



European Communities Trade Mark Association

Report of the Meeting with WIPO on 5 March 2007

PARTICIPANTS:

On behalf of WIPO

Mr. Rubio	Assistant Director General
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Mr. Graça-Aranha	Director, International Registrations Department
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On behalf of ECTA

Mireia Curell	President
Sandrine Peters	Legal Co-ordinator
Doris Bandin	Chair of the Law Committee
Leopold von Gerlach	Chair of the Design Committee

The following was discussed:

1. The Office and its administration including brief overview of 2006 statistics and forecast for 2007

Madrid System

WIPO provided a paper including the "Highlights and statistical indicators for the year 2006" regarding the Madrid System for the International Registrations of marks which can be found under ANNEX 1.

To be noted:

- 2006 was a good year as:

- The number of members increased. The system comprises 80 members of whom only 8 are bound only by the Agreement.
 - A record number of international registrations have been recorded (+12.2% versus 2005).
 - The backlog in recording international registrations was reduced and the average processing time for recording in the last 3 months of the year was 5 weeks. The aim is to bring this further down to 4 weeks.
- The number of international applications filed through OHIM rose by 32% as compared to 2005.
- The EU has become a favourite target market for designations (+68.7%) and moved from the 22nd to the 6th position in the ranking of most designated members of the Madrid Union. The majority of these designations (about 60%) were made in applications or subsequent designations originating in an EC Member State. Also to be noted that there is a decrease in the number of designations of individual EU countries.
- There is a slight decrease in the average number of designations:
 - In 2006: 8,5
 - In 2005: 9
 - In 2004: 11
- On renewals, a 102.8 % growth is to be noted compared to 2005. This is mainly due to:
 - The 10 years anniversary of the Protocol which entered into force in 1996.
 - The change of the 20 years to a 10 years renewal period.
- Improvement in the services provided by WIPO
 - The electronic renewal facility which has been put in place in April 2006. Today about 22% of the renewals are applied for through this tool.
 - Implementation of some new features to the ROMARIN system and free accessibility since January 1, 2007.

Forecast:

- WIPO has some favourable indications regarding possible new members namely, Israel (within the first half of 2007), India and Brazil.
- WIPO foresees a 7 to 8% growth in the number of applications in 2007.
- WIPO is planning to provide for the notification of irregularity letters by electronic means and gradually expand communication with users by e-mail to other notifications.

ECTA offers to publicise the e-business tools of WIPO, such as the renewal facility or any initiative towards e-communication with users, in particular to expedite transmission of notifications related to provisional refusals of protection.

Haque Agreement

There has been an increase in the number of contracting countries and by the end of March there will be 46 members.

There is a strong indication that the EU will accede to the Geneva Act of the Agreement with effect from 2008 and WIPO is already in close contact with OHIM in order to work on the practical issues. WIPO is also planning to introduce an e-filing facility and would welcome feedback from users on their experience with OHIM's interface.

WIPO has had further good indications from the US about accession to the Geneva Act, but it is still unclear when this may materialize.

China is also seriously looking into possible accession to the Geneva Act but is faced with the difficulty that it does not qualify for the application of individual fees while the standard designation fee is insufficient to cover the cost for the work involved for its Office. As there are more countries in a similar position, WIPO is preparing the holding of informal consultations on the issue.

2. Revision of the Madrid System

ECTA discussed the latest developments on the Revision of the Safeguard Clause and the "possible compromise". See minutes of the third session of the Ad hoc Working Group on the Legal Development of the Madrid System for the International Registration of Marks, which can be found at:

http://www.wipo.int/edocs/mdocs/mdocs/en/mm_ld_wg_3/mm_ld_wg_3_5.doc

ECTA mentioned that it is in the process of preparing a position paper on this matter.

WIPO recalled that the Working Group now seems to favour a total repeal of the safeguard clause, with some protection regarding renewal fees for existing designations. We explained that not all ECTA members seem to be satisfied either with this repeal or with the proposed compromise. WIPO indicated that one of the longer term advantages of the latter was that it would make the holding of discussions on a revision of the Madrid System more promising, as they would need to be concerned with the Protocol only.

WIPO draws our attention to the fact that the increase in designations concerns mainly Protocol-only parties, and also that the designation of the EC is strongly increasing while the designation of individual EC countries is decreasing. This is also the case for applicants designating the EC coming from EC Member States.

3. Delays in sending communications

ECTA raised the issue that some communications from OHIM such as a notification of a provisional refusal on absolute grounds reached the representative or the owner after the expiration of the response deadline.

WIPO was surprised to hear this and promised to look closer at the deadlines when notifying documents. ECTA will look into this matter further with WIPO.

4. Functioning of the link between the Madrid Protocol and the Community Trade Mark

WIPO confirmed having a very good relationship with OHIM, with informal meetings between the two of them about 6 to 7 times a year.

They also participate in a programme for which OHIM has taken the initiative, enabling examiners from national offices of EC Member States to be trained for 6 or 9 months at WIPO, in order to get acquainted with the examination work under the Madrid system in WIPO, and 6 months at OHIM to apply the acquired knowledge in the examination work concerning Madrid applications and designations in OHIM. Moreover, they will carry this knowledge with them for application at their national Office. Presently, they have 2 examiners from the Czech Republic and one from Slovakia. WIPO is favourable to more such programmes.

5. Individual classification reports.

ECTA raised the issue that this was a useful tool and that it would like this facility to be reinstalled as it can be necessary to avoid rejections or overcome objections in some circumstances.

6. WIPO decisions and possible appeal

ECTA raised the issue that none of the decisions taken by WIPO such as in classification matters, or recordal of assignments and other modification or rights, can be "appealed". WIPO clarified that with respect to assignments and other modifications, its examination only addressed formalities and that, in particular, it had no authority to take a decision on substantive issues.

ECTA suggested that, with respect to classification issues, at least some administrative appeal procedure, or review instance, might be organised, so as to give the possibility to have some of the decisions revised whenever needed.

WIPO said that it would study the matter.

7. Reorganization of Examiner's work

WIPO gave an explanation about the reorganisation of examiners work.

Through a pilot team, WIPO will set up a new process whereby an examiner will no longer be dedicated to a specific task but will be in charge of the whole registration process of a specific mark. This pilot project will start on March 19, 2007.

This should enable examiners to be better informed about the whole process and better able to answer questions of users. Also this should facilitate the relationship with the national offices and allows users to have a single contact point in WIPO per application.

A pilot team is working on OHIM – British and Swiss applications. Any comments from user's on their experience regarding these countries would be welcome.

8. "Real and effective place of business"

ECTA raised the issue that the meaning of this phrase is not really clear and asked WIPO whether it could provide some guidelines in this matter.

WIPO replied that it depended on the respective national legislation and that it therefore cannot provide any such guidelines. Also WIPO is not aware of any case law in this matter.

ECTA suggested the possibility of proceeding with a questionnaire on this issue so as to obtain the relevant information from member states. WIPO promised to evaluate the possibility.

9. Harmonisation of Design law

ECTA raised the importance of harmonizing the Law on Designs as much as possible. WIPO referred to the work performed by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications where the Committee had agreed, at its 16th session, to an exchange of information with a view towards promoting better understanding of various design registration systems. The Secretariat was requested to develop a draft questionnaire relating to the formalities of industrial design registration for consideration at the next session.

We refer you amongst others to the minutes of the 16th SCT meeting which can be found at: http://www.wipo.int/meetings/en/details.jsp?meeting_id=10983

Reported by Sandrine Peters, ECTA Legal Co-ordinator