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EDITORIAL

The Commission attaches great importance to the operation of the Office for Harmonization in the Internal Market. The

Community trademark system constitutes one of the major pieces in the jigsaw of legislation necessary for the completion and the proper functioning of the internal market.

The initial expectations for the Office were ambitious. For 1996 a figure of 15 000 applications for marks was envisaged. The structure, budget and staffing for the new office were all based on this figure. However the immediate attraction of the system meant that rather than 15 000 applications, the Office was faced with more than 40 000 applications in the first year alone. Since then the number of applications is but raising. The estimate for year 2000 is 55 000 - 60 000 applications. It is likely that the number of applications will rise beyond that level in years to come.

In spite of some initial difficulties in handling almost three times as many applications as initially predicted, the Office has nevertheless demonstrated its adaptability and through hard work on the part of all those involved is now providing a service that satisfies the need of its clients - the trademark applicants and holders. The continuously raising number of applications is in itself a proof of confidence.

In addition to the high number of trademark applications in the present Community trade mark system, the Office will also need to consider the practical consequences of handling a Community Trademark system covering those countries that will join the European Union. I am greatly encouraged to know that the Office is already co-operating closely with representatives of the candidate countries. This bodes well for a smooth transition from a Community trademark covering 15 countries to one covering anything up to 25 countries.

The Community trade mark system has turned out to be a first important tool for industry. The ambition is now, as a second step, to develop a system of protection for industrial designs compatible with that provided for trademark.

In June 1999 the Commission presented an amended proposal for a regulation on the

Community Design. This proposal is now under discussion within the Council. It is difficult to say at this time when the Council will adopt the Regulation and when the Office will start to receive the first Community design right applications, but I can assure you that the Commission attaches great importance to this dossier.

Whenever this happens I am convinced that the Office will be able to carry out this additional task with the same efficiency as it demonstrated in the case of Community Trade Marks. I am also sure that we have all learnt from the introduction of the Community trademark so that the incorporation of the Community Design system in the Office day to day work will run smoothly.

In order to provide industry with a third tool of industrial property protection at a Community level the Commission will present a proposal for a unitary Community patent system in June.

The Community patent will have the same features as the Community trade mark and the Community Design. The Community patent must also be affordable. It is also crucial that the Community patent system could guarantee legal certainty. In this context the Commission has in its contribution to the Intergovernmental Conference on institutional reforms, proposed for the creation of a single European Patent court of first instance. This court would deal not only with procedural issues but also examine patent cases also in substance. Further, there will also be a possibility to appeal to a second instance within the framework of European judicial system.

The Office for Harmonization of the Internal Market has indeed shown an impressive capacity in the field of industrial property law. However, in view of its long and high-level experience in managing the European patent, it is desirable that the European Patent Office should become the technical operator for the future Community patents.

I would like to conclude this article by formally recognising the hard work that has been put into by all those associated with the Office. This has made the Office the success that it is today and has established it as an essential pillar of the internal market policy of the European Community. ■

LE MOT DU PRÉSIDENT

L'OAMI: UNE "START UP" COMMUNAUTAIRE?

L'OAMI est un organe de l'Union européenne. Mais il est aussi une espèce de «start up» tant sa croissance est rapide. En 4 ans de fonctionnement son budget est passé de rien à 120 Millions d'euros. De 3 personnes à ses débuts il dispose aujourd'hui de 600 collaborateurs. D'un bâtiment généreusement prêté par l'Espagne, il doit se répartir aujourd'hui sur 6 sites, dont l'un construit par lui a été inauguré il y a quelques mois par les plus hautes autorités de l'Union européenne et du Gouvernement espagnol.

Le nombre de demandes de marques explose à un rythme de 35% par an. J'en prévois plus de 55.000 en l'an 2000 et... peut-être 100.000 dans 3 ou 4 ans. Y a-t-il seulement une asymptote?

Le contribuable doit être heureux: l'OAMI est et sera toujours autofinancé.

Comme pour toute «start up» la gestion est dure et difficile. Seules la rapidité de décision et des procédures efficaces, des équipes motivées et compétentes, ont permis jusqu'ici d'assurer l'essentiel: le service et la satisfaction des citoyens usagers de la marque communautaire.

