

MAIN COMMITTEE I OF THE DIPLOMATIC CONFERENCE FOR THE
ADOPTION OF A REVISED TRADEMARK LAW TREATY

Chair: Mr. Li-Feng Schrock (Germany)

Secretary: Mr. Marcus Höpperger (WIPO)

First Meeting Wednesday, March 15, 2006 Morning

1. The CHAIR thanked the delegations for having entrusted to him the task of chairing Main Committee I, and considered this an honor for his country and a privilege for himself. He said that he hoped his Chairmanship would live up to the expectations of all delegations.
2. He noted that the task of Main Committee I was to deal with the substantive provisions of the treaty, as contained in Articles 1 to 22 of the Basic Proposal. By way of introduction, the Chair recalled that the present conference had the advantage of basing itself on two pillars to support its work: firstly, the revised Trademark Law Treaty was meant to replace the TLT currently in force. However, the aim of this exercise was to complement and further develop the TLT 1994. Thus, certain provisions in the Basic Proposal for the revised Treaty were congruent with the text of the existing TLT. To the extent that these provisions had been confirmed during the process of development of the Basic Proposal it was his understanding that – as a general rule – such provisions would meet broad support and would be challenged only in very exceptional cases.
3. The second pillar was the result of the work done by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) in preparation of the Conference. He recalled that the SCT worked on draft proposals for a revised TLT as from May 2002. Over a period of seven sessions, the SCT considered the provisions already existing in the TLT as well as the addition of new provisions. At its 14th session held in Geneva in April 2005, the SCT agreed on the drafts for a revised Treaty and revised Regulations. In this context, he highlighted another important principle. In their opening remarks, several delegations said that the revised Treaty should strike a fair balance of interests to make sure that eventually all stakeholders would benefit from this international instrument. He was well aware that IP law was not an end in itself. It was a tool to encourage investment in creativity, reduce transaction costs for the branded goods industry and to facilitate international trade and investment. The Director General of WIPO referred to it as a power tool for economic growth and wealth creation. The SCT was well aware of this dimension of intellectual property when the present Basic Proposal was negotiated.

4. In this context, he wished to highlight that the proposed provisions for the Treaty as well as for the Regulations were approved not only by consensus, but also as “clean drafts”, i.e. drafts that did not contain any text in square brackets or alternative texts for any particular provision. This was certainly due to the fact that fair and balanced solutions were sought and approved in a spirit of constructive cooperation and mutual trust. He was persuaded that the work of the Conference would be characterized by the same approach and dynamics.

5. He called the attention of the meeting to the documents for a revised Treaty and Revised Regulations that had been submitted by the Director General of WIPO for consideration at the diplomatic Conference, namely: TLT/R/DC/3 (treaty provisions) and TLT/R/DC/4 (the Regulations). He also called the attention of the Conference to the fact that there were *Corrigenda* to document (TLT/R/DC/4), one for the French version and three for the Russian version of documents TLT/R/DC 2, 3 and 4. One additional document had been submitted to the Conference for information purposes (TLT/R/DC/5). It contained Notes on the Basic Proposal. These notes had been prepared by the International Bureau. The purpose was to explain the Basic Proposal, but the Diplomatic Conference would not work on the notes and they would not be adopted by this Conference.

6. He then turned to the way of proceeding with the work of the conference and suggested to run through the text of the Basic Proposal article by article and to deal with the corresponding rules after each article. The Chair also recalled that the Rules of Procedure of the Conference provided that proposals for amendments had to be presented in writing and at least three hours prior to being taken up for discussion.

7. In the absence of any proposal relating to a provision under consideration, the Chair would conclude that Main Committee I had approved the text of the Basic Proposal, and that the provision was adopted *ad referendum*. He also recalled that all texts approved by the Committee would be sent to the Drafting Committee for editorial checking. He noted that, once the Drafting Committee had reviewed a text, it would come back to Main Committee I for approval, as the Drafting Committee could not make any substantive changes to the text. Once approved by the Committee, the texts would be submitted to the Plenary for final adoption.

8. Mr. GHORBANI (Islamic Republic of Iran) expressed his appreciation for the work of the Chair during the preparatory sessions of the SCT, and declared his willingness to continue the fruitful cooperation at the present conference. Referring to the procedure outlined by the Chair, he wished to point out that the Diplomatic Conference and the SCT were different in nature, and thus, the proceedings at the Conference were necessarily different. In particular, he held the view that, at the Diplomatic Conference one could not close the discussion on particular articles or items after a first consideration. Also, the work would not be finished at the level of Main Committee I, but only after consideration by the Plenary.

9. He referred to Rule 29(2) of the Rules of Procedure adopted by the Conference, concerning proposals for amendment, which provided that any Member State delegation, may propose amendments to the Basic Proposal. That meant that at the Conference, proposals may be made on any Article or Rule. This would ensure the effective participation of all delegations and particularly, developing country

delegations. He also noted that members of some delegations would arrive on the second week of the Conference and proposals concerning certain provisions could still be submitted at that stage.

10. He further noted that, while according to the Rule 29(3), any proposal for amendment should be submitted to the Committee at least three hours before so that delegations may consider them, it did not seem timely, at this point to close discussion on any Article because proposals had not been submitted, since the Conference had only started and perhaps delegations had not yet had time to submit their written proposals to the Secretariat for distribution.

11. The CHAIR stated that, even where delegations might wish to come back later to any provisions that were already reviewed, it could be a good procedure for the meeting to start its work in numerical order.

Article 1: Abbreviated Expressions

12. Mr. OTIENDO-ODEK (Kenya) referred to Article 1(v) which provided that “references to a person should be construed as references to both a natural person and a legal entity” and suggested whether the final part of the provision could be redrafted to include “and/or” so as to cover both the natural person and the legal entity.

13. The CHAIR considered that this was perhaps a drafting question which could be properly dealt with by the Drafting Committee, although his understanding was that the current drafting already seemed to cover both the natural person and the legal entity.

14. Mr. ARBLASTER (Australia) suggested that, in order to save time, it might be useful to develop a mechanism by which purely drafting issues could be identified and submitted to the Drafting Committee.

15. Ms. SUNKER (South Africa) said that it could be debatable whether a particular point was of drafting or substantive nature. This should be appreciated by each individual delegation, as there may be different views. Rather, delegations should be encouraged to highlight their concerns with regard to the texts.

16. The CHAIR said that while he was sensitive to the concerns expressed by the Delegation of South Africa, it was important not to lose sight of the obligations incumbent on Main Committee I and on the Drafting Committee.

17. El Sr. CONSTENLA ARGUEDAS (Costa Rica) hizo un comentario en relación con el apartado iv) del Artículo 1. Al respecto dijo que su delegación consideraba que la multiplicidad de acepciones que se daba al término “comunicación” provocaba confusión. Para evitar aquello, el delegado recomendó eliminar la multiplicidad de conceptos y que el término “comunicación” se refiera o corresponda únicamente a los términos “petición” o “solicitud” sin hacer mención de los términos “declaración, correspondencia u otra información relativa a una solicitud de un registro”.

18. El Sr. CONSTENLA ARGUEDAS (Costa Rica) dijo que después de haber notado la relación del Artículo 1 con el Artículo 8 señalada por el Presidente, su delegación reconocía que efectivamente el hacer un cambio en el Artículo 1 afectaría el Artículo 8 y en ese sentido deseaba retirar la observación anterior a fin que el texto concuerde a lo largo de los distintos artículos.

19. Mr. GHORBANI (Islamic Republic of Iran) said that if the Conference was revising the text article by article, delegations could well indicate their concerns first and then submit them in writing to the Secretariat, for their formal submission to the Conference.

20. Mr. DONG BAOLIN (CTA) held the view that the clarification requested by the Delegation of Kenya to Article 1(v) could be included in the Notes, to further facilitate the understanding of the provision.

21. Mr. OTIENDO-ODEK (Kenya) noted that Rule 1 also contained definitions and suggested that the Conference consider them in tandem with the definitions in Article 1.

22. The CHAIR confirmed that Rule 1 would be considered together with Article 1.

23. Mr. SHORTHOUSE (United Kingdom) suggested changing the definition in Article 1(xii) to read “‘licensee’ means the person to whom a license is granted”.

24. The CHAIR held the view that the suggestion made by the Delegation of the United Kingdom was perhaps a drafting point and asked delegations whether this point could be submitted to the Drafting Committee. It was so decided.

25. Mr. BISEREKO (Uganda) considered that a definition of “licensor” was probably also needed in Article 1. This term could be used in a document relating to the license outside of the treaty.

26. The CHAIR noted that the abbreviated expressions related to terms that were used in the treaty or the regulations, and it seemed that the word licensor was not used in either one of them. Therefore, a definition of this term did not seem necessary.

Rule 1: Abbreviated Expressions

27. The CHAIR noted that there were no observations with regard to this provision.

Article 2: Marks to Which the Treaty Applies

28. Mr. GHORBANI (Islamic Republic of Iran) said that he wished to reserve his position with regard to this Article, since he may submit proposals on it in the course of the Conference.

Article 3: Application

29. Ms. LIEW (Singapore) sought clarification as to whether the indications listed in Article 3(1)(x), constituted a single element or three separate elements and whether a Contracting Party had the freedom to choose one or more or none of the elements. She also sought clarification on point 8.3.1 of Model International Form No. 1 of the Basic Proposal for the Regulations, which requires an indication of the color(s) claimed and 8.3.2 that requires an indication of the part(s) of the mark that are in that (those) color(s). Both indications shared the same Footnote 11 which required the applicant to indicate the name or code of the color claimed. She also noted that there was only one provision in the Regulations, namely Rule 3(2) relating to a claim for color as a distinctive feature of the mark, but there was no mention relating to a claim for a mark that is a color mark *per se*. Within the treaty or the regulations, the equivalent Model International Form No. 1 in the TLT 1994 contained in part 8.1 and 8.2 an indication for a claim for color as a distinctive feature of the mark. There was no separate indication for color *per se* as a mark. From these observations, she sought clarification as to whether the indications referred to a mark claiming color or a color *per se* mark.

30. Mr. HÖPPERGER (WIPO) explained that the provisions referred to separate types of marks, one was a mark for which color was claimed as a distinctive feature, and indeed this type of mark was already foreseen in the TLT 1994. In that case, the figurative element of the mark contained some colored portions and under the law of certain countries, it was possible to indicate that the colored portions of the mark was a specifically claimed distinctive feature. If an applicant wished to claim that colored portion of the mark as a distinctive feature, it was possible to indicate that in the application. Different from that was a color *per se* mark, which was a relatively recent development that existed in certain countries and not in others. This provision was not contained in the TLT 1994, and was a novelty of the revised TLT. If certain countries allow a claim of color *per se* in an application, the relevant Form in the Regulations should provide an indication to that effect.

31. Mr. MEJÍA GUEVARA (Honduras) sought a clarification or perhaps another amendment, because he saw the relationship between Article 3 and the concept derived from it, and Article 1(iii). In the latter provision, the concept of application was construed as “application for registration”, but this did not apply for all the other items of paragraph (1) and in particular items (x) to (xii). He thus suggested to list in Article 1(iii) the specific provisions of Article 3(1) to which the abbreviated expression referred.

32. The CHAIR explained, with regard to the suggestion made by the Delegation of Honduras, that the purpose of the definition for “application” in Article 1(iii) was to distinguish an application for registration of a mark from other requests that the Office may receive, for example the request for a copy from the files. Nevertheless, the term application in the sense of the TLT was already a very broad term encompassing all the adjacent indications. So, this could be considered before submitting a written proposal on the provision.

33. Mr. MEJÍA GUEVARA (Honduras) clarified that the objective of his intervention was to get more clarity on the provisions. For example, Article 3(4)(iv) read “the furnishing of evidence to the effect that the mark has been registered...” That implied that another element should be provided and not just the request for registration, as mentioned in Article 3(1). He said that caution should be exercised when considering the implications of Article 3, as the provision seemed to be broader than the concept stated in Article 1(iii).

34. The CHAIR said that with regard to Article 3(4), that provision contained elements which cannot be part of an application because the provision reads that “No Contracting Party may demand other requirements than those referred to in paragraphs (1) and (3) and in Article 8.” Thus, furnishing of evidence to the effect that the mark has been registered in another country, for example, could not be part of the application because it was banned under this Article, which was not a new feature for the revised TLT but a basic element of the TLT 1994. Thus, the definition contained in Article 1(iii) would not apply with regard to Article 3(4).

35. Mr. PARKES (FICPI) held the view that the intervention made by the Delegation of Singapore concerning Article 3(1)(x) referred to whether the three indications listed in that sub-paragraph were alternatives. He referred to the version of this Article that was presented in document SCT/14/2 of the fourteenth session of the SCT and said that in that draft the indications was three separate sub paragraphs (ix), (x) and (xi), indicating three different types of statements that could be made. He wondered whether delegations might consider amending subparagraph (x) of the Basic Proposal to indicate that these are three separate alternatives, for example by inserting (a), (b) and (c) before each indication.

36. Mr. PAPARO (Italy) suggested changing the expression “representation” for “reproduction” Article 3(1)(ix), because in the Rule 3 only the second term was used.

37. The CHAIR drew the attention of the Conference to Note 3.09 containing explanations for the term “representation”. Generally speaking, the term “representation” was broader than “reproduction” and was intended to cover both the graphic or photographic reproduction of a mark and any other means of representation, for example, descriptions or electronic data files. He added that the terms “representation” and “reproduction” had been carefully chosen after some discussion and it was better not to change them.

38. Mr. ARBLASTER (Australia) said that in a number of places in the Rules, both terms were used. There was a slight difference in meaning in the two terms and this was particularly highlighted in Rule 3.

39. Mr. MEJÍA GUEVARA (Honduras) said that he agreed with the explanation provided by the Chair, regarding the relationship between Articles 1(iii) and 3. However, he wished to propose an amendment to Article 1(iii) to read “application means an application for registration, as referred to in Article 3”. In this manner, there would be a logical link between the two provisions.

40. The CHAIR said that the Delegation of Honduras may consider submitting a written proposal on Article 1(iii), to make this connection with Article 3.

41. La Sra. ROAD D'IMPERIO (Uruguay) señaló que el término “representación” que se usaba en el Artículo 3.ix) era acorde no solo con las notas, es decir la explicación que dio la Oficina Internacional, sino que se trataba de un término que abarcaba las reproducciones gráficas y fotográficas de la marca y que era acorde con lo dispuesto en el Artículo 8 sobre las comunicaciones. Por eso el cambio con el TLT que hablaba de “una o más reproducciones de la marca” en el párrafo xii) del Artículo 3.1.

42. Mr. DONG BAOLIN (CTA) said that applicants chose sometimes to use their full names and other times not. This resulted in the same applicant having different names. He considered that, to some extent, this might have an impact on the priority of the application and might lead to problems in the future, as well as additional burdens for the office. Representatives could have complaints, as in some cases the same applicants go to different representatives. He considered that more explanations were needed on this point, so that the applicant is obliged to use the same name whenever he applies. Another point that he wished to make regarded the representation of the mark. He said that the Notes explained that the representation could be a written description and this could pose the problem of accuracy. He suggested using the term “graphic representation” to avoid any misunderstanding.

43. Mr. PARKES (FICPI) referred to the intervention made by the Delegation of Italy and recalled that the broader term representation was used instead of reproduction in Rule 3(6) that dealt with non-visible signs, and it was important that the definition in Article 3 should also cover that point.

44. Mr. HÖPPERGER (WIPO) referred to the intervention by the Representative of the CTA concerning the obligation to provide for a description of the mark and pointed out that the Basic Proposal did not provide for such an obligation. The TLT 1994 had an express prohibition for an office to require the applicant to provide a description of the mark. However, since the revised TLT had a broader scope, and it also applied to new types of marks (e.g. sound or scent), a possible way to represent those marks was to describe them. Nevertheless, the general rule would remain that trademarks are represented through reproductions and descriptions are not needed. He also noted that Rule 2 concerned the manner of indicating names and addresses and that provision could shed some light on the problem highlighted by the Representative with regard to the indication of names.

45. Mr. MAHINGILA (United Republic of Tanzania) sought a clarification concerning the use of the term “reproduction” in Rule 3(a)(i) to (iii).

46. Mr. BISEREKO (Uganda) expressed concern as to Article 3(1)(c) and (2) concerning fees for a single application. He considered that if there was one application for goods and services in different classes and one single fee to be paid, this would not be beneficial for most offices.

47. Mr. HÖPPERGER (WIPO) clarified that Article 3(1)(c) did not prevent Contracting Parties from adopting a fee structure under which fees could be charged on the basis of the number of classes of goods and services covered in the application. Consequently, if there was a multiple class application and that application pertained

to goods and services in more than one class of the International Classification, the fee structure could foresee that the payment will refer to the number of classes in which the goods can be classified that are in the application.

48. Ms. EL TINAY (Sudan) referred to the remark made by the representative of the CTA regarding the situation where one or more persons filed an application. He suggested that in this case, the filing should be made in the name of the applicant and should not have several names. She believed that this was a very good and useful proposal, because in certain cases in Sudan, similar problems were faced, particularly in the case where several persons participated in one company. She asked whether in a situation where a company had several shareholders, every person would file the application separately or the filing would be done in the name of one company or one entity.

49. Ms. SUNKER (South Africa) held the view that paragraphs 3(4) on prohibition of other requirements and 3(5) on evidence did not seem to be harmonized with each other. She suggested to change the wording of paragraph (5) as follows: “Notwithstanding the provisions contained in paragraph (4), any Contracting Party may require that evidence be furnished to the Office in the course of the examination of the application where the office may reasonably doubt the veracity any indication or any element contain in the application.”

50. The CHAIR wondered whether the proposal made by the Delegation of South Africa concerned a drafting point which may also appear in other places. He asked the Conference whether this point could be submitted to the Drafting Committee.

51. Mr. ARBLASTER (Australia) referred to the comment made by the Delegation of South Africa and, responding to the Chair, said that this was a question of drafting that should be dealt with in the Drafting Committee. He also indicated that he wanted to better understand the nature of the difficulties raised by the Delegation of Sudan and the representative of the CTA in relation to the manner of identifying a person. The TLT 1994 was silent on this question and left it to the law of the Contracting Party to also determine the way of identifying a range of shareholders or partners of a company. Referring to the comment made earlier by the Delegation of Uganda in relation to fees, he noted that the expression was clearly in plural. As a member of the TLT 1994, he offered to discuss with any interested delegation issues relating to the interpretation of that treaty or the negotiating history of the basic proposal.

52. M. YACOUBA KAFFA (OAPI) demande au Secrétariat de lui donner plus de précisions, suite à la question posée par l’honorable délégué de l’Ouganda et aux réponses données par le Secrétariat. Selon lui, il est dit à l’article 3, paragraphe 2 qu’une seule et même demande peut se rapporter à plusieurs produits ou services. En ce qui concerne la taxation de ce type de demande, il indique que la pratique suivie dans les offices consiste à ce que les usagers fassent une demande pour un certain nombre de classes lorsqu’ils ont automatiquement droit à la protection pour tel nombre de classes. Toute classe allant au-delà doit faire l’objet du paiement d’une taxe additionnelle par classe supplémentaire. Il demande également à ce que la disposition en question soit lue avec l’article 6 : en effet il est dit à l’article 3, deuxième paragraphe “peut se rapporter à plusieurs produits ou services” et lorsque

l'on se réfère à l'article 6 il est dit par la suite que "cette demande donne lieu à un seul enregistrement". M. Kaffa observe donc que c'est comme si on permettait un seul enregistrement alors que tel que l'article 3, paragraphe 2, est libellé, il semble laisser la possibilité aux Parties contractantes d'exiger un dépôt, peut-être une demande, pour les produits et une demande pour les services. Par conséquent c'est comme si l'article 6 venait battre en brèche cette pratique selon lui. Or, il rappelle qu'une telle pratique existe déjà dans un certain nombre d'offices, qu'il s'agisse de pays membres du traité ou pas, et il suggère qu'il en soit tenu compte à l'article 6. À ce propos, le délégué informe le Président et le Secrétariat que l'OAPI et ses États membres se proposent de déposer une proposition d'amendement écrite au Secrétariat. Il précise toutefois qu'il s'agit d'une proposition d'amendement de l'article 6 naturellement, et non de l'article 3. Néanmoins, il voudrait que le Secrétariat confirme au préalable si l'interprétation qu'ils ont faite de l'article 3, paragraphe 2, est correcte.

53. Mr. DONG BAOLIN (CTA) clarified his previous intervention by saying that the issue of the name of the applicant was actually a real problem in China. For example, the CTA had many representatives and because there were different names in the application, the office took it that there were different applicants, even where the address was the same, because different companies may function in the same building. He also considered that Article 4 relating to address for service, should refer to the representatives admitted to practice.

54. The CHAIR noted that the discussion on Article 4 would follow later.

55. Ms. SUNKER (South Africa) asked whether delegations could continue to intervene on issues that they considered as being issues of substance, regardless of whether other delegations might view those same issues as being drafting points.

56. The CHAIR said that it was understood that, where a delegation felt that something was substantive in nature, even though on the surface it looked like a drafting point, it could always raise it, and Main Committee I would make a decision, because it was clear that the Drafting Committee could not make decisions on substance.

57. Mr. PARKES (FICPI) cautioned the meeting when making the determination as to whether a question was merely a drafting point. In particular, he referred to the suggestion made by the Delegation of South Africa to insert the words "notwithstanding paragraph (4)" in Article 3(5). He suggested that the meeting pay attention to the fact that this provision corresponded to the TLT 1994. He mentioned that, in his understanding, the prohibition of other requirements that was contained in Article 3, paragraph (4), dealt with possible requirements outside of the material in the application, such as the furnishing of a certificate from the Register of Commerce, an indication that the applicant carried on a particular industrial or commercial activity, etc. Paragraph (5), dealt with the option for an office to require evidence where it may reasonably doubt the veracity of any indication or element contained in the application. The representative considered that there was a distinction between paragraphs (4) and (5). Paragraph (5) allowed any office to seek evidence if there was something in the application whose veracity was doubtful, whereas paragraph (4) dealt with requirements outside of the application. Therefore, there was no need to link the two paragraphs. He noted that Article 3, paragraphs (7) and (8) were

considered to be a very important part of the treaty in 1994 and they should continue to be so in this revised treaty.

58. The CHAIR said that he would await submission of the written proposal by the Delegation of South Africa before discussing this point again.

Rule 2: Manner of Indicating Names and Addresses

59. Mr. BISEREKO (Uganda), referred to subparagraph (1)(a)(ii), where the person is a legal entity, and considered that the expression “the official designation of the legal entity” was ambiguous because in the case where a multi-national company has a parent company with many officials, it would be clearer to state the residential address of the first registration.

60. Mr. HÖPPERGER (WIPO) noted that, regarding the indication of names and addresses in the application and in other requests, it was important to highlight that these rules had been adopted more than 10 years ago and were contained in the TLT 1994. Those rules provided that Contracting Parties should be given the freedom to require certain specifications from applicants and they should also know the form of indication that they have to make. Relating to the issue of several applicants and several names in the application, it was understood that the TLT provided for an application to be filed by co-holders, because it is conceivable that an application may be owned by more than one person. He added that it was up to the applicant to decide the name in which the application should be filed and in the case of complicated corporate structures, it should be decided whether the registration should stand in the name of the parent company or of the local holding company or both. Thus, it was clear that under the TLT 1994, there could be several applicants who would then become co-holders, and Rule 2(b) provides certain solutions at the technical level and some leeway.

Rule 3: Details Concerning the Application

61. The CHAIR opened the floor for comments on this provision and requested the International Bureau to clarify a question concerning the Spanish version of Rule 3.

62. El Sr. ESPINOSA (OMPI) hizo referencia a la versión en español del documento TLT/R/DC/4 y confirmó que la expresión “representaciones” aparecía correctamente en la Regla 3 párrafo 6, relativa a marcas no visibles, y que esa expresión era distinta de la expresión “reproducción” que se usaba en otras partes de esa Regla.

63. The CHAIR noted that there were no further comments on this provision.

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64. The CHAIR informed Main Committee I that the International Bureau wished to make two announcements of a procedural nature, and that one delegation had also asked for the floor in order to make an announcement.

65. Mr. HÖPPERGER (WIPO) informed Main Committee I that, in order to avoid confusion and misunderstandings, and to provide a sound basis for the production of formal proposals, the International Bureau proposed the following procedure: delegations wishing to make proposals were kindly requested to submit their proposals in writing to either the Chair or the International Bureau. The proposals should clearly indicate:

- a) the name of the Delegation making the proposal;
- b) the name of the particular delegate making the proposal; and
- c) the time and date when the proposal was submitted.

66. He drew the attention of Main Committee I to the fact that, from the rostrum, it was difficult to identify the name plates. He therefore begged the indulgence of delegates in case a request for the floor was not noticed immediately. To avoid misunderstandings and delays, he invited particularly delegations sitting further back in the room to contact one of the ushers in the room and keep up their name plate.

67. The CHAIR announced that there would be a coffee break of half an hour at 4.30 pm which would offer groups the opportunity to meet. He informed Main Committee I of his intention to adjourn the meeting at 6 pm and to continue work the following morning at 10 a.m.

Article 4: Representation; Address for Service

Rule 4: Details Concerning Representation and Address for Service

68. The CHAIR turned to Article 4 of the Basic Proposal.

69. Mr. HÖPPERGER (WIPO) informed Main Committee I that, in the English text of Article 4(2)(b), the expression “an applicant, holder of other interested person” in the third line of subparagraph (b) should read ‘an applicant, holder or other interested person’.

70. The CHAIR opened discussion on Article 4(1) and (2).

71. Mrs. HOU (China) proposed that, in Article 4(1), the expression “[a]ny Contracting Party may require that a representative appointed for the purposes of any procedure before the Office” be supplemented by an additional clarification that the

representative had to acquire a “professional practice license”. She believed that the representative would have to be someone who was professionally permitted to practice, and that a more precise definition of the qualifications required by a representative would clarify Article 4(1) without altering its original meaning. If the representative did not acquire the qualifications or credentials required, he or she could not properly protect the interests of the appointing person. It was imperative that the representative have a legal background and a good understanding of the legal proceedings at issue. She recalled that Article 4(1) of the TLT 1994 contained an explicit reference to the requirement of being “admitted to practice before the Office”.

72. The CHAIR confirmed that the text of Article 4(1) of the TLT 1994 contained the words “admitted to practice before the Office”. He held the view that, in the new Article 4(1) contained in the Basic Proposal, this requirement was expressed in an indirect way. He referred to the requirement that a representative “have the right, under the applicable law, to practice before the Office” in Article 4(1)(a)(i) which he understood to capture not only jurisdictions in which the right to practice before the office flew from a formal admittance procedure and jurisdictions applying other practices.

73. Mr. HÖPPERGER (WIPO) referred to the preparatory work on Article 4(1) of the Basic Proposal. He clarified that the reason for the departure from the text of Article 4(1) of the TLT lied in the fact that not all countries had a system requiring representatives to be admitted to practice. While a system in which agents had to pass a professional qualification exam existed in many countries, others allowed individuals to practice before the office without being technically-speaking “admitted”. The somehow broader wording in Article 4(1) of the Basic Proposal had been chosen to cover countries with and without admission exams alike. He suggested to make additions to the Explanatory Notes on Article 4(1) of the Basic Proposal in order to clarify the matter.

74. The CHAIR noted that the Conference was not working on the Explanatory Notes. The International Bureau would be able to change the Notes *ex officio*. He invited the Delegation of China to reflect on whether or not to submit a formal proposal which would then be considered by Main Committee I.

75. Mr. WARDLE (New Zealand) informed that, in New Zealand, trademark agents were not regulated. There was no requirement to pass any special qualifications. He added that most individuals practicing before the Office of New Zealand were registered patent attorneys whose profession was regulated, or practicing lawyers. The Commissioner of Trademarks had the right to refuse to recognize a particular person as a representative. He felt that the wording of Article 4(1)(a) of the Basic Proposal suited the New Zealand situation well.

76. Mr. GHORBANI (Islamic Republic of Iran) agreed that the International Bureau could make additions to the Explanatory Notes. When finally approving and adopting the Treaty and the Regulations, however, these Notes should also be taken into account. They should be reviewed by Member States in order to establish a common understanding.

77. La Sra. ADÁN (Argentina) dijo que a título de ejemplo y para poder esclarecer el último punto quería hablar de la experiencia en Argentina. La delegada subrayó que en Argentina existen los agentes de propiedad industrial que pasan un examen en el Instituto Nacional de Propiedad Industrial, pero que existe la posibilidad de que una persona individual gestione su propio trámite. Es decir que conviven con los dos sistemas. Se puede efectuar los trámites a través de un agente o a título individual. La delegada indicó que sólo decía eso a fin de considerar la amplitud que en su opinión se debe considerar en la segunda propuesta.

78. Mrs. EL TINAY (Sudan) informed Main Committee I that Article 15 of the Trademark Act of Sudan reads as follows:

“Article 15. (Qualification of an Agent)

- (1) The following are eligible to act as trademark Agents:
 - (a) Sudanese advocates practicing in Sudan;
 - (b) Sudanese chartered and certified accountant, practicing in Sudan;
 - (c) With the written consent of the Minister which may be withdrawn at any time and subject to such conditions as he may think fit:
 - (i) University or Higher Institute Sudanese graduates, who took Commercial law;
 - (ii) Sudanese who have had at least five years experience in a public or private trademark office;
 - (iii) Other persons whom the Minister may think fit.
- (2) The Registrar shall not be bound to recognize as such agent any person who has been convicted by a criminal court or struck off the roll of advocates or has been restrained from acting as chartered or a certified accountant.”

79. Mr. OMOROV (Kyrgyzstan) sought clarification on Article 4(2)(a) and (b). He explained that, in Kyrgyzstan, attorneys had to be citizens or residents of the country. He wondered whether Article 4(2)(b) had to be understood to include also other individuals who were neither citizens nor residents but provided an address for service.

80. Mr. HÖPPERGER (WIPO) clarified that the reference to “the right, under the applicable law, to practice before the Office” in Article 4(1)(a)(i) could allow the inclusion of a requirement as to nationality. Article 4(2)(b) was a subsidiary provision concerning situations in which representation was not required. If the Office of a Contracting Party did not require representation, it may still require that the person submitting a request have an address for service on the territory of the Contracting Party concerned. To facilitate communications, such as the acknowledgement of receipts, offices usually preferred to correspond with applicants having an address for service on the territory of the Contracting Party concerned.

