



A I P P I

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POUR LA PROTECTION DE LA PROPRIETE INTELLECTUELLE**

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FOR THE PROTECTION OF INTELLECTUAL PROPERTY**

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



Report Q177

Substantive Trademark Law Harmonization

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Special Committee Q177 on Substantive Trademark Law Harmonization, was established after the EXCO in Lisbon in 2002.

The Special Committee held a first organizational meeting at the time of the meeting of AIPPI's Executive Meeting in Lucerne, in October 2003. The Special Committee is scheduled to have a second meeting, at the time of AIPPI Congress in Geneva, in June, 2004.

Topical Background

Substantive International Trademark Law is constituted today mainly by the following Texts:

- Paris Convention for the protection of Industrial Property (Articles 1, 6, 6bis, 6ter, 6quater, 6quinquies, 6sexies 6septies, 7, 7bis..).
- TRIPS Agreement (Articles 15, 16, 17, 18, 19, 20, 21, 22, 23, 24).
- Trademark Law Treaty and Regulations (October 27, 1994).
- Joint Recommendation concerning provisions on the Well Known Marks (September 1999).
- Joint Recommendation concerning Trademark Licenses (September 2000).

There are also other texts, mainly of a regional nature, which will not be listed here.

Harmonization of International Trademark Law

The World Intellectual Property Organization (WIPO) has been engaged in the harmonization of International Trademark Law which should contribute to its better enforcement and efficiency in particular in a globalized world. In this respect it is to be noted that the implementation of the TRIPS Agreement fully relies on the WIPO Treaties as a natural complement to its provisions. In the Trademark field in particular, the TRIPS Agreement contains few provisions which are necessarily to be complemented by the relevant WIPO Treaties.

WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT).

The General Assembly of WIPO, at its session of 1998, established a Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications as a "forum to discuss issues, facilitate coordination and provide guidance concerning the progressive international development of the law of trademarks, industrial designs and geographical indications, including the harmonization of national laws and procedures".

WIPO's General Assembly considered different issues when establishing the SCT, such as the normal preoccupation for a better and stronger protection of trademarks, the further development of international law and the general goal of harmonization of trademark formalities, apart from revisiting rules concerning Industrial Designs, Geographical Indications and the Internet Domain Names.

In the field of Trademarks, it was agreed that one of the first tasks for the SCT would be the revision of the Trademark Law Treaty.

Trademark Law Treaty (TLT)

This Treaty was concluded on October 27, 1994.

The Treaty constitutes an attempt to harmonize in particular de administrative aspects of Trademark applications and registrations. It thus contains long and detailed provisions on matters such as, Representation and Address for Service (article 4); Filing Date (art. 5); Changes in Names or Addresses (art. 10); Change in Ownership (art. 11). The Treaty contains also Regulations providing for further details in relation to some of the provisions and model forms for applications, powers of attorney; requests for recordal of changes, etc.

The TLT has not been very successful when considered that in ten years only 31 States have become party to it.

In a very general manner, a first criticism that results from an examination of this treaty concerns precisely its rather limited substantive scope. It deals with matters where harmonization practically exists already. In fact, most countries deal with the matters provided for in the Treaty roughly in a similar manner without major problems. Two other criticisms may be added as to concrete provisions of TLT: (i) There is a provision (art. 3(1)(xvii)) making mandatory to include in an application "a declaration of intention to use the mark". This is an obligation impossible to comply with in countries not providing for a compulsory use of trademarks and there are quite a few of them in this situation; (ii) The Treaty contains also a number of prohibitions against requiring certain formalities, such as certificates, notarization or certification of documents or signatures, etc. In this respect it is necessary to point out that in certain countries such requirements are an integral part of their general legal system which makes unlikely that they may or can really decide exceptions for the trademark system, which will eventually affect on their willingness or ability to accede to the Treaty.

Revision of TLT

The SCT has been engaged in particular at its 11th session (Geneva, November 10 to 14, 2003) and 12th session in the examination and discussion of a revised text for the TLT prepared by the WIPO Secretariat. This draft is the result of discussions starting at the 8th session of the SCT where harmonization of substantive trademark law was discussed and where a preliminary indication of topics regarding the substantive harmonization of trademark laws were agreed upon. In addition, the SCT instructed the WIPO Secretariat to prepare a questionnaires on trademark law and practice for discussion and the SCT's 9th session which was held in Geneva from November 11 to 15, 2002. The SCT approved the questionnaire which was circulated to member States and international governmental and no-governmental organizations for reply up to the end of January 2003.

The revised TLT draft text contains important deletions and important additions to the TLT Treaty, in an attempt to include in it more substantive provisions.

The most important additions and/or deletions incorporated to the draft Treaty concern the following provisions:

- Article 3 (Application).
A number of details have been deleted or transferred to other provisions.
- Article 4 (Representation; Address for Service).
Detailed provisions have been added concerning the rights of representatives, certain obligations and, in particular, the effect of their actions.
- Article 8 (Communications).

This is one of the articles where a number of entirely new substantive provisions have been added dealing with the language of communications, the presentation of same and their signature, the effect of communications filed in electronic form or by electronic means and the opportunity to make observations in case of intended refusal.

- Article 10 (Changes in Names or Addresses).
A number of details have been deleted from this article and part of them transferred to other provisions.
- Article 12 (Correction of a Mistake).
A number of details have been deleted from this article.
- Article 14 (Measures in Case of Failure to Comply with Time Limits).
This article is practically new and deals with measures, exceptions, fees and prohibition of other requirements.
- Article 17 (Request for Recordal of a License).
- Article 18 (Request for Amendment or Cancellation of the Recordal of a License).
- Article 19 (Effects of Non-Recordal of a License).
- Article 20 (Use of a Mark on Behalf of Holder).
- Article 21 (Indication of the License).

The five above mentioned articles are entirely new in the text of the draft Treaty and are taken basically from the Joint Recommendation Concerning Trademark Licenses, adopted by the General Assembly of WIPO in September 2000. This is a matter which was not dealt at all by the TLT. To be pointed out that not all delegations participating at the April session of the SCT were in agreement to the inclusion of this new topic into the future revised TLT.

The draft TLT revised Treaty is to be examined together with draft revised Regulations to the Treaty and Notes prepared by the WIPO Secretariat for the better understanding of all provisions.