



**SUBJECT: Report on the 16th meeting of the OAMI
User's Group**

AUTHOR: Elia Sugrañes, Reporter CET 9
PURPOSE For information

DATE: April 27, 2009
REFERENCE: EXCO/US09/CET/1901
MEETING:: ExCo Washington D.C., US
MEETING DATE : 6 & 10 June, 2009
TABLED TO : All attendees

EXECUTIVE SUMMARY

The OAMI Users Group met in Alicante on 16th March 2009, being the 16th meeting of this Group.

FICPI was represented by Elia Sugrañes.

This paper is a report on said meeting, which we believe to be important that FICPI continues to attend.

The next meeting is scheduled to be held on beginning of 2010.

16th Meeting of the OAMI Users' Group Alicante, 16th March 2008

Report of FICPI

The OAMI Users Group met in Alicante on 16th March 2008.

Agenda

1. Opening of the meeting by the President of the Office

Mr. Wubbo de Boer opened the meeting and welcomed everyone to the 16th meeting of the OAMI User's Group.

There were representatives from several organisations including AIM, APRAM, BusinessEurope, CNIPA, ECTA, EFPIA, FICPI, ICC, GRUR, INTA, MARQUES, UNION, European Commission, as well as several participants from the office.



2. Adoption of the agenda of the 16th meeting

The Agenda was circulated by email a few weeks before the meeting. No extra topics were added.

3. Adoption of the minutes of the 15th meeting

The minutes of the last meeting held on 3rd March 2008, were adopted by everyone present in the User's Group Meeting.

4. Current status of the activities of the Office in general

General Overview. The President suggested to follow the questions issued by the User's Group and it is agreed. Some of the questions are already replied in later ones.

(AIM) What impact is the Office seeing from the contraction in business due to the recession? Do you anticipate any amendment to your projections for the coming 2 years in light of this downturn?

As of today the figures do not show that the number of applications will be lower than 75000 CTM Application. The budget of the OHIM was based on this figure – even with the fee reduction that will come into effect soon and that since last trimester 2008 the number applications has been reduced in 10 %- if during this year it becomes apparent that this figure will be lower then there will be some rebudgeting.

(AIM) Can the Office give any indication as to the likely timetable for the changeover of the Presidency ?

The President and the Vice President's mandate terminate in 2010. Before the end of 2010 there will be notices for both posts. In the spring of 2010 there will be decisions on the people assigned for these new jobs.

Euromarc++ impact on services

This new improved system has gone live on 6 February 2009 with some advantages: simplified, independent, not status based but task based

The CTM ONLINE will fully updated by the 3rd week of March after some delays due to the freeze that was necessary to migrate the data.

User Satisfaction Survey

The full report will be available online today on the OHIM website. There were more replies this year than any other year, and the survey was, once again, considered representative for the results shown.

A general conclusion may be drawn that there is an increase in the satisfaction in the e-business tools.



5. China

Commission's DG TRADE Presentation

The President gave the floor to the EU Commission representative, Mr. Ravillard, who explained to the User's group the IPR2- an important cooperation agreement that has been going on between the European Union and China since 2002 and is now in its second version.

The aims of this project are to improve IP enforcement in China, through trade marks and designs expertise.

The background of this project and the significant investment the European Union has put into it has to do with the following:

China is a key trading partner of the European Union (it is the 2nd behind the United States).

The EU is the biggest trading partner of China. China is a priority for the EU and in particular the IP is a priority in this partnership considering that 60% of counterfeit goods come from China, and this is improving since in 2008 it was 80%.

One of the greatest difficulties is the complexity of administrative procedures, the court system in China is bureaucratic and, moreover, at the local level, the regulatory enforcement and corruption are considerable.

The EU answer is Cooperation and Dialogue in a government to government Meetings once a year in Brussels and Beijing. It has been started a working group in Beijing with industry that focus on particular areas every time, one member of the OHIM staff is directly working in this program.

There have been very limited results, such as: Improvements in new patent law that will come into force this year, and the Counterfeit markets in Beijing: agreements supported by the Courts, allocation of more staff to the trade mark office to deal with trade mark applications and trade mark oppositions and, in particular a positive court decisions: e.g. Ferrero.

As per the technical Assistance in 2007: New technical cooperation programme with the IPR2 for 4 years – 2007 – 2011. There will be an investment of 16 million euros, 11 million euros will be funded by the EU and the other 6 million euros by China).

There is a long term commitment to develop IPR in China. And it covers various areas such as a legal framework – IPR laws and regulations (criminal law, gi's, civil).



