



Managing Trade Marks

LEGAL MEDIA GROUP
EUROMONEY

WOMEN IN BUSINESS LAW AWARDS 2011
Claridges Hotel, London June 29, 2011



MANAGING COPYRIGHT | MANAGING INTERNET IP | MANAGING PATENTS

Managing Intellectual Property

Welcome: TOVE GRAULUND
[My Clippings](#) [My Searches](#) [My Account](#) [Logout](#)

(Search Keywords) Search [Advanced Search](#)

[HOME](#) [COPYRIGHT](#) [INTERNET IP](#) [PATENTS](#) [TRADE MARKS](#) [MANAGING IP MAGAZINE](#) [RESOURCES](#) [SUBSCRIBE](#) [EVENTS](#) [ABOUT US](#)

[Managing Trade marks archive](#) [Trade Marks Topics](#) [News by Jurisdiction](#)

Follow us on: [t](#) [f](#) [in](#) [RSS](#)

You are here: [Managing Trade marks](#) > [Archive](#) > Trade Mark Study: users list concerns

TRADE MARK STUDY: USERS LIST CONCERNS

14 March 2011

[Print article](#) | [Have your say](#) | [Email a colleague](#) | [Add clipping](#)

Simon Crompton, London

Fees, revenues and renewals are among the areas in the Max Planck Trade Mark Study that cause unease, according to representatives of brand owners' associations

THREE FOR ONE

The associations disagreed on the study's suggestion that trade mark applications should be for one class, rather than three-for-the-price-of-one, as it is now.

MARQUES welcomed the removal of the three-for-one system of classes, while several others rejected it. "Some products, like keyrings, can fall into two classes quite easily - 6 and 18 for the metal and leather elements, in that case - where other products may be sold in the millions but only fall into one class," said AIM's Dawn Franklin.

Any reduction in the number of classes should also lead to a reduction in fees, as it meant getting less for the money, she argued. Anything else is "just a tax on business".

Franklin also points out: "The study says that it is removing the three-for-one system based on the idea that the register is becoming cluttered, but also admits this point is not proven." In the view of Tove Graulund of MARQUES, the register is bigger but that is hardly surprising: "It's an inevitable result of the success of the CTM system, with marks coming together from all over Europe," she said.

INTA, meanwhile, hung back from making any statement on the issue because of the level of disagreement among its members.

Other associations commented that it was their job to make sure companies realised the benefits, both in terms of time and cost, of filing as few marks as possible.

Money going back to the regions

"We've all come to terms with the fact that OHIM revenue is going to be sent back to the national offices," said the spokesman for one industry association. "We don't like it but we've learnt to accept it."

There was concern in industry, however, that there were not sufficient checks on how this money would be used - particularly given that the study said 15 of the national offices are not financially independent. "There need to be controls administered by the Administrative Board, with clear and measurable performance indicators. Most importantly, if those indicators show a project didn't work, offices shouldn't be able to spend the money the same way again," commented AIM's Franklin.

The biggest concern is that any funds returned to the offices might simply replace money that would have been spent on trade marks anyway. One way to prevent this would be to require offices to produce records from previous years. So if an office received €4 million every year from its national budget, and that dropped to €3 million in the year it received €1 million from OHIM, the replacement would be obvious.

Christina Sleszynska, Europe representative for INTA, agreed: "We have always stressed that there have to be specific mechanisms in place to trace how the funds are used. We would reiterate that all funds must be used exclusively for activities related to trade marks."

INTA said it was also disappointed to see that renewal fees would not be lowered, which it had always supported. Most other associations were happy with the level of fees - as long as new ones were not charged, for suggested searching services, for examples.

RELATED ARTICLES

- [Background: Lucasfilm v Ainsworth](#)
- [Trade Mark Study: coexistence proposal troublesome](#)
- [Australia set to raise the bar for patents](#)
- [EU Trade Mark Study proposes fee changes](#)
- [Industry should challenge more Community designs](#)

EVENTS

International Patent Forum 2011

Renaissance London Chancery Court Hotel, London

April 5-6, 2011

[Click here](#) to register



LATEST COUNTRY UPDATES

Israel Customs wrong to charge Levi's for destroying counterfeits

SUPPLEMENTS

- [Japan IP Focus 2011 7th edition](#)
- [Korea IP Focus 2011 5th edition](#)
- [Asia-Pacific & Middle East IP Focus 2010 8th edition](#)
- [Mexico IP Focus 2010 7th edition](#)
- [Americas IP Focus 2010 6th edition](#)

MOST READ ARTICLES

- [Howrey to dissolve](#)
- [Top social media brands revealed](#)
- [OHIM launches centralised search service](#)
- [Rosetta Stone calls for amicus support](#)
- [Mexico City firms form TMI Abogados](#)

Another big area of concern was the coexistence of similar trade marks in different parts of the EU. For more detail, see Managing IP article [here](#).

OHIM'S REACTION

OHIM, meanwhile, has been consistent on not commenting on what it thinks of the various proposals, as has the European Commission.

Although some have considered this silence telling, it is not surprising that neither has openly welcomed or criticised any particular points, given that this is part of a consultation on legislation that has been going on for at least four years and will lead to legislative proposals - though not until later in the year, possibly October.

It is clear that there are elements of the study that both OHIM and the Commission are unhappy with. But that is hardly surprising in an independent study. Anything more than speculation will have to wait until October.

The study, commissioned by the European Commission to look at the overall functioning of the European trade mark system, was published last week. It was welcomed as serious, rigorous and well-thought out by representatives of brand owners.

Bookmarks

Del.icio.us	Digg.com	Facebook	LinkedIn	Reddit.com	Stumbleupon.com
Twitter					

Managing Intellectual Property

WEB SEMINAR

Strategies for European patents, prosecution and enforcement

CLICK HERE TO REGISTER FOR FREE

March 24 2011
10am PST/
1pm EST/
5pm GMT

SPONSORED BY



LexisNexis™



[Back to top](#) [Change font size: a a a](#)

About Managing IP

- [About us](#)
- [Subscribe](#)
- [Free Trial](#)
- [Contact us](#)
- [Media pack](#)
- [Editorial Calendar](#)
- [FAQs](#)
- [Privacy policy](#)
- [Terms and conditions](#)
- [Sitemap](#)
- [Disclaimer](#)

My Managing IP

- [My account](#)
- [Password Reminder](#)
- [Twitter](#)
- [Facebook](#)
- [LinkedIn](#)
- [RSS feeds](#)

Managing IP Products

- [Managing Copyright](#)
- [Managing IP magazine](#)
- [Managing Internet IP](#)
- [Managing Patents](#)
- [Managing Trade Marks](#)

Topics

- [Managing Copyright topics](#)
- [Managing Patents topics](#)
- [Managing Trade marks topics](#)

Resources

- [Surveys](#)
- [Roundtables](#)
- [Web seminars](#)
- [Awards](#)
- [World IP survey 2010](#)
- [IP Handbook](#)
- [Archive](#)
- [Supplements](#)
- [Conference Newspapers](#)

Recommended Links

- [International Tax Review](#)
- [Transfer Pricing Week](#)
- [China Law & Practice](#)
- [IFLR](#)
- [Legal Media Group](#)
- [External Links](#)