81. Mr. OMOROV (Kyrgyzstan) wondered about the correctness of his understanding that, in exceptional cases, a national from another country could act before the Office on the condition that he provided an address for service on the territory of Kyrgyzstan.

82. The CHAIR confirmed that this understanding was correct.

83. Mr. FICSOR (Hungary) felt that the Explanatory Note 4.02 on Article 4(1)(a) had to be amended in order to clarify whether the requirements of Article 4(1)(a)(i) relating to an appointed representative and the requirement of Article 4(2)(a)(ii) relating to an address on the territory prescribed by a Contracting Party applied cumulatively or alternatively.

84. Mr. PARKES (FICPI) pointed out that the discussion on the admission to practice before the Office could be traced back to early meetings of the SCT. He added that, in some countries, even when there was a list of admitted representatives, individual lawyers also had the right to represent clients before the Office. He felt that the issue in question was whether a representative was admitted to practice or whether he or she had the right to practice. He held the view that this distinction was one of the reasons for the broader wording in Article 4(1)(a). With regard to the issue raised by the Delegation of Hungary, he expressed the view that the wording in Article 4(1)(a)(ii) probably was intended to cover the situation in the European Union where there were individual Member States but nevertheless some freedom to provide services within the European Union. He felt that the possibility of prescribing something other than the territory of a particular country may be important in this situation.

85. Mr. HÖPPERGER (WIPO) clarified that the Explanatory Note 4.02 was intended to shed light on the question of the right to practice before the Office. Contracting Parties were allowed to require that the appointed representative be a person entitled to practice. This implied that a requirement of nationality would also be covered. He explained that, as there were countries applying less strict requirements, the second sentence of Note 4.02 sought to clarify that Contracting Parties were also free not to require an admission to practice. While the first sentence of Note 4.02 outlined a maximum requirement, the second sentence thus was intended to leave room for countries following a more liberal approach.

86. The CHAIR felt that, after these explanations, the issue had been dealt with in some detail. He opened discussion on Article 4(3) to (6) and Rule 4.

87. Mr. BISEREKO (Uganda) indicated that the reference to Article 8 made in Article 4(5) may raise problems for certain countries.

88. The CHAIR proposed to deal with the concern expressed by the Delegation of Uganda in the context of the discussion on Article 8 which would permit to consider the issue on the basis of a better understanding of the meaning of Article 8.

Article 5: Filing Date

Rule 5: Details Concerning the Filing Date

89. The CHAIR underlined the importance of obtaining a filing date in the context of trademark applications. He opened discussion on Article 5.

90. Mr. OTIENO-ODEK (Kenya) expressed the view that the relationship between subparagraphs (a) and (b) of Article 5(1) was not clear. While the use of the word “shall” in subparagraph (a) pointed towards the establishment of mandatory requirements, use of the word “may” in subparagraph (b) introduced a discretionary element. He felt that, because of this structure, there was some ambiguity as to what should actually be sufficient documentation for the granting of a filing date. Given the importance of the filing date, he feared that this may give rise to problems between the Office, the applicant and other interested parties.

91. Mr. ZHAROV (Ukraine) drew the attention of Main Committee I to a difference in wording between Article 5(1)(iv) and Article 3(1)(ix). Whereas the term “representation” was used in the latter provision, Article 5(1)(iv) referred to “reproduction”. He was of the opinion that the term “representation” was broader than the term “reproduction”, and that it was preferable to use the broader term “representation” also in Article 5.

92. Mr. KIANI (Islamic Republic of Iran) suggested that the word “implicit” in Article 5(1)(a)(i) be deleted. He gave the example of a situation in which the Office did not receive all necessary indications but those set out in Article 5(1)(a)(i) and (iii). If the Office, in such a situation, called the applicant and obtained additional information on the telephone, it would be very difficult to decide whether sufficient indications had been given and to record the information received.

93. Mr. HÖPPERGER (WIPO) agreed with the Delegation of Kenya that Article 5 concerning the filing date was an essential element of the text. The recording of a filing date for an application was of particular importance when it came to determining rights to a given trademark. He said that, ideally, there would be only one standard for granting a filing date in all Member States of WIPO. The approach taken in Article 5(1) was identical to the approach reflected in Article 5(1) of the TLT, namely, that there was a list of six indications, and that an office receiving all those indications would grant a filing date. This approach ensured that an applicant providing all six indications would obtain a filing date in all Contracting Parties to the TLT. The discussion in the context of the TLT, however, had shown that there were countries which followed a more liberal approach and required fewer indications. In order to acknowledge also these more liberal approaches, Article 5(1)(b) had been introduced. The result was a compromise between certainty as to the applicable requirements and freedom to adopt more liberal approaches. Accordingly, there was a maximum standard to be found in the “shall” provision of Article 5(1)(a) followed by a clarification in the “may” provision of Article 5(1)(b) that less may be required. This combination of maximum requirements and freedom to demand less could be found more often throughout the Basic Proposal.

94. He turned to the issue raised by the Ukraine and clarified that use of the term “reproduction” in Article 5(1)(a)(iv) was unintentional. He said that it would be preferable to refer to “representation” because the Basic Proposal was intended to cover also types of marks that could not be represented through graphic reproduction. He endorsed the view expressed by the Delegation of the Ukraine that the broader term “representation” covered “reproductions”. Article 5(1)(a)(iv) should already have been amended accordingly when preparing the Basic Proposal.

95. With regard to the issue raised by the Delegation of the Islamic Republic of Iran, he explained that the background to the use of the word “implicit” in Article 5(1) of the Basic Proposal, which corresponded to Article 5(1) of the TLT, was the issue of communications transmitted by telefax. If an office received a telefax communication which clearly showed the trademark, specified goods and services and provided the necessary contact details, it would appear inappropriate to additionally require an explicit statement to the effect that the registration of a mark was sought. This intention could easily be inferred from the indications given in the communication. The situation was comparable to an application which was not filed on the prescribed form, in which case it would also seem unjustified not to grant a filing date if all necessary indications were given.

96. The CHAIR wondered whether the issue of “reproduction” and “representation” could be dealt with by the Drafting Committee without requiring a formal proposal since the International Bureau admitted that the term “reproduction” in Article 5(1)(a)(iv) should already have been replaced with “representation” in the course of preparing the texts of the Basic Proposal.

97. Mr. ARBLASTER (Australia) expressed the view that the Drafting Committee could consider the use of the term “reproduction” in Article 5(1)(a)(iv) and elsewhere and report back to Main Committee I.

98. The CHAIR concluded that the Drafting Committee would be asked to replace the term “reproduction” in Article 5(1)(a)(iv) with the term “representation”. He recalled that the provision would finally have to be adopted by Main Committee I.

99. Mr. OTIENO-ODEK (Kenya) wondered whether the reference to “the time of becoming party to this Treaty” in Article 5(2)(b) implied that an element of reservation had to be introduced when adhering to the Revised TLT in order to maintain a national requirement concerning the payment of fees, as reflected in Article 5(2)(a).

100. Mr. HÖPPERGER (WIPO) clarified that Article 5(2)(b) would apply automatically, and that no reservation had to be made when adhering to the Revised TLT.

101. Mr. ARBLASTER (Australia) expressed the view that Article 5(2)(b) should be understood to allow the continuation of the practice of requiring the payment of fees if this requirement existed at the time of adherence to the treaty. It was his understanding that no reservation was needed.

102. The CHAIR opened discussion on Rule 5. In the absence of any request for the floor, he turned to Article 6.

Article 6: Single Registration of Goods and/or Services in Several Classes

103. The CHAIR opened discussion on Article 6.

104. M. YACOUBA KAFFA (OAPI) indique que lors de leur première intervention de la matinée, suite à la question posée par le délégué de l'Ouganda et la

réponse donnée par le Secrétariat, sa délégation a fait une intervention au cours de laquelle il a été précisé qu'ils soumettraient une proposition d'amendement. Celle-ci a été remise. Il estime de ce fait avoir rempli toutes les conditions sauf une seule étant donné qu'ils ont omis de mentionner l'heure et la date de remise. Le délégué souhaite par conséquent que la proposition d'amendement en question soit soumise à la Plénière.

105. Le Bureau International accuse formellement réception de la proposition et ajoute que celle-ci sera mise en format, traduite, reproduite et mise à la disposition du Comité dès que possible.

106. Mr. HÖPPERGER (WIPO) confirmed that the proposal submitted by OAPI would be distributed.

107. The CHAIR announced that the further consideration of Article 6 would be postponed until the proposal by OAPI would finally have been made available and could be considered by the Committee.

[Suspension]

Article 7: Division of Application and Registration

108. The CHAIR opened discussion on Article 7.

109. Mr. SIMONOV (Russian Federation) sought clarification on the Explanatory Note 7.01. He wondered about the reference, in the Note, to typical situations in which an applicant was likely to request the division of an application or registration.

110. Mr. HÖPPERGER (WIPO) explained that the sentence of the Explanatory Note 7.01 starting with “[t]ypically, the applicant is interested in dividing...” aimed to clarify the background to provisions for the division of an application or registration. In particular in the context of multi-class registration systems, objections raised by an office with regard to an application concerning goods and services in several classes might concern only some of the classes requested. Similarly, under a system providing for opposition proceedings, a third party may challenge an application with regard to some goods and services only. In such a situation, it was advantageous for the applicant to request the division of the application and proceed further with regard to unaffected goods and services. The applicant could receive a registered right for the undisputed part of the application while remaining at the opposition stage with regard to the part of the application that was problematic.

111. Mr. KHAN (Pakistan) agreed that, in case of a multi-class application, where the applicant may be prevented from registration because of an opposition or objection concerning only some classes, he should have the right to divide the application. As to Article 7(2) concerning the division of a registration, however, the delegate felt that it was not clear whether the single registration rule of Article 6 required that, ultimately, there should be only one registration. He indicated that it may be difficult to reconcile Article 6 with the notion of the division of a registration.

In practice, it was not clear what would happen with the application numbers and how the division of the registration could be justified. He held the view that, also after a division, it would still have to be the same registration. If, for instance, an opposition for two or three classes was finally decided in favour of the applicant, then these classes should be added to the registration certificate for those classes of the initial application which had not given rise to opposition proceedings. Otherwise, there was a risk of confusion.

112. Mr. HÖPPERGER (WIPO) clarified that Article 7(2) complemented Article 7(1). He explained that there were countries which did not examine an application as to relative grounds for refusal. Similarly, there were countries which did not have opposition procedures but dealt with conflicting rights in the course of post-registration invalidation procedures. Under these systems, there was no longer an application that could be divided at the time of raising an objection with regard to certain goods or services because the mark had already been registered. The holders of conflicting rights, technically speaking, sought the invalidation of a registration. Nevertheless, the same reasoning applied. Rather than jeopardizing an entire multi-class registration because of invalidation proceedings concerning only certain classes, it seemed more appropriate to allow the division of the registration. Whereas Article 7(1) concerned an application at the application stage, and pre-registration opposition proceedings or objections raised by an examining office on relative grounds, Article 7(2) dealt with the parallel situation in countries which first registered the mark and allowed for the consideration of conflicting rights afterwards. The Basic Proposal thus did not provide for the division of a registration to regulate situations falling outside the general framework of application procedures. It rather reflected the approach taken by countries in which the issue of conflicting rights was dealt with at the post registration stage.

113. Mr. KHAN (Pakistan) held the view that, under the laws of most countries, rectification proceedings offered the possibility to cancel only a specific part of the affected registration rather than jeopardizing the entire registration. Similarly, specific goods or services that were not under use could be removed from the register after a certain period of time. He believed that the issue of the division of registrations required further consideration by Main Committee I. In his view, the word “division” was likely to create confusion, as the registration would be the same and the registrar would remove classes which conflicted with third party rights from the same registration certificate.

Article 8: Communications

Rule 6: Details Concerning Communications

114. The CHAIR opened discussion on Article 8. He recalled that the Delegation of Uganda had already expressed a concern with regard to the reference to Article 8 made in Article 4(5).

115. Mr. BISEREKO (Uganda) said that he had dropped his concern.

116. Mr. ZHAROV (Ukraine) drew the attention of Main Committee I to the three subparagraphs (a), (b) and (c) of Article 8(2). He pointed out that, whereas subparagraphs (a) and (b) referred to Contracting Parties, subparagraph (c) made reference to the Office. He felt that this was an inconsistent approach.

117. Mr. ARBLASTER (Australia) pointed out that several references to either Contracting Parties or the Office were to be found throughout the Basic Proposal. In the case of Article 8(2), these references were made in the same paragraph. As to the reason for this combination, he recalled that Contracting Parties may enact legislation, whereas offices may sometimes be able to establish a requirement by regulation or some other legislative instrument, or shape requirements, for instance, as to admissible languages, through their practice. He believed that the combination of references in Article 8(2) was appropriate but was not opposed to checking the language.

118. The CHAIR said that the Committee could further reflect on the issue raised by the Delegation of the Ukraine. He pointed out that a formal proposal would be necessary in case the scrutiny of the language showed a need for changes.

119. Mme FARAH (Maroc) note que dans l'article premier, l'office est défini comme étant "l'organisme chargé par une Partie contractante de l'enregistrement des marques". Dès lors si le terme "office" ou "Partie contractante" est utilisé, cela revient au même.

120. Mr. ZHAROV (Ukraine) pointed out that a distinction had to be made between the Contracting Party and the Office. It was the Contracting Party that instructed the Office but not *vice versa*. He indicated that he might submit a formal proposal to draw attention to this point.

121. The CHAIR pointed out that Article 1 provided definitions of the term "Contracting Party" on the one hand, and the term "Office" on the other hand.

122. Mr. DANILIUC (Republic of Moldova) expressed support for the intervention made by the Delegation of the Ukraine. He emphasized that there was a need for a harmonized wording in Article 8(2).

123. M. SISSOKO (Mali) dit qu'il a constaté une différence entre les alinéas 2)b et 2)c de l'article 8 et qu'il aurait quant à lui plutôt opté pour les dispositions de l'alinéa 2)b). Il demande cependant s'il n'est pas possible de faire traduire la communication par un officier ou une autorité consulaire plutôt que d'exiger que la traduction soit faite par un traducteur assermenté. Selon lui il faut simplifier les choses et seule la première disposition contenue au paragraphe 2)b) aurait mérité d'être retenue. A son avis le paragraphe 2)c ne fait que compliquer les choses.

124. The CHAIR said that the issue would be dealt with once Main Committee I had received the proposal from the Delegation of the Ukraine.

125. Mr. MTSHALI (South Africa) said that South Africa wanted to reserve the right to make an intervention on Article 8 at a later time. The Delegation first had to conclude internal consultations.

126. The CHAIR noted the announcement by the Delegation of South Africa. He drew the attention of Main Committee I to Rule 6 and explained that the Rule distinguished between paper filings, communications filed by electronic means of transmittal and electronic filing. He recalled the particular effort made in the SCT to draft Article 8 and Rule 6 so as to cover not only traditional forms of communication, such as paper communications, but also new forms, such as electronic filing.

127. Mr. GHORBANI (Islamic Republic of Iran) referred to Rule 6(6) concerning the application of authentication systems in the case of the filing of communications in electronic form. He held the view that a Contracting Party which permitted the filing of communications in electronic form should not decide individually on the authentication system to be applied. He suggested that the Diplomatic Conference mutually agree on one system and indicated that the Delegation of the Islamic Republic of Iran would submit a proposal concerning Rule 6.

128. Mr. KHAN (Pakistan) pointed out that communications in electronic form could be transmitted from persons domiciled, residing and living in foreign countries. He felt that, in such a case, the indication of an address for service should be mandatory, at least when the Office did not require the appointment of a representative. He was of the opinion that Rule 6 needed further consideration by the Committee and announced to submit a proposal.

129. Mr. HÖPPERGER (WIPO) recalled that the Basic Proposal offered Contracting Parties maximum flexibility with regard to the requirement of representation and the indication of an address for service. This flexibility could also be used to deal with future changes in the communication system.

130. The CHAIR adjourned the meeting.

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131. The CHAIR proposed to continue the discussion on Article 8 and Rule 6, and opened the floor for comments.

132. Mr. BOLDVIK (Norway) said that he wanted to address a question regarding Rule 6, paragraph (5), which was of particular relevance to countries that provided for a communication on paper to be filed by electronic means of transmittal, and that required the original document to be forwarded to the office at a later stage. Rule 6(5) stated that where the applicant had filed a communication on paper by electronic means of transmittal, for example, by facsimile, the office could require that the applicant file the original of that communication within a time limit of at least one month from the date that earlier transmission was received by the office. He noted that, from the wording of the provision, it seemed that it was up to the office to decide how the provision should be read, and whether the time limit should start to run automatically from the receipt of the communication filed by electronic means of transmittal or not.

133. He explained that previously, Norway had a similar provision in its legislation, with the time limit running automatically from the date of filing of the communication by electronic means of transmittal. However, very often the applicant was not aware of the time limit or overlooked it. The applicant would also forget to send the accompanying letter with reference to the earlier transmission, thus the office in Norway treated the new communication as a new application and not as a duplicate. This caused problems both for the applicant and for the Office.

134. As a result of these problems, Norway changed its practice. Its office still requires that the application should be submitted in original, but there was no longer an automatic time limit running from the date of the applicant's communication on paper filed by electronic means of transmittal. In practice, if at the time of examining the application, the office found that it needed the original and that applicant had not yet submitted it to the office, the latter would notify the applicant in writing and would request the original. In this communication, the office would also mention if there were any other irregularities with the application or obstacles preventing registration. This communication would have a time limit of at least one month. It was considered that this practice made the system more transparent than before and the applicant was made fully aware of the time limit that was running. Therefore, the practice was also more user-friendly.

135. Against this background, he suggested to consider whether an amendment along these lines would be adequate and relevant to be discussed further. In such a case, the Delegation of Norway would submit a written proposal. The amendment would mean that the time limit mentioned in Rule 6(5)(ii) should not start running from the date when the office received a communication from the applicant filed by electronic means, but rather from the later date when the office requires that the communication be submitted with a signature in original. Therefore, the wording in Rule 6(5)(ii) should be changed from “received the communication by electronic means of transmittal” with “requested the original”.

136. Mr. CARLSON (Sweden) supported the substance of the proposal made by the Delegation of Norway, as it would help the Office to make a more clear and transparent decision. However, he wondered whether Article 21 would in practice achieve the same goal.

137. Ms. BERESFORD (United States of America) said that, in her view, Rule 6(5)(ii) as currently drafted, did not seem to be incompatible with the practice observed in Norway. She noted that the provision read that the Contracting Party “may” require the original of a communication on paper filed by electronic means of transmittal and then give the applicant the minimum time limit of one month to provide such an original. It seemed that, according to the practice observed in Norway, the time limit was more generous and thus it seemed that the practice was not inconsistent with the current text of the rule.

138. Mme VENIŠNIK (Slovénie) dit que la proposition de la délégation de la Norvège lui paraît très intéressante non seulement parce qu’elle paraît très conviviale pour les utilisateurs, mais également parce qu’elle peut être très intéressante pour les offices étant donné qu’elle n’encombre pas leur travail. Elle précise néanmoins qu’elle a besoin d’un supplément d’informations à ce sujet. Elle ajoute qu’elle est parfaitement consciente qu’elle pourrait demander ces informations bilatéralement mais estime que cela peut être également intéressant pour les autres délégations de connaître la réponse à la question de savoir si cette notification au demandeur est faite toujours obligatoirement ou bien seulement si l’office estime qu’il est nécessaire d’avoir l’original.

139. Mr. BOLDVIK (Norway) clarified that he did not consider that the current practice in Norway was inconsistent with Rule 6(5)(ii) as currently drafted. However, he thought that his proposed amendment would make the Rule more transparent for the user and give him clear information about the time limit that was running, by indicating the starting point from an active communication by the office.

140. The CHAIR suggested that those delegations that had expressed themselves on this issue could consult bilaterally with the Delegation of Norway to decide whether a written proposal should be submitted on this matter for its further consideration.

141. M. YACOUBA KAFFA (OAPI) dit qu’il a suivi avec beaucoup d’intérêt les explications et la proposition faite par l’honorable délégué de la Norvège. Il souhaite néanmoins préciser que telle que la règle 5 est rédigée actuellement, il est d’avis qu’elle contient suffisamment de transparence et qu’elle permet une bonne traçabilité

des différentes communications. Il précise que la pratique à l'OAPI est exactement pareille à la pratique de la Norvège avant l'amélioration de leur système, et qu'il estime que la règle peut être laissée telle quelle, et au gré des différents offices, pour améliorer éventuellement leurs pratiques et accorder des délais supplémentaires. Il conclut en disant que sa délégation estime qu'au stade actuel, il n'est pas, et il ne serait pas très utile, de bouleverser la règle telle qu'elle est actuellement rédigée.

142. Ms. SUNKER (South Africa) referred to Article 8 "Means of Transmittal and Form of Communications" and expressed concern that the wording of the provision, which allowed any contracting party to choose the means of transmittal of communications and whether it accepted communications on paper, in electronic form or any other form of communication, would in fact allow a contracting party to choose electronic filing only, with the exclusion of other forms of communication. She noted that developing countries were not always in a position to make electronic filings and this provision could cause problems to those countries. She therefore suggested changing the wording of the provision as "any Contracting Party may accept communications in electronic form or any other form of communications. However, communications on paper must always be accepted by Member States".

143. M. OUBEIDILLAH (Comores) dit qu'il souscrit parfaitement à la recommandation qui a été proposée par l'Afrique du Sud. Il précise en effet que son pays ne dispose pas des équipements et de la technologie nécessaires pour que les demandes soient entièrement déposées électroniquement. C'est pourquoi, il lui paraît judicieux et même fondamental pour les Comores que les moyens traditionnels, c'est-à-dire que le papier ou toute autre moyen utilisé auparavant, puissent toujours être acceptés pour que les demandes puissent continuer à être déposées dans le pays.

144. La Sra. ROAD D'IMPERIO (Uruguay) dijo que quería referirse a lo que había planteado la delegación de Noruega respecto a la Regla 6.5), e indicó que su delegación se remitía a la misma tal como estaba redactada. En su opinión aquel punto de partida que se fijaba de por lo menos un mes después de que la comunicación haya sido recibida por la Oficina, constituía un punto de partida seguro y transparente para ambas partes, ya sea para el usuario como para la Oficina, y añadió que a su parecer un mes era tiempo más que prudencial.

145. Mr. GHORBANI (Islamic Republic of Iran) supported the views expressed by the Delegation of South Africa, and added that he had the same concern in relation to Rule 6(6) because of the digital gap, which affected in particular developing and least developed countries. He believed that the provisions in question would continue to intensify this gap. They would probably create a division between developed countries, on the one hand and developing and least developed countries on the other. Therefore, he believed that this issue should be dealt with in the treaty in a manner that it solves the problem.

146. M. YACOUBA KAFFA (OAPI) dit que cela lui avait paru tellement évident que les communications ou bien les demandes sur papier puissent être également admises qu'il n'a pas pris soin de le préciser. Il est par conséquent, d'avis que la suggestion faite par l'honorable délégué de l'Afrique du Sud est tout à fait heureuse, ne serait-ce que pour les raisons que le Groupe africain a exprimées dans sa déclaration générale par l'intermédiaire du Nigéria. Il indique qu'il souscrit

totalement et entièrement à la proposition faite par l'Afrique du Sud mais qu'il espère seulement pouvoir bénéficier d'une proposition écrite dans un bref délai.

147. Ms. BERESFORD (United States of America) said that she understood the provision allowing offices to choose the means of communication to be an empowering provision, because each office could make that determination. She noted that usually, applicants did not file applications by themselves but through a representative who, in most cases, had access to the Internet. The experience of the United States Patent and Trademark Office (USPTO), which accepted both paper and electronic filing, was that applications were filed electronically from all over the world, including from countries in Africa and South America. She declared that the USPTO had no plans to eliminate the ability to receive paper filings in the near future, but that it could do it gradually. Her concern was to avoid tying the offices in the future, under this particular treaty, and not allowing them to choose electronic filing.

148. Ms. EL TINAY (Sudan) supported the proposal put forward by the Delegation of South Africa and the views expressed by the Delegation of the Islamic Republic of Iran. She said that paper filings should be kept, even where more modern technological means were accepted. This was so because certain countries did not have such means at its disposal, and particularly developing countries.

149. Ms. SUNKER (South Africa) thanked other delegations that had intervened on this matter. She conceded that, in the multilateral process of establishing a treaty, it was necessary to ensure that the treaty respond to technological developments. However, there seemed to be a difficulty if an international instrument were to legislate the technological divide. She considered that an agreement allowing a Member State to actually refuse an application simply because it was not in electronic form would be the source of problems. Therefore, she believed that the treaty should provide legal security for those countries that were not at a level of development that would allow them to file by electronic means.

150. The CHAIR noted that there were perhaps three possibilities to proceed in relation to Article 8(1): the first possibility would be to keep the *status quo* of the TLT 1994, the second would be to keep the provision in Article 8(1) of the Basic Proposal and the third possibility would be not to have the provision at all. Under the third option, the result would be the same, since as long as a country is not bound by an international commitment it is free to choose how it wishes to organize the national office.

151. Mr. ARBLASTER (Australia) said that with it was important to define the intent of the provision and then look at the best way to achieve it. He recalled that Article 8(1) had been the subject of extensive debate in the SCT –particularly from the tenth to the twelfth sessions– as shown in the proceedings for those sessions, and the Committee came to the conclusion that this provision was the right one. He supported the views expressed by the Delegation of the United States of America to the effect that, in the vast majority of jurisdictions, an address for service of a representative in the country of application was required. It seemed clear that, in such a case, the local representative would have access to the range of resources required by the office in order to be effective.

152. Ms. KADIR (Trinidad and Tobago) endorsed the recommendation made by the Delegation of South Africa. She held that, even where some developing countries could be in a position to accept electronic filing, they would incur additional costs to put in place the administrative infrastructure needed to implement such systems, as well as to enact the corresponding legislation. While she agreed that systems must respond to technological developments, it was important to remember the peculiar problems that developing countries faced. She encouraged the Delegation of South Africa to submit a written proposal.

153. Mme KANDA (Togo) félicite le Président de la Commission principale I; elle supporte la proposition faite par la délégation de l'Afrique du Sud concernant l'article 8.1) et toutes les raisons avancées par cette délégation et par les délégations qui l'ont soutenue.

154. Mr. BISEREKO (Uganda) supported the proposal made by the Delegation of South Africa on the ground that it gave the right flexibility for all parties concerned. On the issue of the local agent representing users, he noted that the costs involved would be affected by the legal framework of the country in which the user wanted to file an application.

155. La Sra. SÁNCHEZ TORRES (Cuba) dijo que su delegación apoyaba la propuesta de Sudáfrica y consideraba que la versión en español, por su redacción, excluía la comunicación en papel de manera implícita ya que dependía de la aceptación o no de la Oficina nacional. Añadió que en ese caso se excluía la posibilidad de que los solicitantes que no contaran con los medios de comunicación necesarios pudieran presentar solicitudes en papel si la Oficina nacional no aceptaba ese medio de comunicación. Por tanto, a su parecer, la comunicación en papel debía estar presente y de manera adicional se debía considerar la presentación de solicitudes a través de otros medios de comunicación.

156. Mr. GHORBANI (Islamic Republic of Iran) said that, as pointed out by the Delegation of Australia, this issue had been discussed at the SCT. However, very few developing countries participated in the relevant sessions of the Committee. In the report of the thirteenth session of the SCT, the Delegation of the Islamic Republic of Iran expressly reserved its rights to raise this matter at the Diplomatic Conference. Several other developing countries supported this position.

157. La Sra. MENJIVAR CORTÉS (El Salvador) dijo que tal como lo habían señalado las anteriores delegaciones, en el Comité SCT se había discutido ampliamente ese Artículo. Añadió que el Gobierno de El Salvador, junto con la oficina registral y el sector pertinente de abogados marcarios, habían llegado a la conclusión que el Artículo gozaba de las flexibilidades adecuadas y daba la facultad potestativa al Estado de mantener ambos sistemas, es decir, recibir comunicaciones en papel o recibir las comunicaciones en forma electrónica. No obstante, indicó que en el caso de El Salvador, aunque la Oficina tuviera la capacidad de aceptar las comunicaciones en forma electrónica, recibían sugerencias e indicaciones de parte de su sector privado de abogados que no todos ellos estaban en disposición de hacer comunicaciones de carácter electrónico, por lo cual su delegación consideraba que ese Artículo debería mantenerse abierto y permitir la comunicación en ambos sentidos.

158. Mr. CARLSON (Sweden) said that although he understood the concerns expressed, amongst others, by the Delegation of South Africa, he considered that offices could use the fee mechanism as an incentive to use electronic filing. For example, Offices could establish a different or higher fee for paper filings.

159. Mr. Grace Issahague (Ghana) supported the proposal made by the Delegation of South Africa, since it provided developing countries with flexibility to accept paper based communications. She recalled that not every country had access to the Internet and declared that she would welcome a written proposal by South Africa on this matter.

160. M. PIAGET (Suisse) souhaite souligner une partie de l'intervention du délégué australien. Il ajoute que le contexte de la conférence diplomatique est indiscutablement différent de celui du comité permanent, mais que néanmoins il souhaite rappeler, comme l'a dit l'Australie, les discussions très longues, complètes et parfois fastidieuses qui se sont succédées lors du comité permanent. C'est la raison pour laquelle il indique que sa délégation estime peu opportun de revenir sur ces questions et de refaire les mêmes discussions ici même. Il rappelle que jusqu'au SCT/10 un choix de trois variantes avait été discuté et que la variante C avait finalement été retenue. Il précise qu'il s'agit là de la variante qui figure dans la proposition de base et ajoute que lors du SCT/10 il y avait un consensus pour retenir cette variante comme étant une bonne variante de compromis. Il dit que s'il ne fait erreur de très nombreuses délégations s'étaient ralliées à cette variante et que parmi ces délégations, il note encore dans le rapport, figuraient plusieurs pays en voie de développement, chacun étant conscient qu'il s'agissait là d'une variante de compromis. Pour conclure il rappelle et insiste encore sur le fait que l'article 8, alinéa 1) donne bien entendu le choix aux Parties contractantes de choisir la forme qu'elles entendent imposer s'agissant de leur office national.

