

Sent via email on July 7, 2010 to Professor Annette Kur at MPI

INTA suggestions for MPI's further consideration to reduce inconsistencies

Potential modifications for the Trade Mark Directive TMD:

- Assignment of trademarks: The TMD does not contain any provisions regarding the transfer of trademark rights and this could be further considered. The following areas might be harmonized:
 - (1) Does an assignment agreement need to be in writing in order to be valid?
 - (2) Is it necessary to have a trademark assignment recorded with the national trademark register? What are the consequences in case the recordal has not taken place?
- Consistency of formalities - Power of Attorney (PoA): Various issues are ripe for harmonization, e.g., notarizations, requirements for original or copy, need for further documents to show that PoA has been signed in accordance with the rules of representation of the legal entity, etc.
- Conversion: There appear to be inconsistencies in criteria, procedures, and how member states apply rules in the conversion of CTMs.
- Disclaimers: Consistency in the use of disclaimers should be considered.
- Examination process: Consideration should be given to determining which aspects could be further harmonized, particularly the *ex officio* examination by the national offices (i.e. unifying the criteria for this examination).
- Graphic representation for non-traditional marks: There seem to be inconsistencies in the application of standards for registration and requirements for graphic representation that vary between national offices and OHIM, making it difficult for an applicant to judge what will or will not be accepted in a national forum, when compared with the CTM.
- Classification systems for goods and services: Further harmonization is needed.
- Grounds for opposition: Further harmonization is needed.
- Opposition proceedings availability: The possibility to challenge use of a prior mark in opposition proceedings is one area for possible further harmonization. Such

harmonization could ensure that there is no further need to start separate cancellation proceedings before national courts.

- Procedural litigation: Some national offices do not handle procedural litigation such as oppositions and cancellations and this leads to great expense for applicants and opponents. Questions have been raised about whether such proceedings should only be handled within national offices rather than by the courts.
- Procedural rules in Opposition procedures: Users have expressed that further harmonization is needed in opposition and cancellation proceedings, particularly in relation to the quality of decisions, checking of oppositions for admissibility, making opposition proceedings quicker, and setting time limits for decisions. To improve quality in decisions, consideration of harmonization of the qualifications for the members of appeals boards might be in order.
- License agreements: There have been questions raised as to whether the TMD should address licensing and particularly:
 - (1) Does a license agreement need to be in writing in order to be valid?
 - (2) Does a license agreement need to be registered? What are the consequences, if no registration has taken place? (Please note that INTA is strongly opposed to mandatory trademark license recordal.)
 - (3) Is the licensee entitled to take legal action against trademark infringements?
- Maintenance of records on seniority claims; this should be considered further.
- Inconsistencies in the publication of legal decisions should be looked at further.
- Inconsistencies in remedies – costs, foreign law evidence, and monetary compensation should also be considered.

Other Potential Modifications for Office Practices:

- Availability of best practices/model guidelines: Greater consistency could be achieved if all offices publish and effectively use guidelines.
- Increased cooperation between offices:
 - There is great potential for national offices to further harmonize their databases.
 - Additionally, current initiatives to harmonize the systems (particularly the OHIM Cooperation Fund) constitute a great step forward. Ongoing dialogue (such as meetings between the national offices and OHIM) will continue to be crucial if/when proposals to revise the TMD enter into force.

- Technology: National offices could further improve and harmonize their use of technology and their accessibility to users, thereby becoming more transparent in their procedures.
 - Search facilities - some national offices could provide more sophisticated search facilities, including on-line clearance searches.
 - On-line records- at some national offices, the on-line records of CTMs show the basic details but are not as comprehensive as the national mark records or the CTM records at OHIM.
 - CTM Information - to allow for “one-stop” on-line searching, it would be useful if the current full details of CTMs could also be disclosed by the national offices’ on-line records (including seniority claims) and if searches on proprietor names could also include CTMs.