

2 Quality Management Methods for Trademark Examination Based on Evaluations by Applicants/Agents^(*)

In addition to quality control in individual cases, comprehensive and systematic quality management is also important for promoting efforts to maintain and improve the quality of trademark examination. Therefore, we conducted this study to examine the desirable trademark examination from the standpoint of external users and quality methods to manage it, using surveys on the actual conditions of quality management at overseas intellectual property offices and through hearing and analysis of the opinions and requests of domestic users. We also conducted a questionnaire survey to evaluate the quality of the overall trademark examination, the quality of the trademark examination in individual cases, and quality management methods for trademark examination in Japan, targeting 1,000 applicants and agents in total. In order to understand the questionnaire in greater detail, we conducted an interview survey targeting 20 applicants and agents in total in Japan. According to the results of the survey, more than 80% of users feel that the “quality” of the recent trademark examination procedures by examiners is appropriate. However, we believe that it is necessary to make continued efforts to further improve quality based on the various opinions and requests from applicants and agents. In addition, there have been improvements in expediting the examination in relation to the first action pendency. Expediting reexamination of written opinions or written amendments and maintenance and improvement of the quality of the examination are considered to be tasks for the future.

I Introduction

In order to maintain and improve the quality of trademark examination, efforts have been made for greater promptness and precision. In addition, the examinations that secure transparency and fairness have been promoted based on a common understanding with the users of the trademark system, by further increasing transparency in the formulation of the Examination Guidelines for Trademarks.

To ensure prompt and precise examination for individual cases, the trademark examination department has continuously conducted the quality control of trademark examination by checking the content of individual trademark examinations by the head of each examination office, etc. up to the present date. At the same time, the Trademark Division and the trademark examination department have exchanged opinions with and collected opinions from various industry groups in order to understand user needs.

Furthermore, they also hold discussions on the mechanism of quality management in trademark examination in order to make organized efforts to improve the quality, by mapping out environmental changes in and outside of Japan and by efficiently providing

consistently high-quality services that are sensitive to the voices of the users.

In this study, we surveyed and analyzed problems with the current state of trademark examination and user needs while focusing on the quality management method for the trademark examination adopted at overseas intellectual property offices and external evaluation thereof (evaluation of the trademark examination by applicants and agents). We conducted this study for the purpose of providing basic data useful for considering desirable trademark examination from the standpoint of external users and the quality management method for trademark examination.

II Quality Management Method for the Trademark Examination and Evaluation System by External Users in Other Countries

1 Quality management method for trademark examination at intellectual property offices in seven countries and one region

We conducted a survey on departments in

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charge of quality management for trademark examination at each intellectual property office and on management methods as well as evaluation thereof by external users (including customer satisfaction survey). We sent a questionnaire targeting intellectual property offices in seven countries and one region, specifically, the United States, Europe, South Korea, China, the United Kingdom, Germany, Australia, and Singapore. However, intellectual property offices in Europe, South Korea, China, and the United Kingdom answered the questionnaire on the condition that their answers would be kept undisclosed. Therefore, for these four offices, only the results of the bibliographic survey are included in this report.

(1) United States Patent and Trademark Office (USPTO)

The USPTO has the Office of Trademark Quality Review and Training (OTQRT), which is a department in charge of quality management, under the control of the Deputy Commissioner for Trademark Examination Policy of the Trademark Office.

The OTQRT is a department independent from the Trademark Examination Organization (TMEO) and it objectively evaluates the quality of trademark examination. A review is conducted mainly at the examination stage; however, it is also possible to conduct evaluation even before examination or after registration. The OTQRT evaluates the quality of determinations by examiners, of individual documents, and of support documents based on evidence, and stores related data. Moreover, the OTQRT analyzes this data to specify the need for quality, which is incorporated through various kinds of training provided to improve the quality of examination operations at the USPTO.

With regard to evaluation by external users, the USPTO has been implementing the Customer Panel Quality Survey since 2006.

