

Annette Kur – Max Planck Institute
Session 5.3 "What is the optimum system?"
Review of the European Trade Mark System

Brief outline

Background for the Study

Methodology (associations, OHIM and national offices, users' survey by Allensbach)

Results

- fees

- genuine use

- proposals for further harmonisation

- (national procedures/substantive law)



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The “Trade Mark Study“ – Agenda, Working Scheme and First Results

Prof. Annette Kur, MPI Munich

Schedule (Overview)

- **November 12, 2009: Signing of contract with COM**
- **From November 2009: Contacts & consultations with stakeholder organisations**
- **From November 2009: economic analysis of OHIM application & registration data by INNO-tec**
- **December 2009 – March 2010: Interviews with national PTOs (+ sending of questionnaires)**
- **February 2010 – April 2010: survey among CTM users conducted by IfD Allensbach**
- **June 1, 2010: Academic workshop, MPI**
- **June 8/9, 2010: Hearing with user associations, MPI**
- **June 17, 2010: consultations with members of OHIM BoAs, Alicante**
- **August 12, 2010: Draft Final Report delivered to COM**

- **November 12, 2010: Delivery of Final Report**



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Main impressions & results, I: PTOs, user organisations

- **National PTOs**
 - strong diversities in size, structure and workload
 - Partially critical attitude towards the present (perceived) imbalance vis-à-vis the CTM system
 - (nearly) unanimous wish for enhanced cooperation, creation of common platforms, exchange of information etc.
 - (mostly) cautious attitude vis-à-vis stronger role in enforcement matters
- **Right holder associations:**
 - Diverging views, depending on structure of membership
 - Basic consent that law & practices should become more harmonised
 - Enforcement is generally not considered as an issue that PTOs should become involved with



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Main impressions and results, II: The Allensbach survey

**The following slides were elaborated by IfD
Allensbach and show some results of the survey
(dated April 2010)**

**PLEASE NOTE that the results shown do not
determine the proposals endorsed by the Study
group.**



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Sample composition

Respondents by country

Q1: Where is the company or firm where you work located?

	Share in sample before weighting	Share in weighted sample	Structure of the CTM database
Germany	29%	29 %	29%
United Kingdom	11	10	10
France	7	12	13
Italy	8	8	8
Spain	5	8	9
Other EU Member State	39	32	31
Other country	1	1	-
TOTAL	100	100	100

- = no cases

A vast majority of users appreciate the benefits of the CTM system

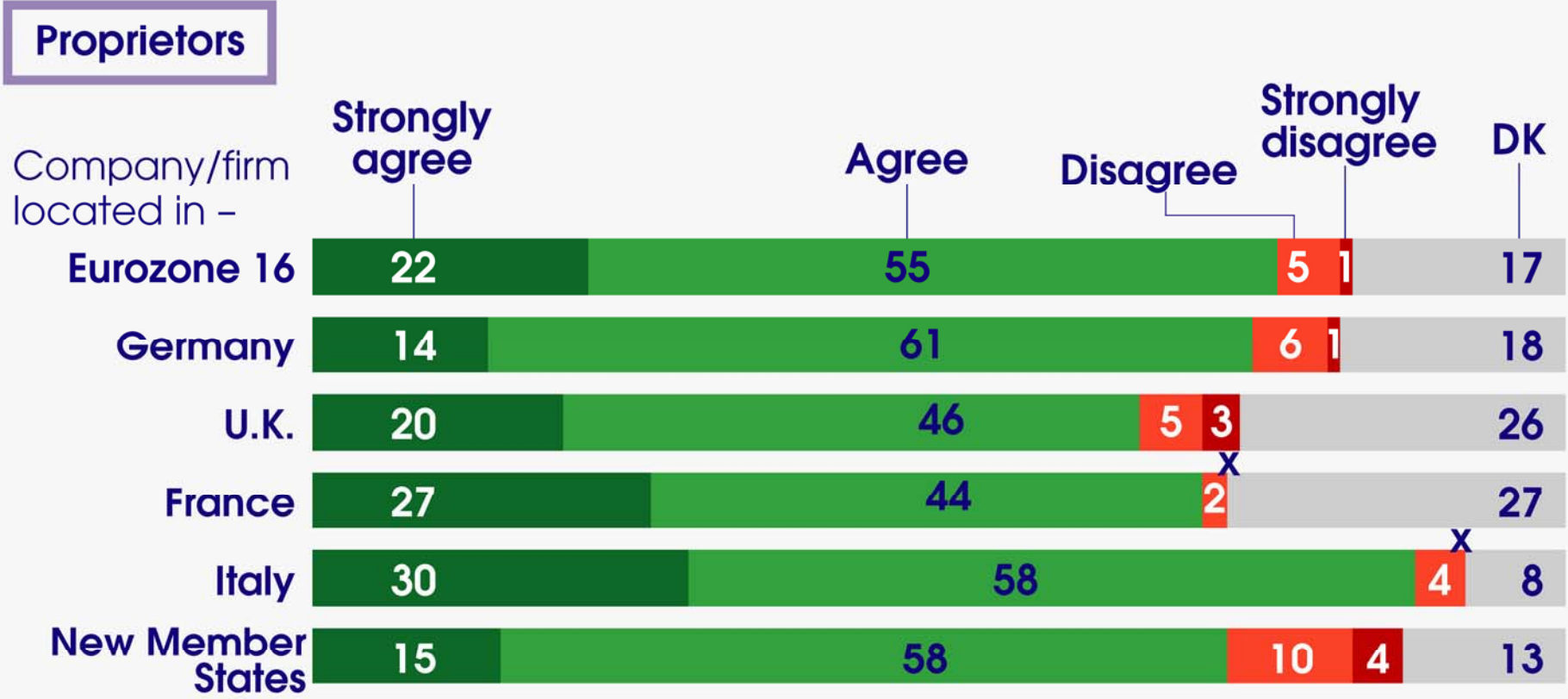
Q9: Please indicate how strongly you agree or disagree with the following statement:

The CTM system offers trade mark owners substantial simplifications and strongly expanded possibilities aside from national trade mark registrations.



Proprietors from new EU Member States are least convinced of the benefits of the CTM system

Q9: Please indicate how strongly you agree or disagree with the following statement: "The CTM system offers trade mark owners substantial simplifications and strongly expanded possibilities aside from national trade mark registrations".

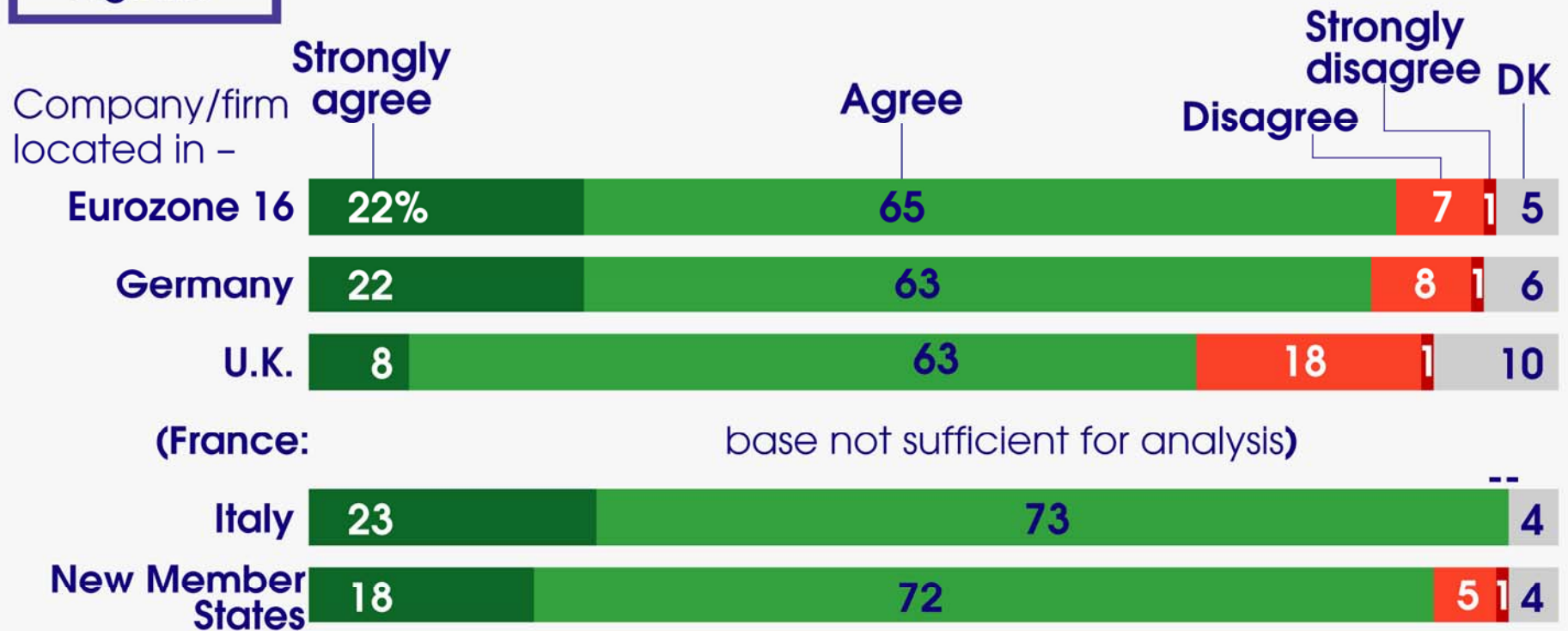


x = less than 0.5 percent

Agents from the U.K. are least convinced of the benefits of the CTM system

Q9: Please indicate how strongly you agree or disagree with the following statement: "The CTM system offers trade mark owners substantial simplifications and strongly expanded possibilities aside from national trade mark registrations".

