



Resolution of the Executive Committee, Berlin, Germany, 2-6 June 2003

“Consideration of Prior Trade Mark Rights in IP Offices”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Berlin, Germany, 2 and 6 June 2003, passed the following Resolution:

Having closely followed the discussions about consideration of prior trade mark rights by IP Offices which are processing a trade mark for registration,

Noting the proposal of the European Commission to delete the system of searches under Article 39 of the Community Trade Mark Regulation, which includes:

1. searches among prior Community Trade Marks and notification to the owners of the prior marks when the searched application is published, and
2. searches by those national IP Offices that decide to operate a search in their own registers,

Noting also that certain national authorities have been seeking expressions of view concerning possible ending of the system of *ex officio* examination and refusal of applications under their national law on the basis of prior registered marks,

Considering that awareness of the existence of conflicting trade mark rights is important to owners of both later marks and prior marks,

Considering also that private searching and monitoring of prior rights imposes cost burdens on small and medium-sized businesses,

Considering further that well-conducted and thorough official searches at the application stage provide valuable assistance to small and medium-sized businesses in avoiding adversarial proceedings later and in making the use of the trade mark system available to more businesses,

FICPI Resolves

(1) that IP Offices which currently undertake search and/or examination of prior rights, including IP Offices of states acceding to the European Community, should maintain those systems with, where necessary, an improvement in the quality of searches to meet the needs of small and medium-sized businesses for reliable consistent information, and

Further noting the different traditions of dealing with prior rights in various national systems,



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including:

- registration systems without any searching, examination or opposition at the IP Office, and leaving consideration of prior rights to the Courts,
- systems without searching or examination but allowing opposition at the IP Office by owners of prior marks before or shortly after registration of a later mark,
- systems with searching and opposition,
- systems with searching, *ex officio* examination/refusal, and opposition;

FICPI Resolves

(2) that the relevant international and national authorities engaged in discussion of convergence of trade mark practices should agree that the availability of opposition proceedings at the IP Office should be required as a minimum standard for dealing with prior rights.