

Brussels, 9 September 2013

Revision of OHIM Guidelines – ECTA Comments

ECTA reviewed the New draft Guidelines and it congratulates OHIM for such an effort. Indeed, ECTA finds it a very useful instrument that all practitioners ought to consult because it strives to be as complete as possible also by including references to examples and relevant case law.

ECTA also appreciates that OHIM wishes to translate the new Guidelines into all EU languages and agrees that the unification in only one document of the Guidelines and the Manual is a welcome initiative.

Nonetheless ECTA, which shall offer some detailed comments down below, finds and regrets that the stakeholders were given such short period of time to analyse so important document. Therefore ECTA hopes that at further stage, all new changes will be clearly indicated in the next cyclical revisions, so as to allow an easier issue spotting and relative analysis, and also hopes that OHIM will provide users with the possibility to download a single unitary copy of the new Guidelines rather than having through the process of having to download single files which may not be entirely identifiable especially when various versions will begin to add up.

In conclusion, ECTA welcomes the New Guidelines although cautions OHIM not to forget that examiners, opposition/cancellation divisions and all the other departments at the Office should only be bound by the Guidelines to the extent that these foresee a situation in which the circumstances are identical to the case at hand and there is no contrary case law which has been laid out by the Court of Justice in the meanwhile (see case C 149/11, Leno Merken BV v Hagelkruis Beheer BV: “*Second, it is to be noted that the OHIM Guidelines are not binding legal acts for the purpose of interpreting provisions of European Union law*” at 48).

ECTA looks forward working closely with OHIM in the next cycles where it is confident to be able to offer its constant contribution toward an always better and improved set of rules which may render the CTM system always more in line with the expectations of its users so as to increase its competitiveness, attractiveness, functionality and in the end offer a valuable instrument to companies which want to fully exploit the opportunities of the internal market.



European Communities Trade Mark Association

User Association/National Office	ECTA – European Communities Trade Mark Association
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Contributor (name & position)	
Linguistic version the comments refer to	<input checked="" type="checkbox"/> EN <input type="checkbox"/> DE <input type="checkbox"/> ES <input type="checkbox"/> FR <input type="checkbox"/> IT
Part/Section/Chapter of the Guidelines the comment(s) refer to	Part A General Rules, Section 3 , Payment of fees, costs and charges
Page of the document	page 6
Issue(s) you wish to comment on	<p><u>Payment by credit cards</u></p> <p>Comment: Payment by credit card - as a commonly used method of payment in other businesses – should be available to all OHIM fees and not to only two types of them. Payment by credit card is immediate and thus in urgent cases would be very helpful for the users to have this opportunity.</p>
Suggestion for text	ECTA recommends further discussions.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part A General Rules , Section 3, Payment of fees, costs and charges
Page of the document	Page 13
Issue(s) you wish to comment on	<p>Refund of fees – renewal will not be refunded if the holder has instructed the Office to debit a current account at the time of requesting renewal, and then later partially (in relation to some classes) or totally withdraws their instruction to renew, the already debited renewal fee will not be refunded.</p>
Suggestion for text	<p>There is no rational for not refunding the renewal fees in case of partial or, even more, total withdrawal of the renewal instructions provided that “correcting” instructions are filed within the time limit for renewal of a trade mark.</p> <p>Proposed new wording:</p> <p><i>Where the holder has instructed the Office to debit a current account at the time of requesting renewal, and then later partially (in relation to some classes) or totally withdraws their instruction to renew, the renewal fee will be funded provided that the subsequent instructions concerning partial renewal or withdrawal of a CTM is filed before expiration of the time limit for renewal before expiration of the ordinary time limit for renewal of a trade mark.</i></p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part A, section 5 (professional representation) Annex 1
Page of the document	Page 24
Issue(s) you wish to comment on	Annex with the different national terms for professional representation – Belgium: “Falls under the Benelux law (Article 50)”
Suggestion for text	<i>“Falls under the Benelux Treaty for Intellectual Property (Article 4.1)”</i>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part A, section 5 (professional representation) Annex 1
Page of the document	Page 30
Issue(s) you wish to comment on	Annex with the different national terms for professional representation – Luxembourg: “Falls under the Benelux law (Article 50)” Annex with the different national terms for professional representation – the Netherlands is missing
Suggestion for text	<i>“The Netherlands: Advocaat – Lawyers are fully entitled, but a person cannot be a lawyer and a professional representative at the same time – Merkengemachtigde - Falls under the Benelux Treaty for Intellectual Property (Article 4.1). Any person having an address in Benelux territory may represent clients in IP matters. The entitlement is not conditional upon the need for special professional qualifications; person’s applying to be entered on the list must have regularly acted as professional representatives for at least five years before a central industrial property office of a Member State.”</i>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B, Examination section 2
Page of the document	Page 48
Issue(s) you wish to comment on	Further examples with regard to word marks: “ <i>POPEYE – POPEYE – not the same</i> ”.
Suggestion for text	Should be: “ <i>the same</i> ”.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B Examination , Section 4 , Absolute Grounds for Refusal
Page of the document	Page 5
Issue(s) you wish to comment on	<p>1.3 European criteria -arguable: reference to “language understood in at least a part of the European Union” not necessarily an official language.</p>
Suggestion for text	<p>The proposed wording of point 1.3 creates a situation of uncertainty and unpredictability of results. The wording of the point 1.3 should indicate in more detail criteria regarding relevant “part of the EU” such as:</p> <ul style="list-style-type: none"> - territorial scope and/or - population using a given language - should be understood to constitute sufficient basis for refusal of a CTM. <p>As a Guideline, AIPPI Resolution Q 135 “ Protection of terms in foreign languages as marks” could be used. We suggest the following wording: “That means that it suffices for a refusal if the trade mark is descriptive, or lacks distinctive character in a language understood for a significant section of the relevant public, in at least a part of the European Union.</p>