6. Alteration to CTM fees

State of play

(ICC) Distribution of OHIM surplus – possibility of further reductions to registration fees and other fees

(INTA) Can OHIM confirm that the new fees will be valid as from 1 July 2009. What will be the practical impact of “merging” the application and registration fee particularly during the transition period.

(GRUR) Fee Reduction which date ? Apparently 1st May 2009

7. Cooperation Fund

Overview

The floor was for the Vicepresident, Mr. Peter Lawrence who gave the general overview of the surplus of the office and announce the small group of people specialize in funds – expertise of funding that will be responsible for the funds (3 / 4 people) that will have the power from the administrative board to manage the money surplus. Ti fund projects these are project tat will be of benefit to users.

There is an amount of 50 million to be dispersed within 5 years for several projects within more than one country. It is not about spending distributing cash. It is about specific projects and about sharing projects within several countries or national offices.

Eg: Use this money, not to subsidize bureaucracy, but to use software to improve .

(INTA) One of the actions agreed during the Joint Meeting of the Administrative Board and the Budget Committee of the OHIM on 18/19 September 2008 is the allocation of 50m Euro as a cooperation fund for the national offices in order to improve and harmonise the CTM system. These funds will be used for projects “closely related” to the protection and promotion of trade marks and designs and to the harmonisation of the European trade mark systems. In its letter of 6 October 2008 to Dr Frohlinger, INTA indicated that it strongly encourages the establishment of an oversight and governance mechanism which must include CTM users’ input as a means to ensure that the Cooperation Fund will be used for the purposes exclusively related to trade mark issues. What are OHIMs views and concrete plans in this respect?

(INTA) Remaining sum after repartition of Cooperation Fund (50m Euro) and Reserve Fund (190m Euro) There are 400m Euro in excess. After different repartitions 160m Euro will remain. In its letter of 6 October 2008 to Dr Frohlinger, INTA confirmed its belief that such funds must be used solely for the benefit of users of the CTM system, that is, to ensure that OHIM can maintain high standards of quality service. What are OHIMs views and concrete plans in this respect?



8. Trade Mark Study

State of play by EU Commission

This study has not yet started. It should be a part of a global evaluation study. To identify potential areas of evaluation potential area of the Community Trade mark system as well as of the national trademark systems and to the benefit of the users.

The commission wants to emphasise the start of the trademark survey the EBTP, allows the Commission. To get feedback from the users, it is that first part to get feedback that started in the last quarter of 2008.

The results have been made public, and these results are also on the OHIM website.

The study that should now follow is a 2nd and major element should be launched soon. The scope of the study has been determined already. It is still being decided if it should be one big study or 2 or 3 small studies.

Time line: a result will not be issued before early 2010. They confirm they are ready for the review of the trademark regulation and the community trademark regulation study.

Scope: this is a broad one. They will have a deep analysis of the trademark systems in Europe as far as trademark offices performance in concerned. They will look into the major drives of the users.

It is one of the goals the assessment of the links between the community trademark systems and the national systems. The nature of the links between these systems, and what the national trademark offices are doing the functioning of the community trademark system as a whole, in particular as enforcement.

How to make the system more effective for the users.

[\(AIM\) Does the Office have any insight as to the projected timeline and scope of the forthcoming study on the functioning of the trade mark systems in Europe](#)

The members of the meeting requested to be part of this study and not only of the end of the same.

9. E Business

A presentation will be distributed to the parties as it was explained very quickly. Basics will be:

Update on projects

*Latest implementations

E –communication – reply online to the office

Online certificates: download electronically from the website

E certification: download the documents certified by the office.

Reduce delay in inter partes procedures.



***Ongoing projects**

2009: many new tools put into production
RDC filing e designs accessible through my page
April 2009_ credit card electronic renewals
May 2009: Ctm watch warnings for the status
1st quarter 2010: Management electronically of the opposition procedure
1st quarter 2010: Recordals electronically (transfer, representative)

April 2009_ TM View: Former Euroregister; search engine to allow trademark registers of EU members starts as well as WIPO will do.

Euroclass Centralised classification tool should provide access to classification information of participation offices: more countries and more functionalities.

Harmonisation: in the data bases of goods and services.

***Lab projects:**

For internal use: Decision Template Generator or the Examiner Support Tool
And for external use: Common Security Module Common Payment Platform
Common online Platform (for acceding publications)
Platform for Online Services replacing MyPage
Exchange platform (opposition tool)
Convert the prototype into accessible tools and test them

***Planned projects**

CTM online for EM ++

The system has been changed since 13th March 2009 and will now be updated daily.

