

## **QUESTION 92 D**

### **Harmonization of formal requirements for trademark applications, registrations and amendments thereof**

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Yearbook 1992/II, pages 344 - 345

Q92 D

Council of Presidents of Lucerne, September 15 - 19, 1991

### **Question Q92 D**

#### **Harmonization of formal requirements for trademark applications, registrations and amendments thereof**

#### **Resolution**

1. The AIPPI
  - a) notes the extreme diversity among countries concerning the formalities for filing, transfer of trademarks and any later modification thereof, in particular, change of name and address.
  - b) notes that this diversity constitutes a serious obstacle for the acquisition, the maintaining and even the exercise of the trademark right.
  - c) notes that practitioners of industrialized and developing countries agree that a solution of this problem should be found by the international harmonization and standardization of certain formalities and documents.
  - d) expresses the wish that trademark offices should be obliged to accept an universal and standard form both for the application of a trademark and the power of attorney without being excluded, however, from accepting the applications and powers of attorney in a different form.
  - e) considers that an international agreement could be possible on the following points:
    - 31.1 Goods and services (where applicable) should be classified in accordance with the international classification of Nice.
    - 32.1 The application should be filed by using a prescribed form.

- 32.2 The application should be signed by the applicant or his duly authorized representative (at his option).
  - 32.3 Foreign applicants should be represented by a person permitted to practise before the office or have an address for service in the territory of the contracting party.
  - 32.4 No authentication of signature (by a notary public or even signature before a notary public or legalization with a consulate, etc.) should be required.
  - 32.5 No certificate or extract from a Register of Commerce should be required.
  - 32.8 No evidence should be required that the trademark applied for is registered in another country.
- 33.1 The office may be informed about a change of name or address by simple written communication of the owner, signed by him or his duly authorized representative.
  - 33.2 The information about change of name or address may be made by the owner in one single communication for all trademarks which are registered in his name in the office.
- 34.3 The assignee may ask for registration of the assigned marks in his name submitting written evidence of the assignment, duly signed by the assignor or his legal representative.
  - 34.4 The demand of the assignee must be signed by himself or his representative.
2. For these reasons, the AIPPI strongly recommends that the member states of the Paris Convention for the protection of industrial property initiate appropriate procedures to arrive as soon as practicable at an international harmonization of formalities in the field of trademarks.

It considers that this harmonization of formalities might constitute the first part of the trademark harmonization project presently studied by WIPO.

3. The AIPPI decides to continue its studies concerning the harmonization of formalities concerning the following points:
- 31.2 Goods and services belonging to any number of classes of the international classification may be covered by one and the same application and shall be covered by one and the same registration on such an application.
  - 32.6 The carrying on of an industrial or commercial activity by the applicant should not be a requirement for trademark registration.
  - 32.7 The carrying on of an activity by the applicant corresponding to the goods or services listed in the application should not be a requirement for registration.
  - 34.1 Assignments may be made without goodwill and without transferring a business to which the trademarks are related.
  - 34.2 The assignment must be made in writing.

- 34.5 No authentication of any of the documents of assignment is required.
- 34.6 No certificate or extract from a Register of Commerce should be required.
- 34.7 The carrying on of an industrial or commercial activity by the assignee should not be a requirement for his registration as new owner of the registered trademark.
- 34.8 The carrying on of an activity by the assignee corresponding to the goods or services listed in the registrations should not be a requirement for registration of the assignee as new owner of the registered trademark.

