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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**STANDING COMMITTEE ON THE LAW OF TRADE MARKS,
INDUSTRIAL DESIGN AND GEOGRAPHICAL INDICATIONS**

Tenth Session
Geneva, April 28 to May 2, 2003

DRAFT REVISED TRADE MARK LAW TREATY

Document prepared by the Secretariat

INTRODUCTION

1. TherevisedProgramandBudgetfor2002 -2003includesunderSub -Program05.2, “LawofTrademarks,IndustrialDesignsandGeographicalIndications,”thefollowing activities(documentWO/PBC/4/2,page53):

“ConveningoffourmeetingsoftheSCT(andanyWorkingGroupsetupbythis Committee)toconsidercurrentissues,including:

- the *revisionoftheTrademarkLawTreaty(TLT)* toaddress, *interalia*, the creation ofanAssembly,inclusionofprovisionsonelectronicfiling,andtheincorporationofthe JointRecommendationonTrademarkLicenses;[..];”

2. Atitssixthsession(March12to16,2001),theStandingCommitteeontheLawof Trademarks,IndustrialDesignsandGeographicalIndications(SCT),discussedadocument preparedbytheInternationalBureaucontaininganoverviewofthepossibleissues tobe consideredbytheStandingCommitteeinthefuture(documentSCT/6/4).Thedocument outlined(paragraphs7to15)differentissues thatcouldbeaddressedwithintheframeworkof revisionoftheTLT.TheCommitteeagreedthatdiscussionsshouldfocusonthefollowing pointswwhichwerelistedintheabove -mentioneddocument:

- EstablishmentofanAssembly;
- Electronicfiling;
- Trademarklicenses;
- Limitationofmandatoryrepresentation;
- Reliefinrespectoftimelimits.

3. Attheeighthsession(May27to31,2002)oftheSCT,theInternationalBureau submittedadocume nt(SCT/8/2)containing suggestionsofdraftarticlesforconsiderationin theperspectiveoffurtherharmonizationofformalitiesandproceduresinthefieldofmarks, whichcouldleadtoarevisionoftheTLT.Thedocumenttookintoaccountthedevelopm ent oftechniquesandtheneedtofurther simplifyformalities.Moreover,thisdocumenttriedto harmonizetheTLTprovisionswithsimilarprovisionsofPatentLawTreaty(PLT)adoptedby WIPOMemberStatesin2000.Onthebasisofthediscussionswhich tookplaceattheeighth session,theInternationalBureaupreparedreviseddraftprovisions(documentSCT/9/2)for theninthsessionoftheSCT(November11to15,2002).Atthatsession,theSCTdiscussed Article8andArticle13 *bis*,13 *ter* and 13*quater* andrelatedrulesanddecidedthatthe InternationalBureau shouldrevisedocumentSCT/9/2accordinglywiththediscussions.

4. ThepresentdocumentcontainsarevisedversionofdraftArticles8,13 *bis*and13 *ter*and relatedrulesofthedraftrevisedTrademarkLawTreaty(“TLT”),whichis presented separatelyfromtherestofthetext,pursuanttoadecisionoftheSCTatitsninthsession.The documentalsocontainsexplanatorynotesrelatedtothesearticles.

5. TheSCTisinvited toconsiderandcomment ontheproposalscontainedintheAnnextothis document.

[Annexfollows]

ANNEX

DRAFTREVISEDTRADEMARKLAWTREATY
ARTICLES8,13 *bis*AND13 *ter*

Article8
Communications

[AlternativeA]

(1) [*FormandMeansofTransmittalofCommun ications*](a)Exceptforthe establishmentofafilingdateunderArticle5(1),andsubjecttoparagraph(3),theRegulations shall,subjecttosubparagraphs(b)to(d),setouttherequirementswhichaContractingParty shallbepermittedtoapplyasre gards~~the~~formandmeansoftransmittalofcommunications.

(b) NoContractingPartyshallbeobligedtoacceptthefilingof communicationsotherthanonpaper.

