



CARIFORUM Intellectual Property Rights and Innovation

Esther GIMÉNEZ | Alicante | 16 April 2024



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

www.caripi-hub.com

IP Cooperation and Strategy

Examination Practices



CARIFORUM



EXAMINATION PRACTICES

AGENDA

- INTRODUCTION
- CarIPI – INITIATIVES carried out
- CarIPI II – The way forward
- QUESTIONS/COMMENTS

1. INTRODUCTION

EXAMINATION PRACTICES



At the heart of an office work

EXAMINATION PRACTICES



Documenting Practices

EXAMINATION PRACTICES



Transparency
Predictability
User satisfaction

2. CarIPI - INITIATIVES carried out

PRACTICES MANUALS

- Two Manuals on Trade Mark related practices
- One Manual on Design related practices
- Available in English and Spanish
- 15 IP offices participating on different Manuals



BELIPO
BELGIAN INTELLECTUAL PROPERTY OFFICE



OCPI OFICINA CUBANA DE LA
PROPIEDAD INDUSTRIAL



ONAPI



Corporate Affairs & Intellectual Property Office
Ministry of Legal Affairs of Grenada



JIPO
Jamaica Intellectual Property Office



TRADE MARK MANUALS

Manual on TYPES OF MARKS and DISTINCTIVENESS of Trade Marks in Absolute Grounds in (selected) CARIFORUM IP Offices



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Ministère du Commerce
&
de l'Industrie



TRADE MARK MANUALS

TYPES OF MARKS

- Definitions of the different Types of Marks
- Summary with the types of marks accepted by each participating Office

COUNTRIES	AG	BB	BZ	CU	DM	DO	GD	GY	HT	JM	LC	KN	SR	TT
Mark Type														
Word	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
Figurative	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
Mixed	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
Shape	✓	✗	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✗	✓
Position	✓	✗	✓	✗	✓	✓	✗	✓	✓	✓	✗	✓	✗	✓
Pattern	✓	✗	✓	✗	✓	✓	✓	✓	✓	✓	✓	✓	✗	✓
Colour	✓	✓ ¹²	✓	✗	✓	✓	✓	✓	✓	✓	✓	✓	✗	✓
Sound	✗	✗	✗	✗	✗	✓	✗	✓	✗	✓	✗	✗	✗	✓
Motion	✗	✗	✗	✗	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓
Multimedia	✗	✗	✗	✗	✗	✓	✗	✗	✗	✗	✗	✗	✗	✓
Hologram	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✗	✓
Smell/Olfactory	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✗	✓
Tactile	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✗	✓

- Footnotes

	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗
	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗
	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗	✗

TRADE MARK MANUALS

DISTINCTIVENESS

- General remarks
- Criteria and examples

Word Elements

Single Letters

Slogans

Basic Shapes and Simple Figures

Common/Non-Distinctive Labels

Shape Marks

Position Marks

Pattern Marks

Colour Marks



ANNEX – LEGAL REFERENCES

TRADE MARK MANUALS

Manual on DESCRIPTIVENESS of Trade Marks in Absolute Grounds in (selected) CARIFORUM IP Offices



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ONAPI



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IPOSKN
THE INTELLECTUAL PROPERTY OFFICE
OF THE REPUBLIC OF POLAND



REGISTRY OF COMPANIES
AND
INTELLECTUAL PROPERTY
Saint Lucia



Commerce &
Intellectual
Property
Office



BIE
Bureau Intellectuele Eigendom



TRADE MARK MANUALS

DESCRIPTIVENESS

- *General remarks – the notion of descriptiveness*
- *Criteria and examples*

Word Marks

- One word
- Combinations of words
- Misspellings and omissions
- Abbreviations and acronyms
- Terms describing subject matter in goods and services
- Slogans
- Geographical terms
- Descriptive Single letters
- Numerals
- Names of colours
- Names of banks, newspapers/magazines, and airports
- INN codes



Flavour and aroma

Figurative Marks

Other Types of Marks

- Sound marks
- Motion marks
- Multimedia marks
- Hologram marks



ANNEX – LEGAL REFERENCES



DESIGNS MANUALS

Practice Fiche

GRAPHIC REPRESENTATION OF DESIGNS

in (selected) CARIFORUM IP Offices



DESIGNS MANUALS

GRAPHIC REPRESENTATION OF DESIGNS

- Principles and examples

- Use of visual disclaimers
- Types of views
- Neutral background



- Format of views – Requirements from each participating Office

- Recommendations on the quality of the representations (drawings and/or photographs) by IPO

EXAMINATION PRACTICES' MANUALS

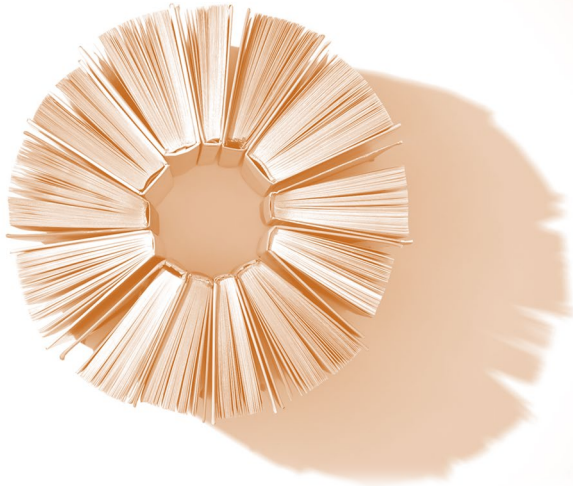
- ***Non-binding documents – Supporting Guides for internal and external stakeholders***
- ***Guiding common principles with associated examples to add clarity***
- ***Cover the majority of cases (approx. 80%)***
- ***No legal constraints***

