



European Communities Trade Mark Association

ECTA's comments on OHIM's Note of February 2010 on OHIM's database for comparison of goods and services

ECTA praises OHIM's initiative to improve consistency in making comparisons of goods and services in their decisions. Clarity and predictability are clearly important aspects of the CTM system.

ECTA's comments regarding OHIM's note of February 2010 (presented at the OAMI Users Group Meeting of 15 March 2010) on OHIM's database for comparison of goods and services are as follows:

1. Content of the database and presentation of results

According to OHIM's paper, the database contains a collection of comparisons of goods and services in the form of "pairs" (one good or service compared with another). The "pairs" are mainly derived from decisions from the Court of Justice, General Court, Boards of Appeal and Opposition Divisions (the decisions being identified in the database). However, there are also "pairs" which do not derive from past decisions but have been autonomously devised by OHIM (hereinafter "unsupported pairs"). The comparisons are categorized as: identical, high degree of similarity, similar, low degree of similarity and not similar.

ECTA's remarks are the following:

- As regards the "unsupported pairs", under what conditions and in accordance with which standards and which procedure has OHIM determined them? If a pairing is so obvious, then examiners would not need the database to tell them what to do. If the pairing is not so obvious, then before updating the database perhaps OHIM should wait for a decision that provides a factual context and analysis which may serve as a basis for the inclusion of the pairs in the database.
- It would be advisable for the database to show which decisions were analyzed and then disregarded and possibly provide for some comments which may allow users to understand the rationale for which OHIM did not consider the decision capable to be reflected in the database. ECTA believes that unless there are contradictory decisions, which should nonetheless be indicated, the database should not deviate from the decisions from the Court of Justice and General Court.
- Decisions from the Cancellation Division should also be considered for entry.
- Decisions by Community Trade Mark Courts might also be considered for entry, although ECTA realizes that given the difference in the national legal system this might be difficult to achieve in the short term.

2. Database maintenance

According to OHIM's paper, the database is updated daily since it needs to grow, case law evolves, markets change to the extent that existing comparisons are no longer appropriate, new goods/services enter the market place, and words that are used to describe goods/services are no longer appropriate.

Validation of "pairs" is carried out by experts from the Office's Department for Industrial Property Office (DIPP) and Trade Mark Department (TMD). These experts select the pairs to include in the database and the decisions to support a given pair (taking into account that there are inconsistencies between decisions and sometimes even contradictions).

ECTA's remarks are the following:

- Pairing is very important and needs to be done at a very senior and experience level. It would be useful to publicly identify those individuals and disclose their experience/qualifications.
- It would be helpful to introduce a mechanism whereby users are given the opportunity to comment and /or alert OHIM of new decisions or errors in the database.

3. Database relevance

According to OHIM's paper, the database will draw exact matches and non-exact matches. Exact matches constitute an instruction for the examiners that they are required to follow. Non-exact matches are mere guidance for the examiners. The database has no binding effect on the Boards of Appeal.

ECTA's remarks are the following:

- It is not clear whether the Cancellation Division will use the database. However, since the database will enhance clarity and predictability of OHIM's decisions, this would be highly desirable.
- It is worrying if examiners have to consider exact matches as binding even if evidence is submitted showing, contrary to what the database stipulates, why in a particular case the goods/services are similar, dissimilar or complementary. If examiners ignore the evidence submitted by the parties, this would amount to a potential breach of fundamental justice rights to have a case properly considered and would force some parties to file appeals where a full analysis will take place.
- ECTA suggests that an exact match should just be a rebuttable presumption which the parties can challenge by submitting evidence that will be properly examined by OHIM and be taken into consideration (with the database being amended/updated accordingly once a case is decided).