(c) NoContractingPartyshallbeobligedtoexcludethefilingof communicationsonpaper.

(d) AnyContractingPartyshallacceptthefilingofcommunicationsonpaper forthepurposeofcomplyingwithatimelimit.

[EndofAlternativeA]

[AlternativeB]

(1) [*FormandMeansofTransmittalofCommunications*]AnyContractingParty maychoose themeansoftransmittalofcommunications,inaccordancewiththerequirements prescribedintheRegulations.

[EndofAlternativeB]

[AlternativeC]

(1) [*FormandMeansofTransmittalofCommunications*]AnyContractingParty maychoosethemeansof t ransmittalofcommunications.

[EndofAlternativeC]

(2) [*Language of Communications*] (a) Any Contracting Party may require that any communication be in [the language, or in one of the languages] [a language], admitted by the Office. Where the Office admits more than one language, the applicant, holder or other interested person may be required to comply with any other language requirement applicable with respect to the Office, provided that the communication may not be required to be in more than one language.

(b) Any Contracting Party may require that, where the communication is not in [the language, or in one of the languages,] [a language] admitted by the Office, the communication be accompanied by a translation or a certified translation of the document in [the language, or in one of the languages,] [a language] admitted by the Office;

[Alternative A]

(3) [*Presentation of a Communication*] Subject to paragraph (2), any Contracting Party shall accept the presentation of a communication, the contents of which correspond to the relevant Model International Form provided for in the Regulations, if any.

[End of Alternative A]

[Alternative B]

(3) [*Presentation of a Communication*] As regards the requirements concerning the presentation and contents of a communication, and subject to paragraph (2), no Contracting Party shall refuse a communication:

(i) where the Contracting Party allows the transmittal of communications to the Office on paper, and the communication is so transmitted, if it is presented on a Form which corresponds to the relevant Model International Form provided for in the Regulations, if any;

(ii) where the Contracting Party allows the transmittal of communications to the Office in electronic form or by electronic means, and the communication is so transmitted, if the contents of that communication correspond to the relevant Model International Form provided for in the Regulations, if any.

[End of Alternative B]

(4) [*Signature of Communications*] (a) Where a Contracting Party requires a communication to be signed, that Contracting Party shall accept any signature that complies with the requirements prescribed in the Regulations.

(b) No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature which is communicated to its Office, except if the law of the Contracting Party so provides, where the signature concerns the surrender of a registration and as prescribed in the Regulations.

(c) Subject to sub paragraph (b), any Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the authenticity of any signature.

(5) [*Indications in Communications*] No Contracting Party may require that a communication contain indications other than those prescribed in the Regulations.

(6) [*Address for Correspondence, Address for Legal Service and Other Address*] Any Contracting Party may, subject to any provisions prescribed in the Regulations, require that an applicant, holder or other interested person indicate in any communication:

- (i) an address for correspondence;
- (ii) an address for legal service;
- (iii) any other address provided for in the Regulations.

(7) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraph [(1) or (3) to (6)] [(1) to (6)] are not complied with in respect of communications, the Office shall notify the applicant, holder or other interested person, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(8) [*Non-Compliance with Requirements*] Where one or more of the requirements applied by the Contracting Party under paragraphs [(1) or (3) to (6)] [(1) to (6)] are not complied with within the time limit prescribed in the Regulations, the Contracting Party may, subject to Article 5 and to any exceptions prescribed in the Regulations, apply such sanctions as is provided for in its law.

[Alternative A]

Article 13bis
Relief in Respect of Time Limits Fixed by the Office

(1) [*Request*] Any Contracting Party shall provide for relief in respect of a time limit fixed by the Office for an action in a procedure before the Office in respect of an application or registration. Such relief shall consist of at least one of the following, at the option of the Contracting Party:

(a) an extension of the time limit for the period prescribed in the Regulations, where a request to that effect is filed with the Office prior to the expiration of the time limit and in accordance with the Regulations; or

(b) continued processing with respect to the application or registration and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration, where a request to that effect is filed with the Office in accordance with the requirements and within the time limit prescribed in the Regulations. on

(2) [*Exceptions*] No Contracting Party shall be required to provide for the relief referred to in paragraph (1) with respect to exceptions prescribed in the Regulations.

