



European Communities Trade Mark Association

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Mr. António Campinos  
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Brussels, 15 July 2011

Dear Mr. Campinos,

### **ECTA COMMENTS ON THE CONVERGENCE PROGRAMME BRIEF**

Thank you for your letter and Programme Brief of 21 June 2011 to ECTA and other user associations in connection with the Convergence Programme.

At the 40<sup>th</sup> Joint Meeting of the OHIM Administrative Board and Budget Committee on 3 May 2011, ECTA already welcomed OHIM's draft Strategic Plan naming 33 Key Initiatives by which, within 2015, three strategic goals shall be achieved.

One of these is to promote convergence of the practices of the National Offices (NOs), the Benelux Office (BOIP), WIPO and the OHIM (Key Initiative 28) by proposing the creation of working groups composed of members of NOs, BOIP, OHIM and WIPO in order to analyze the differences and to develop options for a common approach.

ECTA, which had asked at that meeting whether users would also be involved in the working groups, therefore welcomes the President's invitation to users' associations to actively participate in creating and achieving a Convergence Programme and to comment on the document which details how OHIM intends to organise the Programme.

The users of the CTM system and the national systems are subject to and "suffering" the most from different practices not converged at present under manifold aspects. It is the users who have to deal with problems arising from inconsistent decisions of the NOs, BOIP and OHIM in the same matter throughout the EU. The users and their representatives are experiencing presently that the practices of the Offices seem to go on divergent instead of harmonized routes so that user's uncertainty is increasing.

ECTA therefore thanks the President for his detailed Programme Brief and agrees that it appears feasible to adopt the working methodology applied for the projects of the Cooperation Fund (CF) although ECTA has the following remarks and suggestions.

## I. Working Methodology and Involvement of User Associations

ECTA suggests that at least one IP expert from a User Association becomes a member of each project team and, thus, to slightly amend the description of the responsibilities in 4.1 “Roles and Responsibilities”, so as to read:

National IP Offices, BOIP	<p>The National Office/BOIP IP expert is responsible for the requirements of the final solutions that projects have to provide in order to cover the needs of his National Office/BOIP</p> <p>.....</p> <p>In addition, the National Office/BOIP IP expert is responsible to provide input on the practices at national level whenever required.</p> <p>.....</p>
WIPO experts User Associations IP experts	<p>.....</p> <p>As members of the project working group, the <b>WIPO expert and the User Association IP expert</b> provide general support and knowledge throughout the whole project and participate to the definition of the proposals resulting from the project.</p>

Despite the participation of the User Association IP expert in the project working group, the adopted methodology should allow the User Associations to express their view on the project. Indeed, User Associations are not a “one man show”. They have a structure that requires gathering information from several bodies and putting the result to vote.

The intervention foreseen by User Associations in the project working groups would require the representative of the respective Associations to give its input on the spot, without having time to consult with the deciding bodies of the Associations.

Therefore, the Programme Brief (and in particular section 2.1.3.) should be restructured in such a way that:

- 1) An initial paper on the objectives of the programme is set and where questions are raised, so that User Associations can give their input from the very beginning.
- 2) With all this information, the working group should work looking for common proposals that could be accepted by consensus.
- 3) The final proposal should be sent again to the User Associations for consideration and observations.
- 4) All the comments received should be considered by the working group before putting a proposal for acceptance to the ABBC delegates.

## II. Projects

ECTA presumes that many of the Projects proposed under Annex 1 emerged from discussions/presentations held in OHIM Liaison Meetings with the NOs and BOIP broadening OHIM's expertise on possible areas where convergence of practices might be within reach. ECTA regards in principle all the Projects concerning "Absolute Grounds of Refusal" as well as "Relative Grounds for Refusal" to be of high priority.

### 1. *Absolute Grounds of Refusal*

With regard to the Convergence Projects on absolute grounds for refusal:

1.1. According to ECTA's experience, users often cannot predict to which extent possible **descriptive meanings in foreign languages** are taken into account by the NOs, apart from the NO of the "home country". In practice this means that users often cannot really assess whether instead of filing for a CTM national trade marks' applications in the most important EU countries should be preferred from the beginning: e.g., are descriptive/generic English, French, Spanish, Italian and German words refused in the same way throughout the EU? What about descriptive words of other official languages of the EU?