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## Question Q92 D

### Harmonization of formal requirements for trademark applications, registrations and amendments thereof

#### Resolution

Yearbook 1992/III, pages 273 - 275  
Executive Committee of Tokyo, April 5 - 11, 1992

Q92 D

#### 1. Work undertaken by AIPPI

- 1.1 In its Resolution adopted in Lucerne on September 20, 1991 AIPPI has noted the great interest of practitioners of industrialized and developing countries in the conclusion of an international agreement on the harmonization and standardization of certain formalities and documents.
- 1.2 In view of the strong majorities of affirmative answers to a Questionnaire to which more than sixty replies were received from National and Regional Groups as well as from individual members, AIPPI considered that such international agreement could be reached on a certain number of points listed in the Questionnaire and referred to under 1 e) of the Resolution.
- 1.3 In view of the differing views of considerable minorities on a certain number of items, AIPPI decided to continue its studies on these items (31.2; 32.6; 32.7; 34.5; 34.6; 34.7; 34.8 of the Questionnaire).
- 1.4 From the positive responses received to a second Questionnaire on these items AIPPI can now conclude that they may as well be included in the proposed harmonization treaty.

#### 2. Work undertaken by WIPO

- 2.1 AIPPI therefore notes with great satisfaction that the governing bodies of WIPO in their annual meeting September/October, 1991 took note of AIPPI's Resolution to Question 92D and that WIPO in preparation of the third meeting of the committee of experts on harmonization of laws for the protection of marks, scheduled for June 1 - 5, 1992, on February 25, 1992, submitted a draft treaty on the simplification of administrative procedures concerning marks (document HM/CE/III/2) which is largely based on the recommendations contained in the Resolution of Lucerne.
- 2.2 AIPPI appreciates that WIPO in its introduction to the draft treaty made specific reference to Resolution Q 92D and even reproduced it in the Annex to document HM/CE/III/2.

- 2.3 AIPPI notes, that WIPO in its draft treaty has transformed the recommendations contained in Resolution Q 92D in clear and applicable legal provisions. AIPPI therefore fully supports the draft treaty as an excellent document which in its opinion can largely be adopted in its present form.
- 2.4 AIPPI offers a certain number of proposals for changes or additions. These proposal are added to this Resolution as an Annex.

### **3. Future work**

- 3.1 In view of the importance of international harmonization of formalities in the field of trademarks as explained in the Resolution on Q 92D dated September 20, 1991 and in view of the excellent preparatory work of WIPO, AIPPI urges that the work on this draft treaty be concluded as soon as possible and a Diplomatic Conference be convened for the conclusion of the proposed draft treaty amended as suggested.
- 3.2 In view of the complexity of topics of substantive law AIPPI firmly believes that the proposed treaty should be restricted to the simplification of formalities. The harmonization of other topics of interest to trademark owners should be undertaken in a separate treaty on the more arduous harmonization of substantive trademark law.
- 3.3 AIPPI however reiterates its wish expressed in 1d) of the Resolution dated September 20, 1991, that Trademark Offices ought to be obliged to accept an universal and standard form both for the application of a trademark and the power of attorney. Such forms might be added as Annex to the proposed treaty on the simplification of administrative procedures concerning marks.

## Question Q 92 D Annex

### **Suggestions and amendments of the WIPO Draft Treaty on the simplification of administrative procedures concerning marks, dated February 25,1992.**

