



Question Marks

COMPU-MARK NEWSLETTER

June 2004

An increasingly global economy and world trade requires a global approach to trademark searches and trademark protection. It is therefore timely that the three Thomson trademark specialists - Compu-Mark with its head office in Antwerp, Thomson & Thomson or T&T from Boston and Brandy from Tokyo - have joined forces to form a single large group. On 1 April 2004 Mr Geert Noorman was appointed CEO of this new group. Now that we are all operating under a single leadership, we can continue to extend our range of products and services and respond even more quickly to the constant changes in the market and the market environment. Our top priority continues to be the extension of our electronic services, such as Watch E-Services, which is covered in more detail in this edition.

Jan Broeckx, General Manager

FOCUS

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Watch E-Services: now with on-line selection

To facilitate the management of your watch portfolio, Compu-Mark keeps your watch information updated on-line free of charge. This spring a number of important features have been added to Watch E-Services. Our text explaining these comes from Product Manager Sabine Vermuyten.

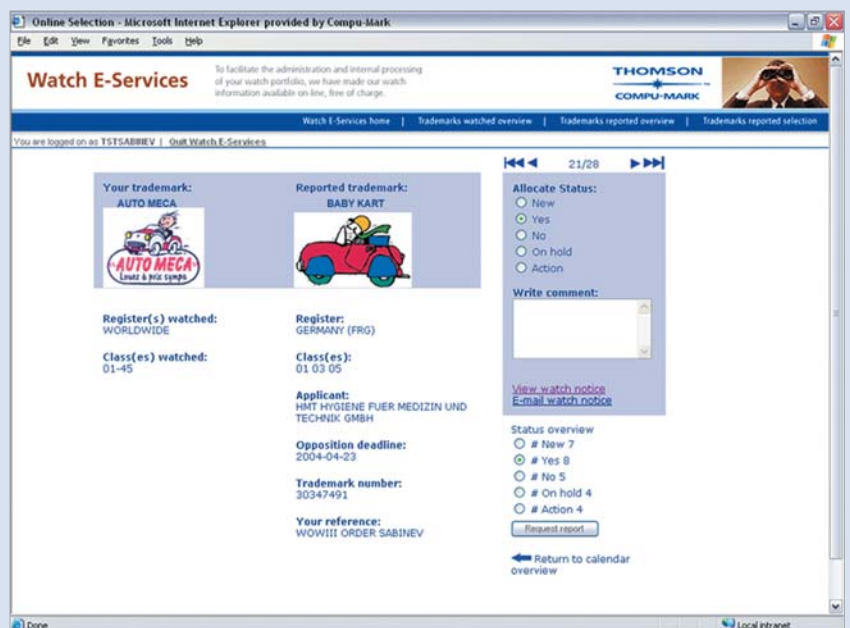
So, to recap: what are Watch E-Services?

'You could use Watch E-Services to consult your whole current watch portfolio and view the trademarks and devices that have been reported. Since April we have also been offering an on-line selection tool. This makes internal processing of your watch notices a lot simpler.'

What exactly does the new selection tool involve?

'Whenever we discover new and possibly conflicting marks, we send you an e-mail. When you log in via www.compu-mark.thomson.com to view Watch E-Services, you see the newly reported marks for that day on the selection screen. You can see at a glance all the relevant information on both the mark which is being watched and the one which has been reported. This allows you to assign a status very quickly to every trademark that is reported: is immediate action required, is it a relevant trademark that certainly needs to be followed up, is some consultation required or can it be ignored? You can also see the full watch notice by following a direct link and enter your personal comments in the notes field.'

The new on-line selection tool allows you to assign a status to every newly reported trademark



What reporting takes place from that point onwards?

'After your daily selection process you can request a watch notice immediately: you will then receive all watch notices with the status of your choice by mail. You can then send that notice directly to clients or colleagues, which results in significant time savings.'

Five major advantages

1. All the information about the trademarks which are being watched and reported is **available on-line**: this allows you to save time and therefore take the required action more quickly;
2. with **on-line selection** it becomes much easier to process your watch notices internally;
3. opportunity for **personalisation**: through the Marks Reported Overview, for example, you can generate personalised trademark lists;
4. extensive **reporting options**: you can request both Excel spreadsheets and watch notices by e-mail, with the watch messages of your choice included as attachments;
5. Watch E-Services provides a **free archiving** tool: your trademark information is stored on-line for a longer period.

