



■ *El vínculo entre el sistema internacional y el sistema comunitario de marcas*

Una decisión histórica acaba de ser adoptada: La marca comunitaria se vinculará en un futuro próximo con el sistema de registro internacional de marcas. En efecto, el 19 de septiembre el COREPER ha dado luz verde a la propuesta de Decisión del Consejo posibilitando la adhesión de la CE al Protocolo de Madrid y a la propuesta de modificación del RMC que permitirá que el vínculo entre la marca comunitaria y la marca internacional sea operativo. Asimismo, el 25 de septiembre la Asamblea de la Unión de Madrid ha adoptado un conjunto de medidas que va a impulsar el Sistema de Madrid y permitir su vínculo en la marca comunitaria. Estas medidas que entrarán en vigor el 1 de abril de 2004 fueron, fundamentalmente, la modificación de ciertas reglas del Sistema de Madrid y la inclusión del idioma español como tercer idioma dentro del Protocolo. (doc OMPI MM/A/35/1)

El vínculo entre ambos sistemas era el destino anunciado desde la creación de la marca comunitaria y la adopción del Protocolo de Madrid. El sistema comunitario de marcas ha nacido para coordinarse con otros sistemas que juegan o pueden jugar un papel complementario. Este es el caso del sistema de registro internacional. La posibilidad de este vínculo se recogía en el propio Protocolo al establecer que podrán adherirse al mismo las organizaciones intergubernamentales que tengan una oficina regional para el registro de marcas que surtan efecto en el territorio de dicha organización.

Las razones en favor del vínculo son de distinta naturaleza y alcance. Con carácter general y en primer lugar, el vínculo ofrecerá más alternativas a la industria para proteger sus marcas en Europa. En segundo lugar, el vínculo permitirá la complementariedad entre dos mecanismos supranacionales que tienen vocación para ello. En tercer lugar, y, como consecuencia de ese vínculo, la protección de las marcas en la Unión Europea a través de la marca comunitaria saldrá favorecida y potenciada. El importe de las tasas a pagar por una marca comunitaria que siga la vía de Madrid será inferior a las tasas a pagar por los solicitantes que sigan la vía directa, al repercutirse en las mismas los ahorros que se derivan del examen realizado por la

OMPI. Asimismo se confía en acortar el tiempo que la Oficina necesita para otorgar la protección solicitada.

Un nuevo factor subraya la conveniencia del vínculo. EE.UU. será parte del sistema de Madrid a partir del 2 de noviembre del presente año, y no podemos olvidar que las marcas de origen norteamericano representan más del 25% del total de las solicitudes de marca comunitaria.

Las decisiones y las normas ya adoptadas serán completadas por otras decisiones y disposiciones del Consejo y de la Comisión. Así, el Consejo adoptará formalmente los acuerdos del COREPER. La Comisión adoptará un Reglamento que modifique el Reglamento de Ejecución sobre la Marca Comunitaria para prever y reglar la nueva vía de protección. Se introducirán también ciertos cambios menores en el Reglamento sobre las tasas. La preparación y adopción de estas modificaciones a los textos antes indicados, así como la necesidad de que transcurra un plazo de tres meses entre el depósito del instrumento de adhesión de la CE y la entrada en vigor del vínculo, ha llevado a la Comisión a considerar la fecha del 1 de octubre de 2004 como el momento en que probablemente se podrá solicitar de manera efectiva una marca comunitaria a través de la solicitud de marcas internacionales. Y viceversa, sería a partir de ese momento cuando una marca comunitaria o su solicitud podrán servir de base para una solicitud internacional.

La OAMI no ha permanecido ajena a todos estos trabajos y negociaciones. Antes al contrario, de un lado ha colaborado con la Comisión y con la OMPI en la preparación de los documentos ahora adoptados. Y continuará haciéndolo en el futuro. Por otro lado, ha creado un Grupo de Trabajo con el objeto de definir las medidas internas a adoptar, impulsarlas y coordinar los trabajos de los distintos Departamentos. La actividad de este Grupo comprende tanto los aspectos institucionales como los internos. Y dentro de este último sector abarca los distintos ámbitos - jurídico, financiero, técnico y organizativo - en los que incidirá el vínculo en su actividad interna.

