



OAMI

news



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editorial

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OAMI

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

HABM

HARMONISIERUNGSAMT
FÜR DEN BINNENMARKT
(MARKEN, MUSTER,
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)

During our 126th Annual Meeting held in Atlanta this May, I was honored to speak about the International Trademark Association's (INTA) efforts to erase borders in the trademark world. In truth, there was a lot to talk about. Over the past few years, INTA has been very active in the issues that trademark owners really care about, such as counterfeiting, geographical indications, trade dress, famous and well-known marks and the Internet. To better represent our members, we have worked with other organizations and offices, such as the U.S. Patent and Trademark Office (USPTO), the ASEAN IP Association, the Asociación Interamericana de Propiedad Industrial (ASIPI), and of course, the Office for Harmonization in the Internal Market (OHIM).

Since 1995, when INTA was first honored by the presence of OHIM officials at our meetings, INTA and OHIM have cooperated on a wide range of joint activities and initiatives. The presence of OHIM representatives at INTA's functions has not only been a unique opportunity for INTA leadership to interact with OHIM leaders, but also for the two organizations to exchange views on Community Trade Mark (CTM) and Community Design (CD) issues. In addition to such meetings, INTA has never missed an OAMI Trademark Users Group Meeting in Alicante. Such wider user meetings are valuable for both the trademark and design community, as they provide for an exclusive opportunity for all interested parties to meet and discuss issues of relevance to all users of the CTM and CD.

In the public policy arena, INTA and OHIM have been especially diligent in forging strong relationships to address trademark issues in the European Union (EU), particularly regarding the CTM system, and more recently, the CD system. Over the years, INTA has provided the Office with valuable and detailed comments from the trademark owners' perspective on the CTM. The recent inclusion of the CD as a new Community right under OHIM's umbrella has led INTA to include CD issues in its scope of activities. To this effect, we have even renamed our former Community Trade Mark Office Subcommittee. It is now the Community Trade Mark and Design Office (CTMDO) Subcommittee, focusing on design as well as trademark initiatives.

2003 and 2004 were very active years for INTA on the CTM front, as the EU and thereby the CTM system were undergoing major changes. INTA has not only

submitted many detailed comments on the various draft guidelines issued by OHIM since September 2003, and on the customer satisfaction survey recently released, but it also took a proactive role in supporting major changes to the EU CTM System, such as the EU accession to the Madrid Protocol, the transition to an optional search under Article 39 CTMR, and the CTM enlargement formula.

In June 2004, an OHIM delegation visited the INTA offices to discuss information sharing between the organizations. INTA receives many questions on a daily basis about the CTM and CD systems, and both organizations felt that the trademark community could be better served by coordinating efforts to answer those questions. Additionally, OHIM representatives were educated on the internal structure of INTA, giving them a better idea of how they can contribute to its members.

In 2002, INTA and OHIM held a joint conference in Alicante on the CTM. The program was so successful that we will be co-hosting another one this year from October 14-15 in San Francisco. This time, the event will cover both the CTM and CD. The conference will feature practical information and useful tips on these two mechanisms, and should benefit anyone wanting to find out more about the systems.

And, on October 26, INTA's Industry Advisory Council (IAC) Committee plans to hold a seminar for OHIM examiners on pharmaceuticals. The seminar will feature representatives from pharmaceutical member companies, who will speak about the issues that they encounter on a daily basis when working with the Office. INTA gave this seminar to the USPTO examiners earlier this year, and it was extremely well-received. We are delighted to be able to present it in Alicante.

From the perspective of trademark owners, the CTM system is more attractive than ever. This is not surprising, as it represents the widest harmonized regional system of trademark protection, covering 25 major jurisdictions, and will soon be accessible through International Madrid registrations. In addition to these very important substantive changes, Wubbo de Boer and the rest of OHIM's leadership continue their commitment to making the CTM and CD filings always easier and more cost-effective to the users that support OHIM's image as a leading office worldwide.

A NEW VERSION OF CTM-ONLINE

The OHIM has launched a comprehensively revised version of CTM-ONLINE.

As an important part of our *e-business* campaign, this new version of CTM-ONLINE improves both the search criteria and the information available and provides a greater degree of user-friendliness and transparency for our users. Combined with other planned *e-business* developments (MYPAGE, e-filing, e-communication, etc.), our clients will be able to take full advantage of the Internet to do business with the OHIM.

The changes and improvements to CTM-ONLINE have greatly benefited from the comments and extensive feedback received from a broad cross-section of CTM users, including both representatives and owners.

What's new about CTM-ONLINE?