161. M. NDINGA (Congo) indique qu'il souhaite intervenir sur l'article 8, alinéa 1) dans le souci de promouvoir l'adhésion d'un plus grand nombre de Parties au Traité révisé sur le droit des marques. Il note en effet d'une part que très peu d'Etats ont adhéré au TLT actuel, et d'autre part que le fait de donner la possibilité d'exclure les pays en développement en limitant le dépôt sur papier dans le traité révisé revient également à limiter l'efficacité de celui-ci. C'est pourquoi sa délégation souhaite que les deux possibilités, à savoir le dépôt électronique et le dépôt sur papier, soient prises en compte dans le traité révisé afin de garantir la majorité d'adhérents à ce traité. Il conclut en disant que sa délégation soutient par conséquent la déclaration de l'Afrique du Sud.

162. M. SISSOKO (Mali) dit qu'il pense également que la possibilité doit être donnée de faire des dépôts sur papier ou des dépôts électroniques. Il rejoint en ce sens ce qui a été dit par le délégué de l'Afrique du Sud et par le représentant de l'OAPI.

163. Ms. POWER (Canada) said that the Canadian Delegation was very interested on Article 8. The Canadian trademark office, like many others, accepted both electronic and paper communications. Although users in Canada might continue to use paper in the future, she wished to support the text of Article 8(1) of the Basic Proposal. She supported the views expressed by the Delegations of Australia and the

United States of America that the Committee should work towards creating a forward looking treaty that allowed enough flexibility for offices and for users.

164. Mr. MAHINGILA (United Republic of Tanzania) expressed support for the proposal made by the Delegation of South Africa.

165. La Sra. ROAD D'IMPERIO (Uruguay) dijo que su delegación apoyaba lo expresado por la Delegación de El Salvador, e insistió en que se debía tener presente que las presentaciones efectuadas por nacionales en el exterior y las presentaciones hechas por nacionales de otros países en el ámbito nacional, era el primer motivo para armonizar el derecho y los requisitos necesarios para hacer las solicitudes.

166. Mr. AYALOGU (Nigeria) supported the views expressed by the Delegation of South Africa. He noted that while every country would like to use electronic filing in the sense that it was easier, there was no doubt that there was still a very wide digital divide between developed and developing countries. He also noted that it was important to have an all inclusive treaty that allowed flexibility and this was the sense of the proposal made by the Delegation of South Africa.

167. Mr. WARDLE (New Zealand) said that he understood the provision in Article 8(1) as allowing a Contracting Party to choose the form and means of communication. In other words, it provided flexibility for offices in respect of how they received trademark applications and how they used new technologies to reduce business compliance costs, to keep the cost of applications down and improve office administration efficiency. He noted that his delegation would to enter a reservation in respect of any amendment that would effectively lock a Contracting Party into an outdated technology such as paper. He recalled that the importance of paragraph (1) was to give offices the flexibility to embrace new technologies and therefore, it should not be restricted to require officers to continue using in the future.

168. Mr. BANDA-BOBO supported the proposal made by the Delegation of South Africa. He noted that few developing countries had participated in the deliberations of the SCT.

169. M. BELFORT (Haïti) dit que la proposition faite par l'Afrique du Sud est tout à fait judicieuse et que dans cette perspective sa délégation décide de l'appuyer.

170. El Sr. RAMÍREZ BATHEL (República Dominicana) dijo que efectivamente existía una gran brecha tecnológica entre los países en vías de desarrollo y los países desarrollados, y añadió que aunque así lo quisieran, no podían negar la existencia de una determinada realidad de los países en vía de desarrollo. Lo único que podían hacer era enfrentar y vivir esa realidad y por lo tanto su delegación recomendaba una mayor flexibilidad conforme a sus realidades. Aclaró que lo que querían era llegar a la aplicación de un tratado que sea factible tanto en el presente como en el futuro. Por lo tanto el delegado indicó que su delegación apoyaba la posición de Sudáfrica y sugirió que Sudáfrica presente su propuesta por escrito.

[Suspension]

171. The CHAIR drew the attention of Main Committee I to two new documents containing proposals by the Delegation of the African Intellectual Property Organization (OAPI) concerning Articles 6 and 13 of the Basic Proposal for a Revised TLT (documents TLT/R/DC/7 and 8). He recalled that the Committee had already read Articles 1 to 8 of the Basic Proposal for a Revised TLT and the related Rules 1 to 6. He proposed to have no coffee break during the meeting of the Committee in the afternoon in order to accelerate the first reading of the provisions of the Basic Proposal.

172. Mr. MEJÍA GUEVARA (Honduras) announced a meeting of GRULAC at 14:30 hrs.

173. The CHAIR invited the Committee to consider Articles 9 and 10 of the Basic Proposal for a Revised TLT. In the absence of any delegation wishing to comment on these Articles, he turned to Article 11.

Article 11: Change in Ownership

174. Mr. GHORBANI (Islamic Republic of Iran) suggested that the expression “at the option of the requesting party” in Article 11(1)(b) be deleted. He held the view that the decision on the documentation accompanying a request for a change in ownership should be left to national offices. He felt that it was inappropriate to offer an applicant or another requesting party a choice between different options.

175. Mr. PARKES (FICPI) pointed out that the language used in Article 11(1)(b) corresponded to the parallel provision in Article 11(1)(b) of the TLT. He stressed that the choice between different options with regard to the documents to be furnished in case of a change in ownership was a very important element for users and thus rendered the Treaty user-friendly.

176. The CHAIR felt that a good reason would have to be given for a departure from the TLT.

177. M. YACOUBA KAFFA (OAPI) reconnaît qu’il est plus proche du rappel fait par l’honorable délégué de la FICPI parce que si le bout de phrase est biffé au choix du requérant, il pense que la formulation contiendrait la possibilité pour un office d’exiger par exemple un seul ou plusieurs des documents listés. Or, il estime qu’il faut laisser beaucoup plus de souplesse tant pour les déposants que pour les offices pour que les demandes d’inscription puissent être traitées avec un peu plus de diligence. Pour cela, l’OAPI n’est pas très favorable à un changement ou à un bouleversement de l’économie de ce texte.

178. Mr. GHORBANI (Islamic Republic of Iran) underlined that Main Committee I was not in a process of considering the TLT but a new treaty instrument. He recalled that the TLT had only 33 members and that the adoption of a Revised TLT aimed to broaden membership. He held the view that the provisions of the TLT should not be used as a yardstick for determining whether a proposal concerning the new treaty was good or wrong.

179. Ms. BERESFORD (United States of America) held the view that the 33 members of the TLT had managed well with the provision in Article 11(1)(b) leaving several options to the party requesting the recordal of a change in ownership. She wondered why this solution successfully applied in the members of the TLT should not be appropriate for more countries.

180. The CHAIR shared the view that positive experiences had been made with the text contained in the TLT.

181. The CHAIR adjourned the meeting.

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182. The CHAIR then turned to Rule 7 dealing with Manner of identification of an application without its application number and opened the floor for comments.

183. Mr. KHAN (Pakistan) wished to clarify that Rule 8 related with details concerning Article 5 on filing date.

184. The CHAIR said that there appeared to be no comments on Rule 7. He then turned to Article 12 Correction of a mistake, which had no corresponding rules in the Regulations.

185. Ms. SUNKER (South Africa) asked to turn back to Article 11. Referring Article 11(1)(b), she did not consider it adequate that the requesting party be left with the choice of documentation to be provided and, in this respect, she supported the intervention made by the Delegation of the Islamic Republic of Iran.

186. The CHAIR noted that there did not seem to be any comments on Article 12 and turned to Article 13, on which there were two written proposals. The first proposal was contained in document TLT/R/DC/8 and had been submitted by the Representative of OAPI.

187. M. YACOUBA KAFFA (OAPI) dit que la proposition de l'OAPI tient juste compte de leur pratique et de leur législation. En effet, il indique que l'annexe 3 de l'Accord de Bangui qui est la loi de l'OAPI et de ses 16 États membres en matière de droit des marques, dispose qu'il est possible pour un déposant de requérir le renouvellement dans l'année du dixième anniversaire soit dans les six mois qui suivent, ou dans les six mois qui précèdent la date anniversaire.. En effet, après le dixième anniversaire, il lui est également accordé la possibilité de procéder à la demande de renouvellement moyennant le paiement d'une pénalité. Il ajoute que cette pénalité se justifie à cause des travaux supplémentaires que cela occasionne au

niveau de l'OAPI. A cet égard il indique que, conformément à leur procédure administrative, avant l'échéance les déposants sont déjà informés de l'échéance qui interviendra et que l'office effectue alors une nouvelle classification des dépôts qui au jour du dixième anniversaire n'ont toujours pas été renouvelés. Il indique qu'ils conservent ces dossiers pendant six mois afin que les déposants retardataires qui n'ont toujours pas renouvelé puissent disposer de six mois supplémentaires après la date anniversaire pour pouvoir demander le renouvellement. Dès lors, si l'article 13.1)c) est adopté tel quel, il indique qu'ils seront alors obligés de réaménager entièrement l'Accord de Bangui, et donc d'entamer une procédure de révision relativement longue et fastidieuse. En parallèle, ils seront également obligés de revoir leurs procédures ainsi que leur mode de gestion des dossiers de marques. C'est la raison pour laquelle il suggère que l'article 13.1)c) *in fine* soit supprimé. Le représentant de l'OAPI précise toutefois que sa délégation est favorable à toute autre proposition qui tiendrait compte de leurs préoccupations.

188. Mr. PARKES (FICPI) asked the International Bureau of WIPO whether it could confirm his understanding that, under Article 5*bis* of the Paris Convention there was a minimum period of six months for the payment of renewal fees with the payment of a surcharge.

189. Mr. HÖPPERGER (WIPO) said that the general provision of Article 5*bis* of the Paris Convention provided for a grace period for the payment of renewal fees of at least six months, subject to a surcharge. This meant that, under the Paris Convention, a Contracting Party should give to trademark holders, after the date in which the fee was due, an opportunity to pay such a fee. The provision in Article 13 of the TLT went further because it also allowed holders to request the renewal within a period of six months after the actual date in which the renewal was due. Thus, if the renewal was dependent on a request and the request was made prior to the expiry of the registration but the fee was paid after, as long as the fee was paid within 6 months following the renewal date, and as long as there was a penalty fee, the registration remained valid. This was the reason why subparagraph (c) of Article 13 provided that Contracting Parties should give the holders the opportunity to present the request for renewal during of six months after the renewal date.

190. The CHAIR noted that in some systems the renewal was made simply through the payment of the renewal fee, whereas in this Article there was a request for renewal.

191. M. YACOUBA KAFFA (OAPI) dit qu'il ignore s'il s'agit d'un problème de traduction ou non, et précise qu'ils ont effectivement fait une proposition d'amendement de l'article 13.1)c) et non b). Il ajoute que si la discussion doit se poursuivre en ce qui concerne les périodes minimales prescrites par la règle 8 du règlement d'exécution, et plus particulièrement en ce qui concerne la mention " au plus tôt six mois après " la date d'échéance, il tient à souligner que dans le cadre de leur législation une fois que la période de six mois après le dixième anniversaire est dépassée, une autre procédure doit être lancée, à savoir une procédure de restauration.

192. La Sra. ROAD D'IMPERIO (Uruguay) dijo que su delegación sólo quería hacer una acotación a la clara explicación que había dado la Oficina Internacional que

esa disposición ya estaba en el Tratado de 1994, ya sea el Artículo como la Regla en las mismas condiciones, o sea que en ese momento se estaba repitiendo lo que ya existía que era acorde, como explicó la Oficina Internacional, con el Artículo *5bis*.

193. Le Secrétariat s'adresse au délégué de l'OAPI et admet que l'expression " la date à laquelle le renouvellement doit être effectué " puisse être lue d'une manière un peu ambiguë. Il souligne cependant que le contenu du débat en cours sera consigné dans les comptes rendus de l'Acte de la conférence diplomatique. Les comptes rendus indiqueront que " la date à laquelle le renouvellement doit être effectué " est en effet la date à laquelle expire l'enregistrement. Il espère que cette précision sera de nature à rassurer le délégué de l'OAPI sur ce point.

194. M. YACOUBA KAFFA (OAPI) rappelle le contenu de l'Article 13.1)c), à savoir « Toute Partie contractante peut exiger que la requête en renouvellement soit présentée et que la taxe correspondante visée au sous-alinéa b) soit payée, à l'office pendant la période fixée par sa législation ». Aussi, en ce qui concerne la taxe de renouvellement proprement dite il se réfère dès lors à l'alinéa 1)b) « Toute Partie contractante peut exiger que, pour la requête en renouvellement, une taxe soit payée à l'office ». Il demande encore une fois au Bureau international de préciser la nature de la taxe en question : est-ce que celle-ci comprend à la fois la taxe de renouvellement et la surtaxe, ou bien est-ce qu'il s'agit uniquement de la taxe de renouvellement à proprement parler ? Par ailleurs, le délégué de l'OAPI rappelle qu'il est nécessaire de tenir compte des différents systèmes, c'est pourquoi souplesse et flexibilité s'imposent en l'occurrence. Il ajoute enfin qu'il connaît et qu'il est effectivement conscient de l'existence de cette disposition dans le TLT de 94, mais souligne cependant que le TLT de 94 n'est pas rédigé dans le marbre ce qui explique d'ailleurs le processus actuel de révision.

195. Le Secrétariat dit qu'il souhaite expliquer comment le libellé de cette disposition doit être compris. A cet effet, il précise qu'à partir du moment où la date du renouvellement est passée la période ou le délai de grâce s'applique alors pour le paiement de la taxe de renouvellement. A partir de ce moment là les Parties contractantes sont parfaitement libres de demander une surtaxe. Il rappelle que c'est d'ailleurs la solution qui est déjà prévue par la Convention de Paris, et qu'il n'y a par conséquent rien de nouveau dans cela. Dès lors, le Secrétariat indique que si la taxe de renouvellement est payée à la date du renouvellement, il s'agit alors d'une taxe « standard », par contre si cette taxe est payée après la date du renouvellement, à ce moment là les offices ont la possibilité de demander une surtaxe, notamment pour couvrir les dépenses encourues au niveau administratif. Le Secrétariat conclut son intervention en précisant que ce système ne prévoit donc rien de nouveau, et rappelle que tout ceci est déjà prévu dans la Convention de Paris. Il souligne que le paiement de cette surtaxe est énoncé à la règle 8 du règlement d'exécution.

196. Mr. ARBLASTER (Australia) requested a clarification on the proposal submitted by OAPI. In his understanding, that proposal did not relate to the question of when the fee was payable, but when the surcharge was due. He considered that the treaty was silent on the issue of when the surcharge should be payable, but it would not be possible for the latter to be due before the former.

197. M. TRAPSIDA (Niger) dit qu'il a écouté avec attention les explications données par le Bureau international et par le délégué de l'Australie. Il indique que la compréhension qu'il a eue de l'explication donnée par le Bureau international est que l'application de la surtaxe peut intervenir dès la fin de la dixième année, or, il souligne que lorsqu'il se réfère à la règle 8 ceci ne paraît pas aussi évident. En effet, selon la règle 8 la surtaxe n'intervient qu'au terme du sixième mois et cela lui pose un problème. Il estime que tel est justement le sens de la modification qui est demandée afin d'éviter notamment d'avoir à bouleverser totalement leur législation.

198. The CHAIR suggested considering a change in Rule 8 rather than in the treaty. The advantage in doing so would be that the rule could be changed in the future by the Assembly if that was deemed necessary.

199. M. PIAGET (Suisse) dit qu'il semble que le problème se pose effectivement non pas à l'article 13 mais à la règle 8. En effet, d'après lui il semble que le problème découle de la compréhension même de cette notion de renouvellement ou de délai de renouvellement. Il se demande par conséquent si à la règle 8, il ne serait pas possible de différencier entre la date d'échéance de l'enregistrement, c'est-à-dire la fin de la période de 10 ans, et la période de renouvellement. Il propose par conséquent la formulation suivante pour le dernier paragraphe de la règle 8: " Si la requête en renouvellement est présentée ou si les taxes de renouvellement sont acquittées après la date d'échéance de l'enregistrement, toute Partie contractante peut subordonner le renouvellement au paiement d'une surtaxe ". Il indique qu'il faut peut être revoir la formulation proposée mais qu'il est d'avis que si on distingue bien la date d'échéance de l'enregistrement, soit la fin de la période de 10 ans, il sera possible de faire une distinction avec la période de renouvellement.

200. M. YACOUBA KAFFA (OAPI) note que le Bureau international a promis d'apporter beaucoup plus d'explications, tant en ce qui concerne les notes explicatives que la règle, dans l'Acte final de la Conférence diplomatique. Il ajoute que malheureusement le délégué de la Suisse a été tellement rapide dans sa dictée qu'il n'a pas pu noter sa proposition, dès lors il souhaite pouvoir la recopier et demande au Comité de lui donner un certain temps pour qu'il puisse consulter Yaoundé.

201. M. PIAGET précise qu'il s'agit d'un essai de formulation qu'il conviendra bien évidemment de discuter et le cas échéant d'améliorer. Il souligne que la première partie du deuxième paragraphe de la règle 8 reste inchangée " Si la requête en renouvellement est présentée ou si les taxes de renouvellement sont acquittées ", c'est seulement par la suite que la formulation change " après la date d'échéance de l'enregistrement, toute Partie contractante... ", la fin de la règle 8 restant quant à elle inchangée.

202. Mr. WARDLE (New Zealand) held the view that there was perhaps not a problem with the substance of the provision but with its wording and suggested that the question be transferred to the Drafting Committee.

203. Mr. ARBLASTER (Australia) said that speaking as a member of the Drafting Committee it would be difficult for that body to deal with this provision without having a clear notion of the Committee's intent.

204. Mr. KHAN (Pakistan) pointed out that Rule 8 concerned the renewal of a registration. The TRIPS Agreement provided for an initial term of registration and renewal terms of ten years. He informed Main Committee I that, like most national laws, Pakistan allowed the renewal fee to be paid during a period of 6 months prior to the last day of the registration. Under Rule 8, a further period of six months had to be given after the expiry of that date. During this grace period, the registration could still be renewed subject to the payment of a surcharge. The delegate wondered in which way the date could be fixed until which renewal on payment of a surcharge would be allowed. In addition, he sought clarification whether Contracting Parties would be obliged not to remove the mark from the register until the grace period expired.

205. The CHAIR proposed that Delegations which had expressed their concern, such as Switzerland and OAPI, hold informal consultations in order to draft a text which would give more precise instructions to the Drafting Committee.

206. La Sra. ROAD D'IMPERIO (Uruguay) dijo que respecto a la intención que el Presidente había manifestado de que el Comité de Redacción interviniera en el punto en discusión de la segunda frase de la Regla 8, su delegación, al conducir dicho Comité de Redacción, quería que se le explicitara con qué alcance tenían que hacer la modificación y que se les dieran más elementos o herramientas para poder trabajar al respecto.

207. The CHAIR agreed that the Delegations concerned should hold informal consultations to draft a text which could be presented to Main Committee I for further consideration.

208. M. SISSOKO (Mali) dit que la règle 8 ne lui pose pas de problème contrairement à la définition de la date d'échéance. Par conséquent il voudrait qu'on lui indique à quel moment une marque tombe en déchéance. Il ajoute que si cette définition lui est donnée tout sera clair pour lui à ce moment là.

209. Mr. MTESA (Zambia) expressed support for the interventions made by the Delegation of Australia and the Delegation of Uruguay. He held the view that the issue was of a substantive nature and that, for this reason, it could not be left to the Drafting Committee. He suggested that Main Committee I leave the matter for the time being and return to it after the Delegations concerned had had the opportunity to hold informal consultations.

210. M. DIOH (Sénégal) dit que si le bout de phrase qui se termine par “ six mois après cette date ” était biffé il n'y aurait plus de problème étant donné que la date dans la proposition de la Suisse se référerait effectivement à la date d'échéance de l'enregistrement, c'est-à-dire à la date anniversaire du dépôt et de l'entrée en vigueur de la protection.

211. Mr. PARKES (FICPI) suggested considering replacing the words “the date on which renewal is due” in Rule 8 with the expression “the end of the duration of the period of registration” which would be in line with the wording of Article 13(5) and the period of ten years mentioned by the Delegation of OAPI.

212. Mr. HÖPPERGER (WIPO) said that, even though the proposal made by the Delegation of Switzerland was tempting, an inherent problem had to be considered.

Technically-speaking the trademark had not expired as long as the grace period of six months was applicable. In consequence, the date of expiry also constituted an ambiguous point in time with regard to the payment of the renewal fee and the surcharge. In his view, the proposal made by the Representative of FICPI pointed towards the right direction because it disassociated the expiry from the payment of the surcharge and referred clearly to the period of registration. He explained that the wording used in the Basic Proposal had initially been chosen because, as a result of the obligation under the Paris Convention to provide for a grace period of six months, it was not clear when the period of registration ended. Although the period of registration was already over, it was still possible to renew the registration. In practice, most Offices waited until the expiry of the grace period before rectifying the register. As the choice of words reflecting the complex situation was difficult, he felt that informal consultations would be appropriate to explore alternatives to the present wording that took into account all concerns which had been expressed.

213. M. YACOUBA KAFFA (OAPI) dit qu'il prend bonne note de la proposition en attendant de consulter Yaoundé et les États membres de l'OAPI. Il souligne néanmoins que la règle 8 est parfois source d'incertitude parce qu'il est difficile de savoir quand finit cette période exactement. Dans la version française, il est précisé qu'il s'agit " d'au moins six mois ", ce qui signifie qu'il est possible en amont de donner plus de temps, soit plus de six mois avant la date à laquelle le renouvellement doit être effectué, pour présenter la requête en renouvellement et payer la taxe de renouvellement correspondante. A l'inverse la règle 8 indique que cette période se termine " au plus tôt six mois " après la date à laquelle le renouvellement doit être effectué. Ce qui, à son sens, signifie que c'est là le minimum que l'on puisse donner et qu'il est par conséquent possible d'étendre cette période jusqu'à une année. Comme il l'a expliqué auparavant leur système est fondé sur la Convention de Paris, soit six mois avant et six mois après. Dès lors, une fois que la période de six mois après le dixième anniversaire est dépassée commence une nouvelle période dite de restauration. Il souligne à cet égard qu'une période de restauration n'est pas un délai de grâce parce que les droits ne sont plus véritablement les mêmes, et qu'il faut également tenir compte des droits des tiers. Il dit qu'il est entièrement d'accord avec la proposition du Président de procéder à des consultations informelles. Le délégué de l'OAPI ajoute qu'il fera également part de toutes ses préoccupations au Comité de rédaction.

214. Mr. ARBLASTER (Australia) wondered whether the problem of the wording of Rule 8 resulted from the way in which the English text of the provision had been translated into French. In his view, the English text was clear. He understood that the Delegation of OAPI did not seek to change the substance of the provision. Therefore, it was necessary to reconcile the English and the French text in a way which would ensure the clarity of both texts. He supported informal consultations to achieve this goal.

215. The CHAIR stressed the necessity to harmonize all language versions and to fully reflect all problems in all language versions. He said that interested francophone and Anglophone delegations should hold informal consultations on the wording of Rule 8 before proceeding further in Main Committee I and the Drafting Committee. On this understanding, he opened discussion on Article 13(2) to (5).

216. Mr. KIANI (Islamic Republic of Iran) proposed to delete Article 13(2)(i). He wondered about the reasons for excluding the requirement that a reproduction of the mark be furnished when requesting its renewal. He reserved the right to return to Article 13(2)(i) after he had had the opportunity to hold further consultations.

217. Mr. HÖPPERGER (WIPO) pointed out that a request for renewal could only be presented after the mark had finally been registered and kept in the register for the initial period of registration. Therefore, it should not be difficult to identify the mark concerned if the request for renewal indicated the registration number. He explained that Article 13(2)(i) served the purpose of simplifying the renewal procedure. There seemed to be no need to apply a procedure which was comparable to the initial application procedure. He also recalled that there were so-called trademark annuity firms specializing in the renewal of trademarks. In his view, their work would be rendered difficult if renewal procedures resembled application procedures.

218. The CHAIR agreed that it would seem inappropriate to be obliged to repeat the application process when requesting the renewal of a mark. He drew the attention of Main Committee I to document TLT/R/DC/7 containing a proposal by the Delegation of Japan to introduce a new Article 13(6). He opened discussion on this proposal.

219. Mr. TASHIRO (Japan) pointed out that the Basic Proposal for a Revised TLT did not contain a provision which corresponded to the transitional provision in Article 22(6) of the TLT. He recalled that Article 22(6) of the TLT had been established in consideration of the unique situation surrounding service marks in Japan, and stressed that the provision was necessary for the trademark administration process in Japan. The contents of Article 22(6) of the TLT should be maintained in the Revised TLT.

220. He explained that Japan had adopted a service mark registration system in April 1992. That system allowed the registration of service marks for which applications had been filed within six months counted from the date of implementation of the system, regardless of whether the applications concerned were in conflict with each other. This practice had resulted in redundant registrations. In order to solve the problem of multiple registrations, multiply registered service marks had to undergo substantive examination only at the time of first renewal, which was carried out 10 years after the registration date. Specifically, the examiner should consider whether renewal was requested for any other multiply registered service mark, and if so, whether or not the service mark in question was liable to cause confusion as to the owner of the mark. If the examiner decided that a multiple service mark held by another person had become more famous through use over the past ten years since the marks had been registered, he should not allow the renewal of the service mark concerned.

221. The delegate said that Article 22(6) of the TLT allowed Japan to carry out substantive examination for multiply registered service marks at the time of first renewal, despite the prohibition contained in Article 13(6) of the TLT. The inclusion of Article 22(6) in the Revised TLT was necessary because the Office of Japan needed to eliminate multiple registrations. He added that the final multiple registration had been made at the end of the year 2000. Therefore, the transitional

provision of Article 22(6) of the TLT should be included in the Revised TLT until around the year 2011.

222. The CHAIR wondered whether a phase-out period should be added to the provision proposed by the Delegation of Japan.

223. Ms. BERESFORD (United States of America) said that she had no objections to the proposal by the Delegation of Japan because it was so limited in scope. It would apply only to a specific country legislation model and only to the renewal of those service marks that had been filed during the first six months following the entry into force of the specific legislation concerned. Although the proposal set no time limit, she felt that there was a very practical limit on the number of service mark registrations that would be examined at the time of renewal. She recalled that the narrow exception sought by the Delegation of Japan was reflected in the TLT.

224. The CHAIR agreed that there seemed to be an automatic phasing-out mechanism resulting from the very nature of the provision proposed by the Delegation of Japan.

225. Mr. CHOI (Republic of Korea) expressed support for the proposal by the Delegation of Japan. He underlined that the issue had been dealt with in Article 22(6) of the TLT. In view of the current situation in Japan, he held the view that the issue should be reflected in some way in the framework of the Revised TLT. He felt that the need for the provision was understandable.

226. Mr. CARLSON (Sweden) said that he had no objection to the substance of the proposal by the Delegation of Japan. He agreed with the Delegation of the United States of America on its limited scope. He wondered whether it would be acceptable for the Delegation of Japan to include the proposed additional provision in the Regulations. As it was a transient problem, this would permit to change the provision more easily once it was no longer necessary.

227. Mr. BISEREKO (Uganda) expressed support for the proposal by the Delegation of Japan. In his view, the proposal reflected an appropriate way of introducing service marks in national trademark systems.

228. Ms. BERESFORD (United States of America) wondered whether the provision proposed by the Delegation of Japan could be moved to the Regulations. As it modified a treaty provision, it seemed more appropriate to create a transitional provision in the final and administrative clauses of the Revised TLT. The issue could be dealt with by Main Committee II.

229. Mr. TASHIRO (Japan) considered it acceptable to embody the provision proposed by his Delegation in a transitional provision in the final and administrative clauses of the Revised TLT.

230. The CHAIR expressed his gratitude for the flexibility shown by the Delegation of Japan. He wondered whether Main Committee I could agree on the substance of the proposal.

231. Mr. ARBLASTER (Australia) proposed to inform Main Committee II that Main Committee I had no objections to the substance of the proposal by the Delegation of Japan.
232. Mr. HÖPPERGER (WIPO) said that, as a new article had to be devised, it might be preferable to send the proposal to the Drafting Committee first. The Drafting Committee could be asked to submit the new provision directly to Main Committee II.
233. The CHAIR agreed on this way of proceeding further.
234. Mr. GHORBANI (Islamic Republic of Iran) suggested that the Delegation of Japan present a proposal to Main Committee II.
235. The CHAIR pointed out that there seemed to be consensus on the substance of the proposal by the Delegation of Japan in Main Committee I. In his view, it was unnecessary to impose the burden on the Delegation of Japan to prepare a new proposal which then would have to be processed by the International Bureau.
236. Mr. ARBLASTER (Australia) said that the most efficient way of dealing with the proposal would be to send it to the Drafting Committee which could then send it directly to Main Committee II.
237. Mr. TOPIĆ (Croatia) expressed support for proceeding in the way described by the International Bureau.
238. La Sra. ROAD D'IMPERIO (Uruguay) dijo que su delegación también había entendido que respecto al fondo de la cuestión planteada por la Delegación de Japón había consenso, por lo que entendía que la vía formal correcta y más rápida era la señalada por la Oficina Internacional y ratificada por el señor Presidente de la Conferencia.
239. Mr. GHORBANI (Islamic Republic of Iran) said that the proposal could be send to the Drafting Committee.
240. The CHAIR concluded that there was consensus on the proposal by the Delegation of Japan. The Drafting Committee would be asked to create a new article in the final and administrative clauses of the Revised TLT and submit the new provision directly to Main Committee II.

Article 14: Relief Measures in Case of Failure to Comply with Time Limits

Rule 9: Relief Measures in Case of Failure to Comply with Time Limits

241. The CHAIR opened discussion on Article 14. He recalled that this provision had been discussed extensively in the SCT. While Article 14(1) contained a “may” provision which highlighted an option for Contracting Parties to provide for a relief measure before the expiry of a time limit, Article 14(2) set out three different relief measures, at least one of which had to be offered after the expiry of a time limit. In

the case of Article 14(2), Contracting Parties would thus be obliged to adopt at least one relief measure out of the three possibilities reflected in the provision.

242. La Sra. MOGIN BARQUÍN (España) sugirió que se cambiara el orden de redacción de la Regla 8.

243. The CHAIR proposed that the Delegation of Spain join the informal consultations on Rule 8. He returned to the consideration of Article 14.

244. Mr. TASHIRO (Japan) announced a proposal concerning Rule 9.

245. Mme FARAH (Maroc) se réfère à l'alinéa 2 de l'Article 14 de la proposition de base dans la version française et suggère de biffer " des " à la phrase " la Partie contractante prévoit une ou plusieurs des mesures de sursis ci-après ". La nouvelle formulation devrait donc être " la Partie contractante prévoit une ou plusieurs mesures de sursis.. ".

