



The President

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The Convergence Programme

Dear António,

We would like to thank you for your letter of 21st June 2011, in connection with the Convergence Programme designed by the OHIM in order to set up a cooperation between the OHIM, the National Offices and BOIP aimed at fostering a harmonisation of practices of the EU IP Offices.

As you know, **MARQUES** has supported those initiatives aimed at increasing harmonisation of the trademark systems for a long time and has especially endorsed the Cooperation Fund's initiatives in this area, in view of the consistency and transparency ensured by the Fund's operative and financial control.

Since its presentation to the Administrative Board and Budget Committee last May, **MARQUES** has appreciated the strength and potential of the OHIM Strategic Plan for 2011-2015, acknowledging that the three main objectives identified in the Strategic Plan, namely, the creation of a common platform of databases and e-business tools, the harmonisation of trade mark laws and procedures through the Trademark Directive and the fostering of convergence in practices are fundamental to the creation of a true interoperable and collaborative European Trademark and Design Network and in fact **MARQUES** perceives the Network as the best way of achieving a higher level of harmonisation.

In line with its former positions, **MARQUES** thus appreciates the OHIM's endeavour of initiating a comprehensive Convergence Programme aimed at achieving convergence of practices by means of a process of sharing and mutual understanding, as only can in fact be accomplished through the involvement of all interested parties, namely, the OHIM, the National IP Offices, BOIP and the Users Associations.

The Convergence Programme objectives as stated in the Programme Brief are fully shareable and when achieved they shall fine-tune the coexistence of systems within the European Union and in turn satisfy the users' expectation that whichever system they may use, they will be offered the same excellent standards of service and the same level of consistency. Where the projects within the Convergence Programme will be framed and executed by basically following the models and procedures as used under the Cooperation Fund Programme and where the set up of the Programme Work Plan and action points of the final Project Briefs will be defined with the involvement and commitment of all participants, including the Users Associations, **MARQUES** confidently expects that tangible and beneficial results can be achieved in a transparent and controlled way.

MARQUES acknowledges that the projects of the Convergence Programme shall aim at harmonising practices in areas where it can be done without legislative amendments and especially in those areas that are of particular interest to Offices and users. **MARQUES** likewise agrees that the convergence projects that have been already launched in the fields of Harmonisation of classification of goods and services and of the Class Headings both cover top priority matters. In this respect **MARQUES** assumes that in line with the general indications included in the Programme Brief, the Users Associations will be promptly involved in and committed also to these projects.

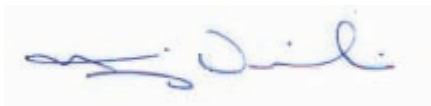
MARQUES would also see a need of convergence of practice in connection with the assessment of the similarity between goods and services, yet notes that the project CF 1.2.9. Common Tool on Similarity of Goods & Services of the Cooperation Fund Programme should serve the same purpose. While acknowledging that this and also two other top priority matters are being dealt with under the Cooperation Fund Programme, i.e. the creation of a Seniority Repository (Package 1, CF 1.1.4.) and the Software Package (Package 2, CF 2.14), **MARQUES** would favourably see an expressed consensus, for instance by means of a Memorandum of Understanding between all participants to the Convergence Programme, that all of the above mentioned areas in fact are both eligible to fall under the projects of the Convergence Programme and are highly desirable to users, so long that they can prove to highly impact on the move forward to a much harmonised and coherent overall IP practice system. The deployment of these projects under the Cooperation Fund Programme may take effect within a still manageable timeframe yet longer than the one anticipated for the projects of the Convergence Programme. The strict coordination with the Cooperation Fund and the collaboration foreseen between the Programme Manager and Legal Coordinator of the Convergence Programme and the corresponding functions of the Cooperation Fund Programme shall ensure an appropriate and efficient use of resources and the future implementation of any additional processes or tools within the Convergence Programme if and to the extent required and at the proper time.

In turn, **MARQUES** considers that priority has to be given to those other issues that can prove to have no or less potential of being controversial, and in any case simpler to deploy within a manageable timeframe and likely to produce a tangible level of improvement for the users, especially in terms of simplification of administrative procedures. In this sense, of those items included in the list of possible areas of convergence under the Annex 1 to the Programme Brief, **MARQUES** would primarily favour the progress of a project concerning the convergence of practice on the registration of non-traditional trademarks. Another two projects which may

prove to fulfil the requirement of simplicity and to encompass a high potential of improvement for users concern the simplification of the standard rules regarding entries into the registers, such as on transfer of rights, to the extent that no legislation changes may be needed, and the accomplishment of common standards on what and how to submit as proof of use. The reach of a convergence of practice in those other areas as identified in the Annex 1 to the Programme Brief, e.g. on the scope of protection of trademarks exclusively in black, white and/or shades of grey or on how to examine or deal with non-distinctive or weak components of trademarks in the context of examination of either absolute or relative grounds for refusal may be likewise desirable, yet any achievement of convergence in these areas may exceed the scope of the mere practice and that being the case it may lead to the need of reconsideration in statutes or case-law.

We respectfully submit this contribution to your attention in the hope that our input may prove helpful in assisting your revision of the Programme Brief in view of the set up of the Programme Work Plan. Should you wish to further discuss any of the above comments, we gladly remain at your disposal.

With our best regards,



Nunzia Varricchio
Chair of **MARQUES** Council



Tove Graulund
Member of **MARQUES** Council and Observer
to the OHIM Administrative Board and Budget
Committee