

## **TM5 ANNUAL MEETING**

**Kunshan, Jiangsu, China, October 28-29, 2016**

### **JOINT STATEMENT**

The European Union Intellectual Property Office (EUIPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Administration for Industry and Commerce of China (SAIC), and the United States Patent and Trademark Office (USPTO), (hereinafter referred to as the “Partners”), held the 2016 TM5 Annual Meeting in Kunshan, Jiangsu, China, between October 28<sup>th</sup> and 29<sup>th</sup>, 2016.

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 proposal as well as on their respective operational practices with the theme of “Effectively Restrain Bad-faith Trademark Registration”.

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

1. The following 13 projects<sup>1</sup> were discussed and agreed:

1) TM5 Website: led by KIPO.

- KIPO reported on the progress of the project and the outcomes of the modification of the website interface for user convenience and better function.
- The Partners appreciate KIPO’s efforts and achievements, and agreed to continue to provide new information or materials to be uploaded and to promote the website.

2) ID List: led by USPTO.

- The volume of ID List terms is continuously increasing, and all Partners are diligently fulfilling their duties of voting on-line.
- New Zealand, Australia, Vietnam, Peru, Brazil, Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, Thailand, Turkey, Morocco, Algeria, United Arab Emirates, India, South Africa, OAPI and ARIPO have been invited to participate in the MOC.
- Technical Guidelines for New Term Proposals are now available in the User Guide on the voting web site.
- USPTO is still further enhancing the voting web site, and the Partners appreciate USPTO’s efforts and achievements

3) Taxonomy and TMClass link: led by EUIPO.

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<sup>1</sup> All Partners participate in each of the 13 projects.

- EUIPO reported on the progress of the project and the follow-ups of the Midterm Meeting and the Experts Meeting in July, 2016.
  - EUIPO proposed the timeline for the review of Taxonomy structure, the Partners agreed on the timeline with the exception of USPTO who still requires more information and further discussion.
  - EUIPO reported on the briefs and proposed timeline of the User Survey on Taxonomy Structure. The Partners agreed on the timeline and follow-ups.
  - EUIPO reported on the update of TM5 ID List Search Tool. The Partners agreed on the changes and the next steps, in particular with regard to the translation of the ID List terms to be provided by SAIC, JPO and KIPO.
- 4) Improve Convenience of Applicants of the Madrid Protocol by Enriching Information Provision: led by JPO.
- JPO reported on the progress of the project after the last Annual Meeting, including posted on the “TM5 Website” the information on national filing procedures under the Madrid System at each of the TM5 Offices, by using the format approved by the Partners.
  - The Partners agreed on JPO’s proposal that the above mentioned information together with information of other Madrid Protocol member countries will be provided through the Madrid Member Profile Database which is being developed by WIPO.
  - The Partners agreed that JPO will check the progress on development of Madrid Member Profile Database at the WIPO and share the progress information with other TM5 Offices.
  - The Partners agreed that after Madrid Member Profile Database is completed, JPO will inform the Partners to that effect and obtain official approval from the Partners to conclude the Project at a TM5 Midterm or Annual Meeting.
- 5) User-friendly access to trademark information (TMview): led by EUIPO.
- EUIPO reported on the progress of the project, which showed that the project is moving forward steadily.
  - EUIPO is initiatively advancing the integration of SAIC data and will further communicate with SAIC on the details of integration.
  - EUIPO and SAIC will work together to complete the integration as early as possible.
- 6) Continuation/Expansion of Bad Faith Project: led by JPO.
- JPO reported that the “Case Examples of Bad-Faith Trademark Filings” is in progress. At present, JPO is collecting case examples (10 examples per Office) from the Partners and asked for their continued cooperation.
  - The Partners agreed to upload the case examples to TM5 website.
  - The Partners agreed on JPO’s proposal that after the completion of the “Case Examples”, it will publicize the “Case Examples” at the INTA Annual Meeting (May 2017) as well as publish them on the TM5 website.
  - The Partners agreed on JPO’s proposed plan for the next steps on the “Case Examples of Bad-Faith Trademark Filings.”
- 7) Comparative Analysis on Examination Results: led by KIPO.