(3) [*Fees*] Any Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) [*Prohibition of Other Requirements*] No Contracting Party may require that requirements other than those referred to in paragraphs (1) and (3) be complied with in respect of the relief provided for under paragraph (1), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(5) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraph (1) may not be refused without the applicant or holder being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Article 13ter
Reinstatement of Rights After a Finding of Due Care
or Unintentionality by the Office

(1) [*Request*] Any Contracting Party shall provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or registration, the Office shall reinstate the rights of the applicant or holder with respect to the application or the registration concerned, if the following conditions are fulfilled:

(i) a request to that effect is filed with the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements in respect of which the time limit for the said action are complied with, within the time limit prescribed in the Regulations;

(iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(2) [*Exceptions*] No Contracting Party shall be required to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

(3) [*Fees*] Any Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) [*Evidence*] Any Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that requirements other than those referred to in paragraphs (1), (3) and (4) be complied with in respect of the request provided for under paragraph (1), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(6) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraph (1) may not be refused without the applicant or holder being given the opportunity to make observations on the intended refusal within a reasonable time limit.

[End of Alternative A]

[Alternative B]

Article 13 bis
Relief in Respect of Time Limits and
Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office

(1) [*Request for Relief in Respect of Time Limits*] Where an applicant, holder or other interested person has failed to comply with a time limit fixed by the Office for an action in a procedure before the Office in respect of an application or registration, a Contracting Party shall provide for at least one of the following:

(i) extension of the time limit, in accordance with the requirements prescribed in the Regulations; or

(ii) continued processing with respect to the application or registration, in accordance with the requirements prescribed in the Regulations.

(2) [*Request for Reinstatement*] Where an applicant, holder or other interested person has failed to comply with a time limit for an action in a procedure before the Office in respect of an application or registration, and the failure to comply with that time limit has the direct consequence of causing a loss of rights with respect to the application or the registration concerned, a Contracting Party shall provide for the reinstatement of the rights of the applicant or holder with respect to the application or registration, in accordance with the requirements prescribed in the Regulations.

(3) [*Exceptions*] No Contracting Party shall be required to provide for the relief referred to in paragraph (1) or for the reinstatement of rights referred to in paragraph (2) with respect to exceptions prescribed in the Regulations.

(4) [*Fees*] Any Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) and (2).

(5) [*Prohibition of Other Requirements*] No Contracting Party may require that requirements other than those referred to in paragraphs (1), (2) and (4) be complied with in respect of the relief referred to in paragraph (1) or the reinstatement of rights referred to in paragraph (2), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(6) [*Opportunity to Make Observations in Case of Intended Refusal*] A request under paragraphs (1) and (2) may not be refused without the applicant or holder being given the opportunity to make observations on the intended refusal within a reasonable time limit.

[End of Alternative B]

RULES

Rule 5bis
Communications Under Article 8

[Alternative A]

(1) [*Communications Filed on Paper*] After [month, day, year] any Contracting Party may, subject to Articles 5(1) and 8(1) (d) exclude the filing of communications on paper or may continue to permit the filing of communications on paper. Until that date, all Contracting Parties shall permit the filing of communications on paper.

[End of Alternative A]

[Alternative B]

(1) [*Communications*] Any Contracting Party may accept the filing of communications on paper for the purpose of establishing a filing date under Article 5(1) and of complying with a time limit.

[End of Alternative B]

[Alternative C]

(1) [*Communications*] No Contracting Party is obliged, [against its wishes], to accept the filing of communications in electronic form or by electronic means of transmittal, or to exclude the filing of communications on paper.