Trademarks watched overview

Consult your current watch portfolio

Trademarks reported overview

View the trademarks and devices that have been reported

Trademarks reported selection

Assign a status to all newly reported marks and thereby select the trademarks for which you wish to receive a watch notice

How can you get access to the Watch E-Services?**Are you already a user of Watch E-Services?**

When we renewed our website (see also page 10) we created a personalised [Client Area](#), a secure area that gives you access to our electronic services Watch E-Services and SAEGIS. You log in to www.compu-mark.thomson.com using your password and user name. If you go to [Enter E-Services](#) and click on [Watch E-Services](#), you will automatically be directed to Watch E-Services.

Do you wish to use the on-line selection tool? If so, please contact Customer Support Department on + 32 3 220 72 11.

Are you not using Watch E-Services yet?

Ask Customer Support Department for a free user name and password. You can call them on + 32 3 220 72 11.

New EU languages and other useful information about the Community Trademark



Kathy Van der Herten

The recent enlargement of the European Union has been the subject of much discussion. Nevertheless, Kathy Van der Herten, Product Manager Search, would like to draw your attention to a number of points that should not be missed. One aspect that you should certainly keep in mind is the arrival of nine new official EU languages.

Since 1 May 2004 new Community Trade Marks can also be filed in Estonian, Hungarian, Latvian, Lithuanian, Maltese, Polish, Slovene, Slovak and Czech. The second language will provisionally continue to follow the old five-language regime. A publication always mentions the twenty official languages.

How does Compu-Mark deal with this in practice?

Kathy Van der Herten: 'We have sought to find the ideal balance in our reports: we provide you with all the information you need without overloading you with extra paper. Thanks to the following changes, we have succeeded in this:

- In the past we have already limited the **full official publication**, as shown for example in our trademark and

device searches, to five languages: English, French, German, Italian and Spanish. We are not going to change that.

- For **the updated list of goods and services** for our 'paper' products we always display the list in the language in which the trademark has been filed, the language of the report and the computer translation (if applicable). Last year we already limited the number of languages.

For several months you have had the option to choose which language you wish to see for the published Community Trademarks. On our on-line platform SAEGIS the number of possible languages has been extended with 9 since the enlargement.

Which new EU countries are actually most active?

Kathy Van der Herten: 'On the basis of a number of Community Trade Mark filings between 1996 and 2003 we are expecting a flood of trademarks mainly from Poland and Cyprus. Each of these accounted for approximately one-quarter of the 1000 trademarks that were filed by the ten countries in question during that period. Despite its small size, Malta is surprisingly in fifth place with some 8%. Latvia brought up the rear with only four filings.'

Finally, what is the situation as regards opposing the use?

Kathy Van der Herten: 'Despite the automatic extension to the new Member States, it is possible that you may encounter opposition from individual countries. That does not mean the end of the Community Trade Mark, but only the end of non-protection in those countries. The OHIM does not publish this information. Above all you should therefore remember to carry out a national search before you launch a trademark.'

Do you have any further questions? If so, please contact Customer Support Department on + 32 3 220 72 11.

SAEGIS™ welcomes Lithuania and Ireland



Yes: we have added the Lithuania database to SAEGIS. A new addition to the on-line searches market! Ireland has also returned. After a few years of absence you can once again conduct on-line searches in Saint Patrick's country. **All this means that full on-line coverage of the EU, via Custom Search and AutoQuery, is coming closer.** Meanwhile we are already working on new databases. We are trying to get these on-line as quickly as possible!

Product News: FAQ

An answer to all your questions

How fast is an immediate search? Can Compu-Mark search and watch for foreign characters? What is the difference between an identical search and an identical screening search? These are the questions you may ask yourself when you look at the products on our price list and you can certainly ask Customer Support Department about them.

As you can read on page 10 of this Question Marks, Compu-Mark has been working on a new, improved website for you since the spring of this year. One classic part, which is none the less important for that, is the Q&A (Questions & Answers) section: an extensive and representative overview of questions that have been put to our Customer Support Department over the years.

Questions & Answers: three clear sections

1. About our company
2. About trademarks and IP
3. About our products

It is therefore in all our interests to keep this important source of information up to date.

Does this mean that the FAQ section will be disappearing from Question Marks? On the contrary, in this newsletter we will continue to work hard to shed light on current topics and trademark-related questions that often arise!

Visit www.compu-mark.thomson.com and click on Questions & Answers.