- ② • More information on the Community Trade Mark registration process, updated daily
- Better supporting information via the help page, which now includes a glossary of statuses and information on Vienna codes

- Links to other databases, such as OHIM Case-Law (refusals, opposition, cancellation, appeals) and Curia, the European Court of Justice and Court of First Instance database

- Basic search criteria enhancements:

- Search by **type of mark** – word, figurative, 3D, colour, sound, olfactory, hologram, others
- Search by trade mark name now possible using '**stemming**' – e.g. 'film', 'films', 'filming', 'filmed', etc.
- Search by **Vienna Classification** for figurative trade marks

- Advanced search criteria enhancements:

- The use of **advanced operators** (Boolean) and **wildcards** for trade mark names
- Search by **Nice class**
- Search by **filing or registration date**
- Search by **status**
- Limit search to trade marks with or without **acquired distinctiveness**

- Improvements to the results:

- Possibility of **sorting** results by number, filing date or name, in ascending or descending order
- Up to **1,000 results** may be displayed
- Refine search (**search within a search**) now possible based on the previous (unlimited) results
- More precise **status information and visual representation**
- **Historical log** of statuses
- Detailed information on **opposition, cancellation, appeal and recordals**

Feel free to try it out at <http://www.oami.eu.int/>, and contact information@oami.eu.int if you have any questions.

THE OHIM HAS STARTED DELIVERING DECISIONS ON INVALIDITY OF REGISTERED COMMUNITY DESIGNS

On 1st April 2003 the OHIM began registering and publishing Community designs. According to the definition in Article 3 CDR (Community Design Regulation), a 'design' means the appearance of the whole or a part of a product.

Registration proceedings for Community designs are restricted to an examination of the formalities of the application, i.e. payment, quality of the drawings or photos etc. Prior to registration there is no substantive examination, i.e. novelty and individual character of the designs are not subject to examination.

However, after registration, third parties may object to a registration by filing an invalidity request with the OHIM based on prior art or other earlier rights. The OHIM will cancel the registration where the facts and evidence presented by the third party prove that the contested Community design does not fulfil the requirements for protection.

The Invalidity Division, within the Designs Department at the OHIM, has delivered its first decisions on applications for a declaration of invalidity of registered Community designs.

The first four cases concerned three different objects: a skin antiseptic composition dispenser, a stool or chair and a light fitting. In one case the applicant's design request was upheld and in the other cases rejected. The number of cases decided has now increased.

The scope of protection conferred by a Community design includes any design which does not produce a different overall impression on the informed user, taking into consideration the degree of freedom of the designer (Art. 10 CDR). The respective

overall impressions produced by the prior design and the Community design on the informed user were assessed in these first cases, in particular the features which are essential or characteristic to the two opposing designs. The Invalidation Division found that the designs did not

STATISTICS (SITUATION UNTIL THE END OF JUNE 2004)

COMMUNITY TRADE MARK (CTM) & COMMUNITY DESIGNS (RCD) APPLICATIONS

BREAKDOWN BY COUNTRY

	CTM						RCD			
	1996 - 2003	%	2004 [30.06]	%	Total	%	2003	%	2004 [30.06]	%
TOTAL WORLD	352.382	100	30.255	100	382.637	100	40.119	100	17.177	100
TOTAL EUROPEAN UNION	222.603	63,17	21.051	69,58	243.654	63,68	30.887	76,99	13.868	80,74
BELGIQUE/BELGIË [BE]	5.212	1,48	464	1,53	5.676	1,48	691	1,72	469	2,73
CYPRUS [CY]	246	0,07	44	0,15	290	0,08	22	0,05	0	0,00
CZECH REPUBLIC [CZ]	177	0,05	109	0,36	286	0,07	20	0,05	6	0,03
DANMARK [DK]	5.541	1,57	414	1,37	5.955	1,56	1.218	3,04	446	2,60
DEUTSCHLAND [DE]	58.053	16,47	4.974	16,44	63.027	16,47	9.880	24,63	4.502	26,21
ELLAS/GREECE [GR]	1.097	0,31	137	0,45	1.234	0,32	15	0,04	3	0,02
ESPAÑA [ES]	25.129	7,13	3.094	10,23	28.223	7,38	2.862	7,13	1.033	6,01
ESTONIA [EE]	26	0,01	5	0,02	31	0,01	0	0,00	0	0,00
FRANCE [FR]	22.459	6,37	2.230	7,37	24.689	6,45	2.778	6,92	1.503	8,75
HUNGARY [HU]	140	0,04	51	0,17	191	0,05	7	0,02	19	0,11
IRELAND [IE]	3.242	0,92	307	1,01	3.549	0,93	167	0,42	208	1,21
ITALIA [IT]	26.259	7,45	2.522	8,34	28.781	7,52	5.730	14,28	2.492	14,51
LATVIA [LV]	4	0,00	3	0,01	7	0,00	0	0,00	0	0,00
LITHUANIA [LT]	11	0,00	6	0,02	17	0,00	0	0,00	0	0,00
LUXEMBOURG [LU]	1.781	0,51	137	0,45	1.918	0,50	60	0,15	29	0,17
MALTA [MT]	71	0,02	12	0,04	83	0,02	3	0,01	0	0,00
NEDERLAND [NL]	9.752	2,77	1.136	3,75	10.888	2,85	1.569	3,91	644	3,75
POLAND [PL]	246	0,07	208	0,69	454	0,12	31	0,08	24	0,14
ÖSTERREICH [AT]	5.202	1,48	783	2,59	5.985	1,56	818	2,04	456	2,65
PORTUGAL [PT]	2.447	0,69	259	0,86	2.706	0,71	167	0,42	127	0,74
SLOVAKIA [SK]	13	0,00	2	0,01	15	0,00	13	0,03	0	0,00
SLOVENIA [SI]	77	0,02	46	0,15	123	0,03	11	0,03	18	0,10
SUOMI/FINLAND [FI]	3.219	0,91	233	0,77	3.452	0,90	296	0,74	127	0,74
SVERIGE [SE]	7.378	2,09	556	1,84	7.934	2,07	970	2,42	285	1,66
UNITED KINGDOM [GB]	44.821	12,72	3.319	10,97	48.140	12,58	3.559	8,87	1.477	8,60
TOTAL OUTSIDE EUROPEAN UNION	129.779	36,83	9.204	30,42	138.983	36,32	9.232	23,01	3.309	19,26
Amongst which										
AUSTRALIA [AU]	3.038	0,86	221	0,73	3.259	0,85	194	0,48	47	0,27
CANADA [CA]	4.461	1,27	347	1,15	4.808	1,26	146	0,36	37	0,22
HONG KONG [HK]	1.559	0,44	192	0,63	1.751	0,46	603	1,50	179	1,04
JAPAN [JP]	10.080	2,86	730	2,41	10.810	2,83	1.710	4,26	662	3,85
SWITZERLAND [CH]	7.595	2,16	739	2,44	8.334	2,18	828	2,06	290	1,69
TAIWAN [TW]	2.492	0,71	280	0,93	2.772	0,72	295	0,74	159	0,93
UNITED STATES OF AMERICA [US]	85.518	24,27	5.104	16,87	90.622	23,68	4.085	10,18	1.419	8,26