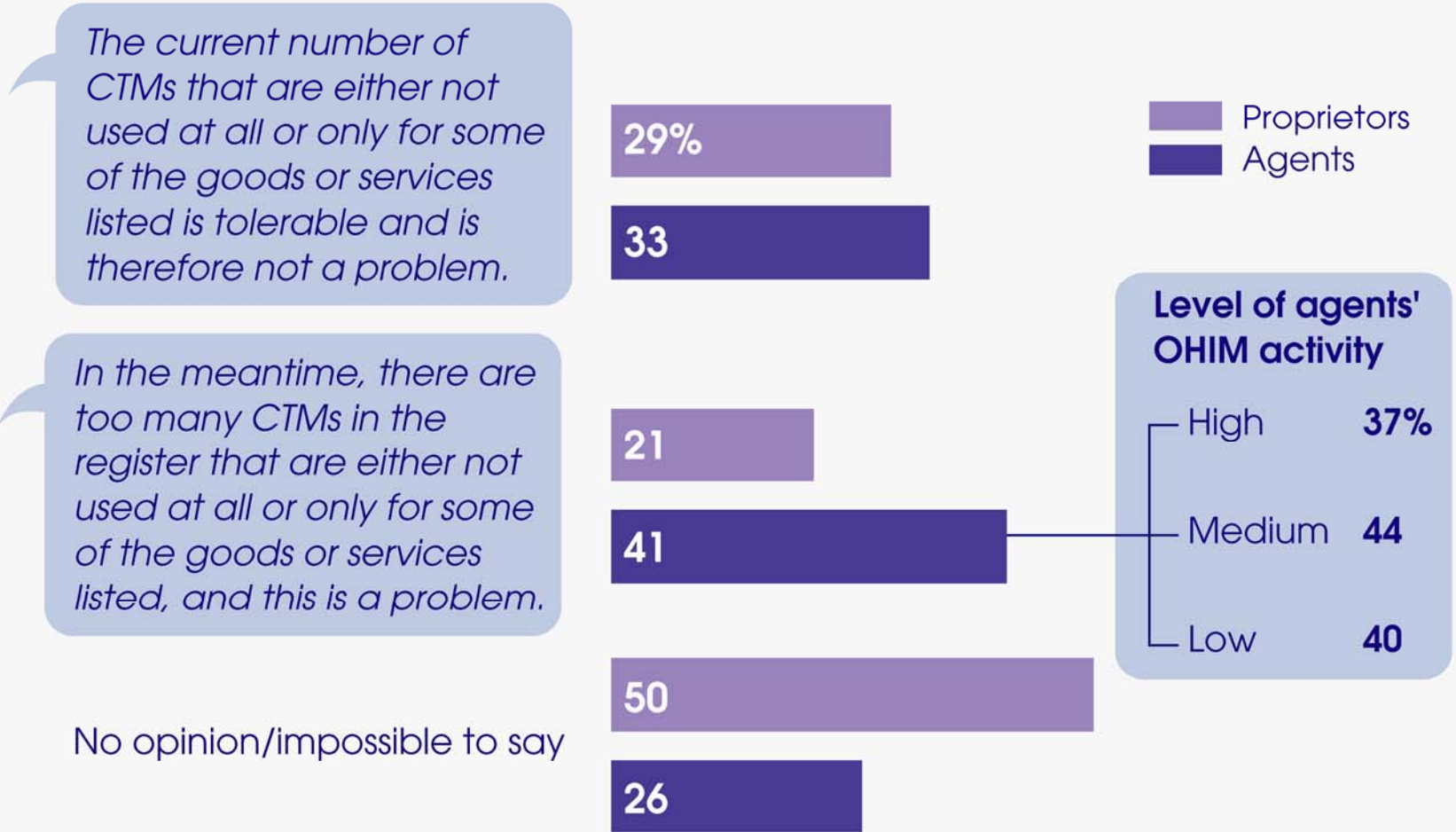
Agents



- = not cited by any respondents

The number of CTMs in the register is mainly a problem for agents with a low/medium level of OHIM activity

Q16: Which of the following two opinions do you share?



Evaluation of OHIM's current practice: Quality of decisions

Q13: Next, please assess the quality of OHIM's decisions for the following proceedings:

