

WIPO



TLT/R/DC/6
ORIGINAL: English
DATE: March 14, 2006

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

DIPLOMATIC CONFERENCE FOR THE ADOPTION OF A REVISED TRADEMARK LAW TREATY

Singapore, March 13 to 31, 2006

ARTICLE 13

Proposal by the Delegation of Japan

The Delegation of Japan proposes to add the following text to Article 13:

“(6) [*Substantive Examination on the Occasion of Renewal*] Any State or intergovernmental organization may declare that, notwithstanding paragraph (4), the Office may, on the occasion of the first renewal of a registration covering services, examine such registration as to substance, provided that such examination shall be limited to the elimination of multiple registrations based on applications filed during a period of six months following the entry into force of the law of such State or organization that introduced, before the entry into force of this Treaty, the possibility of registering service marks.”

Comments: The Basic Proposal for a Revised Trademark Law Treaty (TLT) does not include a provision corresponding to Article 22(6) of the TLT 1994. That provision considered the particular situation of Japan regarding the registration of service marks. Japan adopted a service mark registration system in April 1994. That system allowed the registrations 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 resulted in redundant registrations.

In order to solve the problem of multiple registrations, multiply registered service marks must undergo substantive examination only at the time of first renewal, which is carried out 10 years after the registration date. Specifically, the examiner should consider whether renewal is requested for any other multiply registered service mark, and if so, whether or not the service mark in question is liable to cause confusion as to the owner of the mark. If the examiner decides that a multiple service mark held by another person has become more famous through use over the past ten years since the marks were registered, he should not allow the renewal of the service mark concerned.

Article 22(6) of the TLT 1994 allows 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 1994. Japan considers it necessary to include Article 22(6) in the Revised TLT, because its Office needs to eliminate multiple registrations.

For reference purposes, Japan notes that the final multiple registrations were made at the end of the year 2000. An appeal against the examiner's decision of refusal or a lawsuit may have been filed regarding the justifiability of the registration. Therefore, the transitional provision contained in Article 22(6) of the TLT 1994 should be included in the Revised TLT until the year 2011.

The proposed draft text is similar to that of Article 22(6) of the TLT 1994, except for a change in the reference to "Article 13(4)" instead of "Article 13(6)."

[End of document]