



# OHIM

## The year in review

*WTR* reveals the top Community trademark filers for the past 12 months and canvasses their opinion on OHIM's performance and the latest developments in the European trademark industry

View from OHIM: the Observatory  
View from OHIM: mediation services

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# OHIM users have their say on a year of change in European trademarks

As part of our annual OHIM focus, *WTR* polled the office's top filers to gauge their perception of its performance and address some of the most pressing issues in the European trademark industry – and asked OHIM to provide an update on its activities

If one recurring motif has emerged over the past 12 months at the Office for Harmonisation in the Internal Market (OHIM), and looking ahead to the future, it is that of tools. Tools are central to OHIM's current mission and to its future expansion, both figurative and literal – this year it picked up hammer and nails to start building work on a major office extension in Alicante.

For users, it is the tools designed to develop and streamline OHIM's trademark offerings that are most important. These offerings are central to the mandate of the Cooperation Fund, which encompasses 18 such projects (two of which – TMview and TMclass – were already in existence before the fund's establishment). In November 2012 nine new tools were released online: search image, the common examiner support tool, the common gateway for applications, quality standards, the common user satisfaction survey, Designview, CF Similarity, e-learning for small and medium-sized enterprises (SMEs) and a new workflow console for TMclass. With this in mind, *WTR* polled the top Community trademark (CTM) filers to determine how helpful such aids are in practice and how users would rate OHIM's general performance over the past 12 months. We also investigated the impact of recent European Court of Justice (ECJ) decisions and the proposed overhaul of the European trademark framework.

## A new view

We begin with the assessment of OHIM's new tools. Of the two pre-existing aids, TMclass was the most widely used among the filers polled by *WTR*. The system – which is based on the Nice Classification and helps users to classify goods and services correctly when filing a trademark – was hailed as a useful offering that, according to one survey respondent, "is likely to become essential for the future".

That said, improvements could still be made through the addition of all accepted terms. Lidy-Anne Jeswiet, head of trademark practice at Gevers, further observed: "It is good for finding commonly used expressions, but for more technical terms it is not always that easy to use, because there are constantly new concepts and inventions to take into account – for instance, CLOUDS ('virtual storage of information') – so it has to be followed very closely."

The second pre-existing tool, TMview, is an online system that conducts trademark searches across all participating offices. Of the users polled by *WTR*, an overwhelming majority also availed of TMview on a regular basis (see figure 7) and it was similarly perceived as a positive offering.

However, while TMview won praise as "a really quick and useful tool – one of the best things OHIM has done", it is not yet regarded as a cost-free alternative to traditional service provider search options, and improvements were once again suggested.

The biggest drawback identified is the lack of an option to save configurations and preferences. Verena von Bomhard, a partner at Hogan Lovells, explained: "I use it to check single records, but not for searches. It does not offer a way of producing and downloading overviews and lists, of maintaining records and adding additional records from other searches, etc. However, it is still useful, as it provides access to official records which sometimes allow us to verify data provided by other database/search providers."

Building on the TMview model, a companion system, Designview, is also now live. However, awareness of this offering is much lower – more than two-thirds of the top filers questioned by *WTR* had not yet used the system. Those made aware of the tool appeared willing to try it out, but there is obviously some work to be done in terms of raising its profile among the trademark community.

This is also true of CF Similarity, a search tool which can be used to assess whether specific goods or services are considered similar (and to what degree) by participating IP offices.

Over half of respondents had not used the offering (although a number expressed interest in the concept and stated their intention to investigate further). One in-house trademark counsel told *WTR*: "It is a very promising and useful tool, but it should be more prominently displayed on the OHIM website, for instance with the degree of prominence given to TMview".



Away from the Cooperation Fund's new offerings, existing online tools continued to receive attention, with the e-filing system the main facility availed of by filers (see figure 6). The e-opposition procedure, meanwhile, was frequently used by the majority of users polled (67%), although less so for complex cases or those involving large attachments.

### Getting the day job done

Of course, tools are simply a means to an end, and for users the primary concern is that the offerings available support OHIM's core work – that of maintaining the CTM register – rather than becoming a preoccupation in and of themselves. OHIM has repeatedly stated that this remains its central focus, so *WTR* quizzed the top filers to see how they viewed its performance in key areas.

Overall, the response was positive – 58% rated OHIM as 'good' or 'very good' (a +8% swing compared to last year's results) and 18% as 'satisfactory'. Among the particular areas of improvement identified were server stability, the speed of examination and registration procedures, database offerings and general consistency.

However, almost one-quarter of respondents were less enthusiastic about OHIM's performance (see figure 1), with concerns over oppositions handling the main reason for the dropped marks (more on this later). Other prospective improvements that users felt merited attention were a more commercial view in examination and *inter partes* proceedings, the development of a "complaints procedure with teeth" and increased fax capacity. One in-house trademark counsel stated: "Additionally or alternatively, it would be good if OHIM allowed the filing of substantial submissions, such as substantiations of grounds or writs for proof of us, via email. This would avoid deadline problems possibly created via fax blockage."

Drilling down to the handling of CTM applications, over two-thirds of respondents rated this as 'good' or 'very good' (see figure 2), with less than one-fifth regarding it as 'unsatisfactory'. In terms of gripes revealed in the feedback, "consistency in absolute grounds examinations" pipped "consistency in examination of specification of goods/services". One brand owner expanded: "From time to time, we encounter unreasonable notices of refusal on absolute grounds, issued possibly by overzealous examiners. The practice by national offices in the EU regarding examination on absolute grounds is also far from being harmonised and needs to be addressed."

Elsewhere, the handling of RCD applications was almost universally praised (93% rated it as 'good' or 'very good', with the remaining 7% not having an opinion). Users felt that the system is user friendly and fast, with any potential improvements suggested relating to technical considerations. One private practitioner recommended that the system be revised to allow additional images to be submitted: "Currently only seven images are taken into

account, but it should be possible to file more than seven if you want to rely on them as a priority claim elsewhere. Because of the system's limits, you currently need to fax additional images through."

### Opposing views

As mentioned earlier, OHIM's performance in terms of CTM opposition actions proved divisive among the filers that *WTR* surveyed. While two-thirds rated its performance as 'good' or 'very good', 12% felt it was 'unsatisfactory' and a similar percentage labelled it 'poor' or 'very poor'.

Once again, consistency was the main concern. Carrollanne Lindley, partner at Kilburn & Strode LLP, said: "It all depends which opposition division one gets – there is no uniformity of standard." Another filer confirmed: "We have certainly observed issues with consistency. We had two decisions on parallel matters where one division held the signs to be similar, whereas another division on the parallel decision considered the signs to be dissimilar."

A key drawback in this regard is that different divisions can refuse to consider judgments from previous actions. One private practitioner concluded: "The quality of OHIM decisions, particularly in opposition and appeal proceedings, remains inconsistent and is often very poor. Moreover, the office seems unwilling or unable to properly respond to complaints regarding poor-quality decisions."

Turning to CTM appeals, OHIM's efforts were unanimously regarded as 'satisfactory' or above – with 64% labelling them 'good' or 'very good'. France Delord, a partner at Taylor Wessing, opined: "Board of appeal decisions tend to be a refreshing counterbalance to the inconsistencies found at first instance level." That said, some improvements were suggested, including allowing for mutually consented suspension requests on a more general basis as soon as the notice of appeal has been introduced, and greater "quality controls so that obvious errors by the board in reaching its decisions can be rectified without the appellant (or other interested parties) having to go to the enormous expense of a further appeal to the General Court".

