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1997

## SEARCHES FOR EARLIER TRADE MARKS UNDER ARTICLE 39 CTMR

### I. Introduction

Pursuant to Article 39 of the Community Trade Mark Regulation (CTMR) all Community trade mark applications (CTM applications) are subject of a search whose purpose it is to establish earlier national marks or CTMs which may be invoked under Article 8 CTMR against the CTM application. The search for earlier CTMs or CTM applications is done by the Office under Article 39 (1) CTMR, while the search for earlier national marks is done, under Article 39 (2) and (3) CTMR, by the central industrial property offices of each Member State which has informed the Office of its decision to operate a search in its own register. Of the 13 offices of the Member States (the Benelux States having a common office, the Benelux Trade Mark Office), ten have decided to participate in the search. The three offices not participating are those of France, Germany, and Italy.

The Office has begun with the operation of the search system in July 1996. Until the end of 1996, about 3,250 applications were submitted to the participating national offices. Until the middle of March 1997, about 2,400 further applications have been communicated to the national offices. The Business Plan of our Office provides that in 1997 more than 50.000 applications will be sent to national offices. By the middle of March 1997, the Office had communicated a total of about 1,770 applications to the applicants under Article 39 (5) CTMR.

The Community search itself has not yet become operative, for reasons which are explained in more detail later.

The Office has received many comments on the search reports sent to applicants. The principal concerns of these comments relate to the content of the search reports which are frequently criticized as not containing sufficient information.

The purpose of this article is to explain the search system and its inherent limitations. The focus is on national searches; however, the Community search will also be dealt with.

### II. National searches

1. Article 39 (2) and (3) CTMR provide the legal basis for the search reports by national offices. Our Office is obliged to communicate applications to national offices as soon as the filing date has been accorded. The national offices participating in the search system must communicate their search reports within three months from the date when the application was communicated to them. Upon receipt of search reports, the Office must transmit them to the applicant without delay.

2. The Office has been in contact with all national offices even since before the beginning of its operations to determine the manner of carrying out the search system provided for in Article 39 CTMR. For this purpose, Liaison Meetings with representatives of national offices have been held. In this regard, two main elements - our Office's role and that of the national offices - must be kept apart.

a) As far as our Office is concerned, it was agreed that rather than sending true (physical) copies of applications received, we would establish lists of applications received and communicate these lists at periodic intervals (such as once a week) to all national offices. These lists contain essential information about applications, in particular the relevant date or dates, the mark itself, and the number of the Nice Classification into which the goods and services fall. Representations of figurative marks are communicated as an annex to these lists. Prior to communication a "pre-classification" examination must be carried out. An indication of the classes is necessary because otherwise an automated search cannot be made.

Given the volume of applications our Office has to handle, it should be apparent that communicating actual copies of applications would be beyond our current capacities, and probably also beyond the capacities of most national offices. Standard applications consist of some 8 to 10 pages. Multiplying these pages by 10 (for each national office) and by the number of applications to be submitted to the national offices before the end of 1997 would result in between four and five

065: XIV/3

million pages that would have to be produced and communicated.

Thus, from the perspective of our Office there is currently no realistic alternative to the list-based approach.

b) As regards the search reports established by national offices, our Office, in the contacts with national offices and in particular in the Liaison Meetings referred to, has sought to establish their contents by providing a list of elements which the search reports should contain.

These elements were, in addition to the indication of the Office carrying out the search (country code) and the CTM application number subject of the search,

- the numbers and dates of earlier applications or registrations making up the search report,
- the names of the proprietors of the earlier marks,
- the marks themselves, if word marks, or the verbal elements of figurative marks,
- an indication if the marks are figurative marks,
- an indication of the class or classes for which the earlier marks are applied for or registered.

Our Office did not request representations of figurative marks or the lists of goods and services of the earlier marks. While in an ideal world these elements might be considered as an important element of a complete search report, our Office and the national offices had to consider the implications of providing more information than that previously referred to.

Even as it is, the national offices and our Office have to handle an enormous volume of paper documents. The search reports we receive vary in length, but on average they are made up of three to five pages of text for each application searched, the actual length of course being dependent on the mark and the number of classes for which the CTM application was filed. Considering the number of applications to be searched up to the end of 1997 and taking four pages for calculation purposes, each national office will have to handle about 200,000 pages of text which together amount to about 2 million pages to be handled by our Office. These pages must be archived. With regard to each CTM application, we have to communicate to the applicant about 40 pages of text. If representations of figurative marks and the list of goods

and services for all marks were added, this would multiply the number of pages at least 10 to 20 times. It should be apparent that our Office would be incapable of handling these volumes.

