



European Communities Trade Mark Association

## ECTA ACTIVITY REPORT JUNE 2010 - JUNE 2011

### I. POSITION PAPERS

ECTA provided authorities with the following position papers. All ECTA's position papers can be found on the Position Papers page of the ECTA website ([www.ecta.eu](http://www.ecta.eu)).

#### A. With the support of the Law Committee:

1. **On 22 June 2010**, to OHIM and DG MARKT, comments on OHIM's note of February 2010 on suspensions and extensions of time in opposition proceedings;
2. **On 2 July 2010**, to OHIM and the Max Planck Institute, comments in connection with the meeting of the User Organisations on 8-9 June 2010 on the Study on the functioning of the European Trade Mark System sent to DG MARKT;
3. **On 21 October 2010**, to OHIM and DG MARKT, comments on OHIM's note of February 2010 on OHIM's database for comparison of goods and services;
4. **On 15 December 2010**, to DG SANCO, Position Paper on Commission's proposal to revise the tobacco products Directive 2001/37/EC by introducing plain packaging in the EU;
5. **On 28 January 2011**, to OHIM and DG MARKT, Position Paper on designation of goods and services in the CTM and in National and International trade marks designating member States in the EU – User and scope of class headings of the International classification of the Nice agreement including a survey of the Harmonization Committee into the practice of the national patent /TM OFFICES (NPTOs) re the issue whether NPTO regards a TM covering all class headings of a specific class to provided protection for;
6. **On 6 May 2011**, to DG MARKT, OHIM and the Max Planck Institute, preliminary comments on the MPI proposals included in its Study on the Overall Functioning of the European Trade Mark System presented on 15 February 2011.



European Communities Trade Mark Association

**B. With the support of the Internet Committee:**

1. On **28 October 2010**, ICANN with comments on the results of ICANN Study on the Prevalence of Domain Names Registered using a Privacy or Proxy Registration Service;

***Jointly with MARQUES***

2. On **21 July 2010**, to ICANN, comments on New gTLDs Programme - Draft Applicant Guidebook, Version 4 and Explanatory Memoranda;
3. On **10 December 2010**, to ICANN, comments on measures to protect IP in the new GTLDs;
4. On **11 March 2011**, to ICANN, Position Paper on improvements to the rights protection mechanisms of the new GTLD program;
5. On **25 March 2011**, to ICANN, further comments on improvements to the rights protection mechanisms of the new GTLD program;
6. On **15 April 2011**, to ICANN, comments on the WHOIS review team and its work;
7. On **15 May 2011**, to ICANN, comments on "April 2011 discussion draft of the New gTLD Applicant Guidebook".

**C. With the support of the Anti-Counterfeiting Committee:**

1. **On 21 October 2010**, to DG TAXUD and DG MARKT, Position Paper reflection on goods in transit infringing a trade mark;
2. **On 21 October 2010**, to DG TAXUD and DG MARKT, proposal for changes to EU legislation on travellers' personal allowance;
3. **On 13 April 2011**, to DG MARKT, Position Paper in response to the consultation on the Commission's report on the enforcement of IPR;

***Jointly with other Associations***

4. **In November 2010**, to DG TRADE, communication from the Business Community urging the European Union to endorse ACTA;
5. **On 17 November 2010**, to ACTA Negotiators, comments on the draft Anti-Counterfeiting Trade Agreement;
6. **On 20 April 2011**, to the President of the European Parliament and other Members of the Parliament, letter on ACTA.

## **D. With the support of the Harmonization Committee**

1. **In March 2011**, to DG MARKT and OHIM, survey in respect of Legal Enforcement of Security Interests of Trade Marks in the Member States;
2. **In March 2011**, to DG MARKT and OHIM, survey in respect of Requirements for Protection of Marks with a Reputation;
3. **In March 2011**, to DG MARKT and OHIM, survey in respect of how Trade Mark Offices deal with the ECJ principle that differences in connotation or graphic appearance between two trade marks may counteract even strong similarities under other aspects as to exclude a likelihood of confusion;
4. **In March 2011**, to DG MARKT and OHIM, survey on Trade Marks filed in bad faith.

