

## Revision of Guidelines for Trademark Examination

November 14, 2023

**Sponsoring Committee:** Trademark Office Practices Committee

### **PROPOSED RESOLUTION:**

**WHEREAS**, the International Trademark Association from time to time needs to analyze and comment on the trademark application examination procedures of national and jurisdictional trademark offices or is asked to provide advice and recommendations to such offices on existing and/or proposed procedures;

**WHEREAS**, the Trademark Office Practices Committee has recommended the use of Guidelines for Trademark Examination to serve as a baseline standard by which INTA and its advocacy committees can provide analysis, advice, comments, recommendations, and training on the trademark application examination procedures of national and jurisdictional trademark offices;

**WHEREAS**, the most recent prior version of the Guidelines for Trademark Examination was adopted by INTA's Board of Directors in 2007;

**WHEREAS**, the Trademark Office Practices Committee has recommended that the Guidelines for Trademark Examination be updated to reflect among other things amendments to INTA's Model Trademark Act adopted in 2019 as well as INTA's current positions with respect to the protection and enforcement of trademarks as evidenced by various amicus briefs filed since 2007 and INTA Board Resolutions adopted since 2007;

**BE IT RESOLVED**, that the International Trademark Association adopts the revised Guidelines for Trademark Examination, 2023 edition, to serve as a standard and guidance for national and jurisdictional trademark office application examination procedures and to be used by INTA and its advocacy committees for purposes of providing analysis, advice, comments, recommendations and training related to national and jurisdictional trademark application examination procedures. This version supersedes the 2007 edition.

### **BACKGROUND:**

INTA's Board of Directors first adopted the Guidelines for Trademark Examination in 1998 and revised them in 2007. The Guidelines suggest a minimum set of standards for examination of trademark applications for, for example, a jurisdiction implementing trademark application examination procedures for the first time, or a jurisdiction amending its trademark application examination procedures. The Guidelines are also used by INTA advocacy committees for purposes of training national and jurisdictional trademark office personnel in jurisdictions with undeveloped procedural standards or where current procedural standards represent an obstacle to registration of certain types of marks.

In 2022, the Trademark Office Practices Committee (TOPC) formed an Examination Guidelines Subcommittee to study the 2007 version of the Guidelines for Trademark Examination and make recommendations for revisions to the Guidelines. The Examination Guidelines Subcommittee was comprised of TOPC committee members from 18 countries, including Argentina, Australia, Austria, Brazil, Canada, China, El Salvador, Germany, India, Italy, Kenya, Nigeria, Singapore, Switzerland, Turkey, the United Kingdom, Ukraine, the United States.

In preparing recommendations for revisions to the 2007 version of the Guidelines for Trademark Examination, the TOPC Examination Guidelines Subcommittee reviewed the INTA Model Trademark Law (2019) and the work of a prior TOPC task force (2014-2015) as well as the position taken by INTA in Board Resolutions since 2007. The following Board Resolutions were determined to be relevant:

- Benefits of opposition proceedings (September 2008)
- Bad faith in opposition proceedings (September 2009)
- Electronic evidence (September 2009)
- Extension, deferral or suspension of opposition proceedings (September 2009)
- Classification and confusion analysis (September 2010)
- Ambush marketing (November 2010)
- Well known marks protection in USA (March 2011)
- Guidelines for decision-makers in respect of oppositions (September 2011)
- Partial non-use cancellation (November 2011)
- Requirements in pre- and post-opposition proceedings (November 2012)
- Default judgement (November 2013)
- Requirements in non-use cancellations (November 2013)
- Repeat filings (May 2015)
- Madrid protocol dependency (May 2017)
- Geographical indications (November 2019)
- Bad faith trademarks (November 2020)
- Recognition, protection and registration of non-traditional trademarks (November 2021)
- Data access (November 2021)

The Subcommittee also reviewed INTA's position in Amicus Briefs since 2007. The following Amicus Briefs were determined to be relevant:

- Geographic terms (Cases R 1613/2019 *Iceland Foods Limited v. Icelandic Trademark Holding ehf and R 1238/2019-1 Iceland Foods Limited v. Islandsstofa (Promote Iceland), The Icelandic Ministry for Foreign Affairs and SA - Business Iceland*)
- Names of famous and historic persons (Case R 2248/2019-5, *The Estate of the Late Sonia Brownell Orwell ./. EUIPO*)
- Titles of famous books (Cases R 1719/2019-5 and R 1922/2019-5, *The Estate of the Late Sonia Brownell Orwell ./. EUIPO*)
- Assessing similarity of goods in likelihood of confusion analysis (Case R 964/2020-4, *EUROMADI IBERICA, S.A./ Zorka Gerdzhikova*)
- Functionality (Cases 21-417, *Sulzer Mixpac AG v. A&N Trading Company* and 20-1817, *Ezaki Glico Kabushiki Kaisha, D/B/A Ezaki Glico Co., Ltd. & Ezaki Glico USA Corp. v. Lotte International America Corp. & Lotte Confectionary Co. Ltd.*)



- Unregistered prior rights (Case 112/21, *X BV v. Classic Coach Company vof, Y, Z*)
- Scandalous marks (Case R-260/2021-1; *Matthias Zirnsack vs. EUIPO*)

The Subcommittee also solicited comments from the following trademark offices and INTA Advocacy Committees:

- USPTO
- EUIPO
- Enforcement Committee
- Famous and Well-Known Marks Committee
- Geographic Indications Committee
- International Amicus Committee
- Legislation and Regulation Committee
- Non-Traditional Marks Committee
- TOPC (TOPC leadership and all subcommittees, including TM5)

With the context of all of the above in mind, the Subcommittee incorporated a “best practices” approach to analyzing the provisions of the 2007 version of the Guidelines and making recommendations for proposed revisions. As part of that analysis, references to and preferences for the current practice of specific trademark offices were eliminated, and in particular, the prior focus of the Guidelines on U.S. practice was substantially reduced. The Guidelines were also revised to align them with current technological practices and capabilities.