OAMI

OFICINA DE
ARMONIZACIÓN 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
L'HARMONISATION
DANS LE MARCHÉ
INTÉRIEUR
(MARQUES, DESSINS
ET MODÈLES)

UAMI

UFFICIO PER
L'ARMONIZZAZIONE
NEL MERCATO INTERNO
(MARCHI, DISEGNI
E MODELLI)

NEW TYPES OF TRADEMARKS

In the past, so-called new types of trade marks (colours, sounds, shapes, smells) have been a challenge to IP offices and the Courts, and the OHIM has been no exception.

From OHIM's perspective, for all categories of so-called new types of marks, two issues must clearly be separated:

- does the type of mark fall under the category of signs which may constitute a CTM and is it capable of being represented graphically (Article 4 CTMR)?
- is the mark distinctive, either inherently or by virtue of the use made of it?

As Article 4 CTMR does not exclude any type of sign as long as it can be represented graphically, the answer to the first question will normally be "yes". However, this is of no assistance in answering the second question: the distinctiveness of a mark must always be assessed taking into account the specific circumstances of the case and looking at the goods and services for which registration is sought.

Colours per se

The Office continues to apply the following practice:

Marks containing or consisting of colours or colour combinations, including colours per se, comply with Article 4 and Article 7 (1) (a) CTMR, provided that a graphic representation showing the colour(s) is filed.

However, the Office will in general consider marks which consist exclusively of one or two basic colours as devoid of distinctive character.

In a recent ruling the Court of Justice has dealt with the question whether a colour per se can be a trade mark (ruling of the ECJ in case C-104/01 of 6 May 2003, "Libertel").

This ruling was a result of a reference to the Court under Article 234 EC by the Hoge Raad der Nederlanden (Netherlands) for a preliminary ruling in the proceedings pending before that

court concerning a Benelux trade mark application for the colour "orange", on the interpretation of Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

Two significant issues for the Office and users of the CTM system arise from the ruling. Firstly, the Court has confirmed the approach that the Office has taken to distinctiveness of colour marks per se. It also dealt with the question of graphic representation of colour marks.

This latter aspect has given rise to concerns on the part of some clients of the Office. This concern arises, principally, from the Court's statement that "A mere sample of a colour does not, however, satisfy the requirements .." of graphic representation which ".. must be clear, precise, self-contained, easily accessible, intelligible, durable and objective." The Court went on to suggest how this problem might be addressed by for example "... a verbal description of a colour..." or "... by adding a colour designation from an internationally recognised identification code."

The Office notes that the Court, in addressing this point, referred to the problem of the deterioration of a colour over time, in particular by reference to colour reproduced on paper. The Court acknowledged that on certain media it is possible to reproduce a colour in permanent form.

In accordance with Rule 84(1) of the Implementing Regulation the Register of Community Trade Marks is, in practice, kept in electronic form. The representations of all trade marks, except word marks, are scanned and stored electronically. The question of durability addressed by the Court does not, therefore, arise in respect of Community trade marks.

Nevertheless, the Office would recommend that where registration in colour is applied for the indication of the colour required under Rule 3 (5) should where possible include a designation from an internationally recognised

identification code. The Office will accept such designations to be made also after the filing of the CTM application in the form of an amendment of the CTM application or registration.

Sound marks

The Office accepts musical notations as an appropriate graphic representation of a sound mark. The same is not true for complex frequency oscillograms, which the Office does not consider clear and precise enough. The examination of distinctiveness of sound marks has not yet given rise to specific problems.

Smell marks

The question whether and under what conditions smells may be registered as trademarks was answered by the Court of Justice in its landmark ruling in case C-273/00 of 12 December 2002, "Sieckmann". The Court underlined that in order to secure a functioning registration system for trademarks, a graphic representation of a mark must be self-contained, easily accessible, intelligible, durable, unambiguous and objective. The Court then analysed all the various methods of graphically representing smells which are presently available or had been offered to the Court, namely a chemical formula, a verbal description, through deposit of a sample of the smell, or a combination of these methods, but it rejected all of them. In other words, there is presently no possibility of graphically representing a smell in a way which fulfils the criteria laid down by the Court of Justice.

This clearly closes the door for the registration of smells as Community trade marks. In the past, some uncertainty has arisen from the fact that whereas the Examination Division of the Office consistently refused smell marks, two individual decisions of the Boards of Appeal (in the cases "fresh cut grass" and "the smell of raspberry applied to fuel") have accepted smell marks at least for the purposes of Article 4 CTMR. Now, following the Court's judgement, the position is clear.

