

Standing Committee on

Trademarks

2015



Date: 2nd October 2015

REPORT Standing Committee on Trademarks

Chair: Eléonore GASPAR
Responsible Reporter: Anne Marie Verschuur

- 1) Report on the activities of the Standing Committee during the reporting period
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I. Goals and priorities for the reporting period

The SC TM had the following priorities for its substantive work:

1. Responding to WIPO's informal requests regarding various legal questions.
2. Reinforcement of cooperation with OHIM.
3. Representation of AIPPI at WIPO and OHIM meetings.
4. Coordination of actions with regards to the EU trademark reform (proposed revision of the Community Trade Mark Regulation and the Trade Marks Directive). This issue will be discussed in the ExCo meeting this year.
5. Follow-up on ICANN issues.

On an operative level there have been three main goals:

1. Expansion of the SC TM with the incorporation of a few new members and greater involvement of its current members. From 21 members in August 2014, the SC TM has grown to 26 members. Overall, the involvement of the SC TM members is slightly better but there is still room for improvement. This goal is closely related to the establishment of sub-committees.
2. Establishment of sub-committees (based on both geographical and substantial criteria). It was agreed at the AIPPI Congress held last year in Toronto to set up several task forces as a way to deal more effectively with the many projects to be covered by the SC TM.
3. Increasing visibility of the SC TM, in particular through publications in the AIPPI eNews, and representation of AIPPI at external meetings. At the meeting held in Toronto last year, the SC TM agreed to enhance their involvement in the work of the Communications Committee by submitting articles for publication in the eNews from time to time. A few articles have been published but there is still room for improvement.

II. Substantive work

(i) General Assistance

We supported the RGT with our input with regard to:

- The working guidelines of Q245 on free-riding and parasitism.
- The AIPPI statement regarding the proposed diversion of OHIM's accrued surplus to non-trademark related activities.
- Several questions regarding absolute grounds and goods and services submitted to the SC TM before

- the meeting held with OHIM on 12 May 2015 for the signature of the Memorandum of Understanding between OHIM and AIPPI. Specifically, the input of SC TM dealt with distinctiveness of sound marks (how to set objective criteria for distinguishing between simple and non-memorable sounds from those which are), the means for representing these signs (and searches thereof) and the similarity between the providing of food and the food itself (for example between 'ice-cream parlours' and 'ice cream').
- Potential speaker for the Rio Panel session "Don't miss the (right) mark". The SC TM has contributed to the search of a panelist with a particular focus on trademarks in the pharma sector who would be interested in participating.

(ii) Establishing a draft position paper on the ICANN's proposal regarding geographical terms in gTLD.

The members of the SC TM were asked to provide their views on the proposal made by the Governmental Advisory Committee of the Internet Corporation for Assigned Names and Numbers (ICANN) to introduce enhanced restrictions and procedures in future gTLD application rounds for the application of gTLD strings incorporating geographic names.

In order for AIPPI to take a position on this issue, the SC TM produced a draft position paper based upon the contributions of all the members of the SC TM who had expressed their views. We would like to take the opportunity to thank the SC TM member who took the lead in preparing the paper.

AIPPI submitted its opinion in a position paper on this issue.

(iii) Informal consultation with WIPO

The SC TM provided answers to WIPO on the various questions that were raised.

WIPO has requested of AIPPI this year that, in the context of the Madrid Users Informal Consultation Group, it provide feedback on:

1. Two proposals for changes in practice concerning:
 - a. Revision of the legal definition of the holder in the International Register, and
 - b. Recording of a declaration that change in ownership has no effect, in accordance with the procedures set out in Rule 27(4) of the Common Regulations under the Madrid Agreement and Protocol.
2. Survey on dependency: the Twelfth Session of the Madrid Working Group, which was held in October 2014, requested that the International Bureau prepare a Madrid user survey on dependency principle issues. The Working Group also requested that a draft of the proposed survey be made available for comments before the survey is conducted. WIPO asked AIPPI to provide its views on the draft user survey on dependency principle issues.

SC TM should continue to contribute to the work of the Madrid Users Informal Consultation Group in order to strengthen ties between AIPPI and WIPO.

(iv) EU trademark reform package

Since the EU trademark reform package should be adopted by the end of 2015 and the final compromise texts on the TM Directive and on the CTM regulation were made public in June 2015, the RGT upon initiative of SC TM, has agreed to participate in a short panel during the ExCo I in Rio on the contents of such draft pieces of legislation. The panel, which will include an OHIM representative, should be moderated by the Chair of SC TM.

