TM5 ANNUAL MEETING

Seoul, Republic of Korea, 5-6 December 2013

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 the 2013 TM5 Annual Meeting in Seoul, Republic of Korea on 5-6 December 2013.

The World Intellectual Property Organization (WIPO) was present as an observer, as it had been at the previous TM5 meeting. In addition, representatives of various user associations participated in the open session of the meeting. That session was productive and useful.

During the Meeting, the Partners exchanged views and information on practices and programs, as well as on common projects aiming at promoting cooperation and collaboration among the Partners and con tributing to increasingly user-friendly trademark systems.

The Partners reached the following conclusions:

Trademarks

1. Continuation/ Expansion of Bad Faith- led by the JPO with the participating offices of KIPO, OHIM, SAIC and USPTO

   - The Partners agreed that JPO will host a seminar on bad-faith filing on the margins of the upcoming INTA annual meeting in Hong Kong, in May in 2014. JPO will extend invitations to each of the four TM5 partners.
   - The Partners agreed that at the upcoming mid-year meeting of the TM5 in Hong Kong, the JPO will present a draft Report on the TM5 partners' respective laws and examination practices that pertain to bad faith filings. The partners further agreed that JPO will present a proposed final version of that Report at the annual TM 5 meeting in 2014.
   - The Partners noted that, before JPO finalizes its Report, certain of the Partners' relevant laws and/or examination guideline may be amended. If that occurs, the Partner in question, may, as appropriate, either revise the answers it provided to the questionnaire that was the basis for the Report, or clarify that the law or examination guideline referred to in the questionnaire will come into effect on a particular date. The final Report that JPO will issue will reflect any such revisions or clarifications.
   - Concerning that questionnaire, the JPO will provide the Partners with copies of the responses it received from each of the Partners by the end of 2013.

2. Image Search- led by the JPO with the participating offices of KIPO, OHIM, SAIC and USPTO

   - The Partners agreed that the Image Search Project is useful and it should be continued.

- Future discussions regarding image searching may be devoted to identifying – and discussing possible solutions to – problems that arise in the area of image searching. In addition, those Partners that are developing image search systems may wish to share their experiences.
- The Partners agreed that the JPO will host a working-level meeting in Japan in March or April of 2014, at which Partners can share information, and at which JPO may present its interim report on image searching.

3. <u>Common Statistical Indicators</u>- led by the OHIM with the participating offices of JPO, KIPO, SAIC and USPTO

- The JPO, the KIPO, the OHIM and the SAIC may exchange data once a year on a calendar year basis, in January of each year. In addition, the USPTO may provide its data based on its fiscal year, which commences on October 1 of each year.
- With regard to KPI 1(Trademark Application), the OHIM may choose to provide data regarding filings at both OHIM and at the EU National Offices.
- The Partners agreed that it could be beneficial to conduct working-level discussions on the statistics, including discussions on how to provide data regarding the number of examiners at each Partner office. Such discussions could be helpful, since the various Partners may define the term "examiner" differently.
- The Partners will share their own forecast estimate on the condition that it is used for internal purpose. In addition, the Partners may determine whether they wish to share the information regarding forecasting methodologies.
- Statistical indicators will be published in the TM5 website.

4. <u>User-friendly access to trademark information</u>- led by the OHIM with the participating offices of JPO, KIPO, SAIC and USPTO

- OHIM reported that trademark data from the USPTO and the KIPO will be searchable in TM view in December 2013. In addition, the feasibility study of JPO and SAIC will be carried out in 2014.

5. <u>Common Status Descriptors</u>- led by the USPTO, with the participating offices of JPO, KIPO, OHIM and SAIC

- The Partners agreed that each would adopt proposed levels 0 and 1 of the descriptors.
- In addition, by January 15, 2014, the Partners will provide views on: the remaining proposed levels, on the visual status "ICONS" that the USPTO proposed, on the meaning of the term 'dismissed' in level 2, and on whether KIPO's proposals with respect to use of the terms 'invalidated' and 'abandoned'.

6. <u>TM5 Website</u>- led by the KIPO, with the participating offices of JPO, USPTO, OHIM and SAIC.

- The Partners noted their appreciation of the TM5 web site, and noted as that the web site can be of great use in enhancing cooperation among the Partners and in assisting users.
- The Partners agreed to launch the website as soon as possible, and to provide feedback on the proposed "TM5 Website Operation Regulation" and on the interface, by December 20, 2013. The KIPO expects to launch the web-site in the beginning of 2014.

7. <u>Taxonomy and TMClass link</u>-led by OHIM with the participating offices of JPO, KIPO, SAIC and USPTO

- The Partners agreed that the technical meeting in Washington D.C was very useful and agreed to hold additional technical meetings if all agree that such meetings are both feasible and appropriate.
- The OHIM noted that the Taxonomy project is not yet completed, and assured the Partners that once the structure of taxonomy is agreed to, the OHIM will not change that structure without the agreement of the Partners.
- In the future, OHIM will provide the Partners with information regarding consultations on Taxonomy that it may conduct with other organizations, including WIPO.
- The JPO proposed to provide Japanese translations to contribute to the development of TMclass and the Partners welcomed that proposal.