Base: Respondents who give an assessment



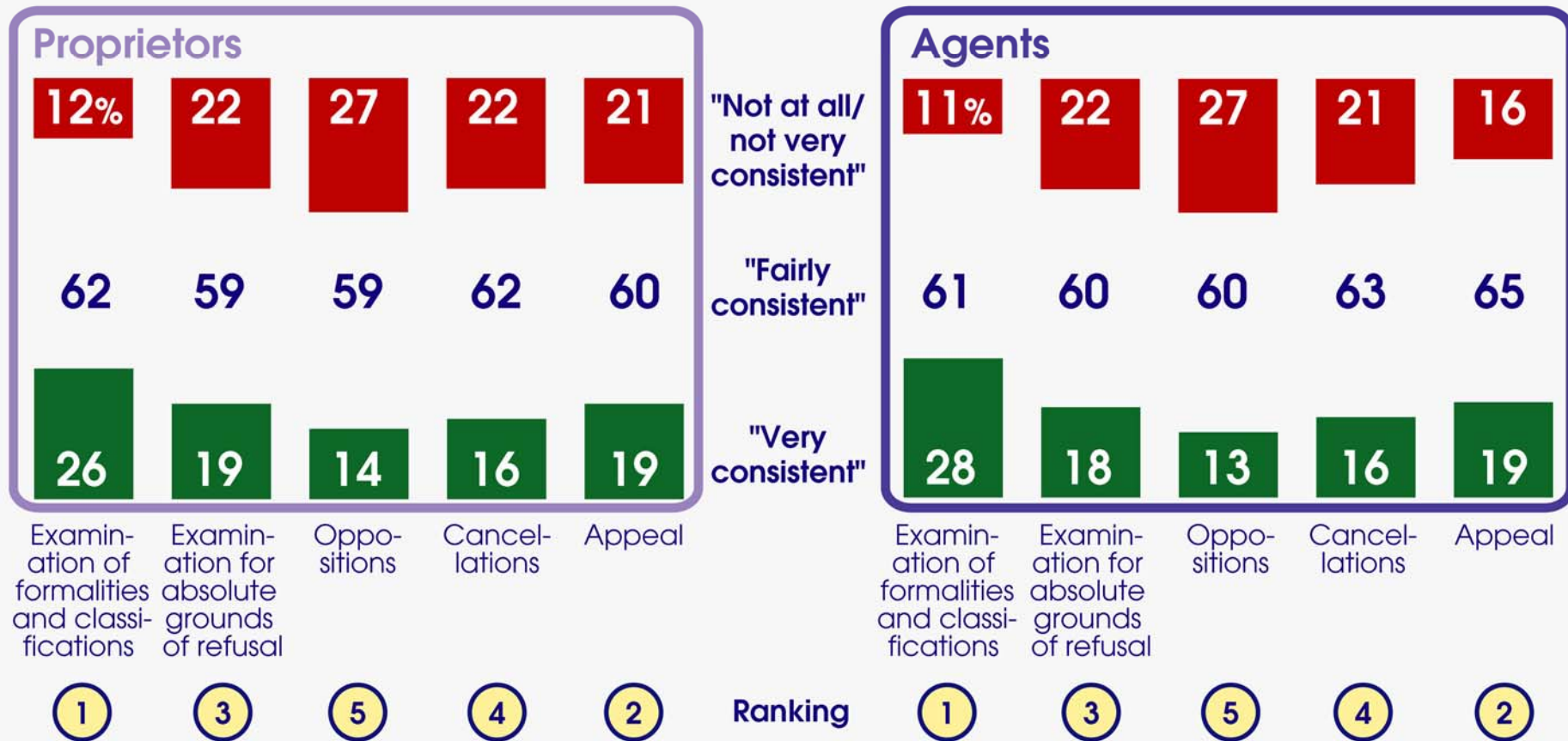
BASE: OHIM users registered in the CTM database
SOURCE: Allensbach Archives, IfD Survey 2784, February - March, 2010

Evaluation of OHIM's current practice: Consistency of decisions

Examinations of formalities and classifications are perceived as most consistent; cancellations and oppositions obtain the lowest scores

Q14: Now please assess the consistency of OHIM's decision-making for the various proceedings.