[End of Alternative C]

(2) [*Communications Filed in Electronic Form or by Electronic Means of Transmittal*] Where a Contracting Party permits filing of communication in electronic form or by electronic means of transmittal, it may require that the original of any such communication, accompanied by a letter identifying that earlier transmission, may be filed on paper with the Office within a time limit which shall not be less than one month from the date of the transmission.

Rule 6
Details Concerning the Signature Under Article 8(4)

(1) [*Indications Accompanying Signature*] Any Contracting Party may require that the signature of the natural person whose signs be accompanied by:

(i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person;

(ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

(2) [*Date of Signing*] Any Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so permits, a date earlier than the latter date.

(3) [*Signature of Communications on Paper*] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party:

(i) shall, subject to item (iii), accept a handwrittensignature;

(ii) may permit, instead of a handwrittensignature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or a bar-coded label;

(iii) may, where the natural person whose signs the communication is a national of the Contracting Party and such person's address is on its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment on its territory, require that a seal be used instead of a handwrittensignature.

(4) [*Signature of Communications Filed in Electronic Form or by Electronic Means of Transmittal Resulting in Graphic Representation*] Where a Contracting Party allows the transmittal of communications in electronic form or by electronic means of transmittal, it shall consider such a communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on that communication as received by the Office of that Contracting Party.

(5) [*Signature of Communications Filed in Electronic Form Not Resulting in Graphic Representation of Signature*] Where a Contracting Party allows the transmittal of communications in electronic form, and a graphic representation of a signature accepted by that Contracting Party under paragraph (3) does not appear on such a communication as received by the Office of that Contracting Party, the Contracting Party may require that the communication be signed using a signature in electronic form as prescribed by that Contracting Party.

(6) [*Exception to Certification of Signature Under Article 8(4)(b)*] Any Contracting Party may require that any signature referred to in paragraph (5) be confirmed by a process for certifying signatures in electronic forms specified by that Contracting Party.

Rule 6bis
Details Concerning Indications Under Article 8(5), (6) and (8)

(1) [*Details Concerning Indications Under Article 8(5)*] (a) Any Contracting Party may require that any communication:

(i) indicate the name and address of the applicant, holder or other interested person;

(ii) indicate the number of the application or registration of the mark to which it relates;

(iii) contain, where the applicant, holder or other interested person is registered with the Office, the number or other indication under which he is registered.

(b) Any Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain:

(i) the name and address of the representative;

(ii) a reference to the power of attorney, or other communication in which the appointment of that representative is or was effected, on the basis of which the said representative acts;

(iii) where the representative is registered with the Office, the number or other indication under which he is registered.

(2) [*Address for Correspondence and Address for Legal Service*] Any Contracting Party may require that the address for correspondence referred to in Article 8(6)(i) and the address for legal service referred to in Article 8(6)(ii) be on a territory prescribed by that Contracting Party.

(3) [*Address Where No Representative is Appointed*] Where no representative is appointed and an applicant, holder or other interested person has provided, as his address, an address on a territory prescribed by the Contracting Party under paragraph (2) that Contracting Party shall consider that address to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, holder or other interested person expressly indicates another such address under Article 8(6).

(4) [*Address Where Representative is Appointed*] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, holder or other interested person expressly indicates another such address under Article 8(6).

(5) [*Sanctions for Non -Compliance with Requirements under Article 8(8)*] No Contracting Party may provide for the refusal of an application for failure to comply with any requirement to file a registration number or other indication under paragraphs (1) (a)(iii) and (b)(iii).

Rule 6ter

Time Limits Concerning Communications under Article 8(7) and (8)

(1) [*Time Limits Under Article 8(7) and (8)*] Subject to paragraph (2), the time limits referred to in Article 8(7) and (8) shall be not less than [] months from the date of the notification referred to in Article 8(7).

