

Standing Committee on

Trademarks

2016



Date: 5th September 2016

REPORT Standing Committee on

Trademarks

Chair: Eléonore GASPAR
Responsible Reporter: Anne Marie Verschuur

1) Report on the activities of your Standing Committee during the reporting period

Please provide a general overview of the activities of your Standing Committee over the last 12 months, but please include at least:

a) meetings of the Standing Committee during the reporting period

The Standing Committee has an annual meeting during the AIPPI World Congress. The last meeting was held in Rio de Janeiro in October 2015.

b) any external representation on behalf of AIPPI by any member of your Standing Committee

WIPO

The Secretary of our Committee, Elena Molina, and a member of the Committee, Michael Reinle represented AIPPI at the 13th Working Group of the Working Group for the Legal Development of the Madrid System held at WIPO between 2 and 6 November 2015. Elena Molina also represented AIPPI at the 14th session of the Working Group for the Legal Development of the Madrid System held at WIPO between 13 and 17 June 2016. The outcomes of these meetings were reported to the AIPPI Bureau.

Our committee has coordinated with the Standing Committee on Designs and the Standing Committee on Geographical Indications as regards the representation of AIPPI at the 35th session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/35) held at WIPO between 25 and 27 April 2016.

The SC still represents AIPPI in the WIPO informal "Madrid consultation group".

EU IPO

A member of our Committee, Marieke Westgeest, represented AIPPI at the 14th Liaison Meeting on Trademarks that was held on 6 and 7 October 2016.

The Chair of our Committee, Eléonore Gaspar, together with members of the Bureau, attended the bilateral meeting of AIPPI with EUIPO which was held in Alicante on 10 May 2016.

ICANN

A member of the Standing Committee, Torsten Bettinger, represented AIPPI at the IPC meeting in

Dublin in October 2015. He also attended the ICANN meeting in Marrakech between 5 and 10 March 2016.

c) any contribution by your Standing Committee to any external consultations

The Standing Committee was consulted on the various topics discussed by WIPO during the 14th session of the Working Group, and in particular on the Marques paper regarding dependency and central attack.

The Standing Committee has provided the EUIPO with input (through a submission or otherwise) with regard to:

- The questions to be discussed at the bilateral meeting held on 10 May 2016 between AIPPI and EUIPO.
- Questionnaire from the EUIPO's Knowledge Circles (KC), specifically KC Proceedings and KC Absolute Grounds that should be discussed at the bilateral meeting. The questions covered issues regarding substantiation of proceedings, presentation and organization of evidence, representation of marks and certification marks.
- Draft guidelines of the Work Package Legal Reform: our Committee did not review the full document in depth but provided some input on specific issues.
- Consultation on the Annex to the Draft Communication of EUIPO's President on the implementation of Article 28 of the EU Trademark Regulation and a list of Frequently Asked Questions. Written answers and comments from AIPPI were sent in January 2016.

d) any studies or analyses undertaken or position papers prepared by your Standing Committee, with a brief summary of the outcome(s)

The Standing Committee prepared a number of contributions that were published in the AIPPI eNews, in particular on the new trademark package in Europe (Regulation and Directive published in December 2015) on the following topics :

- Changes that will enter into force on March 23, 2016
- Certification marks,
- Counterfeit goods in transit,
- article 28 of the EU trademark regulation.

e) involvement of your Standing Committee in any other activities of AIPPI, eg Panel Sessions, contribution to Study Guidelines, etc

The Standing Committee submitted topics for Panel sessions to be held in Milan (2016) and for the Study Questions to be discussed in Sydney (2017).

f) any other relevant activities

not responded

2) Key issues/developments relevant to the Terms of Reference of your Standing Committee during the

reporting period

Please include a short summary of any significant case law, legislative or regulatory developments, or policy initiatives, including their relevance and/or any implications for the work of your Standing Committee or for AIPPI more generally

The EU Trademark Package was approved. The new EU Trademark Directive and the Regulation amending the EU Trademark Regulation were published on 23 and 24 December 2015 respectively. Most of the provisions of the amended EU Trade Mark Regulation entered into force on 23 March 2016, with the exception of a few that will enter in force only on 1 October 2017. This reform has brought significant changes in many areas of EU trademark law, including the withdrawal of the requirement of graphical representation, certification marks, counterfeit goods in transit opposition, administrative invalidity and revocation proceedings and infringement.

