

JOINT STATEMENT

POSITION PAPER

List of Goods and Services 512 characters restriction

10 February 2016

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association des praticiens du droit des marques et des modèles



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OF INTELLECTUAL PROPERTY



The Institute of
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Attorneys



The purpose of this short paper is to highlight some issues that users face due to the fact that OHIM does not allow more than 512 characters without using a semi colon when drafting the list of goods and services in a CTM application on line. The limitation has a negative impact on users, also from the financial point of view. We hope that by setting out in detail the problems that it creates, OHIM will understand better users' concerns on this topic and hopefully address them swiftly.

1. LACK OF LEGAL BASIS

The signatories of this paper believe there is no legal basis for this approach. The limitation of 512 characters is neither envisaged in the current text of the Regulations nor, based on our knowledge, foreseen in any provision of the EU trade mark reform package. Therefore it could be considered as unjustified and, because it is not proportionate and it is expensive, it could also be perceived as unfair.

We understand that the reasons behind the limitation of 512 characters would be to keep the terminology of the goods and services clear and precise and enable efficient examination and translation. OHIM explained that with an unlimited number of characters allowed, it would not be possible to examine the lists of goods and services efficiently and it would make automatic examination impossible.

We believe that technical shortcomings or bugs should not impact or shape the law, especially when users are so unfavourably affected and, furthermore, that technical means should be adapted to the law.

Moreover, it has to be reminded in this context that the Office favours applicants filing electronically, who benefit from lower fees, against those applicants filing on paper. It could be argued that by establishing shortcomings for electronic filing, the Office makes discrimination to those applicants requiring filing trade marks with a list of goods that the Office does not allow to file electronically.

2. ISSUES WHEN CLAIMING PRIORITY

A major problem of the limitation arises when priority of a first trade mark application is claimed for the CTM. If the wording of some goods and/or services exceeds 512 characters, it needs to be changed and adapted, without altering the scope of protection of the mark. That immediately triggers costs for the OHIM's users.

Additionally, the changes made can produce uncertainties, especially when the CTM is enforced and the priority claim may be subject to challenge before national courts of the member states. Legal certainty is of paramount importance and all the more so at enforcement level. That can be best achieved by allowing applicants to maintain 1:1 the wording used in the priority application without unnaturally forcing them to carry out changes that increase uncertainty and therefore, inevitably, litigation and costs.

3. DIFFICULTY TO READ THE SPECIFICATION

Introducing semicolons and artificially splitting-up description of goods and services can also make harder for judges and practitioners to review the CTM specifications. This is especially problematic for the latter when clearance searches are performed and they have to go through the long lists of earlier marks cited in search reports, with their corresponding specifications. The more complex and less clear are these specifications, the more burdensome (and expensive) it gets to prepare a report for a trade mark clearance.

4. HIGHER COSTS WHEN CLAIMING PRIORITY IN ASIA

The additional costs that the limitation in question generates become immediately evident when we consider the scenario of an owner claiming priority from a CTM application in Asian countries. In fact, when applying for a mark in those countries costs often depend on the counting of words. For example, we learnt from our experience that the specification of goods or services which exceeds 500 characters in India triggers an extra official fee for each ten additional characters. Likewise, in Thailand the official fee for filing a new trademark application depends on the number items.

The limitation of 512 characters undoubtedly causes an increase in the number of words used by applicants. To give a concrete example: often class 35 specifications are quite long and we are obliged to split the list of goods/services in several parts starting with "retail services in relation to ..." so that each "term" between semicolons does not exceed the limit of 512 characters. The same may happen in relation to the goods in class 7, taking also in to account that the term "machines" is not considered sufficiently clear and precise by OHIM and need further description.

Therefore, when using the priority date of the CTM application and seeking trade mark protection in key growing Asian markets, applicants face higher costs and often delays in having their applications examined.

5. CONCLUSIONS

In the light of the above, we believe that OHIM should abolish the maximum limit of 512 characters that can be used between semicolons in lists of goods and services.

A request in this regard was already put forward by user associations at the last "User Group Meeting", held in Alicante on 24 April 2015. We encourage OHIM to take into consideration users' opinion and to simplify as much as possible the administrative procedures. That will, indeed, contribute to deliver higher user satisfaction, which is one of the Office's objectives set out in the Annual report 2014.