Pendant ce temps des esprits imprégnés d'une culture centralisatrice et peu soucieux des principes de bonne gestion, imaginent que les décisions importantes, comme la fixation des effectifs par exemple, devraient être prises à 2000 km d'Alicante selon des procédures dont chacun connaît la lourdeur. Les contrôleurs

deviendraient aussi gestionnaires. Où seraient les responsabilités?

Le jacobinisme est toujours bien vivant malgré les discours officiels.

Il faut clairement choisir:

- ou bien l'OAMI deviendra une «start down» et il y aura une administration de plus à Alicante. Le client devra s'y faire, et peut-être le contribuable aussi...
- ou bien l'OAMI sera un grand office de propriété industrielle dont l'Union européenne pourra s'enorgueillir pour le bien être des entreprises clientes.

Le choix est entre les mains des Etats membres de l'Union. Je demeure confiant.

Jean-Claude COMBALDIEU

INSPECTION OF FILES

In the defence of earlier rights, third parties may be alerted – either through periodic searches in the Bulletin or OAMI on-line services or through a commercial agency providing similar search services or in some other way – to the existence of a conflicting CTM application or registration. Once alerted, the proprietor of the earlier right may often want more detailed information on the application or registration in question. To this end, he can make one of three requests to the Office:

- To inspect the file
- To obtain (either certified or uncertified) copies of certain documents in the file
- To receive a reply to a request for information

Prior to publication of a CTM application, only the applicant for that mark can inspect it, or a person who has that applicant's consent or who has adduced evidence that once registered, the proprietor will rely on it against him. After the CTM application has been published, anyone may inspect the files. However, certain documents are always withheld from inspection (e.g. those marked as

confidential), unless the person requesting inspection can show an overriding legitimate interest in obtaining them. In any event, the courts or authorities of the Member States always have an unfettered right of access.

Where inspection of files has been requested, the Office must examine the formal admissibility of the request (particularly the requirements as to payment and writing). The Office then estimates the number of pages in the file and contacts the person who requested the inspection, giving him an estimate of how many pages there are in the file. That person can then either choose to come and inspect these paper documents at the Office in Alicante (in which case the Office will give him an appointment time to do so), or request copies of certain documents or of the whole file. In both cases, payment must be made beforehand in order to validate the request. To facilitate matters, persons making these sort of requests will often have current accounts with the Office from which the sums owing can be debited.

If a person comes to the Office to inspect the file, it will cost € 30.

If uncertified or certified copies are then requested, the price will be € 10 or 30 respectively for up to 10 pages of copied materials and thereafter € 1 per page. The same restrictions as apply to inspection also apply to delivery of copies. In the near future, the Office will make on-line inspection possible for outsiders coming to the Office's new central seat in Alicante (again by prior appointment).

Requests for information cost € 10 per request and are subject to identical restrictions as the other requests. Examples of matters commonly dealt with include, whether a CTM application has been contested in opposition proceedings and the identity of the opponent(s). The reply of the Office is always given in writing by way of a formal letter.

The simplest way of making requests of the types mentioned will be by sending a fax to the Office (fax number: + 34 96 51 31 344). This fax, once received by the Office's central server, will be forwarded to the mail queue of the Register Service (Inspection Group) for further processing. ■

REISSUE OF CERTIFICATES OF REGISTRATION: PRACTICE OF THE OFFICE

WHAT HAPPENS WHEN THE CERTIFICATE CONTAINS AN ERROR?

WHAT HAPPENS IF THE ORIGINAL CERTIFICATE IS SENT BACK TO THE OFFICE FOR CORRECTION?

This article aims at answering these questions, frequently asked by users.

The Certificate of Registration (sent to applicants at the end of the registration procedure) reflects the contents of the Register of Community Trade Marks on the date it is issued. Occasionally,

users complain that the Certificate does not reflect the current position (e.g., ownership) of the CTM, and ask for a «corrected» Certificate. This gives us an opportunity to explain our practice: when does the Office issue a «corrected» Certificate of Registration?