While most feedback was positive, one respondent who wished to remain anonymous characterised the appeals procedure as "Kafkaesque", stating that "even to relatively straightforward procedural issues, different boards take different approaches". In addition, the filer commented: "What we have found disturbing is that recently, when a file is ready for decision, board members actively propose and even try to impose mediation. This leads to very significant delays in the appeal proceedings and generally comes at far too late a stage, when sophisticated parties have long pondered and possibly attempted settlement."



### Active observation

The possibility of mediation as an alternative to appealing trademark and design decisions to the Boards of Appeal is a new initiative which OHIM has begun promoting to users (for more see page 40). One drawback, however, is that mediation makes most sense at the outset of a conflict rather than at the appeals stage, when the parties will have already invested time and resources in the resolution of the issue. Gevers' Jeswiet explained: "If we are the ones filing the appeal, we will have to file the statements of grounds before requesting mediation, in which case the client has already paid most of the costs in the appeal and is not keen on postponing the matter further. Besides, we have in general already tried to settle the matter well before getting to the appeal stage. If, however, we are not the ones filing the appeal, we are generally happy with the outcome of the decision and would like the Boards of Appeal to maintain the Opposition Division's decision."

Another relatively new activity for OHIM is its oversight of the European Observatory on Infringements of Intellectual Property Rights. In September 2012 the first meeting of the OHIM Observatory Plenary took place, outlining a work programme that included the creation of an enforcement repository database and a series of training programmes to disseminate best practice across the European Union (for an update on the observatory's activities, see page 38).

Perhaps the most high-profile project is a study identifying the most IP-intensive industries and the extent of their contribution to the European economy. While a handful of respondents were unsure what impact such a study might have outside IP circles, for the most part these efforts to afford intellectual property a tangible economic value were welcomed. Jeswiet suggested: "It might help to convince all levels in society that IP rights are useful rights and thus that infringing them may have important consequences, in the end, for all of us. People, governments and consumer organisations

are generally more sensitive to hard figures." Another European filer added: "I am always in favour of promoting IP and the respect that is due to it. Therefore, I am certainly curious regarding the findings of the study once released. Let's first see its content and then consider how it should be used."

Other respondents agreed that the study would also be useful for public image purposes, but that its wider impact would depend on the findings themselves and how the observatory uses them.

### The genuine use debate – is resolution any nearer?

Away from Alicante, the past year has seen two issues that affect both OHIM and wider industry practice discussed at ECJ level – genuine use of a CTM and the treatment of class headings.

The debate over exactly what constitutes 'genuine use' of a CTM in the Community has been a protracted one. In *Leno Merken BV v Hagelkruis Beheer BV* (Case C-149/11, December 19 2012) – often referred to as the *ONEL* decision – the ECJ found that while use of a CTM in one member state may suffice to establish genuine use in the Community, "all facts and circumstances" should be considered. It ruled out a *de minimis* rule and suggested that the bar for showing genuine use within the Community is somewhat higher than that for showing the same in a specific member state.

Discussion at the European Communities Trademark Association (ECTA) annual conference, held in Bucharest this June, reflected the divide in opinion over the likely implications of the decision. Providing the multinational's perspective, Myrtha Hurtado Rivas, global head of trademarks, domain names and copyright at pharmaceutical company Novartis, felt that the decision will have few practical ramifications for her organisation: "Before *ONEL*, we knew that 'all facts and circumstances' had to be taken into account. So what is new? It did state that national borders should be discarded and clearly states there is no *de minimis* rule – but as lawyers, we knew the court would not

provide a *de minimis* rule. So for me, there is no real impact for international companies after the decision.”

By contrast, Alexandra von Bismarck – a partner at Field Fisher Waterhouse and professor of law at GGS German Graduate School of Management and Law – suggested that uncertainty over the assessment of genuine use may prompt SMEs to reconsider existing strategies and to “increasingly turn their attention to national registrations”.

This sentiment was echoed by another private practitioner, who told *WTR*: “We believe it is correct that use in one member state can suffice, as this is important for protecting the integrity of CTMs. However, the decision has cast some doubt on whether genuine use in one member state is going to be sufficient and this may lead to increased filing of national applications.”

Delord expanded further: “As no clear answer has been given and the court would not say what the minimum amount of required use is, this will lead to uncertainty and more discussion in the future as to whether a CTM’s use is genuine. This is a disappointing decision for trademark owners – we cannot assume that use in, for example, Germany will be sufficient to maintain a registered trademark. Owners of CTMs which are not used throughout the EU should be considering their registrations in light of the decision and whether to file further national applications.”

Elsewhere, there was a sense that the ruling is reasonable, despite the lack of clear guidance. Dehns’ Ashley Benjamin commented: “The decision simply confirms previous case law and guidelines – that is, use in one member state is enough to show use in the Community. The CTM is a unitary system and the European Community is a single market, and it would therefore be contradictory to base proof of use assessments on the particular member states for which use is shown. You can’t have your cake and eat it too!”

One brand-owning respondent agreed that “it is a good thing that use in one country of the EU is not necessarily sufficient in order to prove use of a CTM in the entire EU”, adding: “Still, the decision makes it less predictable for trademark owners to know under which circumstances use of their trademark in certain countries or parts of countries will be considered sufficient. So I expect there will be quite a lot of diverging OHIM case law before the ECJ makes the ramifications more clear in future judgments.”

Considering how the decision will influence their advice to clients, one private practitioner opined that there will still be a need to cover all bases by recommending that CTMs be used in more than one member state. For Simone Verducci-Galletti of Bugnion SpA in Italy, “The decision is a step forward, but not a particularly big one, as we would say. The position of the ECJ is correct, but a real criterion to assess the kind of use is still missing. The decision has, of course, an impact in our day-to-day work. We will have to clearly inform clients that they have to make a use of the mark as much as they can, but it is to early to say, ‘Yes this use is fine’ – unless obviously you are not using the mark everywhere.”

Perhaps the most succinct conclusion came from Jeffrey Parker of Jeffrey Parker and Company, who stated: “It seems a logical decision to me, and as usual doesn’t really decide anything!”

### Lost in translation

The second ECJ ruling to spark intense debate is *IP TRANSLATOR* (Case C-307/10, June 19 2012), which relates to class headings. The ECJ ruled that “the goods and services for which the protection of the trademark is sought must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trademark”. As a result, the use of

### Survey methodology

In July 2013 *WTR* sent out a survey to the top 50 agent filers of CTMs and top 40 brand-owning filers listed in the tables.. Respondents were asked 30 questions on a range of topics, designed to explore current issues surrounding the European trademark regime and to assess OHIM’s performance over the past 12 months. The key results are set out in the text and accompanying graphics. In order to guarantee candid answers, respondents were offered the option of having their comments unattributed when used in the article.

Figure 1. In general terms, how would you rate OHIM’s performance over the past 12 months?

