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**DRAWN UP BY:** Andrew Parkes  
CET Special Reporter, Trade Marks & Designs

**SUBJECT:** **FICPI Report on the 14<sup>th</sup> OAMI Users Group Meeting  
Alicante, March 9, 2007**

**PURPOSE:** For ratification

**DISTRIBUTION:** All attendees



## **FICPI Report on the 14<sup>th</sup> OAMI Users Group Meeting Alicante, 9<sup>th</sup> March 2007**

FICPI was represented at the OAMI Users Group Meeting by Andrew Parkes, because neither the Chairman nor the Reporter of CET Group 9 was available to go at short notice. The meeting was preceded by a very useful discussion over dinner the previous evening with representatives of ECTA, AIPPI, APRAM and UNION.

The first item of substance on the OAMI Agenda was a lengthy presentation about the User Satisfaction Survey carried out in December 2006, with comparisons to the previous Survey in 2005. Little was added to the information already available on the OAMI website and summarised in Alicante News, the Office's online newsletter. While the results were generally positive, there had been some dissatisfaction with the consistency of examiners' decisions, the difficulty in making contact with Examiners and problems with the Office's e-business tools. A. di Carlo of the Quality Management Department then gave a further presentation on the OHIM Service Charter which is to be published in April. Useful information included the following:

- Information queries sent to [information@oami.europa.eu](mailto:information@oami.europa.eu) should be answered within 2 days;
- Complaints filed at [customercare@oami.europa.eu](mailto:customercare@oami.europa.eu) will be taken into account in regular reports and if relating to an examiner will be sent to the examiner, the legal advisor and the head of the service involved.

B. Schmidt of the Trade Mark and Cancellation Department (TMCD) described a new quality check system that has been put in place for both examination and opposition, looking at randomly selected cases. The results will be reported quarterly, any systemic problems will be identified and there will be feedback to examiners, although this is unlikely to lead to revocation of a particular decision unless there has been a grave error.

### Fees

As a result of large budget surpluses and cash reserves at the Office, the European Commission had issued a Communication on the Financial Perspectives of OHIM [COM (2006) 865 Final of 22.12.2006] proposing a method of regular review of the fees, probably on an annual basis. The fees would no longer be fixed by a Commission Regulation. Various organisations had made written comments on this proposal. H. Temmink for the Commission said that it was hoped to get agreement from Member States and the European Parliament in time for a meeting of the Competitiveness Council in May. There was considerable resistance from sectors within Member States. Most user organisations welcomed the proposal which would result in a reduction in fees but some emphasised that the quality of service must not be affected and that more of the surplus should be invested, particularly in e-filing facilities and in staff quality and experience. ECTA mentioned that the CTM is an exclusive right valid in the entire territory of the EU and proper legal treatment must be given to the process of granting it. If at all possible, there should be an equilibrium between the value of a CTM and the value of a national mark. FICPI [AJP] said that in view of the accumulated surplus the current Commission proposal for a regular review of fees seemed to be the logical thing to do but it was regrettable that this situation was not recognised at the time in 2002/3 when the abolition of searches was proposed and we were told that continuing the searching system would adversely affect the Office's financial independence. FICPI had argued against this at the time. FICPI agreed with several points in ECTA's written paper,



particularly with regard to investment in quality of OHIM's services. It would be important to maintain a balance between owners of existing registrations and their competitors who are seeking freedom to use new marks. If filing, registration and renewal fees were to be reduced, then the fees paid by third parties for opposition and cancellation should also be reviewed. FICPI also asked whether there was any proposal to review the CTM system generally after 10 years of operation. The law had its origins in the 1970's when there were only 9 Member States and even since it had been adopted in 1994 there had been a large increase in the number of Member States up to 27. Some parts of the law might need to be reconsidered in order to achieve the right balance in the enlarged Community.

H. Temmink for the Commission said that no study of the CTM system was planned but that was not to say that it would not be useful after 10-12 years of existence. He confirmed that investments would continue to be made in the system and that Office performance came before surpluses. Commissioner McCreevy was very impressed with the performance of the Office. P. Lawrence, Vice President of the Office, said that there was no trade off between quality and financial management. They could pay enough to retain quality of staff and the budget for services including IT was not constrained.

#### E-business

Plans for improving online access were described. User organisations complained about the stability and practical difficulties during e-filing. Fax filing was still easier and paralegals preferred to use it. The Office provided 2 phone numbers for e-business hot-line queries:

Support        139100  
Technical     139400

They are arranging training sessions for paralegals in Alicante and Brussels. If the system is particularly slow, as it was at Christmas, all who reported filing problems were allowed to file by fax at the e-filing fee. However users did not regard this as a solution. CNIPA suggested that some of the excess finance in the Office should be used to investigate an off-line filing system.