3. CarIPI II – The way forward

INITIATIVES

Regional: Manuals on selected
topics of interest

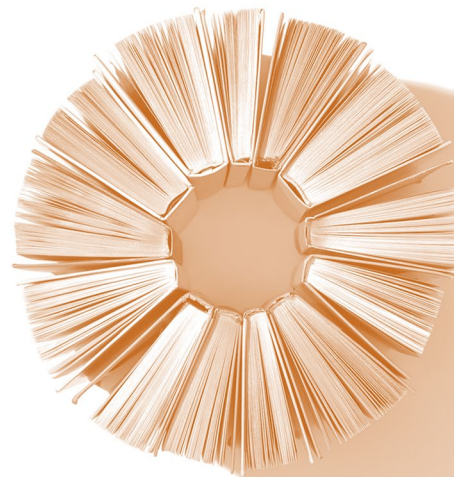
National: Development - Update
of National Guidelines



Initiatives - REGIONAL

Manuals on selected topics of interest

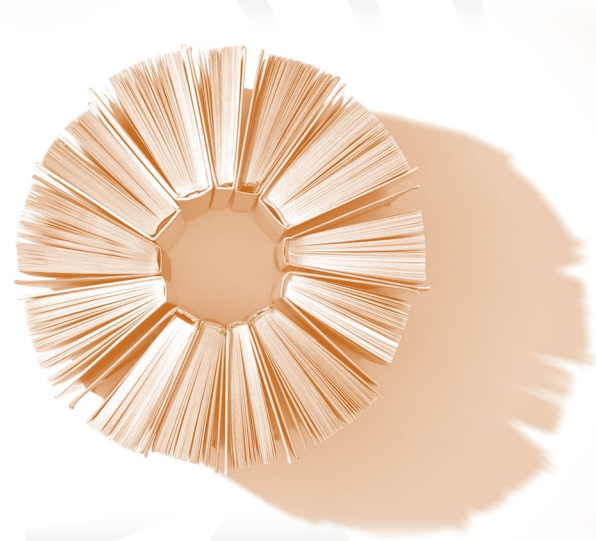
- Identify topics
- Rank the topics based on
relevance for IPOs



Initiatives - REGIONAL

Manuals on selected topics of interest (Examples of TM related topics)

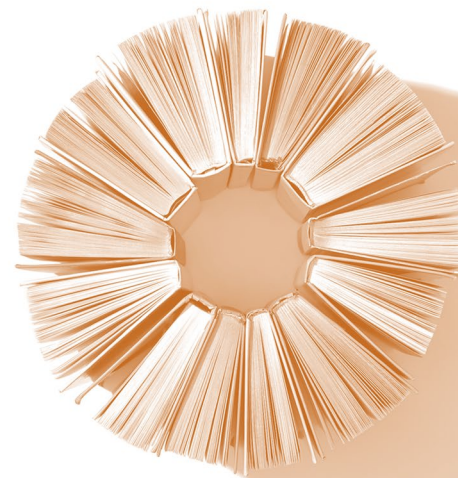
- Evidence of Use (ex. Marks used in a different form to the one registered)
- Likelihood of Confusion (ex. Assessment)
- Acquired distinctiveness
- Bad faith applications
- Trade marks in conflict with flags and other symbols (6ter)
- Trade marks contrary to Public Policy or accepted principles of Morality
- Well-known and Reputed marks



Initiatives - REGIONAL

Manuals on selected topics of interest

1. **Identifying topics of interest and ranking of topics**
2. **Drafting of Manual**
3. **Implementing actions** (including, for example, training and communication actions)



Initiatives - NATIONAL

Development/Update of **National Guidelines** (TMs and/or Designs)



- **UNIQUE SOURCE** of information of all the substantive examination practice of the Office
- **STRUCTURED**
- **PRACTICAL** to staff in charge of the different procedures and to the users of the different office services

Initiatives - NATIONAL

Development/Update of **National Guidelines** (TMs and/or Designs)



1. **Expression of interest and to AWP**

2. **Drafting**

- Defining **working methodology** and **planning** of the activity
- Setting up of **working team** (Office and CarIPI)
- Drafting of **documents** until adoption by Office

3. **Implementing actions** (including, for example, training, updating mechanism and communication actions)

NEXT STEPS

Regional:

- CarIPI PMT to prepare a **tentative list of topics** and invite **all IPOs** to propose additional topics
- IPOs to establish priority topics (**ranking**)
- CarIPI will share the final ranking with all IPOs and **trigger the drafting phase**

National:

- Interested IPOs to **express interest** to the CarIPI PMT
- If additional information is needed by the IPO, a **dedicated vico** can be organized
- Recommended to start at early stages of the project implementation

4. QUESTIONS/COMMENTS

Thank you * Gracias * Merci * Bedankt

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EUIPcooperation



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