The Standing Committee has closely followed this reform and published a few contributions in the eNews of AIPPI.

3) Any recommendation for AIPPI involvement/action for the next 12 months

This need not be limited to recommendations for your Standing Committee but can be recommendations for AIPPI more broadly. In each case, please explain why such involvement/action is recommended, by whom it should be undertaken and any relevant time frames. For example, please include:

- a) any recommendation for involvement/action in relation to any upcoming or foreshadowed case law, legislative or regulatory developments, or policy initiatives
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We would recommend increasing the participation of AIPPI in the EUIPO activities.

We would recommend enhancing the involvement and visibility of AIPPI in the context of the Working Group for the Legal Development of the Madrid System held annually at WIPO. This could be achieved by taking a stance on the proposed changes or amendments in the substantive law or practice, even where no AIPPI Resolution applies (most changes are related to very specific legal aspects or practices regarding international trademarks). The importance of enhancing the involvement and visibility of AIPPI in said Working Group and its Roundtable lies in the weight and tradition of AIPPI, the geographical coverage and extended use of international trademarks, the degree of participation of other international associations, the openness of WIPO towards the stakeholders' views and the potential impact of certain proposed changes.

- b) any other recommendation(s) for AIPPI involvement/action
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It would be good to reinforce cooperation with the other IP associations.

4) Outline of the work programme of your Standing Committee for the next 12 months

Please set out specific activities and priorities having regard to the matters in 1) - 3) above, including any relevant time frames

The Standing Committee should continue to :

- respond to questions raised by EUIPO, WIPO or ICANN and try to submit position papers when possible,
 - respond to WIPO's informal request regarding various legal questions,
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- represent AIPPI at meetings organised by EUIPO, WIPO and ICANN,
- submit contributions to eNews.

The Standing Committee should reinforce its cooperation with EUIPO and involvement in various working groups.

During the next meeting in Milan, the Standing Committee will discuss whether to focus on a specific issue.

AIPPI

Names and Functions of Committee Members

Chair	Eléonore GASPAR	France
Co Chair(s)	Alexander VON MÜHLEND AHL	Germany
Secretary	Elena MOLINA LÓPEZ	Spain
Members	Abdurrahim AYAZ	Turkey
	Murat BASMACI	Turkey
	Torsten BETTINGER	Germany
	Loreto BRESKY	Chile
	Tobias COHEN JEHORAM	Netherlands
	Theresa CORNEAU	Canada
	Cesare GALLI	Italy
	Bartosz KARKOWIAK	Poland
	Sheldon KLEIN	United States
	Eduardo KLEINBERG	Mexico
	S. Yong LEE	Republic of Korea
	Jorge LLEVAT	Spain
	Alana LONG	Australia
	Elena MILLER	Bulgaria
	Anastasia MINDRUL	Ukraine
	Masako NISHIMURA	Japan
	Chihiro ONISHI	Japan
	Avi ORDO	Israel
	Graciela PEREZ DE INZAURRAGA	Argentina
	Dennis PRAHL	United States
	Aleli A. G. QUIRINO	Philippines
	Michael REINLE	Switzerland
	Joaquin SAYOC	Philippines
Lena SHEN	China	
Elisabeth SIEMSEN	Brazil	
Stoyan SIRAKOV	Bulgaria	
Shane SMYTH	Ireland	
Béatrice THOMAS	France	
Stefano VATTI	Italy	
Jan VLECK	United Kingdom	
Marieke WESTGEEST	Netherlands	
Peter WIDMER	Switzerland	