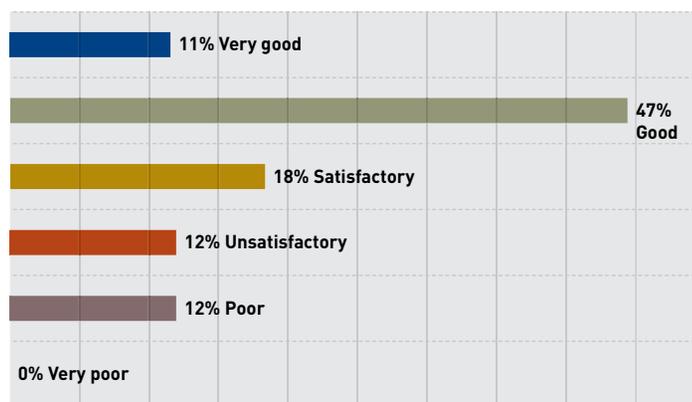
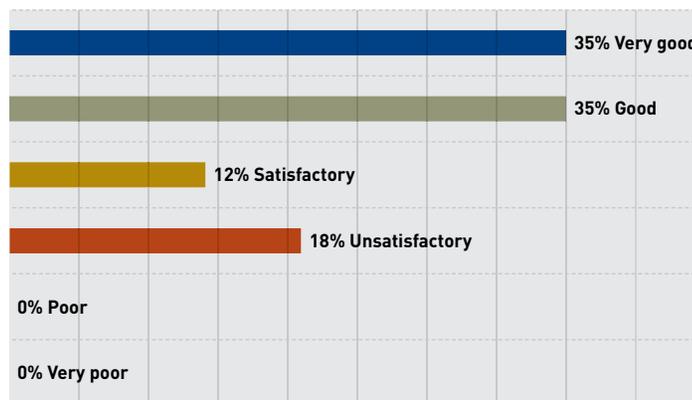


Figure 2. In general terms, how would you rate OHIM’s performance in terms of handling CTM applications over the past 12 months?



class headings from the Nice Classification system may suffice for some classes, but not all.

In response, OHIM wasted no time in repealing its Communication 4/03, which stated that the use of class headings in the specification of an application effectively meant that all goods or services within that class were covered by the trademark (a ‘class headings cover all’ approach). Instead, its swiftly issued Communication 2/12 explains that for CTMs registered before the new communication entered into force which use all of the general indications listed in a particular class heading, “the office considers that the intention of the applicant... was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made”. Similarly, for applications not yet registered before the communication took effect, OHIM will consider that the applicant’s intention was to cover all goods or services listed in the particular class, unless it has specified that protection is sought only in respect of some of the goods and services. Going forward, applicants that use all general indications of a particular class heading “must expressly indicate whether or not their intention is to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services in that class”.

Again, opinion on the decision is divided. Some, like Parker, have slated it as “a logical but crazy decision. The result – that we now have specifications of goods and services that can be three or four or more pages long and over a hundred pages when translated – is an example of complete impracticality, in my opinion. The rest of the world must be laughing at us,” he concluded bluntly. Others believe the judgment is at least a step in the right direction.

For his part, Delord contends that the decision has done nothing to resolve the issue of over-wide specifications: “It is now possible, for example, to claim the class heading, the alphabetical list of goods and services falling within a particular class and also particular goods of services of interest to the trademark owner. The decision is not likely to reduce the length of specifications. It will also not make advising on clearing rights any easier. Furthermore, the fact that it will be possible for trademark owners to state whether CTM registrations pre-dating the *IP TRANSLATOR* case cover all of the goods and services in a class or not will lead to more uncertainty in the future, as a registration for a class heading may

Figure 3. In general terms, how would you rate OHIM’s performance in terms of CTM opposition action over the past 12 months? Has it improved over the previous year?

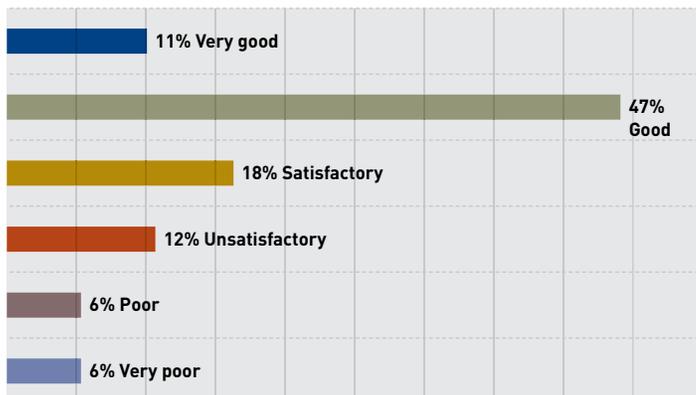


Figure 4. In general terms, how would you rate OHIM’s performance in terms of CTM appeals over the past 12 months?

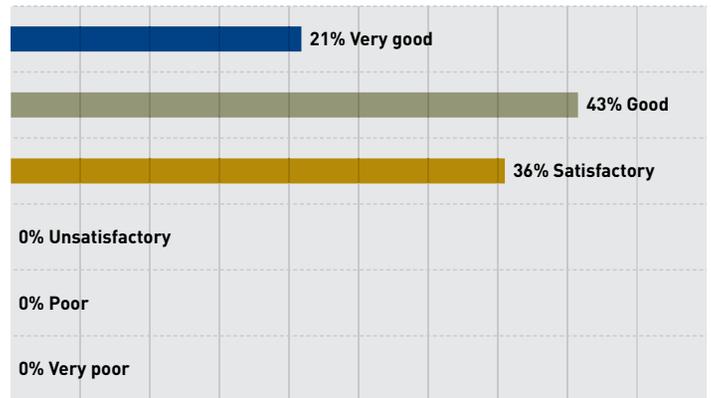


Figure 5. In general terms, how would you rate OHIM’s performance in terms of handling RCD applications over the past 12 months?

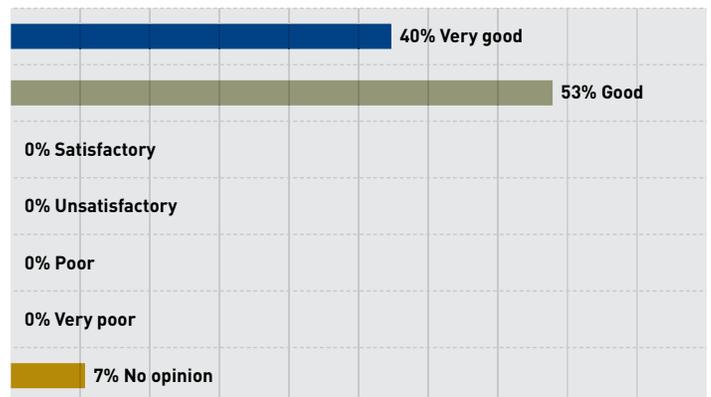


Figure 6. How often do you use the e-opposition procedure?

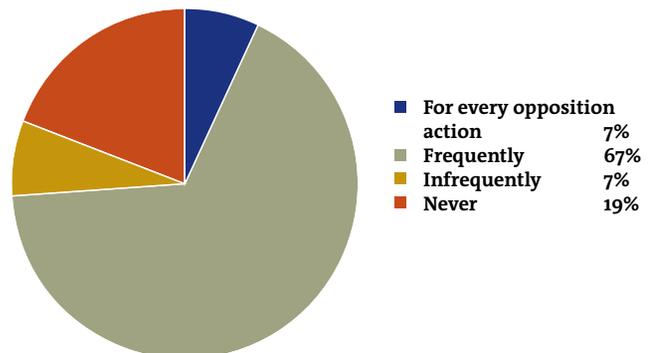


Figure 7. TMview is now three years old. Do you regularly use the system?

