



European Communities Trade Mark Association

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## **ECTA POSITION PAPER ON THE INTRODUCTION OF A COMMON ELECTRONIC FILING PORTAL (CEFP) FOR INTERNATIONAL TRADE MARK REGISTRATIONS (MADRID SYSTEM)**

### **I. INTRODUCTION**

Currently, it is practically impossible to file IR marks electronically, because each National Office has a different system and many are not compatible with the WIPO system. Often, applicants have to fill out various WIPO paper forms (e.g. MM2, MM4, etc), add a national paper filing form and send both by regular mail (e.g. in case of colour marks) to their National Office. The forms are then scanned (with changes to the colours) or transmitted by regular mail to WIPO where they are then scanned.

ECTA has considered whether a **Common Electronic Filing Portal (CEFP)**, administered by WIPO (without abolishing the dependency on the national basic mark and by keeping the examining competency of the (home) National Office) could be a good solution for trade mark owners, offices, the public and representatives to facilitate filing.

### **II. COMMENTS**

Most of our relevant Committee Members consider that the existence of a basic application/registration (dependency) and a national examination of the international application is beneficial for the International Registration's owner and there is a separate *ECTA Position Paper on the dependency of International Trade Marks on a national basic application or registration* outlining these reasons.

Nevertheless, the above does not mean that improvements to the mere filing possibilities cannot be proposed, especially in order to streamline the processes, facilitate the work of WIPO and National Offices and give more comfort to the applicants and transparency to the public.

Right now paper filing of IR marks is still necessary with most IR offices, the highly electronically advanced EUIPO has only recently introduced an electronic filing system.

A Common Electronic Filing Portal (CEFP), administered by WIPO, would function as follows:

1. CEFP would receive international applications and send them to the Office of the basic application or registration through the already existing means;
2. The Office of the basic application or registration would carry out the examination as before, possibly contact the applicant for clarifications (checking of the validity, examination of the identity of the list of goods and services, checking translations, etc.);



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3. Then the Office of the basic application or registration would inform WIPO about the termination of the national examination, forwarding of the International Registration would not be necessary as WIPO would download all data from the CEFP;
4. Then WIPO proceeds as usual and disseminates the information to the designated offices who may download all data from the CEFP or – alternatively – receive the International Registration as before, by paper or other means through WIPO;
5. The terms established by the Madrid System should not start to apply, until WIPO receives the confirmation of the details of the basic trade mark from the National/Regional receiving Office.

The advantages of such system are striking, in particular, the following can be noted:

- a. There is one common portal where all parties can access their information, including the public;
- b. The CEFP may collect the national and international fees via one payment (at the moment, the applicant has to pay twice), CEFP will then send the national fee to the Office of the basic application or registration (like the designation fees);
- c. When filing, the applicant can profit from the Madrid Goods & Services Manager (MGS) of WIPO and other online tools provided by WIPO;
- d. Application number and date are instantaneously sent to the applicant;
- e. Processes can be automated;
- f. Fees may be reduced;
- g. According to Article 3.4 of the Madrid Agreement and Protocol, as well as Rule 24.6 (b) of the Common Regulation, the application shall be forwarded from the National Offices to the International Bureau within a period of two months. Unfortunately, some National Offices do not always respect this deadline with the irreversible consequence: the applicant loses the priority claimed. With CEFP this problem would be solved.

If we look how technology develops and changes our lives and that the business of law will soon change as well, and if we think about the future of IP services and how technology dramatically develops, it will soon force us to think differently and change the way we handle trade mark cases and filings.

### **III. CONCLUSION**

ECTA suggests that the International Trade Mark filing procedure should be done through a common filing portal administered by WIPO, while examination is done nationally as until now, including the first examination of the home application. The idea is practically to use WIPO as an “electronic post box” so all filings could be done centrally and electronically at WIPO.



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The idea of a Common Electronic Filing Portal (CEFP) does in fact keep the status quo, it would now also facilitate the filing, namely electronically with a common portal. Keeping on track with today's very fast changes in technology which has already been taken into consideration by EUIPO where trade marks are e-filed, this should be followed in the case of International Trade Marks as well.

ECTA hopes that the above comments are useful and can be taken into account by the Working Group on the Legal Development of the Madrid System for the International Registration of Marks.

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# ECTA

European Communities Trade Mark Association

ECTA, which was formed in 1980, is an organisation concerned primarily with trade marks and designs. ECTA has approximately 1,500 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world. ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, copyright and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields. ECTA does not have any direct or indirect links to, and is not funded by, any section of the tobacco industry.



The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognised technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognised expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;
- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognised by WIPO as a non-Government Organisation (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks, including the globalization of markets, the explosion of the Internet and the changes in the world economy.