

# MARQUES

**The President**  
**António Serge De Pinho Campinos, Esq.**  
**Office for Harmonisation in the Internal Market (Trade Marks and Designs)**  
**Avenida de Europa, 4**  
**Spain**

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## **MARQUES** for OHIM Strategic Plan

Dear António,

On behalf of **MARQUES** we would like to express appreciation for your initiative of opening the door to a genuine and transparent dialogue with the users in connection with the draft of a Strategic Plan of the Office for the coming years. We take this as a clear sign of your willingness to create an even more fertile environment for a true and beneficial cooperation with the users.

At **MARQUES** we have always devoted great efforts in having the views and expectations of our members towards the Office shared and discussed in a transparent and proactive manner and with the same understanding we have now interpreted your invitation to make a contribution on the subject matter and we gladly submit our thoughts to your attention.

We hope that our input may prove helpful in assisting your valuable project of enhancing both the Community Trade Mark and Design Systems and prompting your Office to become a comprehensive IP Agency.

With our best regards,



Guido Baumgartner  
Chair of **MARQUES** Council



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

## MARQUES for OHIM Strategic Plan

Within the frame of the Study on the functioning of the Trade Mark system in Europe, **MARQUES** has already confirmed favouring that the national, regional and international trade mark systems must continue to coexist and to represent equally efficient solutions that remain attractive for users, both as individual solutions and as solutions that can be combined depending on the needs and circumstances of the user who will make the choice very much on a case-by-case basis. Simple and cost-effective registration systems can be really beneficial to the industry and to all those economic operators that need protection for their intellectual property rights, as part of the valuable assets of their business. **MARQUES** has always strongly supported the CTM system and has promoted the accession of the European Community to the Madrid system of International registration of trademarks. However, it has always believed that the fact that rights owners have a number of choices for protection (national, regional and international) is highly beneficial as each product and each situation will differ and change over time. As the users expect the systems to offer the same excellent standards of service, **MARQUES** fully supports the OHIM's active role in contributing to the enhancement of the trademark systems in Europe, to promote further harmonisation within the Internal Market and to increase competitiveness. **MARQUES** in fact believes that the Office can have a very important role in fostering convergence amongst the offices, both in terms of IP practices and tools. Being itself an experienced administrator of registration systems, the Office may in fact take the lead by helping the coordination work behind the consultation of the users, to collect all of the users' views and concerns on one side, and interfacing these with the needs and realities at the national office level in both the EU and outside the EU (as well as with WIPO) on the other side, with a view of achieving a progressive approximation and harmonisation of the respective IP systems, methods of work and procedural practices. **MARQUES** considers in this regard that the OHIM's Cooperation Fund is an example of how the Office may work to create the required interoperability amongst the different systems in a transparent and controlled way. Sitting at the Administrative and Budget Board Committee as an observer, **MARQUES** has appreciated that the OHIM and the national Offices have been working together to improve the systems and raise the level of consistency and efficiency of various trade mark office practices (OHIM and national) to increase their progressive – in the end hopefully full - harmonisation. Subject to the introduction of specific legal provisions that would define a transparent framework of any cooperation, within specified projects and established time frames, e.g. in the same way as achieved through the Cooperation Fund projects, and avoid any kind of diversion into national state budgets, **MARQUES** would not object in the event that the cooperation between the Office and the national Offices should extend to funding activities of the national Offices, aimed at improving their work and efficiency and thus provable to produce effectiveness and to be really beneficial both for the systems and the users.

As to trade marks, a need of harmonisation is primarily – though not exclusively – felt in the following administrative and procedural law areas:

- Registration and examination procedures, favouring *inter alia* the full abolition of examination of earlier rights *ex officio*
- Classification and the use of class headings, favouring *inter alia* the more equitable interpretation of “means what it says”

- Opposition proceedings, favouring a pre-registration opposition procedure
- Opposition and cancellation proceedings available at the administrative level
- The harmonisation of the law and practice concerning the signs used in the course of trade, so called business identifiers, and especially company names and logotypes - to the effect that they can be the basis for opposition and cancellation proceedings
- Standards applied regarding the proof of genuine use of a trade mark
- Exhaustion

Particularly in the area of the territorial requirement for a CTM to be genuinely used in the Community, **MARQUES** sees one of the Office's challenges for the future, to lead the way to solve what it would seem an open conflict between a compelling demand for a progressive full harmonisation of the IP right protection systems in Europe on the one hand and a strive to strengthen national rights on the other hand. The notion behind the CTM system is the concept of a single market, which is the very essence of the European Union and shall be kept safe and intact. A single market means that there are no boundaries and borders: a Community Trade Mark is a unitary right. Using trademarks is about addressing markets, not states. The question whether use is sufficient to constitute genuine use must rely on all the circumstances relevant to establishing that the use is real. **MARQUES** appreciates that the Office has strongly supported the Commission and European Parliament in reaffirming the unitary character of the Community trade mark.