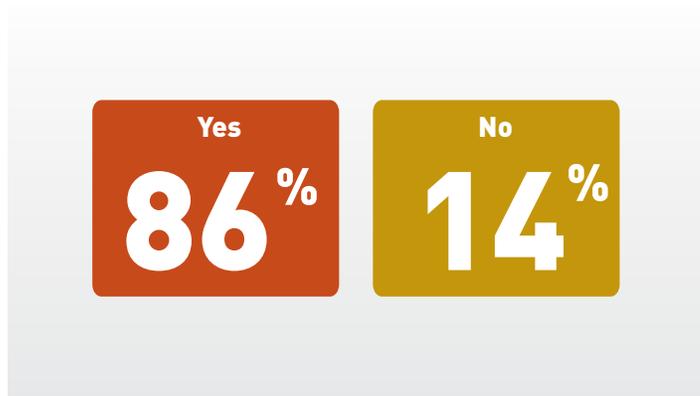


Figure 10. Have you read the European Commission's proposals to recast the Trademarks Directive, revise the CTM Regulation and revise the fees payable to OHIM?

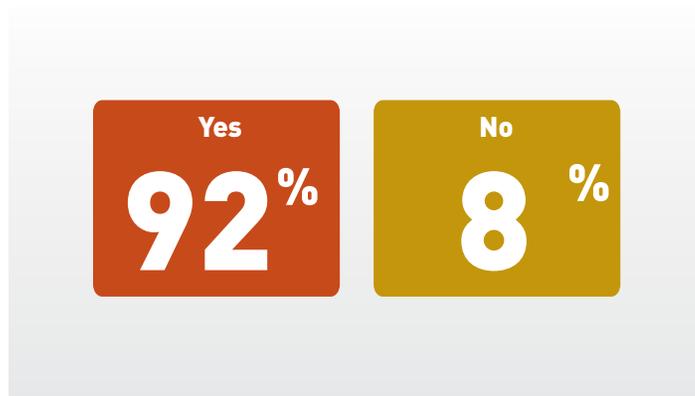


Figure 8. Designview launched in 2012. Have you used the system?

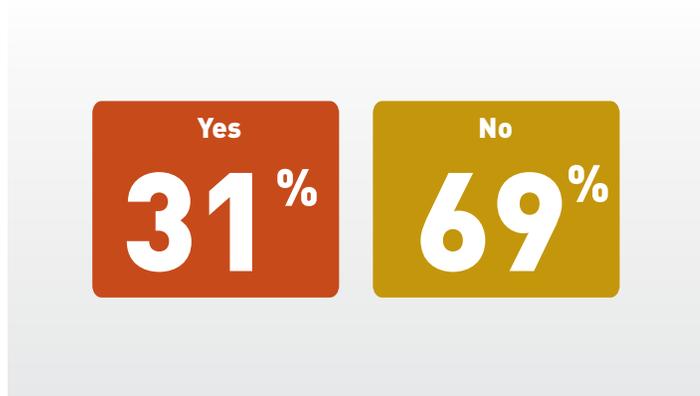
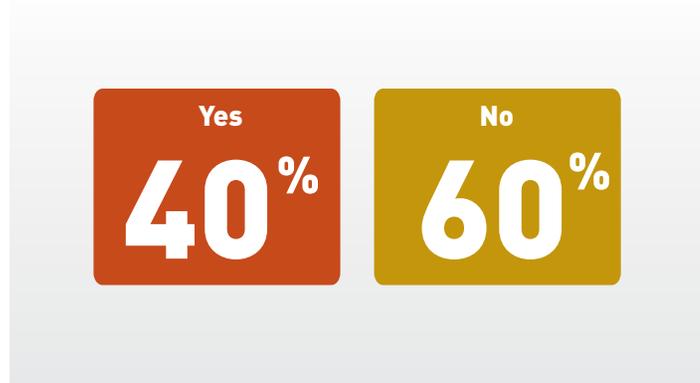


Table 1. Approximately what percentage of the following do you file through the e-filing system?

	CTM applications	RCD applications
90%-100%	100%	67%
80%-90%	0%	7%
70%-80%	0%	7%
60%-70%	0%	12%
50%-60%	0%	0%
40%-50%	0%	0%
30%-40%	0%	0%
20%-30%	0%	0%
10%-20%	0%	0%
0%-10%	0%	7%

Figure 9. Have you used the CF Similarity tool?



#### Methodology for filing tables

OHIM data lists the Community trademark (CTM) filings originating from individual offices (with each designated a unique CTM representative code). This means that a single firm can have multiple entries in multiple countries under the same firm name (because the named firm filed via a range of individual offices, each designated its own unique CTM representative code). To obtain an alternative perspective on the market, *WTR* compiled the tables in this article, using data kindly provided by OHIM, by adding the filings of all offices (filing 25 or more CTMs) of each named firm and/or brand owner (where a firm operates under distinctly different names/runs a separate consulting business, these are counted separately). Having compiled the list according to overall filings by firm name, we then compiled the top 10 country lists according to each firm's country of origin; so, for instance, Hogan Lovells appears in the UK table, not the Spanish table. While every care has been taken to guarantee that all relevant figures were considered, *WTR* accepts no responsibility for any errors in the tables.

include all the goods and services in that class or not, and will also depend on the Nice Classification edition in force at the time of filing.”

A number of brand owners suggested that *IP TRANSLATOR* will have a minimal knock-on effect on their registration strategies, as they already take a specific approach to goods and services in their applications. For others, however, the impact will be more significant. Ramón Cañizares, associate partner at Elzaburu, praised OHIM’s speedy reaction to the decision, acknowledging that “OHIM examiners and representatives have now to handle really long and complex lists of products and services, not only in examination of classification, but also in oppositions and cancellation proceedings. We know that OHIM is putting great efforts into solving this matter through taxonomy works, and this is also very positive.” (For more on Taxonomy, see page 33.)

### Evolution or revolution?

While the trademark community was digesting the *ONEL* and *IP TRANSLATOR* decisions, the European Commission was looking further ahead, working on a package of initiatives to make registration systems across the European Union “cheaper, quicker, more reliable and predictable”. In March, it also formally presented plans to amend the EU Community Trademark Regulation (207/2009), recast the EU Trademarks Directive and overhaul the filing fees regime. The proposals include the following:

- OHIM would be renamed the ‘European Union Trademarks and Designs Agency’ and CTMs ‘European trademarks’
- The goods and services for which registration is sought would be classified in conformity with the Nice Classification system.
- Marks would not be registrable as European trademarks if, after their transcription or translation into any EU language, they fell within one of the absolute grounds for refusal.
- The requirement of ‘graphic representability’ of a European trademark would be removed.
- In line with Article 16(1) of the Agreement on Trade Related Aspects of Intellectual Property Rights, Article 9 of the regulation would be amended to clarify that infringement claims are without prejudice to earlier rights.
- Rights holders would be entitled to prevent third parties from bringing goods from third countries bearing a trademark which was identical to their own trademark registered for the same goods into the EU customs territory without authorisation, regardless of whether the goods had been released for free circulation.
- European certification marks would be introduced.
- The ‘own name’ defence would apply only to personal names.
- Relative grounds examination within member states would be abolished and official examination limited to absolute grounds.
- Administrative oppositions and cancellation procedures would be established in all countries.

A significant majority of users surveyed (92%) had read the proposals in full. *WTR* then dug deeper to determine how these latest initiatives have been received.