- KIPO reported on the progress of the project. The pilot study of the cases is completed and the main study is currently underway. The Partners have already provided their opinion on the general questions.
  - The Partners agreed on KIPO's plan to finish the report by mid-December and publish the report on TM5 website by the end of 2016.
  - The Partners agreed on KIPO's plan to discuss during the 2017 TM5 Midterm Meeting whether to carry on a study with another 50 cases.
- 8) Common Statistical Indicators: led by EUIPO.
- EUIPO reported that due to the delay in collecting data from the Partners, the original timeline could not be met.
  - SAIC expressed the unavailability of data at present due to IT transformation reason.
  - The Partners agreed to establish a new timeline concerning data compilation and graphics preparation.
  - The Partners agreed to JPO's proposal of first publish the data of the other 4 Offices, while add SAIC's data when available.
- 9) Common Status Descriptors: led by USPTO.
- The Partners agreed on the common status descriptors chart and the corresponding definitions, as well as the accompanying icons.
  - The Partners are in process of deploying common status descriptors. JPO has deployed in a test environment, and EUIPO will deploy on November 5, 2016.
  - The Partners agreed to continue to implement the common status descriptors' wording and the icons.
  - The Partners agreed to consider inviting other national trademark offices to implement the common status descriptors.
- 10) Image Search: led by JPO.
- JPO reported on the progress of the project and introduced the survey<sup>2</sup> on image search.
  - The Partners agreed on JPO's proposal that it would continue to collect information on the initiatives taken in each Partners as well as share the collected information on appropriate occasions such as expert meetings.
  - The Partners agreed that JPO would provide the Partners with opportunities to share information on the progress of development of image search systems and the WIPO Global Brand Database, such as by holding expert meetings.
- 11) Indexing of Non-Traditional Trademarks: led by USPTO.
- USPTO reported that the Working Group will convene electronically in the near future, and is reviewing questionnaire responses for accuracy and completeness, as well as discussing different types of non-traditional trademarks.
  - The Partners agreed that the Working Group will convene electronically to define a non-exhaustive list of the types of non-traditional trademarks, and consider how to

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<sup>2</sup>In September 2016, the JPO conducted a survey on the TM5 Partners for the purpose of collecting information on the existing figure trademark examination system and on how the Partners are handling the issues regarding the image search system.

devise a consistent way of indexing non-traditional trademarks after the list has been defined.

12) User Association Involvement: led by EUIPO and JPO.

- EUIPO and JPO reported that the project is moving forward steadily.
- EUIPO planned to complete the User Association Involvement Pilot Survey of Taxonomy as early as possible.
- The Partners agreed that EUIPO will prepare the circular letter for User Associations that can be used by the Partners; the Partners will translate the survey and send out invitations to the survey to User Associations. The results of the survey will be distributed to Partners before the 2017 Annual Meeting and EUIPO will report on the survey results during that meeting.
- The Partners agreed on JPO's proposal of holding the 1<sup>st</sup> Joint Workshop with User Associations, as well as the proposed timeline and other organizational matters of the 1<sup>st</sup> Joint Workshop.
- The Partners agreed on JPO's proposal that it would publicize the "Case Examples of Bad-Faith Trademark Filings" at the 1<sup>st</sup> Joint Workshop to be held in cooperation with the user associations at the INTA Annual Meeting (May 2017).

13) Provide Information how to describe product names for users: led by KIPO.

- KIPO reported on the progress of the project that all Partners have provided comments on general and specific information with KIPO, and some Partners have provided comments on the 100 terms of pilot study.
- KIPO reported the current study result of the project.
- The Partners agreed that KIPO will finish the final report concerning general and specific information by the end of November and publish the report on the TM5 website by the end of this year.
- The Partners agreed on KIPO's proposed timeline of finish the main study of more specific information in 2017.

2. The following theme was discussed and agreed:

○ Amendments to the Rules of Governance

- The Partners agreed on USPTO's proposal to change "Office for Harmonization in the Internal Market (OHIM)" into "European Union Intellectual Property Office (EUIPO)".
- The Partners agreed USPTO's proposal to remove references to industrial designs.
- The full name and acronym of SAIC in the text of the Rules of Governance is still to be further discussed.

3. The following project proposal was discussed:

○ Quality Management for Trademark Examination

- JPO explained the objective of the project, which is to enhance mutual understanding and trust by exchanging information on respective quality management systems and relevant initiatives.
- JPO introduced the draft measures of the project.

- USPTO, KIPO and SAIC supported JPO's proposal to submit a project brief during the 2017 Midterm Meeting. EUIPO required some more time to reflect on the proposal.
4. 2017 TM5 Secretariat
    - The Partners agreed that EUIPO will act as the secretariat for the 2017 TM5 meetings.
    - The Partners agreed in principle on EUIPO's proposal of holding the Midterm Meeting in late May, the Annual Meeting in late 2017 and the Experts Meeting in July.
    - The place of the Experts Meeting is still to be discussed.
  5. WIPO's participation in the Experts Meeting
    - The Partners basically agreed that WIPO will act as a Standing Observer in the subsequent Experts Meetings on Goods and Services in addition to being Standing Observer at the Annual Meeting.
  6. Opinions regarding the Content of the 2017 TM5 Annual Meeting
    - JPO proposed that the TM5 Partners could reconsider the method of conducting Annual Meetings in order to thoroughly discuss individual projects by taking measures such as (i) extending the meeting period to three or four days, (ii) limiting the number of projects to be included in the agenda, and (iii) utilizing expert meetings to lighten the burden of Annual Meetings.
    - The Partners agreed to consider the issue until the 2017 Annual Meeting.
  7. Sessions with User Representatives
    - A face-to-face Q&A exchange session was organized, and approximately 20 user representatives from Associations including INTA, CTA, JPAA, JIPA, MARQUES, ACC, IPO, etc. attended the session.
  8. Symposium on "Effectively Restrain Bad-faith Trademark Registration"
    - Representatives from the Partners exchanged the legal framework and practices of each Office against bad-faith trademark registration.
    - Representatives from academy, enterprises and trademark attorneys introduced their opinions and practices concerning bad-faith trademark registration.

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