## **E. With the support of the Professional Affairs Committee:**

**In September 2010**, to OHIM and DG MARKT, survey on representatives applying for trade mark registrations in their own name.

## **F. With the support of the OHIM Link Committee (in collaboration with the Chairs of the Law and Harmonization Committees):**

1. **On 7 February 2011**, to OHIM, discussion papers on cluttering of CTM register, trade marks receiving unduly wide scope of protection, new format of OHIM opposition decisions, suggestions of tasks for the European Observatory on counterfeiting and piracy;
2. **On 17 February 2011**, reply to OHIM President's letter of 7 February 2011 re proposal for strategic plan.

## **G. With the support of the Design Committee:**

**On 25 March 2011**, to the UK Patent, Position Paper on the UK consultation with regard to amendments to design legislation.

## **H. With the joint support of ECTA Committees:**

1. **On 24 June 2011**, to DG MARKT, OHIM, the EU General Court, the EU Court of Justice and the Permanent Delegation of the Council of the Bars and Law Societies of the EU, comments on the judicial architecture of the EU Courts for trade mark cases;
2. **On 14 March 2011**, to DG SANCO, response to the Commission's consultation on the use of alternative dispute resolution as a means to resolve disputes related to commercial transactions and practices in the EU.



European Communities Trade Mark Association

## **II. PARTICIPATION IN MULTILATERAL AND BILATERAL MEETINGS WITH THE OHIM, EC COMMISSION AND ENTITIES LINKED TO THE EC COMMISSION**

- Max Planck Institute's Hearing of the Users Organisations and 5 NGOs, 8-9 June 2010, Munich;
- OHIM Administrative Board and Budget Committee meetings, 22-24 November 2010, Alicante;
- OAMI E-Business Users Group meeting, 1-2 December 2010, Alicante;
- OHIM Cooperation Fund, kick off meetings, package 1, 27-28 January 2011;
- ECTA OHIM Link committee meeting, 7 February 2011, Alicante;
- OAMI Users group meeting, 15 April 2011, Alicante;
- OHIM Administrative Board and Budget Committee meetings, 2-4 May 2011, Alicante;
- DG MARKT Hearing of Users Associations, on the Study on the overall functioning of the TM system in Europe, 26 May 2011.

## **III. INVOLVEMENTS IN PROJECTS LINKED TO THE EU COMMISSION AND THE OHIM**

- Meetings of Sub-group on legal framework of the European Observatory for Counterfeiting and Piracy, DG MARKT, Brussels;
- Volunteers in projects of Packet 1 of OHIM Cooperation Fund;
- Volunteers in projects of Packet 2 of OHIM Cooperation Fund.

## **IV. PARTICIPATION IN MULTILATERAL AND BILATERAL MEETINGS OF INTERNATIONAL ORGANISATIONS**

- 43<sup>rd</sup> session of the UNCITRAL, 21 June-9 July 2010, United Nations, New York;
- 23<sup>rd</sup> session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 30 June, 1-2 July 2010, Geneva;
- 8<sup>th</sup> session of the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks, 5-9 July 2010, Geneva;
- WIPO Working Group on the Development of the Lisbon System (Appellations of Origin), 30-31 August, 1-3 September 2010, Geneva;
- 24<sup>th</sup> session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 1-3 November 2010, Geneva;



European Communities Trade Mark Association

- 21<sup>st</sup> session of the committee of experts of Nice Union, 22-26 November 2010, Geneva;
- 6<sup>th</sup> session of the Advisory Committee on Enforcement, 1-2 December 2010, Geneva;
- 40<sup>th</sup> ICANN meeting, 13-18 March 2011, San Francisco;
- 25<sup>th</sup> session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 28-31 March, 1 April 2011, Geneva;
- ECTA-WIPO annual meeting, 8 April 2011, Geneva;
- 3<sup>rd</sup> session of the WIPO Working Group on the development of the Lisbon system, 23-27 May 2011, Geneva;
- WIPO Ad Hoc Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs, 30 May -1 June 2011, Geneva;
- WIPO Worldwide Symposium on Geographical Indications, 22-24 June 2011, Lima.

