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POUR LA PROTECTION DE LA PROPRIETE INTELLECTUELLE**

**INTERNATIONAL ASSOCIATION
FOR THE PROTECTION OF INTELLECTUAL PROPERTY**

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Report

Special Committee Q177

**Substantive Trademark Law Harmonisation
Harmonisation du Droit Matériel des Marques
Harmonisierung des materiellen Markenrechts**

Report Q177

Substantive Trademark Law Harmonization

by Marino PORZIO (Chile)

The Terms of Reference of the Special Committee Q177 mention as main task of Q177 "to monitor the work of the WIPO Standing Committee on Trademarks (SCT), to attend their meetings, to study their proposals and in particular advise on the works of the Trademark Harmonisation proposals".

The last Session of the SCT has taken place in April 2005 and in order to give a full overview of the recent discussions and developments my Report of this Session is included below. As these are the latest news in the field, this Report serves at the same time as Committee Report of the Special Committee Q177.

Report to the Bureau of WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT); 14th Session (April 18 to 22, 2005)

**Marino Porzio, Chairman Special Committee Q177,
AIPPI's observer to SCT**

From April 18 to 22, at the World Intellectual Property Organization (WIPO), in Geneva, took place the Fourteenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).

This session was almost entirely devoted to finalize preparations for the Diplomatic Conference on the revision of the Trademark Law Treaty (TLT) of October 27, 1994, which is scheduled to take place, on March 13 to 31, 2006, while it also dealt briefly with the possible future work of the Standing Committee which Fifteenth Session is tentatively scheduled for November 28 to December 2, 2005.

The session of the SCT was followed, on April 30 and 31, by a two day preparatory meeting for the Diplomatic Conference which participation was limited to Government representatives. At this meeting, the representative of Singapore announced that his Government would be making a formal invitation to the WIPO Assembly in September, in order that the Diplomatic Conference be held in Singapore.

A) Revision of TLT

I) General

- 1) The session continued the examination of the Draft Revised Trademark Law Treaty prepared by WIPO's Secretariat in order to discuss those provisions which had not yet been discussed and to complete discussion of those which had remained pending of approval from previous sessions.
- 2) One of the most important discussions of a general nature, because of its legal and political implications, arose from the need to determine the nature and scope of the Diplomatic Conference. In fact, many delegates were under the impression that the Diplomatic Conference would be convened for revising the existing TLT. However, after listening to explanations from the Secretariat the SCT's final decision was that the Diplomatic Conference will be convened to examine and conclude a "new" treaty, although the text to be adopted is based on a revision of the existing TLT.

While the distinction is rather subtle, the importance of this discussion results from the fact that the governments that can be invited by WIPO in both cases are entirely different. In fact, if the Conference's task is the revision of the existing treaty, only the actual thirty three members of same can be invited, while if the Conference is to examine and conclude a new treaty, all WIPO members can be invited which may eventually result in an easier and wider acceptance of the new treaty.

II) Specific

The most interesting features in relation to the substantive aspects of the draft revised treaty, which were discussed during this session are the following:

1) Article 2, "Marks to which the treaty applies"

After considering several possible draft alternatives for Art. 2(1) in relation to the nature of the marks, the SCT decided on a simple and clear provision: "Any Contracting Party shall apply this Treaty to marks consisting of signs that can be registered as marks under its law".

2) Article 3, "Application"

In this long provision dealing with the several requirements of an application, those requirements referring to the representation of the applied for mark were pending of decision and were thus the subject of lengthy discussions. The two following subparagraphs were adopted by the Commission:

- Art. 3(1)(a)(ix) "Any Contracting Party may require that an application contain ...at least one representation of the mark, as prescribed in the Regulations".
- Art. 3(1)(a)(x) "Any Contracting Party may require that an application contain ...where applicable, a statement, as prescribed in the Regulations, indicating the type of mark as well as any specific requirement applicable the that type of mark, indicating that the applicant wished that the mark be registered and published in the standard characters used by the Office, or indicating that the applicant wished to claim color as a distinctive feature of the mark".

