



## QUESTION 23

### Study on the unification of the right of trade marks

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Yearbook 1958, New Series No. 6, 61st Year, page 47  
23rd Congress of Stockholm, May 26 - 31, 1958

Q23

#### Question Q23

#### Study on the unification of the right of marks

**23 - Comparative study of the concept of the trade mark in the different countries (formerly B 6).**

The Congress decides to pursue the study of this question and proposes to the Executive Committee the constitution of a special committee to advance this study.

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## **QUESTION 23**

### **Study on the unification of the right of trade marks**

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Yearbook 1961, New Series No. 11, 2nd Part, 64th Year, pages 117 - 118  
Executive Committee of Ottawa, September 25 - 29, 1961

Q 23

#### **Question Q23**

#### **The notion of the trade mark**

#### **Resolution**

In view of this the Executive Committee is of the opinion that all countries should agree that

a) a mark is any sign that is inherently distinctive, or that has become distinctive, of the wares or services of a person or group of persons, and

b) the following among others, should be recognised as marks provided that these are inherently distinctive or have become distinctive as set forth in paragraph a):

1. Words including slogans, and titles of periodical publications;
2. Letters;
3. Numerals;
4. Devices including for example signatures, portraits, drawings, pictures and insignia, emblems and monograms;
5. Names of persons including given names and surnames whether or not the same may also constitute or form part of the name of a firm or corporation;
6. The form or any other presentation of the contents or packagings of wares providing that these are not of a functional nature.
7. Colour as a feature of any of the above;
8. Combinations of colours;
9. Any combination of the above.

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## **Question 23**

### **Study on the unification of the right of marks**

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Yearbook 1963, New Series No. 13, 1st Part, 66th Year, page 83  
25th Congress of Berlin, June 3 to 8, 1963

Q23

## **Question Q23**

### **Study on the unification of the right of marks**

#### **Resolution**

The Congress, with a view to bringing the law relating to marks into harmony, adopts the following principles:

I. A mark is a sign capable of distinguishing the products or services of a person or of a group of persons.

The distinctive character of a mark, in respect of the goods or services designated by it, arises from the nature of the sign or of the use which has been made of it.

II. The following signs are capable of constituting marks, on the sole condition that they are distinctive or have become distinctive for the products or services which they designate:

1. Words or collections of words, whether invented or not, including the titles of daily or periodical publications, the titles of collections of works, slogans;

2. Letters;

3. Numerals;

4. Devices including for example signatures, portraits, drawings, pictures and insignia, emblems and monograms;

5. Proper names, including surnames (family names), given names and pseudonyms, as well as characteristic parts or abbreviations of trade names;

6. The shape or any other presentation of products, or of their containers and their packages, on condition that they are not exclusively functional in nature;
7. Colours in combination with signs;
8. Combinations of colours;
9. Any combination of the signs enumerated above.

Note: The list merely gives examples and is not limiting.

The Congress decides to continue studying points III and IV:

- acquisition of rights in a mark
- incontestability of marks

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## **Question 23**

### **Study on the unification of the right of marks**

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Yearbook 1964/II, 67th Year, pages 119 - 122  
Executive Committee of Salzburg, September 14 - 18, 1964

Q23

## **Question Q23**

### **Study on the unification of the right of marks**

#### **Resolution**

#### **1. Acquisition of the right to a mark**

The right to the mark may be acquired

a) by registration or

b) by use provided that the mark be recognized in the relevant circles as distinctive of the products or services of its proprietor.

The foregoing is without prejudice to the provisions of the Paris Convention relating to the six-month convention priority (Art. 4), temporary protection of marks used at official international exhibitions (Art. 11) and the protection of well-known marks (Art. 6bis). Furthermore no rights shall arise from any registration obtained or use made in bad faith.

It is understood that use of the mark shall be a condition for the maintenance of the registration and the rights deriving therefrom.

#### **2. Incontestability of Registered Marks**

The Executive Committee recommends the adoption of the principle of incontestability of registrations after five years.

It shall be the responsibility of each country to adapt its legislation to safeguard the interests of proprietors of prior rights by appropriate means; in particular the national legislation shall determine the commencement of the five-year period.

A shorter term may be set by national legislation, provided that the proprietors of earlier registrations be given adequate notice of the filing.

