

## **Singapore Treaty on the Law of Trademarks (STLT)**

### **Assembly**

#### **Second (1<sup>st</sup> Extraordinary) Session Geneva, September 20 to 29, 2010**

#### **REVIEW OF RULE 3(4) TO (6) OF THE REGULATIONS UNDER THE SINGAPORE TREATY ON THE LAW OF TRADEMARKS**

*Document prepared by the International Bureau*

1. At its first session, held in Geneva from September 22 to October 1, 2009, the Assembly of the Singapore Treaty on the Law of Trademarks (hereinafter referred to as “the Assembly” and “the Singapore Treaty”) considered document STLT/A/1/3 on “Future Work”, which made reference to the areas of convergence concerning the representation of non-traditional marks agreed by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), in 2008. Those areas of convergence were submitted to the attention of the relevant WIPO Assemblies in 2009, in document WO/GA/38/7, and are published as WIPO document WIPO/STrad/INF/3 at <http://www.wipo.int/sct/en/wipo-strad>.
2. At that session, the Assembly approved the initiation of a Review of Rule 3(4) to (6) of the Regulations under the Singapore Treaty with a view to align that rule, where considered possible and appropriate, with the areas of convergence concerning the representation of non-traditional marks agreed by the SCT. The Assembly further approved the convening of one session of a Working Group to meet back-to-back with the first ordinary session of the SCT in 2010, to undertake preparatory work for the review of Rule 3(4) to (6) (see document STLT/A/1/4, paragraph 12).

3. Rule 3 of the Regulations under the Singapore Treaty deals with the representation of the mark in an application for registration. It is a generally accepted feature of trademark registration procedures that a mark for which registration is sought must be presented to the relevant trademark authority.
4. While the Singapore Diplomatic Conference reached agreement on Rule 3(1) to (4) concerning marks reproduced in standard characters (Rule 3(1)), marks claiming color (Rule 3(2)), the number of reproductions (Rule 3(3)) and certain issues relating to the reproduction of three-dimensional marks (Rule 3(4)), questions concerning the reproduction of hologram marks, motion marks, color marks and position marks (Rule 3(5)), as well as the representation of marks consisting of non-visible signs (Rule 3(6)) remained unresolved. In this regard, Rule 3(5) and (6) refer to national law.
5. In this context, it appears useful to recall that the term “representation” includes “reproduction” and, in particular, any graphic or photographic reproduction of a mark and any other means of representation, for example descriptions or electronic data files (see Note 3.09 of document TLT/R/DC/5).
6. Following the decision of the Assembly referred to in paragraph 1, above, the Director General convened, on June 28 and 29, 2010, a first session of the Working Group for the Review of Rule 3(4) to (6) of the Regulations under the Singapore Treaty on the Law of Trademarks (hereinafter referred to as the “Working Group”). In preparation of that session, the Secretariat issued document STLT/WG/1/2 containing suggestions for the possible alignment of Rule 3 with the areas of convergence concerning the representation of non-traditional marks agreed by the SCT, in the form of draft amendments to Rule 3 with accompanying text.
7. It is recalled that there is no obligation under the Singapore Treaty to provide for the registration of any of the signs contemplated in Rule 3(4) to (6). The effect of those amendments will be that Contracting Parties that accept for registration those types of marks accept the representation of such marks as prescribed in the Rule.
8. At the conclusion of the first session of the Working Group, the Working Group agreed on the text for a revised Rule 3(4) to (10), as reproduced in the Annex to this document. The Working Group further agreed to recommend to the Singapore Treaty Assembly the adoption of the text for a revised Rule 3(4) to (10) as reproduced in the Annex to this document, with November 1, 2011, as the date for its entry into force. Following the adoption of the recommended Rule change by the Assembly, the Secretariat was requested to introduce all consequential amendments to the model international forms (see paragraph 5 of the Summary by the Chair, adopted by the Working Group on June 29, 2010 (document STLT/WG/1/3)).

