




## FICPI INFORMATION DOCUMENT

### 3 JULY 2013

CET INFORMATION DOCUMENT	
<p>TITLE: <i>Report on the FICPI/OHIM bilateral Meeting, 3 July 2013</i></p> <p>DRAWN UP BY: <i>Commission d'Etude et de Travail (CET) Work &amp; Study Commission</i> <i>Andrew Parkes, CET Special Reporter, Trade Marks &amp; Designs</i></p> <p>PURPOSE: For information and publication in the library section of FICPI's website</p>	<p>QR CODE:</p> 

#### FICPI/OHIM BILATERAL MEETING, JULY 3, 2013

Present:

OHIM: Joao Negrao, Inge Buffolo, Marc Vannaken, Pedro Duarte, Luca Rampini; (for part of time) Carlos Ortega, Dennis Scheirs, Paul Maier

FICPI: Bastiaan Koster (BK), Francesco Paolo Vatti (FPV), Elia Sugranes (ES), Robert Watson (RW), Andrew Parkes (AP)

The meeting began at 15.15. Antonio Campinos, President of OHIM, was unable to attend as he had been delayed on a return journey from Croatia.

Joao Negrao gave an introduction to OHIM's recent activities. About 40% of the targets in the 2011 Strategic Plan have already been achieved. The number of CTM applications is increasing by about 2-3% this year. In the User Satisfaction Survey, 80% of respondents were satisfied or very satisfied with OHIM's performance. The new mediation service has received 4 cases, one of which has been settled. Construction of the new building alongside the existing Office has commenced. The European Commission has asked OHIM to implement IP co-operation programmes with China, SE Asian countries and Russia, on which the EPO was previously the agency for the EU. OHIM will do it in co-operation with the EPO.

Carlos Ortega gave a presentation about the Co-operation Fund projects, developing new tools, for which there is an overall budget of € 50 million and more than 300 people involved. 24 National Offices and 11 User Associations (including FICPI) have participated. e-filing tools for TMs and designs are going live in various countries. The Search Image project has recently been re-launched. A Common Gateway is being set up. Joao Negrao asked whether FICPI would put a link on its website to the Common Gateway.

Dennis Scheirs gave a presentation about the Convergence Programme projects, seeking convergence in practice and procedures where there are no legal constraints. 95 individuals from 25 National Offices are working on these projects. Agreement has been reached on harmonization of Classification of goods and services. The new Taxonomy, presenting a hierarchy of terms in the TM Class database, has been recently introduced. In response to a query from AP, it was confirmed that WIPO is also using the Taxonomy but its database contains less terms than OHIM's. AP pointed out that one of the aims of the Taxonomy project, to facilitate use of shorter terms by applicants, was also an encouragement to applicants to seek broader coverage than they might need. Dennis Schiers replied that it could work the other way, i.e. that applicants would work their way down the Taxonomy to more precise terms.

Work is continuing towards adoption later this year of a Common Communication saying which individual terms in the Nice Class headings are not considered to be clear and precise (as



required by the IP Translator judgement of the CJEU). A Common Communication has already been issued to summarise the ways OHIM and the National Offices are interpreting Class headings in the aftermath of the IP Translator case.<sup>1</sup>

Another group of Convergence Programme projects is studying absolute grounds of refusal for figurative marks, scope of protection for black & white marks (including issues of identity on priority claims and on proof of use) and questions of likelihood of confusion. AP pointed out that when FICPI raised the question of how to assess figurative marks containing a non-distinctive word at a previous Bilateral meeting, the discussion had turned to the provision in the CTMR for disclaimers, which OHIM has never used. AP asked whether this factor had been introduced by any of the national offices into the Convergence Programme considerations but the answer was that the programme had been defined and the discussion did not go beyond these definitions.

Convergence Programme projects cannot alter the law in any country but it is the hope that common practices will be reflected in manuals or the like in national offices.

Paul Maier introduced the work of the Observatory which was set up originally by the European Commission to bring together all those interested in fighting counterfeiting. It was taken over by OHIM in 2012 with a wider brief covering infringements of IP rights. They are studying how many people are employed in IP intensive industries, directly or indirectly, and how much added value (GDP) is created in those industries. They are also carrying out an opinion poll to question EU citizens about their perception of IP. RW suggested that they should look at National Office campaigns for increasing awareness of IP. Paul Maier replied that they did not know how successful these campaigns had been but they were including a repository for awareness campaigns on the Observatory website, as well as a library of studies and research on topics linked to IP and a knowledge platform for IP enforcers. They have taken over the enforcement database<sup>2</sup> which will be linked to a record of registered trade marks in Europe.

BK asked whether FICPI could have data relating to the work the Observatory has done on IP intensified industries in Europe as FICPI had a special commission working on the contribution of private attorneys in stimulating economic benefits of IP,. Paul Maier suggested making contact with OHIM's Chief Economist.

The Observatory wants active stakeholder participation. Stakeholders include EU Member States, European Commission and Parliament, EU and International organisations, private sector associations, consumers and civil society organisations. Among private sector associations there are some "legacy" stakeholders from the early days of the Observatory including national associations which would not be allowed to join now. BK mentioned James Fish's presentation in Geneva which had explained the role of private attorneys in Customs enforcement. FICPI would like to nominate a member to the Observatory. Paul Maier went through the criteria including registration in the EU Transparency Register which FICPI complies with. A formal request should be submitted. ES asked about participation in Working Groups. Paul Maier said that with AIPPI he had asked whether they could be represented by a member who was there on behalf of another organisation. In any case, if FICPI's request is accepted, FICPI would get an invitation to the Plenary and would get reports.