246. Le Président s'enquiert auprès de la délégation du Maroc afin de savoir s'il a bien compris son intervention et lui demande de confirmer si dans la phrase " la Partie contractante prévoit une ou plusieurs des mesures de sursis ci-après ", le mot " des " doit effectivement être biffé.

247. M. DIOH (Sénégal) estime qu'il faut maintenir le terme " des " à l'alinéa 2 de l'Article 14, sinon le texte n'aurait aucun sens.

248. Le Secrétariat indique que l'expression entre parenthèses " le délai considéré ", a été intentionnellement introduite dans le texte afin de rendre la disposition, qui est quand même assez compliquée, plus lisible. Ainsi, le délai considéré se réfère au délai que le déposant ou le titulaire ou une autre personne intéressée n'a pas observé. Le Secrétariat ajoute que s'il fallait à chaque fois répéter cette phrase au lieu d'utiliser le raccourci " le délai considéré ", l'alinéa serait trois fois plus long. Il précise enfin qu'il s'agit là d'une astuce au niveau de rédaction afin de rendre le texte plus lisible.

249. The CHAIR concluded that the issue concerned a question of drafting and should be dealt with by the Drafting Committee. With regard to Rule 9, he proposed to postpone the discussion until the proposal by the Delegation of Japan had been made available.

250. Mr. WARDLE (New Zealand) informed Main Committee I that his Delegation had also submitted a proposal in respect of Rule 9, the production of which was under way. The proposal concerned Rule 9(1)(i), (2)(i) and (3)(i).

Articles 15 to 18

251. The CHAIR turned to Article 15. In the absence of any request for the floor, he opened discussion on Article 16 and recalled the provisions contained in the TRIPS Agreement which sought to establish equality between trademarks and service marks. In the absence of any request for the floor, he turned to Articles 17, 18 and 19.

Article 19: Effects of the Non-Recordal of a License

252. La Sra. MOGIN BARQUÍN (España) indicó que el Artículo 19.2) de la propuesta de Tratado decía que “una Parte Contratante no podrá exigir la inscripción de una licencia como condición para gozar del derecho que pueda tener el licenciataria conforme a la legislación de esa Parte Contratante, , a personarse en un procedimiento de infracción entablado por el titular o a obtener, en ese procedimiento compensación por los daños y perjuicios resultantes de una infracción de la marca objeto de licencia”. A su parecer, el contenido de ese Artículo chocaba con lo regulado en su ley de marcas y por lo tanto su delegación suscribiría la reserva que se establecía en el Tratado del Artículo 29.

253. The CHAIR wondered whether the reservation allowed under Article 29(2) would accommodate the concern expressed by the Delegation of Spain.

254. La Sra. MOGIN BARQUÍN (España) aclaró que se refería al Artículo 29 apartado 2 que a su vez se refería expresamente al Artículo 19.2 del Tratado que era el que estaban examinando.

255. The CHAIR noted that the Delegation of Spain had announced to make use of the reservation for which Article 29(2) provided.

256. M. YACOUBA KAFFA (OAPI) dit que sa délégation voudrait que le Bureau international la rassure en ce qui concerne l'article 19, paragraphe 2. Il souhaite en effet s'assurer qu'il a parfaitement compris cette disposition. A la lecture de celle-ci il comprend qu'à défaut d'une inscription de la licence de la part du preneur de licence, à titre de sanction celui-ci ne pourra pas suite à une défaillance ou mise en demeure du titulaire se substituer à lui pour agir en contrefaçon. Il comprend également que cela n'empêchera pas le preneur de licence de pouvoir demander des dommages et intérêts s'il a éventuellement subi un dommage, lorsqu'une telle action est intentée par le titulaire. Le délégué de l'OAPI souhaite que le Bureau international lui confirme si sa compréhension est la bonne et si toute autre personne, qu'il s'agisse d'une licence exclusive ou non, pourrait éventuellement intervenir. Il indique que si tel est le cas cela ne leur posera aucun problème, mais que dans le cas contraire ils seront obligés de revoir leur position.

257. Mr. KHAN (Pakistan) held the view that the issue deserved consideration. He informed Main Committee I that, in Pakistan, the recordal of licenses was obligatory. He feared that the non-recordal of licenses would create a risk of trafficking because the users of a trademark could not be determined on the basis of the register. In the case of a large number of persons using a trademark, the quality of the goods and services concerned could be affected negatively. He stressed that the non-recordal of licenses may also raise problems with regard to infringement proceedings and resulting damages. For these reasons, Pakistan would use the reservation in Article 29(2).

258. Mr. OMOROV (Kyrgyzstan) referred to Article 17(4)(a)(ii). He informed Main Committee I that, under the national law of Kyrgyzstan, it was mandatory to

submit documents or certificates, such as the license contract, when requesting the recordal of a license. He pointed out that his country would be prepared to modify its domestic legislation in the light of a potential consensus. The provisions of the Revised TLT could serve as a model for the amendment of national legislation in Kyrgyzstan.

259. M. YACOUBA KAFFA (OAPI) souhaite attirer l'attention du Comité sur les notes qui accompagnent la proposition de base et qui se trouvent dans le document TLT/R/DC/5. Il indique qu'il y a toute une série de notes explicatives qui accompagnent l'article 15 et plus particulièrement il se réfère à l'alinéa 2 de cette disposition, ou il est énoncé de manière générale que la proposition de base n'oblige aucunement les Parties contractantes à donner le droit ou non au preneur de licence d'agir en justice. Il précise que ce qui est dit à l'alinéa 2 de l'Article 19, c'est que dans le cas où une marque est utilisée dans le cadre d'une licence et qu'il s'avère qu'il y a contrefaçon de cette marque, le fait que la licence ne soit pas inscrite au registre ne devrait pas empêcher le preneur de licence d'initier une action en justice en son nom propre, ou de se joindre à une action initiée par le titulaire pour demander des dommages et intérêts par exemple.

260. Le délégué constate que la proposition de base n'aborde pas la question de savoir si le preneur de licence lui-même a le droit d'initier une action en justice, et parle seulement d'une situation où c'est le preneur de licence qui veut se joindre à une telle action notamment pour demander des dommages et intérêts.

261. Il insiste sur le fait que tout ce que dit l'article 19.2 c'est que le fait que la licence ne soit pas inscrite n'empêche le preneur de licence de se joindre à une action en contrefaçon intentée par le titulaire. Il note que cette disposition a rencontré une certaine opposition lors des travaux préparatoires, ce qui explique que la possibilité de formuler une réserve ait été prévue à l'article 29.

262. Il rappelle que le comité permanent de l'OMPI avait finalement conclu que si on ne donnait pas cette possibilité au preneur de licence cela profiterait ultérieurement aux contrefacteurs. En effet s'il s'agit d'un preneur de licence qui utilise la marque de bonne foi, et s'il apparaît qu'il y a des contrefaçons sur le territoire pour lequel la licence a été accordée, à ce moment là le preneur de licence n'aurait pas la possibilité de demander des dommages et intérêts.

263. Encore une fois, le délégué souligne le fait qu'on ne donne pas le droit au preneur de licence d'initier une action en justice en son nom propre. Il s'agit là du droit qui est en quelque sorte réservé au titulaire, et au cas où le titulaire initierait une telle action, le preneur de licence devrait avoir la possibilité de se joindre à cette action pour obtenir des dommages et intérêts.

264. M. HOPPERGER (OMPI) dit que le Bureau international attire encore une fois l'attention du comité sur les notes qui accompagnent la proposition de base et qui se trouvent dans le document TLT/R/DC/5. En effet, il y a toute une série de notes explicatives qui accompagnent l'article 15 et plus particulièrement l'alinéa 2) de cette disposition où il est déjà énoncé de manière générale que la proposition de base ne contient aucune obligation de donner le droit aux preneurs de licences d'agir en justice. Dès lors, le Bureau international précise que tout ce qui est dit dans

l'alinéa 2) de l'article 19 c'est que dans le cas où une marque est utilisée sous une licence et qu'il s'avère qu'il y a une contrefaçon de cette marque, le fait que la licence ne soit pas inscrite au registre ne devrait pas empêcher le preneur de licence d'initier une action en justice en son propre nom ou de se joindre à une action initiée par le titulaire lui-même pour demander des dommages intérêts par exemple. Il est vrai que la proposition de base ne va pas jusqu'à imposer que le preneur de licence lui-même ait le droit d'initier une action en justice.

265. Le Bureau international précise par conséquent que tout ce que dit le 19.2) c'est que le fait que la licence ne soit pas inscrite ne devrait pas empêcher le preneur de licence de pouvoir choisir entre tenter une action lui-même ou se joindre à une action intentée par le titulaire. Le Bureau international souligne que cette disposition a rencontré une certaine opposition lors des travaux préparatoires et que c'est la raison pour laquelle une possibilité de réserve a été prévue à l'article 29. Le Bureau international rappelle que cette disposition a été prévue parce que le Comité permanent de l'OMPI a estimé que si on ne donnait pas cette possibilité au preneur de licence cela profiterait ultérieurement au contrefacteur. En effet si l'on est en présence d'un preneur de licence qui utilise la marque de bonne foi et qu'il apparaît qu'il y a contrefaçon sur le territoire pour lequel la licence a été accordée, à ce moment là le preneur de licence n'aura pas la possibilité de récupérer des dommages-intérêts. Le Bureau international souligne encore une fois qu'on ne donne pas le droit au preneur de licence d'initier une action en justice en son nom propre, ce droit étant en quelque sorte réservé au titulaire, cependant dans le cas où le titulaire initie une telle action le preneur de licence doit avoir la possibilité de se joindre à cette action afin d'obtenir des dommages intérêts, en dépit du fait que la licence ne soit pas inscrite. Le Bureau international indique qu'il y a aussi la possibilité de prévoir une réserve à cet égard comme cela a déjà été évoqué par le délégué de l'Espagne. Le Bureau international attire enfin l'attention des participants sur les notes relatives à l'article 19 qui contient toute une série d'explications à cet égard, mais souligne également qu'il demeure à la disposition des délégations pour fournir de plus amples explications le cas échéant.

266. Mr. HÖPPERGER (WIPO) stressed with regard to the intervention made by the Delegation of Pakistan that nothing in the Basic Proposal prevented a Contracting Party from requiring the recordal of a license. He said that it was frequent practice to provide for the compulsory or optional recordal of trademark licenses in order to enhance security in the business environment. Recognizing the different practices, the provisions of the Basic Proposal on trademark licenses were drafted so as to streamline related administrative procedures without precluding different national approaches.

267. M. PIAGET (Suisse) dit qu'il souhaite reprendre la première partie des explications et préciser deux points. Il pense en effet que l'article 19 alinéa 2 ne devrait pas être problématique pour les délégations présentes pour deux raisons essentiellement. La première raison c'est que le champ d'application de l'article 19.2 est extrêmement étroit, et comme l'a dit le Bureau international l'interdiction qui est faite d'inscription au registre ne fait pas référence à l'action du preneur de licence en dommages-intérêts par exemple, mais à quelque chose de beaucoup plus restreint, c'est-à-dire à l'intervention du preneur de licence dans le cadre d'une action intentée par le titulaire. Il précise qu'en droit suisse on parle d'une intervention au sens

technique du terme. Le délégué souligne encore une fois que le champ d'application de l'article 19.2 est extrêmement étroit et que par conséquent cette disposition ne devrait toucher que très peu de délégations. Dans sa deuxième remarque il indique que même dans l'hypothèse où cette disposition et ses effets devaient poser problème à quelques délégations, comme cela semble être le cas pour l'Espagne, il reste toujours la possibilité de faire une réserve pour ne pas être lié par l'article 19.2 comme l'a rappelé le Bureau international.

268. Mr. DONG (CTA) underlined that the issue of trademark licenses seemed very important in today's economic environment. There were many cases involving the licensing of the right to use a trademark to another party. He explained that the old legal system in China had been similar to the system of Pakistan, requiring the licensee of a trademark to register with the Office. Otherwise, administrative fines would have been imposed. If a license still had not been registered, the license and the trademark registration could be revoked after the expiry of a certain period of grace. A new trademark law, which had been adopted in 2001, recognized rights in trademarks as private rights and the contractual relationship between the licensor and the licensee. If, under the new law, a license was registered at least until the expiry of a certain grace period, no administrative fines were imposed and the trademark registration was not revoked. Pursuant to legal doctrine in China, the licensee would not have the possibility to seek damages and to participate in litigation processes if the trademark license had not been recorded.

269. The representative held the view that Articles 17 and 18 of the Basic Proposal regulated the need to record a trademark license with the Office in a way that was less liberal than trademark legislation in China. He felt that Article 19 gave rights of a different kind to the licensor and the licensee. The reservation permitted under Article 29 was compatible with the practice of the courts in China. He informed Main Committee I that the intermediate court of Shanghai had decided numerous cases concerning the relationship between the licensor and the licensee. In business practice, the licensor received a certain amount of money from the licensee. In turn, the licensee required the licensor to record the license with the Office. If, however, the licensor refused to register the license, the licensee did not have the possibility to seek damages in case of infringement. The representative felt that, in this situation, the court practice in China did not offer an effective mechanism for ensuring the recordal of a license. He wondered whether it would be appropriate to require the licensor to record the license and impose certain penalties in case he or she did not fulfill this obligation. He feared that, otherwise, the courts would not be able to settle disputes between the licensor and the licensee.

270. The CHAIR explained that the Basic Proposal established a legal framework for those Member States providing for the recordal of licenses. He pointed out that there was no obligation under the Revised TLT to do so. The Basic Proposal thus allowed the coexistence of different systems. In the absence of any further comments with regard to Article 19 and any request for the floor with regard to Article 20, he turned to Rule 10.

Rule 10: Requirements Concerning the Request for Recordal of a License or for Amendment or Cancellation of the Recordal of a License

271. Mme FARAH (Maroc) dit qu'en ce qui concerne la Règle 10 1) a) ix) du Règlement d'exécution, elle pense qu'il faut également mentionner le numéro de la demande d'enregistrement de la marque qui fait l'objet de la licence, au lieu du numéro d'enregistrement seul.

272. The CHAIR said that a request for the recordal of a license could be made with regard to an application and a registration alike. He referred to the horizontal provision laid down in Article 17(6).

273. Le représentant du Bureau International demande à la déléguée du Maroc si elle peut répéter son intervention parce qu'il n'a pas bien compris ce qu'elle a voulu dire. Il indique qu'il va maintenant écouter la version originale en français pour mieux comprendre son intervention.

274. M. YACOUBA KAFFA (OAPI) dit que si la demande se réfère à une demande d'enregistrement de marque, les explications données par la déléguée du Maroc et par le Secrétariat sont largement suffisantes. Par contre, il ajoute que si le numéro de la demande se réfère à la requête d'inscription, dans ce cas il va de soi que cela ne sera pas possible dans la mesure où c'est l'office qui reçoit et qui détermine le numéro d'une demande d'inscription. Le délégué estime par conséquent que l'ajout est possible que s'il s'agit effectivement du numéro d'une demande d'enregistrement de marque. A l'inverse si la déléguée se réfère au numéro de la demande de la requête d'inscription, dans ce cas il leur paraît difficile d'accepter cette proposition.

275. Mme FARAH (Maroc) précise que son intervention concerne l'alinéa 1, sous-alinéa 9, relatif au contenu de la requête. Elle indique qu'en ce qui concerne le contenu de la requête, cette disposition du Règlement d'exécution prévoit l'indication du numéro de l'enregistrement de la marque faisant l'objet de la licence. Elle propose quant à elle, si cela est possible, d'indiquer le numéro de la demande ou de l'enregistrement, étant donné que l'on permet l'enregistrement de la licence, d'une demande de marque ou d'une marque enregistrée.

276. Mr. ARBLASTER (Australia) underlined that the system of applying certain provisions *mutatis mutandis* was used on many occasions throughout the Revised TLT. In his view, Article 17(6) also applied to the Regulations and therefore covered Rule 10. For the text of Rule 10 to be correct, no further mention of applications was needed. He held the view that an express reference to applications should not be added in Rule 10. This would damage the general principle of *mutatis mutandis* application and give rise to the question whether the principle was applicable to other provisions in which no express reference was made.

277. Mme FARAH (Maroc) dit qu'en présence d'une demande d'enregistrement il faut quand même signaler un numéro. Elle précise qu'il s'agit du numéro de la demande et qu'il n'y a pas encore enregistrement.

278. The CHAIR wondered whether the intervention by the Delegation of Morocco concerned the number of the trademark application or the number of the request for the recordal of a license.

279. Mrs. EL TINAY (Sudan) drew the attention of Main Committee I to an ambiguous term to be found in the Arabic text of Articles 17, 18 and 19. The Arabic word used for “recordal” may be misunderstood in the sense of “restriction”.

280. Mrs. CLETO (Portugal) referred to the intervention made by the Delegation of Australia. She held the view that the *mutatis mutandis* principle did not hinder express mention of the number of the request for recordal of a license in Rule 10. She pointed out that, pursuant to the practice of the Office of Portugal, the registration number and the number of the request for the recordal of a license were identical.

281. Mme KADRI (Algérie) pense que l'article ne pose pas de problème et qu'il faudra simplement le renvoyer au Comité de rédaction. Elle ajoute que l'article 9 reprend cela et qu'il est également possible de trouver la mention « requête d'enregistrement » dans les formulaires internationaux de type 1.

282. Mr. OMOROV (Kyrgyzstan) pointed out that, in Kyrgyzstan, the indication of the territory covered by a trademark license was mandatory. He felt that the reference to “a part of the territory” in Rule 10(1)(xii) was not entirely clear in the Russian text of the Basic Proposal. He proposed to add a clarification at the end of Rule 10(1)(xii) to the effect that the indication of the territory concerned could be required. In Rule 10(1)(b)(i), the reference to items (i) to (ix) of Rule 10(1)(a) should be extended to items (x) to (xii) of that provision.

283. La Sra. RÍOS DE DAVIS (Panamá) solicitó una aclaración puesto que al hablar del número de la solicitud de registro se estaría hablando de la solicitud de inscripción de una licencia sobre la base de una expectativa de derecho porque todavía el solicitante no tendría la marca registrada. La delegada dijo que eso la preocupaba y que por lo tanto quería una explicación de la Secretaría al respecto. Efectivamente, ella asumía que el solicitante debía tener la marca registrada y no solo una expectativa de derecho para poder inscribir una licencia en un momento dado.

284. The CHAIR held the view that the issue raised by the Delegation of Panama was subject to national law and not precluded by the Basic Proposal.

285. Mr. PARKES (FICPI) referred to Rule 10(1)(a)(ix). He drew the attention of Main Committee I to the fact that the request for the recordal of a license may be made simultaneously with the application for the registration of a trademark, particularly when the mark was intended to be used exclusively by the licensee. He assumed that, in such a case, Rule 7 would be applied to identify the application. With regard to Rule 10(1)(a)(viii), he recalled the written statement on behalf of FICPI which had been made available to delegations. A request for the recordal of a license would be made in a situation where the holder had already registered the trademark or had filed an application. Pursuant to Article 3(1)(a)(iv), a Contracting Party could require in this situation that the applicant state the legal nature of the legal entity concerned and the State etc. under the law of which the legal entity had been organized. The representative held the view that it would therefore be unnecessary to

impose the obligation on the holder to repeat this information when requesting the recordal of a license. He suggested that the words “the holder or” in Rule 10(1)(a)(viii) be deleted and International Form No. 11 be amended accordingly.

286. The CHAIR wondered whether the issue raised by the Delegation of Morocco could be dealt with by the Drafting Committee.

287. Mme FARAH (Maroc) dit qu’il reste toujours une ambiguïté au niveau de la règle 10. En effet elle estime que lorsque le numéro d’enregistrement de la marque est demandé c’est comme s’il fallait attendre que la marque soit enregistrée pour avoir la possibilité de faire une requête en inscription d’une licence. Elle indique que s’il n’y a pas de risque de confusion elle pourra se satisfaire de ces explications.

288. The CHAIR concluded that the Drafting Committee should explore the issue raised by the Delegation of Morocco and report back to Main Committee I if it found a problem of a substantive nature.

289. The CHAIR adjourned the meeting.

Fifth Meeting
Friday, March 17, 2006
Morning

Article 21: Observations in Case of Intended Refusal

290. The CHAIR opened discussion on Article 21.

291. Ms. SCHMIDT (Germany) expressed the view that Article 21 ensured the right of the applicant or a requesting party to be heard with its arguments and observations before the Office took any decision which was not in favor of the application or request. She underlined that this principle of the right to be heard was well-established in Germany and guaranteed as a constitutional right. In her view, the requirement of giving the parties the opportunity to submit observations before a decision was taken by the Office related only to those cases in which the Office had a possibility to base its decision on the arguments advanced by the applicant. This was obviously not the case where the consequence of a certain situation – mostly after the expiry of a time limit – was stipulated by national law or another binding regulation, and where the Office was not free to take any other decision. In those cases, relief measures could be offered after the expiry of a time limit, as envisaged in Article 14.

292. The delegate felt that the Explanatory Notes were ambiguous in this regard. It was her understanding that the Notes would neither be discussed nor approved at the Conference. She pointed out that it would be appreciated by her Delegation if, in case of a revision of the Notes, the International Bureau could take into account her observation.

293. Mr. AL-MOHAMMED (Iraq) pointed out that the expression “in respect of Article 14” to be found in the English text of the provision had not been translated into Arabic.

294. Mr. ARBLASTER (Australia) wondered whether the issue pointed out by the Delegation of Iraq would be referred to the Drafting Committee. In general, he raised the issue of how to harmonize the different language versions of the legal texts under consideration.

295. The CHAIR explained that the International Bureau would deal with translation errors. The translators would participate in the meetings of the Drafting Committee.

296. Mr. AL-MOHAMMED (Iraq) clarified that he was not referring to a translation error but an omission in the Arabic text.

297. The CHAIR said that it had to be ensured that all language versions were compatible. This was a matter of drafting. He agreed that the issue pointed out by the Delegation of Iraq rather constituted a clerical error.

298. Mr. MAHINGILO (United Republic of Tanzania) sought clarification on the expression “reasonable time limit” used in Article 21. He pointed out that the Basic Proposal did not provide any definition of this term.

299. The CHAIR explained that the term was particularly used in Anglo-American statutory law.

300. Mr. ARBLASTER (Australia) held the view that the term “reasonable time limit” offered room for individual decisions under national law. It constituted an element of flexibility. The term would require taking a decision in the light of the specific circumstances of the individual case concerned.

301. Mr. KHAN (Pakistan) said that Article 21 constituted a provision ensuring national justice. He believed that the principle expressed in Article 21 to be widespread. In Pakistan, whenever there was a refusal, the applicant was informed properly and could enter into appeal procedures. The reasonable time limit referred to in Article 21 started from the notification of the applicant or other requesting party concerned.

Article 22: Regulations

302. The CHAIR opened discussion on Article 22. He drew the attention of Main Committee I to the proposal by the Delegation of South Africa which was reproduced in document TLT/R/DC/15.

303. Mr. KRAPPIE (South Africa) expressed the view that the status of the Regulations was not clear. Article 22(4) implied that the Regulations formed a part of the Treaty but had a lower status. He pointed out that, according to Article 23(2)(ii), the Regulations could be amended by the Assembly. He believed that this system would work well in practice. A specific provision clarifying the status of the Regulations, however, would be useful.

304. Mr. ARBLASTER (Australia) expressed support for the effort to clarify the language of the Treaty made by the Delegation of South Africa. He wondered whether the International Bureau could provide further guidance on the issue.

305. Ms. BERESFORD (United States of America) stressed that she had never seen the language proposed by the Delegation of South Africa before. She wondered about its impact on the status of the Regulations and sought further clarification in this respect.

306. Mr. WARDLE (New Zealand) expressed his uncertainty as to the language proposed by the Delegation of South Africa. He underlined that his Delegation would be prepared to support the clarification of the Basic Proposal and recalled that

Article 14(1)(a) of the Patent Law Treaty referred to “[t]he Regulations annexed to this Treaty”.

307. Mr. HÖPPERGER (WIPO) said that he could not provide a prevailing interpretation of the provision. He proposed to seek advice from the Legal Counsel and compare the language used in the Basic Proposal with the texts of other international treaties administered by WIPO.

308. El Sr. CONSTENLA ARGUEDAS (Costa Rica) dijo que tomando en consideración el tema que se estaba tocando tal vez podía ayudar un poco en clarificar el asunto. Indicó que venía de la de la Oficina Internacional de Tratados de la Cancillería de Costa Rica y que tenía entre sus documentos la Convención de Viena sobre Derecho Internacional de los Tratados. En la Convención de Viena había un artículo que tal vez podía aclarar un poco el sentimiento que en ese momento se estaba planteando por diversas delegaciones. El párrafo 2 del Artículo 31 de la Convención indicaba que “para los efectos de la interpretación de un tratado el contexto comprenderá, además del texto, incluido su preámbulo y anexos”... El delegado dijo que esperaba que de cierta forma ese artículo pudiera servir como una luz para entender el valor que podía tener el Reglamento conjuntamente con el documento marco que sería el Tratado Revisado.

309. The CHAIR adjourned the meeting.

Sixth Meeting Friday, March 17, 2006 Afternoon
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310. The CHAIR referred to the discussion on the proposal made by the Delegation of South Africa on Article 22(1)(a). He noted that, upon consultations with the Legal Counsel of WIPO, it had been determined that the provision in question could be drafted after Article 14(1) of the Patent Law Treaty, which read: “the Regulations annexed to this Treaty provide Rules concerning...” Taking this formulation would have the advantage of consistency with the language used in other WIPO administered treaties and would also be consistent with the Vienna Convention on the Law of Treaties, which had been mentioned by the Delegation of Costa Rica. He also noted that this formulation would also be helpful to have a consistent interpretation of WIPO-administered treaties.

311. Mr. STEMMET (South Africa) supported the suggestion made by the Chair.

312. The CHAIR noted that there were no additional comments on Article 22. He suggested that the Committee establish a first list of Articles and Rules that had received consensus, so that they could be submitted to the Drafting Committee.

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313. Mr. HÖPPERGER (WIPO) established that list as follows: Articles 7, 9, 10, 12, 14, 15 to 22 and Rules 1, 2, 4, 5 and 7.
314. Mr. GHORBANI (Islamic Republic of Iran) announced that his delegation would submit proposals on Articles 11(1)(b), 13(2)(i) and Rules 3(4)(b) and 10(2)(a), 10(3)(a) and 10(4).
315. Mr. ZAHROV (Ukraine) wondered whether the Committee could discuss a proposal on Article 8.
316. The CHAIR replied that the Committee would discuss those proposals which had been submitted in writing.
317. Mr. WARDLE (New Zealand) wondered what the situation was with Rule 9.
318. The CHAIR explained that Rule 9 would not yet be submitted to the Drafting Committee.
319. Mr. TASHIRO (Japan) announced that the Delegation of Japan wished to provide a clarification on Rule 10, but not a proposal.
320. The CHAIR suggested to start the analysis of proposals submitted on Article 1. He then turned to the proposal submitted by the Delegation of South Africa and contained in document TLT/R/DC/15, to arrange the abbreviated expressions in alphabetical order, according with standard treaty practice.
321. Mr. STEMMET (South Africa) said that his proposal was not substantive but it might help someone who was reading the treaty for the first time. His delegation was nevertheless ready to withdraw its proposal if other delegations considered that it was not essential.
322. Mr. HÖPPERGER (WIPO) said that, on this point once more, the order of the abbreviated expressions followed the in-house practice of WIPO. The main reason for not arranging those expressions in alphabetical order was that probably, the order would only follow in one of the official languages of the treaty. He noted that the Preparatory Meeting had considered that this practice should be followed and wondered if the Committee could take that advice.
323. Mr. STEMMET (South Africa) withdrew his proposal on Article 1.
324. The CHAIR noted that, since there were no additional comments on Article 1, it could be submitted to the Drafting Committee and opened the floor on Article 2 “Marks to Which the Treaty Applies”. He recalled that the Delegation of the Islamic Republic of Iran had announced that it would submit a proposal on that Article and asked the Delegation if it could indicate the specific issues to which the proposal would relate.
325. Mr. GHORBANI (Islamic Republic of Iran) said that his delegation no longer had a difficulty with Article 2.

326. The CHAIR noted that, since there were no additional comments on Article 2, the provision could be submitted to the Drafting Committee. He then turned to Article 3 “Application” and recalled that, on this provision there were two proposals: one from the Delegation of Singapore, as stated in document TLT/R/DC/11 and another one from the Delegation of South Africa, as stated in document TLT/R/DC/15 and invited those delegations to present their proposals.

Article 3: Application

327. Ms. LIEW (Singapore) said that her proposal did not intend to introduce any substantive change in the Basic Proposal, but was merely intended to separate the elements contained in Article 3(1)(a)(x), so that it would be clear that Contracting Parties had the freedom to choose one, more or none of the elements listed.

328. La Sra. DAFAUCE MENÉNDEZ (España) sugirió, si no había oposición de los demás delegados, cambiar la partícula “y” del final del cuarto párrafo por la partícula “o”. A su parecer, el párrafo redactado quedaría más claro de esa forma.

329. Ms. LIEW (Singapore) said that, in her understanding, the formulation did not have a conjunctive but a disjunctive effect. However, it would perhaps be preferable to submit the question of the use of “and” or “or” to the Drafting Committee.

330. Mr. ALEMU (Ethiopia) requested a clarification from the Delegation of Singapore as to the reasons behind the proposed amendment. In its comment, the Delegation of Singapore stated that the amendment would enable Contracting Parties to choose none, one or more of the elements or indications. But from reading the provision, as it stood now, it seemed that Contracting Parties would not be allowed to choose no element or indication, but at least one.

331. Ms. LIEW (Singapore) replied that the expression “some or all indications or elements” referred to the *château* of the provision which read that “any Contracting Party may require that an application contain some or all of the following indications or elements”.

332. The CHAIR then asked the Delegation of South Africa to present its proposal.

333. Mr. STEMMET (South Africa) considered that in Article 3, the wording “notwithstanding paragraph (4)” should be added at the beginning of paragraph (5) concerning Evidence, so as to establish a distinction between requirements and evidence. He understood the provision as meaning that no other requirements should be asked for, except where there is a need to provide evidence. He noted that the same type of construction appeared in Articles 10(5), 11(4), 12(4), 13(3) and 17(5). He further noted that the Committee could consider as a model the provisions contained in Article 8(3)(b) and (c). In the interest of progress, it was probably best to refer this matter to the Drafting Committee.