3) Article 8 "Communications"

In this article the question of means of transmittal and form of communications had remained pending of approval. The SCT adopted the following drafting for this paragraph:

Art. 8(1) "Any Contracting Party may choose the means of transmittal of communications and whether it accepts communications on paper, communications in electronic form or any other form of communication".

4) Article 20 "Use of a Mark on behalf of the holder"

The provision included in the draft treaty prepared by the Secretariat had been the subject of discussion in previous meetings of the SCT. The following final draft provision was adopted: Art. 20 "A Contracting Party may not require the recordal of a license as a condition for the use of a mark by a licensee to be deemed to constitute use by the holder in proceedings relating to the acquisition, maintenance and enforcement of the mark".

5) Article 22 "Observations in case of intended refusal"

This important article had also been the subject of discussions in previous meetings. A final draft provision was approved by the SCT with the understanding that a clarification reflecting the content of the provision would be added to the notes. The text adopted is the following: Art. 22: "An application under Article 3 or a request under Articles 7, 10

to 14, 17 and 18 may not be refused totally or in part by an Office without giving the applicant or the requesting party, as the case may be, an opportunity to make observations on the intended refusal within a reasonable time limit. In respect of Article 14, no Office would need to give an opportunity to make observations where the requesting party has already had an opportunity to present an observation on the facts on which the decision is to be based”.

- 6) *In addition to the above, a number of provisions concerning the draft Regulations were also discussed and a draft provision eventually adopted.*

The most important discussions and decisions dealt with Rule 2, on the manner of indicating names and addresses; Rule 3, on details concerning the application; Rule 4, on details concerning representation and address of service; Rule 5, on details concerning the filing date; Rule 6, on details concerning communications; Rule 7, on the manner of identification of an application without its application number and Rule 10 on details concerning the request for recordal of a license or for amendment or cancellation of the recordal of a license.

B) Future Work

A brief discussion was held on the future work of the Standing Committee but no formal proposals were made nor detailed topics were mentioned except in a very general manner.

Informal discussions mentioned topics like Industrial Designs and Geographical Indications although on the latter there is a certain awareness that the topic has been the subject of difficult discussions at WTO with no foreseeable result as to the final decision.

WIPO's International Bureau circulated, as a matter of recollection and to facilitate discussions, a paper it had prepared in 2002, entitled "Suggestions for the further development of International trademark Law" (WIPO Document SCT/8/3 (April 26, 2002)).

In conclusion, SCT decided to invite representatives of member States as well as observers, to submit in writing to WIPO's Secretariat, by **July 1, 2005**, concrete proposals for the future work of the Committee. These proposals will be duly translated by the Secretariat and made available to the Committee for consideration at its next session.

C) Conclusion

The meeting concluded preparations for the Diplomatic Conference and was able to finalize a solid draft text from the legal and technical point of view and which should serve as an excellent basis for the new treaty to be concluded by the Diplomatic Conference. This text will also contribute to the harmonization of Trademark Law in the sense that it has a certain resemblance to a Model Law on the matter which, if adopted by a large number of States, should become an interesting common basis for the treatment of trademarks.

It would be interesting for AIPPI to examine this text, probably within Special Committee Q177, with a view to formulating concrete recommendations for AIPPI which could be circulated to National Groups for information. These recommendations, if appropriate, could be forwarded by National Groups to their government representatives. Finally, such recommendations could be used by the AIPPI observer delegates to the Diplomatic Conference as a basis for their participation.

Finally, to be recalled the invitation of SCT to formulate proposals on its future work which could constitute a good opportunity for AIPPI to send concrete suggestions if this is deemed appropriate. The imminence of the deadline will probably make difficult to conduct a broad consultation to National Groups but perhaps a quick consultation is still possible in order to draw up a list of proposals which perhaps some National Groups may have ready if they have been working on these topics.