Base: Respondents who give an assessment

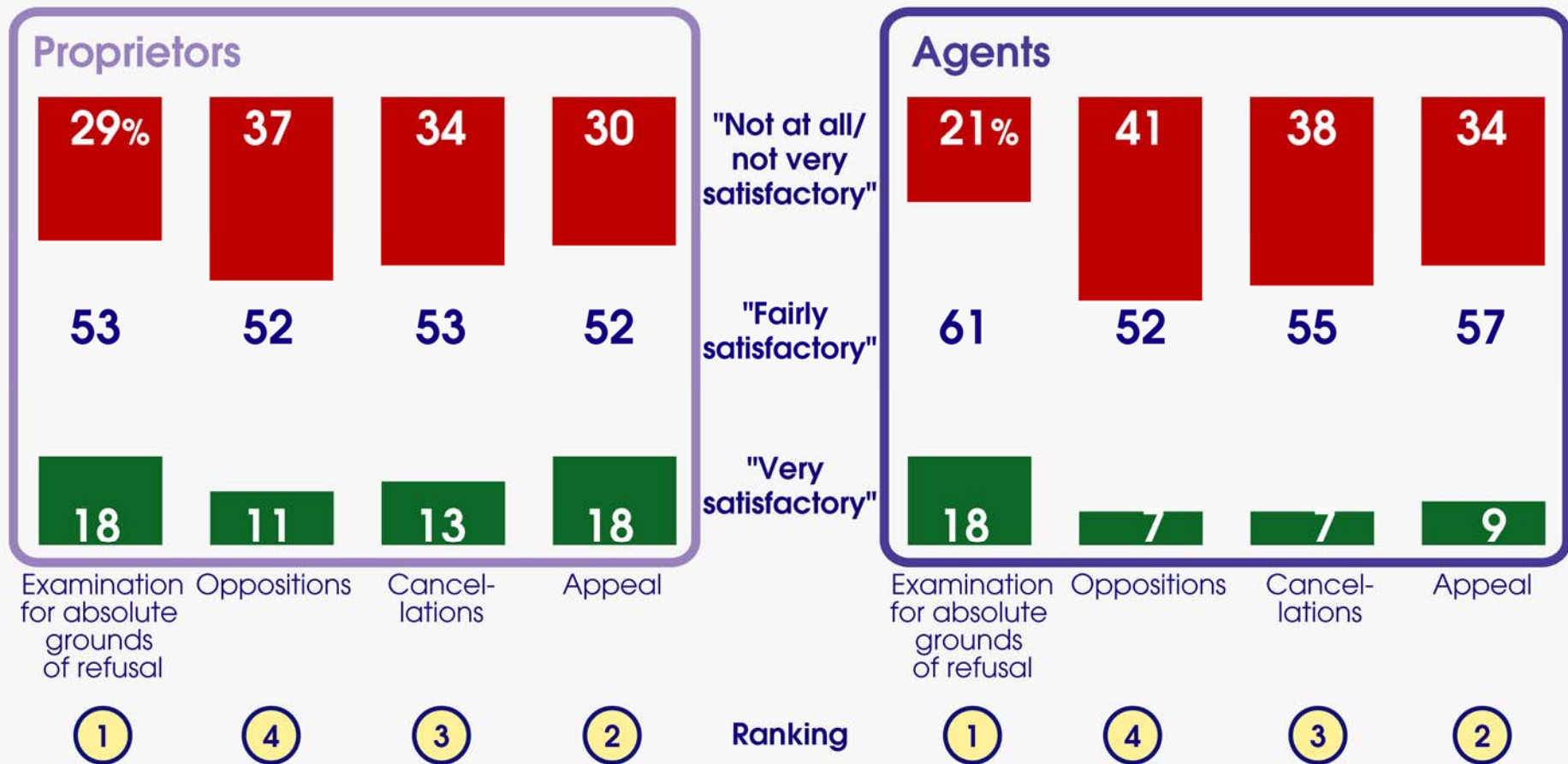


BASE: OHIM users registered in the CTM database
 SOURCE: Allensbach Archives, IfD Survey 2784, February - March, 2010

Evaluation of OHIM's current practice: Time it takes to issue decisions

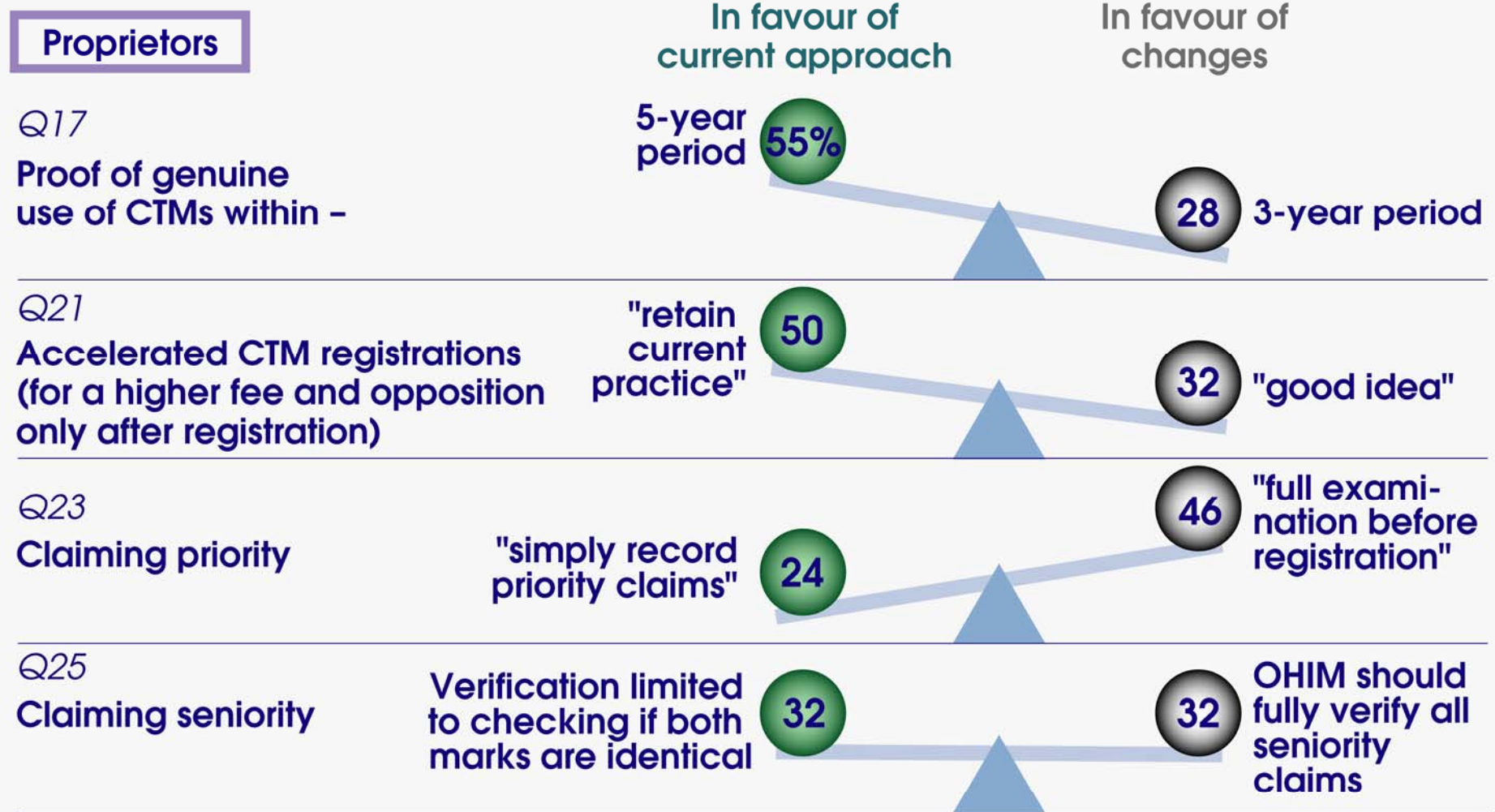
Q15: And finally, what do you think of the time it takes for OHIM to issue decisions?