8. ID list- led by USPTO with the participating offices of JPO, KIPO, OHIM and SAIC

- The Partners agreed to adopt the proposal that, when rejecting a proposed new entry to the ID list, each Partner will signify the basis for its rejection by selecting one of the eight grounds for rejection identified at the technical meeting held in Washington in October in 2013.
- The Partners agreed to invite IP offices from the ASEAN region to participate in the project, and further agreed that the USPTO, as the lead office, would send letters of invitation to such offices.
- The Partners agreed that it would be helpful to conduct working-level discussions regarding the Draft Rules of Governance for the ID list project and the text of the Memorandum of Cooperation that memorializes the participation of non- TM5 members in the effort.
- The Partners accepted the JPO′s proposal to invite WIPO to consider integrating the TM5 ID list into WIPO′s goods and services manager.

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

- At the session for representatives of user organizations, KIPO introduced fifty one attendees from groups including GRUR and ICC(OHIM), JIPA, JPAA, JTA(JPO), KOTA, KINPA, KAPP(KIPO), ABA, AIPLA, INTA, IPO(USPTO). There were approximately forty questions from users.
- The Partners noted that a central purpose of their joint work and of the annual meetings, was to benefit their users. The Partners further agreed that at future meetings, they should allow additional time for sessions with users.

The following new projects were presented and discussed.

10. Comparative Analysis on Examination Results- proposed by KIPO

- The KIPO assured that the objective of this project was not the harmonization of each partner's laws, practices. In addition, it confirmed that the partners will discuss and agree upon the subjects, detailed categories and the number of cases to be analyzed by the Partners.
- The Partners agreed that the project would be beneficial to both the Partners and to users. The Partners adopted the KIPO′s proposals, with the understanding that the precise details of the project would be explored and agreed to at the working level. The Partners furthered agreed to cooperate with the KIPO in implementing the project, and agreed that they would discuss the details of such implementation, including the appropriate uses of the data to be gathered.

11. Improve Convenience of Applicants of the Madrid Protocol by Enriching Information Provision- proposed by the JPO

- The Partners welcomed this proposal, and agreed that they should conduct additional discussions regarding the proposal. In particular, the Partners agreed to conduct further discussions during the next mid-term meeting in 2014, and to provide views to the JPO in advance of that meeting.

Discussion on TM5 Cooperation

1. Project Maintenance

- The Partners welcomed the OHIM's proposal on project maintenance, and also agreed that the Partner Office that is responsible for maintaining a particular project should craft project maintenance plans whose form and content is based on characteristics of the project in question.

2. Proposal on Operating TM5 Working Group

- The Partners welcomed the proposal by the KIPO to form Working Groups and decided to have Working Group meetings, in cases where such meetings are appropriate and feasible.
- The Partners will also explore which means might be appropriate for conducting particular working group meetings, such as digital videoconferences.
- At the 2014 mid-term meeting, the Partners will discuss how best to organize and operate the different working groups, and the details regarding any meetings they may wish to convene.

2014 TM5 Secretariat

- The Partners agreed that JPO will act as the secretariat for the 2014 TM5 meetings.

Design

The Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Office for Harmonization in the Internal Market (Trademarks and Designs) (OHIM), the United States Patent and Trademark Office (USPTO) (hereinafter referred to as the "Design Partners") and World Intellectual Property Organization (WIPO) participated in the "TM5" Annual Meeting held in Seoul, the Republic of Korea on 5-6 December 2013.

The OHIM as the lead office of design drawing and view catalogue project presented a draft of the catalogue and raised possible issues on the follow-up plan for the project.

The Design Partners discussed the maintenance method and the possibility of publication for users filing design applications in all respective countries and territories (the United States of America, the Republic of Korea, Japan and the European Union) as well as international design applications with WIPO.

The Design Partners agreed to refine the current draft of catalogue by March 1, 2014 and decide whether and how it is shared with users no later than the next TM5 Mid-term Meeting.

The Design Partners updated each other on the latest amendments to design legislation. Additionally, the JPO shared a recent design-related court case with other partners.

The Design Partners informed each other of their Hague Agreement accession and/or implementation efforts.

The Design Partners exchanged information and views on the design system and practices in their respective offices and discussed specific issues (DAS for Designs, grace period, design search system, examination quality review system and registrability of minimalist design and architectural design).

The Design Partners agreed to decide to consider the project proposed by the KIPO (development of a design registrability/patentability comparison report) at the next TM5 Mid-term Meeting. KIPO offered to take the lead of this project and share a project brief.

The Design Partners discussed the impact of other design jurisdictions outside of the Design Partners.

Possible areas for future discussion at the TM5 Annual Meeting in 2014

● 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 to discuss the further enhancement of the design search system.
● The Design Partners agreed to discuss the possible use of electronic priority document exchange via DAS in the future.