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B/Section 4/Chapter 1.2
Page of the document	Page 4
Issue(s) you wish to comment on	Specification of goods by restricting by certain condition on characteristics of goods
Suggestion for text	Although such use of specification allows indicating the goods clearly - however since it has been forbidden by the Court the examples on how specification should be made in such cases should be provided.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B/Section 4/Chapter 2.3.1.2.
Page of the document	Page 5
Issue(s) you wish to comment on	Evaluation of the meaning of the word
Suggestion for text	Evaluation of the meaning of the word has been extended, in a language understood" - however uncertainty has been created with the "at least a part of the European Community". It means that it is not required that the particular language should be a language of the European Community - it is only sufficient that it is understood - which means that the level of evaluation criterion is raised very high. So the wording used in Manual ("one of the languages of the EU" should be left).
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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part B/Section 4/Chapter 1.6
Page of the document	Page 7
Issue(s) you wish to comment on	„re-open ex officio (...)”
Suggestion for text	It is unclear in which cases the examination might be opened as it creates uncertainty for the holders of the trade marks whether the trade mark registered will not be re-examined at later stage. The same should be noted regarding the new case-law: it is not acceptable to set a risk for the trade mark that its registration might be cancelled considering later changes in case-law. The following text is suggested: “It suffices that the term is meant to be used, or could be understood by a significant section of the relevant public, in at least a part of the EU, as a description of the claimed goods or services.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part C, section 0
Page of the document	Page 7
Issue(s) you wish to comment on	“Earlier rights” – “entirely successful”
Suggestion for text	It would be better if all the invoked earlier rights will be identified in the decision instead of only the relevant earlier right.

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Part/Section/Chapter of the Guidelines the comment(s) refer to	Part C, section 2, chapter 2.1
Page of the document	Page 5-9
Issue(s) you wish to comment on	Examination of distinctiveness: general issues
Suggestion for text	Almost all issues raised will be repeated in chapters 2.2 and 2.3. It would be better if the general issues are restricted in order to avoid overlaps.