#### CTM Optional Search

B. Schmidt said that the Office was preparing for the Optional search system which is to operate on CTM applications from March 2008. Neither the amount of the extra fee payable nor the number of countries participating was known yet. At present 16 countries provide search reports. The option will be for all searches or none.

FICPI (AJP) asked whether the requirements for national search reports to meet the standards of new Rule 5.a from March 2008 were being considered as part of the technical cooperation programmes with national offices. V.O'Reilly replied that the only requirement was an agreed format. The fees will be discussed during the November meeting of the Administrative Board. The OHIM had asked national offices to tell them the cost of doing the searches. It varied depending on the informatic systems used. FICPI asked whether there was any intention of investing funds in information technology so that the optional national search reports could be provided in accordance with Rule 5.a in a more usable and attractive form for users. V. O'Reilly replied that there was no connection with technical cooperation funding from OHIM. The President said that the fees yet to be fixed are supposed to cover all of the costs for the offices participating in the system. [In private conversation with AJP the President emphasised that the OHIM could not pay any of the costs of national systems but he did say that an IT interface to facilitate communication from national offices could possibly be funded by OHIM].



### Madrid Protocol

The Office had produced a paper for discussion concerning the problem of where to send communications in a case where Madrid Protocol applicant designating the EC does not have a professional representative on the OHIM list. Search reports, in particular, cannot be sent through WIPO. ECTA objected strongly to a part of the paper referring to a “possible surprise” for the TM owner if a professional representative carried out work on the search report and charged for it. User organisations had not had time to consider the paper and the President closed discussion on it, asking for written comments by the summer.

### Classification

UNION, supported by APRAM, questioned the OHIM interpretation that a class heading covers all goods in the class. V. O’Reilly acknowledged that their practice is different from the majority of Member States but it was done to give satisfaction to users because the term “all goods in Class X” was not allowed.

### Proof of use and Use requirement

V. O’Reilly said that until something changes, the OHIM will follow the statement in the Council’s minutes (that genuine use in one country is sufficient). Regarding use to sustain earlier rights and the interpretation of “sub-sets” to which goods or services could be restricted, he asked users to draw attention to any decisions since last October in which there had been discrepancies.

### Opposition

Concerning “cooling-off”, H. Jakobsen reported that since the 22-month system had been adopted on 01.03.2006, the average time and the number of cases in cooling-off had been reduced, tempting him to jump to the conclusion that the effort in reminding parties every 2-3 months under the old system had had no effect.

APRAM raised a question about the requirement in Art. 8(4) CTMR to show that a non-registered sign relied upon had been “used in the course of trade”. When must this use have taken place? The answer was that the Office would expect to see proof that the sign had been used in the past 5 years.

### Consistency of decisions

In response to a query from INTA about different decisions on three 3D bottle marks, V. O’Reilly gave a detailed presentation on the allocation of cases, the training of examiners, legal advisers etc.

### Boards of Appeal

P. Maier summarised the performance of the Boards, which closed 1670 cases last year, confirming the decisions in 81% of *ex parte* cases and about 2/3rds in *inter partes* cases. Three cases have been decided by the Grand Board.

### Accessibility

The Office has out-sourced its main switchboard, which has reduced the level of non-attended calls to less than 1%. There is a dedicated line for e-business queries. All phone calls to examiners must now go to a central number. If the examiner is not available, an email should be sent to the central mailbox [info@oami.europa.eu](mailto:info@oami.europa.eu) and an answer can be expected within 2 days.



### Designs

Daily publication is to begin in July. This will speed up registration.

### Technical Co-operation with National Offices

M. de Sousa said that of €2 million budgeted for 2006, only a quarter had been requested by Member States. Only DE and IE asked for funding for seniority databases.

### Location of User Group Meetings

UNION suggested that in view of the inconvenience of travel to Alicante, one of the meetings each year should be held in Brussels. However it would be difficult to find a venue with translation facilities there and most users preferred the opportunity to meet OHIM officials in the Office.

### Other Agenda items

As so much time had been spent on early items, it was not possible to complete the agenda. The President undertook to provide answers in the Minutes about the remaining issues. The next meeting will probably be in November 2007.

N.B. Draft Minutes are available at

[http://oami.europa.eu/pdf/office/draft\\_minutes\\_14th\\_OAMI\\_USERS\\_GROUP.pdf](http://oami.europa.eu/pdf/office/draft_minutes_14th_OAMI_USERS_GROUP.pdf)

Andrew Parkes

CET Special Reporter (Trade Marks and Designs)