As far as the national offices are concerned, they must establish the search reports for the 25 ECU fixed by the Office's Budget Committee. The national offices also are not necessarily equipped to provide lists of earlier marks with the content proposed by our Office. Therefore, all the search reports received so far are not necessarily structured in the same way or contain the same information. Rather, these search reports are made by the national offices according to their decisions, and they are responsible for their contents and manner of presentation.

3. Our Office recognizes the potential shortcomings of the search system as it is currently operating, which are however inherent in the system itself. Therefore, there are no realistic prospects for a fundamental change of the system itself. We shall however continue to work for more harmonized search reports by the national offices.

We have already introduced some improvements. Thus, the standard letters accompanying the communication of search reports to the applicant have been revised to contain some additional information which should facilitate the comprehension of the search reports. Furthermore, we are in contact with the national offices with a view to improving the contents and the manner of presentation of search reports, along the lines previously indicated. For example, we will ask national offices using abbreviations in the search reports to provide a full explanation of the meaning of these abbreviations.

The issue of search reports will continue to remain on the agenda of our contacts with national offices. The next Liaison Meeting scheduled for the second half of May 1997 will also deal with these matters.

4. It should be noted that at the initial stages of our operations we - and the national offices - are handling search reports in a traditional manner, which is to a large extent still paper-based. We will develop alternatives in the near or intermediate future, such as in conjunction with the RESMA network between national offices and our Office which will establish high-speed communication links. This will allow us eventually to depart from the current system. To the extent that applicants or

their representatives are themselves capable of handling electronic messages, also this part of our operation would change. Finally, creating these networks will also facilitate access to information currently not easily available or available only at substantial expense, so that the reliance on full paper-based search reports may eventually become a concern of the past.

## II. Community searches

As indicated in the introduction, our Office is obliged as well to carry out a search for earlier CTMs or CTM applications. However, under the transitional rules found in Article 2 of the Implementing Regulation the Office will not carry out a search with regard to all applications having 1 April 1996 as their filing date. The reason for this is that these applications are not earlier as against each other, even if filed at a point in time before 1 April 1996. As the Office is currently dealing with applications having a 1 April 1996 filing date, no Community searches have yet been carried out. Given our current production schedules, the first searches will not be necessary until much later this year.

The Office, after a public tender offer, has entered into a contract with an outside firm to develop an automatic search system. The development of the Community search system is currently in its initial stages.

## III. Conclusion

The search system provided for in Article 39 CTMR is the result of a difficult compromise reached in the negotiations in the Council of Ministers on the Community Trade Mark Regulation. The search reports communicated by our Office to applicants may be of substantial value to the applicant, but they may also present the applicant with difficult choices because a full investigation of all the marks contained in such search reports is time-consuming and expensive. It is for each applicant (or his representative) to decide how to proceed in these circumstances.

It is useful to point out that Article 39 (7) CTMR provides that the Commission must present a report to the Council of Ministers on the operation of the search system after five years of operation. At that point in time a full review of the search system as provided for in Article 39 CTMR will take place. The voices of the users of the system will play a significant role in that evaluation.

## “NOS SERVICES”

L'article qui suit est le premier d'une série d'articles sur les différents services de l'OHMI. Afin de situer cette série d'articles dans son contexte, il est opportun de rappeler l'organisation interne de l'Office, telle que publiée au JO 1/97 de l'OHMI, page 9.

A la tête de l'OHMI, se trouvent le Président et deux Vice-présidents. Chaque vice-présidence comprend un département et une ou plusieurs divisions. L'office comprend également un Contrôleur financier ainsi que des Chambres de recours. La Vice-présidence administrative et technique est composée du :

- Département des services administratifs et techniques, qui comprend:
  - le service financier, budget et comptabilité;
  - le service des ressources humaines et administration sociale;
  - les services généraux;
  - le service informatique;
- Division de la coopération technique;
- Secrétariat du Conseil d'administration, du Comité budgétaire et de la Commission consultative des achats et des marchés

La Vice-présidence juridique est composée du:

- Département juridique, qui comprend:
  - le service juridique et contentieux;
  - le service de la législation et des affaires juridiques internationales;
  - le service de la représentation professionnelle;
  - le service de l'administration du registre.
- Divisions examen;
- Divisions opposition;
- Divisions annulation;

Chaque département est divisé en services, eux-mêmes composés de secteurs, puis de sections.