1. In Art. 2 (1)(a)(vi) the Draft Treaty provides that the application may be signed by the applicant's representative where the representative has been appointed at the latest at the same time at which the application has been filed. However, it should be understood, that for practical purposes a representative must in those countries providing this option be able to file an application without furnishing a signed power; the respective Office may request that this power be filed within a fixed period of time.
2. AIPPI believes that the filing of a declaration of bona fide intent to use as provided under Art. 2 (1)(b)(vii), may be requested only by those countries having such requirement in their legislation at the time of conclusion of the Treaty.
3. AIPPI believes that the possibility offered under Art. 2 (1)(b)(viii) to demand the furnishing of a declaration alleging that the mark is used by or on behalf of the applicant in commerce in the territory of the country with whose Office the application has been filed, should be made available only as an alternative to the possibility offered under Art. 2 (1)(b)(vii) and not as a condition for the acceptability of an application.
4. AIPPI believes that under Art. 2 (3) a further element should be added to those which no Contracting Party may require, namely that an application cannot be refused for the reason that the applicant does not provide evidence of a registration for the same mark in another country, except where Art. 6 quinquies of the Paris Convention applies.
5. AIPPI believes that in Art. 3, dealing with the form of the signature, it should expressly be provided that documents may be transmitted to the respective Office by facsimile with effect at the date of receipt of the facsimile by the Office, provided that the Office can require that the original document be filed within a fixed period of time.
6. AIPPI considers that under Art. 6 (3), the payment of a fee is not justified in the case of change of name and address of the representative.
7. AIPPI believes that in Art. 7 (1) dealing with changes in ownership, the requirement of written evidence of the entitlement should be made mandatory, whether the request is made by the new or the old owner.
8. AIPPI believes that in Art. 8 (1) when a holder appoints one representative for several applications then it should be possible for the serial numbers of the applications to be omitted if they are not known at the time of filing the appointment of the representative. The wording of paragraph 3, dealing with general powers, will have to be adapted accordingly..

9. AIPPI welcomes the proposals made by WIPO additionally to its own recommendations in Articles 9 and 10. As concerns Art. 10, AIPPI believes that the provision should expressly require that the Office notify the applicant its grounds for refusal. It is understood that this provision also applies in the case of a partial refusal or amendment of the application.

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## Question Q92 D

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#### Resolution

Yearbook 1994/II, page 393

Q92 D

Executive Committee of Copenhagen, June 12 - 18, 1994

The AIPPI, at its Copenhagen Executive Committee Meeting,

- **appreciating** the work and the efforts of the World Intellectual Property Organization and of its Member States which have lead to the preparation of the "Basic Proposal" for a Trademark Law Treaty to be concluded by a Diplomatic Conference in October 1994;
- **satisfied** that the substantive provisions of the Draft Treaty respond to the wishes expressed by an overwhelming number of AIPPI members and reflect the AIPPI proposals for an effective simplification and harmonization of formalities in trade mark matters as expressed in its Resolutions taken by the Council of Presidents of Lucerne of 1991, and the Executive Committee of Tokyo of 1992 (Q 92 D/Yearbook 1992 II, 344 and Q 92 D/Yearbook 1992 III, 273);
- **reiterating** its firm belief that the adoption and early acceptance of this Treaty by a great number of states will effectively facilitate the acquisition, the maintaining, the transfer and even the exercise of trademark rights and will thus satisfy important needs and interests of trademark owners and trademark practitioners throughout the world;
- **being, however, seriously concerned** that there still exist differences of opinion among the negotiating parties as to certain institutional provisions which might endanger the success of the Treaty,
- **urges**, therefore, the parties participating in the negotiations of the Diplomatic Conference for the Conclusion of the Trademark Treaty to make all efforts to agree on and to adopt such institutional provisions of the Treaty which will allow an early acceptance of the Treaty by as many states as possible.

(Earlier Resolutions concerning the same question respectively the same subject matter: Q 92 A/1988 II, 214; Q 92 B/1988 II 220; Q 92 C/1989 II, 309; Q 92 D/1992 II, 344; Q 92 D/1992 III, 273.)

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**QUESTION 92 D**

**Harmonization of formal requirements for trademark applications, registrations and amendments thereof**

**Resolution**

Yearbook 1995/VIII, page 374  
36th Congress of Montreal, June 25 - 30, 1995

Q92 D

AIPPI

- is delighted at the signature by numerous states of the T.L.T. Treaty which is directed at harmonizing and simplifying administrative formalities concerning trademarks, a treaty which was framed in accordance with the resolution adopted by AIPPI at the Council of Presidents of Lucerne in 1991;
- emphasizes the interest of industrialists and businessmen in seeing the treaty come into force as quickly as possible; and
- consequently invites the governments that have signed the treaty to have it ratified with the minimum delay.

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