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

CTM	1996 - 2003	2004 [30.06]	Total
Filing dates accorded	333.196	36.887	367.083
Number classifications checked	316.275	40.073	356.348
Applications published	269.314	27.041	296.355
Oppositions received	66.743	3.583	70.326
Contested applications	49.517	3.120	52.637
Appeals received	5.149	473	5.622
Registered Trade Marks	202.480	10.514	212.994
Requests for cancellation	786	143	929

OTHER OHIM FIGURES

Number of professional representatives	7.051
Number of current accounts	1.018
Number of OHIM staff	662

produce different overall impressions and therefore it was decided that the Community design was in conflict with the prior design. Consequently, the Community design was declared invalid according to Art. 25(1)(d) CDR.

To know more about these and future cases a specific page has been created on the OHIM Internet site OAMI-ONLINE:

<http://www.oami.eu.int/en/design/invalid.htm>.

PUBLIC REGISTER OF THE OFFICE

Upon the entry into force of the Treaty of Amsterdam, Article 255 granting a right of access to European Parliament, Council and Commission's documents to any Union citizen and to any natural or legal person residing or having its establishment in a Member State was introduced. After a legislative process, this text is now applicable to the OHIM's administrative documents. On 18 April, a public register was launched via the OHIM's website. This right to access our documents is not applicable to Community trade marks and registered designs files, which will continue to be subject to specific inspection of files rules. A number of documents are already published on paper or online. However, with the new provisions applicable to the Office, any person will be allowed to request any unpublished document in paper, electronic version or any other format. When a request is filed with the Office, the Documentation Centre, which will manage the public register, will, within 15 working days, provide the document in the existing form. Specific information can be found at the following address: <http://oami.eu.int/en/office/preg/default.htm>

A new OHIM **electronic newsletter** will start to be sent soon. If you wish to receive it, please send your e-mail address to Subscribe@oami.eu.int.

USEFUL NUMBERS

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

www.oami.eu.int

Switchboard telephone number:

+ 34-965 139 100

General inquiries fax number:

+ 34-965 139 173

Fax number for the filing of any correspondence relating to Community trade marks, and designs (applications, letters to examiners, oppositions, cancellations, appeals, entries in Register, etc.):

+ 34 -965 131 344

CTM and RCD applicants and proprietors and their representatives are strongly advised to use only the above fax number for all communications relating to proceedings before the Office. Faxes will be sent to an automatic fax server which eliminates the printing and physical handling of documents. This will facilitate and accelerate the handling of incoming faxes. Faxes sent to other fax numbers in the Office will entail additional work and create substantial administrative burdens.

Telephone number for obtaining information concerning means of payment (opening of current accounts, bank transfers, payments by cheque, etc.):

+ 34-965 139 340

Telephone number for obtaining information about professional representatives (list of professional representatives, new entries, allocation of ID numbers, authorisations, etc.):

+ 34-965 139 379

Obtaining information in relation to copies from the file and extracts from the register:

+ 34-965 139 198

Obtaining information in relation to transfers, licences, conversions:

+ 34-965 139 175

Telephone number for obtaining information concerning subscriptions to our publications [OHIM Official Journal, CTM Bulletin (paper and CD-ROM), EUROM, etc.):

+ 34-965 139 102