As to designs, **MARQUES** firmly believes that internationally harmonised and more efficient systems for protecting industrial designs would increase interest amongst users, facilitate a greater number of multi-jurisdictional filings, prevent loss of rights which may derive from divergent legislation and practice and raise the profile of industrial design law relative to more established areas of intellectual property law, all this to the mutual benefit of the users and the administrators. As the Office has successfully administered a simple and cost-effective design registration system, **MARQUES** appreciates that with its experience the Office may profitably support the discussions leading towards the harmonisation of industrial design law and practice, within the frame of its dialogue with WIPO on the promotion of activities linked to the Hague Agreement. With the same understanding, the newly built cooperation of the Office with the Trilateral Arrangements cannot but be welcomed and may in fact prove useful and effective, provided that there is a proper and correct basis of representation of the views of all of the concerned stakeholders.

In the area of the possible future new competences for the Office, **MARQUES** appreciates that OHIM also plays an important role in interacting and cooperating with the European Commission, particularly with respect to addressing the Commission and through this the EU legislators on the harmonisation issues. **MARQUES** in fact believes that the fast and efficient progressing of the harmonisation processes at the EU and the national levels represents the basic requisite to achieve the first and most cost- and time effective policy of IP rights enforcement. The efforts that the Office has spent and will spend in the future to build on the expertise in the area of enforcement by means of targeted educational and training programs (such as the seminar series for judges in the CTM and RCD courts in the EU member states), the creation of legal repositories of case-law, infringement cases and right holder directories for consultation

purposes by the IP enforcement authorities and the project of creating an OHIM Academy to group training and educational activities are fully supported by **MARQUES**. In this way, OHIM would certainly achieve the goal of becoming a true world-leading organisation in the field of Industrial Property.

As to a future involvement of the Office in cooperation programs with member states specifically aimed at the fighting counterfeiting and piracy, **MARQUES** would support those enforcement projects that may be developed for instance within the framework of specific and time-limited projects of the OHIM Cooperation Fund.

As to a future involvement of the Office in the Commission's Observatory on counterfeiting and piracy **MARQUES** would reserve itself an opinion, based on the outcome of the Commission's Study and a more comprehensive knowledge of the Office future strategic plans in this regard.

Focussing on the more institutional functions of the Office, in **MARQUES'** opinion, the main role and mission of the OHIM must still remain the fast, efficient and reliable delivery of title to IP rights. As a matter of fact, IP rights are a cornerstone of economic activity providing significant value to their owners and the wider wholesale and retail economy and this economic impact drives the need for IP rights to be protected effectively at both the domestic and international levels. In this sense, **MARQUES** fully agrees with the Office's mission statement that the mission of the Office is to manage the Community Trade Mark and Community Design registration systems.

We have been recently addressed and have considered with interest the contents of the OHIM's Work Program for 2011. We have noted that the Work Program sets out the strategic goals of the Office and also include key performance indicators. Amongst the most important strategic goals, we see the improvement of service standards and consistency of decisions and the increasing of efficiency in the official processes to improve productivity, so as to keep times on target and clear any existing backlogs. **MARQUES** gladly favours the Office's view that the Office shall also focus on building a strong organisational culture from the inside, thus spending efforts on motivating its entire staff to the betterment of the Office's performances at all levels.

In general, the accomplishment of a full e-Office system, with a view to simplify bureaucracy and develop more efficient and faster working methods between the Office and the users of both the CTM and RCD systems is certainly another goal which may be happily supported.

Overall, **MARQUES** finds that the above goals may be in line with the users' expectations on what the Office should primarily do. To the purpose of achieving said goals, **MARQUES** believes that the Office should especially focus its attention and efforts on the following objectives:

- Make sure that all its processes are run with an absolute transparency
- Increasing efficiency of the Office as in speed (decision making time), particularly in the opposition and cancellations procedures, and cost effectiveness:

- Increasing quality standards *vis-à-vis* consistency, predictability and quality of decisions, at both the examination stage and in *inter partes* proceedings
- Allowing users' full access to the same tools as made available to and relied upon by examiners in connection with the Office guidelines on Examination and Opposition procedures and the comparison of goods and services
- Safeguarding the principle of the freedom of choice of users in the utilisation of the tools and methods that the Office offers when they access the CTM or RCD registration systems: although it is a fact that there are new and simplified ways of doing business brought by the Internet age, and the electronic services may empower users and enable them to be more and more self-sufficient, the Office should still keep on securing the user's right to avail himself of any preferred methods – whether the traditional or the electronic methods - to access the services and communicate with the Office, so as to achieve the difficult yet equitable balance between the needs of those, especially SMEs, that may still prefer working in a more traditional way, and the very high expectations of those users demanding a fully and efficient IT-driven e-business solutions to interface with the Office.
- Ensuring well-timed and representative consultation of users before any prospected changes in the Office's practices and strategies which may affect the usage of the both the CTM and the RCD systems, in line with the Office's goal of maintaining close contacts with users, through the regular consultation of them and/or their major interest representative organisations.