

Tokyo, December 5, 2014

## TM5 ANNUAL MEETING

Tokyo, Japan, December 3-5, 2014

### JOINT STATEMENT

The Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Office for Harmonization in the Internal Market (Trademarks and Designs) (OHIM), the State Administration for Industry and Commerce (SAIC) and the United States Patent and Trademark Office (USPTO), (hereinafter referred to as the “Partners”) held the 2014 TM5 Annual Meeting in Tokyo, Japan, between December 3rd and 5th, 2014.

The World Intellectual Property Organization (WIPO) was present as an observer, as it had been at the previous TM5 meeting.

At this meeting, the Partners exchanged views and information on common projects and new project proposals as well as on their respective operational practices with the theme of “Enhancing International Cooperation toward Creating User-friendly Trademark Systems” in order to share the basic concept for discussions.

During the Meeting, the Partners held a user session on TM5 projects for representatives of various user associations. Also, for the first time, the Partners held a user session for representatives of user associations and general users based on the theme of policies of non-traditional trademarks in the respective countries and region.

Acknowledging the growing importance of industrial design collaboration, the Partners agreed to separate the related matters currently covered by the TM5 collaboration into an industrial design forum. The Partners agreed that the industrial design forum should be conducted in an efficient and cost-effective manner such as meeting directly before or after TM5 meetings and at the same venue. In 2015, the TM5 meeting and industrial design forum will be held consecutively by the USPTO.

Only the trademark section of this joint statement applies to SAIC.

#### Trademarks

1. The following 12 projects based on the TM5 Overall Work Plan were discussed and agreed:

(1) TM5 Website: led by KIPO, with the JPO, USPTO, OHIM and SAIC participating.

- The Partners shared the information on the TM5 Website maintenance, including security management and regular updates and visitor statistics, expressing their anticipation that the website will be of greater use.

- The Partners approved the modification of the website interface for user convenience and better function and agreed to develop the official TM5 logo image for future promotion.
- The Partners also agreed on the significance of website contents and confirmed their willingness to provide information or materials to be uploaded and to promote the website. KIPO shall seek approval from the Partners for uploading the information or materials but it may upload them if no objection is addressed within the period that KIPO specifies.

(2) Comparative Analysis on Examination Results: led by KIPO, with the JPO, USPTO, OHIM and SAIC participating.

- KIPO assured that virtual examination would not be conducted for this project. In addition, it proposed a new approach, i.e., studying trademarks filed in the TM5 Offices through the Madrid Protocol.
- The Partners agreed on this new proposal with the understanding that KIPO would provide the Partners with lists of international registrations through the Madrid Protocol filed in one TM5 office (office of origin) designating the four other offices by the end of February 2015 and they would select 10 to 15 cases among those whose office of origin is itself in order to find out other offices' examination practices by the end of April 2015.
- The Partners agreed to continue to discuss contents and the total number of cases to be analyzed.

(3) ID List: led by USPTO, with the JPO, KIPO, OHIM and SAIC participating.

- The Partners approved the updated Rules of Governance for the ID List Project.
- The Partners agreed to develop technical guidelines that the ID List participants should endeavor to follow when submitting new proposals for the ID List.

(4) Common Status Descriptors: led by the USPTO, with the JPO, KIPO, OHIM and SAIC participating.

- The Partners approved the complete table of common status descriptors, as well as their corresponding definitions.
- The Partners agreed to be committed to implementing up to level 2 of the common status descriptors, as displayed on the chart presented at the midterm meeting.
- The Partners agreed to undertake work on future enhancements, such as the discussion on the design, choice, and method of utilization of icons.

(5) Taxonomy and TMClass link: led by OHIM, with the JPO, KIPO, SAIC and USPTO participating.

- OHIM reported on the progress of the project and the outcomes of the working group meeting 2014, in particular:
  - TM5 ID List search tool is ready to be launched and its plan to provide the link to the tool in the TM5 website
  - Work progress under the taxonomy feasibility study
  - Introduction of the TrafficLightSystem pilot exercise
- The Partners agreed that the TM5 ID List search tool is ready to be launched on the TM5 website in the beginning of 2015.
- The Partners agreed to hold next classification technical meeting in July 2015.

(6) User-friendly access to trademark information: led by the OHIM, with the JPO, KIPO, SAIC and USPTO participating.

- OHIM reported that trade mark data from the USPTO and KIPO have been searchable in TMview since December 2013 and February 2014 respectively.
- The feasibility of JPO integration shall be finalized in the upcoming months in view of the integration of trade mark data from JPO in 2015.
- OHIM will continue with the feasibility of SAIC integration during 2015, in order to promote step by step the integration of SAIC's trademark data.

(7) Common Statistical Indicators: led by the OHIM, with the JPO, KIPO, SAIC and USPTO participating.

- The Partners agreed upon the timeline for sharing of the statistical data.
- The Partners agreed to share the relevant data as expediently as possible.
- The Partners agreed on the indicators that are currently uploaded on the TM5 website and how they are presented.
- The Partners expressed interest in OHIM's forecasting methodology. OHIM agreed to share information on the methodology with the Partners.
- OHIM is pleased to receive proposals about possible improvements to the existing indicators and the development of new ones.
- The Partners also agreed based on KIPO's proposal to explore the possibility to hold a working-level meeting on the forecasting system during the TM5 Mid-term meeting. WIPO expressed its willingness to attend the meeting to share its expertise in such a system on the condition that the Partners so request.