La section courriers et dépôts, qui fait l'objet du premier article de la série, est comprise dans le secteur diffusion de l'information au sein des services généraux.

## La section courrier et dépôts

Il a paru judicieux de commencer cette série d'articles par la section courrier et dépôts qui est le point d'entrée des demandes de marques communautaires. Dans le jargon interne de l'office, cette section est mieux connue sous le nom de "mail room".

Le courrier est reçu à l'Office sous différentes formes: papier, télécopie, télécopie connectée à un serveur, disquette, messages sur le serveur EUROPA (INTERNET) de la Commission. Dès son arrivée, le courrier se voit attribuer une date de réception à l'Office.

Si le courrier a trait aux demandes de marques communautaires, il doit alors être chargé dans EUROMARC, le système de gestion de la procédure des marques. Il s'appuie sur une base de données qui contient toutes les informations relatives aux marques déposées. Ce système est opérationnel depuis le mois de mai 1996. Ainsi, les 24.000 marques reçues avant la mise en fonctionnement du

système (déposées entre le 1er janvier et le 30 avril), ont-elles fait l'objet d'un traitement particulier, en deux étapes:

La première étape du traitement des premiers dépôts a été la constitution d'une base de données interne qui devait recenser les dépôts de marques reçus, avec leur date de réception à l'Office. Elle servait également à attribuer automatiquement les numéros de dépôt.

La seconde étape a consisté en la constitution de dossiers sur base des demandes reçues sur support papier (par courrier ou par télécopie). Pour la petite histoire de l'Office, les premiers dépôts de marques communautaires ont été placés dans des pochettes "bleues", d'où leur surnom de "dossiers bleus". Les examinateurs ont ensuite envoyé les accusés de réception sur base des dossiers papier. Ces 24.000 "dossiers bleus" ont dû ensuite être scannés à leur tour par le service courrier tout au long de l'été. Le papier a enfin été archivé.

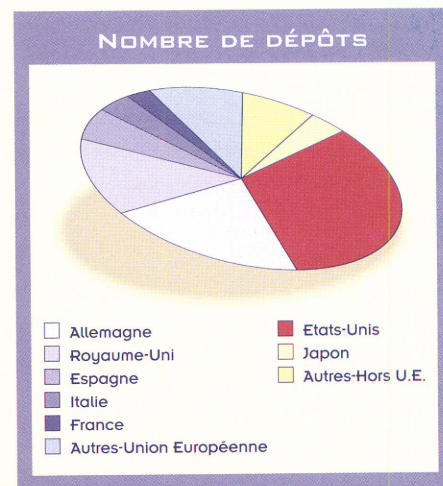
A partir de mai 1996, le système de gestion interne EUROMARC a démarré.

### QUELQUES CHIFFRES SUR L'OHMI au 15 avril 1997:

- 1) dépôts de marques communautaires
  - nombre de dépôts encodés dans EUROMARC: 49 678
  - répartition géographique des déposants sur base des dépôts encodés dans EUROMARC:

Union européenne:	29 101	58,58 %
Allemagne	8 634	17,38 %
Royaume-Uni	6 553	13,19 %
Espagne	3 213	6,47 %
Italie	2 715	5,47 %
France	2 104	4,24 %
Pays Bas	1 272	2,56 %
Suède	1 032	2,08 %
Danemark	832	1,67 %
Autriche	792	1,59 %
Belgique	723	1,46 %
Finlande	443	0,89 %
Irlande	314	0,63 %
Portugal	207	0,42 %
Luxembourg	166	0,33 %
Grèce	101	0,20 %
Hors Union européenne	20 577	41,42 %
dont :		
E.U.A	15 048	30,29 %
Japon	1 610	3,24 %
Suisse	1 080	2,17 %
Canada	552	1,11 %
Australie	332	0,67 %

- nombre d'accusés de réception envoyés: environ 49 000
- nombre de dates de dépôt accordées: environ 27 000



- 2) nombre de mandataires agréés auprès de l'OHMI : 4 830
- 3) nombre de comptes courants ouverts auprès de l'OHMI : 410
- 4) effectif de l'OHMI: 223

Le mode de chargement dans EUROMARC dépend du support sur lequel le formulaire de dépôt ou tout autre document relatif aux marques déposées, est entré à l'Office:

Le papier (courrier ou télécopie) fait l'objet d'une numérisation en mode image (il est scanné). Les documents ainsi "scannés" sont ensuite vérifiés et transférés dans EUROMARC; les logos subissent le même traitement à la différence près qu'ils doivent être toilettés avant leur transfert et mis au format de leur publication.

