

Mr. Francis Gurry  
Director General  
World Intellectual Property Organization

28<sup>th</sup> February 2018

Dear Mr. Gurry,

**WIPO Communication C. M 1462 of 24 January 2018  
Proposal to Discontinue Communications by Facsimile**

**Observations of the Chartered Institute of Trade Mark Attorneys**

From WIPO Communication C. M 1462 of 24 January 2018 it is noted that it is proposed that communications by facsimile with the Office be discontinued with effect from 1 April 2018.

The Institute welcomes the provision of on-line forms, the Madrid Portfolio Manager and the Contact Madrid services and the efficiencies that they provide. However on-line systems are subject to service failures, even in the best maintained systems. Similarly, national offices, rights holders and their representatives may suffer problems with their systems, despite their best endeavors. We therefore are of the strong opinion that the Office should retain the facility for reception of communications by facsimile that should be separate from its main systems, for use when, and only when, there has been a breakdown / failure either with the Office's systems or those of a national office, rights holder or their representative. It would inequitable if rights holders were to lose their rights through no fault of their own.

We understand that within the last two weeks the Office's online ePCT system failed, a technical error having occurred with the receiving Office filing server. Had there not been the ability to file the application by facsimile the situation would have been fatal for a last day case.

It is to be noted that the EUIPO recognizes that on-line systems may fail; it recognises the potential problem; their Guidelines for Examination in the Office, Part A, General Rules, for example at page 5, says:

However, fax is not an accepted means of communication for filing applications for the registration of an EU trade mark<sup>1</sup>. Nevertheless, exceptionally, where a technical malfunction prevents the applicant from filing through the User Area, an EUTM application submitted by fax will be deemed to have been received by the Office provided that the applicant resubmits, within three working days of the original fax submission, the application for registration of an EUTM with the same content

through the User Area together with a fax receipt clearly identifying the original fax submission. Failure to comply with these conditions will result in the original fax submission being deemed as not having been received.

<sup>1</sup> Applicable as of 01/01/2018.

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We would therefore ask that the Office reconsiders its decision to discontinue completely the ability to communicate with the Office, and that it still be available for use, but of course only in exceptional circumstances.

Yours faithfully,

Oscar Benito  
Lead CITMA WIPO Liaison Working Group.