(2) Office of Harmonization for the Internal Market (OHIM)

The OHIM has obtained ISO 9001:2000 certification and has introduced a Quality Management System (QMS) for the entire OHIM, thereby making efforts for quality management, including checking the quality of sample cases.

The OHIM User Satisfaction Survey, which is conducted as part of the OHIM QMS, has been conducted once a year since 2005 up to the present.

(3) Korean Intellectual Property Office (KIPO)

The KIPO has the “Examination Quality Assurance Officer” under the Deputy Commissioner, as a “department” in charge of quality management for overall examination operations.

The KIPO outsources evaluations by external users to external specialist research organizations, and has conducted the customer satisfaction survey twice a year (semi-annually) and the user-friendliness survey four times a year (quarterly) by phone or by other means since 2003. The survey results are published on its website to coincide with each fiscal year.

(4) China Trademark Office (CTMO)

The CTMO’s examination quality management framework is a means of strengthening organization control, with the aim of appropriately implementing quality-management operations for trademark examination.

The CTMO’s specialized staff conducts the customer satisfaction survey when they speak with users in the telephone service set up for receiving inquiries.

(5) United Kingdom Intellectual Property Office (UKIPO)

The UKIPO has a department in charge of the quality management of trademark examination, which is independent from the examination department.

With regard to the customer satisfaction survey, the UKIPO conducts an Online Survey via the Web on a steady basis and conducts a Customer Survey once every two years.

(6) German Patent and Trademark Office (DPMA/GPTO)

The DPMA has a department that has jurisdiction over or coordinates quality management of the examination, and carries out the quality management of trademark examination independently, separately from the quality management of the examination of other industrial property rights (patents/designs).

The quality checking of the examination starts immediately after data is retrieved for the first time; and all procedures during the duration of a trademark are subject to the check. This includes quality checking in terms of whether the examination procedures themselves have been correctly implemented and whether all the

internal instructions have been observed.

The DPMA does not implement any measure for evaluation of the quality of the trademark examination by external users at present. However, it plans to do so during the period from fiscal 2012 to 2013.

(7) IP Australia (IPA)

The IPA has a “Quality Improvement Section,” which administers quality management for examinations. The Quality Improvement Section is operated independently from the examination department.

In the examination-results quality-review process at the IPA, examination operations by trademark examiners, excluding assistant trademark examiners, are subject to review. The process is carried out by sampling examination results. Samples for each examiner are reviewed by checking with a series of evaluation standards.

The IPA implements measures for evaluation by external users through the IPA Customer Benchmark Survey.

(8) Intellectual Property Office of Singapore (IPOS)

The IPOS has no department in charge of quality management for examinations.

The IPOS formally introduced the Case Management Conference (CMC) system in March 2009 after going through a trial operation from February to July 2008, so that it could hold interviews with the parties concerned more proactively at an early stage of the examination procedures and could promptly and effectively process the cases to be examined.

So far, the IPOS has yet to conduct any customer satisfaction survey.

2 Survey targeting overseas agents and applicants

In addition to the survey on the actual conditions of quality management method for the trademark examination targeting intellectual property offices in the aforementioned seven countries and one region, we conducted a survey by using one representative or law firm for each country/region in order to gain an understanding of external users’ (applicants’ and agents’) evaluation of the quality management method for the trademark examination adopted at intellectual property offices in the seven countries and one region.

The survey results revealed that overseas

agents and applicants regarded evaluations by external users, including customer satisfaction surveys, as one of the appropriate methods for the quality management of trademark examination.

In addition, many agents and applicants believe that an effective way to improve the quality of the trademark examination is by reflecting the results of surveys, including customer satisfaction surveys, on the actual practice of the trademark examination.

III Quality Management Method for the Trademark Examination Based on Evaluation by Domestic Applicants/Agents

We conducted a domestic questionnaire survey targeting 650 domestic applicants who filed 10 or more applications for trademark registration in 2008 and 350 agents who acted for applicants in filing applications for trademark registration in 2008 (1,000 in total).