(8) Continuation/Expansion of Bad Faith Project: led by the JPO, with the KIPO, OHIM, SAIC and USPTO participating.

- As the outcome of this project, the Partners approved the final version of a report entitled "Laws and Examination Guidelines/Practices of the TM5 Offices against Bad-faith Trademark Filings" that the JPO submitted. With the confirmation of the SAIC, the JPO will publish the Report. The Partners agreed to publish the Report on the TM5 website.

- The Partners also agreed to periodically revise the Report and hold seminars on bad-faith trademark filings, in order to provide updated information on bad-faith trademark filings.
  - The Partners further agreed to analyze the contents of the report after the publication as a next step.
- (9) Image Search: led by the JPO, with the KIPO, OHIM, SAIC and USPTO participating.
- As the outcome of this project, the Partners approved a report on TM5 Image Search that the JPO submitted. The JPO will upload it on the TM5 website, after the Partners agree that it be uploaded on the TM5 website.
  - In order to share the experiences of each office on image searches, the Partners agreed to provide updated information on their activities involving image searches, also agreeing to hold working-level meetings periodically.
- (10) Indexing of Non-Traditional Trademarks: proposed by USPTO
- The Partners approved this proposal as a TM5 project and they also approved a revised draft of this Project Brief, which was proposed by the USPTO.
- (11) Improve Convenience of Applicants of the Madrid Protocol by Enriching Information Provision: proposed by the JPO
- The Partners agreed on a standardized format for designated offices in each country to input information on their respective filing requirements for the Madrid Protocol.
  - The Partners agreed to input their respective information in the prescribed format and submit it to the JPO. The Partners also agreed that the JPO will compile and organize the information, in order to present the final version at the Fourth TM5 Annual Meeting.
- (12) TM5 Workshop: proposed by JPO
- The JPO presented a revised Draft of this Project Brief.
  - It was decided that the details of this project be further defined by the JPO (see (13) below).
- (13) Discussion on user involvement in the TM5 projects-OHIM.
- OHIM presented a proposal to improve user involvement in TM5 by inviting users to participate in the working group of the TM5 collaboration projects.
  - The Partners agreed that it is important to make TM5's activities and initiatives more transparent and efficient for the users, who are the main reason for the existence of

the TM5 forum.

- The partners entrusted OHIM to prepare the respective Project Brief to be presented at the next TM5 meeting.
- KIPO proposed the TM5 user session be held in the Mid-term Meeting, and the Partners agreed that a pilot TM5 User Session will be held at the 2015 Mid-term Meeting, in order to evaluate the feasibility of further user interaction with TM5. The host of the said session will be the USPTO.
- Given the close link between OHIM's proposal and JPO's proposed Workshop project, JPO and OHIM will then jointly prepare one Project Brief which covers all user involvements.

## 2. Session with users – led by the host country with the participating offices of JPO, KIPO, OHIM, SAIC and USPTO

### (1) Session in which representatives of user organizations participate:

- In this user session, JPO introduced 45 attendees from groups including JIPA, JPAA, JTA (JPO), KOTA and KPAA (KIPO), the CNIPA and UNION-IP (OHIM), and AIPLA and INTA (USPTO). There were approximately 30 questions from users.
- The Partners exchanged information and opinions with users on the TM5 collaborative projects.

### (2) Session in which representatives of user organizations and general users attended

- At the user session on trademarks for representatives of user organizations and general users, a total of 245 users attended.
- The Partners exchanged information and opinions with users about the reports on the past year's development in each office; and about non-traditional trademarks.

## 3. 2015 TM5 Secretariat

The Partners agreed that USPTO will act as the secretariat for the 2015 TM5 meetings.

## Designs

The Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), the United States Patent and Trademark Office (USPTO) (hereinafter referred to as the “Design Partners”) and the World Intellectual Property Organization (WIPO) participated in the design session 3<sup>rd</sup> TM5 Annual Meeting held in Tokyo, Japan, between December 3<sup>rd</sup> and 5<sup>th</sup>, 2014.

The OHIM led discussions on the next steps for the View and Drawing Requirements for the Design Project, for which the Design Partners have compiled a Catalogue. The Design Partners exchanged opinions on the legal provisions and guidelines for improve convenience of the users.

The Design Partners exchanged opinions to regularly maintain the Catalogue and the geographical extension of the Catalogue.

The Design Partners exchanged information with each other on their Hague Agreement accession and/or their implementation efforts.

The Design Partners also exchanged information on the Digital Access Service (DAS) for exchanging priority documents on designs as well as on each Office’s examination quality review system.

The Design Partners made proposals and exchanged opinions on future agenda items in the field of designs. The two projects, “Feasibility Study for 3D including Animated Designs” and “DesignView” were presented. It was agreed that OHIM will draft Project Briefs and present them at the next TM5 Mid-term Meeting in 2015. Furthermore, the Design Partners will continue the exchange of opinions on future agenda items.

Acknowledging the growing importance of industrial design collaboration, the Partners agree to separate the related matters currently covered by the TM5 collaboration by an industrial design forum (ID5).

The Design Partners agreed that ID5 should be conducted in an efficient and cost-effective manner such as meeting directly before or after TM5 meetings and at the same venue. In 2015, the TM5 and ID5 meetings will be held consecutively by the USPTO.

The Design Partners agreed to invite SIPO to the first ID forum meeting in 2015.