



November 4, 2011

Hon. David Kappos
Under Secretary for Commerce and
Director of the U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22313

RE: IPO Comments Regarding the Trademark Trilateral Meeting

Dear Director Kappos:

Intellectual Property Owners Association is a trade association representing companies and individuals in all industries and fields of technology who own or are interested in intellectual property rights. IPO's membership includes more than 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. Thank you for the opportunity to present the following comments regarding the Trademark Trilateral Meeting.

I. What practices and procedures, including information technology, do you find useful from each IP office and what areas could be improved?

A. Korean Intellectual Property Office ("KIPO")

- i. The electronic-filing system, KIPONET, has been very useful for filing applications online and retrieving documents/information related to pending applications and registrations.
ii. The information provision system adopted through the Korean Trademark Act allowing third parties to submit information to a KIPO examiner about a pending application before the application is accepted for publication has been useful for addressing potentially conflicting marks early on before the opposition period.
iii. KIPO's expedited examination procedures are useful for obtaining registration quickly when desired.
iv. Allowing more flexibility and consistency with respect to the identification of goods/services in trademark applications would be useful. This would

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## INTELLECTUAL PROPERTY OWNERS ASSOCIATION

allow trademark owners to better anticipate what descriptions will be acceptable and to manage prosecution costs.

- v. Accepting letters of consent as a means for overcoming cited prior marks would be useful. Specifically, this would allow trademark owners to resolve potential conflicts among themselves.
- vi. Simplifying the process for recording name/address changes and correcting clerical errors would be useful. Under the current procedures, for example, it can be burdensome, costly, and time consuming for trademark owners to make corrections to or update their registrations/applications.

### **B. Chinese Trademark Office (“CTMO”)**

- i. The CTMO’s recruitment of additional examiners has reduced the amount of time for registration.
- ii. Only limited information is available publicly. Increased access to information (including in English) concerning trademark applications/registrations, the examination of those applications, and CTMO/TRAB proceedings and decisions would be very useful.
- iii. Bad-faith trademark filings in China have become an increasingly common and costly problem for trademark owners. Additional safeguards are needed to prevent these filings. Also, trademark owners need cost-effective procedures for combating bad-faith filings in a timely manner.
- iv. The current deadline to respond to office actions is very short compared to other countries. Extending this time period would help trademark owners to better manage their applications and prosecution expenses.
- v. Determining whether goods/services are related during prosecution depends largely on the sub-classification of the goods/services. Other criteria should be considered, including the strength of the mark, relationship of the products/services, trade channels, etc.
- vi. Currently, the electronic filing system is limited to filing trademark applications with standard description of goods and services. It would be

useful to expand the electronic filing system to include all trademark applications and opposition/cancellation proceedings.

**C. Japanese Trademark Office (“JPO”)**

- i. Providing access to additional information in English through the online Industrial Property Digital Library (IPDL) would be useful, including, for example, information about the owner of an application/registration, the goods/services covered by the application/registration, etc.
- ii. Allowing for the registration of non-traditional trademarks such as colors, product designs, etc. would offer trademark owners additional protections, which are available in other countries.
- iii. Accepting letters of consent as a means for overcoming cited prior marks would be useful. Specifically, this would allow trademark owners to resolve potential conflicts among themselves.
- iv. Shortening the time for obtaining a final decision from the Appeal Board of the Japanese Trademark Office would be useful.

**D. Office of Harmonization for the Internal Market (OHIM)**

- i. OHIM’s online databases provide access to a significant amount of information, are easy to use, and are very helpful.
- ii. The cooling-off period beginning after an opposition is instituted helps parties focus on settlement early on and potentially resolve disputes before additional litigation fees are incurred.
- iii. OHIM rarely conducts hearings in opposition proceedings. In some cases, hearings would be useful.
- iv. The registration process can take much longer in some cases compared to national registrations. Shortening the amount of time to registration would be useful.

**II. What practice and procedures would user groups like to see the IP offices harmonize?**

- i. Online access to information in English, including but not limited to prosecution histories and documents filed in opposition/cancellation proceedings.
- ii. Acceptance of uniform/standard descriptions of goods/services in trademark applications.
- iii. Acceptance of multi-class applications.
- iv. Uniform/Consistent examination of applications owned by a common applicant, including possibly assigning the same examiner to all such applications.
- v. Uniform timelines for responding to office actions.
- vi. Uniform periods of time for seeking to cancel a registration based on non-use.
- vii. Consistent treatment/recognition of well-known marks.
- viii. Uniform acceptance of letters of consent.