1 Quality evaluation of the overall trademark examination

(1) Degree of satisfaction with the trademark examination

Those who evaluate overall procedures carried out recently (within around one year) as appropriate (total of those who answered “Appropriate” or “Rather appropriate”) accounted for more than 80%.

(2) Key points in the trademark examination

It was revealed that applicants and agents regard “appropriateness of determination of similarity” (85.5%) and “appropriateness of determination of distinctive feature” (84.9%) as the most important viewpoints for measuring the degree of satisfaction with the examination, followed by “examiner’s understanding of designated goods and designated services” (39.8%) and “promptness of the examination” (38.9%).

With regard to “appropriateness of determination of distinctive feature,” most respondents consider “invariable determination among examiners” (74.5%) to be important, followed by “determination based on the actual conditions of transactions” (65%), “determination that does not depart from the Examination Guidelines for Trademarks” (43%), and

“determination that does not depart from trial/court” (33.8%).

With regard to “appropriateness of determination of similarity,” most respondents consider “invariable determination among examiners” (75.4%) to be important, similar to the aforementioned appropriateness in determining a distinctive feature, followed by “determination based on the actual conditions of transactions” (56.1%), “determination that does not depart from the Examination Guidelines for Trademarks” (48.7%), and “determination that does not depart from trial/court” (36.8%).

With regard to “appropriateness of examiner’s understanding of designated goods and designated services,” most respondents consider “understanding of the actual conditions of transactions” (64.7%) to be important, followed by “invariable determination among examiners” (55.2%) and “understanding of designated goods or designated services stated in filing documents” (54.9%).

(3) Promptness of the examination

About 80% of the respondents regard the current first action pendency (period from the filing date to the day on which the first examination result is notified; 5.9 months on average in fiscal 2009) to be reasonable. Most of the respondents who answered “long” consider “three months” to be a desirable period, while most of the respondents who answered “short” desire a period of more than “six months.”

With regard to the “period from submission of a written opinion or a written amendment to dispatch of a notice of the final examination result,” about 60% of respondents regard the current period as reasonable. However, compared to the degree of satisfaction with the first action pendency, more respondents consider the “period from submission of a written opinion or a written amendment to dispatch of a notice of the final examination result” to be “long.”

(4) Communication with examiners

Both applicants and agents cite the following as matters that they consider particularly important from the viewpoint of communication with examiners, in order of descending prevalence: “appropriateness of statements in a notice of reasons for refusal” “appropriateness of statements in a decision of refusal” and “appropriateness of correspondence in interview, by phone, etc.”

2 Evaluation of the quality of the trademark examination in individual cases

(1) Statements in a notice of reasons for refusal

In answer to a question of whether it was possible to sufficiently understand reasons for refusal indicated by the examiner from a notice of reasons for refusal, more than 90% of the agents and applicants answered “Possible to sufficiently understand” or “Rather possible to understand.” And the percentage of applicants who answered “Possible to sufficiently understand” is 10% higher than the agents who answered the same.

(2) Statements in a notice of reasons for refusal

In answer to a question of whether it was possible to sufficiently understand why the reasons for refusal indicated by the examiner have not been eliminated from a decision of refusal, about 70% of respondents answered “Possible to sufficiently understand” or “Rather possible to understand.” However, more than 20% of the agents and applicants answered “Rather not possible to understand.” The percentage for understanding statements in a decision of refusal is 15% lower than that for understanding statements in a notice of reasons for refusal. As for reasons that it was not possible to understand statements in a decision of refusal, besides “Others,” most respondents answered “Examiner’s view is not sufficiently indicated” with regard to the matters asserted in a written opinion, accounting for about 30%, followed by “Examiner’s view is not at all indicated,” accounting for 17%.

3 Survey method

With regard to the content of questions in the questionnaire, about 80% of the respondents answered that there was “no” question that was hard to answer or to understand.

With regard to a desirable question form, more than 70% of the agents and applicants in total answered “Close-ended question.” The breakdown is: “Close-ended question” 72.6%, “Grade-evaluation question” 17.4%, and “Free-answer question” 8.8%.