Paul Maier also spoke about the Academy which among its training functions is designing training sessions in collaboration with law enforcers' organisations. They are setting up a learning Portal (OALP). They organise an annual Judges' Forum, mainly for judges from the national courts which function as Community Trade Mark and Design Courts, and a Judges'

<sup>1</sup> The approaches by the various Offices are still quite divergent. AP wanted to ask a question about one aspect of the Tables in this Communication but this was deferred and eventually no opportunity arose.

<sup>2</sup> Previously a Co-operation Fund project



Symposium involving judges from the CJEU as well as some of the Advocates General, every 2 years. They have an OHIM/INTA Day each year with speakers from big company TM departments talking to examiners. This will be proposed as a webinar for national offices and for public access. BK asked about the possibility of introducing the attorney's point of view to examiners. Paul Maier answered that some of the INTA presentations were given by attorneys.

AP raised the long-standing question of collecting and translating national court decisions on CTMs and CDs. Paul Maier confirmed that this remains a problem. Most courts do not send them. OHIM could ask national offices but they are not optimistic. There are criminal court cases enforcing IP rights as well as civil court judgements. AP said that the cases of interest to practitioners are those which interpret the laws. BK said that FICPI could provide a single point of contact in each EU Member State through whom information could be routed.

After a coffee break, the meeting resumed at 18.15. Luca Rampini started a presentation about the process for updating OHIM's Manual and merging it with the more formal Guidelines. These will be open to review annually based on case law of the previous year. External users' input is important. In view of the late hour, the presentation was cut short but a written summary had been provided. In response to questions from AP, the timetable was explained. After a draft amendment has been prepared by the Knowledge Circle Working Party, it will be submitted to Users for comment. Although the draft will then be in the course of translation, the User's comments can be taken into account until the middle of the third month after circulation.<sup>3</sup> Otherwise they will go into the next year's review process.

With regard to Re-establishment of rights, FICPI had sent a further written submission to President Campinos on 28 June 2013, before the deadline for input to the relevant Working Party 2, but this had not yet reached Mr. Rampini. AP explained that the paper showed why the current wording of the Manual was not based on Court case law because it restricted the circumstances for *restitution* to those which are exceptional, unforeseeable **and** independent of the will of the person concerned. The Office had granted *restitution* only if there had been an event outside the control of the owner or representative but this was not the right place to draw the line if the decisions of the General Court were fully considered. The 2004 version of the Guidelines had set down the criteria as alternatives. Mr. Rampini said that FICPI had wanted the Office to consider the owner's intention but this was not possible. AP responded that the *BrainLab* case showed that the General Court took account of the fact that the CTM was the company's name and the Court found that there was a degree of likelihood bordering on certainty that the owner would give instructions to renew the mark if the Office had not sent its renewal notice to the wrong place. The owner's intention was one of the circumstances relevant to the overall circumstances of the case. Joao Negrao confirmed that as the FICPI paper had been received before the end of June, it would be considered in Working Party 2 starting work now in July.

BK spoke about recent FICPI activities, including a meeting in Luxembourg with the CJEU where the need for a specialised tribunal for TM and Design cases was raised. FICPI had held a symposium in China on Utility Models which were significant in IP protection there. The OHIM presentation about its new website at the Sorrento Forum was welcomed and it was agreed that OHIM would maintain a booth for the period of the Forum and would refer to this on its website.

Concerning the FICPI request for a revised Disclaimer on the Search screen for TMView and DesignView, Pedro Duarte said that OHIM agreed with the suggestions in general, particularly with regard to professional representation. They planned to introduce a link to the OHIM list of

<sup>3</sup> FICPI has until 13.09.2013 to submit comments on the draft from Working Party 1 which has recently been circulated



representatives. The position of any disclaimer on the screen was difficult. They were studying the possibility of a pop-up but this was uncertain. Joao Negrao commented that it would be necessary to discuss any changes with national offices.

On the European Commission's proposals for amendment of the CTM Regulation, Joao Negrao said that in general they regarded the technical provisions as good, providing more legal certainty. The governance proposals were more difficult. At the recent Administrative Board meeting, the unanimous position had been that the current system works well. FICPI is to send OHIM a copy of its paper when it has been sent to the European Parliament.

On the change from Rules to Delegated Acts of the Commission, the period for consultation remains the same – the Delegated Acts have to be adopted 18 months after finalisation of the Regulation. As agreed with BK, AP said that FICPI would be concerned if any further procedures<sup>4</sup> were to be excluded from the requirement for mandatory representation. Joao Negrao said that he was not aware of any such proposal.

RW raised the issue of the limit on the number of representations for an RCD, particularly if priority is being claimed from a US application having (say) 10 representations. Luca Rampini said that the additional representations are not disregarded and can be taken into account when considering priority. RW pointed out that under the law they can be disregarded by a court. It was agreed that legislative intervention would be needed. **FICPI would need to take this up with the European Commission.**<sup>5</sup>

Joao Negrao referred to the history of involvement of Users as Observers at the Administrative Board and Budget Committee. The current trial period will expire in 2014 and will be reviewed in the first semester next year. The Chair of the AB will be in charge of this. OHIM is in favour of having NGOs there.

On the WIPO SCT discussions on a possible Design Law Treaty, AP said that FICPI and the EU seemed to be in agreement on support for the Treaty which should have mandatory rules, not options.

The meeting ended at 19.15.

Andrew Parkes

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<sup>4</sup> Apart from filing of an application for the purpose of a filing date

<sup>5</sup> **EUCOF please note**