

13 July 2011

Mr. António Campinos
President, Office for Harmonization in the Internal Market
Avenida de Europa, 4
E-03008 Alicante, Spain

Dear Mr. Campinos:

Thank you for your 21 June letter informing us of the forthcoming Convergence Programme, which will support the recently published Strategic Plan's fundamental initiative to foster the harmonization of practices among EU trademark offices.

INTA welcomed the opportunity to share our input when the Office was drafting the new Strategic Plan. In our February contribution, we stated there was an opportunity to achieve further consistency between OHIM and EU national offices by developing procedures that would encourage more predictability, uniformity and quality examination operations within the EU. We are therefore pleased that such harmonization will be facilitated by the new Convergence Programme.

We agree that the model used to set up and execute the various projects of the Cooperation Fund will be useful in implementing the Convergence Programme projects. INTA's volunteers in the Cooperation Fund's Packet 1 working groups have found the process to be efficient, transparent, and rewarding. We therefore look forward to applying and participating in the future Convergence Programme working groups in due course. We understand that the working group on class headings is already underway, and if there is a possibility for users' groups to participate in this particular task, we would like to nominate Peter Gustav Olson, a member of our OHIM Subcommittee.

As for our preferred Convergence Programme projects, it is difficult to make a general statement as to which projects would be of the most benefit to INTA's membership. Certainly, there is a great deal of diversity in the needs of users (not just between trademark owners and agents, but also between industries). There will naturally be different views as to what is most important and most desirable. However, that being said, our OHIM subcommittee members have expressed preferences for the following projects:

- 1) *Convergence of Practice of how to assess the visual, aural and conceptual similarity between two trademarks in the context of the examination of relative grounds for refusal.*
- 2) *Convergence of Practice of the examination of absolute grounds for refusal as regards figurative trademarks with purely descriptive/non-*

distinctive words/expressions (when does the figurative element carry the trademark distinctiveness)

- 3) *Convergence of Practice of how to deal with non-distinctive/weak components of trademarks in the context of the examination of relative grounds for refusal (likelihood of confusion).*
- 4) *Convergence of Practice of the scope of protection of trademarks exclusively in black, white and/or (shades of) grey (do they cover any/all colours or not?)*

We also inquire whether OHIM will involve the judicial bodies which review appeals on decisions from EU national trademark offices. Having them participate in addition to the IP offices could further ensure that the adopted common practices will also be accepted by the judicial bodies in Member States.

As for the anticipated timeline of the work plan, we suggest that there be a provision to allow for an extension of the programme's projects, if necessary.

We hope our comments are helpful as you proceed in setting up the Convergence Programme. We look forward to the next stage, and to taking an active role in the working groups. In the meantime, if you have further questions or need clarification, please contact Carla Schwartz at cschwartz@inta.org.

Yours sincerely,



Gerhard Bauer
President