

OAMI

news

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*Président des
chambres de recours*

éditorial

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Les chambres de recours de l'OHMI constituent une création originale, sinon unique, du législateur communautaire. Partie intégrante de l'Office dont elles ont pour mission de contrôler les décisions qui affectent les utilisateurs de la marque communautaire et du dessin ou modèle communautaire, elles offrent aux parties aux procédures devant l'Office, du fait de l'indépendance dont jouissent leurs membres, la garantie fondamentale d'un recours devant une instance spécialisée et indépendante dans ses décisions de la hiérarchie de l'Office. Les décisions des chambres de recours n'en restent pas moins des décisions de l'Office, soumises au contrôle de la Cour de justice européenne.

Plus encore que l'Office dont elles font partie, les chambres de recours sont une institution jeune, puisqu'elles n'ont réellement commencé à fonctionner qu'au cours de l'année 1998. L'importance qu'elles revêtent dans le processus d'enregistrement de la marque communautaire et les ambiguïtés qu'a pu susciter, à l'origine, la position particulière qu'elles occupent au sein de l'Office, ne sont pas étrangères au processus de réflexion engagé sous l'impulsion du conseil d'administration de l'Office, dans un double souci d'efficacité et de cohérence, en vue de doter les chambres des moyens de répondre encore mieux qu'elles ne le font actuellement aux attentes des utilisateurs.

On trouvera dans ce numéro un résumé statistique de l'activité des chambres de recours depuis leur création. On en retiendra en particulier que, en 2002, pour la première fois depuis le début de l'activité des chambres de recours, le nombre des décisions rendues par les chambres et le nombre des affaires réglées ont excédé le nombre des recours reçus, ce qui s'est traduit par une réduction de près de 10% du nombre des affaires pendantes devant les chambres, lequel s'établissait à environ 1350 au 31 décembre 2002, soit quelque 14 mois d'activité des chambres.

Cette montée en puissance de l'activité des chambres de recours n'est pas seulement le reflet de l'augmentation des moyens en personnel mis à leur

disposition; elle est aussi et surtout le résultat des efforts d'une équipe éminemment qualifiée et consciente de sa mission. Elle laisse entrevoir que, à moins d'une augmentation importante du nombre des recours, que rien ne permet de prévoir à court terme, les chambres de recours devraient être en mesure non seulement de faire face à la demande, mais encore de réduire progressivement le nombre des recours en attente de résolution et, par conséquent, la période de latence des recours formés devant elles.

Une plus grande convergence dans les décisions des chambres de recours et une plus grande lisibilité des principes qu'elles dégagent, c'est-à-dire une plus grande prédictibilité pour les usagers du système, constituent l'autre objectif de la réflexion en cours.

Quant aux mesures propres à traduire ces objectifs en action, le Conseil a décidé de nommer un président des chambres de recours, responsable du fonctionnement des chambres et de leurs services d'appui. J'ai pris mes fonctions à Alicante en septembre dernier. D'autres mesures de nature institutionnelle seront nécessaires, qui impliquent une modification du règlement du Conseil sur la marque communautaire, actuellement à l'examen d'un groupe de travail du Conseil, et du règlement de la Commission établissant les règles de procédure des chambres de recours. Il s'agit notamment d'instituer une chambre élargie, présidée par le président des chambres de recours, dont le rôle essentiel devra être de prévenir ou de résoudre les conflits de jurisprudence au sein même des chambres, et de permettre l'élimination de facteurs structurels de rigidité dans l'organisation du travail des chambres, afin de disposer d'une plus grande flexibilité dans la distribution des ressources disponibles et de favoriser la convergence des approches et des pratiques.

Dotés de ces moyens supplémentaires, les chambres de recours devraient être encore mieux à même de remplir la mission qui leur est assignée, au service des utilisateurs de la marque et du dessin ou modèle communautaire.

OAMI

OFICINA DE
ARMONIZACION 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
HARMONISATION
DU MARCHÉ
INTERIEUR
(MARCQUES, DESSINS
ET MODELES)

CEE: XIV/3

1. Absolute grounds for refusal

Single letters

In case R 224/2002-3, 'T', the Board stated that a single letter may not be denied distinctive character without examination of the individual goods and services listed, on the ground that single letters without additional original or unusual elements are excluded as a rule from registration. No such generalised ban on registration can be inferred from the legislation, nor can any such general empirical principle be identified in the trade. A denial of specific distinctive character requires finding of facts from which it may be inferred that the targeted public will not understand the letter as an indication of origin in respect of certain goods.