Trademark research in Japan: Japanese Group Code

by Atsuko Tagaki - Brandy International



As you know, Japan is member of the Nice agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. However, JPO has used for long its own grouping of goods/services as a criterion. All goods/services belonging to the same group are deemed similar to each other. This grouping has been called "Group Code".

Incidentally, China, South Korea and Taiwan also have their own grouping (which is similar to that of Japan) through which the new trademark applications are examined.

Under the Japanese examination practice, designated goods/services belonging to the same Group Code are deemed to be similar, even if they appear to be totally different at a first glance or if they belong to different international classes according to the Nice Classification of Goods and Services. (ICGS).

This might be complicated and hard to understand for those who are not familiar with the Japanese system. Therefore, we would like to elucidate this matter as follows.

Japan follows the first-to-file system that provides that if one or more applications conflict with another, the application that was filed first is registered. In this system,

the applicant is required to declare probability of use of the mark, so there is no "use requirement". This is quite different from the first-to-use system that provides that in case of conflicting applications, it will be the one with the oldest proof of use that is registered. This system requires an intention-to-use declaration of the mark for the requested goods/services.

In order to limit the risk of conflicting situations, the JPO examination standards are based on similarity of goods according to the aforementioned Group Code sub-division of the International Classification of Goods and Services by which the 45 international classes are further sub-divided into approximately 800 different Group Codes.

The mentioned Group Code is classified and prepared from the viewpoints of the use-application-system and the shop-of-sale-system, and is totally considered in the productive sector, the marketing sector and consumer business to identify the raw material and the quality of the finished goods and their parts.

This might give you the feeling that there is a gap between the viewpoints of use-application-system and the raw material-system under the International classification standard and the said Group Code.

Under the above circumstances, there are advantages and drawbacks to the Group Code system.

Let's take the example of "pre-recorded video disks" (ICGS 9) and "photo stand" (ICGS 16) which both belong to Japanese Group Code 26D01. According to the above examination standards of the JPO, these goods are deemed similar to each other.

This is advantageous, because you can presume or conjecture easily what are the similar articles to your designated goods by recognizing the Group Code.

This means that you can expect in advance whether or not use of your goods/services might be attacked by third party's trademark right in future.

On the other hand, as a drawback example, "large-sized



Jan Van Barel, Quality Director, takes an unusual view of current affairs

precision measuring machines" (ICGS 9 - measuring or testing machines) are deemed to be identical to "measuring rules" (ICGS 9 - measuring or testing machines) since they both belong to the Group Code, 10C01, whereas the purpose-of-use and shop-to-sales of each of them might be different in the actual market.

As you can see, under the Japanese system, it might be even more important to determine the correct Group Code of your goods/services than the International class when conducting Japanese Trademark searches, filing an application, etc. in Japan.

Finally, if you should require further clarifications on the Japanese Group Code system, we recommend you to visit the "Industrial Property Digital Library" in the "Reference Room" of the JPO's home page: www.jpo.go.jp/index.htm.

Are devices treated unfairly?

Statistics on the number of newly filed trademarks have shown that approximately 33% of them are devices or contain figurative elements. Production statistics, however, tell a completely different story: device searches accounts for only 7,16% of all trademark searches and device watches constitute only 12,18% of the total number of watches.

Should we conclude from this that those filing devices see their devices and the image elements of combined marks as second-class trademarks? The answer is certainly that they do.

The reasons for this lie mainly in the fact that for a long time device searches had a lower level of reliability than trademark searches and were generally carried out on a time basis, which resulted in a higher price in most cases. Furthermore, the number of conflicts between devices is significantly lower than the number of conflicts between trademarks, which means that those filing them are often willing to take greater risks.

This situation, however, has changed. The level of reliability of device searches has risen significantly, thanks to much improved technology and consistent computer support. Many search organisations, among which Compu-Mark is playing a leading role, have standardised their prices for device searches, so that those filing them will not face any surprises when the bill arrives.

All this should be taken into consideration. Perhaps it would be useful or even vital for those filing trademarks to review the situation of their registered devices.

JAN VAN BAREL

Opposition according to Madrid in 2004

More than a year ago Data Acquisition Manager Bruno Van Treeck gave you an overview of the opposition procedures to be followed when trade or service marks are seeking protection in one or more countries which are members of the Madrid Agreement and/or Madrid Protocol. Since then, however, there have been radical changes in the legislation in a number of countries. An update is therefore needed!