A number of respondents flagged up some downsides to the proposal to abolish relative grounds examination within member states, such as a potential increase in invalidity actions. Overall, however, the move towards greater harmonisation of practice was welcomed, with filers noting that it should result in enhanced consistency across the Community. Florian Schwab, attorney at law with Boehmert & Boehmert, remarked: “The abolition of ex

Table 2. **Top brand owner filers of CTM applications (year to May 31 2013)**

Position	Representative name	Country of origin	CTM filings
1	L'oreal	FR	488
2	Novartis AG	CH	304
3	The Procter & Gamble Company	US	213
4	Samsung Electronics CO LTD	KR	177
5	Glaxo Group Limited	GB	144
6	LG Electronics INC	KR	129
7	Batmark Limited	GB	121
8	Bauer	DE	106
9	Actavis Group PTC EHF	IS	105
10	Boehringer Ingelheim International GMBH	DE	104
11	Johnson & Johnson	US	98
12	Home Focus Development Limited VG	VG	93
13	Novomatic AG	AT	90
14	Hammer	DE	85
15	Eli Lilly And Company	US	81
16	Nissan Jidosha Kabushiki Kaisha [also as NissanJP Motor CNO LTD]	N	74
17	Hewlett-Packard Development Company, LP	US	71
18	Allied Domecq Spirits & Wine Limited	GB	70
19	Chivas Holdings (IP) Limited	GB	69
19	Eveline Cosmetics Dystrybucja SP ZOO SKA	PL	69
21	Bsh Bosch Und Siemens Hausgerate GMBH	DE	68
22	Comité International Olympique	CH	66
22	Everything Everywhere Limited	GB	66
24	Bristol-Myers Squibb Company	US	65
25	Actervis, GMBH	CH	64
26	Koninklijke Philips NV	NL	64
27	British American Tobacco (brands) INC	US	63
28	King.com Limited	MT	62
28	Norbrook Laboratories Limited	GB	62
30	Bayer Intellectual Property GMBH	DE	60
30	Henkel AG & CO KGAA	DE	60
30	Lidl Stiftung & CO KG	DE	60
30	Unilever NV	NL	60
34	Salim	GB	58
35	Copernicus Eood	BG	57
36	Société Des Produits Nestlé SA	CH	56
37	Eblenkamp	IT	53
37	Gamesys Limited	GB	53
39	SC Prosper Mod	RO	52
40	Beiersdorf AG	DE	51
40	Huawei Technologies CO LTD	CN	51
40	Miguel Torres SA	ES	51

Table 3. Top 50 representative filers of CTM applications for the 12 months to May 31 2013

Position	Representative name	Country of origin	CTM filings
1	Marks & Clerk LLP	GB	663
2	Gevers	BE	643
3	Novagraaf Nederland BV	NL	598
4	Boehmert & Boehmert	DE	545
5	Clarke, Modet Y Cia, SL	ES	541
6	Harrison Goddard Foote LLP	GB	517
7	Taylor Wessing	GB	514
8	Elzaburu, SLP	ES	504
9	Jacobacci & Partners SPA	IT	469
10	Grunecker, Kinkeldey, Stockmair & Schwanhauser	DE	467
11	Bugnion SPA	IT	456
12	Barzano & Zanardo	IT	446
13	Hogan Lovells	UK	441
14	D Young & Co LLP	GB	417
15	J Isern Patentes Y Marcas	ES	390
16	FRKelly	IE	389
17	Boult Wade Tennant	GB	375
18	Kilburn & Strode LLP	GB	372
19	Herrero & Asociados	ES	351
20	Cabinet Germain & Maureau	FR	350
21	Withers & Rogers LLP	GB	344
22	Ungria Lopez	ES	341
23	Field Fisher Waterhouse LLP	GB	312
23	Baker & Mckenzie	US	312
25	Stobbs	GB	309
25	Perani & Partners Spa	IT	309
27	Casalonga Et Associes	FR	301
28	Pons Patentes Y Marcas Internacional, SL	ES	297
29	Jeffrey Parker And Company	GB	292
30	Novagraaf France	FR	284
31	Mewburn Ellis LLP	GB	280
32	Zacco Sweden AB	SE	277
33	Zacco Netherlands BV	NL	275
34	RGC Jenkins & CO	GB	271
35	Friedrich Graf Von Westphalen & Partner	DE	265
36	Dehns	GB	264
37	Murgitroyd & Company	GB	261
38	Barker Brettell LLP	GB	258
39	Forresters	GB	255
40	Silex IP	ES	247
41	Ladas & Parry LLP	GB	246
42	Lane Ip Limited	GB	236
43	Merkenbureau Knijff & Partners BV	NL	232
44	Meissner, Bolte & Partner	DE	231
45	Abril Abogados	ES	222
46	Pons Consultores De Propiedad Industrial, SA	ES	221
46	Gill Jennings & Every LLP	GB	221
48	Keltie LLP	GB	219
49	Modiano	IT	216
50	Studio Torta SPA	IT	214

*officio* relative grounds examination is positive, speeding up the registration procedure and ‘educating’ owners of earlier rights to be attentive and check the registry themselves without relying on sometimes doubtful *ex officio* searches.”

Taylor Wessing’s Delord added: “We believe that removing examination on relative grounds will reduce uncertainty and will prevent CTMs being cited against applications in some countries, but not others. We also hope that it will result in more trademark applications proceeding to registration where there is no commercial conflict with marks of earlier mark owners.”

One provision that has caused some concern is the commission’s suggestion that absolute grounds for refusal would apply “where a trademark in a foreign language is translated or transcribed in any script or official language of the Member States”. The move could prove a challenge when clearing names and, importantly, would increase the burden on examiners.

#### Fees – fighting clutter or maintaining the status quo?

Turning to fees, the commission has proposed a universal ‘one class per fee’ principle, which would apply both for CTM applications and for national trademark applications. For instance, the basic fee for registration of an individual CTM would fall to €925. The fee for a second class of goods would then be €50, rising to €75 for a third class and €150 per class thereafter (with lower fees for online filing and online filing using the online classification database).

At the ECTA conference, the European Commission’s Tomas Eichenberg outlined two potential benefits of this new fee structure: the contribution it would make towards both balancing OHIM’s budget and de-cluttering the register. “We believe that as long as we don’t put too much intervention in the system by placing obstacles, there is an argument for a system of ‘one fee per class’,” he explained. “We believe that applicants will only pay for those classes that best serve their business needs and the system will discourage them from pursuing unnecessarily broad protection.”

The response from filers, meanwhile, ranged from enthusiasm to indifference. Pablo López Ronda, manager of Clarke, Modet & Co’s Alicante office, noted that “every reduction is good in order to facilitate the access to the system to individuals and small companies”, while one law firm respondent added: “It makes sense to pay a fee per class in order to avoid claiming classes just because the costs will be the same.”

But other practitioners questioned whether the new model will change much, given that the price for registration in three classes will essentially remain the same. Schwab stated: “While the ‘one fee per class’ approach is interesting, differences concerning costs between filing one and three classes are not very important. All in all, I doubt that this minimal change of fees – which seems much ado about nothing – will have a great impact on the present practice to file one or up to three (or more) classes.”

#### The way ahead

Of course, there is still some way to go before the proposals become reality, and while they will have mandatory application if adopted, Eichenberg has acknowledged that “some member states seriously disagree with important aspects of the package and we must see to what extent we can achieve agreement”. The new fee structure is one such contentious issue, with Eichenberg admitting: “[Some] remain extremely critical of the ideas we have for implementing a move to a ‘one class per fee’ system, as they are concerned about further measures that drive a reduction in fee levels and could lead to further migration to OHIM registrations

Back in 2003, the registered Community design (RCD) became a reality. In April this year OHIM celebrated its tenth anniversary, with a major conference in Alicante. Nearly 700 delegates crowded into the ADDA auditorium in the city, OHIM's home for the past 18 years, to reflect on the changes and developments in European and global designs since the introduction of the RCD.