The proprietor of a mark who has failed to assert in good time his rights against a later registration shall retain all of his other rights and in particular the right to use his own mark or to rely upon it as against third parties.

It is self-evident that incontestability concerns exclusively conflicts between registered trademarks and prior private rights, and that it may not be relied upon in case of bad faith.

## **Explanatory Comments of the Commission**

### **1. Acquisition of the right to a mark**

The commission chose a compromise solution whereby the right to a mark may be acquired either by a registration in conformity with national legislation, or by use. It does not seem possible to define in a precise manner all of the criteria of use sufficient to create a right; it is in any case unnecessary that the use be in the whole of the territory of the country. It shall be the responsibility of each country to determine whether use of a mark has been such as to justify protection.

The commission refrained from carrying out an extended study on the subject of possible conflicts between different users within the same country of the same or similar unregistered trademarks, as it believes that this question must be regulated by national legislation.

### **2. Incontestability of the right to the mark**

Here also it was necessary for the commission to find a compromise solution, some of the members being of the opinion that application of the principle of incontestability could not be effectively carried out except in conjunction with an official examination for anticipations, an opposition procedure, or a system for the giving of notice to the owners of prior registrations.

The commission, therefore, limited itself to recommending the adoption of the principle of incontestability leaving to national legislation the task of determining the measures required to insure the preservation of prior rights.

In particular national legislation shall determine whether the five-year term shall begin to run from the dates of filing or registration, or from the dates of the publications thereof.

Similarly national legislation may fix a shorter term provided that the proprietor of the prior registration shall have given notice of the subsequent registration pursuant to a determined procedure.

The question of incontestability is closely tied to that of the possibility of cancellation of a registration for failure to use the mark. This point has nevertheless not been raised in the part of this resolution dealing with incontestability; it was mentioned at the end of the part relating to the acquisition of the right to the mark.

## **Proposals to the Executive Committee regarding new questions to be studied by AIPPI**

### **A. Juridical effects of commercial names in the field of marks.**

In connection with the study of question 23 B, the commission also briefly considered the case of possible conflicts between a mark and a commercial name previously used not as a mark but as a characteristic denomination for an enterprise (sign of establishment, writing paper etc.) This problem has not been raised in any of the reports. Since it is a complex situation touching upon different branches of law it would be appropriate to make a special study of it.

### **B. Effects of the obligation to use a mark in areas where the mark is registered for various products or services.**

The question has been raised whether the use of a mark for certain specific products or services is sufficient to safeguard the validity of a registration thereof for other products or services. This question concerns particularly defensive registrations of important or well-known marks. Some statutes have dealt with this problem by means of special provisions (e.g. the British Trade Marks Act 1938); up to the present time, however, the question has not yet been made the subject of a thorough study on an international level.

### **C. Effects of the territoriality of trademark law in the case of unauthorized importation of products.**

This question is of present interest, as in the past several years it has given rise to conflicting juridical decisions in several countries. It is desirable that the AIPPI should be concerned therewith.

## **Resolution IAPIP/ICC**

The International Association for the Protection of Industrial Property (IAPIP) which comprises 26 national groups and individual members in 38 other countries, expresses its deep concern about pending or imminent legislative proposals in various countries aimed at abolishing or weakening patents and/or trademarks related to certain fields of creative research and industrial activity.

Therefore, IAPIP supports the Resolution adopted in Stockholm on May 26, 1964 by the Council of the International Chamber of Commerce advocating the patentability of inventions in all industrial fields, which Resolution is worded as follows:

"The grant of patents of invention in any field of industry promotes the creation and the economical production of valuable products, as well as their commercialization, it adds to the ability of the business undertakings to meet the needs in general and enhances the interest they have to do so, and finally it assures to a maximum degree the development of international commerce profitable to the common welfare of any country.

The International Chamber of Commerce has already formulated this point of view in its Statement of November 24, 1961 (Doc. No. 450/210 Rev.).

Two international texts have recently been prepared in the field of patents: The Convention of the Council of Europe on the unification of certain points of patent law and the Draft Convention establishing a European patent.

The ICC believes it is significant that the Convention prepared by the Council of Europe on the unification of certain points of substantive patent law aims at protecting any new invention in any field of industry.