Bruno Van Treeck: 'For the sake of clarity I must remind you that your International trademarks are subject to the trademark law in force in the member country in which you are seeking protection. Consequently, new international registrations or territorial extensions of existing registrations seeking protection in countries that provide for an opposition procedure will undergo the same type of procedure as in the national country. This also applies, for example, to the recently introduced administrative opposition system in the Benelux, where the following rules apply and where the opposition term is two months. Note that initially and as a transition period, opposition in the Benelux can only be lodged against trademark applications filed in at least one of the following international class(es): 2, 20 and 27.'

- For national applications the term starts from the 1st of month following the publication date in the Benelux Trademark Bulletin (Markassiet) and in which the new application was advertised.
- For international trademarks the two-month term starts from the first of the month following the publication in the Gazette of International Marks (GIM).

You will find below an updated overview of the current member countries of the Madrid Agreement or Madrid Protocol which have an opposition system. Amendments compared to the previous table from early 2003 are indicated in bold.

Antigua & Barbuda:	3 months - no further specifications available for the time being
Australia:	3 months after publication in the national trade marks journal
Benelux:	2 months from the 1st of the month following publication in the GIM
Bhutan:	1 year from the date of publication in the GIM
China:	3 months from the 1st of the month following publication in the GIM minus 1 day
Croatia:	3 months from the 1st of the month following publication in the GIM
Cuba:	2 months after publication in the national trademarks journal
Cyprus:	2 months after publication in the national trademarks journal
Czech Republic:	3 months from the 1st of the month following publication in the GIM
Denmark:	2 months after publication in the national trademarks journal
Estonia:	2 months after publication in the national trademarks journal
Egypt:	6 months after publication in publication in the GIM
Finland:	2 months after publication in the national trademarks journal
France:	2 months from the 1st of the month following receipt of the GIM at the INPI
Georgia:	3 months after publication in the national trademarks journal
Germany:	3 months from the 1st of the month following publication in the GIM
Greece:	4 months from the 16th of the month following publication in the national gazette
Iceland:	2 months after publication in the national trademarks journal
Iran:	30 days - no further specifications available for the time being
Ireland:	3 months after publication in the national trademarks journal
Japan:	2 months after publication in the national trademarks journal
Kenya:	60 days - no further specifications available
Latvia:	4 months after publication in publication in the GIM
Lesotho:	3 months - no further specifications available for the time being
Lithuania:	3 months after publication in publication in the GIM
Macedonia:	90 days - no further specifications available for the time being

Moldova:	3 months after publication in the national trademarks journal
Mozambique:	60 days - no further specifications available
Namibia:	2 months - no further specifications available
Norway:	2 months after publication in the national trademarks journal
Poland:	6 months after publication in the national trademarks journal
Portugal:	2 months after publication in the national trademarks journal
Romania:	3 months after publication in the GIM
Russian Federation:	5 years from the publication in the national trademarks journal
San Marino:	1 year - under investigation
Sierra Leone:	3 months from the publication in the national trademarks journal
Singapore:	2 months after publication in the national trademarks journal
Slovak Republic:	3 months from the 1st of the month following publication in the GIM
Slovenia:	3 months from the date of publication in the GIM
South Korea:	30 days after publication in the national trademarks journal
Spain:	2 months after publication in the national trademarks journal
Sudan:	6 months from the date of publication in the GIM (8 months for persons not residing in Sudan)
Swaziland:	3 months after publication in the national trademarks journal
Sweden:	2 months after publication in the national trademarks journal
Switzerland:	3 months from the 1st of the month following publication in the GIM
Turkey:	3 months after publication in the national trademarks journal
United Kingdom:	3 months after publication in the national trademarks journal
U.S.A.:	30 days after publication in the national trademarks journal
Zambia:	2 months - no further specifications available

Every effort has been made to provide information as accurately as possible in the above table. In case of a specific action the service of a competent professional adviser should be obtained.



During the yearly INTA meeting in ATLANTA it was communicated that the link between the Community Trademarks system and the Madrid Protocol will become effective on October 1, 2004 and that the Madrid Protocol and Madrid Agreement will enter into force on August 5, 2004 with respect of the Syrian Arab Republic.

Country list extended to include Treaties

In addition to the existing overview of the Madrid Agreement/Madrid Protocol, the current Classification System and the Eighth Edition of the Nice Classification, we now also have an overview of those countries which have ratified the Nice, Vienna, The Hague, Locarno and Lisbon Agreements.

Would you like a copy of this list? If so, visit www.compu-mark.thomson.com and download the list.