Because this matter was addressed to OHIM back in April 2015 and users are currently suffering of the consequences of this problem on a daily basis, we would like to kindly urge the Office to solve this problem as soon as possible.



association des praticiens du droit des marques et des modèles

Association of Trademarks and Designs rights Practitioners – is an international Association for French-speaking specialists in industrial and intellectual property, in particular Trademarks and designs. The association, which now has nearly 1000 members, was founded 38 years ago and is open to lawyers practicing, all over the world, in the field of Trademarks and designs. It gathers together in-house intellectual property specialists, Attorneys at law and Trade mark Attorneys.

The purpose of the association is notably to play an active role in, and be at the forefront of, further to consultation or on its own initiative, discussions concerning intellectual property and business law in France, Europe and the world.

As a prominent international intellectual property association, **APRAM** is notably member of the OHIM's users group and the OHMI's Observatory, and is observer at the World Intellectual Property Organization (WIPO). More information about **APRAM** and its initiatives is available at **apram.com**



The Benelux Trademark Association (**BMM** or Beneluxvereniging voor Merken- en Modellenrecht / l'Association Benelux pour le droit des marques et des modèles) is the professional organisation that defends the interests of all trademark professionals in the three Benelux countries. The association has more than 600 members, which are active as trademark agents, in-house counsels, attorneys and academics.

The **BMM** promotes trademark law and other forms of intellectual property law and guarantees the professional quality of the services rendered by its members, by organizing conferences and giving training. The organization imposes an ethical code to its members. The organization keeps close contacts with the Benelux Office for Intellectual Property Law and with OHIM.

More information is available on the website <http://www.bmm.eu>.

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European Communities Trade Mark Association

ECTA, the European Communities Trade Mark Association, was formed in 1980. ECTA numbers approximately 1,500 members, coming from all the Member States of the European Union and with associate members from all over the world. It brings together all those persons practicing professionally in the Member States of the European Community in the field of Trade Marks, designs and related IP matters. These professionals are lawyers, Trade Mark advisors, Trade Mark attorneys, in-house counsels and others who can be considered specialist practitioners in these areas.

www.ecta.eu



GERMAN ASSOCIATION FOR THE PROTECTION
OF INTELLECTUAL PROPERTY

The German Association for the Protection of Intellectual Property (“Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht e.V.”, in the following “GRUR”) is a scientific non-profit association. Its statutory purpose is the academic advancement and development of industrial property, copyright and competition law at the German, European and international level. For fulfilling these tasks, GRUR provides assistance to the legislative bodies and to authorities competent for issues of intellectual property law, organises conferences, workshops and further education courses, provides financial aid to selected university chairs and research projects and also publishes four leading German professional IP law journals (GRUR, GRUR International, GRUR-RR and GRUR-Prax.) With over 5,200 members coming from 52 countries, GRUR offers an umbrella for a wide range of IP professionals: lawyers, patent attorneys, judges, academics, representatives of the specific public authorities and of the international organisations as well as enterprises dealing with issues of intellectual property.



The Institute of
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ITMA is the professional membership organisation representing the interests of the trade mark and design attorney profession in the UK. With some 1500 members it helps educate, develop, promote and support those within the profession.

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Foundation - In 1961, twenty two far-sighted Patent Attorneys from nine European countries founded the "union of European Patent Attorneys" with the intention of providing European colleagues with a forum for discussing and influencing forthcoming draft laws and international agreements, and also helping the profession in Europe to grow together. Although originally restricted to Patent Attorneys in the countries of the European Economic Community, **union** has meanwhile removed these limitations from its statutes today welcomes free and employed intellectual property practitioners from all (geographical) European countries, as expressed in the present name "**union of European Practitioners in Intellectual Property**". Still retained are the limitations to European membership and the concentration of activities on problems and developments which especially affect the professionals in Europe.

Aims – **union**, also referred to as **UNION-IP**, is an association of practitioners in the field of Intellectual Property, that is, of individuals whose principal professional occupation is concerned with Patents, Trademarks, Designs or Copyright and related subjects and who carry on their profession independently or as employees. **UNION-IP** is a private, free, international association that is not dependent on any national or international authority: it approves its own members, in accordance with its statutes, in total independence, and likewise decides on its own activities and its own budget. It aims on the one hand to work continuously on current developments in Intellectual Property in Europe, especially by making early submissions during the preparation of proposed laws and treaties with the intention of influencing them and on the other hand to devote itself to the improvement of professional and personal understanding between European practitioners in the Intellectual Property field in different countries and different branches of the profession.

For more information: <http://www.union-ip.org>