Base: Respondents who give an assessment

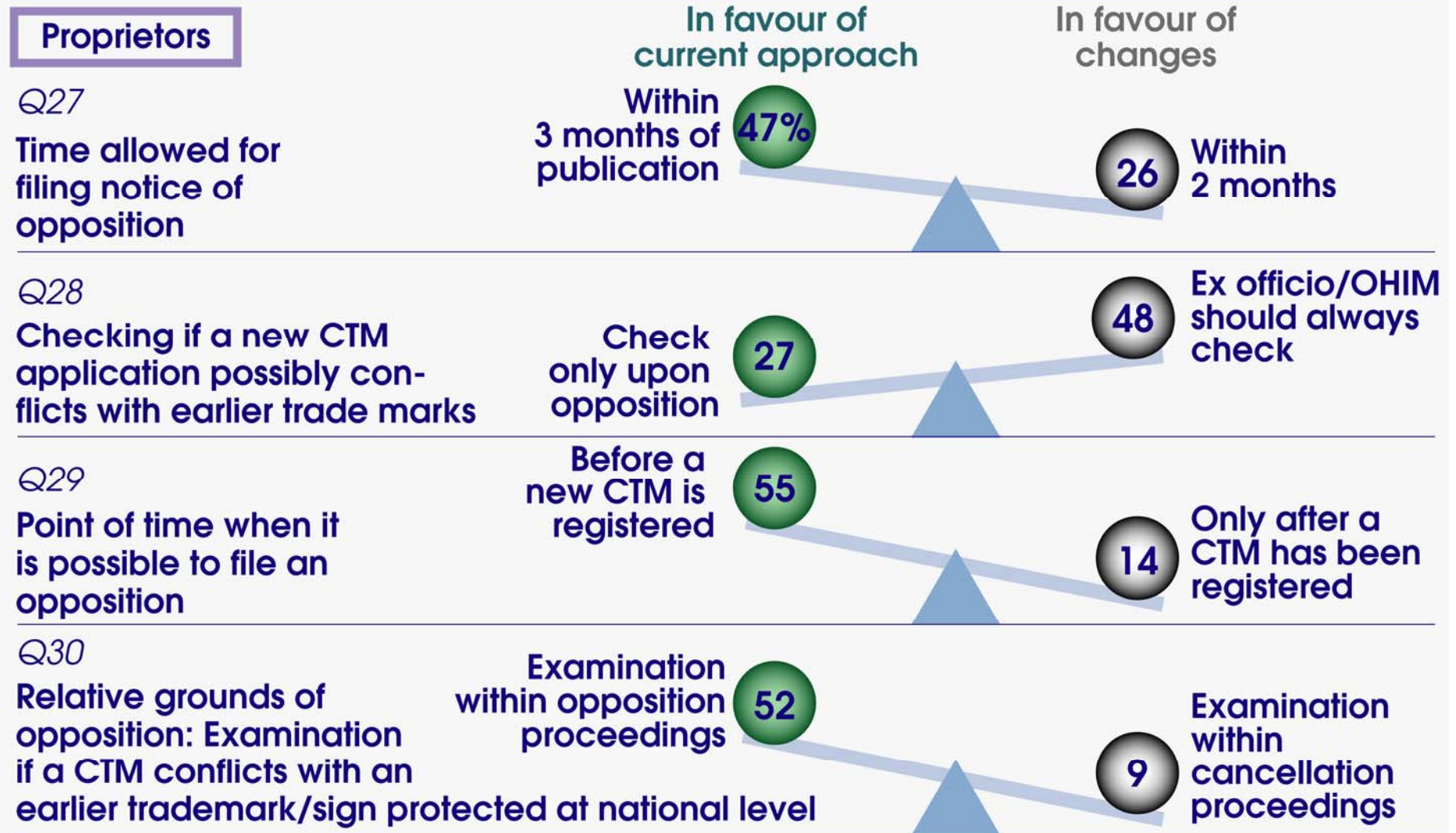


BASE: OHIM users registered in the CTM database
SOURCE: Allensbach Archives, IfD Survey 2784, February - March, 2010