A new Certificate is only produced

when the first one is erroneous. There is an error when the Register contains incorrect information which is reproduced in the Certificate. For example, the Office has duly recorded a transfer, but the Register and the Certificate show the previous ownership, as if no transfer had been recorded. ➔

STATISTICS (SITUATION AT THE BEGINNING OF APRIL 2000)

COMMUNITY TRADE MARK APPLICATIONS

BREAKDOWN BY COUNTRY

| | 1996-1999 | % | 2000 (31.03.00) | % | Total | % |
|-------------------------------------|----------------|--------------|-----------------|--------------|----------------|--------------|
| TOTAL WORLD | 143.062 | 100 | 13.711 | 100 | 156.773 | 100 |
| TOTAL EUROPEAN UNION | 87.715 | 61.31 | 8.383 | 61.14 | 96.098 | 61.30 |
| BELGIQUE/BELGIË [BE] | 2.197 | 1,54 | 180 | 1,31 | 2.377 | 1,52 |
| DANMARK [DK] | 2.326 | 1,63 | 228 | 1,66 | 2.554 | 1,63 |
| DEUTSCHLAND [DE] | 23.476 | 16,41 | 2.334 | 17,02 | 25.810 | 16,46 |
| ELLAS/GREECE [GR] | 339 | 0,24 | 35 | 0,26 | 374 | 0,24 |
| ESPAÑA [ES] | 8.836 | 6,18 | 881 | 6,43 | 9.717 | 6,20 |
| FRANCE [FR] | 8.367 | 5,85 | 775 | 5,65 | 9.142 | 5,83 |
| IRELAND [IE] | 1.224 | 0,86 | 104 | 0,76 | 1.328 | 0,85 |
| ITALIA [IT] | 9.922 | 6,94 | 901 | 6,57 | 10.823 | 6,90 |
| LUXEMBOURG [LU] | 624 | 0,44 | 88 | 0,64 | 712 | 0,45 |
| NEDERLAND [NL] | 3.848 | 2,69 | 366 | 2,67 | 4.214 | 2,69 |
| ÖSTERREICH [AT] | 2.223 | 1,55 | 194 | 1,41 | 2.417 | 1,54 |
| PORTUGAL [PT] | 850 | 0,59 | 103 | 0,75 | 953 | 0,61 |
| SUOMI/FINLAND [FI] | 1.357 | 0,95 | 118 | 0,86 | 1.475 | 0,94 |
| SVERIGE [SE] | 3.225 | 2,25 | 296 | 2,16 | 3.521 | 2,25 |
| UNITED KINGDOM [GB] | 18.901 | 13,21 | 1.780 | 12,98 | 20.681 | 13,19 |
| TOTAL OUTSIDE EUROPEAN UNION | 55.347 | 38.69 | 5.328 | 38.86 | 60.675 | 38,70 |
| Amongst which= | | | | | | |
| UNITED STATES OF AMERICA [US] | 39.044 | 27,29 | 3.433 | 25,04 | 42.477 | 27,09 |
| JAPAN [JP] | 3.861 | 2,70 | 304 | 2,22 | 4.165 | 2,66 |
| SWITZERLAND [CH] | 2.663 | 1,86 | 253 | 1,85 | 2.916 | 1,86 |
| CANADA [CA] | 1.725 | 1,21 | 169 | 1,23 | 1.894 | 1,21 |
| AUSTRALIA [AU] | 1.241 | 0,87 | 149 | 1,09 | 1.390 | 0,89 |
| TAIWAN [TW] | 899 | 0,63 | 76 | 0,55 | 975 | 0,62 |

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

| | 2000 (07.04.00) | 1996-1999 | Total |
|----------------------------------|-----------------|-----------|---------|
| Filing dates accorded | 14.828 | 132.780 | 147.608 |
| Number classifications checked | 12.112 | 126.970 | 139.082 |
| Applications published | 10.128 | 98.583 | 108.711 |
| Oppositions | 3.198 | 21.024 | 24.222 |
| Contested applications | 2.345 | 15.754 | 18.099 |
| Appeals | 316 | 1.132 | 1.448 |
| Registered Trade Marks | 9.827 | 59.147 | 68.974 |
| Published Registered Trade Marks | 8.258 | 55.513 | 63.771 |
| Requests for cancellation | 24 | 79 | 103 |

OTHER OHIM FIGURES

| | ON 10.04.00 |
|--|-------------|
| Number of professional representatives | 5.509 |
| Number of current accounts | 780 |
| OHIM Personnel | 517 |

This is a case where the Office will rectify the error in the Register, and issue a «corrected» Certificate. The correction will also be published in Part B.4.2 of the Bulletin of Community Trade Marks, dealing with errors made upon registration.