334. The CHAIR noted that there was consensus in the meeting to submit Article 3 to the Drafting Committee. He then adjourned the meeting.

Seventh Meeting Monday, March 20, 2006 Afternoon
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335. The CHAIR pointed out that Main Committee I had made good progress during the first week of the Diplomatic Conference. It had been possible to dispose of Articles 1, 2, 3, 7, 9, 10, 12 and 14 to 22, as well as Rules 1, 2, 4, 5 and 7. These provisions had been sent to the Drafting Committee. He recalled that, in accordance with Rule 13 of the Rules of Procedure, the Drafting Committee coordinated the drafting of all texts without altering their substance. The following provisions were still pending: Articles 4, 5, 6, 8, 11 and 13, and Rules 3, 6, 8, 9 and 10. He informed Main Committee I of his intention to clear the text to the largest extent possible by giving priority to those provisions and proposals which appeared to be less problematic before returning to those provisions that seemed more difficult and complex.

336. He drew the attention of Main Committee I to the proposal made by the Delegation of Benin on behalf of the Group of least-developed countries which had been reproduced in document TLT/R/DC/16. He underlined that the proposal indicated that the suggested text should become a new Article and announced that the Delegation of Benin would introduce the proposal to the Committee.

337. M. AMOUSSOU (Bénin) s’exprimant au nom des pays les moins avancés, s’est proposé de présenter rapidement leurs préoccupations contenues dans le document mis à la disposition des participants.

“Nouvel article à insérer dans le traité révisé sur le droit des marques – Proposition de la délégation du Bénin au nom du groupe des pays les moins avancés (PMA)”

1. Les pays les moins avancés (PMA), reconnus comme tels par l'Organisation des Nations Unies, mettront en œuvre le présent traité et son règlement d'exécution conformément à leurs besoins nationaux en termes de développement, de finances et de marques et après avoir acquis les capacités financières, administratives et institutionnelles nécessaires.

2. Les pays développés aideront les PMA à développer les capacités administratives et institutionnelles pour mettre progressivement en œuvre le traité.”

338. Le délégué du Bénin a conclu son intervention en disant que lorsque les questions de fond seront abordées, une nouvelle explication de leurs propositions sera présentée.

339. The CHAIR expressed his gratitude for the announcement of an explanatory note concerning the proposal. He said that Main Committee I would continue the consideration of the proposal once the explanatory note was available.

340. Mr. MTESA (Zambia) seconded the proposal made the Delegation of Benin on behalf of the Group of least-developed countries. He recalled that the United Nations had clearly recognized least-developed countries as a special category of States that needed special attention because of their numerous inadequacies. He stated that the least-developed countries were most grateful to their development partners who were providing technical assistance and capacity building so that they could meet the Millennium Development Goals by the year 2015.

341. The delegate stressed that a number of international organizations, including WIPO, were providing highly-needed technical assistance and capacity building with the support of the development partners, and expressed gratitude for these programs. He explained that the proposal which the least-developed countries had put forward for insertion in the Revised TLT was in line with activities in all international organizations. In WIPO, the Development Agenda had been discussed. The IMF, the World Bank and the WTO were in the process of discussing Aid for Trade.

342. He was confident that the Delegations at the Conference would not find it difficult to support the proposal by the Delegation of Benin which, if properly implemented, would contribute to the development of least-developed countries through technical assistance and capacity building programs. He believed that the best outcome of the Conference would be to make beautiful Singapore remembered as a place where the weak in society had not been forgotten but where efforts had been made to bring them along in today's technological era.

343. The delegate indicated that Zambia did not delight to belong to the Group of least-developed countries. It was the desire and aspiration of his country to leave the Group as soon as possible. He expressed the hope that the Conference would not impose unnecessary difficulties on least-developed countries.

344. Mr. AHMED (Bangladesh) expressed support for the proposal made by the Delegation of Benin on behalf of the Group of least-developed countries. He wished

to reserve the right to contribute further to this proposal in the course of the future discussion.

345. La Sra. SÁNCHEZ TORRES (Cuba) dijo que su delegación apoyaba la propuesta de la delegación de Benín en representación de los países menos adelantados. Efectivamente indicó que su delegación consideraba que era importante que los tratados internacionales en materia de propiedad intelectual incluyan flexibilidades de aplicación teniendo en cuenta el nivel de desarrollo de los países, y en particular de los países menos adelantados.

346. Mr. GHORBANI (Islamic Republic of Iran) referred to the proposal made by the Delegation of Benin on behalf of the Group of least-developed countries. He saw the proposal as an indicator for the intention of the least-developed countries to play a role and engage in the negotiation process. He assumed that this was a constructive move. He was of the opinion that the least-developed countries also had a substantial concern, namely as to their national development needs. He understood from the text of the proposal that the least-developed countries did not want the Revised TLT to harm them now or in the future. In particular, the Treaty should not impose any further commitment on them. The delegate said that, if this understanding of the proposal was correct, he was prepared to support the intention of the least-developed countries. He expressed the view that the issue should be accommodated by adopting appropriate treaty language.

347. Mr. MTSALI (South Africa) expressed support for the proposal made by the Delegation of Benin on behalf of the Group of least-developed countries. He pointed out that South Africa supported the aim of the least-developed countries to enter the mainstream and probably adopt the Revised TLT once they were ready to take this step. He felt that it was necessary to take into account the fact that the Revised TLT might not offer much breathing space for the implementation of policy objectives. He indicated the intention to broaden paragraph (2) of the proposal so as to include developing countries and reserved the right to elaborate further on this issue in the course of the future discussion of the proposal.

348. The CHAIR pointed out that Main Committee I would have the opportunity to continue the discussion of the proposal at a later stage and that every Delegation would be offered the opportunity to contribute to that discussion.

349. Mr. AYALOGU (Nigeria) expressed the support of his Delegation and the Group of African countries for the proposal made by the Delegation of Benin on behalf of the Group of least-developed countries. He announced that he would make further observations on this proposal once the full discussion on the issue would be opened.

350. M. YACOUBA KAFFA (OAPI) dit que puisque la discussion est close en ce qui concerne la proposition faite par le Bénin, il souhaite revenir aux dispositions du TLT et tout particulièrement à l'article 13.c)i) au sujet duquel l'OAPI a soumis une proposition écrite. Il indique qu'ils ont eu des consultations informelles avec la délégation suisse et le Secrétariat du Bureau international et qu'ils se sont rendus compte que les préoccupations de l'OAPI pouvaient être dissipées si la règle 8 était légèrement modifiée. C'est pourquoi, de façon informelle, ils ont fait une proposition

de reformulation de la règle 8 *in fine* qui serait rédigée comme suit “toute Partie contractante peut subordonner la recevabilité de la requête en renouvellement au paiement d’une surtaxe”. Le délégué de l’OAPI indique que de cette façon il n’y aura pas de difficulté d’interprétation et que cette disposition sera totalement conforme à leur loi qui est aussi la loi des États membres de l’OAPI. Il ajoute que si cette proposition est soutenue il déposera une proposition écrite et retirera sa proposition d’amendement de l’article 13.c)i).

351. The CHAIR wondered whether his understanding was correct that the Delegation of OAPI withdrew its proposal concerning Article 13 and sought to make additions to Rule 8 instead. He said that the changes to Rule 8 would leave the first sentence of the provision untouched. The second sentence of Rule 8 should read: “[i]f the request for renewal is presented and/or the renewal fees are paid after the date on which the renewal is due, any Contracting Party may subject the acceptance of the request for renewal to the payment of a surcharge.” He wondered whether Main Committee I could accept this change to Rule 8 as a countermove to the withdrawal of the proposal by the Delegation of OAPI.

352. M. YACOUBA KAFFA (OAPI) dit qu’après avoir écouté la traduction en français de l’intervention du Président, il souhaite préciser qu’il faudrait plutôt lire “toute Partie contractante peut subordonner la recevabilité, la recevabilité de la requête en renouvellement au paiement d’une surtaxe”. Il indique qu’il s’agit uniquement d’une question de sémantique mais qu’il tenait à ce que ce soit précisé, étant donné que la traduction en français ne lui paraissait pas tout-à-fait correcte.

353. The CHAIR thanked the Delegation of OAPI for its efforts and informal consultations. He concluded that Rule 8 could be sent to the Drafting Committee in order to include the change proposed by the Delegation of OAPI.

Article 4: Representation; Address for Service

354. The CHAIR turned to Article 4. He pointed out that two proposals had been submitted with regard to this provision.

355. Mr. HÖPPERGER (WIPO) informed Main Committee I that the Delegation of China had submitted a proposal that was reproduced in document TLT/R/DC/10. The second proposal made by the Delegation of South Africa was to be found in document TLT/R/DC/15.

356. The CHAIR first turned to the proposal by the Delegation of China, because it concerned the first paragraph of Article 4.

357. Mrs. HOU (China) explained that the proposal made by the Delegation of China aimed to introduce a new item (i) in Article 4(1)(a). The new item concerned the admission of a representative to practice before the Office. The delegate informed Main Committee I that China was in the process of revision of Regulation on Trademark Representation. The adoption of the Revised TLT would provide a basis for the continuation of the legislative work presently undertaken in China. She indicated that the proposal made by her Delegation sought to enhance the standard of

the quality of trademark representatives which was a matter of particular importance to his country. In 2005, the Office of China had processed 660,000 trademark applications. About 80 percent of these applications were presented through agents. One sixth of the applications were of foreign origin.

358. The delegate stressed that the quality of trademark representatives strongly influenced the efficiency of Office procedures. In the interest of foreign and domestic applicants alike, certain quality requirements had to be established with regard to representation before the Office in order to ensure the professional handling of administrative procedures. She believed that the introduction of the proposed new item (i) was in line with the main principles underlying the Revised TLT and would serve the interests of applicants.

359. Mrs. KIRIY (Russian Federation) pointed out that the wording of Article 4(1)(a)(i) fully corresponded to the wording of Article 7(1)(a)(i) of the Patent Law Treaty. It appeared to her that the proposal by the Delegation of China, if adopted, would narrow the circle of persons having the right to be a representative before the Office. She failed to see sufficient reasons for this. The problems and issues to be resolved by representatives in respect of patents were not less complex than in the case of trademarks, and required the same degree of knowledge and experience. In the Russian Federation, experts in the field of law would not automatically be granted the right to act as a representative before the Office. At the same time, there were experts who had practical experience in the judicial defense of rights. In her view, these specialists could be permitted to be representatives before the Office without requiring some special certificate or accreditation which the proposal by the Delegation of China seemed to imply. For this reason, she expressed support for retaining Article 4(1)(a)(i) as presented in the Basic Proposal.

360. La Sra. MENJIVAR CORTÉS (El Salvador) dijo que su delegación consideraba que el Artículo 4 numeral 1, literal a), i) debería mantenerse tal como estaba por las razones que brevemente señalaría. Añadió que su delegación agradecía el esfuerzo de la presentación de la propuesta de la delegación de China cuya distinguida delegada había manifestado las razones por las cuales las había formulado. Sin embargo, en el caso de El Salvador, precisó que su legislación aplicable pertinente no era necesariamente legislación del área de derecho de marcas o de propiedad industrial, sino otra legislación que también regulaba la materia, tal como la ley del derecho notarial en ciertos casos. Asimismo, señaló que el código de procedimiento civil también podía tener una aplicación directa en la materia. Por lo tanto dijo que su delegación consideraba que la redacción que señalaba que sea “conforme a la legislación aplicable” era conveniente para su país.

361. Mr. WARDLE (New Zealand) expressed the view that the present wording of Article 4, as contained in the Basic Proposal, was sufficient to fulfill the needs of China. He saw no need to amend the provision. The new item (i) proposed by the Delegation of China would impose the obligation on a State or intergovernmental organization to first regulate the admission to practice before its Office before becoming party to the Revised TLT. Referring to his earlier intervention, he recalled that trademark agents were not regulated in New Zealand. The experiences made in New Zealand showed that only patent attorneys and practicing lawyers represented trademark owners in trademark proceedings. For this reason, he failed to see any

need to specifically regulate the trademark attorney's profession. He stated that he could not support the proposal by the delegation of China.

362. Mrs. TOTIĆ (Serbia and Montenegro) said that she preferred keeping Article 4 as it was presented in the Basic Proposal. In her view, Article 4(1)(a)(i) of the Basic Proposal already included the substance of the additional item (i) proposed by the Delegation of China. If someone had the right, under the applicable law, to practice before the Office in respect of applications or registrations, this person necessarily had to be admitted to practice before the Office. In Serbia and Montenegro, only lawyers had the right under the trademark law to practice before the Office in respect of trademark applications. A patent attorney who was admitted to practice before the Office had no right to practice in trademark cases if he was not a lawyer. The delegate wondered about the need to expressly mention the requirement of admission in a new Article 4(1)(a)(i). It seemed to her that this was unnecessary.

363. Mr. DONG BAOLIN (CTA) felt that the Delegation of Serbia and Montenegro, the Delegation of the Russian Federation and the Delegation of New Zealand had made good suggestions on the basis of their experience as to the qualifications of trademark representatives. Usually, these representatives had to be lawyers and well versed in legal affairs. They also had to obtain the permission of the judicial departments in which they practiced. This guarantees the quality and efficiency of the work of trademark authorities and further protects interests of trademark applicants and holders. The representative pointed out that the situation in China was entirely different because there were no qualification requirements in the sense of a legal requirement for trademark representatives. China was still undergoing the process of drafting a law with respect to the issue of representation. Those representatives who were qualified to practice as lawyers and well versed in the field of trademarks constituted only a very small percentage of the entire group of lawyers.

364. The CHAIR thanked the representative of CTA for his explanation of the situation in China. He pointed out that several delegations had expressed the view that the result of the present wording of Article 4(1)(a)(i), as contained in the Basic Proposal, would be the application of Chinese Law to the question of representation. National legislation in China was free to specify the circumstances under which somebody had the right to practice before the Office in respect of applications and registrations. The admission to practice would totally depend on the applicable law in China. As no delegation had seconded the proposal by the Delegation of China, he wondered whether the Delegation of China would be prepared to withdraw its proposal in view of the general feeling within Main Committee I that the present text of Article 4(1)(a)(i) already accommodated the concern expressed by the Delegation of China.

365. Mrs. HOU (China) said that her Delegation would submit a new, amended proposal with regard to the question of the admission to practice before the Office in Article 4(1)(a)(i).

366. The CHAIR turned to the proposal by the Delegation of South Africa which concerned Article 4(3)(d) and was reproduced in document TLT/R/DC/15.

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367. Ms. SUNKER (South Africa) explained that the proposal made by her Delegation consisted in adding the word “herself” after “himself” at the beginning of the second line of Article 4(3)(d) in order to be correct as regards gender. The same approach should be followed consistently throughout the text of the Basic Proposal.
368. Mr. CARLSON (Sweden) expressed support for the proposal by the Delegation of South Africa. He said that the approach outlined in the proposal should not only be followed in the context of the Revised TLT but also with regard to future treaties.
369. Mr. RAGAB (Egypt) stressed that, in his country, a woman would not be excluded from practicing because of the language presently found in Article 4(3)(d) of the Basic Proposal.
370. Mr. WARDLE (New Zealand) recalled that discussions on the issue of including both “him” and “her” in the SCT had shown that the approach proposed by the Delegation of South Africa with regard to the English text may give rise to translation difficulties.
371. Mr. PARKES (FICPI) pointed out that the “person” to which the word “himself” related in Article 4(3)(d) could be an individual but also a legal entity pursuant to the definition given in Article 1(v).
372. The CHAIR said that the discussion of the proposal by the Delegation of South Africa clearly pointed towards a gender mainstreaming perspective. He wondered whether Main Committee I would be comfortable to send the issue to the Drafting Committee to ensure consistency throughout the text in this respect.
373. Mrs. SUNKER (South Africa) supported the suggestion of sending the proposal to the Drafting Committee. She underlined that gender neutrality was an important issue. She wondered what it would mean to be challenged before a court on the grounds that a provision regulating representation before the Office referred only to men.
374. The CHAIR concluded that there was agreement on sending the proposal made by the Delegation of South Africa with regard to Article 4(3)(d) to the Drafting Committee.

Rule 3: Details Concerning the Application

375. The CHAIR turned to the proposal by the Delegation of the Islamic Republic of Iran concerning Rule 3(4)(b) which was reproduced in document TLT/R/DC/19. He explained that the proposal consisted in the deletion of the words “at the option of the applicant” in Rule 3(4)(b).

376. Mr. GHORBANI (Islamic Republic of Iran) expressed the view that the Office should determine the different necessary views of the mark. The holder of the mark may make a choice which did not satisfy the Office.

377. Ms. SCHMIDT (Germany) invited the Delegation of the Islamic Republic of Iran to rethink its proposal. She pointed out that often one view of the mark was sufficient but sometimes different views were necessary. If the views provided by the applicant were insufficient, the Office could demand further indications, such as additional views of the mark.

378. Mr. ARBLASTER (Australia) said that, in Australia, the applicant had the freedom to decide on the views of the mark. The experience in Australia with this approach had been positive. He confirmed that the Office could ask more views in case it was not satisfied with the indications given by the applicant.

379. Mr. GHORBANI (Islamic Republic of Iran) stated that, in a spirit of flexibility, his Delegation withdrew the proposal concerning Rule 3(4)(b).

380. The CHAIR concluded that Rule 3 could be sent to the Drafting Committee.

[Suspension]

Article 5: Filing Date

381. The CHAIR turned to Article 5. He drew the attention of Main Committee I to the proposal made by the Delegation of the Islamic Republic of Iran with regard to the words “or implicit” in Article 5(1)(a)(i). The proposal was reproduced in document TLT/R/DC/19.

382. Ms. SCHMIDT (Germany) supported the present wording of Article 5(1)(a)(i) to be found in the Basic Proposal. The acceptance of an implicit indication that the registration of a mark was sought was advantageous for the applicant. She did not see any disadvantages on the side of the Office and sought further clarification on the proposal.

383. Mr. GHORBANI (Islamic Republic of Iran) said that the acceptance of implicit indications would cause vagueness and insecurity. He gave the example of a situation in which the applicant simply called the Office in order to express his wish to register a mark.

384. Mr. SHORTHOUSE (United Kingdom) said that the inclusion of the word “implicit” was particularly useful with regard to less experienced users of the application system. He gave the example of an applicant who wrote to the Office and requested to “patent the name” of his or her company. In such a case, the Office of the United Kingdom would take that as being an indication that the applicant wished to seek a trademark. The delegate believed that this practice might not fall within the definition proposed by the Delegation of the Islamic Republic of Iran. For this reason, he expressed his concern over the proposal.

385. The CHAIR indicated that it may be harsh to exclude an applicant if the wish to apply for a trademark registration clearly transpired from what he submitted to the office.

386. M. PIAGET (Suisse) dit qu’il est entièrement convaincu par l’exemple qui a été donné par la délégation du Royaume-Uni. Il estime en effet que si l’on en venait à supprimer cet élément “ ou implicite ” dans la proposition de base, cela reviendrait à dire que même si le titulaire réunit l’ensemble des conditions qui sont mentionnées dans l’alinéa, ou que l’on peut déduire de toutes les circonstances que l’on a à faire à une requête, cela voudrait dire que l’office ne pourrait pas attribuer une date de dépôt de par le simple fait que le mot “ requête ” ou “ demande ” n’est pas expressément mentionné dans la demande du titulaire. Le délégué est d’avis que cette condition est extrêmement formaliste et qu’elle est non seulement contraire aux intérêts des utilisateurs, mais qu’elle est vraisemblablement également contraire aux intérêts des offices qui devraient contrôler à chaque fois de manière formelle si le mot “ demande ” ou “ requête ” est expressément mentionné dans le cadre de la demande. C’est pourquoi il dit que sa délégation soutient la position qui est exprimée de manière claire par la délégation du Royaume-Uni.

387. Mr. AHLGREN (Sweden) expressed support for earlier interventions in favor of the present wording of Article 5(1)(a)(i) to be found in the Basic Proposal. He said that, if anything, he could agree on deleting the words “express or implicit” altogether.

388. Mr. GHORBANI (Islamic Republic of Iran) wondered about a situation in which the Office would receive only the indications reflected in Article 5(1)(a)(i) and (iii) and would seek to clarify the situation on the telephone.

389. The CHAIR pointed out that an Office was free to require all six indications listed in Article 5(1)(a).

390. Mr. KHAN (Pakistan) underlined the importance of obtaining a filing date also in countries in which rights in a trademark could be acquired by use. He said that the word “implicit” in Article 5(1)(a)(i) implied some discretion for the Office. It was in the interest of the applicant to make an express statement. This would enhance security in favor of the applicant.

391. M. REQUENA (France) dit que tout comme les délégations qui se sont exprimées avant lui, notamment la délégation de la Suisse et de la Suède, sa délégation est également favorable au maintien de la mention “implicite” qui figurait déjà dans la version de 1994. Effectivement dans le domaine des dépôts de marques,

il indique que l'expérience qu'ils en ont c'est que cela touche une population qui n'est pas toujours familiarisée avec le droit de la propriété intellectuelle et qui parfois utilisent une formulation qui ne correspond pas exactement aux termes qu'aurait choisis un spécialiste. Quoiqu'il en soit, il rappelle qu'il y a les autres dispositions qui figurent dans l'article 5.1)a) et notamment l'indication d'une marque, d'un signe, l'indication d'une liste de produits ou services. Par conséquent il estime qu'il existe une série d'éléments qui en règle générale permettent de déduire assez aisément qu'une marque est demandée. En effet, si une entreprise demande de breveter son nom en indiquant un signe, une liste de produits, etc., il pense qu'on peut déduire assez facilement qu'en réalité ce qu'elle cherche à protéger c'est un nom de marque. Cela lui paraît implicite, c'est pourquoi il est d'avis que la version initiale doit être conservée.

392. The CHAIR pointed out that, so far, no delegation had given an example of difficulties which it had experienced with regard to the acceptance of implicit statements.

393. Mr. ARBLASTER (Australia) pointed out that the Office in Australia had worked with the language used in the Basic Proposal for about 10 years. Even though Australia had a very high level of people who were not represented before the Office, the national experience in Australia had not shown any difficulties with the acceptance of implicit indications. He encouraged countries which were developing their systems also to allow private individuals and companies to represent themselves before the Office because, in the experience of Australia, that had been very successful. Often people seeking a trademark simply did not know to use the correct technical terms. In his view, these people should not be deprived of rights simply because they did not manage to find the right words. He therefore expressed support for the wording to be found in the Basic Proposal which included implicit indications.

394. Mr. RAGAB (Egypt) held the view that, in the normal course of events, an application contained an express indication of the wish to apply for the registration of a mark. Sometimes, however, misleading words were used by the applicant, such as the words "patent a trademark". In these cases it may be difficult to clarify whether the applicant sought the registration of a mark. However, general requirements remained, such as the payment of the required fee. The delegate said that it might be considered to omit both the term "express" and the term "implicit". In consequence, a general requirement to indicate the wish to register a mark remained. It would also be possible to keep Article 5(1)(a)(i) as presented in the Basic Proposal.

395. The CHAIR felt that there was broad support for the text contained in the Basic Proposal. He saw little need for a change. He said that, for the time being, he wished to leave open the issue raised by the Delegation of the Islamic Republic of Iran. He drew the attention of Main Committee I to the proposal made by the Delegation of South Africa with regard to Article 5(2)(a) which was reproduced in document TLT/R/DC/15.

396. Mrs. SUNKER (South Africa) explained that, frequently, there was a difference between the date on which the payment was made and the date on which

the money was finally received by the Office. Her Delegation preferred to refer to the date on which the required fees were finally received by the Office.

397. Mr. HÖPPERGER (WIPO) recalled that the system established by the Revised TLT should be user-friendly. The requirement that fees had to be received by the Office was stricter for the applicant. Particularly at the end of a time limit, it may be essential to satisfy payment requirements promptly. The Office had the possibility to trace back payments it received to the day of the bank transfer instead of only checking whether it finally received the fee.

398. Mr. ARBLASTER (Australia) gave the example of a check. When this mode of payment was used, the money was already paid to the Office but not yet received because the bank transfer had to be made first.

399. Mr. WARDLE (New Zealand) expressed a preference for the word “paid” for the reasons explained by the honorable delegate from Australia. In his view, it was necessary to be sure that the money had been paid. The acceptance of, for example, a personal check carries the risk that the check may not be honored by the person’s bank and, therefore, the fee would not be paid.

400. Mr. KHAN (Pakistan) wondered how somebody could be said to have paid the fees before the Office received the money. He therefore was of the opinion that the word “received” should be used in Article 5(2)(a).

401. Ms. BERESFORD (United States of America) stressed that the language used in the Basic Proposal stemmed from the TLT. In her view, it was much more advantageous for the applicant to require payment instead of receipt, particularly on the last day of the priority period.

402. Mr. AYALOGU (Nigeria) expressed his concern about payment modalities which implied money transfers. He proposed to combine the text in the Basic Proposal with the proposal by the Delegation of South Africa and adopt the wording “until the required fees are paid and received”.

403. The CHAIR said that the proposal made by the Delegation of the Islamic Republic of Iran with regard to the word “implicit” in Article 5(1)(a)(i) had not received sufficient support from the Committee. He felt that, similarly, the proposal by the Delegation of South Africa to use the word “received” in Article 5(2)(a) had not received substantial support. He therefore wondered whether the text of the Basic Proposal could be retained.

404. Mr. GHORBANI (Islamic Republic of Iran) indicated that further internal consultations would be necessary before proceeding further on the issue of the acceptance of implicit statements under Article 5(1)(a)(i).

405. Mr. BISEREKO (Uganda) stressed that there was a fundamental difference between the term “paid” and the term “received”. He supported use of the word “paid” as contained in the Basic Proposal.

406. Mr. OMOROV (Kyrgyzstan) said that, in view of the discussion on different payment modalities, Article 5(2)(a) should be kept as presented in the Basic Proposal. As to the question of including implicit statements under Article 5(1)(a)(i), he expressed support for the suggestion by the Delegation of Egypt to delete both the term “express” and the term “implicit”. It should be sufficient that the applicant asked for the registration of a mark.

407. The CHAIR concluded that the word “paid” in Article 5(2)(a) would be retained. The consideration of the proposal made by the Delegation of the Islamic Republic of Iran would continue once the Delegation had had the opportunity to finalize its internal consultations.

408. The CHAIR adjourned the meeting.

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Article 13: Duration and Renewal of Registration

409. The CHAIR suggested to deal with the proposal made by the Delegation of the Islamic Republic of Iran on Article 13(2), as stated in document TLT/R/DC/19.

410. Mr. GHORBANI (Islamic Republic of Iran) said that his proposal consisted on making item (i) optional or deleting it. He believed that any reproduction or other identification of the mark could be required under national law. This idea was supported by paragraph (3) which required that evidence be furnished to the office in case of reasonable doubt.

411. Ms. BERESFORD (United States of America) clarified that the purpose of the provision was to make absolutely clear that as part of the renewal process, a reproduction or copies of the mark could not be required. She believed that this provision had posed no particular problem for countries that were members of the TLT. And indeed, the fact that the minimum requirements for renewal allowed a country to require that the application or registration number be identified seemed to be sufficient for purposes of a maximum list of requirement at the time of renewal. She believed that this explicit provision saying that no reproduction of the mark could be required was one that addressed some problems in the renewal processes of some countries.

412. Mr. PARKES (FICPI) supported the views expressed by the Delegation of the United States of America said that from a user’s point of view, it would certainly be a step backwards if removal of this phrase was to create the impression, that a reproduction of the mark could be required at renewal. Presently, many renewal

systems operated by the use of data processing systems and that is part of the modern way of handling trademarks matters. This facilitated the system in countries around the world and it would certainly be undesirable if the Conference took a step backwards in that respect. He expressed his preference to maintain the phrase remains. He suggested that the Drafting Committee look at the question of replacing the word, “reproduction” by “representation” in this particular sub-paragraph.

413. Mme VENIŠNIK (Slovénie) dit que sa délégation souhaite également que le texte soit maintenu en l'état et ajoute qu'ils sont d'avis que supprimer cet alinéa serait un retour en arrière. À titre d'exemple, elle dit qu'il est parfois arrivé à leur office de recevoir la reproduction au moment du renouvellement de la part des titulaires de marques, sans que cela leur ait été demandé. Dès lors, leur office connaît parfois de grandes difficultés parce que les titulaires leur envoient une marque tout à fait différente, où bien les titulaires qui ont une série de marques n'ont pas de bonnes archives, ou bien encore ne savent pas très bien quelle marque est arrivée à terme. Elle ajoute que dans ces cas de figure il leur fallait contacter les titulaires et cela prenait du temps.

414. M. REQUENA (France) dit que sa délégation est pour le maintien du texte en l'état. Il ajoute que comme d'autres délégations l'ont exprimé avant lui, ce serait un retour en arrière que de revenir à cette disposition et de permettre à un office d'exiger une reproduction d'une personne qui souhaite simplement effectuer un renouvellement de sa marque. Il indique que dans le cas de la France le numéro de la marque suffit à l'identifier et que la reproduction n'ajoute strictement rien, voire amène des confusions comme l'a souligné la délégation de la Slovénie. Il conclut en disant une nouvelle fois que sa délégation est favorable au maintien de cette disposition.

415. Mr. RAGAB (Egypt) considered that this matter should be discussed in connection with Article 8 because there was a close connection between the two provisions.

416. Mr. CARLSON (Sweden) supported the views expressed by the Delegations of France, Slovenia, the United States of America and the Representative of FICPI.

417. M. PIAGET (Suisse) dit qu'ainsi que l'ont exprimé plusieurs délégations, notamment les délégations de la Suède, de la France, de la Slovénie, et enfin le représentant de la FICPI, il est d'avis qu'il convient de maintenir la disposition dans le cadre du traité. Il souligne que l'office dispose de toutes les conditions nécessaires pour définir précisément l'objet de la requête. Il peut notamment exiger toutes les dispositions de l'article 13, alinéa premier, lettre a), et il est ainsi en mesure d'avoir toutes les précisions qu'il désire afin qu'il n'y ait aucun doute sur l'objet de la requête. Il conclut en disant qu'il est d'avis que la disposition dont il est question doit être conservée dans le traité révisé.

418. Ms. MORGADO (Brazil) expressed the view that in some countries like Brazil, the trademark files were not scanned and the reproductions of the marks had very poor quality. In the occasion of renewal, the office could collect a better copy or reproduction of the mark.

