

## **TM5 Annual Meeting**

**Alexandria, Virginia, December 1-2, 2015**

### **Joint Statement**

The Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Office for Harmonization in the Internal Market (OHIM), the Trademark Office of 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 2015 TM5 Annual Meeting in Alexandria, Virginia, between December 1<sup>st</sup> and 2<sup>nd</sup>, 2015.

The World Intellectual Property Organization (WIPO) was present as an observer, as it had been at the previous TM5 meeting.

At this meeting, the Partners exchanged views and information on common projects and new project proposals.

During the Meeting, the Partners held a user session on TM5 projects for representatives of various user associations.

1. The following 11 projects<sup>1</sup> were discussed and agreed:
  - a. TM5 Website: led by KIPO.
    - i. KIPO reported on the progress of the project and the outcomes of the modification of the website interface for user convenience and better function.
    - ii. The Partners agreed to continue to provide new information or materials to be uploaded and to promote the website.
    - iii. KIPO is pleased to receive proposals about possible improvements to the existing TM5 website.
  - b. ID List: led by USPTO.
    - i. The Partners agreed to amend the ID List Memorandum of Cooperation (MOC) to include a counterparts clause to allow for separate signature pages and to subsequently re-execute the MOC with Chile in an expeditious manner.
    - ii. The Partners agreed that the USPTO would change the ID List voting website to impose a monthly limit of 150 submissions to TM5 partners and MOC Offices combined, to be reviewed periodically.
    - iii. The Partners agreed to send invitations to Ukraine, Turkey, Morocco, Algeria, UAE, South Africa, OAPI, ARIPO and India and to continue discussing inviting new MOC Offices to participate in the ID List Project.
  - c. Taxonomy and TMClass link: led by OHIM.

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<sup>1</sup> All partners participate in each of the 11 projects.

- i. OHIM reported on the progress of the project and the outcomes of the working group meeting in July, 2015.
  - ii. The Partners agreed to implement additional functionalities in the TM5 ID List search tool, including functionalities regarding translations.
  - iii. The Partners agreed to continue with the review of the Taxonomy structure and to invite interested users to help in this review.
  - iv. The Partners agreed to hold the next classification technical meeting in July 2016, location to be determined.
- d. Improve Convenience of Applicants of the Madrid Protocol by Enriching Information Provision: led by JPO.
  - i. The Partners agreed on the information on Madrid Protocol procedures for each TM5 Office stated in the standardized format.
  - ii. The Partners agreed that JPO will disclose the information on Madrid Protocol procedures for each TM5 Office stated in the standardized format on the TM5 Website with cooperation from KIPO.
  - iii. The Partners agreed that JPO will consider enhancing the information (content) to be provided in the standardized format and consider effective ways of using the format, in cooperation with WIPO.
- e. User-friendly access to trademark information (TMview): led by OHIM.
  - i. OHIM reported that trademark data from the USPTO, KIPO and JPO have been searchable in TMview since December 2013, February 2014 and November 2015 respectively.
  - ii. OHIM will support integration of Chinese data to complete the project.
- f. Continuation/Expansion of Bad Faith Project: led by JPO.
  - i. The Partners agreed on compiling a collection of case examples on bad faith trademark filings.
  - ii. In addition, the Partners agreed on collecting the latest bad faith trademark filings in each TM5 Office and holding a seminar to introduce the bad faith trademark filings on 1 March 2016 in Tokyo to broadly share the information with users.
- g. Comparative Analysis on Examination Results: led by KIPO.
  - i. KIPO reported on the progress of this project as follows:
    - 1. KIPO forwarded the list of the 150 cases which contained grounds for provisional refusals (if a provisional refusal was issued) and examination results;
    - 2. The Partner Offices selected 50 cases; and
    - 3. A pilot study is currently underway.
  - ii. KIPO proposed that the Partner Offices provide KIPO with comments on items to be reviewed and complete the pilot study by the end of this year; furthermore, KIPO also suggested that Partner Offices complete the study on the selected 50 cases by March 2016.
  - iii. KIPO appreciated the Partner Offices' continued support for this project.

- h. Common Statistical Indicators: led by OHIM.
    - i. OHIM distributed the overview of all received statistics from the Partners regarding the year 2014.
    - ii. The Partners agreed to provide data for the preceding calendar years in a timely manner as agreed in the maintenance report. Data on all indicators will be filled in as completely as possible. The reason for not having been able to do so will be noted for each indicator.
    - iii. The Partners agreed to hold a mid-term work session in order to discuss the existing indicators and enhance the ability to compare them. This session could be bilateral via video conference if deemed opportune.
    - iv. The Partners agreed to revise the indicators which will include deletion of design indicators from this project.
  - i. Common Status Descriptors: led by USPTO.
    - i. The Partners agreed to continue their work on implementation of the common status descriptors' wording, including conducting a video conference to discuss our implementation efforts.
    - ii. The Partners agreed to continue to undertake work on future enhancements, such as the design, choice, and method of utilization of icons.
  - j. Image Search: led by JPO.
    - i. The Partners agreed that JPO will continue to collect the latest information on measures taken in each Partner Office regarding the image search system.
    - ii. The Partners agreed to create opportunities such as expert meetings to share the information collected.
  - k. Indexing of Non-Traditional Trademarks: led by USPTO.
    - i. The Partners agreed to appoint members to the working group and for the working group to undertake work to: a) ensure the accuracy and completeness of the questionnaire answers, and b) define a non-exhaustive list of the different types of non-traditional marks. After the list has been defined, the working group will consider how to devise a consistent way of indexing non-traditional marks.
2. The following three proposals were discussed and agreed:
- a. User Association Involvement, proposed by OHIM and JPO.
    - i. The Partners approved this proposal as a TM5 project and they also approved a revised draft of this Project Brief, which was proposed jointly by JPO and OHIM.
    - ii. For on-going projects, the lead offices of the TM5 projects will assess the form of user participation in their respective projects and make proposals to the other TM5 partners.
    - iii. For new projects, the Lead office will include a proposal on user participation in a specific section of a given project brief when seeking approval from the other TM5 partners, in accordance with the agreed guidelines.
  - b. Provide Information how to describe product names for users, proposed by KIPO.

- i. KIPO explained that the aim of this new project is to enhance user convenience in identifying goods and services by providing the Partner Offices' descriptions of acceptable goods and services, and then posting the collected information onto the TM5's public website.
    - ii. Agreeing to proceed with KIPO's initiative as a sub-project of the TM5 website, the Partners officially approved it as a TM5 cooperation project.
  - c. Amendments to the Rules of Governance to Remove Industrial Designs
    - i. The Partners agreed to continue their discussions at a working-level about how to amend the Rules of Governance to remove industrial designs.
- 3. Sessions with User Representatives-led by USPTO, with JPO, KIPO, OHIM, and SAIC participating.
  - a. The USPTO introduced approximately 17 user attendees from groups including AIPPI, EURATEX, ABA, AIPLA, FICPI-U.S., IPO, INTA, and the U.S. Chamber of Commerce. There were approximately 22 questions from users regarding Office Updates and approximately 12 questions regarding the TM5 projects.
- 4. 2016 TM5 Secretariat
  - a. The Partners agreed that SAIC will act as the secretariat for the 2016 TM5 meetings.

This Joint Statement does not create any legal obligations under international or domestic law.