



**11th Meeting of the OAMI Users' Group  
Alicante, Spain  
29 November 2004**

The 11th meeting of the OAMI Users' Group was held on 29 November 2004 in Alicante, Spain with representatives from a number of NGO's, including AIPPI.

This unofficial report has been prepared to provide the members of AIPPI with information of the meeting as soon as possible. To facilitate the reading of the report, and particularly to compare with the official minutes to follow, the report is structured in accordance with the official agenda.

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

**2. Adoption of the agenda**

AIPPI suggested refocusing the meeting in the future by submitting a written report on the activities of the Office (item 4.-7 of the agenda) to the participants prior to the meeting. During the meeting there should still be a possibility of the Office to highlight important issues, and for the participants to raise questions and comments relating to the report, but the meetings should be focused on discussion of the substantive issues (item 8.-10. of the agenda).

**3. Adoption of the minutes of the 10<sup>th</sup> meeting**

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

By its decision of 9 November 2004 in case T-116/03 Montalto vs. Council the CFI has annulled the Council's decision to nominate the President of the Boards of Appeal. The Office informed that it is awaiting the official communication of the decision and the instructions of the Council, and therefore is not in a position to comment further for the time being.

**a) Filing figures**

Regarding the impact of enlargement, the number of applications from the new member states has not increased substantially in absolute figures, but in relative figures. Applicants from the new member states and candidate countries (RO, BG and TR) have in 2004 filed 1162 applications as

compared to 2003 where applicants from the same countries filed 570 applications. The overall picture is the same regarding oppositions, where owners from the new member states and candidate countries in 2004 filed 47 oppositions as compared to 2003 where owners from the same countries filed 18 oppositions.

Regarding the impact of the Madrid Protocol, the Office received in October 2004 187 Madrid Protocol applications based on a CTM, and expects to receive approx. 1,500 applications per year.

So far the Office has received only 4 Madrid Protocol registrations designating the EC but is aware that another approx 300 Madrid Protocol applications are under examination at the WIPO. The applicants designating the EC are primarily from USA, Switzerland and Australia.

b) Production figures

The Office informed that it has eliminated the backlog on classification and reached a normal workload, and that it is close to eliminate the backlog on examination and thus to reach a normal workload. On oppositions the Office will meet and exceed its target for the year 2004, and is thus continuing the positive development, but the situation is still unsatisfactory.

**5. Users' satisfaction measurement**

The Office has completed a pilot users' satisfaction survey, on the basis of the result of which the Management Committee of the Office has identified the following areas for improvement:

- Speed
- Predictability/decision consistency
- Availability of the staff to the user
- Dealing with complaints

To address these issues the Office will immediately make available on its website the names and telephone numbers of the examiners, and has established a Customer Care Unit to deal with complaints, see item 6 below. Further the Office will within a few weeks publish on its website a presentation of its quality measures together with monthly updated pendency times. The Office urged the NGO's to submit their comments on these measures.

Based on the experiences from the pilot survey a full scale users' survey involving approx. 800 CTM as well as RCD users will run in the spring of 2005.

## **6. Customer Care Unit**

Based on a decision of the President, the Office has on 29 November 2004 established a Customer Care Unit (CCU) with the purpose of centralizing the dealing with complaints, increase customer loyalty, control quality and improve the image of the Office. The CCU can be reached i.a. at [customercareunit@oami.eu.int](mailto:customercareunit@oami.eu.int).

## **7. E-business Initiative**

Recently the CTM Online has been improved, and on 7 December 2004 the Office expects to introduce also an improved CTM e-filing system.

The improved CTM e-filing system will immediately provide the applicant or his/her representative with the final filing number (and not as presently with a provisional number) and a confirmation of receipt on the day of filing. Further it will be linked to EuroAce, which contains approved terms for the designation of goods and services.

EuroAce will be accessible also independent from the e-filing system, and is expected to become a valuable tool in connection with the drafting of list of goods and services. EuroAce also contains the so-called "trilateral terms", which are the terms for designating goods and services which have been approved by the Office, the USPTO and/or the JPO. Each of the terms contained in EuroAce are identified as being Nice terms, trilateral terms or Office terms.

At the same time as the improved e-filing system, the Office will introduce a My Page-facility where each user of the system will have a password secured site, which will allow to exchange communications with the Office through an own mailbox and to save information online.

Effective from January 2005 the Office expects to make the search reports available online through the My Page-facility.

Further the Office informed about the following mid term e-business initiatives:

- **RCD Online** is expected to be available from Summer 2005 with a search facility and online access to non-confidential information in RCD files,

- **CTM files** are expected to be accessible online (with certain exceptions, including with the exception of certain information) from mid 2005, including with an online form for applying for file inspection,
- **E-opposition and My Calendar** are expected to be available from mid 2005 with a possibility to file oppositions online, and create an overview of all deadlines of an owner or representative with the Office.

And of the following long terms e-business initiatives:

- **E-payment** (online payment, i.e. with credit card)
- **E-person** (access to search facilities on owners and representatives, and to update own data online)
- **RCD e-filing improvements** (parallel to the improvement of the CTM e-filing)
- **E-renewal** (e-filing and payment of individual and batch renewals)

Regarding B2B, the Office informed that a supplier has developed a tool which will enable their IP management system to direct e-filing with the Office, and that the Office has invited other suppliers of IP management systems to develop similar tools.

## **8. The Community Trademark**

### a) Update by the Office

The highlights in the development of the CTM-system since the last OAMI Users' Group meeting have been the enlargement, the accession of the EC to the Madrid Protocol and the CTMR-reform.