NICE CLASSIFICATION

Classification is more than an administrative tool used to determine the level of the fees paid by the applicant.

According to the Community trade mark Regulation, the classification of goods and services may be seen as merely an administrative tool for the Registry to conduct an efficient search system. However, in practice it is far more than that. If the applicant does not select an accurate list of goods and services, and if the examination by the Office is carried

out incorrectly, the validity of the right may be called into question and the mark revoked. Classification determines the scope of protection of a trade mark when an infringement action is brought, on the basis of the speciality principle.

Therefore, classification must be as accurate as possible.

The "International Classification of Goods and Services for the purposes of the

Registration of Marks" was established by an Agreement concluded at the Diplomatic Conference held in Nice (France) in 1957, and is commonly referred to as the "Nice Classification". It is administered by the World Intellectual Property Organization (WIPO) in Geneva and has undergone several revisions since 1957. The Eighth Edition came into force on 1st January 2002.

Whilst the European Union is not a party to the Nice Agreement (only the Member States

STATISTICS (SITUATION UNTIL THE END OF AUGUST 2003)

COMMUNITY TRADE MARK APPLICATIONS

BREAKDOWN BY COUNTRY

	1996 - 2002	%	2003 (31.08)	%	Total	%
TOTAL WORLD	294.625	100	32.880	100	327.505	100
	1996 - 2002	%	2003 (31.08)	%	Total	%
TOTAL EUROPEAN UNION	183.509	62,29	21.626	65,77	205.135	62,64
BELGIQUE/BELGIË [BE]	4.253	1,44	498	1,51	4.751	1,45
DANMARK [DK]	4.642	1,58	486	1,48	5.128	1,57
DEUTSCHLAND [DE]	48.667	16,52	5.348	16,27	54.015	16,49
ELLAS/GREECE [GR]	845	0,29	160	0,49	1.005	0,31
ESPAÑA [ES]	19.438	6,60	2.902	8,83	22.340	6,82
FRANCE [FR]	18.355	6,23	2.326	7,07	20.681	6,31
IRELAND [IE]	2.773	0,94	277	0,84	3.050	0,93
ITALIA [IT]	21.432	7,27	2.761	8,40	24.193	7,39
LUXEMBOURG [LU]	1.485	0,50	160	0,49	1.645	0,50
NEDERLAND [NL]	7.641	2,59	1.090	3,32	8.731	2,67
ÖSTERREICH [AT]	4.417	1,50	476	1,45	4.893	1,49
PORTUGAL [PT]	1.921	0,65	266	0,81	2.187	0,67
SUOMI/FINLAND [FI]	2.785	0,95	267	0,81	3.052	0,93
SVERIGE [SE]	6.331	2,15	575	1,75	6.906	2,11
UNITED KINGDOM [GB]	38.524	13,08	4.034	12,27	42.558	12,99
	1996 - 2002	%	2003 (31.08)	%	Total	%
TOTAL OUTSIDE EUROPEAN UNION	111.116	37,71	11.254	34,23	122.370	37,36
Amongst which						
UNITED STATES OF AMERICA [US]	74.457	25,27	6.306	19,18	80.763	24,66
JAPAN [JP]	8.535	2,90	943	2,87	9.478	2,89
SWITZERLAND [CH]	5.982	2,03	852	2,59	6.834	2,09
CANADA [CA]	3.889	1,32	371	1,13	4.260	1,30
AUSTRALIA [AU]	2.646	0,90	230	0,70	2.876	0,88
TAIWAN [TW]	1.994	0,68	308	0,94	2.302	0,70

OTHER STATISTICS RELATING TO COMMUNITY TRADE MARKS

	1996 - 2002	2003 (31.08)	Total
Filing dates accorded	282.245	28.428	310.673
Number classifications checked	263.781	30.821	294.602
Applications published	230.106	27.359	257.465
Oppositions received	56.814	7.164	63.978
Contested applications	41.788	5.242	47.030
Appeals received	4.430	522	4.952
Registered Trade Marks	168.190	22.973	191.163
Published Registered Trade Marks	166.088	22.400	188.488
Requests for cancellation	520	166	686

OTHER OHIM FIGURES

Number of professional representatives	7.161
Number of current accounts	992
OHIM Personnel	647

are able to sign), the OHIM does utilise the international classification system and consults WIPO when necessary regarding interpretation or when matters arise that are not covered by the listings. The OHIM also attends the "Committee of Experts", in an observer status, where changes or clarification to the listings are discussed and debated.

