



**Office for Harmonization
in the Internal Market**
(Trade Marks and Designs)

Developments at OHIM

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OHIM



- Commission Study
- Case Law



- Some core issues
 - Genuine use
 - Finance

- OHIM concerns
 - Modernisation
 - Governance



- OHIM submission
 - http://oami.europa.eu/ows/rw/resource/documents/OHIM/OHIMPublications/ohim_contribution.pdf
 - Essentially favouring the *status quo*



- Fees Bi-annual review
- Reserve Reduce from €190m to €50m
- Surplus Refund €300m (€400 to €600
per CTM)



- Need for legislation that is compatible with an electronic (not a paper) world
- Eliminate unnecessary bureaucracy
- Update the law to accommodate changes in the Madrid rules



- Reduce conflicts of interests in governing bodies
- Proper representation of all interests
- Change they way fees are set



- Court of Justice
 - Preliminary rulings
 - Appeals
- General Court
- Grand Board of Appeal



C-487/07 L'Oreal

C-59/08 Copad

C-301/07 PAGO

C-324/08 Makro

C-32/08 Design

C-529/07 Lindt



- To establish reputation a CTM must be known by a significant part of the public concerned, in a substantial part of the Community.
- In view of the facts Austria may be considered a substantial part of the Community.



- In order to determine whether the applicant is acting in bad faith..., the national court must take into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a Community trade mark, in particular:



- the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;
- the applicant's intention to prevent that third party from continuing to use such a sign;
- the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought.



- C-498/07 La Española
- C-202/08 Maple Leaf
- C-542/07 PURE DIGITAL
- C-398/08 Vorsprung durch Technik
- C-408/08 COLOR EDITION





- Opposition rejected by examiner and Board of Appeal
- GC (then CFI) reverses Board
- Court of Justice upholds opposition



- ...it must be held that the Court of First Instance was right to hold that the trade mark in question must have acquired distinctive character before the date of application for registration in consequence of the use which had been made of it.



- Meaning: advance or advantage through technology
- No obvious direct message from slogan
- It cannot be excluded that the connection for the public in relation to cars extends to other goods and services



- Conformation of invalidity on grounds of descriptiveness for cosmetic and make-up
- There is no basis for claiming that actual or potential damage must exist for a cancellation action to be taken





- CFI case T-215/06
- Classes 18, 25 and 40
- Refused by BoA for all three classes
- Refused by CFI for 18 and 25 only




- Case R 323/2008-G

the examiner lacked the competence to take a new decision on the substance of the case after the filing of the appeal



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