### b) Madrid Protocol

According to the guidelines (item 13.C.6.5), the registration fee will be refunded only in case the designation of the EC is refused by provisional refusal of the Office becoming final.

The Office informed that the guidelines will be amended, so that the registration fee will be refunded irrespective of the circumstances under which the designation of the EC is lost, including if renounced by the owner.

### c) Opposition proceedings

Regarding the cooling-off period, the Commission wishes an absolute limit of 24 months to secure legal certainty. The Office supported the Commission and referred to the fact that the parties may

request that the opposition proceedings are stayed, whereas the NGOs generally support to retain the present regime without an absolute limit on the cooling-off period.

Regarding the opponents filing of evidence of use, the NGO argued in favor of a possibility for the Office to make an interim decision on the evidence of use. The Office referred to the fact that the present proposal for amendment of the CTMIR includes a mechanism that dealt with the issues. The Commission has so far no opinion on the subject. INTA urged that the opponent be required not only to file evidence of use, but also to translate such evidence into the language of the proceedings and to substantiate what is considered proved by the evidence filed.

d) Conversion of CTM's

The Office has changed its policy on how to decide on the admissibility of applications for conversion. The new policy does not affect the substantive requirements on when an application for conversion is admissible.

AIM stated that the Office on certain occasions have included other circumstances in its decision on the admissibility of the application for conversion than has been included in the decision of the Office refusing or canceling the CTM, and thus without giving the applicant or owner the possibility to file observations thereon.

e) Priority and seniority documents

Before the end of 2004 the President expects to issue a decision dispensing from the requirement to file priority and seniority documents if the relevant information is available from public sources on-line.

The Office will not publish a list of approved sources, but expect the applicants to cooperate by indicating a source from which the relevant information is available. The examiner will not download or print the information from the source, but make a note on the file that he/she has consulted the relevant source to confirm the priority or seniority claim. The examiner may at his or her discretion request that the applicant file priority or seniority documents in paper form as before.

f) Case law of the ECJ and CFI affecting the practice of the Office

Following the ECJ-decision of 24 June 2004 in case C-49/02 (Heidelberger Bauchemie-case) the Office will not register color-combinations on the basis of an abstract description, but examine the applications on the basis of the representation as filed.

The Office is considering issuing a practice note as after the Libertel-case, which also will consider how to deal with color-combination marks already registered to avoid cancellation following the above decision.

In its decision of 21 October 2004 in case C-447/02 P (KWS-case) the ECJ found that the BoA had violated Art. 73 CTMR by in its decision referring to facts which have not been made available to the application and thus without giving the application the possibility to file its observations thereon, but upheld the decision as the facts which had been made available to the applicant were sufficient to reach the decision.

The Office confirmed that it is obviously its intention to respect Art. 73 CTMR, and that it will be more careful in the future, in particularly to avoid a broad interpretation of the KWS-case and thus retain a certain flexibility, which i.a. will allow the examiner to look up in a (another) dictionary to confirm facts already made available to the applicant.

## **9. The Community Design**

The NGO's stressed the importance of the launch of the RCD Online (see item 7 above) with search facilities which enables trademark owners to search for device marks as an increasing number of device marks are filed as RCD's.

To meet this requirement the Office informed that it is the process of classifying the designs which may be considered device marks according to the Vienna classification, including coordinating this classification with that of CTM Online. When completed, this classification, should make it possible to make an availability search of a device mark in CTM Online as well as in RCD Online using the Vienna classification.

The My Page-facility will not in the short term be linked to RCD Online.

## **10. Legislative issues: State of Play**

### **a) CTMIR**

Regarding the proposal for amendment of the CTMIR, the Commission informed that it is presently being discussed in the Commission of Trademarks and Designs, and that meetings have been scheduled with 4-6 weeks intervals.

b) Rules of procedure of the Boards of Appeal

A proposal for amendment of the regulation laying down the rules of procedure of the Board of Appeal (12 July 2004, COM(2004)) has been prepared and was presented to the participants.

c) Fees

Given its present and expected financial results, the Office has presented a proposal for a fee reduction to its Budget Committee. It is foreseen that application, registration and renewal fees will be reduced whereas opposition, cancellation and appeal fees will be increased – the latter however only to a certain extent. Further it is considered to introduce an e-business incentive.

The Commission generally supports a fee reduction but it remains an open questions, which fees will be reduced and how much. The Commission will receive and take into consideration observations on the fee reductions, but informed that it is going to present its proposal with a reasonable time.

The Commission provided an update on the following legislative initiatives:

Regarding regulation 2004/48 EC on the enforcement of intellectual property rights, the Commission expects shortly to publish a statement on the interpretation of Art. 2 to confirm that all intellectual property rights are covered by the regulation, and will follow up closely on the formal as well as substantive implementation of the regulation towards the member states.

On the consultation on the accession of the EC to the Geneva Act of the Hague Convention the Commission reported that almost everyone participating in the survey have been in support of the accession, and the Commission will now prepare the necessary draft legislation to be presented in the second half of 2005.

In accordance with Art. 225A of the Treaty of Nice, the Commission expects to establish a Community Trademark and Design Court as attached to the CFI, which in the future will be renamed to the High Court.

The Community Trademark and Design Court will hear matters on appeal from the BoA but (so far) not inter partes matters. Its decisions will be subject to appeal to the High Court and under extraordinary circumstances to the ECJ (on review). The change is not going to affect the BoA.

## **11. Micellaneous**

An e-newsletters has been introduced by the Office, who asked the NGO's to submit their suggestions for improvements to enhance the value of the newsletter as a source of information to the users of the Office.

Copenhagen, 1 December 2004

Martin Sick Nielsen