

Korea to host Trademark Five (TM5) meeting in 2013

By Michael McDaniel



The Korean Intellectual Property Office (KIPO) has been selected as secretariat to host the 2013 meeting of the Trademark Five (TM5), which consists of KIPO, the Japan Patent Office (JPO), the Office for Harmonization in the Internal Market (Europe's OHIM), the State Administration for Industry and Commerce (China's SAIC) and the United States Patent and Trademark Office (USPTO).

The TM5 represents the evolution of the earlier so-called Trilateral Meeting created by JPO, OHIM and the USPTO. It is contemplated that other national IP offices will be invited to join the group in the near future.

The TM5 held its first annual meeting in Barcelona, Spain on October 30th-31st, 2012. The Director General of WIPO, Francis Gurry, joined the five members for part of the meeting and three WIPO officials participated in all the sessions. The 2013 meeting of TM5 is likely to be held late this year. KIPO became an official member of the TM5 in early 2012, and the KIPO Commissioner Ho-Won Kim attended the annual meeting in Barcelona.

The TM5 was formed for the purpose of improving the procedures and efficiencies of the members' respective trademark regimes through the exchange of information and ideas, and cooperation, and to ultimately harmonise their respective methods, procedures and practices to the extent practicable in order to eliminate or minimise divergent criteria for obtaining trademark registrations in the member offices. The members work together on an ongoing basis and plan to meet annually to discuss relevant topics and collaborate to improve their respective trademark regimes.

Some of the currently pending projects discussed at the 2012 TM5 meeting include:

ID List Project – this involves the creation of an agreed list of harmonised identifications of goods and services that are acceptable to all the members. Thus, the identification in a trademark application of any agreed goods and services will streamline the acceptance of applications submitted to member offices. On the basis of this project, applicants can indicate agreed goods/services in their international applications, with less risk of refusal, for trademark protection in the member countries. For example, specific to Korea, a number of goods have been officially recognised pursuant to the ID List Project, such as rice wine (Makgeoli) and non-alcoholic rice drinks (Sikhye), Korean distilled spirits (Soju), a non-alcoholic cinnamon drink with dried persimmons (Sujeonggwa), a soup dish of chicken and ginseng (Samgyetang), cubed radish Kimchi (Kkakdugi), etc. Expansion of the list is ongoing and currently includes 13,000 agreed

identifications. Other countries are also participating in this project and several invitations remain outstanding. It is contemplated that the harmonised list will be published on a TM5 Website (discussed below).

Common Statistical Indicators Project – to exchange data and allow the member countries to compare critical data of interest in order to measure their respective efficiency, pendency, productivity, etc.

Common Status Descriptors Project – to agree upon a uniform set of descriptors with respect to the status of trademark applications and registrations. TM5 is contemplating publishing a glossary of such descriptors.

Continuation/Expansion of Bad Faith Project – to collectively agree upon what constitutes a "bad faith" trademark filing, to share information on the relevant laws, regulations and examination practices involving bad faith filings in each member country, with a view to formulating consistent measures to be taken against bad faith filings, and to raise public awareness thereof.

Image Search Project – to identify and address the shortcomings of current search capabilities with respect to design marks, logos and figurative marks, and to develop a uniform image search system among the members to facilitate image searches. This is largely an issue of technology.

EuroClass Link and Taxonomy Project – this project contemplates TM5 potentially adopting OHIM's EuroClass classification system for goods and services, which brings together classification databases to assist trademark filers in organising their goods and services into the correct International Classes. Taxonomy pertains to structuring the classifications of goods and services from broad to specific terms. Implementing taxonomy into EuroClass could permit more intuitive searches.

User-Friendly Access to Trademark Information Project – this project contemplates the possibility of members integrating their trademark data into OHIM's TM View system, thereby improving Web-based services with the goal of providing increased access to trademark-related information.

Website Project – to be headed by KIPO, the goal of this project is to create a TM5 Web site where the public can obtain information about TM5's initiatives, goals, projects, meetings, publications, etc.

There are no specific projects currently with respect to designs. However, the TM5 members have agreed to collaborate on design issues and to continue exchanging information about their respective procedures and practices, with the goal of simplification and alignment.

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