With regard to a request for answering a questionnaire about the quality evaluation of the trademark examination in the future, more than 95% of the respondents answered “Will cooperate” or “Will cooperate with conditions.”

With regard to the points to which consideration has to be given in a survey like this, most respondents cited the handling of information on individual cases and consideration to personal information.

IV Domestic Interview Survey

We conducted the domestic interview survey targeting 13 applicants and 7 agents (20 in total) with the aim of understanding the items of the domestic questionnaire survey in further detail.

1 Evaluation of the quality of the trademark examination

With regard to the impression of the “quality” of recent examination procedures, there were opinions that “Both the quality of examination by examiners and examiners’ responses are basically appropriate,” “The content of reasons for refusal has been reasonable in the past two or three years, and there is no problem,” “Suggestions for amendments are written in an understandable way, and there is no problem in terms of responses,” and “There is no problem in terms of the overall quality of trademark examiners.”

With regard to the examination period, many said that the current first action pendency (5.9 months on average in fiscal 2009) was reasonable. On the other hand, many applicants and agents were concerned that there would be problems in relation to the priority under the Paris Convention and applications based on the Madrid Protocol if the first action pendency were shorter than sixth months.

Some pointed out that the “period from submission of a written opinion or a written amendment to dispatch of a notice of the final examination result” differs depending on the cases. There is also a request that “a standard should be set; for example, the final examination result shall be dispatched within a certain period, e.g., within one to three months.”

On the other hand, where examination appears to be delayed, agents tend to actively submit a letter of inquiry. Applicants sometimes submit a letter of inquiry through their agents. However, there was an opinion that applicants who file applications by themselves do not actively use a letter of inquiry for fear that it might have a negative effect on the examination result.

2 Method for evaluation of trademark examination by external users

Both the applicants and the agents requested that questionnaire and interview surveys like those conducted at this time continue to be conducted as they can have opportunities to express their opinions. In addition, they also requested that opportunities like this interview or the meetings for exchange of opinions between applicants and examiners be increased if possible.

With regard to the questionnaire survey method, there was no negative opinion. However, some said that an online survey that is conducted via the Internet also matched the modern age. With regard to the question form, many said that close-ended questions imposed fewer burdens on respondents.

With regard to the frequency of the surveys, most interviewees answered “once every two to three years” or “once every three to five years.”

With regard to publication of the results, many interviewees hope that the survey results are published (five opinions), and some interviewees said that they would like to know the answers of other users. In addition, there was an opinion that respondents would have an incentive to answer questions if they could find out how the JPO was going to use the survey results in examinations.

V Desirable Trademark Examination Based on Evaluation by Applicants/Agents and Problems with and Analysis of Quality Management Method

1 Significance and necessity of quality management method for the trademark examination based on evaluation by applicants/Agents

Evaluation of the trademark examination by applicants and agents is important not only in directly confirming the evaluation of the quality of the examination as “external evaluation” but also in promoting the measurement and improvement of the effect of the quality management method. Overseas intellectual property offices are also aware of the importance and have started related efforts. In Japan, there is also a request to establish a method by which evaluation by applicants and agents can be heard efficiently and

sufficiently.

Out of the overseas intellectual property offices in the seven countries and one region for which this survey was conducted, those in the six countries and one region have a department in charge of quality management intended to improve the quality of the examination themselves. In addition, a department independent from the examination department conducts evaluation of the quality of the examination in many of those countries/region. This should be drawn on from the perspective of objectivity and fairness.

Moreover, the aforementioned overseas intellectual property offices in the six countries and one region conduct surveys on evaluation by external users (including customer satisfaction survey) as part of quality management. It is considered necessary to establish a department in charge of quality management and continuously conduct surveys on evaluation by external users (including customer satisfaction survey) in Japan in reference to the results of the survey targeting the overseas intellectual property offices.