The conference highlighted the universality and utility of designs in everyday life. Designs in all their forms were celebrated by Michelin-starred chef Quique Dacosta, renowned designer Javier Mariscal, leading industry figures, politicians, design law experts and representatives of EU national IP offices.

Although the design conference looked forward to the future of design, it also looked back at the history of the RCD. Several participants recalled the 'sunrise filings' – when OHIM provided for filings on January 1 2003, to enable

designs to be registered on April 1 2003, the first day that the design legislation came into force. Some conference attendees and design veterans recalled the queues that formed outside OHIM's headquarters on the outskirts of Alicante as representatives waited to be among the first to file. The staff of what was then the Designs Department at OHIM outlined the challenges of building an administrative structure to give life to the concept of the RCD, and of developing and strengthening the RCD as the years went on.



The conference also set the effects of the RCD in context, giving real-world examples of how IP protection for designs has created jobs and boosted innovation in companies large and small. One Spanish shoe and accessories manufacturer told delegates that his company invested over €1.5 million per year in designs, through research, creation of prototypes and samples, and technical adjustments to samples. This investment helps to power 13 factories, as well as maintaining over 600 direct employees and 3,000 indirect jobs. All production is done in Spain and sent on to more than 40 countries, with more than 5,000 points of sale across the world.

That was just one story; many more were told at the conference. A representative of a large multinational company described how his business's dedicated design function employs around 300 people around the world and is serviced by 65 external design agencies.

Ten years later, the RCD

is growing in popularity and is very much a European success story. Over 732,000 design filings have been received at OHIM since 2003. Around 40,000 were received in the first year of operation, with e-filing rapidly becoming the filing mechanism of choice over the past decade. While in 2003 just 4% of designs were filed electronically, 81% of designs have come through the e-filing track so far in 2013. OHIM's fast-track filing facility, in which designs that meet a set of simple conditions are registered in 48 hours or less, has been steadily growing in popularity, too.

Another priority for OHIM in the months ahead is the expansion of Designview (see page 33), which was launched in November 2012, through its €50 million Cooperation Fund programme. It already contains nearly 1 million designs and its forthcoming Phase 2 release in November will see user feedback incorporated into the tool.

Author: **OHIM**

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from member states.”

Another obstacle for national offices was highlighted by Beate Schmidt, president of the German Federal Patent Court and a former director of OHIM, at the ECTA conference, in relation to the proposed extension of absolute grounds examination beyond the member states in which an application is filed. “I agree with the criticism of this – it is practically impossible for national offices to do all this to the required quality,” she said. “This will be a significant challenge and a complete change to their current practice. The commission is giving a ‘mission impossible’ to national offices.”

National office opposition to the proposals was clearly voiced at a European Parliament Committee on Legal Affairs hearing which took place in July. Speaking at the session, Christoph Ernst, deputy director general of the Federal Ministry of Justice of Germany, argued: “The balance of interests between national and Community brands has not been dealt with enough in the proposals – this is why they have been rejected to a large extent by all member states. Some will say, ‘National offices are making objections, so it is business as usual.’ But that isn’t how it is. The almost universal rejection of an EC proposal is something I haven’t seen before.”

The treatment of the OHIM budget surplus is another bugbear for national office participants. In 2008, in what has subsequently been termed ‘the September Agreement’, it was announced that CTM renewal fees would be split 50-50 between OHIM and national offices, on the condition that the latter used the money

Table 4. Top representative filers of CTM applications from Germany for the 12 months to May 31 2013

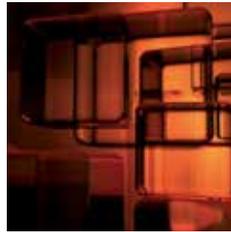
Position	Representative name	Country of origin	CTM filings
1	Boehmert & Boehmert	DE	545
2	Grunecker, Kinkeldey, Stockmair & Schwanhausser	DE	467
3	Friedrich Graf Von Westphalen & Partner	DE	265
4	Meissner, Bolte & Partner	DE	231
5	Harmsen Utescher	DE	199
6	Mitscherlich & Partner	DE	173
7	Cohausz & Florack Patent-Und Rechtsanwaltschaftsgesellschaft	DE	154
8	Hoffmann * Eitle	DE	146
9	Lorenz Seidler Gossel	DE	136
10	Eisenfuhr, Speiser & Partner	DE	128

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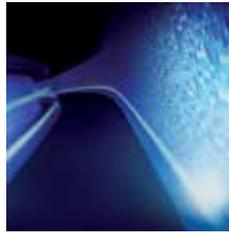
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**OHIM on: the OHIM website overhaul**

OHIM is now completing a major effort to enhance its customer facing e-business suite. After intensive testing and preparation, the new-look OHIM online is nearly ready to roll out, with a new range of tools and functionalities and increased focus on user experience.

The revamped website was designed with input and feedback from a working group of user representatives, to ensure that user requirements were met. Their contribution has allowed OHIM to create a modern, accessible site. It is firmly aimed at business, and at improving the accessibility of trademark and design protection by providing clear, practical information on how to register and on the benefits that registration can offer. New users are catered for with informative and practical sections on IP protection. The new site also provides more advanced facilities for lawyers and professional representatives who regularly do business with OHIM.

Unlike the current site, which is available in OHIM’s five official languages (English, French, German, Italian and Spanish), the new website will be available in 23 EU languages.

The OHIM Image Programme, which is overseeing the website project, also includes a major revamp of almost all current e-business systems, apart from e-filing for designs and oppositions. These will be phased out once the e-business solutions in OHIM’s Cooperation Fund Software Package, which are currently being developed, are delivered.

E-filing has been remarkably successful at OHIM to date. At present, 96% of CTMs, half of oppositions and 83% of RCD filings are received via the e-filing system. The new CTM e-filing will integrate Taxonomy for the selection of goods and services. The site will also host a new e-filing form, which will be fully interactive and easy to use, and will encompass new processes such as recordals.

The existing navigation system will change, and users will be asked to register online, to maximise the benefits of the new site. A user area dashboard will provide a set of solutions for users to work with OHIM online, including reinforced e-communication for all types of OHIM proceedings. The current CTM watch will be replaced by a powerful new alert system for CTMs and RCDs, including a search alert.

There will also be a single search tool for all CTM, RCD and related processes. A

separate search tool for case law will help to make this information more accessible to all stakeholders.

In terms of rollout, OHIM’s revamped online presence will bring important changes to the user community. The new website will be opened to users on a restricted pilot from later this year. At the same time, OHIM will launch a series of workshops organised with national offices and user associations aimed at familiarising users with the new online OHIM ecosystem.

Author: **OHIM**

for “purposes closely related to the protection, promotion and/ or enforcement/ combat counterfeiting of trademarks”. This division of spoils is absent from the latest proposals, and Susanne Ås Sivborg, president and director general of the Swedish Patent and Registrations Office, hit out at plans to move instead to a regime that provides grant assistance to offices engaging in convergence activities. “A CTM invoked in one of the territories of the union inevitably incurs costs for that member state – the idea behind the agreement was that distribution of 50% of CTM renewal fees would reflect such costs,” she argued. “The proposal for remuneration connected to participation in programmes does not reflect this.”