A different case is where the transfer of ownership has been filed before - but is ultimately recorded after - issuance of the Certificate. In this case, the Certificate cannot mention the «new» ownership, because it has not yet been recorded in the Register. This is an example where the Office will not issue a new Certificate: the first one, in fact, reflects the true content of the Register and therefore contains no mistake. What the Office will do is to record (after issuance of the Certificate) the transfer and, then,

issue a separate Notification of Recordal showing new ownership. The recordal will also be published under the relevant heading of Part C of the Bulletin, dealing with post-registration recordals.

The Office will supply copies of the Certificate or of the Notification of Recordal against payment of a small fee: 10 Euros if uncertified, 30 if certified. Another practical alternative is to ask for an Extract from the Register; this document will always reflect the current position of the CTM, and is available at the same prices.

Finally, users are requested never to send back the original Certificate of Registration; the general policy of the Office is not to return any document (whether original or not) filed at the OHIM.

This policy also applies to Certificates of Registration. Users should always keep the original and send photocopies to the Office.

The Office finally notes that users sometimes acknowledge receipt of the Certificate of Registration, by returning a photocopy thereof or otherwise. This is not necessary. ■

LEGAL QUESTION

UNTIL WHEN CAN A CTM APPLICATION BE VALIDLY WITHDRAWN?

The relevant provision is Article 44 (1) CTMR according to which «The applicant may at any time withdraw his Community trade mark application [...]». Thus, the Regulation gives the applicant the possibility of withdrawing his application whenever he so wishes on condition that the registration procedure is not closed, i.e. that he still has the status of «applicant». The registration procedure can be considered closed only when the applicant has no further means of seeking the refusal of his application to be reversed, namely when the effects of the decision become definitive and, consequently, the decision itself becomes final. This can happen in two hypotheses:

- the decision of refusal is subsequently confirmed by all the appeal instances provided by the CTMR;

- the two months time limit to lodge an appeal elapses and no appeal is filed.

In both cases, the effects produced by the decision of refusal from the very moment in which it was taken, cease to be «provisional» and become «final». Insofar as the decision of refusal cannot be in any way reversed any more, the registration procedure can be said to be closed and, therefore, the applicant irremediably loses his status.

To conclude, after a formal refusal of registration has been issued, the Office will still accept an applicant's declaration of withdrawal. This will occur if the declaration is filed before the decision of refusal has become final, i.e. either before the two months limit to appeal the refusal has elapsed or where an appeal has been filed against the refusal. ■

USEFUL NUMBERS

- Switchboard telephone number: + 34-965 139 100
- General inquiries telephone numbers: + 34-965 139 243; + 34-965 139 272.
- General inquiries fax number: + 34-965 139 173
- The Office's Internet site: oami.eu.int
Requests for literature (leaflets, standard forms, official texts, places where to buy 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 urged to use exclusively the above fax number where faxes arrive at an automatic fax server which does not involve any printing and physical handling of documents, for all communications relating to proceedings before the Office. This will facilitate and accelerate the handling of incoming faxes, whereas the sending of such communications to other fax numbers in the Office will require additional operations and creates substantial administrative burdens.
- Telephone number for obtaining information concerning means of payment: + 34-965 139 340
Opening of current accounts, bank transfers, payments by cheques, etc.
- Telephone number for obtaining information about professional representatives: 34-965 139 117
List of professional representatives, new entries, allocation of ID numbers, authorisations, etc.
- Obtaining information in relation to copies from the file and extracts from the register: + 34-965 139 633
- Obtaining information in relation to transfers, licences, conversions: + 34-965 139 515 and + 34-965 139 175
- Telephone number for obtaining information concerning from the files or from the Register: + 34-965 139 175
- Telephone number for obtaining information concerning subscriptions to our publications: + 34-965 139 102
OHIM's Official Journal, the Bulletin of CTMS (paper and CD-ROM), EUROM, etc.