Country names and other geographical indications

The Boards ruled twice on the issue of whether a country name could be registered as a Community Trade Mark ('CTM'). No general ground for refusal exists in relation to the names of states or countries. Their capacity to serve as trade marks must be examined in relation to the list of goods and services claimed. The relevant question is whether that indication designates a place currently associated in the mind of the relevant trade circles with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future. In case R 594/1999-2, SUDAN, the Board stated that SUDAN could function as a sign to designate 'dyes and colorants for colouring and marking mineral oil' because the customer circle interested in such colorants is made up of a specialist public and it is not very likely that these trade circles might assume that these goods originate from the Sudan itself or are associated with it. In case R 691/2000-1, GREENLAND, the Board saw no reason why the sign should not be able to serve as an indication of origin for goods such as 'meat and milk and dairy products or agricultural products', particularly since 'Greenland' could be understood, in relation to these goods, as a fanciful allusion to a natural, organic or environmentally friendly method of cultivating or processing the raw produce.


Decisions R 1220/2000-2 and R 1221/2000-2, Duque de Villena and Duque de Peñafiel, dealt with Article 7(1)(j) CTMR. Trade marks consisting of or containing a geographical indication

identifying wines or spirits must refer to wines originating from this particular geographical area. If such goods do not have this origin, the CTM application has to be refused under Article 7(1)(j) CTMR.

Article 6 ter of the Paris Convention

In case R 466/2000-2,  (ECA), the Board ruled under Article 7(1)(h) CTMR. Due to the strong similarity of the sign to the emblem used by the Council of Europe, the EC and the EU, it decided that it should not be registered for 'computer software, organisation of conferences and congresses and computer program design'. To overcome an objection raised under Article 7(1)(h) CTMR authorisation must be obtained from the authority owning the symbol protected according to Article 6ter of the Paris Convention. This case is now before the Court of First Instance.

Public policy

In cancellation case R 338/2000-4,  (INTERTOPS), the charge of being contrary to public policy was based by the appellant on the fact that the respondent, lacking the official permit necessary under German law in order to be able to organise games of chance, is unable to use the Community trade mark to offer its services as a bookmaker in Germany, and possibly in other States of the EU as well, for similar reasons. The Board stated that any assessment of whether a trade mark contravenes Article 7(1)(f) CTMR must consider the trade mark itself. The fact that the applicant, under national public law, is not allowed to offer its services does not imply that the use of the trade mark as such is unlawful or that it would fall under Article 7(1)(f) CTMR. This case is now before the Court of First Instance.

Colour marks

In relation to colour marks, the Boards continued the case-law developed in 2001. Decision R 194/2000-3, GREEN colour, reviews the relevant issues in the light of the case law of the Boards of Appeal and the Court of First Instance on colour trade marks, confirming that the standards for the assessment of distinctiveness are the same as for other trade marks. In particular, under Article 7(1)(b) CTMR, no evidence is required as to market acceptance or prior use of the sign on the market.


Three dimensional marks

Concerning three-dimensional marks, in

line with the case law of the Court of First Instance in the 'Patterned Glass' case and of the European Court of Justice (ECJ) in the 'Philips' case, the Boards have given, for example, decisions in cases R 252/2002-3, Cigarette packet, and R 177/2002-3, DOPPELNUT. The criteria for assessing the distinctive character of three-dimensional marks, as such, are no different from those to be applied to other categories of trade marks. It is not necessary for the shape of the article to include some capricious addition, such as an embellishment, in order to be distinctive

2. Likelihood of confusion

Article 8(1)(a)

In case R 1/2000-3, ARTHUR ET FELICIE/,  the Board had to deal with Article 8(1)(a) CTMR, and more specifically with the question whether the prohibition on registration imposed by that article applies to identical reproductions – with no element being added or omitted – of an earlier trade mark or whether it is necessary to examine whether or not the earlier trade mark retains its individuality and distinctive character within the sign under consideration. The interpretation given is that the expression 'identical trade marks' should be strictly interpreted and should be limited to perfectly identical signs.