III. Representation of AIPPI at WIPO and OHIM meetings

WIPO and OHIM hold regular meetings with national offices and users organizations (as observers) for the purpose of the further development and/or harmonization of formal and substantive trademark law. AIPPI, usually represented by a member of the SC TM, participates in these meetings. Our committee succeeded in a reasonable representation of AIPPI in regards to such meetings during 2014/2015 due to the participation of several group members for which we take this opportunity to thank them.

The SC Chair participated in the bilateral meeting which was held with OHIM on 12 May 2015 for the signature of the Memorandum of Understanding between OHIM and AIPPI.

The SC Chair also attended OHIM's ABBC meeting together with Felipe Claro, as an observer.

- 2) Key issues/developments relevant to the Terms of Reference of the Standing Committee (arising during the reporting period or coming up)
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Task forces

In the SC TM meeting held last year in Toronto it was agreed to implement a task force system based on different sub-committees within the SC TM to deal in a more effective way with the current and/or pressing TM related issues. The scope was: (i) to improve team-building and facilitate the management of the team given the reduced number of members; (ii) to benefit to a greater extent from the know-how of each member; (iii) to be capable to face several fronts at the same time in a more effective way; (iv) to allow SC TM to provide a tailored response according to the needs of each project; and (v) to encourage members to participate and provide their feedback when requested.

The task forces that were set up were the following:

WIPO

- Elena Molina
- Béatrice Thomas
- Peter Widmer
- Theresa Corneau
- Graciela Pérez
- Abdurrahim Ayaz

EUROPE

- Eléonore Gaspar
- Alexander von Muhlendahl
- Bartosz Krakowiak
- Jan Vleck
- Stefano Vatti
- Tobias Cohen Jehoram
- Jorge Llevat

AMERICAS

- Eduardo Kleinberg
- Theresa Corneau
- Graciela Pérez

APAC

- Lena Shen
- Fiona Brittain

ICANN

- Torsten Bettinger
- Dennis Prah

The members not listed above have not yet expressed their preference for any task force.

All members can participate and are encouraged to respond even if they are not part of the specific task

force.

The establishment of task forces has not led to a huge change in the working methods of the SC TM. The implementation of this project should be reviewed at the upcoming annual meeting to be held in Rio de Janeiro in view of the outcome of the first year of life.

- 3) Any recommendation for AIPPI involvement/action (describe what involvement/action is recommended and why, by whom and relevant time frames)
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None

- 4) Plan for the activities of the Standing Committee for the next reporting period highlighting any priorities
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The main goals and priorities set up for the reporting period apply to the next reporting period. Accordingly the goals and priorities are:

1. Enhancement of co-operation with WIPO.
2. Enhancement of co-operation with OHIM
3. Ensuring representation of AIPPI at WIPO and OHIM meetings.
4. Coordination of actions with regards to the EU trademark reform (proposed revision of the Community Trade Mark Regulation and the Trade Marks Directive). This issue will be discussed in the ExCo meeting this year.
5. Follow-up on ICANN issues.

On an operative level the goals are:

1. Greater involvement of the current SC members.
2. Improvement and consolidation of the task forces system
3. Increasing visibility of the SC TM, in particular through publications in the AIPPI eNews, and representation of AIPPI at external meetings.

Additionally, we encourage all the SC members to participate in the annual meetings.

Names and Functions of Committee Members

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|-------------------|------------------------------|---------------|
| Chair | Eléonore GASPARD | France |
| Co Chair(s) | Alexander VON MÜHLEND AHL | Germany |
| Secretary | Elena MOLINA LÓPEZ | Spain |
| Members | Abdurrahim AYAZ | Turkey |
| | Torsten BETTINGER | Germany |
| | Fiona BRITTA IN | Australia |
| | Tobias COHEN JEHORAM | Netherlands |
| | Theresa CORNEAU | Canada |
| | Cesare GALLI | Italy |
| | Bartosz KARKOWIAK | Poland |
| | Sheldon KLEIN | United States |
| | Eduardo KLEINBERG | Mexico |
| | Jorge LLEVAT | Spain |
| | Masako NISHIMURA | Japan |
| | Graciela PEREZ DE INZAURRAGA | Argentina |
| | Denis PRAHL | United States |
| | Aleli A. G. QUIRINO | Philippines |
| | Michael REINLE | Switzerland |
| | Lena SHEN | China |
| | Elisabeth SIEMSEN | Brazil |
| Shane SMYTH | Ireland | |
| Béatrice THOMAS | France | |
| Stefano VATTI | Italy | |
| Jan VLECK | United Kingdom | |
| Marieke WESTGEEST | Netherlands | |
| Peter WIDMER | Switzerland | |