

## An Update from INTA's TOPC—TM5 Subcommittee

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INTA and the world's five largest intellectual property (IP) offices, known as the TM5, have a long history of collaboration. The latest cooperative efforts include two sessions that TM5 representatives will be hosting at the Association's upcoming 2021 Annual Meeting Virtual+ and INTA's input into several TM5 projects.

The TM5 is a collaborative framework composed of the China National Intellectual Property Administration (CNIPA), the European Union Intellectual Property Office (EUIPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), and the U.S. Patent and Trademark Office (USPTO). Its purpose is to undertake cooperation efforts to simplify and where possible, harmonize practices and programs for the mutual benefit of trademark applicants and IP offices.

The TM5 Subcommittee of INTA's Trademark Office Practices Committee (TOPC) has a twofold interest in the TM5. First, the Subcommittee fosters the Association's relationship with the TM5, offering a user's perspective on its activities and projects, and providing support for its projects, often by liaising between the TM5 and other INTA stakeholders. Conversely, the Subcommittee is engaged in raising awareness among INTA's membership on the TM5 and its projects, given its valuable contributions to users.

Among completed and ongoing TM5 projects discussed on the [group's website](#) (including Common Statistical Indicators, Common Status Descriptors, the ID List, Bad Faith Trademarks and Fraudulent Solicitations), there are several particularly noteworthy projects that are ongoing and have produced useful practical interim guidelines for users. Two are described in detail below.

**Priority Rights:** Priority rights claims are a critical issue for trademark applicants. Users must be familiar with the different and sometimes burdensome formalities required to have priority rights claims accepted in different countries. This includes obtaining certified copies of the documents, and authentication and translation requirements, often under the added pressure of a deadline.

The goal of this project, jointly led by the EUIPO and KIPO, is to explore ways to reduce requirements for legalization of documents related to priority claims. The project's first phase will produce a comparative study of the rules and practices applied by each of the TM5 partner offices for accepting trademark priority claims. The EUIPO has published a [summary presentation of this study](#). Based on this preparatory work, the TM5 offices will explore the possibility of reducing legalization requirements and promoting the acceptance of documents in electronic format.

In its second phase, the project will assess the feasibility of working toward a convergence of practices among the partner offices on priority claim requirements. This ambitious goal may become more feasible as the use of e-filing and publicly available online information from official IP office databases becomes more widespread and as digitalization processes to certify the authenticity of documents become more secure.

INTA believes the convergence of practices would help provide a more user-friendly trademark system that would be cost- and time-efficient for users, and likely alleviate much of the burden on the receiving IP offices. Meanwhile, to provide valuable information to users, the Association would welcome TM5's publication of the comparative study on the group's website alongside the summary presentation that is already available.

**Indexing of Nontraditional Trademarks:** (Nontraditional trademarks are those that include elements other than character data, such as scents, sounds, motion, tactile characteristics, holographic images, colors, and 3D marks.) Based on the exchange of best practices between the partner offices, this USPTO-led project proposes a common or recommended indexing scheme that aims to improve and possibly harmonize the methods for searching and retrieving nontraditional trademarks. Much like the TM5's ID List project on pre-approved goods and services descriptions, this indexing method could then be adopted by IP offices in other jurisdictions.

The TM5 has sought INTA's input on this project, including commenting on methods of indexing nontraditional trademarks in other jurisdictions, which the TOPC—TM5 Subcommittee and Non-Traditional Marks Committee collaborated on.

Given the complexity in identifying characteristics of nontraditional trademarks, this project is expected to progress in stages, but the interim work is already of substantial interest to brand owners. For example, the TM5 has completed a guide to application requirements and examination of 3D marks at each of the partner offices. The TM5 is currently preparing a similar guide on applications and examination of color marks in the partner offices.

**TM5 Sessions at the 2021 Annual Meeting Virtual+**

To learn more about the TM5, the group will be offering two sessions at the Annual Meeting Virtual+:

- TM5 User Group Meeting (Tuesday, November 16, 7:00 am–9:00 am (EST))—this session is for users of any of the TM5 offices or for those interested in learning more about these offices.
- TM5 Joint Workshop on the topic of Tips for Avoiding Refusals by Each TM5 Office (Wednesday, November 17, 7:00 am–9:00 am (EST))—this workshop, hosted by the JPO, will feature each TM5 member discussing common trademark application mistakes that can lead to registration refusals and how to avoid them.

The two sessions are open to all Annual Meeting registrants, but capacity is limited, and pre-registration is required, so be sure to sign up early!

*Although every effort has been made to verify the accuracy of this article, readers are urged to check independently on matters of specific concern or interest.*

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