New e-mail addresses and website

@thomson.com

Since 19 April 2004 all Compu-Mark personnel now have a new e-mail address. As you know, our business forms part of the The Thomson Corporation, a leading supplier of integrated information solutions for businesses and other professional clients. All Thomson businesses will now have a consistent format for their e-mail addresses. This will promote communication between us and help you to recognise Thomson companies better. For the same reason a uniform Thomson logo structure and house style had already been introduced.

New e-mail addresses

customer.support.be@compu-mark.com

→ **compu-mark.be@thomson.com**

customer.support.fr@compu-mark.com

→ **compu-mark.fr@thomson.com**

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→ **compu-mark.it@thomson.com**

customer.support.nordic@compu-mark.com

→ **compu-mark.nordic@thomson.com**

www.compu-mark.thomson.com

The Compu-Mark website was also freshened up on 19 April. All these changes are moves towards greater ease of use and clarity. We want to offer you the maximum amount of useful information with a minimum number of 'clicks'.

At our renewed website you will find:

- detailed information on all our products;
- handy order forms and useful lists;
- our newsletters 'Question Marks' and 'SAEGIS Flash';
- the latest news.

Client Area

From now on you can log on directly to the Client Area from the home page. This gives you access to our electronic services Watch E-Services and SAEGIS. You will also find all local contact information for your country.

Do you already have a user name and password for Watch E-Services? If so, you can now log in directly to the Client Area.

New domain name

www.compu-mark.thomson.com

E-mails to the old addresses will still be forwarded for a period of time. Nevertheless we would ask you to update your address books as soon as possible.

INTA 2004 in Atlanta: informative and entertaining!

The annual conference of the International Trademark Association (INTA) took place in Atlanta this year. From 1 to 5 May 2004 more than 6000 trademark specialists from all over the world congregated around the Hyatt Regency and Marriott Marquis hotels in the heart of the city to attend the largest conference in the trademark world.



The guests at the Compu-Mark party enjoyed the mystical atmosphere and lively music until long after midnight

New services

Compu-Mark was there, of course, showcasing two eye-catching products. The latest version of Watch E-Services, our on-line tool for managing your watch portfolio, met with by far the greatest interest. The novelties in SAEGIS were also well received. Visitors were able to become acquainted with a number of sister companies from the Thomson group: Thomson & Thomson, West, Dialog, Sweet & Maxwell and Carswell.

Unique party

In accordance with tradition, Compu-Mark provided plenty of relaxation: together with the other Thomson companies we organised a fine party on the Tuesday evening. In the impressive 'AmericasMart' our guests were plunged into a unique atmosphere with special lighting effects and mystical features. Almost 3000 people enjoyed an excellent buffet and lively music from live band 'Party on the Moon' until the small hours.

See you next year in San Diego!

Question Marks is the newsletter of Compu-Mark and appears three times a year.

You can also find this newsletter on our website at www.compu-mark.thomson.com

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Would you like to write an article yourself? If so, please contact Natalie Cauwenberghs.

Do you have a question in relation to our services?

Please call our Customer Support Department.

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Site quiz

Have you already visited our updated site? This quiz gives you an extra reason to pay it a visit, because that is where you can find the answers to the questions below. Have a look and win a designer salt and pepper set!

1. What is the name of Compu-Mark's Japanese sister company?
2. What is the name of our on-line platform for screening searches?
3. What does the abbreviation KISS stand for?
4. How many countries/registers are included in the worldwide colour region?
5. At how many levels is the In use search for trademarks available?

Solution

1. = _____
2. = _____
3. = _____
4. = _____
5. = _____

ANSWERS TO THE PREVIOUS QUIZ

The correct combination of flags and countries is as follows: 1-B, 2-I, 3-G, 4-C, 5-D, 6-H, 7-J, 8-E, 9-F, 10-A

These five readers have won a bottle of chocolate or vanilla liqueur with matching glasses:

- Mrs Elvira Schwentner - Gebro Pharma GMBH - Austria
- Mr Ronald Pols - Urquhart Dykes & Lord - UK
- Mrs Ann-Charlotte Carlsson - Dr. Ludwig Brann Patentbyra - Sweden
- Dr. Wolfgang Börner - Degussa Patente - Germany
- Mrs Anne Hierholzer - Cabinet Marek - France

> Send your solutions by e-mail to **compu-mark.questionmarks@thomson.com** or fax them to **+ 32 3 220 73 90**

Mrs Mr

NAME: _____

COMPANY: _____

ADDRESS: _____

COUNTRY: _____