

Letters to the editor

OHIM reveals extent of cooperation

From Tove Graulund

Managing IP has published a number of letters on the subject of OHIM's fees in recent months. Such a large number of contributions to the debate must be seen as very healthy indeed. It appears that there is a clear difference of opinion on what to do with OHIM's surplus.

On the one side are users and OHIM officials who are campaigning to have fees reduced. On the other side are some national offices who are concerned that the gap between the fees they charge and Community trademark (CTM) fees is growing significantly smaller.

There is a clear difference of perspective in the contributions. In addition, the two sides appear to find it difficult to listen to one another. Some national offices complain that they suffer from increasing workloads as a result of the CTM. For example, they say that there are now more oppositions based on CTMs that need to be managed and decided. Some national offices complain that there is no cooperation between them and OHIM.

However, if you consider the latest news, it does not seem that the national offices are always open and transparent. The 2007 final report into OHIM's so-called cooperation activities shows that OHIM sent a total of €1,872,850 to national offices for "services to the CTM and the RCD". Denmark and the UK – the top two receivers – each received more than €250,000. Ten other national offices received in excess of €100,000, while seven offices received smaller amounts.

The next thing that puzzles users is the fact that the Commission has still not produced its proposal for the "immediate reduction of fees" requested by the EU Competitiveness Council in May last year. This delay has given rise to rumours that the proposal will not be presented until the "comprehensive study of the overall functioning of

the CTM system" has been finalized, or else that the Community patent is so important to the Commission that there is a risk that more CTM funds will be given to national offices to persuade member states to reach a deal. Obviously, these rumours have no real foundation, but they are a clear sign of the level of concern among users.

It seems clear that users have difficulty in getting heard in the political debate. When it is more convenient to ignore what they say, user organizations are often accused of only representing big company interests. When user organizations said that the fee for national searches should not be used to divert funds from OHIM to national offices, enough member states chose not to listen even when the users' position was fully explained.

This atmosphere of mistrust and lack of real communication is extremely unfortunate because it gets in the way of progress on more important issues – issues such as the diversion of national fees into national budgets (where users strongly support the national offices' efforts to achieve financial independence), or so-called cluttering of the register where the solutions are unrelated to fees, but must be found in use requirements, granting protection in just one class instead of three classes and/or other ideas. Not to mention important issues unrelated to fees such as anti-counterfeiting.

The situation needs to be resolved very soon or the gap will continue to grow. It is hoped that the proposal for a fee reduction will be published this month, and only when the dust has settled can any work on the "comprehensive study" be undertaken. The study must involve all interested parties and be conducted in an atmosphere of trust, openness, constructive debate and vision for the future.

Tove Graulund, Zacco, and past chair of MARQUES

Patent offices should embrace the PCT, not the PPH

From Samson Helfgott

I read with interest the article on the patent prosecution highway in the April 2008 issue. This procedure for implementing work sharing between the various patent offices is commendable. However, practically it has attracted only a very limited number of users. For example, from its inception on July 3 2006 until March 21 2008, the JPO received only 159 PPH requests from the US. One of the basic problems is that the applicant must first get an allowance in the Office of First Filing (OFF) before the Office of Second Filing (OSF) has begun their own work. Because of the long delays in prosecution in most patent offices, to make use of the PPH, it is necessary to request accelerated examination in the OFF. For those patent offices providing simplified requests for such accelerated examination, users may be able to use the PPH. While US provides the ability for filing a request for an accelerated examination, the requirements for such a request raise serious risks in view of our inequitable conduct laws, such that accelerated examination requests are almost never submitted. US must make an exception to their vigorous requirements for accelerated examination as the OFF, in order for the PPH ever to be useful for US applicants.

The patent offices are seeking ways for work sharing in addition to PPH, including the New Route, the Triway, the SHARE proposal, and others. However, it is regrettable that they are turning their backs on the most significant work sharing opportunity which we already have – the PCT. One of the original goals of the PCT was to avoid the duplication of work and reduce costs for applicants. Applicants continue to increasingly use the PCT. It is unfortunate that patent offices throughout the world have refused to make use of PCT for such work sharing benefits, and instead seek elsewhere for finding such benefits. The patent offices should rather seek to improve the quality of international searches and use PCT for work sharing. They would then have over 150,000 requests, rather than 159 requests.

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