Derogations shall be authorized for a period of transit in order to enable a country to postpone the grant of patents only for food and pharmaceutical products, as distinguished from processes of manufacture of the aforementioned products, as well as for agricultural and horticultural processes.

Similarly, the Draft Convention relating to a European Patent Law defined the patentability in a broad sense by specifying that it shall be applicable to any new invention relating to products or processes in any field, including the plant varieties or animal races and the essentially biological processes for obtaining plants or animals.

Thus, these two important international texts have arrived at the same conclusions in favour of protection by patent in any field. The ICC warmly supports these conclusions bearing in mind that the grant of patents is based on the following ideas:

1. It is an incentive to research work and to inventions;
2. it induces inventors to disclose their inventions rather than to keep them secret and, consequently, to make known in precise terms the most recent techniques for the benefit of any country;
3. it permits to draw a benefit from the investment necessary for developing the inventions until such time as they have become exploitable on a commercial scale;
4. it is an encouragement to capital investment in new products and processes, which might prove unremunerative in the case where others would be interested in the same products or processes.

Moreover, the patents make possible, thanks to licence agreements, the communication of pertinent and technology, owned or developed by the holder of the patent and without which the information disclosed by the patent would in most cases be insufficient in order to be economically useful to the potential user.

The Government of any country may take such steps as the grant of compulsory licences, in order to ensure that the rights attached to the patent are exercised.«

For the reasons outlined in the above Resolution IAPIP is, moreover, particularly concerned about legislative proposals under which the essential exclusivity of patents might degenerate into a mere right of compensation which is often inadequate.

Therefore, IAPIP wishes to state its firm conviction that the true public interest, international cooperation and the legitimate rights of inventors are best served by non-discriminating and proper protection of new and useful inventions as well as trademarks in all fields of creative activity.

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## **Question 23**

### **Study on the unification of the right of marks**

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Yearbook 1966/II a, 69th Year, pages 43 - 44Q23  
26th Congress of Tokyo, April 11 - 16, 1966

## **Question Q23**

### **Study on the unification of the right of marks**

#### **Resolution**

#### I. Acquisition of the right to a mark

The Congress,

with a view to harmonising legislation concerning marks adopts the following principles:

The right to the mark may be acquired

a) by registration or

b) by use provided that the mark be recognized in the relevant circles as distinctive of the products or services to which it applies.

Furthermore no rights shall arise from any registration obtained or use made in bad faith.

It is understood that use of the mark shall be a condition for the maintenance of the registration and the rights deriving therefrom.

The provisions of the Paris Convention relating to the six-month convention priority (Art. 4), temporary protection of marks used at official international exhibitions (Art. 11) and the protection of well-known marks (Art. 6bis) remain effective.

#### II. Incontestability of Registration

The Congress decides that the study of this question should be continued.

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## Question 23

### **Study on the unification of the right of marks Incontestability of registration**

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Yearbook 1969/II, page 224  
27th Congress of Venice, June 9 - 14, 1969

Q23

#### **Question Q23**

#### **Study on the unification of the rights of marks: Incontestability of registration**

#### **Resolution**

The Congress adopts the following principles:

1. The registration and the use of a registered trade mark shall become incontestable as against prior rights to distinctive signs (words names or symbols), when the following conditions have been met:

- a) the trade mark must have been registered in good faith;
- b) the registration must have been published and the owners of the prior rights must have been given the possibility to attack the trade mark within certain given terms;
- c) a term of 5 years must have passed since the publication of the registration and the trade mark must have been used for an adequate time before the expiration of this term; or a term of 1 year must have passed from the time when the owners of the prior rights were notified, and in this case, the trade mark need not, having regard to these prior rights, have been used within this term.

II. The effect of incontestability shall be that the proprietor of prior rights shall no longer be able to assert these rights against the mark which has become incontestable.

But the incontestability shall not prevent the cancellation of the trade mark for lack of validity not arising from prior rights, or for unjustified non-use.

The proprietor of prior rights shall retain the right to use his mark and to rely thereon as against third parties.

III. The national laws may provide that, in order to avoid confusion between the trade mark which has become incontestable and the prior distinctive sign, the courts may impose conditions on the use of either the trade mark or the prior sign, or both, in order to create a distinction between them.

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