Users' involvement in new projects (update on usability methodology)

Usability
Time success satisfaction

Training programme

Workshops paralegal in cooperation with several organisations GRUR, APRAM COAPI (May, September)

[\(ICC\) updating of OHIMs website](#)

[\(INTA\) As from March 2009 all CTM-related notifications to current e-communication users will be done via electronExcahnge Platfomric communication in oppositions, appeal, recordals, cancellations. Users notice that delays in forwarding communications in *inter partes* proceedings slow down the progress of such proceedings. Will these delays be avoided by this new way of communication.](#)



(GRUR) Impact of the new CTM e-filing-system: performance issues:

- * General problems: size of formats e.g. for docket No. of Priority trademarks
- * quality of official receipts (nearly unreadable)
- * problems with the printing of application forms of logos "image not found"
- * problems of communication between Browser Firefox and Explorer 7
- * no confirmation of received applications
- * saving of applications (except in My Page)
- * no print during the filling in of the application form
- * printing deletes the application form

10. The Community Trademark

(GRUR) Impact of new CTM e-filing system: substantive issues:

- * delay in confirmation of e.g. seniority, assignments of CTMs
- * charge of fees even in cases of withdrawal
- * no correct list of goods and services in case of restrictions
- * problems with the change of languages
- * "included in Class ..." no accepted
- * problems with exhibits

National Searches

Quality and Speed of proceedings

(ICC) Quality and speed of application and opposition proceedings

Ambitious objectives: they have been met from our perspective.

(APRAM) delays in the procedures

Opposition procedures

Specific cases, for instance, notification of third party observations

Legalisation of OHIM priority documents or certified extracts

(UNION) Quite some CTM and RCD applications are filed as a first applications in the meaning of article 4 B) Paris Convention, and consequently serve a priority application for subsequent applications in other countries. Many of these other countries still require a legalised copy of the CTM or RCD priority document or register extract. On the OHIM web page we found instructive guidelines indicating the steps for completing legalisation. However these guidelines seem to be addressed exclusively to OHIM representatives having a seat in Spain since, according to these instructions, the legalisation can be completed only before Consulates and Embassies in SPAIN ... (documents can be handed over in person only). We would very much appreciate if the website would be completed so as to include also the legalisation steps to follow for those OHIM representatives that do not have a seat in Spain, so that they can complete the legalisation steps before the Consulate or Embassy in their own country.



Andrea di Carlo responded that there are not many of these cases for the countries that still require a further certification other than the certification already issued by the person in the Office and still need a further legalization for a Spanish authority. He confirmed that they ascertain that the Office is working with the Commission to try and simplify these procedures, since there are only a few countries who require it. For example to proceed with a trademark in Kuwait it would be required that the Kuwait Embassy in Spain, for a document issued by OHIM must be signed by OHIM, EU official and the Kuwait Embassy in Spain.

Several organisations insisted that there are not few of them, around 600, but titleholders go for a national register instead of using the CTM system because of this inconvenience.

The President confirmed they would work on this matter.

Class Headings

(MARQUES) Use of class headings and the enforcement of the OHIM communication no. 4/03, MARQUES position paper of October 2008.

Not many countries of the European Union support this decision of the OHIM.

Mr. Vincent O'Reilly asked for the views of other organizations: there are different views since
T-186/2

There is the issue of legal certainty. Marques wants to put the issue up for discussion.

Acquired distinctiveness

(AIM) it is our understanding that a trade mark should be registrable as a CTM if it is considered sufficiently distinctive to function as a trade mark in a substantial part of the EU. The Glaverbel case seemed to require the applicant to prove distinctiveness country by country of the EU so failure to use the mark in one small market could outweigh significant sustained use in other large countries. Would OHIM clarify how distinctiveness should be determined in such circumstances?

Patterned glass that needed proof of use since it was not made public: profession in the trade + public (consumers in the market) resulted that evidence was only from a number of territories not from all the Community.

Shape of food products: Evidence was only from Italy: court said proof is not sufficient.

OHIM Guidelines: look at markets not necessarily at countries.

Opposition

(INTA) There are situations in which it makes sense that related opposition proceedings (for example oppositions filed against very similar CTM applications filed in the name of the same company and opposed on the basis of identical earlier rights) will be handled by the same examiner. Users notice that OHIM seems to be reluctant to comply with parties' request in this respect despite of the clear advantages. What are OHIM views in this respect.

The Office agrees that they should do it. It is in the interest of the Office and in the interest of the user. Let the Office know soon enough.... So they try to do it.