2 Desirable trademark examination based on evaluation by applicants/Agents

(1) Degree of satisfaction with the trademark examination

According to the results of the questionnaire survey, regarding the degree of satisfaction with the trademark examination, respondents who answered “Appropriate” or “Rather appropriate” account for more than 80%. In addition, in the interview survey, many interviewees said that they had no problem with the “quality” of the trademark examination. However, 16% of respondents of the questionnaire survey answered “Rather inappropriate” or “Inappropriate,” and this figure is not at all small. Although some say that this figure is attributable to special cases and that the respondents do not feel that the overall examination is inappropriate, further improvement of the quality seems to be necessary.

(2) Key points in the trademark examination

With regard to “key points in the examination,” which applicants and agents answered in the questionnaire survey, “invariable determination among examiners” accounted for a large percentage for every item, specifically, 74.5% for distinctive feature, 75.4% for determination of similarity, and 55.2% for

designated goods and designated services.

This means that, from the perspective of uniformity and predictability of examination results, variability in determinations within the JPO causes significant disadvantage to users. Alleviation of such variability seems to be strongly requested.

<Determination of distinctive feature>

With regard to “determination of distinctive feature,” according to the interview survey, many hope for “determination based on the actual conditions of transactions,” despite the opinion that it is wrong to determine a trademark as having distinctiveness as “there is no fact of its use in the market.” This seems to be indicating that a trademark that is highly likely to be used in the relevant field with changing times should be refused based on the “actual conditions of transactions” even if there is no fact of its actual use. However, some of the actual conditions in the relevant industry cannot be understood through an ex officio search by examiners.

<Appropriateness of determination of similarity>

With regard to the “appropriateness of determination of similarity,” it was pointed out, in the interview survey, that standards for determining the consecution and unity of a composite trademark are strict in some cases and are lax in other cases, and that even if one cites past cases as examples, the examiner sometimes simply says that “the example cases differ from this case.” What users request in relation to determination of similarity is considered to be the ensuring of consistency in examiners’ determinations.

<Appropriateness of examiner’s understanding of designated goods and designated services>

According to the results of the questionnaire survey, many applicants and agents answered that they attached importance to “understanding of the actual conditions of transactions” in relation to the appropriateness of examiner’s understanding of designated goods and designated services. It can thus be said that the understanding of the actual conditions of transactions is requested.

(3) Promptness of the examination

With regard to the first action pendency, applicants and agents appear to be basically satisfied with the current period. Taking into account opinions about the first action pendency becoming excessively short (concerns about deterioration in quality, relationships with the

right of priority, and the time limit for submission of an information offer form), it seems that applicants and agents consider the appropriate first action pendency to be around six months.

On the other hand, with regard to the “period from submission of a written opinion or a written amendment to dispatch of a notice of the final examination result,” the period is long for some cases (though these are individual situations), and applicants appear to be dissatisfied with the period in some cases. Therefore, it might be fine to set a goal, for example, three months maximum. In addition, it is necessary for the examiner to promptly render a decision in cases of amendments as instructed by the examiner (in relation to Article 6) and simple written amendments (deletion of designated goods that have been determined to be similar). We believe that priority should be given to expediting the reexamination of a written opinion or a written amendment.

(4) Communication with examiners

Communication with examiners through interview/by phone and suggestions for amendments by examiners were evaluated as being useful.

With regard to statements in a notice of reasons for refusal, the degree of understanding thereof among applicants and respondents was extremely high, at 91%. However, it was only 65.9% for statements in a decision of refusal. Where an applicant is dissatisfied with a decision of refusal, he/she will file a request for a trial against the decision; therefore, a decision of refusal subject to such a request must sufficiently disclose the reasons for the refusal. Consequently, it can be said to be desirable to clearly state determinations on the applicant's assertions if a written opinion has been submitted.

3 Quality management method for the trademark examination based on evaluation by applicants/Agents

(1) Survey method/question form

With regard to the method of questionnaire survey to hear the opinions of applicants/agents according to the questionnaire and interview surveys, there was no answer showing dissatisfaction with the survey method. Therefore, this questionnaire survey method (sending electronic data to those who wish) is considered to be appropriate.