419. The CHAIR noted that for the purposes of renewal, it seemed sufficient to indicate the registration number.

420. Mr. ARBLASTER (Australia) said that the provision under consideration would not prevent the Office in Brazil to require a better copy of the reproduction at any other time. The treaty only said that a reproduction may not be required as a prerequisite for renewal. It was in the interest of the Office and of the users to have a clear reproduction. In addition, he noted that the provision prevented the renewal from hanging on the reproduction of the mark and said that he supported retaining the provision.

421. The CHAIR noted that there had not been a substantial support for the proposal made by the Delegation of the Islamic Republic of Iran. A very large number of delegations had expressed that the text of the Basic Proposal, which was identical to the TLT 1994 should not be changed.

422. Mr. GHORBANI (Islamic Republic of Iran) said that he respected the position of developed country offices, which had good trademark office files. However, in the Islamic Republic of Iran, the office required the reproduction upon renewal. He asked to keep the discussion open until the arrival of other members of his delegation.

423. The CHAIR noted that this Article could be considered as dealt with and could be sent to the Drafting Committee, it being understood that the discussion could continue once the Delegation of the Islamic of Iran was complete.

Rule 9: Relief Measures in Case of Failure to Comply with Time Limits

424. The Chair then turned to Rule 9 and recalled that a proposal had been submitted by the Delegation of New Zealand in relation to paragraphs (1) to (3), and a further proposal had been submitted by the Delegation of Japan, in relation to paragraph (4).

425. Mr. WARDLE (New Zealand) said that his Delegation proposed to amend paragraphs (1)(i), (2)(i) and (3)(i). He explained that each of those sub paragraphs provided that a Contracting Party may require that the request for relief contain only an identification of the requesting party and the time limit concerned. The amendment proposed by the Delegation of New Zealand was designed to tighten the language and clarify what a Contracting Party may require. In particular, giving more information on the relevant application or registration number to which the request related. It was also relevant to identify the name. He noted, that other provisions in the TLT, such as the request for correction of a mistake (Article 12), change of address (Article 10), change of ownership (Article 11), and recordal of a license (Article 17) all provided that the Contracting Party could require the requesting party to identify the application or registration number in question, the name and address of the requesting party and the name and address of any representatives.

426. Ms. SCHMIDT (Germany) said that the practice in her office was to identify most requests with their identification number. She noted that the other elements proposed by the Delegation of New Zealand might not be necessary.

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427. M. REQUENA (France) dit que la proposition faite par la délégation de Nouvelle-Zélande attire sa sympathie à priori. Effectivement, il dit qu'il semblerait que les éléments indiqués facilitent l'identification de la demande pour laquelle une demande de sursis est formulée et facilite donc le traitement de cette demande dans des délais assez rapides. Dès lors, il fait savoir que sa délégation soutiendra cette demande.
428. Mr. AHLGREN (Sweden) supported the views expressed by the Delegations of France and Germany. He noted that, for the sake of clarity, it was justified to require the application and registration number. However, any additional requirements might be burdensome.
429. Mr. KHAN (Pakistan) held the view that the wording of the provision "identification of the requesting party" was sufficient because the identification could not be done without the number, the name and address of the applicant. He was nevertheless ready to discuss the wording proposed by the Delegation of New Zealand.
430. Ms. BERESFORD (United States of America) concurred with the views expressed by the Delegation of Pakistan and supported the proposal to require the identification number only.
431. Mr. ULLRICH (Austria) believed that if the office required the identification of the requesting party and the identification of the time limit concerned, this information would cover the registration number or address. He expressed sympathy for the proposal made by the Delegation of New Zealand because its formulation was clear and flexible and also associated himself with the positions of Germany and the United States of America.
432. Mr. WARDLE (New Zealand) said that following the proposal made by the Delegation of Germany, he could propose to tighten the language of his proposal to read that a Contracting Party may require the request to "specify the application or registration number concerned".
433. The CHAIR concluded that there was consensus that the office should require the registration or application number only and to send this part of the proposal to the Drafting Committee. He then asked the Delegation of Japan to present its proposal.
434. Mr. TASHIRO (Japan) explained the proposal by the Delegation of Japan, as contained in document TLT//R/DC/13. He said that the proposal consisted in including a reference to Article 14 as a whole in Rule 9(4)(i) in order to exclude the possibility of double relief. He noted the difference between the optional relief in paragraph (1) and the mandatory relief in paragraph (2). He also noted that the meaning of this Article was that Contracting Party provided at least one measure in paragraph (2) in case of the failure to comply with the time limit. He added that although they agreed on this idea, it was difficult to understand why Article 14 required double relief. He mentioned that according to the basic proposal, even the case where the Contracting Party already had allowed a relief measure under

paragraph (1), the Contracting Parties were required to grant another relief measure under paragraph (2). He also mentioned that in the last session of SCT, many delegations had not considered the situation as double relief. The delegation believed, when we think of the matter of double relief, the Office should take into account whether or not, the relief measure had already been accorded as stipulated in paragraph (1). He mentioned that some countries provided for long periods of relief if the measure was requested before the expiry of the time limit. He also mentioned that Rule 12(5) of the Patent Law Treaty (PLT) excluded the possibility to grant additional relief, regardless of whether or not the request was filed before the expiry of the time limit. Therefore, it was necessary to change the reference in Rule 9(4)(i) to cover the whole of Article 14.

435. Mr. ARBLASTER (Australia) and Mr. WARDLE (New Zealand) supported the proposal made by the Delegation of Japan, to the effect that no double relief should be granted.

436. Mr. PARKES (FICPI) said that, from the user's point of view, the situation considered in Article 14(1) and in Rule 9(4) did not amount to double relief. Article 14(1) dealt with a request made prior to the expiry of the time limit and a routine extension of time recognized in many countries. He considered that obtaining that extension of time was a fairly a straight forward procedure that effectively set a new due date for the action which was required.

437. He noted that Article 14(2) dealt with a different category of measures which were the relief measures after the expiry of a time limit. The principle behind these provisions was that one of those options should be available to the requesting party if there was some event which caused the time limit to be missed. So, this was relief available in an emergency situation, which did not constitute double relief because the date had already lapsed. He considered that, if the proposal by the Delegation of Japan was accepted, where a routine extension had already been granted and due to an emergency, the extended date was missed, none of the three options under Article 14(2) would be available. He believed that, from a user's point of view, it would be regrettable if the amendment suggested by the Delegation of Japan were accepted.

438. Mr. CARLSON (Sweden) associated himself with the comments made by the Representative of FICPI. The amendment proposed would indeed have the effect described by the Representative.

[Suspension]

Rule 9: Relief Measures in Case of Failure to Comply with Time Limits

439. Mr. WAKIMOTO (Japan) said that he took note of comments from several delegations that the users' needs were duly taken care of and added that he shared these views in a sense, but he pointed out that we should also recognize that users can be divided into two categories. He explained that we had applicants who made filings in the first place and also had lots of applicants who wish to similar marks to be registered but filed on later date. He showed the sympathy with the concern from the

later type of users' view point, concerning double relief, because later applications were not processed until proceeding applications had been examined. This delegation believed that the balance of interests between these different types of users should be duly taken into consideration.

440. The CHAIR returned to the consideration of the proposal made by the Delegation of Japan with regard to Rule 9(4)(i).

441. M. REQUENA (France) remercie la délégation du Japon pour ses explications supplémentaires et dit qu'il comprend la motivation de cette proposition qui est principalement d'éviter que la procédure ne se prolonge indûment lorsque des mesures de sursis ont déjà été accordées. Toutefois pour les raisons exprimées par le délégué de la FICPI, il dit qu'il ne peut soutenir cette proposition. En effet, il lui semble qu'il y a une différence de nature essentielle entre les mesures de sursis selon qu'elles sont accordées avant ou après l'expiration du délai. Bien souvent l'entreprise qui se trouve dans une situation de désorganisation ne peut obtenir rapidement une mesure de sursis. Elle peut à la limite obtenir une prorogation d'un délai mais ne peut obtenir une prorogation après délai. Il faut donc avoir la possibilité d'un rétablissement des droits. Il dit qu'en France para exemple, il est possible bien souvent d'obtenir une prorogation du délai si cela est demandé avant l'expiration du délai qui est en général assez court, de deux mois. Il ajoute que si au cours de cette prorogation l'entreprise se trouvait dans une grave situation de désorganisation et qu'elle ratait le nouveau délai prorogé, il est d'avis qu'il serait tout-à-fait normal, s'il en était justifié, qu'elle puisse bénéficier d'une mesure de rétablissement des droits. Par conséquent il lui semble que les deux dispositifs doivent être maintenus et que le simple fait qu'une mesure de sursis avant expiration du délai soit prévue ne saurait empêcher le recours à des mesures de rétablissement après expiration du délai. Il conclut en disant que sa délégation ne soutient pas la proposition du Japon.

442. M. PIAGET (Suisse) dit que la délégation suisse comprend tout-à-fait les préoccupations et l'origine de la proposition de la délégation du Japon. Cependant, il est convaincu par les explications qui ont été données par la France et par le délégué de la FICPI. Par ailleurs, il souhaiterait mettre en évidence un problème concernant la structure même de l'article 14 qui pourrait entraîner la proposition de la délégation du Japon. En effet, il précise que le système de l'article 14 consiste à obliger les Parties contractantes à prévoir au minimum une mesure parmi les trois qui sont énumérées à l'article 14, alinéa 2), soit au minimum une mesure après l'expiration du délai. Il note que l'article 14, alinéa premier, n'a lui pas de caractère contraignant mais qu'il a pour seul but de rappeler aux États qui prévoient une mesure de sursis avant l'expiration du délai que leurs droits et leurs pratiques ne sont pas affectés par cet article. Dès lors, il dit qu'intégrer l'article 14, alinéa premier, dans le renvoi de la règle 9.4), aurait donc l'effet suivant : une Partie contractante pourrait n'accorder aucune mesure de sursis après l'expiration du délai si une mesure a déjà été accordée avant l'expiration du délai. Autrement dit, l'article 14, alinéa premier, qui consiste pourtant en un simple rappel, permettrait aux Parties contractantes de ne prévoir aucune des mesures de l'article 14, alinéa 2), alors que précisément cet article oblige à prévoir au minimum une mesure de sursis. Le délégué dit qu'il espère avoir expliqué de manière suffisamment claire le problème de structure auquel on pourrait être confronté en allant dans la direction qui a été esquissée par la délégation du Japon.

443. The CHAIR recalled that Main Committee I had already approved the structure of Article 14. He pointed out that the provision was presently under consideration in the Drafting Committee. He underlined that Article 14(1) concerned the situation before the expiry of a time limit. If a Contracting Party adopted the optional relief measure outlined in Article 14(1), then this Contracting Party would still be obliged to implement one of the mandatory options enumerated in Article 14(2). It was his understanding that the Delegation of Japan sought to introduce an exception to the application of Article 14(2).

444. Ms. ASPERGER (Austria) expressed a preference for the present wording of Rule 9 as contained in the Basic Proposal.

445. Mrs. COLEMAN-DUNNE (Ireland) said that she appreciated the intervention by the Delegation of Japan. Nevertheless, she felt that the proposal by the Delegation of Japan would bring about a substantial change. For this reason, she was in favor of the text contained in the Basic Proposal. The option outlined in Article 14(1) was independent of the options described in Article 14(2). In her view, the option before the expiry of a time limit and the set of options after the expiry of a time limit should be viewed individually.

446. La Sra. ROAD D'IMPERIO (Uruguay) dijo que su delegación también quería manifestarse en que valoraba las preocupaciones de la Delegación de Japón pero entendía que el Artículo 14 y la Regla 9, número 4, de la manera que estaba redactada era la correcta. Señaló que su delegación tuvo la oportunidad de estar en las reuniones del SCT que fueron sobre ese punto muy complejas y compartía lo expresado por el Delegado de la FICPI. Indicó que la estructura del Artículo 14 era diferente en sus numerales 1 y 2. Efectivamente, el numeral 1 hacía relación a las medidas de subsanación antes de la expiración de un plazo que era facultativo para las Partes Contratantes, mientras que el Artículo 2 del numeral 14 hablaba de las medidas de subsanación una vez que había expirado el plazo y obligaba a la legislación de las Partes Contratantes. Subrayó que el texto en español decía “dispondrá de una o más de las siguientes medidas de subsanación enumeradas a continuación”. Por lo que, según la delegada de Uruguay, si la Regla 9.4) se aplicara a todo el conjunto del Artículo 14 y no solo al 14.2) aquello daría la posibilidad de que se aplicara el primer numeral 1, y la Parte Contratante no tendría porqué prever ninguna de las medidas dispuestas en el Artículo 2. Para concluir indicó que la propuesta tal como estaba redactada era la correcta según su delegación.

447. Mrs. VESTERGAARD (Denmark) said that she understood the concern expressed by the Delegation of Japan. She pointed out that Article 14(2) was of particular importance to the users of the trademark system. This had clearly been shown by a questionnaire which Denmark had distributed among users. For this reason, she supported the wording of Rule 9 to be found in the Basic Proposal.

448. Mr. SHORTHOUSEL (United Kingdom) expressed support for the intervention by the Delegation of Uruguay. He thanked the Delegation of Japan for discussing the matter with members of his delegations during the break.

449. Mr. RAGAB (Egypt) said that he fully supported the retention of the original text in the Basic Proposal.

450. Mme. MINOR (Communauté européenne) dit que la délégation de la Communauté européenne préfère le maintien du texte de la règle 9 tel qu'il est actuellement rédigé pour les raisons exprimées en particulier par la FICPI, les délégations de la Suisse, de la France et de l'Uruguay.
451. Mr. TOPIĆ (Croatia) said that, even though appreciating the proposal by the Delegation of Japan, he wished to support the text in the Basic Proposal.
452. Mrs. CLETO (Portugal) expressed support for the text of Rule 9 in the Basic Proposal.
453. Mr. RICHARDS (AIPLA) said that, even though sympathizing with the proposal by the Delegation of Japan, he lent his support to the position taken by the representative of FICPI and the retention of the original text in the Basic Proposal.
454. Mr. WAKIMOTO (Japan) recognized that there was a majority within Main Committee I which was in favor of the text of the Basic Proposal. He emphasized that international cooperation was of particular importance to Japan. He said that, therefore, he would withdraw the proposal made by the Delegation of Japan with regard to Rule 9(4)(i).
455. The CHAIR thanked the Delegation of Japan for its cooperation.
456. Mr. ARBLASTER (Australia) recalled that his Delegation had seconded the proposal made the Delegation of Japan. He indicated that he would like to keep open the possibility of further proposals.
457. Mr. WARDLE (New Zealand) said that his Delegation had also supported the proposal by the Delegation of Japan. He stated that he accepted the consensus on keeping the text of the Basic Proposal.
458. The CHAIR adjourned the meeting.

Ninth Meeting Tuesday, March 21, 2006 Afternoon and Evening

459. The CHAIR pointed out that Main Committee I had made good progress with respect to the Rules but there were still several Articles pending, namely Articles 4, 5, 6, 8 and 11.

Article 4: Representation; Address for Service

460. He drew the attention of Main Committee I to document TLT/R/DC/10 which contained a proposal relating to Article 4(1)(a) made by the Delegation of China. He recalled that this proposal had already been under consideration in Main Committee I. On the basis of the discussion in the Committee, interested delegations had consulted with each other to present a compromise solution to Main Committee I.

461. Mr. HÖPPERGER (WIPO) explained that, following the introduction of proposal TLT/R/DC/10 by the Delegation of China and the subsequent debate in Main Committee I, a number of interested delegations had engaged in informal consultations to come up with a compromise proposal. The wording that resulted from these consultations concerned Article 4(1)(a)(i) and referred likewise to the right of a representative to practice before the Office and to the admission to practice before the Office. The proposed amendment to Article 4(1)(a)(i) would read as follows: "...have the right, under the applicable law, to practice before the Office in respect of applications and registrations and, where applicable, be admitted to practice before the Office". He explained that, on the basis of this compromise proposal, the current text contained in the Basic Proposal would be supplemented with the words that had been added after "registrations".

462. The CHAIR added that, on its merits, the compromise proposal merged the text of Article 4(1)(a)(i) of the Basic Proposal and the original proposal made by the Delegation of China, as reflected in document TLT/R/DC/10. In consequence, Article 4(1)(a)(i) would first state a general principle and then point out a more specific situation. He clarified that the compromise proposal would substitute the written proposal in document TLT/R/DC/10.

463. Mr. ARBLASTER (Australia) wondered about the intent and effect of the new draft provision. In particular, he sought clarification on whether this new Article 4(1)(a)(i) would allow an Office to require that a representative have the right to practice under the applicable law and, in addition, be admitted to practice. The question was whether the two requirements in the proposed new Article 4(1)(a)(i) would apply cumulatively or alternatively.

464. Mr. WARDLE (New Zealand) recalled the earlier intervention made by his Delegation in respect of the original proposal by the Delegation of China, as

reproduced in document TLT/R/DC/10. New Zealand was concerned to ensure that the wording of Article 4(1)(a)(i) did not set forth any implicit or explicit requirement for a country or an intergovernmental organization joining the Revised TLT to require their trademark agents or representatives to be regulated in such a way that they had to be admitted to practice before the Office. He said that the proposed new wording was not ideal, but in respect of what had originally been tabled, his Delegation was prepared to accept this drafting. The record of the meeting should show that the intent of Article 4(1)(a) was not to require Contracting Parties to regulate representatives.

465. The CHAIR emphasized that the second part of the compromise proposal which had been added to Article 4(1)(a)(i) of the Basic Proposal made it clear that the requirement of admission to practice would only come into play “where applicable”. The addition had been made to accommodate the concerns which had been expressed earlier by the Delegation of China.

466. Mr. ARBLASTER (Australia) indicated that he was not sure whether the provision had the effect which the Delegation of New Zealand sought to avoid. He said that, to reach agreement on Article 4, it seemed necessary to supplement the requirement that the representative should have the right to practice before the Office, which was reflected in the Basic Proposal, with express mention of the possibility to require that a representative should be admitted to practice before the Office. He emphasized that, as the Delegation of New Zealand had already pointed out, this latter optional requirement, in any case, should not impose any obligation on a Contracting Party to regulate the profession of trademark representatives. He said that, if this was the intent underlying the compromise text that had been read out by the International Bureau, then this compromise text could be taken as a basis for the work of the Drafting Committee. The new text that had been added after the word “registrations” should be seen as text in brackets for the time being. The intent of the provision, however, should be settled in Main Committee I.

467. The CHAIR informed Main Committee I that the Delegation of China indicated its agreement with this way of proceeding further. He concluded that the Drafting Committee would be asked to review Article 4 and draft language that would accurately reflect the intent of Main Committee I.

Rule 10: Requirements Concerning the Request for Recordal of a License or for Amendment or Cancellation of the Recordal of a License

468. The CHAIR opened discussion on Rule 10. He drew the attention of Main Committee I to document TLT/R/DC/19 which contained a proposal by the Delegation of the Islamic Republic of Iran concerning Rule 10(2)(a), (3)(a) and (4).

469. Mr. GHORBANI (Islamic Republic of Iran) said that, as a result of internal consultations, he wished to withdraw the proposal concerning Rule 10(2)(a), (3)(a) and (4).

470. The CHAIR wondered whether Rule 10 could be sent to the Drafting Committee.

471. Mr. PARKES (FICPI) pointed out that the content of certain of the Model International Forms had been incorporated into Rule 10(2)(a)(ii), (3)(a)(ii) and (4)(ii). It was his understanding that the content of the Forms was part of the Rules. He therefore expressed the hope that Main Committee I or the Drafting Committee would have the chance to review the Forms, particularly with regard to those new parts of Rule 10 which he had mentioned. He explained that these Forms were not contained in the TLT but had been newly prepared for the fourteenth session of the SCT. In consequence, they had not been scrutinized.

472. The CHAIR suggested sending Rule 10 together with the corresponding Model International Forms to the Drafting Committee in order to allow the Drafting Committee to review the Forms and remedy any deficiencies in view of the content of Rule 10 or any other provisions in the Treaty and the Regulations.

473. Mr. TASHIRO (Japan) felt that Rule 10(1)(b) may be difficult to apply. The scope or object of an amendment was not clear because it may be affected by the legal system of the Contracting Party concerned. He gave the example of a legal system in which the change of a certain item listed in Rule 10(1)(a) would not be considered as an amendment. Instead, a request for the cancellation of a license and a new recordal of license might be needed. He therefore sought to clarify that the scope or object of an amendment depended on national law.

474. Mr. HÖPPERGER (WIPO) clarified that Rule 10 did not seek to define the concept of amendment or cancellation. This was left to national law. Once a certain request fell within the scope of an amendment or cancellation pursuant to the applicable national law, however, the relevant procedures set out in Rule 10 would be applicable.

475. Mr. OMOROV (Kyrgyzstan) proposed to include in paragraph (1)(b)(i) a reference to the indication contained in item (1)(a)(xii), because a request for amendment or cancellation of the recordal of a license should also indicate whether the license concerns only a part of the territory and to determine that part of the territory.

476. Mr. HÖPPERGER (WIPO) said that perhaps the concerns expressed by the Delegation of Kyrgyzstan were addressed by subparagraph (b)(ii), which made a general reference to all the indications contained in paragraph (a), and therefore, item (xii) would be included.

477. Mr. OMOROV (Kyrgyzstan) said that he could agree with the explanations given by the International Bureau.

478. The CHAIR thanked the Delegation of Kyrgyzstan for its cooperation and comprehension. He concluded that Rule 10 could be sent to the Drafting Committee together with the Model International Forms.

[Suspension]

479. The CHAIR indicated that, having held informal consultations with those Delegations that had made proposals with regard to Article 11, he intended to send the Article to the Drafting Committee.

480. Mrs. KIRIY (Russian Federation) sought clarification on the proposal made by the Delegation of the Islamic Republic of Iran with regard to Article 11(1)(b), as reproduced in document TLT/R/DC/19.

481. The CHAIR clarified that informal consultations with the Delegation of the Islamic Republic of Iran had led to the result that the Delegation no longer wished to uphold its proposal with regard to Article 11(1)(b). The same applied to the related proposals by the Delegation of the Islamic Republic of Iran concerning Rules 3(4)(b) and Rule 10(2)(a), (3)(a) and (4) which were also contained in document TLT/R/DC/19. He concluded that Article 11 could be sent to the Drafting Committee.

Article 6: Single Registration for Goods and/or Services in Several Classes

482. The CHAIR turned to the consideration of the proposal which the Delegation of OAPI had made with regard to Article 6, as reproduced in document TLT/R/DC/7.

483. M. YACOUBA KAFFA (OAPI) dit que l'article 6 est identique à l'article 6 qui figure dans le traité existant. Il ajoute qu'il en est tout-à-fait conscient mais qu'il ne faudrait pas considérer leur proposition comme étant un recul par rapport au traité existant. Il indique que bien que les contextes diffèrent quelque peu, il croit cependant que l'objectif recherché par tous c'est qu'un grand nombre d'Etats adhère au traité révisé. A cet effet, il dit qu'il faudrait pouvoir rassurer tous les éventuels adhérents à ce traité et pour cela il faut tenir compte d'un certain nombre de systèmes dans lesquels on n'admet pas l'enregistrement pour un seul signe comme étant une marque de produits et de services. C'est la raison pour laquelle ils ont inclus deux versions différentes dans leur proposition. Dans la première version ils proposent une légère modification de l'intitulé de l'article qui passe donc de "un seul enregistrement pour des produits ou des services relevant de plusieurs classes" à "possibilité d'un seul enregistrement pour des produits ou des services relevant de plusieurs classes".

484. Dans la deuxième version qu'ils proposent le titre est maintenu en l'état et l'article 6 est repris tel quel. Il souligne toutefois qu'ils ont proposé l'insertion d'un second alinéa qui donne la possibilité à une Partie contractante de ne pas appliquer l'obligation d'un enregistrement unique afin de pouvoir accepter le dépôt d'un signe pour des services et un dépôt pour des produits. Il indique qu'ils ont pris l'exemple de l'article 5.2)b), mais à l'envers, en disant qu'une Partie contractante peut ne pas appliquer cette obligation si avant son adhésion au présent traité elle possédait un enregistrement pour les classes de produits et un enregistrement pour les classes de services. Il dit que le fait de répéter "un enregistrement pour les classes de services et un enregistrement pour les classes de produits", était tout à fait utile pour clarifier les choses, et précise encore une fois qu'ils ne pensent pas qu'il s'agit d'un recul. Ils pensent plutôt qu'il fallait tenir compte de ce que tout le monde a accepté lors des déclarations liminaires et générales, à savoir qu'il fallait plus de souplesse et plus de

flexibilité. Il est d'avis que les deux versions proposées sont suffisamment flexibles et qu'elles tiennent compte de l'ensemble des préoccupations tant du secteur privé que des offices et des États.

485. Mr. BISEREKO (Uganda) expressed support for the first version presented in the proposal by the Delegation of OAPI with an amendment. He suggested deleting the words “according to the legislation of the Contracting Party”.

486. Mr. KHAN (Pakistan) held the view that the text of Article 6 of the Basic Proposal could hardly be reconciled with the division of an application and registration for which Article 7 provided. He believed that a “may” provision in Article 6, as envisaged in the first version of the proposal by the Delegation of OAPI, would contribute to solving the problem.

487. Mr. RAGAB (Egypt) said that he had examined the proposal by the Delegation of OAPI and supported the first version set out in document TLT/R/DC/7. He believed that the wording of the first version would leave sufficient flexibility for Contracting Parties.

488. Ms. SCHMIDT (Germany) underlined that the proposal by the Delegation of OAPI required making a choice between flexibility and harmonization in trademark law. She stated that her Delegation preferred harmonization and the retention of the text contained in the Basic Proposal.

489. The CHAIR noted that the text in the Basic Proposal was identical to the text of Article 6 of the TLT.

490. Ms. SUNKER (South Africa) supported the first version presented in the proposal by the Delegation of OAPI. She felt that the “may” provision would give offices more flexibility in terms of how to handle the registration number as well as priority dates.

491. Ms. BERESFORD (United States of America) pointed out that the first version presented in the proposal by the Delegation of OAPI would give the possibility to continue a single class registration system. The second version would require multiple class registrations for goods and multiple class registrations for services but not for combinations of goods and services. She recalled that the TLT sought to achieve multiple class registration systems in the interest of users. Under a multiple class registration system, users had to file documents only one time for all classes in the multiple class registration when it came to the renewal of a mark, a change of name or address, or a change in ownership. Users of a single class registration system had to file multiple documents when there was a renewal, or a change in ownership, name or address, to cover all single class registrations that had been issued to them.

492. The delegate stressed that the purpose of the language used in the Basic Proposal, which stemmed from the TLT, was to provide users with a more efficient way of acquiring and maintaining trademark rights. She said that the Office of the United States of America had accepted multiple class applications and registrations for many years. This practice had not posed particular difficulties to the Office. She recalled that, in the context of the TLT, the issue of single class registrations had lead

to the adoption of a transitional provision laid down in Article 22(1) of the TLT. She felt that this solution may also be appropriate in the present context. It would allow offices to maintain a single class system for a certain period of time. However, there would also be a requirement to phase out the system at a certain point.

493. M. KONE (Burkina Faso) dit que sa délégation soutient la première variante de la proposition de l'OAPI. Il indique en effet qu'étant donné l'état actuel de leur législation ils sont conscients des difficultés qu'ils vont rencontrer, mais qu'il ne perd cependant pas de vue l'excellente idée qui a été soulevée par la délégation des États-Unis.

494. Mr. KHAN (Pakistan) held the view that the word "shall" in Article 6 of the Basic Proposal contradicted Article 3(2) specifying that "one and the same registration may relate to several goods and/or services". The word "may" in Article 3(2) did not correspond to the word "shall" in Article 6.

495. Mr. HÖPPERGER (WIPO) clarified that the word "may" in Article 3(2) was a "may" from the point of view of the applicant. The applicant may decide whether the application should relate to one or several goods or services but not the Office. The multiple class application system would result from Article 3(1). He explained that the provision which was now reflected in Article 6 of the Basic Proposal had always been understood in this sense.

496. Mr. TOPIĆ (Croatia) expressed support for the intervention made by the Delegation of the United States of America. It corresponded to the very purpose of Article 6 to set forth a "shall" provision. Otherwise, the Article was not needed altogether.

497. Mr. DOUCAS (New Zealand) expressed support for the text of the Basic Proposal. He stated that a transitional provision modeled on Article 22 of the TLT would be acceptable for his Delegation.

498. La Sra. ROAD D'IMPERIO (Uruguay) dijo que su delegación entendía que la redacción que estaba en la propuesta básica, que coincidía con el TLT de 1994, era la que debía mantenerse, y añadió que su delegación concordaba en que podría tratarse de una cláusula provisoria como lo había expresado la Delegación de Estados Unidos, a efectos de atender las preocupaciones de la Organización Africana de la Propiedad Intelectual. Indicó que en su país también tuvieron las solicitudes múltiples en el pasado y que fue muy complicado no sólo para los usuarios sino también para la oficina. Por lo que desde su punto de vista el sistema propuesto era mucho más ventajoso y eficaz para ambos interesados.

499. Mr. CARLSON (Sweden) recognized the concerns of OAPI and those Delegations who had expressed their support for the proposal. He said that, nevertheless, an amendment in line with the proposal by the Delegation of OAPI would be quite a step backwards. As the Delegation of the United States of America had pointed out, a way forward would be to include the proposal in a transitional provision.

500. Mr. ARBLASTER (Australia) expressed support for a transitional provision, as proposed by the Delegation of the United States of America.

501. Ms. ASPERGER (Austria) was in favor of a transitional provision.

502. Mrs. POWER (Canada) lent her support to a transitional provision. She said that Article 6 of the Basic Proposal should be maintained as it was.

503. El Sr. EKUAGA MUAÑACHE (Guinea Ecuatorial) dijo que su delegación estaba de acuerdo con la primera propuesta presentada por la OAPI. En cuanto a la segunda propuesta, quería hacer ver que toda esa visión estaba relacionada con la exigencia de su instrumento jurídico. Concluyó diciendo que, como lo habían dicho otras delegaciones, se podía llegar a una salida siempre y cuando se atiendan su reocupaciones.