*9. The Singapore Treaty Assembly is invited to*

*(i) take note of the recommendation of the Working Group for the Review of Rule 3(4) to (6) of the Regulations under the Singapore Treaty on the Law of Trademarks to amend Rule 3(4) to (6) of the Regulations under the Singapore Treaty;*

*(ii) adopt the proposed amendments to Rule 3(4) to (6), as reproduced in the Annex to this document; and*

*(iii) set November 1, 2011, as the date for the entry into force of the proposed amendments.*

[Annex follows]

REGULATIONS UNDER THE SINGAPORE TREATY ON THE LAW OF TRADEMARKS \*

[...]

*Rule 3*  
*Details Concerning the Application*

[...]

(4) [Three-dimensional Mark]

- (a) Where the application contains a statement to the effect that the mark is a three-dimensional mark, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction.
- (b) The reproduction furnished under subparagraph (a) may, at the option of the applicant, consist of one single view of the mark or of several different views of the mark.
- (c) Where the Office considers that the reproduction of the mark furnished by the applicant under subparagraph (a) does not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, up to six different views of the mark and/or a description by words of that mark.
- (d) Where the Office considers that the different views and/or the description of the mark referred to in subparagraph (c) still do not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, a specimen of the mark.
- (e) Notwithstanding subparagraphs (a) to (d), a sufficiently clear reproduction showing the three-dimensional character of the mark in one view shall be sufficient for the granting of a filing date.
- (f) Paragraph (3)(a)(i) and (b) shall apply *mutatis mutandis*.

~~(5) [Hologram Mark, Motion Mark, Color Mark, Position Mark] Where the application contains a statement to the effect that the mark is a hologram mark, a motion mark, a color mark or a position mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark, as prescribed by the law of that Contracting Party.~~

(5) [Hologram Mark] Where the application contains a statement to the effect that the mark is a hologram mark, the representation of the mark shall consist of one or several views of the mark capturing the holographic effect in its entirety. Where the Office considers that the view or views submitted do not capture the holographic effect in its entirety, it may require the furnishing of additional views. The Office may also require the applicant to furnish a description of the hologram mark.

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\* In the Annex to this document, all suggested changes from the current text of Rule 3 are recapitulated and indicated by underlining for new text and strikethrough for deleted text.

~~(6)~~ [Motion Mark] Where the application contains a statement to the effect that the mark is a motion mark, the representation of the mark shall, at the option of the Office, consist of one image or a series of still or moving images depicting movement. Where the Office considers that the image or images submitted do not depict movement, it may require the furnishing of additional images. The Office may also require that the applicant furnish a description explaining the movement.

~~(7)~~ [Color Mark] Where the application contains a statement to the effect that the mark is a color *per se* mark or a combination of colors without delineated contours, the reproduction of the mark shall consist of a sample of the color or colors. The Office may require a designation of the color or colors by using their common names. The Office may also require a description on how the color is or the colors are applied to the goods or used in relation to the services. The Office may further require an indication of the color or colors by a recognized color code chosen by the applicant and accepted by the Office.

~~(8)~~ [Position Mark] Where the application contains a statement to the effect that the mark is a position mark, the reproduction of the mark shall consist of a single view of the mark showing its position on the product. The Office may require that matter for which protection is not claimed shall be indicated. The Office may also require a description explaining the position of the mark in relation to the product.

~~(9)~~ [Sound Mark] Where the application contains a statement to the effect that the mark is a sound mark, the representation of the mark shall, at the option of the Office, consist of a musical notation on a stave, or a description of the sound constituting the mark, or an analog or digital recording of that sound, or any combination thereof.

~~(6)~~~~(10)~~ [Mark Consisting of a Non-Visible Sign other than a Sound Mark] Where the application contains a statement to the effect that the mark consists of a non-visible sign other than a sound mark, a Contracting Party may require one or more representations of the mark, an indication of the type of mark and details concerning the mark, as prescribed by the law of that Contracting Party.

~~(7)~~~~(11)~~ [Transliteration of the Mark] [...]

~~(8)~~~~(12)~~ [Translation of the Mark] [...]

~~(9)~~~~(13)~~ [Time Limit for Furnishing Evidence of Actual Use of the Mark] [...]

[...]

[End of Annex and of document]