



EXAMINATION

What is it?

We use the term "examination" to describe those proceedings in our Office which deal with Community trade mark applications from the point after reception here in Alicante to immediately before registration, excluding opposition proceedings.

Elsewhere, as for example in relation to examination guidelines referred to in Article 121 (5) CTMR⁽¹⁾, examination refers to all the procedures before instances of the Office (examiners, Opposition Divisions etc.). What is dealt with here is what examiners do.

Basic steps

Examiners first encode the data contained in applications and then issue a receipt in accordance with Rule 5 of the Implementing Regulation. In principle this is done within ten working days of receipt of the application in the Office. Where the application is lodged through the central industrial property office of a member state (or the Benelux Office) that office should already have issued a receipt. In these cases the Office receipt refers to the fact that the application has not been received directly.

Filing date

The next stage is to check whether a filing date can be accorded. Although the Office has not yet reached its target of doing this within two months of receipt of an application, more than 32,000 filing dates have been attributed. The requirements to be satisfied are clear and easy to comply with. The most frequent area of difficulty is timely payment.

A reminder:

payment must be received within one month of the date of application in order to retain the application date as the filing date.

Applications in respect of which payment is made by current account experience the least difficulties as concerns payment.

Classification

The list of goods and services in each application is checked to ensure that it is sufficiently clear to enable each item to be placed in one of the 42 Nice Classes. There is no obligation on the applicant to classify and group the list correctly. However, the extent to which this is done correctly in the application makes this part of the process more simple for both the applicant and the Office. In examination of classification issues the Office has a preference for the use of Nice class headings or the use of terms from the alphabetical lists. Clearly it is not always possible to use these terms, particularly for new products or services, and the Office recognises this in its practice.

After classification the essential content of applications are sent to those national offices which have opted to be part of the search system under CTM Article 39 (2)⁽²⁾. The elements of applications which require translation are sent to the Translation Centre of the Bodies of the European Union in Luxembourg.

Formalities

Examination in respect of formalities involves checking whether a representative is required and has been appointed. Where there is such an appointment authorisation is necessary. The more complex part of formality examination relates to seniority claims. From the practical point of view this is a novel concept for applicants, their representatives and indeed examiners. For all concerned there is the additional difficulty of having to deal with documents in up to eleven languages and from as many as sixteen offices. The layout of these documents is not identical, and, indeed, over time the way offices present information changes. As all of our experience increases it should become progressively easier to deal with these problems.

⁽¹⁾ The abbreviation CTMR refers to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark as amended by Council regulation (EC) No 3288/94 of 22 December 1994.

⁽²⁾ France, Germany and Italy have not taken up this option.

Search

This subject was dealt with extensively in a previous issue of OAMI News and requires no further comment here.

Absolute grounds

The more intellectually challenging phase of examination relates to considering possible absolute grounds of refusal under Article 7 CTMR. While the content of this provision is, as a result of the First Harmonization Directive⁽³⁾, common to the CTM and national legislation in the Member States, practice is not yet uniform. Indeed some observers may question whether practice within any single national office is uniform. In order to assure the greatest degree of uniformity within the Office, particularly with the currently limited experience of this aspect of the process, decisions are taken only after collective discussion. With more decisions made (by now in excess of 2,000 applications have been examined on absolute grounds) there will be a more solid basis for individual decisions than is presently the case.

The aim of the Office is to set standards for absolute grounds decisions that lie in between what would be considered the most rigid approach of national offices on the one hand and the most liberal on the other. No doubt, as with practice at national level, this will evolve over time.

On the basis of the limited experience to date, and this experience relates to applications filed before 1 April 1996, the rate of refusal of applications on absolute grounds will be significantly less than 10%. Initially, applicants will receive notifications of intention to refuse at a higher rate than this but it is clear that some of the objections raised by the Office can be overcome.

In some instances this will be possible by limitation of the list of goods and services and in others by evidence of distinctiveness acquired by use Article 7 (3) CTMR.

Publication

Applications which successfully proceed through the steps mentioned above are published in the Community

Trade Marks Bulletin. Publication, for elements of the application that require translation, appear in all eleven official languages of the European Community. To the greatest extent possible information in relation to an application is coded to avoid the need for translation. Opposition on the basis of relative grounds for refusal must be lodged with the Office (not through any national office) within three months of the official publication date of the Bulletin.

Any third party may also submit observations in relation to a published application Article 41 CTMR.

So far some 9 issues of the Bulletin have been prepared, each containing an average of 100 applications. We have recently moved to a weekly frequency of publication and will gradually increase the number of applications contained in each issue.

It is clear that with new applications coming into the Office at a rate of about 500 per week and a backlog now amounting to 50,000 the rate of publication must eventually approach 1,000 per week if the backlog is to be cleared.

The physical publication date is earlier than the official date mentioned on each issue. This arrangement is to ensure that, as far as possible, the time taken for distribution of the Bulletin from Luxembourg⁽⁴⁾ does not encroach on the three month time limit for lodging possible oppositions.