When examining a specification of goods and services, the OHIM has to ensure a certain level of consistency between all applications received. To ensure that different examiners achieve the same result when considering the same specification, the OHIM is currently developing two new tools to harmonise the examination of specifications.

The first one is called EUROACE, which is currently being tested. It is an internal database based on EUROMARC where examiners will be able to find identical or similar classifications already accepted by OHIM. Once it is established that this tool has been used successfully internally, the Office's intention is to make it available to the public in 2004 in connection with the e-filing system. Therefore, the Office will be able to automatically accept the applicant's specification without having to carry out any further examination. This will imply saving time, to the advantage of both applicants and the Office.

The second tool is more ambitious. For the last two years, in cooperation with the

Japanese and the US Patents and Trade Marks Offices, the OHIM has been developing a TRILATERAL DATABASE ON CLASSIFICATION. Based on the Nice Classification, the purpose is to obtain as far as possible a significant level of "harmonisation" of practices.

Establishing this database is carried out by an exchange of lists of classes accepted by these Offices according to their own practice. The aim is to determine the minimum common standard accepted by these three Offices. Examiners of these Offices will benefit from a more practical and comprehensive database where the content, if used by applicants, will be automatically accepted.

Furthermore, this database will be a very important gain in view of the Madrid Protocol after the EU accession. The OHIM is considering the possibility of using it on-line with the e-filing system.

Two annual meetings have already been held, one in Alicante in 2002 and one in Tokyo in June 2003. Two classes have been or are almost finalised, classes 35 and 25. The next ones to be treated will be classes 9 and 38.

With this tool, OHIM shows its interest in all means of speeding up the registration procedure, harmonising practice and, more importantly, making the procedure transparent and efficient for its clients.

USEFUL NUMBERS

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General inquiries telephone number:
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General inquiries fax number:
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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.

Telephone number for obtaining information concerning means of payment (opening of current accounts, bank transfers, payments by cheques, etc.):
+ 34-965 139 340

Telephone number for obtaining information about professional representatives (list of professional representatives, new entries, allocation of ID numbers, authorisations, etc.):
+ 34-965 139 379

Obtaining information in relation to copies from the file and extracts from the register:
+ 34-965 139 198

Obtaining information in relation to transfers, licences, conversions:
+ 34-965 139 175

Telephone number for obtaining information concerning subscriptions to our publications [OHIM Official Journal, CTM Bulletin (paper and CD-ROM), EUROM, etc.]:
+ 34-965 139 102

4 ARE WITHDRAWALS POSSIBLE AFTER A DECISION HAS BEEN TAKEN?

The following cases are not infrequent:

- The Office refuses a CTM application because the mark is not distinctive. The decision is notified to the CTM applicant, who does not file an appeal but, a few days before expiry of the appeal period, informs the Office that he wants to withdraw the CTM application.
- An opposition is rejected by the Office as unfounded and the opponent shortly before expiry of the appeal period, informs the Office that he withdraws the opposition.

What happens in these cases, what is the legal effect of such a withdrawal?

In the first case, it should be clear that the trade mark has been refused; that means that also for the purposes of conversion, the CTM application must be considered as refused rather than withdrawn (see Article 108(2)(b), (4) CTMR). In the second case, again, the decision of the Office on the opposition does not become undone by the declaration of the

withdrawal, and the winning party should be able to enforce the decision in particular to recover the costs which has been awarded to him. To sum up, when a withdrawal of an application or opposition is declared after a decision has already been taken by the Office but no appeal has been filed, such withdrawal has, simply speaking, no legal significance at all.

The Office has therefore now changed its practice and will from now on in these cases inform the declarant that the declaration of withdrawal is not possible. The previous practice described in OAMI News 2/2000, according to which the Office "accepted" such withdrawals, is no longer followed.

The situation is different if the CTM applicant or opponent files an appeal, because the appeal has suspensive effect (Article 57(1)CTMR). This means that the CTM application or opposition remains pending before the Boards of Appeal and, hence, any restriction or withdrawal may still be declared during the appeal procedure.