Family of marks

The Board ruled on the family of marks' doctrine, for example, in case R 123/2001-4, SPA/GOSPA. It considered that this doctrine might apply in respect of marks which all share a common (identical) distinctive feature and only differ on other, secondary, aspects. That feature is essential, as it will enable consumers to classify a mark as a member of that family (see also R 510/2001-1, ACTIONCAPS/ACTION, and R 627/2001-1, CELEBREX/CEREBRESP). In case R 55/2002-1, BETTY LA MALICE/BETTY, the Board decided that, with respect to 'dolls', almost any combination of the name 'BETTY' with any other element is likely to be perceived by the relevant consumer as belonging to a type or series of such marks because the consumer of these goods is generally aware that variations of such 'named' dolls are often marketed using that name in association with one or more other elements highlighting the particular features of the doll.

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3. Proof of use in opposition proceedings

In a series of decisions dealing with oppositions based on the same earlier mark and having the same parties [nike/NIKE (FIG. MARK)], the Board had the occasion to deal in depth with proof of use in opposition proceedings. In many of these cases, the decisions of the Opposition Division had accepted evidence of the use of the word NIKE as proof of use of the earlier trade mark. The Board reversed these deci-

sions (appeal cases R 19/2000-1, R 73/2000-1, R 16/2000-1, R 880/1999-1 and R 833/1999). These cases are now before the Court of First Instance. It considered that the evidence was insufficient to prove genuine use of the figurative trade mark. The decisions dealt with two main issues: the use of a trade mark in a different form as registered and the meaning of genuine use. In respect of genuine use, the Board decided that the sign must be used

as a trade mark and not as a trade name, company name or other business identifier, since the function of all the latter differs from what is proper to the trade mark. Additionally, the use of the trade mark must be public, that is, external. The trade mark must be introduced onto the market. The private use of the trade mark, that is, where the final destination is not the market and consumer in question, cannot be considered to be use of the trade mark.

STATISTICS (SITUATION AT THE END OF JANUARY 2003)

COMMUNITY TRADE MARK APPLICATIONS

	1996 - 2002	%	2003 (31.01)	%	Total	%
TOTAL WORLD	294.625	100	3.642	100	298.267	100
	1996 - 2002	%	2003 (31.01)	%	Total	%
TOTAL EUROPEAN UNION	183.509	62,29	2.293	62,96	185.802	62,29
BELGIQUE/BELGIË [BE]	4.253	1,44	72	1,98	4.325	1,45
DANMARK [DK]	4.642	1,58	63	1,73	4.705	1,58
DEUTSCHLAND [DE]	48.667	16,52	559	15,35	49.226	16,50
ELLAS/GREECE [GR]	845	0,29	24	0,66	869	0,29
ESPAÑA [ES]	19.438	6,60	294	8,07	19.732	6,62
FRANCE [FR]	18.355	6,23	253	6,95	18.608	6,24
IRELAND [IE]	2.773	0,94	25	0,69	2.798	0,94
ITALIA [IT]	21.432	7,27	253	6,95	21.685	7,27
LUXEMBOURG [LU]	1.485	0,50	15	0,41	1.500	0,50
NEDERLAND [NL]	7.641	2,59	110	3,02	7.751	2,60
ÖSTERREICH [AT]	4.417	1,50	54	1,48	4.471	1,50
PORTUGAL [PT]	1.921	0,65	27	0,74	1.948	0,65
SUOMI/FINLAND [FI]	2.785	0,95	35	0,96	2.820	0,95
SVERIGE [SE]	6.331	2,15	61	1,67	6.392	2,14
UNITED KINGDOM [GB]	38.524	13,08	448	12,30	38.972	13,07
	1996 - 2002	%	2003 (31.01)	%	Total	%
TOTAL OUTSIDE EUROPEAN UNION	111.116	37,71	1.349	37,04	112.465	37,71
Amongst which						
UNITED STATES OF AMERICA [US]	74.457	25,27	803	22,05	75.260	25,23
JAPAN [JP]	8.535	2,90	84	2,31	8.619	2,89
SWITZERLAND [CH]	5.982	2,03	86	2,36	6.068	2,03
CANADA [CA]	3.889	1,32	78	2,14	3.967	1,33
AUSTRALIA [AU]	2.646	0,90	26	0,71	2.672	0,90
TAIWAN [TW]	1.994	0,68	38	1,04	2.032	0,68