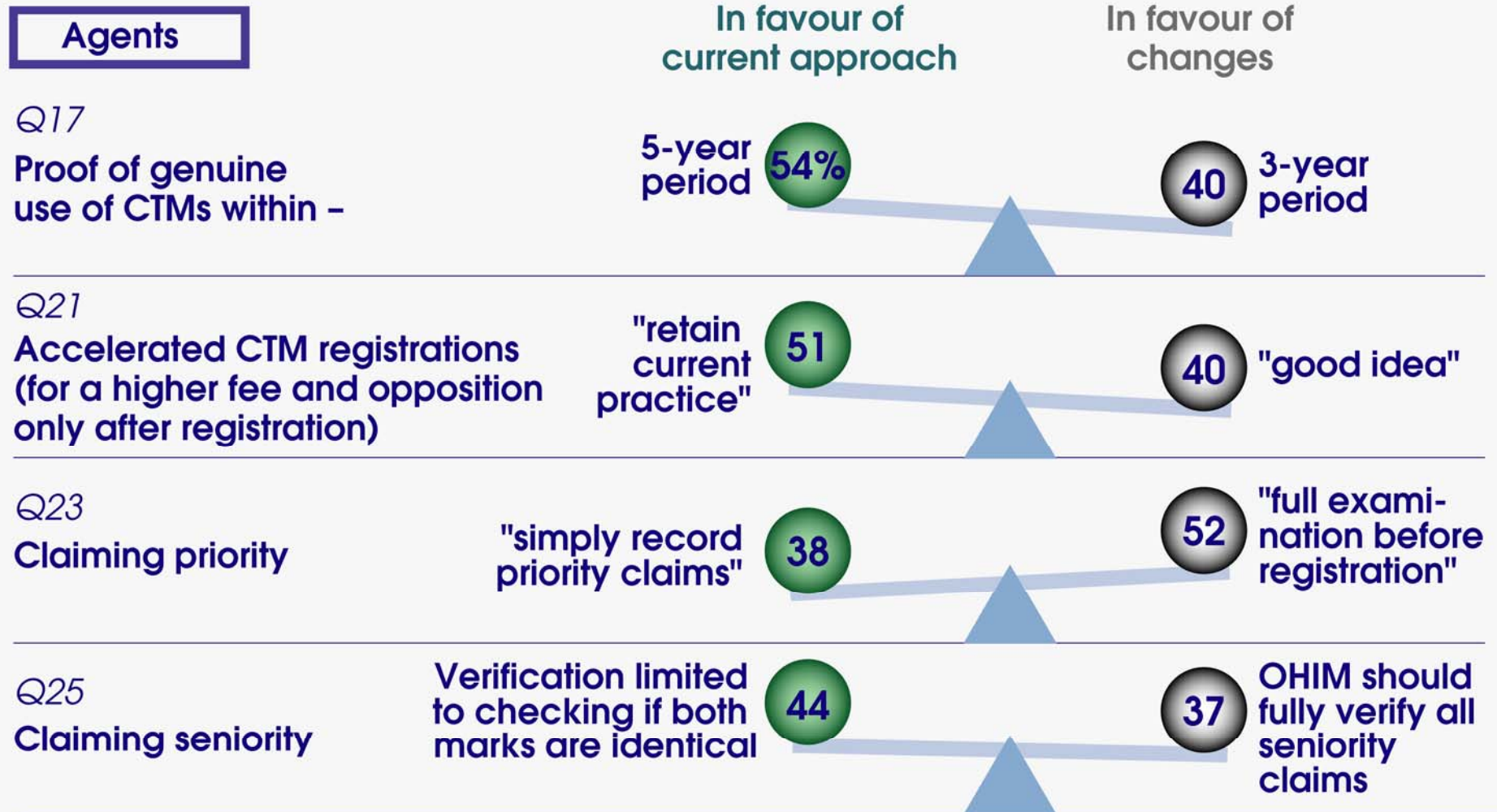
Proprietors think OHIM should carry out full examinations of priority claims, otherwise not much support for procedural changes