504. El Sr. ARELLANO QUIROZ (Chile) hizo presente que según lo que estaban viendo, la propuesta decía en inglés, en un caso “shall” y en otro caso “may”. Pero señaló que en la versión en español, en ambos casos, estaba traducido como obligatorio, ya que el texto decía “dará”. Por lo tanto sugirió que en la primera versión del Artículo 6 propuesto debería corregirse la traducción para que fuese facultativo. También observó que parecía ser que se estaba interpretando el Artículo que estaban discutiendo como si hubiera una distinción entre un sistema monoclasa y un sistema multiclase. A su juicio, lo que decía el Artículo era que se podría dar un registro para productos y un registro para servicios. Es decir, que tendrían un registro con las 34 clases de producto o se podía dar un registro con las 11 clases restantes de servicios. A su parecer, aquello también podía ser útil y no ir en contra de los solicitantes por cuanto si, por ejemplo, la solicitud tuviese una oposición en materia de servicio, permitiera dar entre tanto el registro de productos sin tener que esperar que se resolviera la oposición de servicio, y viceversa. Aclaró que lo que quería hacer presente era que tal vez con esa visión también podían encontrar un punto de consenso para esa norma.

505. Mr. AYALOGU (Nigeria) said that the African Group was of the view that the proposal made by the Delegation of Benin reflected the concerns of African countries. He called upon the Delegation of OAPI to consider in which way the proposal could be ameliorated in order to pave the way for its adoption.

506. The CHAIR summarized that the proposal by the Delegation of OAPI had been endorsed by several delegations. These delegations had expressed a preference for the first version presented in the proposal. Other delegations had stated that the text of the Basic Proposal should be retained. As a compromise, it had been proposed to add a transitional provision. He wondered about how to proceed further in this regard.

507. M. YACOUBA KAFFA (OAPI) dit qu’il a attentivement écouté les réactions de tous les intervenants et constate qu’ils ont reçu le soutien d’un certain nombre de pays. C’est pourquoi il n’est pas d’accord avec le résumé fait par le Président lorsqu’il dit “un grand nombre qui considère”. Il croit en effet qu’un grand nombre considère que le texte actuel est satisfaisant mais remarque surtout qu’un grand nombre souhaite aussi que les préoccupations qu’ils ont exprimées soient prises en

compte. Il précise qu'il s'agit aussi bien de ceux qui leur ont apporté leur soutien que de ceux qui ont adhéré à la suggestion qui a été faite par le délégué des États-Unis. Le délégué demande alors au Président que la discussion en cours soit ajournée jusqu'au lendemain, afin qu'il puisse consulter Yaoundé et qu'il puisse leur faire part des différentes propositions. Il dit qu'il sera alors en mesure de déposer une nouvelle version qui prendrait en compte pratiquement tout ce qui a été dit à la présente session du comité.

508. The CHAIR expressed gratitude for the responsive intervention by the Delegation of OAPI. He concluded that consensus had not yet been reached. Main Committee I would revisit the issue once further consultations would permit to continue the discussion.

Article 8: Communications

509. The CHAIR turned to Article 8. He drew the attention of Main Committee I to the proposal made by the Delegation of South Africa with regard to Article 8(1) which had been reproduced in document TLT/R/DC/15.

510. Ms. SUNKER (South Africa) said that, pursuant to Article 8(1) of the Basic Proposal, 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. In consequence, a Contracting Party may choose to exclude communications or any registration on paper. She expressed the view that such an exclusion would be problematic for developing countries which, at this time, did not have the capabilities to file electronically. According to the proposal by the Delegation of South Africa, Article 8(1) would read: "any Contracting Party may accept communications in electronic form or any other form of communication, provided that communications in paper form shall always be accepted by Member States."

511. The CHAIR reiterated that, in the present context, the degree of computerization of national offices around the world – whether in developed or developing countries or least-developed countries – was not at issue. The issue was the question of how a person, which might be a natural person or a legal entity, could apply for and acquire a trademark registration abroad, if Member States, according to Article 8(1) of the Basic Proposal, were free to choose the means of transmittal of communications to the effect that, at one point in time, they could choose to exclude applications on paper. He recalled that, in past discussions, several delegations had expressed the desire to retain Article 8(1) of the Basic Proposal. At the same time, these delegations had indicated that, for the time being, they accepted applications on paper. Nevertheless, they would feel uneasy if they would be bound to still accept communications on paper in five, ten or fifteen years time.

512. Mr. BISEREKO (Uganda) said that he supported the proposal by the Delegation of South Africa for the reasons given by that Delegation. He was of the opinion that the proposal did not bind Contracting Parties who wished to introduce any form of communication. It only offered sufficient flexibility for all Member States.

513. The CHAIR noted that the word “shall” in the proposal seemed to indicate a binding obligation.

514. La Sra. ROAD D’IMPERIO (Uruguay) dijo que su delegación quería reiterar una vez más que estaba de acuerdo con la disposición tal cual estaba presentada en la propuesta básica. Añadió que se entendía que dicha disposición tenía la flexibilidad necesaria para facultar a las Partes Contratantes a elegir los medios de transmisión que sean necesarios a los efectos de ello, es decir, que las Partes Contratantes eran soberanas en decidir cómo se les presentaban las solicitudes en su país. Indicó que era preciso recordar que este punto ha sido uno de los objetivos de esta revisión del TLT de 1994, y que había que tener presente los avances tecnológicos que habían tenido lugar en las comunicaciones en el ámbito de la comunidad internacional.

515. Mr. MIAH (Bangladesh) expressed support for the proposal by the Delegation of South Africa. He held the view that the proposal would not change the substance of the provision but open more possibilities.

516. La Sra. MENJIVAR CORTÉS (El Salvador) dijo que quería reiterar que El Salvador deseaba que se mantuviera el Artículo tal y como se encontraba en la propuesta del proyecto debido a que dicho Artículo les brindaba la flexibilidad que El Salvador estaba buscando.

517. El Sr. CONSTENLA ARGUEDAS (Costa Rica) dijo que al igual que Uruguay y El Salvador, Costa Rica deseaba indicar que consideraba que el texto que estaba establecido en la propuesta original presentaba la flexibilidad necesaria y permitía que cada país escogiera la forma en la que iba a aceptar las comunicaciones al respecto.

518. Mr. KHAN (Pakistan) held the view that electronic filing could take offices towards automation and scientific progress. He felt that each country in the world was trying to move ahead in this regard. He was concerned that the wording of Article 8(1) of the Basic Proposal may be detrimental to this purpose and supported the proposal by the Delegation of South Africa.

519. The CHAIR clarified that offices in developing countries were free to choose the means of communications. The issue was whether advanced offices should be obliged to still accept paper filings from abroad. The question concerned the digital divide between applicants and not between offices.

520. La Sra. SÁNCHEZ TORRES (Cuba) dijo que su delegación reiteraba su apoyo a la propuesta de la Delegación de Sudáfrica.

521. Mr. MTESA (Zambia) recalled that his Delegation had already supported the proposal by the Delegation of South Africa when it had first been introduced. He was of the opinion that the proposal was helpful especially with regard to developing countries and, in particular, the least-developed countries. He therefore reaffirmed the support of his Delegation for the proposal by the Delegation of South Africa.

522. Mr. MEJÍA GUEVARA (Honduras) recognized that both the Basic Proposal as well as the proposal by the Delegation of South Africa had certain merits. He also

recognized that electronic means of communication were important for enhancing efficiency and effectiveness. In this regard, however, the Delegation of Honduras still wished to reserve its position in order to reconcile the two different points of view and address the concerns of all countries.

523. M. YACOUBA KAFFA (OAPI) dit qu'il estime que la proposition faite par la délégation de l'Afrique du Sud est tout-à-fait heureuse et tient compte de diverses préoccupations. Il ajoute que lorsqu'ils demandent que les Parties contractantes acceptent des communications sur papier, il ne s'agit aucunement d'un refus de progresser ou d'aller vers les technologies nouvelles. Il estime simplement qu'il y a certaines étapes à franchir au préalable et qu'il faut leur laisser du temps. Il note que si par exemple, demain un pays développé comme les États-Unis ou le Canada n'adopte que le système du dépôt électronique et qu'un étranger veuille faire un enregistrement il lui faudra alors passer par un mandataire. Cependant il reste persuadé qu'il faut toujours réserver la possibilité d'effectuer des dépôts sur papier. A titre d'exemple il dit qu'à l'heure actuelle tout le monde se sert d'une carte de crédit mais que les banques ne refusent pas les chèques pour autant. Il suppose que dans tous les offices il y a quand même des formulaires à remplir même si c'est de façon électronique. Il conclut en disant une nouvelle fois qu'il estime que la proposition de l'Afrique du Sud est tout-à-fait heureuse et mérite d'être prise en compte.

524. Ms. LIEW (Singapore) underlined that the present text, as reflected in Article 8(1) of the Basic Proposal, offered flexibility to allow a Contracting Party to determine the means of communication that were appropriate for that Contracting Party. At the same time, the text contained in the Basic Proposal allowed Contracting Parties to respond to progressive changes in their regime brought about by technological developments. As an objective of the Revised TLT was to update the TLT of 1994, Main Committee I should be careful not to lock itself in a position that may become outdated in the future.

525. Mr. AYALOGU (Nigeria) informed Main Committee I that the proposal by the Delegation of South Africa had been considered within the African Group and had been deemed meritorious, especially in view of the flexibility that it offered to applicants. He recalled that the Chair had clarified at the outset of the present discussion that the issue was not the degree of computerization of the trademark office but how a natural person or a legal entity could apply for the registration of a particular mark abroad. At a certain point in time, Member States may choose to exclude applications on paper. It was the belief of the African Group that the proposal by the Delegation of South Africa offered enough flexibility to accommodate the likelihood or the possibility that certain individuals may not gain access to electronic filing as a mode of communication. It ensured that the option of paper applications would be retained. This was very important. The African Group felt that the digital divide implied that certain individuals or entities could not gain access to means of electronic filing. For this reason, the option of paper applications and communications should not be excluded but be retained.

526. Mr. TOPIĆ (Croatia) asked for an example of the detrimental effect which the wording of the Basic Proposal was believed to have.

527. Mr. REN (China) supported the proposal made by the Delegation of South Africa. If a State accepted only filings in electronic form, applicants in less developed countries or countries lacking sufficient technical means might encounter difficulties. In his opinion, the proposal by the Delegation of South Africa was quite flexible and took into consideration the wider needs of a large majority of countries.

528. Mr. RAGAB (Egypt) recalled the discussion on the Patent Law Treaty. He said that, in fact, there had been the same controversy, the same proposals and the same views. Irrespective of these difficulties, it had been possible to establish a text which responded to the concerns of developing countries. The proposal by the Delegation of South African did not prevent the most developed countries from accepting communications in electronic form. It did not prevent developing countries from accepting communication in electronic form either. However, it took into consideration the reality and the different levels of technology

529. The delegate pointed out that it would pose substantial difficulties if all developing countries had to accept communications in electronic form from day one, particularly with regard to applications. For this reason, he believed that the proposal by the Delegation of South Africa was flexible. It took into account the interests of all countries and responded to all their concerns in a very realistic way. He stated that the Delegation of Egypt supported the proposal by the Delegation of South Africa and called upon all developing countries and least-developed countries to support the proposal as well.

530. Mr. WARDLE (New Zealand) expressed support for the text contained in the Basic Proposal and the intervention made by the Delegation of Singapore. The Revised TLT sought to allow Contracting Parties to take advantage of the benefits and opportunities that new technologies could provide. The Delegation of New Zealand considered that a Contracting Party should not be bound long into the future to provide paper registration processes for trademarks. This would deny the opportunity to take advantage of the efficiency and cost savings that could be achieved for both trademark applicants and trademark offices through the use of new technologies.

531. M. MARKOVIĆ (Serbie-et-Monténégro) dit que sa délégation pense que le texte qui se trouve dans le document de base est assez flexible et qu'il permet à chaque pays de choisir le mode de communication qui est le plus approprié à son stade de développement technique.

532. M. AMEHOU (Bénin) dit que l'on ne peut pas arrêter le progrès mais que changer les habitudes, cela prend du temps. Aussi est-il d'avis que pour donner du temps à ceux qui ne disposent pas de moyens technologiques avancés, il vaut mieux s'en tenir à la proposition de l'Afrique du Sud. C'est pourquoi sa délégation soutient la proposition de l'Afrique du Sud.

533. M. KONE (Burkina Faso), indique que sa délégation soutient fermement la proposition qui a été faite par l'Afrique du Sud et qu'il ne reviendra pas sur toutes les raisons qui ont déjà été très brillamment exposées par ses prédécesseurs. Il dit qu'il a écouté avec beaucoup d'attention certaines délégations qui ont parlé notamment des objectifs de cette révision qui consiste à profiter des nouvelles technologies, ce qui est tout à fait juste selon lui. Il ne pense pas que la délégation de l'Afrique du Sud

ignorait cet objectif lorsqu'elle a formulé sa proposition. Il dit qu'une chose est de vouloir effectivement profiter des technologies dont on dispose et qu'une autre est de prendre des précautions pour que la révision proposée n'ait pas pour conséquence celle de mettre de côté un nombre important de pays qui souhaitent prendre part effectivement au champ d'application qui est ouvert par cette convention.

534. Il pense que si de telles précautions ne sont pas prises le risque est d'obtenir un résultat contraire à celui qui était initialement recherché. Il ajoute en effet que si une grande adhésion est recherchée, il paraît souhaitable que les préoccupations des uns et des autres soient prises en compte. Il conclut en disant que sa délégation soutient sans réserve la proposition qui a été faite par l'Afrique du Sud.

535. Mr. AL-MOHAMMED (Iraq) considered the original text contained in the Basic Proposal to be confusing. It stipulated that a Contracting Party may accept different means of transmittal. In consequence, there were different means of accessing offices. The text, however, did not specify in which way communications could be received. He held the view that, if a country accepted communications in paper form but received communications in electronic form, there would be some sort of conflict. It would therefore be preferable to specify not only the means of receiving communications but also the means of transmittal in Article 6.

536. Ms. BERESFORD (United States of America) expressed her understanding that there was agreement that the current text did not require any office to accept applications filed electronically. The current text allowed any office to continue to receive paper or any other means that it chose for the filing of applications. She felt that this point was clearly understood. In her view, the concern seemed to be for applicants who were unable to file. She expressed doubt about this particular concern for a number of reasons. All applicants who filed into the Office of another country had to comport with a number of provisions. They had to file in the language of the Office, they had to pay in the currency of the Office, and they frequently had to consult a local agent in order to file. She underlined that any applicant filing to another country was obliged to meet these requirements.

537. The delegate said that, if a country also chose to have applications only filed electronically, then this would be only one additional requirement that the applicant had to fulfill along with the currency requirement, the language requirement and the requirement to get a representative. All of these latter requirements would continue to be in force under the national laws of the various Contracting Parties. She felt that there was a risk of losing sight of the general situation because of the focus on electronic filing requirements in the present context. Applicants filing from one country to another would still need to meet the specific national filing requirements of the country to which they were sending their application. Although a number of delegations had emphasized the flexibility of the proposal by the Delegation of South Africa, it was very clear to her that the proposal was not flexible in that it implied that an office had to accept paper forever. She failed to see how this approach could be regarded as flexible. It was her concern that the provision in the proposal was not understood completely by everyone. She indicated that the only way forward was a transitional "sunset" provision which could ensure that the obligation to continue to accept paper ended at a certain date. The requirement to accept paper definitely had to end at a certain point.

538. Mr. OTIENO-ODEK (Kenya) stressed that the principle of territoriality had to be considered in the context of Article 6. He recalled that Article 1 provided definitions of the “Office” and the “Contracting Party”. It was his understanding that, when an application was accessing a Contracting Party, it had to go through the process outlined by the Delegation of the United States of America. The application was passed on to the Office by agents if national law required representation in this regard. He held the view that the proposal by the Delegation of South Africa was applicable to this process. In the case of an office requiring communications to be in electronic form, however, the local agent could convert the application into the appropriate electronic format. He felt that this would create a different scenario concerning the Contracting Party rather than the Office. In his view, it was important to consider this particular difference in the context of discussing Article 6.

539. Mr. ANDIMA (Namibia) said that the present discussion had to be seen in the context of the proposal made by the Delegation of Nigeria on behalf of the African Group, as contained in document TLT/R/DC/20 Rev. He recognized the explanation given by the Delegation of the United States of America. He noted that paper filing should come to an end one day. However, it was his belief that this end could only be achieved on the basis of the objectives set out in the proposal made by the Delegation of Nigeria on behalf of the African Group. On this understanding, he expressed support for the proposal by the Delegation of South Africa.

540. El Sr. CONSTENLA ARGUEDAS (Costa Rica) dijo que su delegación deseaba incluir otra idea que podía favorecer el planteamiento de que se mantuviera la propuesta original del Artículo 8. Desde su punto de vista se podía considerar que en el Artículo 8 original iba de la mano el desarrollo tecnológico con el desarrollo sostenible. Ese concepto era muy importante en los países en desarrollo y el delegado lo planteó en el siguiente sentido: la posibilidad de contar con mecanismos electrónicos permitía una mayor protección al medio ambiente en el sentido que si todos los países estuvieran obligados a mantener el formato en papel, eso implicaba a nivel ambiental una destrucción de sistemas ecológicos al tener que talarse árboles para seguir manteniendo el formato del papel. En ese sentido, dijo que Costa Rica deseaba reiterar su apoyo al Artículo 8.

541. Mr. SUNILA (Finland) pointed out that administrative reforms may take place on a broad horizontal basis and not only in respect of one particular Office, such as the trademark Office. Finland had enacted legislation which promoted the use of electronic communications between citizens and the administration. This legislation applied to all public sectors and bodies including the trademark Office. He clarified that the legislation to which he was referring did not set forth a requirement to use electronic communications. It only sought to promote the use of electronic communications.

542. The delegate explained that, for his Delegation, it would be very difficult to make commitments in the area of trademark law which could become obstacles to administrative reforms that may take place on a more horizontal basis in the foreseeable future. For this reason, he held the view that the present wording of the basic proposal should be retained. He indicated that a transitional provision, as outlined by the Delegation of the United States of America, could also be considered.

543. Mme KADRI (Algérie) indique que sa délégation s'est déjà exprimée à travers le Groupe des pays africains en ce qui concerne l'article 8, et qu'elle considère que la proposition faite par l'Afrique du Sud apporte une amélioration par rapport au texte de base et tient compte de l'évolution des moyens des offices et de la réalité actuelle. Dès lors, elle conclut en disant que sa délégation la soutient fermement.

544. Mr. JOSEPH HARLLEY (Ghana) supported the proposal by the Delegation of South Africa. He underscored the point that most developing countries did not have the means to introduce electronic filing systems.

545. Mr. NGINGA (Congo) dit que sa délégation a examiné attentivement le texte contenu dans la proposition de base ainsi que la proposition de l'Afrique du Sud. Il constate que les deux propositions permettent d'utiliser les formes modernes de communication qui existent à ce jour. Il note cependant que la proposition de l'Afrique du Sud offre une certaine primauté à l'utilisation des communications sur papier, ce qui est d'ailleurs l'usage habituel dans son pays étant donné que les modes de dépôt de demandes d'enregistrement de marques par voie électronique sont peu développées au Congo. Pour cette raison, et pour les autres raisons évoquées par les délégations africaines, il dit que son pays soutient la proposition de l'Afrique du Sud.

546. Mr. ARBLASTER (Australia) pointed out that the provision resulting from the present discussion would have to be effective in practice. In Australia, as in most countries, it was of no value to have a trademark unless the trademark holder sold goods in the country. Typically, the sale of goods required a distribution chain or a business in the country. He also pointed out that, in some countries, use of a mark was a prerequisite for its registration. If a mark was not used in Australia, for instance, in the course of a commercial activity carried out by the holder or a distributor, the mark could be removed from the register.

547. The delegate stressed that, as the Delegation of Uganda had clarified, a person filing overseas, typically, would go through an agent in the country concerned because a business relationship with the country had already been established. An agent in the country, however, could be expected to understand the requirements applied by the Office and be able to meet them. Accordingly, an applicant could communicate in paper to an agent, for instance, in Australia. The agent could then communicate electronically with the Office. It was his understanding that Article 6 of the Basic Proposal was not intended to provide for the possibility of a Contracting Party to regulate communications with an agent in a way that an agent would refuse to accept paper. Article 6 only related to whether a Contracting Party would regulate communications with its Office.

548. He wondered whether some language would allow that issue to be made clear in the text of the Revised TLT and whether this might help to address some of the concerns that had been expressed by delegations. He clarified that his Delegation supported the text of the Basic Proposal but also understood the concerns of developing countries. He felt that, in any case, it would be necessary to find a solution which did not only create a chimera giving the impression of meeting concerns. By contrast, useful assistance was needed.

549. Mrs. JUNUS (Indonesia) recalled that a simpler and more effective and efficient trademark system was the main objective of the Revised TLT. She expressed support for Article 8, as contained in the Basic Proposal, because applicants from countries which were not quite advanced with regard to communication systems would be assisted by representatives in the countries where the registration of a trademark was sought.

550. La Sra. RÍOS DE DAVIS (Panamá) dijo que su país se encontraba en una fase de adecuación legislativa para permitir la presentación electrónica de solicitudes y que lo que estaban haciendo era proponer tarifas diferenciadas más bajas para la presentación electrónica, precisamente porque ese era el medio de transmisión que deseaban estimular. Aclaró que su oficina pensaba mantener ambos sistemas de presentación. Por consiguiente, dijo que su delegación estaba conforme con la propuesta básica pero con la variante propuesta por la Delegación de Estados Unidos respecto a la posibilidad de una cláusula transitoria que permita la extensión de la transmisión en formato papel cuando así lo deseaba una oficina, logrando así flexibilidad para los miembros.

551. El Sr. KAHWAGI RAGE (México) dijo que México era un país en vías de desarrollo y que sin embargo siempre había sido muy neutral en su actuación dentro de los Comités del SCT y en este Comité. Sin embargo le llamaba la atención el que la propuesta de Sudáfrica tratara de limitar a las oficinas que reciben solicitudes de registro de marca en su forma de actuar o de recibir o de archivar las mismas solicitudes. En su opinión la disposición era flexible y tal y como estaba no obligaba a nadie a recibir solicitudes en papel ni a recibir solicitudes por vía electrónica. Por lo que, desde su punto de vista, obligar a que sigan recibiendo solicitudes en papel a aquellos países que ya estaban en posibilidades de solamente recibir solicitudes electrónicamente, se le hacía ventajoso. Señaló que la oficina mexicana, al igual que muchas oficinas, crecía varios metros cuadrados al día precisamente debido a la cantidad de papel que era presentada en las solicitudes, por lo que ese mismo año estarían ya implementando la solicitud electrónica en vías de que en un futuro solamente esa sea la vía de recepción. Por consiguiente dijo que su delegación sostenía el apoyo a que la propuesta básica del TLT se quedara tal y como estaba la original. Añadió que en caso de que la preocupación de Sudáfrica y de los demás países en vías de desarrollo o poco desarrollados fuera que sus ciudadanos tuvieran la posibilidad de presentar solicitudes en esas oficinas el proponía lo siguiente: en lugar de tratar de imponer a esas oficinas que sigan recibiendo solicitudes en papel, el propuso que esas oficinas permitieran la presentación de solicitudes proporcionando en sus instalaciones el equipo y la asistencia necesaria para que los usuarios pudieran presentar solicitudes. Eso es que dentro de las mismas instalaciones de las oficinas se contara con equipo de cómputo o demás para que las personas que no tuvieran acceso en dado caso a presentar solicitudes electrónicas, lo hicieran. Según el, eran los países menos desarrollados los que más perdían al no tener solicitudes electrónicas porque México sí podía presentar una solicitud por vía electrónica a Estados Unidos por ejemplo. Pero Estados Unidos, para presentar una solicitud en México tenía que trasladarse a la ciudad de México y presentar la solicitud en papel. Subrayó que le estaba costando mucho más trabajo a ese ciudadano americano presentar la solicitud que a un mexicano presentándola en vía electrónica. Por lo cual concluyó diciendo que era muy ventajoso el no permitir ese desarrollo y solamente pensar en que no tenían desarrollo de cómputo en sus oficinas.

552. Mr. ULLRICH (Austria) expressed support for the text contained in the Basic Proposal and the interventions from those Delegations that were in favor of the Basic Proposal. He stated that a transitional provision would also be acceptable.

553. M. BELFORT (Haïti) dit que la délégation haïtienne réitère son appui à la proposition de l'Afrique du Sud, non pas par réticence au changement mais parce qu'elle tient compte des spécificités de tous les groupes et notamment du groupe des PMA auquel elle appartient.

554. M. MABONZO (Congo) dit qu'il a attentivement suivi les débats de part et d'autre, qu'il s'agisse des pays développés comme des pays en développement. Il rappelle que dans sa première intervention il avait indiqué que la fracture numérique était très importante et que les pays en développement connaissaient de grandes difficultés. Il ajoute cependant qu'il sait pertinemment que l'objectif visé par la révision du présent traité est de réduire les importantes masses de papier que les offices utilisent et d'utiliser des moyens plus performants.

Il dit que la proposition faite par les États-Unis de disposer d'une clause transitoire lui paraît la plus indiquée parce qu'elle permettrait aux États qui ne disposeraient pas de moyens leur permettant de recevoir ou d'effectuer des dépôts par voie électronique, d'être néanmoins en mesure de mettre en œuvre le traité. C'est pourquoi il est d'avis que si le texte est maintenu en l'état, il faut trouver une clause transitoire pour permettre aux pays en développement de s'adapter au rythme du développement.

555. Mr. KARUNARATNA (Sri Lanka) said that his Delegation sincerely sympathized with the proposal made by the Delegation of South Africa which attempted to address the concerns of developing and least-developed countries alike. He also understood the concerns expressed by the delegations that favored maintaining the current provisions as they were. The Revised TLT, however, was intended to respond to technological developments. Therefore, a solution was needed that achieved a balance between these two approaches. He felt that, in consequence, a transitional period should be offered which allowed an office to deny the receipt of communications in paper if it so wished.

556. El Sr. RUBIO ESCOBAR (Colombia) dijo que su delegación apoyaba el texto tal y como fue presentado en la propuesta básica. Lo apoyaba porque la propuesta básica era equilibrada y mostraba flexibilidad en la medida en que era cada Estado el que escogía el medio de comunicación más acorde a su nivel de desarrollo. Es decir, que los países en vías de desarrollo podían escoger, mientras que tuvieran los recursos técnicos para adecuarse a los nuevos desarrollos tecnológicos, el papel como medio de comunicación o por el contrario el medio de comunicación electrónico. Indicó que en lo referente a sus usuarios, a ellos les convenía obviamente que los países desarrollados tuvieran el medio de transmisión electrónico. Por esa razón dijo que la delegación de Colombia consideraba que la propuesta básica mostraba suficiente flexibilidad y que era equilibrada, y a raíz de ello pedía a la plenaria que se aceptara la propuesta básica tal y como estaba presentada.

557. M. REQUENA (France) dit que sa délégation n'a pas de problème avec la proposition de base. Il estime qu'à la lecture de cette disposition, si la France veut ne jamais accepter les dépôts par voie électronique et si elle veut toujours imposer la voie

papier, elle pourra le faire. Il souligne qu'il n'y a strictement rien qui obligerait son pays à passer à la voie électronique dans la disposition en question. Il pense que c'est extrêmement important de le rappeler à tous les pays. En effet, tous les pays gardent la possibilité de choisir leur mode de communication, que ce soit la voie papier, la voie électronique, voire les deux s'ils le souhaitent. Dès lors, il est d'avis que les choses pourraient être clarifiées dans la disposition pour apaiser les craintes qui sont exprimées. Il note que certains pays semblent croire que leur office sera obligé d'ici quelques années à passer à la voie électronique, or il lui semble qu'il n'y a rien dans ce texte qui les y oblige. Il souligne que la seule question qui reste en suspens c'est le cas d'un dépôt transfrontalier où effectivement un national voudrait déposer dans un autre pays et que ce pays exigeait le recours à la voie électronique. Comme l'a rappelé et développé en excellents termes le délégué de l'Australie, il croit que c'est vraiment une hypothèse d'école si le national en question n'a pas dans le pays un agent, un représentant, ou s'il n'entend pas engager une activité commerciale dans ce pays. Il répète, comme l'a rappelé également la déléguée des États-Unis, que pratiquement tous les pays exigent le recours à un mandataire aux fins d'effectuer une élection de domicile dans le pays. Donc il lui semble encore une fois qu'il n'y a absolument rien dans le texte qui oblige un office à passer à la voie électronique, et c'est ce point de vue là que l'évocation d'une disposition transitoire lui pose des difficultés. En effet le délégué dit qu'il ne sait pas à quoi aboutirait une telle disposition, étant donné qu'elle semble sous-entendre que des pays qui sont actuellement soumis à la voie papier auraient un certain délai pour passer à la voie électronique. Or, ce n'est absolument pas à son sens l'objet de la disposition en question. Ou alors on entend qu'un pays qui actuellement imposerait la voie électronique tolérerait la voie papier pendant quelques années. Aussi, il dit que si les pays qui imposent actuellement la voie électronique sont prêts à tolérer cela, ils doivent le dire clairement. Il conclut en disant encore une fois que pour lui cette disposition n'impose absolument pas le recours à la voie électronique et que sa délégation soutient donc son maintien dans la proposition de base actuelle.

558. M. YACOUBA KAFFA (OAPI) dit qu'il semble y avoir un problème de communication entre les différentes délégations, puisqu'en effet il précise qu'ils ne pensent aucunement que cette disposition prétend leur imposer le mode de dépôt électronique. Ce qui les préoccupe est qu'il faudrait que le mode de communication papier soit maintenu dans les différents offices. A cet égard, il dit qu'il a un certain nombre de questions à poser aux différentes délégations des pays développés. Il voudrait préciser auparavant que le problème ne se pose pas tant pour les offices car, à l'heure actuelle, même si un office comme l'OAPI ne procède pas encore au dépôt électronique, ils ont les moyens de pouvoir développer suffisamment les applications informatiques pour accepter de tels dépôts dans le futur.