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	1996 - 2002	2003 (31.01)	Total
Filing dates accorded	282.248	3.470	285.715
Number classifications checked	263.781	3.907	267.688
Applications published	230.106	5.182	235.288
Oppositions received	56.814	861	57.675
Contested applications	41.788	712	42.500
Appeals received	4.430	98	4.528
Registered Trade Marks	168.190	2.069	170.259
Published Registered Trade Marks	166.088	2.150	168.238
Requests for cancellation	520	20	540

OTHER OHIM FIGURES

Number of professional representatives	6683
Number of current accounts	943
OHIM Personnel	630

CEE: XIV/3

USEFUL NUMBERS

Switchboard telephone number:
+ 34-965 139 100

General inquiries telephone number:
34-965 13 88 00

General inquiries fax number:
+ 34-965 139 173

The Office's Internet site: oami.eu.int

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.).

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 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.

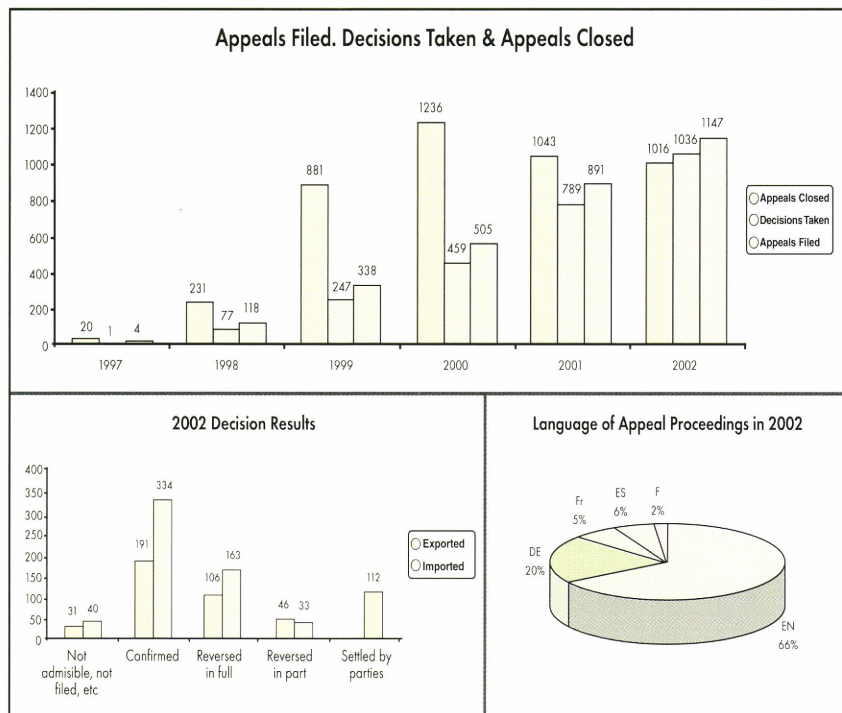
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4 OHIM AT THE 125TH INTA ANNUAL MEETING 3-7 MAY 2003

INTA, the International Trademark Association, is going 'European'.

The organisation has over 4200 members in more than 160 countries. All of them are trade mark owners and professionals.

On 4-5 December 2002, the OHIM hosted the Community Trade Mark Forum in Alicante. This two-day event was dedicated exclusively to the CTM and RCD and brought together more than 200 trade mark professionals from New York to Hanoi.

Not only the history of the CTM but also its future, with the recent proposals to modify and improve the system, and the effects of enlargement of the EU were discussed. The approach of non-European users to the system was also very interesting.

For its 125th annual meeting INTA chose Amsterdam, the Netherlands. The previous

meetings where the OHIM exhibited took place in Denver (2000), San Francisco (2001) and Washington DC (2002).

A high level delegation of the OHIM will go to Amsterdam to give presentations, host table topics and a booth in the exhibition hall. This year the main objective will be to spread awareness and to improve the knowledge about the electronic filing system, the registered Community design as well as the latest developments in the CTM system.

More information regarding the event can be found on the INTA website www.inta.org. As from mid-March, a webpage will also be available with more information about the OHIM delegation and its activities during the meeting at <http://oami.eu.int/>.

Tot ziens in Amsterdam !