## **V. MEETINGS WITH ASSOCIATIONS**

- NGO coordination meeting at AIPPI annual conference, 4 October 2010, Paris;
- BUSINESSEUROPE Working Group on trade marks meetings, 12 October 2010 and 11 April 2011, Brussels;
- Global Congress on combating counterfeiting and piracy, 2-3 February 2011, Paris;
- Sisters Associations meeting (APRAM, BMM, ECTA, ITMA, GRUR, MARQUES, UNION), 4 March 2011, London;
- NGO coordination meeting at the INTA annual conference, 17 May 2011, San Francisco.

## **VI. ORGANISATION OF ROUND TABLES AND WORKSHOPS**

1. In order to contribute to the debate on the EU trade mark system which is particularly relevant in the context of the current Study on the overall functioning of the system launched by the European Commission, ECTA has organised a series of Round Tables in collaboration with the OHIM and the National Trade Mark Offices, so that the stakeholders would have a better understanding of the effective impact of OHIM's activities and the CTM system in the different Member States and learn from the experience of the respective users. By repeating this Round Table on identical topics in the various EU Member States, ECTA contributed also to the further harmonization of the different practices, both from a procedural and legal point of view, at EU level.



European Communities Trade Mark Association

In this regard, after The Hague in April 2008, Munich in March 2009, ECTA organised the following Round Tables:

- **Riga, 9 July 2010**, in collaboration with OHIM, the Estonian, Latvian and Lithuanian trade mark offices "*The Community Trade Mark and the National Trade Marks: are they in harmony? The Baltic countries' points of view*";
  - **Helsinki, 13 September 2010**, in collaboration with OHIM, the Danish, Finnish, and Swedish Patent and Trade Mark Offices, "*The Community Trade Mark and the National Trade Marks: are they in harmony? The Scandinavian countries' points of view*";
  - **Cracow, 22 October 2010**, in collaboration with OHIM and the Bulgarian, Hungarian and Polish Patent and Trade Mark Offices, "*The Community Trade Mark and the National Trade Marks: are they in harmony? The Eastern European points of view*".
2. To promote the Hague System covering International Registrations of designs, ECTA has organised the following workshops:
- **London, 11 February 2011**, Workshop on international registrations of designs in association with ITMA, WIPO and UK IPO;
  - **Rome, 25 March 2011**, Workshop on international registrations of designs in collaboration with WIPO, DGLC UIBM, ADI and INDICAM.

Forthcoming workshops in collaboration with WIPO will be:

- **Paris, 1 July 2011**, in collaboration with APRAM and WIPO;
- **Hamburg, 26 September 2011**, in collaboration with GRUR, WIPO and the German Patent Office;
- **Madrid, in early 2012.**

## VIII. PRESS

1. **In June 2010**, in OAMI Online Newsletter 06 James Nurton's interview of Annick Mottet Haugaard (ECTA President);
2. **On 14 June 2010**, in the World Trademark Review, "*European Union - Users cannot provide a united front against European challenges*" by Adam Smith, including interview of Fabio Angelini (Chair of ECTA Law Committee);
3. **On 12 August 2010**, in Trends "*Schermen met merken*" and Tendance "*Protectrice de marques*", by Gilles Quoistiaux including an interview of Annick Mottet Haugaard (ECTA President);
4. **In autumn 2010**, in magazine Université Liege, "*Une femme de marques*" by Didier Moreau including an interview of Annick Mottet Haugaard (ECTA President);



European Communities Trade Mark Association

5. **On 22 October 2010**, Press release of the ECTA Anti-Counterfeiting Committee dedicated to the matters of importing, offering and putting the counterfeit goods on the EU market;
6. **On 25 October 2010**, Press release of the ECTA Anti-Counterfeiting Committee on finalising the Anti-Counterfeiting Trade Agreement;
7. **In 2010**, in the World Intellectual Property Review “*The evolving gTLD*” by Andrew Mills (Chair of ECTA Internet Committee);
8. **In January 2011**, in the WIPR Digest 2010 “*Laying the foundations of Trademark reform*” by Annick Mottet Haugaard (ECTA President);
9. **On 5 June 2011**, in AWA information, by Dani Backteg including interview of Annick Mottet Haugaard (ECTA President);
10. **On 8 June 2011**, Press release of the ECTA Anti-Counterfeiting Committee on the large quantities of counterfeit medicines distributed from Sweden.