

TM5

Trademark Protection in Opposition and Appeal (Review) Procedure

Revision History

Version	Date	Lead Office
1.0	2021/11/4	CNIPA and EUIPO

Table of contents

REVISION HISTORY 1

1. BACKGROUND..... 3

2. PROJECT DEFINITION..... 3

 2.1. PROJECT OBJECTIVES 3

 2.2. PROJECT SCOPE AND EXCLUSIONS 4

 2.3. OUTLINE PRODUCTS/DELIVERABLES AND/OR DESIRED OUTCOMES 5

3. OUTLINE PROJECT PLAN: 6

4. ROLES AND RESPONSIBILITIES..... 6

5. ACCEPTANCE CRITERIA FOR THE DELIVERABLES 7

6. FINANCIAL ARRANGEMENTS 8

1. Background

Trademark opposition and appeal (review) procedures play an important role in protecting prior rights and the interests of consumers and the public. However, no project related to trademark opposition and appeal (review) procedures has been carried out under the framework of TM5.

This project will help Partner offices and their users understand the different legal system, legal application and examination and ruling practice of trademark opposition and appeal (review), and will benefit the users to protect their legitimate rights and interests more effectively in the trademark opposition and appeal (review) procedures before TM5 Partner offices.

2. Project Definition

2.1. Project objectives

This project plans to deepen users' understanding of the practice of trademark opposition and appeal (review) in TM5 Partner offices and to provide information to the users on how to protect their legitimate rights and interests more effectively through comparing the legal system and practice of trademark opposition and appeal (review) in TM5 Partner offices and by typical cases.

Phase 1: Opposition

Participating offices provide:

1. Information on their legal system for opposition; and
2. Case summaries of 3 typical opposition cases.
 - The Partners will provide the analysis and explanation of each case or make suggestions for protecting trademarks in similar cases.
 - A typical case is one that illustrates and explains common problems in trademark opposition. It can enlighten and help the applicants to better understand the application of law, can be used for applicants' reference in the trademark opposition procedure, or can be used to provide suggestions or tips to applicants.

The project will address in particular the following aspects of the opposition legal systems:

1. Opposition proceedings

Whether the Partner carries out ex officio examinations of earlier rights or advises existing rights holders of potential conflicts, at what stage a trade mark can be opposed, barriers to access the tribunal system (e.g., fees, legal standing to bring suit), and the main stages of an opposition (e.g., a pre-adversarial period to allow for amicable settlements, including encouragement or facilitation of mediation or other means of settlement, discovery and stipulated disclosures, oral hearing, etc.); and

2. Substantive provisions

The grounds on which rights holders can oppose, such as, earlier registered trade mark rights (e.g., likelihood of confusion, unfair advantage, tarnishment, dilution etc.), protected geographical indications, unregistered trade mark rights and other signs, copyright, design rights, bad faith, etc.

The lead offices will compile and publish a report containing the information and cases provided by the Partner offices.

Phase 2: Appeal (Review)

Participating offices provide:

1. Information on their legal system for appeal(review); and
2. Case summaries of 3 typical appeal (review)cases.
 - The Partners will provide the analysis and explanation of each case or make suggestions for protecting trademarks in similar cases.
 - A typical case is one that illustrates and explains common problems in trademark appeal (review). It can enlighten and help the applicants to better understand the application of law, can be used for applicants' reference in the trademark appeal (review) procedure, or can be used to provide suggestions or tips to applicants.

The project will address in particular the following aspects of the legal systems:

- (a) Institutional structure of the appeal (review)process, including, Appeal (Review) Body institutional framework, its structure, independence, appointment of Appeal (Review) Body's Members/Judges etc.
- (b) Scope of appeal (review) proceedings, decision-making processes, quality management of appeal (review) processes, relations of Appeal (Review) Bodies with external stakeholders (users, courts, etc.), alternative dispute resolution, etc.

The lead offices will compile and publish a report containing the information and cases provided by Partner offices.

2.2. Project scope and exclusions

It is in the scope of the project:

-Legal system information and typical cases in the trademark opposition and appeal (review) procedures.

It is out of the scope of this project:

- Legal system information and cases in the judicial procedures.

2.3. Desired outcome

Publishing a report on the trademark opposition and appeal (review) procedures on the TM5 website for users to download.

3. Outline Project Plan:

Date	Deliverable/milestone
May 2021	The lead office sends the project proposal to Partner offices for discussion.
By the end of August 2021	The lead office collects the feedback of Partners and amends the project proposal for discussion at the working-level meeting of TM5.
November 2021	The final project proposal is submitted for approval at the 2021 TM5 Annual Meeting.
January 2022	Start phase 1: Lead offices: send questionnaire and example case to Partners (CNIPA: example case; EUIPO: questionnaire).
Beginning of April 2022	Participating offices: submit the legal system information and typical cases in the trademark opposition procedure.
May 2022	The lead offices compile the material and circulate the first version of the report.
Before 2022 TM5 Working-level Meeting	The lead offices collect the feedback of Partners and revise the report.
At the 2022 TM5 Annual Meeting	The final version of report will be submitted for approval by the Partner offices, and then it will be uploaded to the TM5 website with the help of KIPO after annual meeting.
January 2023	Start phase 2: Lead offices: send questionnaire and example case to Partners (CNIPA: example case; EUIPO: questionnaire).
Beginning of April 2023	Participating offices submit the legal system information and typical cases in the trademark appeal (review) procedure.
May 2023	The lead offices compile the material and circulate the first version of the report.
Before 2023 TM5 Working-level Meeting	The lead offices collect the feedback of Partners and revise the report.
At the 2023 TM5 Annual Meeting	The final version of report will be submitted for approval by the Partners, and then it will be uploaded to the TM5 website with the help of KIPO after the 2023 TM5 Annual Meeting.

4. Roles and Responsibilities

Lead Offices:

- Responsible for making questionnaire and providing example case for Partners' reference.
(CNIPA is responsible for the example case and EUIPO is responsible for the questionnaire).
- Responsible for compiling and publishing the material provided by participating offices; bear the cost of compilation, typesetting and layout of the report.

Participating Offices:

1. Provide legal system information (through filling in the questionnaire), typical cases attached with analysis and explanation or trademark protecting suggestions;
2. Bear the cost of collection and analysis of typical cases.

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5. Acceptance Criteria for the deliverables

- Reports on the trademark opposition and appeal (review) procedures.
- The lead offices will integrate and address comments received during the revision exercise. Deliverables discussed during Midterm Meetings and approved during Annual Meetings prior to their publication and dissemination.

6. Financial arrangements

1. The TM5 Partners will bear their own expenses for transportation, accommodation, and travelling during the arranged meetings.
2. The TM5 Partners will bear parts of the costs according to the agreed responsibilities, e.g., KIPO hosting the reports on the TM5 website, CNIPA and EUIPO the costs of coordination and creation of the deliverables, etc.

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