The proposed diversion of unused surplus funds to the general budget of the European Union has likewise proved unpopular, with Tove Graulund, chair of the MARQUES Study Task Force and principal of Graulund IP Services, stating: “This has always been the ghost in the room, and as users, we refused to believe it would come to that; but now it has.”

Dawn Franklin, chairman of the trademark committee at the European Brands Association, supported the system of “greater cooperation between OHIM and national offices through a system of grants”, but added: “We believe that the moneys paid by trademark owners to protect marks should be used for that purpose only and any surplus should therefore be used to the benefit of users. The accumulation of budget surpluses should be avoided, and in order

**Table 5. Top representative filers of CTM applications from France for the 12 months to May 31 2013**

Position	Representative name	Country of origin	CTM filings
1	Cabinet Germain & Maureau	FR	350
2	Casalonga Et Associes	FR	301
3	Novagraaf France	FR	284
4	Cabinet Beau De Lomenie	FR	140
5	Cabinet Chaillot	FR	128
6	Promark	FR	124
7	Inlex Ip Expertise	FR	113
8	Cabinet Lavoix	FR	105
9	Sodema Conseils SA	FR	99
10	Markplus International	FR	90

Table 6. Top representative filers of CTM applications from Italy for the 12 months to May 31 2013

Position	Representative name	Country of origin	CTM filings
1	Jacobacci & Partners SPA	IT	469
2	Bugnion SPA	IT	456
3	Barzano & Zanardo	IT	446
4	Perani & Partners SPA	IT	309
5	Modiano	IT	216
6	Studio Torta SPA	IT	214
7	Societa Italiana Brevetti SPA	IT	204
8	Giambrocono & C SPA	IT	149
9	Dott Prof Franco Cicogna	IT	137
10	GLP SRL	IT	125

Table 7. Top representative filers of CTM applications from Denmark for the 12 months to May 31 2013

Position	Representative name	Country of origin	CTM filings
1	Otello Lawfirm	DK	127
2	Maqs Law Firm Advokataktieselskab	DK	118
3	Sandel, Loje & Partnere	DK	97
4	Zacco Denmark A/S	DK	96
5	Chas. Hude A/S	DK	95
6	Bech-Bruun Law Firm	DK	83
7	Patrade A/S	DK	70
8	Plougmann & Vingtoft A/S	DK	46
9	Gorrissen Federspiel	DK	36
10	Accura Advokatpartnerselskab	DK	34

to reduce the surplus, we would ask that consideration be given to reducing the renewal and recordation fees further.”

For Campinos, who weighed in in favour of the proposal (“If there is still money left, it is logical that it goes to the EU budget. It is EU money”), there are different ways to approach the allocation of the surplus. “When we talk about surpluses, we first have to deduct the equivalent of one year’s expenditure, which cannot be transferred

to the EU budget,” he said. As to the reminder, he suggested that the commission could look at other areas for which OHIM could usefully be tasked with responsibility.

Graulund observed that there is certainly enthusiasm for such an expanded role at OHIM: “There is a drive from the president and team to expand into new areas. We have said from the beginning that the core businesses must remain the core business – and I think

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The development of common databases and IT tools is a key endeavour of the European Trademark and Design Network. The tools and databases which have been developed so far provide a dramatically enhanced end-user experience. Through the Cooperation Fund, which centres on building software solutions to increase harmonised working methods in the European Union, and the Convergence Programme, which is centred on convergence of practices, OHIM is working with its EU and international partners and users to develop databases that meet the needs of business. All of the tools are accessible through the Network's single entry point, the Common Gateway, at [www.tmdn.org](http://www.tmdn.org).

Taxonomy, now integrated into TMclass, takes its data from the Harmonised Database, a shared common database of pre-approved goods and services. The scope of the Harmonised Database is wide. With 65,000 terms, it will grow and expand as the market grows and expands, and will contain agreed, high-quality translations. In 2011 it had data from five 'harmonised' EU IP offices. By 2012, that number had increased to 11. By the end of 2013, a further seven offices are expected to be on board.

Now that a common database shared by the harmonised EU national offices has been established, the next step will be to make sure that it meets all needs of the market. OHIM has begun a consultation process with its users, to find out what terms they feel should be included in the database.

In fact, TMclass was rebranded this year to reflect the fact that it is now a truly global – not just a European – tool. It is now available in 25 languages, including Japanese and Korean, as well as 23 EU languages, as all EU national and regional trademark and design offices are now integrated, including that of Croatia, which joined the European Union on July 1 2013.

TMview makes it possible to search the contents of all participating national registries. In 2012 11 national EU IP offices joined the tool, meaning that TMview ended the year with around 10 million marks. In 2013 it expanded further. In February OHIM and WIPO published their declaration of intent to link TMview and WIPO's Global Brand Database. And in July, the Department of the Registrar of Companies and Official Receiver of Cyprus, the State Intellectual Property Office of Croatia, the Mexican Institute for Industrial Property and the Norwegian Industrial Property Office were all integrated into the tool, as part of OHIM's international cooperation programme.

Turkey and Morocco are the next offices set to join TMview, and preparatory work to integrate the Korean Intellectual Property Office and the US Patent and Trademark Office is also underway. TMview is already receiving more than 165,000 searches a month. Its July expansion saw it absorb an extra 1.1 million trademarks, bringing the total to more than 11 million.

Designview – the TMview of designs – now has nine participating EU national offices and nearly 1 million designs. The tool is set to move on to a new phase in November 2013, after OHIM asked users how they felt Designview should develop. The new release will incorporate this feedback together with further improvements, while expanding the number of integrated EU offices. The tool will be reinforced particularly in relation to quality of results returned from searches, and the handling of those results in multiple languages.

All of this activity aims to improve the user experience when seeking to protect investment in innovation, and to support professionals in IP offices. In this way, implementation of the tools strengthens all members of the European Trademark and Design Network.



Similarity is a common database of similarity decisions of goods and services, which can be used during opposition or cancellation proceedings. It is a searchable database which allows users to assess whether given goods or services are considered similar or dissimilar – and to what degree – according to decisions of the participating IP offices.

By making prior decisions on oppositions readily accessible, the tool gives more transparency to the decision-making process of EU national offices and OHIM. Similarity also improves the predictability and legal certainty of opposition decisions.

The common databases do not stand alone, but link with ease to a range of other tools developed by OHIM through the Cooperation Fund, including the Common Examiner Support Tool (CESTO), which had its Phase 2 launch on June 30. CESTO enables examiners to have automated searches performed in several databases to help them in gathering all information relevant to absolute grounds examination. The first release of this system, in November 2012, provides reports for examiners with these search results and allows offices to customise the way that the results are presented in accordance with local policies.

Over the last few months, a group of examiners has been

using this tool on a trial basis in order to ensure that the results are useful. Examiners

from Portugal, Latvia, Denmark and Romania have also taken part in the trial, which is set to be extended to other EU national offices in the very near future. It uses an improved search algorithm to find trademarks that are similar based on their verbal similarity to each other, including a phonetic transcription of the words. It also searches the international non-proprietary names database for pharmaceuticals, data on geographical indications and data from the Common Plant Variety Office, as well as national databases.

The Quality tool goes one step further in its aggregation of data. It holds a database of quality standards from across EU national offices, so that users can see the full range of services and standards offered throughout the European Union. The tool can be searched for trademark, design and customer services, as well as quality standards in timeliness, quality, consistency and accessibility.

