



A I P P I

ASSOCIATION INTERNATIONALE
POUR LA PROTECTION DE LA PROPRIETE INTELLECTUELLE

INTERNATIONAL ASSOCIATION
FOR THE PROTECTION OF INTELLECTUAL PROPERTY

INTERNATIONALE VEREINIGUNG
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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 Harmonisation

Composition of the Committee

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| Chairman: | Marino PORZIO (Chile) |
| Co-Chairman: | Roland MALLINSON (United Kingdom) |
| Secretary: | Matthew SWINN (Australia) |
| Members: | Kozo TAKEUCHI (Japan) Gerard DU PLESSIS (South Africa) Richard METZGER (France) Brett A. AUGUST (United States of America) Joaquín LATAS (Spain) Wu QUN (China) Christian ROHNKE (Germany) Zeljko TOPIC (Croatia) |

Mandate

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 on Trademark Harmonization proposals.

To formulate, and with the approval of the Bureau to submit and represent AIPPI's standpoint at WIPO Meetings (particularly SCT).

Report of activities and recent developments

I) The Singapore treaty on the law of trademarks

In the field of Trademarks and in particular Trademark Harmonization, year 2006 was marked by the adoption of the new Singapore Treaty on the Law of Trademarks which was adopted by the WIPO Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty, which was held in Singapore from March 13 to 31.

The adoption of this treaty arose great interest as was shown by the presence in Singapore of delegations from 162 Governments, representing WIPO Member States, plus an important number of International Governmental Organizations and interested Non-Governmental Organizations. The new Treaty was signed by representatives of 43 governments.

AIPPI was represented by an observer delegation in Singapore as well as in all preparatory meetings of this important treaty.

1) Treaty background

The Singapore Treaty represents the culmination of the work of WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications over fifteen sessions starting in 1998.

The objective of this work was the revision of the WIPO Trademark Law Treaty concluded in 1994 with a view of streamlining and simplifying, on a worldwide basis, administrative procedures relating to national and regional trademark applications and the maintenance of trademark registrations.

Although the elaboration of the Singapore Treaty was based on a revision of the 1994 TLT, this Treaty is to be considered as an entirely new treaty which should eventually entirely substitute the former. In fact, provisions adopted at the Diplomatic Conference make this situation very clear. Hence, members of the 1994 TLT will have necessarily to accede to the new treaty.

2) Scope and nature of the Singapore Treaty

The new treaty can be considered as an effective attempt of harmonization in the field of Trademark Law as far as registration of new marks is concerned, renewal of same and licensing of marks. It essentially deals with procedural aspects of trademark law.

Although many of the different provisions are extremely flexible and few are absolutely compulsory, the text of the treaty has the virtue of covering practically all situations a trademark may face from the time of application and the corresponding situations of both applicants and owners as well as the competent authorities. In this manner it amounts almost to a model law for countries not having a well organized system or for those in need of revising same.

The detailed Regulations for the new treaty and the most detailed model forms appearing at the end of the text add clearly to the model function mentioned above.

3) Treaty structure and content

The new treaty consists of 22 substantive provisions and ten administrative provisions, plus 10 provisions of regulations and 12 model international forms. The number of provisions both of the Treaty and Regulations may be misleading. In fact in most cases they consist of several paragraphs and subparagraphs resulting in very lengthy texts.

The text is completed with a Resolution adopted by the Diplomatic Conference which is supplementary to the Treaty. This Resolution deals with two major aspects. In the first place it confirms the freedom of countries in relation to certain provisions of the Treaty and, in the second, it provides for technical assistance to developing and least developed countries.

The whole document is over 100 pages and certainly represents a major legal work where WIPO has invested considerable time and expertise.

Most important provisions

- a) The Treaty will apply to all trademarks relating to goods or services. However, it shall not apply to collective marks, certification marks and guarantee marks.
- b) The major elements of an application are provided for and countries are free to establish some or all of them in their domestic law. In this respect the possibility exists for having a single application for several classes. It is also provided for the possibility of including a declaration of intention of use in the applications. In the same provision certain prohibitions for other requirements are clearly established.
- c) Precise provisions are established for the change of ownership of marks, whether applied for or registered and the corresponding records, in particular the formalities to be complied with whether mandatory or voluntary.
- d) A duration term of ten years is established for registrations and renewals.
- e) A rather detailed regime of relief measures in case of failure to comply with time limits is established.
- f) A detailed regime is also provided for the recordal of licenses with a list of prohibitions of imposing certain requirements.
- g) An Assembly of Contracting Parties is established which, among other things, is empowered to amend the Regulations.

- h) The Treaty shall enter into force after 10 States or authorized international organizations have deposited their instruments of ratification or accession.
- i) A certain preeminence of this Treaty over the 1994 TLT is established.

Regulations

The Regulations of the Treaty contain an elaboration of each of the substantive provisions and the necessary details for implementation.

Model Forms

Finally, the Treaty includes 12 most detailed model forms each of which has a number of alternatives. These forms deal for instance, with: Application for the registration of a mark; Request for the recordal of a change in ownership; Transfer document; Request for the correction of mistakes; Request for the renewal of a registration; Request for recordal of license, etc.

II) Other initiatives in the field of trademark harmonization

Upon completion of the preparatory work for the new treaty by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, said Committee held fifth session in Geneva, from November 28 to December 2, 2005, in order to discuss possible new initiatives in the field which could constitute the agenda for the future work of the Standing Committee.

It is interesting to examine briefly the proposals that were discussed at said session because such proposals along with the recently adopted treaty, may be instrumental for establishing the future work of AIPPI Special Committee Q177.

With a view of advancing in the harmonization of Trademark Law the Standing Committee dealt essentially with the following matters:

- 1) Trademarks
 - a) Harmonization of Substantive Trademark Law
 - b) New types of marks
 - c) Well-known marks
 - d) Collective and certification marks
 - e) Trademarks on the Internet
 - f) Trademark Opposition proceedings
 - g) Marks and International nonproprietary names for pharmaceutical substances
 - h) Industrial Designs and Tri-dimensional marks
- 2) Article 6ter of the Paris Convention
- 3) Industrial Designs
 - a) Industrial Designs and Tri-dimensional Marks
 - b) Design Law Treaty
- 4) Geographical Indications
- 5) Internet Domain Names