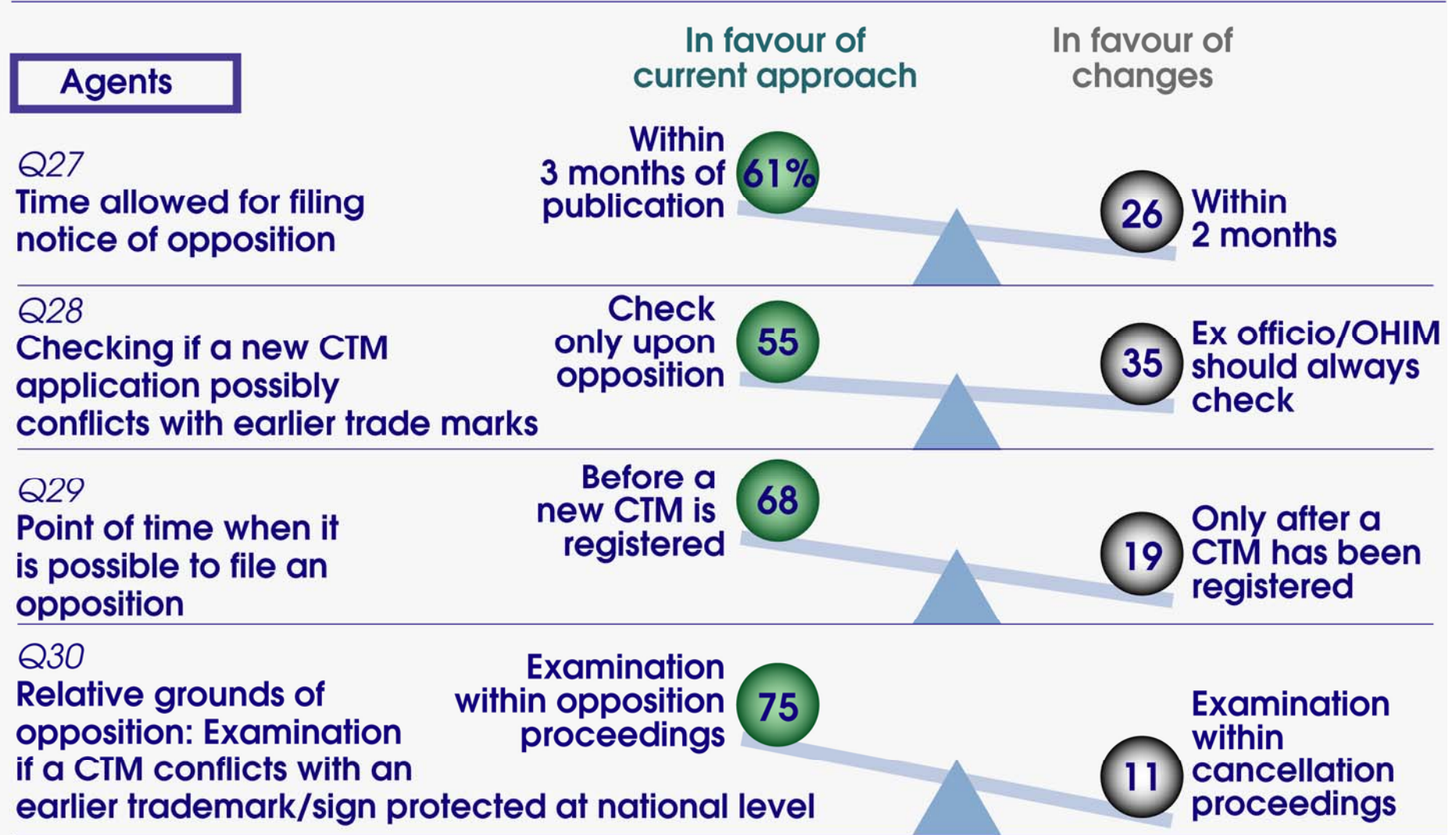
Proprietors also reject all other procedural changes, except for ex officio checks of possible conflicts with earlier trade marks



Agents favour full examination of priority claims; substantial shares of agents also favour shortening the period for proof of genuine use and accelerated CTM registrations



Agents reject all other proposed changes even more clearly than proprietors do



BASE: OHIM users registered in the CTM database
 SOURCE: Allensbach Archives, IfD Survey 2784, February - March, 2010

Proposals: Main topics & general features, I

- **Coexistence**
 - Coexistence remains to be crucial, but:
 - no “artificial“ barriers against registration of CTMs should be installed
 - the principle of unitary rights continues to be governing, including issues like “genuine use“
- **“Cluttering“**
 - No hard evidence was found that “cluttering“ of the CTM registry is a major problem, but:
 - the discontent voiced in respect of “too many, too broad, and unused marks“ at OHIM (or on the national level) is substantial enough to call for reaction



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Proposals: Main topics & general features, II

- **Issues proposed for Harmonisation (TMD)**
 - **Substantive law**
 - **Stronger alignment of absolute and relative grounds for refusal**
 - **scope of protection (marks having a reputation)**
 - **transfer and rights in rem**
 - **Procedural law**
- **CTMR and procedures at OHIM**
 - **Part of the changes proposed for harmonisation concern “common issues“ and should therefore likewise be implemented in the CTMR**
 - **not much support exists for (major) changes of procedure, but some issues should be addressed (classification, seniority...)**



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Enforcement

- Provisions modelled on Directive 48/2004/EC should be included into the CTMR
- Activities by national PTOs in the context of enforcement should primarily concern awareness-raising and collection/distribution of information
- Further active participation of national PTOs in enforcement measures would be less feasible and desirable



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