With regard to a question about desirable

question form, according to the questionnaire survey, close-ended questions account for 72.6%, grade-evaluation questions account for 17.5%, and free-answer questions account for 8.8%. In the interview survey, with regard to the question form in the questionnaire survey, many said that checking questions, such as close-ended and grade-evaluation questions, imposed fewer burdens on respondents. Close-ended questions seem to be reasonable from the perspective of fewer burdens on respondents and easiness of tabulating and analyzing the content.

(2) Selection of those subject to the surveys/individual cases and frequency of the surveys

<Selection of those subject to the surveys/individual cases>

In the questionnaire and interview surveys, there were the opinions that “I don't know how the cases were selected” and “I don't know why the cases were selected.” With regard to the method of selecting individual cases, some expressed the opinion that more answers are obtainable by having users (respondents) select cases or by narrowing down the cases subject to the surveys to cases in which reasons for refusal have been notified at least once.

Some pointed out that “Four to five individual cases are a bit too many,” and there seems to be room for considering a suggestion that “Respondents select individual cases and answer the questions.” Even when not designating cases, it is considered to be a good idea for respondents to select cases from a list prepared in advance and to answer the questions.

<Frequency and timing of the surveys/time for response>

With regard to the frequency of the surveys, some said that once every two to three years or once every three to five years was effective. In addition, others said that it was desirable to conduct surveys in the form of linking well to institutional turning points, including legal revisions and operational reforms, for example, “revisions of the Examination Standards for Similarity of Goods or Services” (every five years). In addition, there was also the opinion that it is desirable to conduct the surveys once a year; however, it is considered unnecessary to increase the frequency of the surveys to that level, taking into account that the answers are not of the nature of changing significantly within a short period of time if the survey content is the same and that the survey results are analyzed and

reflected on the examination and operations. It is considered reasonable to conduct the surveys on a regular basis at certain intervals in consideration of burdens on the respondents.

In addition, it is also possible to use a Web-based full-time satisfaction survey (tabulated quarterly) and a customer satisfaction survey conducted once a year concurrently, like in the United Kingdom and Australia.

With regard to the response time, no one said in the questionnaire and interview surveys that the four weeks given for this questionnaire survey were too short. However, it is considered necessary to cater to respondents, taking into account the timing of the survey, in setting the response time, for example, by setting a little longer period (e.g., six weeks to two months), in order to increase the response rate as much as possible.

<Publication/feedback of the results>

In the interview survey, many wished for publication/feedback of the survey results. Some said that they would like to know the answers of other users. In addition, there was the opinion that respondents would have an incentive to answer questions if they could find out how the JPO was using the survey results on the examination. In any of these cases, it is necessary to avoid the publication of the survey results by which individual cases may be identified, from the perspective of confidentiality of information. Therefore, it is considered necessary to ensure that only statistical results are published and to examine the method of feedback with the greatest care so that individual cases/respondents are not identified.

<Points to keep in mind in the surveys (handling of information)>

In this questionnaire survey, most of respondents who answered “Yes” to the question of whether they think that consideration is necessary in some cases specifically cited the handling of information on individual cases and consideration to personal information. Some respondents were worried that their answers might have a negative effect on the examination of pending applications. Therefore, it is considered necessary to examine, in future surveys, whether it is desirable to adopt an answer form by which the examiner in charge is identified.

4 Conclusion

More than 80% of users feel that the “quality” of the recent trademark examination

procedures by examiners is appropriate. However, we consider it necessary to make continued efforts to further improve quality based on various opinions and requests of applicants/agents concerning the quality of the examination. In addition, improvements have been carried forward with regard to expediting the examination in relation to the first action pendency. Expedition of reexamination of a written opinion or a written amendment and maintenance/improvement of the quality of the examination are considered to be future tasks.

With regard to the task of maintaining/improving the quality of the examination, it is considered necessary to take actions, such as establishing a department in charge of quality management at the JPO in reference to the results of the overseas survey, continuously conducting surveys on evaluation by external users (including customer satisfaction survey), and reflecting users’ opinions. In addition, it is probably important to publish the process and results thereof in order to enhance awareness of both examiners and users.

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