What about descriptive words of important languages outside the EU (Russian/Chinese/Japanese)? To which extent are refusals/admissions to publication of other NOs/the BOIP/the OHIM taken into account and should be taken into account? In our view National Offices or OHIM should take into account the registration of an identical mark in many EU Member States when evaluating a new application (unless the circumstances have significantly changed). Otherwise no harmonisation is achieved.

1.2. When non-distinctiveness of words or laudatory expressions or advertising slogans is assessed are foreign languages considered to the same extent as with regard to descriptive words (see above).

1.3. ECTA believes that these topics should have priority as compared to the examination of absolute grounds for refusal as regards figurative trade marks with purely descriptive/non-distinctive words/expressions (when does the figurative element carry the trade mark distinctiveness), and of non-traditional trade marks, such as positional trade marks, holograms, movement trade marks.

1.4. The issue concerning the requirement of **graphic representation of non-traditional trade marks**, however, should be dealt with as a separate project independently and before the examination for absolute grounds of these trade marks is reviewed.

1.5. ECTA concurs with the President's proposal regarding the convergence of Practice of the **scope of protection of trade marks exclusively in black, white** and/or (shades of) grey (do they cover any/all colours or not?). This topic appears to be of high importance for users.

## 2. Relative Grounds for Refusal

2.1. ECTA agrees that early convergence of Practice of how to deal with **non-distinctive/weak components of trade marks** would turn out as a great benefit to users. The same applies to a clear picture of the status quo and possible convergence of the national practices regarding the application of the Medion case (C-120/04) of the European Court of Justice, e.g. is the “Thomson Life”-principle also applied if the older mark consists of two distinctive elements, one of which constitutes the younger mark or the only distinctive element of it?

2.2. Turning to the proposed Project “Convergence of Practice of **how to assess the visual, aural and conceptual similarity**”, according to ECTA’s experience this topic is perhaps too broad to be likely to bring a useful result (see the summary reports and compilations of answers for the surveys from the ECTA Harmonization Committee on “*The Pronunciation of a Trade mark and how this affects the Assessment of Similarity of Marks by the NO’s*” published in October 2008 and on “*How Trade Mark Offices deal with the European Court of Justice principle that Differences in Connotation or Graphic Appearance between two TMs counteract even strong Similarities under other Aspects so as to exclude a Likelihood of Confusion*” published in March 2011 – four documents herewith attached for your convenience).

ECTA suggests that this Project should be broken down into narrower more precise tasks. While the principles underlying the assessment of visual, aural and conceptual similarity appear to be (more or less) the same, the practices differ already in evaluating, e.g. whether a consonant (and, in a given case, which one) in the beginning of a six-letter-word stands for aural dissimilarity/similarity to a low degree with a five-letter-word identical with the sequence of the second to sixth letter of the six-letter-word (e.g. EVIAN/REVIAN). In particular one can see significant difference in the approach of OHIM and National Offices whether a conceptual dissimilarity of the marks can later exclude a likelihood of confusion. Carrying out the convergence projects on this core issue of trade mark law at a later stage appears feasible.

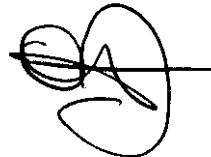
2.3. The **similarity of goods and services** is another core issue of trade mark law, either. ECTA considers achieving convergence of Practice in this area to be of great benefit to users. Considering that the Cooperation Fund is about to establish a common tool on similarity of goods and services (CF 1.2.9) namely, a databank on decisions available to anyone, after its implementation convergence of the practices of the NOs, BOIP and OHIM should become an additional project.

ECTA deems a successful Convergence Programme as initiated by OHIM President capable to entail eminent benefit to the users and is looking forward to continuation of the Programme with regard to many further issues after the first group of altogether five Projects will have been set in place.

Yours sincerely,



Monika Wenz  
Chair of Harmonization Committee



Annick Mottet Haugaard  
President

Enclosures : 4

- Survey of the ECTA Harmonization Committee on the Pronunciation of a Trade mark and how this affects the Assessment of Similarity of Marks by the NO's, published in October 2008 (summary report and compilation of answers).
- Survey of the ECTA Harmonization Committee on how Trade Mark Offices deal with the European Court of Justice principle that Differences in Connotation or Graphic Appearance between two TMs counteract even strong Similarities under other Aspects so as to exclude a Likelihood of Confusion, published in March 2011 (summary report and compilation of answers).