenda for our future collaboration has been set to which we look forward to achieving positive results.

## INTA 124<sup>TH</sup> ANNUAL MEETING

18-22 MAY 2002, WASHINGTON D.C.

Can one envisage a more suitable place than Washington D.C. – the capital of world politics – to discuss and deliberate the theme "The Politics of Trademarks: A Global Dialogue" during four sunny, albeit surprisingly chilly, days in May.

The global dialogue obviously encompasses the CTM system, hence the presence of OHIM at the 124<sup>th</sup> Annual Meeting of INTA - the International Trademark Association - was both natural and sought after. Indeed the interest and curiosity on the role and functioning of the CTM were overwhelming and the follow-up from actual and prospective clients has shown that this interest was genuine.

INTA is an organisation of some 4000 trade mark owners and professionals in more than 150 countries dedicated to the support and advancement of trade marks and related intellectual property, as elements of fair and effective national and in-

ternational commerce. Certainly, the 6900 participants reflected perfectly the impressive span of organisations, companies and individuals involved in trade mark matters around the globe.

The OHIM, headed by its President Mr. de Boer - who gave a highly appreciated speech on the CTM - his assistant Mr. Miranda de Sousa and Vice President for Legal Affairs Mr. v. Mühlendahl, was also present throughout the four days in the exhibition area. Neighbouring the colleagues from the United Kingdom Patent Office - to whom for their dedication and support our most sincere appreciation must be extended - the officials representing OHIM had an excellent location to spread awareness and to intensify the dialogue on its activities in Alicante. Several hundred visitors stopped by the booth and raised questions which varied as much in subject as in scope. Confronted with issues on examination, opposition, appeal and registration of

the CTM, the OHIM officials were equally delighted to discover the attention that the recently adopted Community Design Regulation is capturing.

Securing the place of the CTM – and shortly the CD – on the world map of IP is the objective of the OHIM's participation at the INTA annual meetings. Participation in four of them has made great progress possible, yet there is still more ground to conquer. Thus the pursuit will continue: tot volgend jaar in Amsterdam!



## COMMUNICATION No 5/02 OF PRESIDENT OF THE OFFICE OF 17 MAY 2002 CONCERNING PUBLICATIONS OF THE OFFICE

Recently the 2<sup>nd</sup> edition of the multilingual version of the "Selected instruments relating to the Community trade mark" appeared. It can be obtained at the – unchanged - price of 25 euro plus V.A.T. at any bookshop or the Office for Official Publications of the European Communities. Compared to the 1<sup>st</sup> edition, the texts of the Trade Mark Harmonization Directive and excerpts of the

Paris Convention and the TRIPS Agreement have been added.

The 2<sup>nd</sup> edition of the monolingual versions is under preparation.

The Office has also published, in the five languages of the Office, an information brochure entitled "National law relating to

the Community trade mark", which deals with the interfaces between the CTM system and the national trade mark systems of the Member States. The updated 2<sup>nd</sup> edition of this brochure may now be obtained free of charge from the Office.

Wubbo de Boer  
President

### STATISTICS (SITUATION UNTIL THE END OF JUNE 2002)

#### COMMUNITY TRADE MARK APPLICATIONS

##### BREAKDOWN BY COUNTRY

	1996 - 2001	%	2002 (30.06)	%	Total	%
<b>TOTAL WORLD</b>	<b>249.454</b>	<b>100</b>	<b>22.152</b>	<b>100</b>	<b>271.606</b>	<b>100</b>
	1996 - 2001	%	2002 (30.06)	%	Total	%
<b>TOTAL EUROPEAN UNION</b>	<b>154.103</b>	<b>61,78</b>	<b>14.570</b>	<b>65,77</b>	<b>168.673</b>	<b>62,10</b>
BELGIQUE/BELGIË [BE]	3.627	1,45	294	1,33	3.921	1,44
DANMARK [DK]	3.910	1,57	386	1,74	4.296	1,58
DEUTSCHLAND [DE]	41.693	16,71	3.452	15,58	45.145	16,62
ELLAS/GREECE [GR]	646	0,26	90	0,41	736	0,27
ESPAÑA [ES]	15.700	6,29	1.891	8,54	17.591	6,48
FRANCE [FR]	14.919	5,98	1.695	7,65	16.614	6,12
IRELAND [IE]	2.337	0,94	198	0,89	2.535	0,93
ITALIA [IT]	17.705	7,10	1.859	8,39	19.564	7,20
LUXEMBOURG [LU]	1.208	0,48	119	0,54	1.327	0,49
NEDERLAND [NL]	6.528	2,62	511	2,31	7.039	2,59
ÖSTERREICH [AT]	3.682	1,48	374	1,69	4.056	1,49
PORTUGAL [PT]	1.522	0,61	170	0,77	1.692	0,62
SUOMI/FINLAND [FI]	2.354	0,94	259	1,17	2.613	0,96
SVERIGE [SE]	5.549	2,22	402	1,81	5.951	2,19
UNITED KINGDOM [GB]	32.723	13,12	2.870	12,96	35.593	13,10
	1996 - 2001	%	2002 (30.06)	%	Total	%
<b>TOTAL OUTSIDE EUROPEAN UNION</b>	<b>95.351</b>	<b>38,22</b>	<b>7.582</b>	<b>34,23</b>	<b>102.933</b>	<b>37,90</b>
Amongst which						
UNITED STATES OF AMERICA [US]	64.978	26,05	4.699	21,21	69.677	25,65
JAPAN [JP]	7.391	2,96	485	2,19	7.876	2,90
SWITZERLAND [CH]	4.862	1,95	499	2,25	5.361	1,97
CANADA [CA]	3.263	1,31	334	1,51	3.597	1,32
AUSTRALIA [AU]	2.270	0,91	160	0,72	2.430	0,89
TAIWAN [TW]	1.602	0,64	194	0,88	1.796	0,66

#### OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	1996 - 2001	2002 (30.06)	Total
Filing dates accorded	237.937	22.549	260.486
Number classifications checked	223.363	19.555	242.918
Applications published	190.742	19.566	210.308
Oppositions received	47.025	5.606	52.631
Contested applications	35.093	3.936	39.029
Appeals received	3.414	548	3.962
Registered Trade Marks	132.218	18.969	151.187
Published Registered Trade Marks	129.502	18.937	148.439
Requests for cancellation	361	58	419

#### OTHER OHIM FIGURES

	ON 30-06-02
Number of professional representatives	6410
Number of current accounts in use on the 31 <sup>st</sup> of March:	925
OHIM Personnel	643

"Does the Opposition Division have to point out to the opponent that he failed to produce the translation of the registration certificate of the earlier mark into the language of the opposition proceedings within the period given to do so?"

In its judgment of 13 June 2002 (Case T-232/00, *Chef Revival USA Inc. v OHIM*) - the first to be given in an *inter partes* case - the Court of First Instance (CFI) held that the Opposition Division is not obliged to point out to the opponent that he failed to produce within the period given to do so the translation of the registration certificate of the earlier mark into the language of the opposition proceedings. Neither does the Opposition Division have the obligation to grant the opponent an additional period of two months within which to produce that translation.

The CFI recalls that, in the Community trade mark regulation (CTMR) and its implementing regulation (IR), the legislature has drawn a fundamental distinction between, on the one hand, the conditions which the notice of opposition must satisfy in order to be admissible and, on the other hand, the submission of the facts, evidence and arguments and of the documents in support of the opposition, which fall within the scope of the examination of that opposition.

It is only in cases in which the notice of opposition does not comply with one or more of the conditions of admissibility of the opposition other than those expressly referred to in Rule 18(1) IR, that the Office is required, by virtue of Rule 18(2) IR, to inform the opponent of this and call upon him to remedy the deficiency within a period of two months before it rejects the opposition as inadmissible.

The failure by the opponent to produce, within the time allowed by the Opposition Division and in the language of the opposition proceedings, the translation of the registration certificate for the earlier mark does not constitute a deficiency in the notice of opposition within the meaning of Rule 18(2) IR. Rather, it falls within the scope of the substantive examination of the opposition and, in the absence of translation of the registration

certificate, the Opposition Division may lawfully reject the opposition as unfounded unless it can give a ruling on it on the basis of the evidence which it already has before it. The rejection of the opposition in such a case is not merely the result of the opponent's failure to comply with the period laid down by the Opposition Division but is also the consequence of his failure to comply with a substantive requirement of opposition proceedings, *i.e.* to prove the existence of the facts or the rights on which his opposition is based. Such an interpretation also results from Article 74(1), second clause, CTMR, which provides that, in proceedings relating to relative grounds for refusal of registration (such as opposition proceedings), examination is to be restricted to the facts, evidence and arguments provided by the parties and the relief sought.

The CFI also rejected the opponent's argument that he was not required to produce a translation of the registration certificate since he had indicated in English in a letter to the Opposition Division that the conflicting trade marks 'designated identical products and fell within class 25'. Such a reference does not constitute, nor can it be treated as equivalent to, a translation of the registration certificate of the earlier mark. The CFI underlines that the obligation foreseen by Rule 17(2) IR for the party originating *inter partes* proceedings to submit such a translation into the language of the opposition proceedings is justified by the necessity to observe fully the principle of the right to be heard and to ensure equality of arms between the parties in *inter partes* proceedings.

The Opposition Division's indication that, if the opponent failed to produce the information and translations requested it would give a ruling on the opposition on the basis of the evidence before it could not have caused the opponent to entertain an expectation that, in the absence of a translation, the Opposition Division would give a ruling on the basis solely of the untranslated certificate. Rather, it must be interpreted as meaning that the Opposition Division intended to give a ruling on the opposition without taking the certificate into account as evidence.

NEWS FLASH COUNCIL  
DECISION OF 23 MAY  
2002/NEW PRESIDENT  
OF THE APPEALS  
DEPARTMENT

Mr Bruno Paul Georges MACHADO, born in Paris (France) on 20 August 1945, is hereby appointed additional chairperson of the fourth Board of Appeal and President of the Appeals Department of the Office for Harmonization in the Internal market (Trade Marks and Design) for a period of five years.

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. 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