

Max Planck Institute for Intellectual Property, Competition and Tax Law
Munich - Germany

Study on the Overall Functioning of the Trade Mark System in Europe
Meeting on 9 June 2010 - 9:00 - 16:00

The associations, who are observers to the OHIM Administrative Board and the Budget Committee, were present at the meeting: AIM, BusinessEurope, ECTA, INTA, and MARQUES. The OHIM was also represented and Mr. Eichenberg attended on behalf of the European Commission.

Prof. Annette Kur opened the meeting. She was joined by Alexander von Mühlendahl.

The Tender documents was used in parts in guise of agenda.

To what extent is there a need for further legislative approximation of Members States' national trade mark systems within the current scope of the TMD?

As was already mentioned yesterday the MPI is looking at the provisions that are optional at this stage to consider whether to make them compulsory or leave them as is.

AIM is asking whether MPI will not go into more "local" rules like difference in how oppositions are done in different NPTOs with the purpose of harmonisation.

MPI will not be going into national law, but on the other hand it could be useful for the MPI to have input from users. It was discussed if the 5 organisations would be able to put together a wish list for "harmonization items" before the beginning of summer and also what the MPI and the Commission would be able to do with such a list. It was discussed if a forum could be created where it would be possible to discuss these items. Perhaps something in the context of OHIM meetings and perhaps even funded by the OHIM surplus. It was agreed that in any case it would be very useful to have a listing.

It was again discussed how to have appropriate ways of dealing with lookalikes. Perhaps we could look at opening up discussion on whether definition of a trademark as an indication of origin or if this could be amended. The Commission gave information that the issue was on its agenda and that it is expected to be taken up by the unit of enforcement.

MPI signalled the fact that it is aware of the problem the transit rules cause and that this needs to be looked. The "hamper" of international trade was discussed and what could be done. The MPI would be interested in input from users and in looking for a solution to this complex discussion. We all agreed that the present situation is not satisfactory.

What should be the role and mission of national offices in the future?

What could be the benefits both for the OHIM and users of the CTM system to have the half of the renewal fees revenue going to Member States' national offices? What are possible disadvantages?

How and to which extent could it be ensured that these transferred funds are available to Member States' national offices and really used for the trade mark related purposes concerned?

What would be an appropriate key for distributing 50% of OHIM's renewal fees to the individual Member States?

There was some discussion of the situation of the national offices. We all agreed that the national offices are needed, but also that nothing is set in stone. It was discussed what will happen when and if and how the national offices will start to receive 50% of the CTM renewal fees. The OHIM pointed out that some of the harmonisation projects with national offices that are now funded directly out of OHIM's budget could "move" and become funded by the 50% renewal fees as one option.

MPI will not be giving a proposal to the Commission as to how the use of the 50% will be controlled. There was again a long discussion. The users need to come up with what they want as services from the 50% and it must be different from the projects that are covered by the Cooperation Fund.

It was suggested to create a role of IP zar at a European level/at the Commission to create a tight coordination of enforcement/anti-counterfeiting activities.

It was discussed whether a priority list should be created so that it would be ensured that all offices are made electronic before they can apply for funding of counterfeiting activities (as an example).

After lunch ideas for how to reduce the number of registered marks - without saying that there are too many by all – were discussed.

AIM suggested that maybe to offer an owner to get a refund of say EUR 500 if the registration was withdrawn before the end of the first 5 years or maybe at any time, fully or partial.

MARQUES brought up again the points of well-functioning opposition, cancellation and conversion procedures.

More ideas to create incentives to drop your registered rights were discussed.

There seemed to be agreement that we did not want declarations of use.

Regarding list of goods there seemed to be agreement that applicants could not use a wording 'all goods in class XX'. There seemed to be agreement that OHIM's practice on class heading was wrong.

Harmonisation was needed and especially in the way that the courts would interpret classes and lists of goods and services.

Conversion – there seemed to be agreement that it was necessary to create more clarity on how a conversion of CTM must be done. The fact that re-examination is done, was discussed and there seemed to be agreement that it did not make much sense for a national office to re-examine when OHIM had already conducted the examination.

Coexistence and acquiescence – there was a long discussion about how and why companies make coexistence agreements where they end up dividing the internal market between them.

There seemed to be agreement that it was best left to the economic partners to enter into these agreements for their own reason and for it not be regulated by any public body.

Coexistence should not be forced.

Examination of seniority claims and priority claims – the responses to Allensbach seem to show that users want more services. But we were in favour of keeping the present procedures.

Electronic tools like hyperlinks in CTM ONLIN to claims were discussed. Electronic solutions might solve the problem by giving the required information in only those cases where it was needed rather than make the CTM examination time longer for all applications.

Accelerated examination – there seemed to be agreement that examination times should be brought to a good level and then there should be equality for all. Noone spoke in favour of accelerated examination.

Acquired distinctiveness – the question was whether you have to show acquired distinctiveness for non-traditional marks in all member states (whereas for word marks you have to show only in

member states where that language is spoken). It was agreed that this would seem to be unduly hard.

Prof. Kur closed the meeting at 15.50.