

# National offices hit out at plans to abandon relative grounds examination

A number of national offices have expressed their opposition to the European Commission proposal that *ex officio* examination of relative grounds be abandoned.

At present, nine of the 28 member states retain *ex officio* relative grounds examination. Offering a personal opinion, Susanne Ås Sivborg, director general and president of the Swedish Patent and Registration Office,

told *World Trademark Review*: “It is no secret that support from the member states for a compulsory abolition of *ex officio* examination of relative grounds has been so weak that the Lithuanian presidency, in its compromise proposal, concluded that *ex officio* examination of relative grounds should still remain optional for member states.”

There are number of reasons for this resistance. A statement

supplied by Ireland’s Patent and Trademark Office noted: “Irish stakeholders were of the opinion that *ex officio* relative grounds examination may be beneficial in maintaining the integrity of the register and consequently would provide a greater degree of certainty to the proprietors of registered marks as it was believed that, if such relative grounds examination was not undertaken, there may be a

likelihood that multiple similar or indeed identical marks for equally similar or identical goods and services would exist side by side on the register.”

Meanwhile, the Portuguese National Industrial Property Institute pointed to the system’s usefulness in economies mostly composed of small and medium-sized enterprises (SMEs): “In Portugal, more than 70% of applications are filed by companies which

are not represented by any IP representative and that trust the office to guarantee that all trademarks that might harm their earlier rights will not be registered. The suppression of the *ex officio* examination of relative grounds will only favour large companies able to finance daily monitoring activities, will promote infringement and will have a negative impact in the European economy, overburdening SMEs. ”

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### Case comment

“Having your application examined for relative grounds gives a feeling of more certainty and you end up believing that your national office will keep your registration safe by refusing later applications. However, in view of the fact that CTMs are registered every day with no relative grounds examination, businesses that are not experts on how the

trademark system work will have no notion of the importance of watching CTM publications and filing oppositions. In the end, keeping relative grounds refusals on a national level leads to misunderstandings.”

**Tove Graulund, principal of Graulund IP Services and chair of the MARQUES EU Trademark Reform Taskforce**

