

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The President

DECISION No EX-05-5 OF THE PRESIDENT OF THE OFFICE

of 1 June 2005

concerning the evidence to be provided when claiming priority or seniority

THE PRESIDENT OF THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS),

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, in particular Article 119 (2) (a) thereof, hereinafter referred to as "Council Regulation No 40/94",

Having regard to Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council regulation (EC) No 40/94 on the Community trade mark (hereinafter referred to as "Commission Regulation No 2868/95", in particular Rules 6 (4), 8 (4), 28 (4), 108 (3) and 110 (7) thereof,

Whereas by Decision No EX-03-5 of 20 January 2003 (OJ OHIM 2003, 869), the President of the Office has determined that instead of the originals of the documents referred to in Rule 6 (1) of Commission Regulation No 2868/95, accurate photocopies thereof may be filed;

Whereas by the above mentioned decision, the President of the Office has determined that, when claiming seniority, the evidence to be provided by the applicant for or proprietor of a Community trade mark may also be made available to the Office from a document other than the original or a photocopy of the certified copy of the earlier registration to which Rule 8 (1) and Rule 28 (1) of Commission Regulation No 2868/95 refer, if the document constitutes an extract or printout of an official publication or database published by the office which registered the earlier national mark, or of a database or data carrier which is based on data supplied by that office, provided that the document contains the required indications;

Whereas the above mentioned decision of the President should also be extended to seniority claims made under Rule 108 (1) and Rule 110 (1) of Commission Regulation No 2868/95 by the holder of an International Application or Registration designating the European Community, made under the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989 (hereinafter referred to as the Madrid Protocol);

Whereas Rules 6 (4), 8 (4), 28 (4), 108 (3) and 110 (7) of Commission Regulation No 2868/95 provide that the evidence to be furnished by the applicant on claiming priority or seniority may consist of less than is required in the other relevant provisions of the Implementing Regulation, provided that the information required is available to the Office from other sources;

Whereas the information required to be contained in an original priority document referred to in Rule 6 (1) of the Commission Regulation No 2868/95, namely the file number, the filing date, the name of the applicant or proprietor, the representation of the mark and the list of goods and services, can be available on the Internet Websites of some of the central industrial property offices of States party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organization; ;

Whereas the information required to be contained in an original seniority document referred to in Rules 8 (1), 28 (1), 108 (1) and 110 (1) of Commission Regulation No 2868/95, namely the Member State or Member States in or for which the earlier mark is registered, the priority, application or registration

date of the earlier mark, the number of the earlier registration, the name of the proprietor of the earlier registration, the representation of the trade mark and the indication of the goods and services for which the earlier mark is registered, can be available on the Internet Websites of some of the central industrial property offices of the Member States in or for which the mark is registered or, concerning international registrations with effects in a Member State, on the Internet Website of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as the International Bureau);

Whereas if this is the case, the examiner will be in a position to access this information of his own motion for the purposes of examining both the priority and the seniority claim;

Whereas if the required information is not available on such a Website, either because the relevant industrial property office does not make this information available or because the information cannot be found or retrieved, the applicant for a Community trade mark remains under the obligation to furnish the documents referred to in Rules 6 (1) 8 (1) , 28 (1) , 108 (1) and 110 (1) of Commission Regulation No 2868/95, either in the original or in an accurate photocopy, extract or printout;

Whereas it is not appropriate to determine a list of offices which make the required information available on their Websites, because such a list would be subject to frequent changes;

Whereas the applicant himself is in a position to verify, when claiming priority or seniority, whether the required information is available on a Website, so that he knows in advance whether he needs to furnish an priority or seniority document,

HAS ADOPTED THE FOLLOWING DECISION:

Article 1

Substitution of priority certificates by information from Websites

The evidence to be provided by the applicant when claiming priority may consist of less than what is required under Rule 6 (1) of Commission Regulation No 2868/95, provided that the information required is available to the Office from a Website of a central industrial property office of a State party to the Paris Convention for the Protection of Industrial Property or to the Agreement establishing the World Trade Organization.

Article 2

Procedure

(1) Where priority is claimed, and where the documents referred to in Rule 6 (1) of Commission Regulation No 2868/95 have not already been submitted by the applicant, the Office will verify of its own motion whether information on the file number, the filing date, the name of the applicant or proprietor, the representation of the mark and the list of goods and services of the earlier trade mark application the priority of which is claimed is available on the Website of the central industrial property office of the State in or for which that earlier trade mark application is claimed to have been filed.

(2) Where the required information is available to the Office on such Website, the Office will make a note to this extent in the file of the Community trade mark application. Otherwise, the Office will issue an invitation pursuant to Rule 9 (3) (c) of Commission Regulation No 2868/95 to furnish the documents referred to in Rule 6 (1) of Commission Regulation No 2868/95.

Article 3

Translations

The application of Rule 6 (3) of the Implementing Regulation shall remain unaffected, if and to the extent that the applicant furnishes, or must furnish, the documents referred to in Rule 6 (1) of the Implementing Regulation.

Article 4

Seniority documents for International Registrations designating the European Community

Article 3 of President's Decision No EX-03-5 of 20 January 2003 (OJ OHIM 2003, 869) shall be applicable to seniority claims made by the holders of International Applications or Registrations designating the European Community under the Madrid Protocol.

Article 5

Substitution of seniority certificates and documents by information from Websites

The evidence to be provided by the applicant when claiming seniority may consist of less than what is required under Rules 8 (1) , 28 (1) , 108 (1) and 110 (1) of Commission Regulation No 2868/95, provided that the information required is available to the Office from a Website of a central industrial property office of a Member State in or for which the mark is registered or, concerning international registrations with effects in a Member State, of the International Bureau.

Article 6

Procedure

(1) Where seniority is claimed, and where the documents referred to in Rules 8 (1) , 28 (1) , 108 (1) and 110 (1) of Commission Regulation No 2868/95 have not already been submitted, the Office will verify of its own motion whether information on the Member State or Member States in or for which the earlier mark is registered, the priority, application or registration date of the earlier mark, the number of the earlier registration, the name of the proprietor of the earlier registration, the representation of the trade mark and the indication of the goods and services for which the earlier mark is registered is available on the Website of the central industrial property office of the Member State in or for which that earlier trade mark is claimed to be registered or, concerning international registrations with effects in a Member State, of the International Bureau.

(2) Where the required information is available to the Office on such Website, the Office will make a note to this extent in the file of the trade mark application or registration. Otherwise, the Office will issue an invitation pursuant to Rule 9 (3) (d) and Rule 28(2) of Commission Regulation No 2868/95 to furnish the documents referred to in Rules 8 (1) , 28 (1) , 108 (1) or 110 (1) of Commission Regulation No 2868/95.

Article 7

Entry into force

This decision shall enter into force on the day following its adoption. It shall be published in the Official Journal of the Office.

Done at Alicante, 1 June 2005

Wubbo de Boer
President