559. A la lecture de certaines dispositions tant du texte que du règlement, il souhaite poser un certain nombre de questions. En effet il note qu'à l'article 17, paragraphe 5, on parle de preuves : "Toute Partie contractante peut exiger que des preuves soient fournies à l'office lorsque l'office peut raisonnablement douter de la véracité d'une indication quelconque figurant dans la requête ou dans tout document visé dans le règlement d'exécution", c'est pourquoi il souhaite que le délégué de l'Australie et celui des États-Unis lui disent comment ils procèdent dans des ce type de cas. Il prend un exemple et dit que si demain un déposant OAPI, conformément à la Convention de Paris, veut faire un dépôt en Australie ou aux États-Unis en

revendiquant la priorité de son document antérieur, il voudrait savoir si le déposant OAPI devra fournir une copie scannée de ce document antérieur et si ce sera cette copie scannée que l'office canadien, australien ou américain acceptera. Cela, en dépit du fait qu'il est possible de faire de multiples manipulations par voie électronique, et notamment fournir un document qui pourrait ressembler à un document OAPI sans en être un.

560. Il répète qu'il ne pense pas qu'on veut leur imposer la voie uniquement électronique et note que l'article est clair sur ce point. Ce qui le préoccupe c'est de donner la possibilité aux Parties contractantes d'exclure totalement le dépôt ou toute communication quelle qu'elle soit sur papier. Cela serait à son sens tout-à-fait prématuré et pourrait être préjudiciable pour les déposants. Il ajoute qu'il ne fait aucun doute, comme l'a indiqué le délégué de l'Australie, que quelqu'un qui commerce avec les États-Unis ou bien avec l'Australie devra se soumettre à un certain nombre de procédures, mais comme il l'a déjà mentionné dans son exemple ce qui l'inquiète c'est l'hypothèse où une priorité est revendiquée ou bien lorsqu'il faut effectuer une inscription de licence si l'entreprise est basée dans un pays en développement où les moyens électroniques n'ont pas été développés. En effet il se demande comment elles pourraient fournir ces documents de façon électronique dans ce cas de figure.

561. Ms. SUNKER (South Africa) pointed out that she had listened with great interest to the arguments in favor of the proposal made by her Delegation which had been advanced by numerous supporting delegations. She had also taken account of the proposal by the Delegation of the United States of America to introduce a transitional provision. She indicated her desire to explore the substance of the proposals in the framework of informal discussions in order to find out whether agreement on the issue could be reached.

562. The CHAIR expressed gratitude for the cooperative and constructive approach indicated by the Delegation of South Africa. He felt that no further advancements could be achieved in Main Committee I and invited interested delegations to enter into informal consultations.

563. Mr. ARBLASTER (Australia) referred to the intervention made by the Delegation of OAPI. He explained that, in Australia, Article 17(5) would be handled in the way that an agent would communicate with the Office.

564. El Sr. MEJÍA GUEVARA (Honduras) dijo que su delegación había manifestado al principio su posición de reserva en el hecho de tener un consenso y, luego de oír las posiciones de varias delegaciones y escuchar cuidadosamente la propuesta de procedimiento hecha por Sudáfrica, indicó que su delegación también quería hacer una propuesta intermedia. La idea era de dejar el Artículo 8.1 tal como estaba y de agregar una disposición que establezca un período transitorio. Sin embargo, a pesar de lo manifestado, dijo que cualquier propuesta intermedia en ese sentido también sería problemática. Efectivamente, el período transitorio podía ser mucho tiempo para algunos países mientras que para otros podía ser poco tiempo. Señaló que por la experiencia que habían tenido otros países, inclusive países en desarrollo, con ese período transitorio sabía que había tomado su tiempo. El delegado opinó que la propuesta de Estados Unidos era aún mucho más flexible porque daba la

oportunidad de crear una disposición transitoria. Dijo que su delegación estaba en disposición de presentar esa propuesta el día siguiente.

565. Ms. SUNKER (South Africa) expressed gratitude for accommodating the proposal by the Delegation of South Africa.

566. The CHAIR adjourned the meeting.

Tenth Meeting Wednesday, March 22, 2006 Morning

Proposed new Article 1bis: Principles

567. The CHAIR drew the attention of Main Committee I to document TLT/R/DC/21 containing a proposal by the Delegation of the Islamic Republic of Iran to introduce a new Article 1bis in the Revised TLT which reflected certain principles.

568. Mr. GHORBANI (Islamic Republic of Iran) recalled that the opening declaration which his Delegation had made at the second meeting of the Plenary had laid an emphasis on the need for flexibility and a proper balance in the new Treaty. He explained that the proposal by the Delegation of the Islamic Republic of Iran, as presented in document TLT/R/DC/21, was based on these key notions. The proposal consisted of four parts.

569. First, the proposal sought to define the objective of simplification and facilitation underlying the Revised TLT. Second, while recognizing the process of simplification, there was a need to recognize that the aim of harmonization had to be subject to certain conditions. There was no intention to prevent the developed countries from meeting their technological requirements. Nevertheless, the developing countries and the least-developed countries needed some breathing space to be created by appropriate limitations and exceptions. In this vein, the second paragraph of the proposed new Article 1bis recognized not only the right of developed countries but also certain safeguards in favor of developing countries. The word “optionally” had been used in order to take account of the different levels of development with regard to information technology systems. Paragraph 2 of the proposal had a close interrelation with Article 2 of the Treaty as well as Article 25(2).

570. The delegate explained that paragraph 3 of the proposed new Article 1bis was closely related to the preceding paragraph 2. He pointed out that, recognizing the rights of developed countries on the one hand and safeguarding exceptions and limitations in the interest of developing countries on the other hand, the digital gap between these two groups of countries could be narrowed. The fourth paragraph of

the proposed text contained a suggestion on how to proceed in the context of implementing the Treaty.

571. In Main Committee II, it had been possible to arrive at a compromise solution with regard to Article 25(2). He felt that the principle expressed in paragraph 2 of the proposed Article *1bis*, therefore, had met with approval. The concern of the Delegation of the Islamic Republic of Iran with regard to harmonization had been accommodated by the compromise solution. He was confident that the optional nature of the Treaty would now remain. For this reason, he indicated that his Delegation did not see any further necessity of incorporating the new proposed Article *1bis* in the Treaty. He suggested that the proposed Article *1bis* should be taken into account in the course of the consultations on horizontal issues which were held by the President.

572. The CHAIR expressed gratitude for the explanations and the very reasonable suggestion by the Delegation of the Islamic Republic of Iran. He concluded that Main Committee I could pass on the proposal by the Delegation of the Islamic Republic of Iran which was contained in document TLT/R/DC/21 to the consultations on horizontal issues held by the President.

Proposal to insert a new Article

573. M. AMOUSSOU (Bénin) a dit que deux corrections mineures doivent être apportées à la version française du document TLT/R/DC/16 contenant la proposition des PMA pour la mettre en conformité avec la version anglaise. Il s'agit au paragraphe 1, ligne 2, d'insérer "mettront" au lieu de "mettent" en œuvre. Au paragraphe 2, ligne 1, les pays les moins avancés (PMA) lire plutôt "à renforcer" au lieu d'aider les pays les moins avancés "à développer leurs capacités".

574. Le délégué précise qu'ils n'ont pas de préférence pour l'endroit d'insertion de la proposition des pays les moins avancés dans le traité. Si le Président l'estime opportun, le délégué indique que celle-ci pourra être insérée en tant qu'article *26bis*. Il souhaite simplement qu'elle soit insérée dans le corps même du traité. Enfin, il souligne qu'un problème de délai a été évoqué par certaines délégations au cours de leurs consultations informelles. Il indique à cet égard que les pays les moins avancés n'ont pas voulu s'enfermer dans des délais pour marquer leur volonté de mettre en œuvre le traité. Leur présence massive témoigne de cette volonté. Ce qu'ils demandent, c'est l'appui nécessaire et la volonté politique de leurs partenaires pour cette mise en œuvre.

575. Il revient à la note explicative de leur proposition et indique que les pays les moins avancés (PMA) reconnus comme tels en 1971 par l'Organisation des Nations Unies regroupent aujourd'hui 49 pays dont 34 en Afrique, 9 en Asie, 5 dans le Pacifique et 1 dans les Caraïbes. Il dit que les quatre critères retenus en l'an 2000 par le Conseil économique et social de l'ONU pour établir la liste des PMA, sont :

1. critère de bas revenus, soit une moyenne du produit intérieur brut par habitant pendant trois années inférieur à 900 dollars US

2. critère de retard dans le développement humain basé sur un panel de données relatives à la qualité de vie, en apport en calories, santé, scolarisation, alphabétisation des adultes
3. critère de vulnérabilité économique basé sur un panel de données relatives à la vie économique (instabilité de la production agricole, instabilité des exportations de biens et de services, importance des activités non traditionnelles, concentration des exportations de marchandises, handicap créé par la petite dimension économique)
4. critère démographique : ne pas dépasser 75 millions d'habitants.

576. Il dit que le groupe des pays les moins avancés (PMA) voudrait sortir le plus rapidement de cette situation de vulnérabilité et invite par conséquent ses partenaires au développement à l'aide pour la réalisation des objectifs du millénaire pour le développement.

577. Il ajoute que les PMA se félicitent des initiatives qui ont été prises au cours de ces dernières années par l'OMPI, notamment à travers son directeur général, en vue de les aider à s'attaquer aux problèmes du développement, aux contraintes qu'ils subissent en les intégrant dans la culture de la propriété intellectuelle et dans l'économie mondiale au sens large. Par rapport au projet de traité révisé sur le droit des marques actuellement en cours de négociation, il indique que les PMA réaffirment leur sincère volonté de voir la présente conférence aboutir à l'adoption dudit traité dont ils entendent tirer le meilleur parti en qualité de Partie contractante mais également d'assumer pleinement les obligations qui en découlent. Il dit que c'est à la lumière de ce qui précède que les PMA ont soumis par le biais de la délégation du Bénin la proposition contenue dans le document TLT/R/DC/16 du 17 mars 2006 qu'ils souhaitent voir insérer dans les dispositions du projet de traité révisé sur le droit des marques.

578. En effet, il n'est possible de tirer pleinement parti du potentiel de la propriété intellectuelle sans créer simultanément au sein des PMA, des capacités dans les domaines et secteurs clé auxquels elle est liée. Il précise qu'il n'est point besoin de souligner que la signature et la volonté de mettre en œuvre le traité révisé ne sont pas seulement suffisants pour les PMA en raison des problèmes structurels et d'autres difficultés multiples qu'ils affrontent en dépit des politiques et mesures de réforme de grande portée que beaucoup de ces pays ont essayé de mettre en œuvre au cours de ces dernières années. C'est pourquoi ils en appellent à l'aide des pays développés en vue de renforcer leurs capacités administratives et institutionnelles pour mettre progressivement en œuvre le traité.

579. Il indique que l'aide attendue devra viser dans un premier temps, une évaluation des besoins des PMA et dans un deuxième temps, la mise en œuvre avec la coordination de l'OMPI de programmes adéquats permettant d'atteindre dans les meilleurs délais possibles les objectifs visés. Il conclut en remerciant au nom des PMA tous les pays en développement présents qui en tant que tels, appréhendent bien les problèmes spécifiques des PMA, les ont toujours soutenu et ne manqueront pas de soutenir les propositions soumises à l'appréciation de la conférence. Il remercie également les pays développés pour leurs actions en faveur des PMA.

580. Mr. AHMED (Bangladesh) reserved the right of his Delegation to give additional explanations with regard to the intervention by the Delegation of Benin.

581. The CHAIR indicated that the proposal would be dealt with at a later meeting of Main Committee I.

582. The CHAIR adjourned the meeting.

Eleventh Meeting Thursday, March 23, 2006 Morning

Article 5: Filing Date

583. The CHAIR recalled that Main Committee I still had to finalize its work on Articles 5, 6 and 8 as well as Rule 6. He pointed out that Article 5 had already been discussed in detail and informed Main Committee I that the pending proposal on Article 5(1)(a)(i), reproduced in document TLT/R/DC/19, needed no longer be considered by Main Committee I as a result of informal consultations.

584. In the absence of any further proposals on Article 5, the Chair concluded that the Article could be sent to the Drafting Committee.

Article 6: Single Registration for Goods and/or Services in Several Classes

585. The CHAIR turned to Article 6. He drew the attention of Main Committee I to document TLT/R/DC/7 containing a proposal by the Delegation of OAPI with regard to Article 6. He recalled that this proposal had already been discussed in Main Committee I. The discussion had led to informal consultations among interested delegations in order to explore common ground for a compromise solution.

586. M. YACOUBA KAFA (OAPI) rappelle que l'OAPI a exprimé des préoccupations en ce qui concerne l'article 6. Pour une meilleure prise en compte des différents points de vue, et suite à des discussions informelles qu'ils ont eues avec les différents groupes, il propose d'ouvrir la possibilité aux Etats membres ou aux organisations intergouvernementales d'émettre des réserves pour que les obligations découlant de l'Article 6 ne s'appliquent pas à eux.

587. A cet égard, il précise que la délégation de l'OAPI, étant donné que les discussions informelles se déroulent beaucoup plus souvent en anglais qu'en français, a demandé l'aide de certaines autres délégations pour la rédaction de sa proposition en anglais. Il indique que le délégué de l'Australie s'est proposé pour cet exercice et qu'il estime qu'ils ont abouti à une proposition qui pourrait totalement satisfaire

l'OAPI et les États qui n'ont pas un système d'enregistrement unique pour tous les types de classes. Le délégué de l'OAPI voudrait que le Président donne la parole au délégué de l'Australie afin que celui-ci puisse présenter la proposition rédigée en anglais.

588. The CHAIR expressed gratitude to all delegations who had participated in the constructive informal consultations. He explained that the compromise text, to which the Delegation of OAPI had referred, concerned the possibility of making a reservation with regard to the applicability of Article 6. For practical reasons and reasons of public international law, it was proposed to include the compromise text in the final and administrative clauses of the Revised TLT. Unlike the original proposal made by the Delegation of OAPI, the compromise text, accordingly, would not alter Article 6 but constitute an additional paragraph to Article 29. He recalled that a similar way of procedure had been followed in the case of the proposal made by the Delegation of Japan which was reproduced in document TLT/R/DC/6. He proposed that Main Committee I should take a decision on the substance of the proposed compromise text which would then first be sent to the Drafting Committee before being presented to Main Committee II for adoption.

589. The CHAIR read out the following paragraph to be added to Article 29: “[a]ny State or intergovernmental organization, whose legislation at the date of adoption of this Treaty provides for a multiple-class registration for products and for a multiple-class registration for services may, when acceding to this Treaty, declare through a reservation that the provisions of Article 6 shall not apply.”

590. Mr. WARDLE (New Zealand) stated that the Delegation of New Zealand gave its support to the intent of the wording read out by the Chair, namely to offer the possibility of a reservation to Article 6 in the particular circumstances reflected in the proposed compromise text.

591. Mr. OTIENO-ODEK (Kenya) expressed support for the compromise on Article 6 which would give the right of a reservation to any State or intergovernmental organization.

592. Mr. KHAN (Pakistan) expressed support for the compromise text which had been presented by the Chair. He wondered whether it would be necessary to refer to application/registration in the text.

593. The CHAIR said that the Drafting Committee would have a close look at the text.

594. Ms. BERESFORD (United States of America) indicated that her Delegation preferred the language in Article 6 which stemmed from the TLT. She clarified that the issues raised by the Delegation of OAPI in respect of Article 6 would be dealt with in the framework of a reservation to be included in Article 29. She pointed out that it was the understanding of her Delegation that this reservation was limited to those Contracting Parties which had two registers – one register for goods and one register for services. Her Delegation further understood that these Contracting Parties would allow for multiple class registrations within each of these two registers. This meant that applicants would still receive at the most two registrations, one for multiple classes of goods and one for multiple classes of services. She noted that two

registrations required more filings for the purposes of renewals or changes of address or changes of ownership. Two registrations, however, were preferable to forty-five registrations. On this understanding, she stated that her Delegation could accept the intent of the compromise. She thanked all delegations that participated in reaching this accommodation.

595. Mr. ENÄJÄRVI (Finland) indicated that his Delegation supported the compromise proposal on the same understanding as expressed by the Delegation of the United States of America.

596. The CHAIR expressed gratitude for the support which the compromise text had received. He concluded that the proposed text for an additional paragraph to Article 29 could be sent to the Drafting Committee.

Article 8: Communications

597. The Chair turned to Article 8. He informed Main Committee I that, in respect of this Article, two proposals were pending. The first proposal had been made by the Delegation of South Africa. It related to Article 8(1) and was contained in document TLT/R/DC/15. The second proposal was to be found in document TLT/R/DC/12. It had been made by the Delegation of the Ukraine and was related to Article 8(2). The Chair suggested to start with the first proposal concerning Article 8(1).

598. Ms. SUNKER (South Africa) recalled the original proposal by her Delegation that, under Article 8(1), any Contracting Party may accept communications in electronic form or any other form of communication, provided that communications in paper forms should always be accepted by Member States. She informed Main Committee I that informal consultations on this proposal had led to a compromise solution.

599. Ms. MTSHALI (South Africa) thanked Main Committee I for giving her Delegation the time to seek a durable solution to its concerns and those of many developing countries around Article 8(1) of the Basic Proposal. She expressed her gratitude to all delegations that supported the Delegation of South Africa. She recalled that Article 8 constituted one of the major reasons for convening the Diplomatic Conference. That was to enable the Revised TLT to respond to developments in information and telecommunication technology. She recognized that this was a noble idea which her Delegation wished to support. Nevertheless, her Delegation had expressed certain reservations with regard to the current drafting of Article 8 in the Basic Proposal.

600. She explained that the Delegation of South Africa had departed from the premise that any outcome of this Conference should reflect the interests and concerns of all Member States and, in particular, the striving of the international community for justice in the international system. The Delegation of South Africa had considered that the drafting of Article 8(1) of the Basic Proposal was inadequate in balance and likely to perpetuate the digital divide. As others disagreed with this view, her Delegation had engaged in clarifying matters and negotiating an acceptable compromise. It had been possible to accommodate each other on the following basis: instead of seeking to change the language of Article 8(1) in accordance with the

original proposal made by the Delegation of South Africa, agreement had been reached to maintain Article 8(1) of the Basic Proposal and to add a safeguard clause in Article 8(7) which would clarify the relationship between users and agents so as to avoid any misinterpretation or misapplication of the basic intent of Article 8. She therefore submitted to Main Committee I this compromise proposal as the best way of advancing the work on the Treaty. She pointed out that the compromise solution was acceptable for her Delegation and expressed the hope that other delegations may enjoy equal comfort with the formulation presently proposed.

601. The CHAIR expressed gratitude for the intervention by the Delegation of South Africa. He thanked all delegations which had worked hard and long to finally arrive at a good analysis of the concerns and a compromise proposal. He read out the following text for a new paragraph 7 of Article 8: "Nothing in this Article regulates the means of communication between an applicant, holder or other interested person and its representative." He clarified that Article 8(1) would be retained as presented in the Basic Proposal.

602. Mr. WARDLE (New Zealand) expressed support for this new proposal. He thanked the African Group and, in particular, the Delegation of South Africa for their time and patience throughout the work on a compromise solution.

603. Mr. OTIENO-ODEK (Kenya) stated that his Delegation supported the Delegation of South Africa in arriving at the compromise for Article 8 and the addition of a new paragraph 7.

604. Mr. RAGAB (Egypt) appreciated the effort made by the Delegation of South Africa in order to achieve the compromise text which his Delegation supported, just as it had supported the original proposal by the Delegation of South Africa. He said that the present compromise solution constituted a minimum. It would not be possible to go any further.

605. Mr. ENÄJÄRVI (Finland) expressed support for the additional clarification in the new Article 8(7). He was content that the problem which, at the outset, had appeared difficult, had finally been solved in this way.

606. Ms. BERESFORD (United States of America) appreciated the flexibility of Main Committee I to allow for the consultations that had taken place yesterday. In the course of these consultations, it had been possible to achieve clarity in the text of Article 8. She said that her Delegation agreed with the contents of the compromise language in the new Article 8(7) and wished to thank all of those who had worked intensively and with open hearts and open minds to achieve this result.

607. Mr. KHAN (Pakistan) thanked the Delegation of South Africa and all other groups that had worked hard to achieve consensus on a new clause in Article 8(7). He was glad that the issue could be resolved amicably. He felt that the compromise solution satisfied the needs of developing and least-developed countries alike.

608. The CHAIR concluded that Article 8(1) and (7) would be presented to the Drafting Committee in the following shape: Article 8(1) would be retained as contained in the Basic Proposal. A new Article 8(7) would be added which contained

the compromise text which the Committee had just discussed. He thanked all participants in the process of finding a compromise for the effort they had made, as well as the excellent result which had been achieved. He drew the attention of Main Committee I to document TLT/R/DC/12 which contained a proposal concerning Article 8(2)(c) that had been made by the Delegation of the Ukraine.

609. Mr. ZHAROV (Ukraine) explained that the proposal by the Delegation of the Ukraine was related to the fact that, by referring to the “Contracting Party” in Article 8(2)(c), it ensured a consistent approach to the wording of the Treaty, and also to the fact that the language of the communication may be prescribed only by the legislation of the Contracting Party, and not by the Office.

610. The CHAIR thanked the Delegation of the Ukraine for introducing its proposal. He opened the discussion.

611. Ms. SCHMIDT (Germany) said that the Delegation of Germany was comfortable with the proposal made by the Delegation of the Ukraine.

612. La Sra. DAFAUCE MENÉNDEZ (España) dijo que la delegación de España también podía aceptar esa propuesta e incluso consideraba que mejoraba técnicamente la redacción actual.

613. Ms. ASPERGER (Austria) supported the proposal because of its linguistic merits. She held the view that it would enhance the clarity of Article 8(2)(c).

614. La Sra. MENJIVAR CORTÉS (El Salvador) dijo que su delegación apoyaba la propuesta por considerar que era técnica.

615. Mr. OTIENO-ODEK (Kenya) expressed support for the proposal made by the Delegation of the Ukraine. He said that the proposal improved the consistency of subparagraphs (a), (b) and (c) of Article 8(2).

616. The CHAIR concluded that the proposal made by the Delegation of the Ukraine with regard to Article 8(2)(c) had been approved. He informed Main Committee I that there were no further proposals pending. With respect to Article 8(3)(c), there was one minor aspect which he wanted to indicate for the sake of transparency. In the course of the meetings of the Drafting Committee, the question had arisen as to whether it was advisable to use the word “notwithstanding” in combination with a reference to a certain provision of the Treaty. He recalled document TLT/R/DC/15 which contained a proposal by the Delegation of South Africa to add the word “notwithstanding” to several Articles.

617. The Chair explained that, in this context, the Legal Counsel had informed the Drafting Committee that, in final clauses of international treaties, such as Articles 23 and 29 of the Revised TLT, it appeared to be indispensable to use the word “notwithstanding” for reasons of public international law. With respect to other provisions in the Treaty, such as Article 8(3)(c), however, the word “notwithstanding” would have no legal effect. The Chair noted that, accordingly, it was a question of drafting whether or not to use the expression. On this understanding, he concluded that the entire Article 8 could be sent to the Drafting Committee.

Rule 6: Details Concerning Communications

618. The CHAIR recalled that Rule 6 had already been under consideration in Main Committee I. He wondered whether there was a need for further discussions.

619. Mr. KHAN (Pakistan) indicated that he was fully comfortable with the substance of Rule 6. He held the view that, in the English version, the expression “earlier than the latter date” at the end of Article 6(2) was grammatically incorrect.

620. The CHAIR said that the Drafting Committee would be asked to clarify this issue. He concluded that Rule 6 could be sent to the Drafting Committee. He expressed his gratitude for the cooperative and constructive spirit, and the sense of flexibility and compromise that had allowed Main Committee I to make good progress in the discussion of the substantive provisions of the Revised TLT.

Twelfth Meeting Monday, March 27, 2006 Afternoon
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621. The CHAIR referred to Agenda Item 11 of the Diplomatic Conference: Consideration of the Texts Proposed by the Main Committees. He noted that, before the Plenary could consider any text, some work still needed to be done. According to Rule 12(1) of the Rules of Procedure, Main Committee I was responsible for submitting for adoption by the Conference, meeting in Plenary, texts concerning the substantive provisions of the treaty, the regulations and any recommendation, resolution or agreed statement referred to in the first rule of procedures. The Chair noted that, after Main Committee I had discussed and agreed on the substantive provisions, it had sent the texts to the Drafting Committee for review. He then invited the Chair of the Drafting Committee to inform Main Committee I of the result of its work.

622. El Comité de Redacción realizó ocho sesiones entre el 17 y el 23 de marzo, a efectos de examinar los textos del proyecto de Tratado revisado sobre el Derecho de Marcas y su Reglamento, enviados para su consideración por el Comité Principal I. El Comité de Redacción, plasmó por escrito las decisiones tomadas por el Comité Principal I respecto a los Artículos 1 a 22 del Tratado y a la totalidad de su Reglamento.

623. En tal sentido, el Comité de Redacción completó la revisión y concordancia de los textos en el proyecto de Tratado, el que actualmente figura en el documento TLT/R/DC/24 de la serie de esta Conferencia y en el proyecto de Reglamento que figura en el documento TLT/R/DC/25 de esa serie.

El texto que el Comité de Redacción presenta en esta ocasión incluye las modificaciones a la propuesta básica adoptadas en el seno de la Comisión Principal I y verificadas por el Comité de Redacción. Esos cambios conciernen principalmente a los siguientes Artículos: Artículo 1)(xii), y xiv), Artículo 3-Numeral 1) literal a) romanito x) al romanito xii), Artículo 4. Numeral 1) literal a) romanito i), Artículo 5. Numeral 1) literal a) romanito iv), Artículo 8. Numeral 7), Artículo 13. Numeral 2) romanito i) y Artículo 22. Numeral 1) literal a), y las siguientes Reglas: Regia 7. Numeral 1) romanito iii), Regia 8 y Regia 10. Numeral 1) literal b).

624. Además de lo anterior cabe observar que se ha incluido dos cambios adicionales, omitidos en los documentos del proyecto de Tratado y del proyecto de Reglamento, respectivamente, en el Artículo 8 numeral 2) literal c) y en la Regia 9 numeral 1) romanito i), numeral 2) romanito i) y numeral 3) literal a) romanito i). Estas adiciones figuran como corrigendum, respectivamente, en los documentos TLT/R/DC/24 corr. y TLT/R/DC/25 corr.

625. Finalmente, el Comité de Redacción sugiere al Comité Principal I, que considere incluir, como título de la Regla 2 Numeral 3) el siguiente, a fin de que dicho párrafo no quede sin título: “Otro Medio de Identificación”.

626. El Comité de Redacción entiende que este título preemitiría completar adecuadamente el párrafo.

627. En cumplimiento de su mandato, al reflejar esos cambios en los textos a.C. presentados, el Comité de Redacción fue particularmente cuidadoso de no alterar en absoluto la sustancia de las decisiones tomadas por este Comité Principal I.

628. Siendo todo cuanto tengo que informar a este Comité Principal, solo me resta agradecer la excelente colaboración recibida de las delegaciones Miembros del Comité de Redacción, axial como la asistencia prestada por la Oficina Internacional para apoyarme en el cumplimiento de esta función que la Conferencia tuvo a bien confiarme.

629. The CHAIR thanked the Chair of the Drafting Committee for her report and turned to document TLT/R/DC/24 and its Corrigendum, document TLT/R/DC/24 Corr. He suggested submitting these documents to the Plenary. He noted that one question still needed to be resolved prior to concluding the work of the Committee. This was the written proposal contained in document TLT/R/DC/16, entitled “New Article to be Inserted in the Revised Trademark Law Treaty”, a proposal submitted by the Delegation of Benin on behalf of the Group of Least Developed Countries. He called on the Delegation of Benin to make any additional remarks on this point.

630. M. AMEHOU (Bénin) dit que sa délégation a soumis une proposition dans le but de la voir figurer dans le Traité mais ajoute que suite aux négociations et à la prise en compte de ses préoccupations il a décidé de retirer la proposition en question.

631. The CHAIR said that Main Committee I had decided to submit the text of the treaty, as contained in document TLT/R/DC/24 and its Corrigendum to the Plenary for adoption. He then turned to document TLT/R/DC/25 and its Corrigendum,

document TLT/R/DC/25 Corr. He noted that one additional point had been added in that document, to have the heading “Other Means of Identification” in Rule 2(3). The CHAIR further noted that the Committee had decided to submit document TLT/R/DC/25 and its Corrigendum to the Plenary.

632. The CHAIR recalled that one additional document had been circulated, TLT/R/DC/26 containing the “Draft Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks and the Regulations Thereunder”, a proposal that was presented in writing by all regional group coordinators on behalf of their respective regional groups. He called on one of the regional group coordinators to formally table the proposal.

633. Mr. AYALOGU (Nigeria), speaking on behalf of the regional group coordinators who represented their respective regional groups, said that the Draft Resolution was the result of long negotiations and consultations among the Regional Groups. He recalled that the initiative started as an attempt by the African Group to have, at the core, not only a revised treaty, but one that could be implemented and embraced by all groups. To establish a treaty process that would provide for support for the less endowed in fully implementing the treaty and benefiting from what it offers in the Intellectual Property and management process. He acknowledged that the elements included in the Resolution were not problem-free and some groups had voiced their concerns at various levels of the coordination process. He appreciated that all groups saw the need for the African Group to profile the issue of implementation, technical support and capacity building and on those grounds, they supported submitting the draft resolution to the Plenary.

634. The CHAIR thanked the Delegation of Nigeria for his introduction and explanation of this proposal that had been put together by the joint effort of all regional groups and their respective coordinators. He also thanked the Delegation of Nigeria for highlighting the value of the text.

635. Mr. GHORBANI (Islamic Republic of Iran), on behalf of the Asian Group, expressed appreciation for the good management of the formal and informal meetings carried out during the Conference. The Asian Group also appreciated the flexibility shown by all regional groups during the consultations. He supported the views expressed by the Delegation of Nigeria and hoped that all Delegations would contribute to approving the text in the Plenary.

636. Mr. ADHIKARI (Nepal) said that he appreciated the efforts deployed and believed that the decision on this issue would be unanimous.

637. Mr. OMOROV (Kyrgyzstan) pointed out that the title of the Draft Resolution in Russian could be improved, so that it would correspond to the other languages. He also noted that he would submit in writing, small corrections to the text of the Regulations in the same language.

638. The CHAIR thanked the Delegation of Kyrgyzstan for its observation and assured that the International Bureau would address those concerns.

639. He suggested submitting the draft Resolution, the text of which was identical with an informal document that had been the outcome of informal consultations, to the Plenary for adoption. In the absence of any delegation requesting the floor, he concluded that it was so decided.

640. He then noted that the work of Main Committee I had been concluded and thanked all delegations for their constructive support and collaboration.

641. The CHAIR closed the meeting.