

TM5 ANNUAL MEETING

BARCELONA, SPAIN, 30-31 OCTOBER 2012

JOINT STATEMENT

The Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Office for Harmonization in the Internal Market (Trademarks and Designs) (OHIM), the State Administration for Industry and Commerce (SAIC) and the United States Patent and Trademark Office (USPTO), (hereinafter referred to as the “Partners”) held their first “TM5” Annual Meeting in Barcelona, Spain on 30-31 October 2012.

For the first time, the Partners were pleased to welcome the Director General of the World Intellectual Property Organisation (WIPO), Mr. Gurry, who participated during part of the first day of the TM5 Annual Meeting. The Partners also welcomed the participation of three other colleagues from the International Bureau of WIPO, where their participation and contributions were appreciated in both the trade mark and design sessions.

For the third year in a row, user associations participated in the meeting. The user associations were represented from Europe, Japan, Korea and the United States.

The Partners reached the following conclusions:

Trademarks

The eight Project Briefs falling under the TM5 Overall Work Plan were discussed and agreed upon:

1. ID Project – led by the USPTO with the participating offices of JPO, KIPO, OHIM and SAIC
 - The Partners will consider developing rules regarding the wording of terms to be proposed
 - Further promotion and publicity will be made on the ID list
2. Common Statistical Indicators – led by the OHIM with the participating offices of JPO, KIPO, SAIC and USPTO

- The Partners will at working group level agree upon additions/deletions/modifications of the statistical indicators, as well as the method of their calculation and frequency of exchange
 - This process will be put forward for agreement at the next mid-term TM5 meeting
 - The Partners will look into developing a format, method and frequency for the exchange of filing forecasting data on trade marks and designs
 - Both the common statistical indicators and forecasting data will be exchanged by the next Annual Meeting
3. Common Status Descriptors – led by the USPTO, with the participating offices of JPO, KIPO, OHIM and SAIC
- A commonly accepted list of status descriptors will be developed and agreed upon
 - Guidelines for the application of these descriptors will be sought
 - Each office will develop a schedule for the expected implementation of common status descriptors
4. Continuation/Expansion of Bad Faith Project – led by the JPO with the participating offices of KIPO, OHIM, SAIC and the USPTO
- The Partners will share information on laws and regulations as well as their examination practices and issues regarding bad faith filings. The JPO will submit a questionnaire to the Partners to obtain this information
 - A comparative analysis of the laws and practices in each country/region will be conducted
 - The next seminar will be held in Tokyo on bad-faith trade mark filings focusing on the comparative analysis
 - It is contemplated that an outreach project for users on the topic of bad faith will be conducted
5. Image Search – led by the JPO with the participating offices of KIPO, OHIM, SAIC and the USPTO
- The Partners agreed to carry out a joint research to analyse the issues to be solved for having an effective and reliable image search system for figurative trade marks
 - A report will be presented at the next Annual TM5 Meeting
6. Taxonomy and Euroclass link – led by OHIM with the participating offices of the JPO, KIPO and the USPTO
- The USPTO and the JPO have their classification data integrated into Euroclass. KIPO will aim for integration by the end of 2012.

SAIC expressed interest in exchanging more information on Euroclass

- As a next step, a feasibility study will be carried out to apply the Taxonomy Tree to a list of goods and services determined by the TM5 participating offices

7. User-friendly access to trademark information – led by OHIM with the participating offices of the JPO, KIPO and the USPTO

- A feasibility study will be carried out in order to allow the TM5 partners to decide on the possible integration of their respective offices into TMview. The analysis will evaluate the necessary workload and resources (human, costs) and estimate a possible time frame needed for integration
- The USPTO has declared that it will integrate its data in TMview
- The OHIM has proposed a timeline schedule in the Work Plan for the USPTO and KIPO
- Implementation for USPTO will depend upon resolution of some technical issues
- The JPO will continue consideration and further analysis
- SAIC expressed interest for which further exchanges of information will be carried out
- The announcement was made on the enhanced collaboration between OHIM and WIPO on seeking the means of linking TMView with the Global Brand Database

8. Website – led by KIPO with the participating offices of the JPO, KIPO, OHIM, SAIC and the USPTO

- A website will be designed and created which will be available for Partners and users in January 2013
- At working group level, the next decisions to be decided upon focus on: the domain name; content; layout and frequency of updates

9. Session with users – led by the host country with the participating offices of JPO, KIPO, OHIM, SAIC and USPTO

The Partners agreed to aim to provide transparent information to user associations on the development and implementation of the projects.

The Partners had a lively discussion with users on the Overall Work Plan projects and other issues relating to our practices.

Designs

The Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Office for Harmonization in the Internal Market (Trademarks and Designs) (OHIM), and the United States Patent and Trademark Office (USPTO), (hereinafter referred to as the “Design Partners”) participated in the first “TM5” Annual Meeting in Barcelona, Spain on 30-31 October 2012.

The Design Partners discussed their law and practice on Graphical User Interface (GUI) and icons protection at the respective Offices. Additionally, KIPO presented its own practice and law requirements for designs application in CAD format.

The Design Partners continued exchange of information about their respective drawing and view requirements and discussed the possibility of preparation of a comparative catalogue which could be helpful for all users filing design applications in all respective countries and territories (USA, South Korea, Japan and European Union) which may serve as a basis for further discussion about the potential for simplification and convergence of drawing and view requirements.

The Design Partners agreed to create a working group and to launch a project to prepare such a comparative catalogue in order to present it at next year’s Annual Meeting. The project brief should be approved by the Design Partners no later than the next TM5 Mid Term Meeting in May 2013. The OHIM agreed to take the lead of the project.

The Design Partners informed each other about their practice regarding electronic priority document exchange. WIPO presented its Digital Access Service (DAS) for Priority Document exchange.

All Design Partners agreed to analyze their abilities and interest in using DAS for Designs and inform each other of their findings by the next TM5 Mid Term Meeting in May 2013.

The Design Partners updated each other on their Hague Agreement accession and/or implementation efforts.

The Design Partners agreed to continue the exchange of common statistical indicators.

Possible areas for future discussion at the TM5 Annual Meeting in 2013

- The Design Partners agreed to discuss the catalogue drafted by the working group and explore the potential for simplification and convergence of drawing and view requirements
- The Design Partners agreed to update each other on Hague Agreement accession and/or implementation efforts
- The Design Partners agreed to update each other on the latest amendments to their Design legislation
- The Design Partners agreed to discuss the quality review systems applied in their offices for Design Examination processes
- The Design Partners agreed that depending on the outcome of their analysis regarding DAS they would continue to work on the issue of Priority Document exchange
- As a result of the user session the Design Partners agreed to discuss the “grace period” practice in each office
- As a result of the user session the Design Partners agreed to discuss the further enhancement of the design search system

2013 TM5 Secretariat

- All Partners agreed that KIPO will act as the secretariat for the 2013 TM5 meetings.