This sharing of management practice has been achieved through cooperation at EU national and regional office level, and through the input of user associations. It enables end users to compare how processes work across the European Union and how long processes take in different offices.

Author: **OHIM**

Table 8. The top filers in other European jurisdictions for the 12 months to May 31 2013

Position	Representative name	Country of origin	CTM filings
1	Marn	Slovenia	25
1	Kancelaria Prawa Wlasnosci Przemyslowej I Prawa Autorskiego Teresa Czub & Krzysztof Czub Rzecznicy Patentowi Spolka Partnerska	Poland	91
1	J Pereira Da Cruz, SA	Portugal	91
1	SC Weizmann Ariana & Partners Agentie De Proprietate Intellectuala SRL	Romania	60
1	Agency Tria Robit	Latvia	42
1	Patendiburoo Turvaja Ou	Estonia (joint-top)	34
1	Patent Agency Kaosaar & CO	Estonia (joint-top)	34
1	Kolster Oy Ab	Finland	141
1	Papacharalambous & Angelides LLC	Cyprus	32
1	Law Firm Thanos Masoulas & Partners	Greece	40
1	Danubia Szabadalmi Es Jogi Iroda KFT	Hungary	28
1	FRKelly	Ireland	389
1	Dr Johannes Hintermayr • Dr Franz Haunschmidt • Dr Georg Minichmayr • Dr Peter Burgstaller • Mag Georg J Tusek • Dr Christian Hadeyer • Mag Peter Breiteneder • Dr Harald Lettner	Austria	80

Table 9. Top representative filers of CTM applications from Great Britain for the 12 months to May 31 2013

Position	Representative name	Country of origin	CTM filings
1	Marks & Clerk LLP	GB	663
2	Harrison Goddard Foote LLP	GB	517
3	Taylor Wessing	GB	514
4	Hogan Lovells	GB	441
5	D Young & Co LLP	GB	417
6	Boult Wade Tennant	GB	375
7	Kilburn & Strode LLP	GB	372
8	Withers & Rogers LLP	GB	344
9	Field Fisher Waterhouse LLP	GB	312
10	Stobbs	GB	309

they have, and OHIM can manage more. This does mean fees will be funding other areas of activity, but isn't that better than the surplus going to the EU budget?"

She concluded: "I have been thinking about how Antonio Campinos has done over last three years – and he has done very well indeed. The office was run well before, but has become more visible in its focus on the strategic plan. A lot of time has been spent informing people, including staff, and getting all on board – so everyone is going in the same direction. It's a big change from how things were before. I also like the focus on target times and quality criteria and measurability. Some things are hard to measure, like quality; but OHIM is doing the best it can and is ambitious. There will always be room for improvement, but there is a real sense of good intention and hard work."

In some respects, that hard work is just beginning, with the commission's proposals likely to dominate the trademark agenda in Europe for some time to come. [WTR](#)

“ The proposed diversion of unused surplus funds to the general budget of the European Union has likewise proved unpopular, with Tove Graulund, chair of the MARQUES Study Task Force and principal of Graulund IP Services, stating: ‘This has always been the ghost in the room, and as users, we refused to believe it would come to that; but now it has’ ”

Table 10. Top representative filers of CTM applications from Spain for the 12 months to May 31 2013

Position	Representative name	Country of origin	CTM filings
1	Clarke, Modet Y CIA, SL	ES	541
2	Elzaburu, SLP	ES	504
3	J. Isern Patentes Y Marcas	ES	390
4	Herrero & Asociados	ES	351
5	Ungria Lopez	ES	341
6	Pons Patentes Y Marcas Internacional, SL	ES	297
7	Silex IP	ES	247
8	Abril Abogados	ES	222
9	Pons Consultores De Propiedad Industrial, SA	ES	221
10	Curell Sunol SLP	ES	198

Table 11. Top representative filers of CTM applications from Benelux for the 12 months to May 31 2013

Position	Representative name	Country of origin	CTM filings
1	Gevers	BE	643
2	Novagraaf Nederland BV	NL	598
3	Zacco Netherlands BV	NL	275
4	Merkenbureau Knijff & Partners BV	NL	232
5	Nederlandsch Octrooibureau	NL	205
6	Arnold & Siedsma	NL	187
7	Merk-Echt BV	NL	184
8	Office Freylinger SA	LU	158
9	Algemeen Octrooi-En Merkenbureau	NL	156
10	De Merkplaats BV	NL	155

### OHIM on: Taxonomy

Taxonomy was launched within TMclass, OHIM’s global classification tool, on July 2, and before the end of the year it will be integrated into OHIM’s new e-filing system via the new OHIM website. Taxonomy is, in a very real sense, a response to the needs of the market. New goods and services constantly come on line, all of which fit into the Nice Classification system’s 45 classes. This has led to a situation where classes contain a wide range of goods and services – which then become difficult to find.

Taxonomy offers a way forward. It was developed through collaboration between OHIM, the World Intellectual Property Organisation (WIPO) and EU national and regional IP offices, and is a hierarchical structure based on the Nice Classification terms, with broader terms on top and more specific terms below.

Taxonomy is a classification assistant. It is not an alternative to the Nice Classification; nor does it replace it in any way. The division of Taxonomy into 45 classes means that the very first level of Taxonomy comes from the Nice

Classification itself.

Taxonomy has already adapted with great ease to incorporate the changes from the ninth to the tenth edition of the Nice Classification. The structure makes it straightforward to identify and group terms with the same characteristics and move them to the correct position. This means that when changes are made to the Nice Classification by the Committee of Experts, those changes will be reflected in Taxonomy.

Taxonomy takes its data from the Harmonised Database, which is a common database of acceptable terms. This database contains all of the terms in the alphabetic list of the Nice Classification. Fourteen EU national IP offices, plus OHIM, have had their data incorporated into the database, which currently contains around 65,000 terms of goods and services. Users can easily browse Taxonomy on the left side bar of TMclass to get an overview of which goods and services are in each class. By drilling down through the tree, they can focus on specific groups of terms and disregard those

that are not relevant.

Users who already know the goods or services they are looking for can perform a direct search in the TMclass search field. On the right of the screen, they will find all terms that contain the word they are looking for. On the left, the Taxonomy tree will show where those terms are in the 45 classes.

Taxonomy has a number of benefits for users. It offers an easier, more intuitive search, so even those with no prior knowledge will find it easier to find the correct classification. And since related terms are presented together, Taxonomy avoids time-consuming, repetitive searches.

A longer-term benefit of Taxonomy is that it is responsive to the needs of the market. Most new goods and services can be incorporated into the current Taxonomy structure. If something is developed that is totally new or a new market sector emerges, a new group can be created.

As a living structure, Taxonomy has to grow and develop through consultation and maintenance, and to evolve as markets evolve. So

EU national offices and user associations will suggest new terms, and changes and additions, in coordination with a Convergence Central Team. The team will consist of seconded experts from national offices, who will take on responsibility for the continuity and validity of both Taxonomy and the Harmonised Database.

Taxonomy began as a collaborative, cooperative venture, and will continue as one too. EU national IP offices will continue to work with OHIM to build up Taxonomy and help it to grow and evolve as a tool that is designed to fit market needs. WIPO, which published Taxonomy on its website in April, will be involved in any changes or developments to the system, to make sure that everyone is using the same Taxonomy at all times.

The whole process will continue to rely on the input of users, with their unique connection to the market. Their feedback and advice have been key to Taxonomy’s evolution and growth throughout the process, and their involvement is vital to its future success.

Author: **OHIM**