Similarity of Goods

(EFPIA) the future OHIM database on the similarity of goods

(GRUR) Position on the OHIM database on the similarity of products and services

(APRAM) (MARQUES) update on this project

Mr. Vicent O'Reilly answered on behalf of the office. The Office has been promising a database that would primarily give instructions to examiners about what goods are similar and what degree of similarity there are, so there is consistency in decision making. It would be a useful tool for examiners and for all examiners to have the same opinion as far as similarities.

The development of the tool is yet to be made but and it would be available to the outside world after September 2009.

Use

(AIM) Some NPTOs have suggested that use requirements should be amended to reduce "cluttering". Users would be concerned if there were any amendment to the current use requirements so can we ask if the Office has considered changing it's practice ?

Renewals

(INTA) In case of renewals the OHIM send an automatic reminder notice 6 months before the expiry of a CTM. Users notice that, even if the renewal fee is paid the day after the reminder a notification of renewal will not be received until after the 6 months period has expired. Is this standard OHIM practice. If so, users may wait to pay the fee until the date before expiry.

That is what the law requires. And that the OHIM's practice.

(UNION)

Unlike most patent or trade mark offices, OHIM do not send out an overdue reminder within the 6 month grace period, only an advance reminder. The advance reminder is not of much use, whereas the overdue reminder would be of real assistance.

Yes. That is correct. The OHIM does not do that. The OHIM only notifies the owner if the mark has expired.

40% of the Community trademark system will not be renewed.

11. The Community Design

Registered Community Designs database

(MARQUES) proposal for the registered community designs database so as to display all applications for registration, including those ultimately held non-registrable. MARQUES letter to OHIM of 27 October 2008.



Mr. Rodinger understand the reasons behind Marques proposal. One of the aspects is confidentiality. From the Office's perspective it is an open question. So they are open to discussion, if not all the way, maybe another way around it.

Send comments in writing on the draft proposal of OHIM's reply .

Locarno classification

[\(MARQUES\) Changes to the Locarno classification system. MARQUES position paper 23 October 2008](#)

What things do or what things look like.

There is no action required from OHIM's side but it is still an important issue for OHIM.

Erroneous dates in official publication RCDs (pending issue)

[\(UNION\) This is quite a technical problem concerning the dates published under the WIPO ST.80 codes 45 and 46, but should be resolved as soon as possible in view of the possible legal consequences.](#)

The office was not aware of these errors. When they became aware they have already started the procedures and they should be solved by now.

12. The Boards of Appeal

Update

Mr. Paul Maier, President of the Boards of Appeal gave a brief update on this matter.

Not much to say, just an update.

Very busy year although less appeals.

Pendency times has gone up but hope to recuperate. There are now 1341.

No suspension without statement of grounds.

Confirmation rates are (of the decision of opposition divisions) around 60%

The confirmation of decision in th CFI has gone down.

New IT systems in the boards of appeals has helped. New people joining in June 2009.

13. Miscellaneous

Observer status in OHIM Administrative Board meetings.

The Administrative Board of the OHIM granted the Observer status to a few international non-governmental organisations who are also members of the Users Group.

A representative of the OHIM explained a bit more in detail in which way the non-governmental organisations will be able to participate as observers in the OHIM Administrative Board Meetings.



The Observers status is for 2 years and membership of the Users Group was one of the criteria, among other things. Not more than 5 NGO's were chosen (INTA, ECTA, Business Europe, AIM, Marques) and only one person from each NGO is allowed to participate. The rules of procedure are published on the web page of the OHIM. As an Observer the NGO's may intervene after the members of the board. They may only intervene as regards non confidential issues. They may also suggest topics for the agenda through the chair person.

The next Administrative Board meeting is scheduled for 4-5 May 2009.

Complaints Unit update

Mr. Etienne Sanz Acedo gave a very brief update the CCU.

Total complaints filed in 2008: 196 which is a slight decrease of previous years. The complaints filed are about: CTM Oppositions, E-filing, Classification, Fee Payments, Opposition Decision delays.

Following the User Satisfaction Survey the CCU is reviewing the way the procedure by which complaints are dealt with internally and trying to improve it.

Other issues

The OHIM was visited by members of the European Union that are evaluating and making an assessment of the agency model. Our contacts and names were given and there is the possibility that we will be contacted for this purpose.

Date of next meeting

The date of our next meeting will come with the minutes of the office.

The President thanked everyone for their participation and comments that, once again, contributed to the success of this meeting which was then adjourned.

End of report