Who does examination?

Examiners do it. By examiners we mean all those working on applications in the Office for the processes mentioned above. This includes, for the present, personnel recruited to serve in the Opposition Divisions whose services have been made available to assist in clearing the backlog that currently exists.

Examiners come from a variety of backgrounds. Some have worked in national offices, some have acted as professional representatives or been employed by them. Others have dealt with trade marks on behalf of their employers and more come to us with less direct experience of trade mark matters. All are nationals of Member

States of the Community and almost all Member States are represented in the current staff of examiners.

The number of examiners will continue to increase in the course of the year to a point where there will be almost 100 working full time. In addition, we will continue to have the assistance of colleagues from the Opposition and Cancellation Divisions to the extent that their other responsibilities allow.

How do they do it?

Examination of applications takes place within an electronic system, called EUROMARC, where all the necessary data is encoded. Applications themselves and supporting documents are scanned and viewed by examiners on screen. Classic paper files in relation to applications do not exist. Correspondence to applicants and their representatives is generated from the EUROMARC system.

Although decisions in this phase of the operation are required by the CTMR to be taken by an examiner, examiners are organised within the Office into a unit known as the Examination Division. Smaller units exist within that Division to deal with specific tasks.

Anything else?

Yes. A brief reference has already been made to payment of fees. In addition to ensuring that the basic fee is paid examiners also ensure that all class fees that are due are paid. The basic fee covers up to three classes of goods and services and an additional fee is due in respect of each additional class.

Examiners will also send requests for registration fees once these fall due. This will be when the three month period after publication expires without any opposition, when an opposition has been rejected in whole or in part or where the application is allowed to proceed to registration after settlement of any opposition filed.

⁽³⁾ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks.

⁽⁴⁾ While the content is prepared in the Office, physical production and distribution is handled on our behalf by the Office for Official Publications of the European Communities.

LA SECTION INFORMATION

La section information est composée de 4 personnes, dont deux standardistes. Ces personnes ont des connaissances linguistiques étendues afin de couvrir de façon satisfaisante les 5 langues de l'Office. Cette section a été mise en place dès l'ouverture de l'Office afin de répondre à l'ensemble des questions posées par le public sur l'OHMI, la marques communautaires et les formalités à accomplir afin d'obtenir un enregistrement. Le cas échéant, la section est également chargée de diriger les personnes ayant des questions plus spécifiques, qui sortent de sa compétence de généraliste, sur les bons interlocuteurs à l'intérieur comme à l'extérieur de l'Office.

Durant cette période de démarrage de l'Office, les interlocuteurs et les questions sont nombreuses et variées. On trouve, tout d'abord, le public de tout office responsable d'une procédure de délivrance d'un titre de propriété industrielle, à savoir des industriels et commerçants de la région, du pays, de l'UE et du reste du monde ainsi que des mandataires, des avocats, des juristes d'entreprise, sans oublier les simples particuliers. Les questions sont également posées par les offices nationaux dans la mesure où ils reçoivent également les dépôts. Enfin, il existe un public plus large, attiré par le caractère communautaire de l'Office.

Les questions posées sont en grande majorité relatives à la marque communautaires elle-même mais il ne faut pas négliger les questions relatives aux marques en général, nationales et internationales, aux autres droits de propriété industrielle, (et en particulier le brevet européen), à la propriété littéraire et artistiques. Enfin, il nous arrive de recevoir des questions d'ordre général sur la Communauté, voire sur des thèmes totalement étrangers à notre office, qu'il s'agit d'aiguiller sur des interlocuteurs compétents à Bruxelles éventuellement.

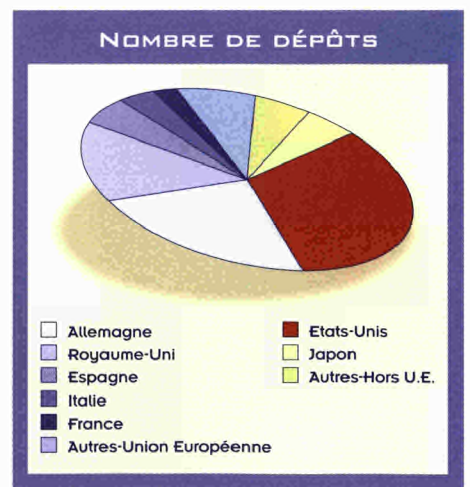


QUELQUES CHIFFRES SUR L'OHMI au 15 mai 1997:

- 1) dépôts de marques communautaires
- nombre de dépôts encodés dans EUROMARC: 53.152
- répartition géographique des déposants sur base des dépôts encodés dans EUROMARC:

Union européenne	30.412	58,56 %
Allemagne	8.917	29,32 %
Royaume- Uni	6.855	22,54 %
Espagne	3.322	10,92 %
Italie	2.848	9,36 %
France	2.292	7,54 %
Pays Bas	1.354	4,45 %
Suède	1.113	3,66 %
Danemark	865	2,84 %
Autriche	809	2,66 %
Belgique	752	2,47 %
Finlande	455	1,50 %
Irlande	331	1,09 %
Portugal	217	0,71 %
Luxembourg	173	0,57 %
Grèce	109	0,36 %
Hors Union européenne	21.520	41,44 %
Dont:		
E.U.A	15.717	73,03 %
Japon	1.687	7,84 %
Suisse	1.114	5,18 %
Canada	578	2,69 %
Australie	359	1,67 %

- nombre d'accusés de réception envoyés: environ 52.443
- nombre de dates de dépôt accordées: environ 33.869



- 2) nombre de mandataires agréés auprès de l'OHMI : 4.873
- 3) nombre de comptes courants ouverts auprès de l'OHMI : 430
- 4) effectif de l'OHMI: 232

Le secteur a su également se donner **les moyens** d'affronter l'afflux de question accompagnant naturellement le volume inattendu de marques reçues à l'Office jusqu'à ce jour. Grâce à la mise en place, en 1996, d'une base de données interne permettant de générer une lettre type dans les 5 langues, le secteur est, en effet, en mesure de faire face aux très nombreuses demandes d'information écrites et, plus particulièrement d'**envoi de documentation** (formulaires de dépôts, brochures de vulgarisation, textes relatifs à la marque communautaire, demandes d'ouvertures de comptes-courants, demandes d'inscriptions sur la liste des mandataires agréées, etc.). Ainsi, plus de 5000 demandes d'information

écrites ont-elles pu être satisfaites en 1996.

Il faut également mentionner l'**assistance téléphonique** (de 20 à 50 questions par jour) et l'**accueil sur place** des déposants et de leurs mandataires. L'accueil des personnes travaillant dans les quelques 20 cabinets installés à Alicante revêt, à nos yeux, une importance toute particulière. Ces cabinets proviennent de toute l'Europe (Espagne, Allemagne, Royaume-Uni, France, Italie, Pays-Bas, etc.) et déposent chaque jour de 5 à 20 dépôts (voire plus) au guichet d'accueil. Le secteur d'information est pour eux et pour l'ensemble de la profession la "vitrine" de l'Office.

NEW ID NUMBERS FOR GENERAL AUTHORISATIONS

Starting on 23 April 1997, General Authorisations received by the Office are being registered and processed in Euromarc. Up to the present, representatives have been given General Authorisation "ID numbers" in the series "P100 000". As from 23 April, the ID numbers communicated to representatives for the new G. A. commence with "P9000".

The computerisation of General Authorisations will accelerate their registration and eliminate the need to process them on paper.

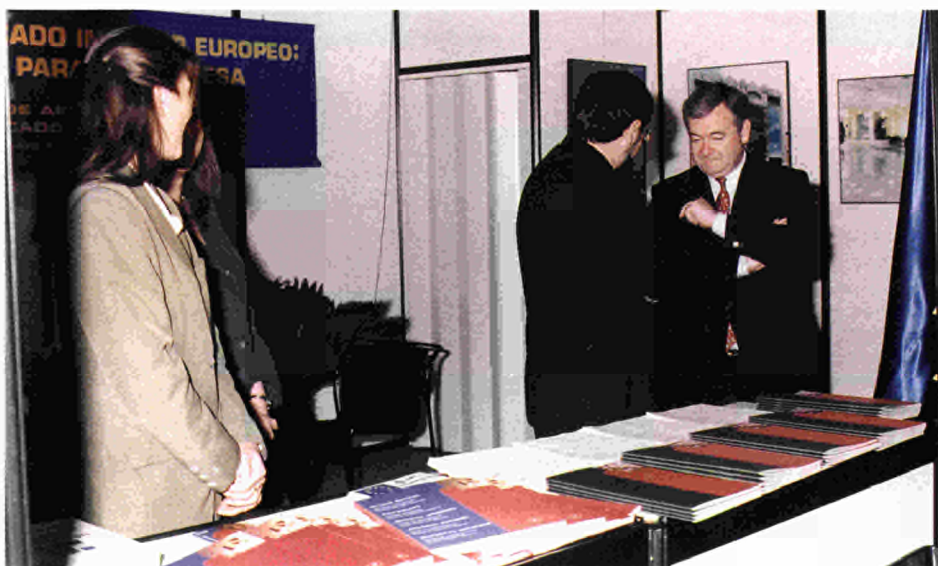
OAMI EN EL EXPOCALZADO

La Oficina de Armonización del Mercado Interior participó con un stand ofrecido por IFA (Institución Ferial Alicantina) en la feria internacional del calzado que tuvo lugar del primero de marzo hasta el día tres de marzo, en el que se difundió información sobre nuestra Oficina.

Los visitantes demostraron un gran interés por nuestra actividad y se entregaron numerosos folletos editados

en distintos idiomas. Se registró una numerosa afluencia de visitantes interesados en tener mayor información sobre la solicitud de marca comunitaria.

La OAMI prevé participar en otras manifestaciones de este tipo.



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.