

Thu, Jul 8, 2010 at 10:29 AM

To: Annette.Kur@ip.mpg.de, roland.knaak@ip.mpg.de

Trade Mark Study/Harmonisation of Practices

Dear all,

On behalf of AIM, BUSINESSEUROPE and MARQUES, thank you once again for the special session with Users about the ongoing Trade Mark Study on 9 June.

As discussed during that meeting, please find below a preliminary list of practices that AIM, BUSINESSEUROPE and MARQUES believe should be harmonised between all Offices. In order to facilitate access to trade mark protection and its enforcement at national level, especially for SMEs, the systems should be harmonised as far as is feasible, so that Users have the same high-quality experience, regardless of in which Member State they choose to register. Given the time pressures involved, the following is a preliminary, non-exhaustive list of points for consideration:

A. Searching

1. Harmonisation of information provided in databases (some do not provide full information on owner (including change in ownership), owner's address, address for service, images of device marks etc);
2. Seniority databases in all Offices and Offices to keep records of abandoned rights for which seniority has been claimed;
3. Clarification of when a seniority claim is effective (if this depends on when the national right has been abandoned as opposed to when the seniority claim has been recorded).

B. Filing an application to register & processing

4. E-filing, e-renewal and e-admin should be available in all Offices with harmonised e-filing functionalities/ requirements (currently some Offices require national residence to access the portal, some do not accept credit cards, some do not allow e-renewal, some do not accept simple changes of address or representative online etc);
5. Publication of databases showing accepted specifications of goods and services (with a view to working towards harmonisation);
6. Publication of absolute grounds examination guidelines by all Offices (with a view to working towards harmonisation);
7. Elimination of relative grounds examination;
8. Harmonisation of classification and description of goods/services systems.

C. Oppositions, cancellations, revocations & enforcement of rights

9. Period within which to oppose: 3 months after publication;
10. Publication of opposition guidelines by all Offices with a view to working towards harmonisation;
11. Opposition should be possible on the basis of any prior rights, e.g. company name, unregistered right, pending applications, registered right etc.;
12. Harmonisation of regulations on proof of use;
13. Harmonisation of the starting date of the grace period of use (both for national/regional and international trade marks);
14. Harmonisation of appeal processes (e.g. one level within national Office);
15. Ability to file one opposition based on several prior marks (rights), and not having to file separate oppositions;
16. Harmonise opposition/cancellation/revocation procedures and processes as straightforward administrative steps handled by the IP Offices (some are administrative and some can only take place in court) with the option of applying directly to court always being possible;

17. Ability to file a single claim for cancellation based on a number of prior rights;
18. Creation of databases on decisions by the Offices in opposition matters and cancellation/ revocation actions;
19. Conversion of CTMs in a simplified and harmonised way by all Offices;
20. Harmonisation of replacement of International Registrations: in some countries this is automatic and in others the IP holder has to request the replacement. In some countries the replacement means that the earlier right is merely deleted whereas in other countries the date of the earlier right is captured in the new IR.

D. General matters

21. Harmonisation and simplification of procedure/rules on legalisation, notarisatation and requirements for powers of attorney, to work towards simplification and less bureaucracy;
22. Address for service should be allowed to be anywhere in the EU - national language requirements remaining unchanged;
23. One right should keep the same number (and not go through changes of application, registration and renewal number for the same trade mark as in some Offices).

E. Look-alikes

24. Work toward harmonisation of the way laws and Offices deal with look-alikes so as to eliminate inconsistencies and improve enforcement.

Please do not hesitate to contact any of us should you require any further clarification or information.

c.c. OHIM Cooperation Fund's Management Board, OHIM and the Commission.