Les télécopies reçues sur le serveur fax (au numéro + 34-6-513 1344) ainsi que les disquettes sont directement transférées dans EUROMARC.

Dans un office qui se veut libéré du papier, cette section trouve une nouvelle dimension dans la mesure où elle est à l'origine de tout le processus de numérisation des données. Elle a

ainsi scanné plus de 600.000 pages en 1996, comprenant en particulier tous les formulaires de dépôts reçus en 1996, à savoir plus de 43.000.

Durant l'année 1996, cette section s'est étoffé en personnel (9 personnes au total) et en matériel (cinq scanners dont deux en couleur). Elle a également pris la responsabilité de nouvelles tâches telles que le contrôle des journaux du serveur fax, c'est à dire la vérification voire la retransmission si nécessaire, de tous les fax qui sont transmis directement via EUROMARC.

Depuis le début de 1997, la mail room a également reçu de nouvelles responsabilités en ce qui concerne le "dispatching" du courrier scanné. En d'autres termes, il ne s'agit pas simplement de scanner le courrier mais également de le router vers différentes files électroniques de documents (les "queues"). Il existe une

file pour le courrier urgent, une autre pour les formulaires de dépôts, une autre pour les certificats relatifs aux dépôts (priorité, ancienneté, pouvoirs, etc.), etc.

Les différentes files électroniques sont ensuite mises à la disposition des services, et en premier lieu de l'examen. Un routage plus fin devra alors être opéré avant que le courrier ne puisse être traité au fond par les personnes compétentes.



## NOTICE TO THE READERS OF THE CTM BULLETIN

CTMR Article 115 stipulates that the applications for Community trade marks shall be filed in one of the official languages of the European Community. The applicant has also to indicate a second language among the five languages of the Office the use of which he accepts as a possible language of proceedings for opposition, revocation or invalidity.

Under the terms of CTMR Article 116, the applications for Community trade marks as well as the entries in the Register of the Community trade marks are published in all the official languages of the European Community.

Paragraph 3 of CTMR Article 116 specifies that "in case of doubt, the text in the language of the Office in which the application for Community trade mark was filed shall be authentic. If the application was filed in an official language of the European Community other than one of the languages of the Office, the text in the second language indicated by the applicant shall be authentic."

In accordance with CTMR Article 117, the translations of the applications for Community trade marks are provided by the Translation Centre of the Bodies of the Union in Luxembourg.

For the publication of the first five numbers, the services of the Office checked all the provided translations in order to improve the quality of the Bulletin, as the Translation Centre did not have the necessary revision facilities. These are currently being provided gradually and will be fully operational soon. However, having regard to the large volume of received applications, the workload of the Office is such that we cannot continue carrying out these checks while awaiting this development.

Consequently only the translation in the second language indicated by the applicant, that can be the authoritative language, is checked by the Office. The other translations are published as they are provided to us.

We trust that the readers of the Bulletin will understand the situation. The quality of the published texts will be the subject of constant improvements.

### USEFUL NUMBERS

- Standard telephone number:  
+ 34-6-513 91 00
- General information telephone number:  
+ 34-6-513 92 43; + 34-6-513 92 72
- General information fax number:  
+ 34-6-513 91 73  
Explanations concerning the application form, questions concerning the registration procedure (priority, seniority, fees, etc.), CD-ROM giving details of the CTM applications, request of documents/literature (leaflets, application forms including electronic filings, authorisations, opening of current accounts, reference guide to official texts, places where to buy the Official Journal of the Community, etc.).
- Fax for CTM applications and any correspondence relating to such applications, as well as for all other proceedings relating to CTMs (opposition, appeal, etc.):  
+ 34 -6-513 13 44
- Telephone information concerning means of payment  
+ 34-6-513 93 40  
Opening of current accounts, bank transfers, payments by cheques, etc.
- Telephone information about representation:  
+ 34-6- 513 91 17  
List of professional representatives, new entries, allocation of ID numbers, authorisations, etc.
- Telephone information concerning certified copies:  
+ 34-6-513 92 20  
Fax request of certified copies:  
+ 34-6- 513 91 14
- Telephone information concerning publications:  
+ 34-6- 513 91 02  
Information on OHIM's Official Journal, the Bulletin of CTM, etc.