(2) [*Exception to Time Limit Under Article 8(8)*] Where a notification under Article 8(7) has not been made because indications allowing the applicant, holder or other interested person to be contacted by the Office have not been filed, the time limit referred to in Article 8(8) shall be not less than [] months from the date on which the communication referred to in Article 8(7) was received by the Office.

[Alternative A]

Rule 9
Details Concerning Relief in Respect of Time Limits
Under Article 13bis

(1) [*Requirements Relating to the Request for an Extension of a Time Limit Under Article 13bis(1)(a)*] Any Contracting Party may require that the request for the extension of a time limit be signed by the applicant or holder and contain an identification of the time limit in question.

(2) [*Period and Time Limit Relating to the Request for an Extension of a Time Limit Under Article 13bis(1)(a)*] The period of extension of a time limit shall be not less than [] months from the date of expiration of the unextended time limit.

(3) [*Requirements Relating to the Request for Continued Processing Under Article 13bis(1)(b)*](a) Any Contracting Party shall require that all of the requirements in respect of which the time limit for the action concerned applied be complied with, within the time limit prescribed in paragraph (4).

(b) Any Contracting Party may require that the request for continued processing be signed by the applicant or holder and contain an identification of the time limit in question.

(4) [*Time Limit for Filing a Request for Continued Processing Under Article 13bis(1)(b)*] The time limit for filing a request shall be at least [] months from the date of expiration of the time limit.

(5) [*Exceptions under Article 13bis(2)*](a) No Contracting Party shall be required to grant:

(i) a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 13 *bis*(1);

(ii) relief for filing a request for relief under Article 13 *bis*(1) or a request for reinstatement under Article 13 *ter*(1);

(iii) relief in respect of a time limit for the payment of renewal fees;

(iv) relief in respect of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;

(v) relief in respect of a time limit for an action in *inter partes* proceedings.

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements of a procedure before the Office shall be required under Article 13bis(1) to grant relief in respect of a time limit for an action in that procedure in respect of any of those requirements beyond that maximum time limit.

Rule 10

Details Concerning Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 13ter

(1) [Requirements Under Article 13ter(1)(i)] Any Contracting Party may require that a request referred to in Article 13ter(1) be signed by the applicant or holder.

(2) [Time Limit Under Article 13ter(1)(ii)] The time limit for making a request, and for complying with the requirements, under Article 13ter(1)(ii), shall be the earliest to expire of the following:

(i) not less than [] months from the date of the removal of the cause of failure to comply with the time limit for the action in question;

(ii) not less than [] months from the date of expiration of the time limit for the action in question.

(3) [Exceptions under Article 13ter(2)] The exceptions referred to in Article 13ter(2) are failure to comply with a time limit:

(i) for an action before a board of appeal or other review body constituted in the framework of the Office;

(ii) for making a request for relief under Article 13bis(1) or a request for reinstatement under Article 13ter(1);

(iii) for an action in *inter partes* proceedings;

[(iv) for payment of a renewal fee;]

(v) for the correction or addition of a priority claim;

(vi) for filing of the subsequent application which claims or could have claimed priority of an earlier application;

(vii) for failure to file a copy of an earlier application required under Article 3(a)(vii).

[End of Alternative A]

[Alternative B]

Rule 9

*Details Concerning Relief in Respect of Time Limits and
Reinstatement of Rights After a Finding of Due Care or
Unintentionality by the Office [Under Article 13bis]*

(1) [*Requirements Relating to the Request for an Extension of a Time Limit Under Article 13bis(1)(i)*] (a) The request for the extension of a time limit shall be filed prior to the expiration of that time limit.

(b) Any Contracting Party may require that the request for the extension of a time limit be signed by the applicant or holder and contain an identification of the time limit in question.

(2) [*Period and Time Limit Relating to the Request for an Extension of a Time Limit Under Article 13bis(1)(i)*] The period of extension of a time limit shall be not less than [] months from the date of expiration of the unextended time limit .

(3) [*Requirements Relating to the Request for Continued Processing Under Article 13bis(1)(ii)*] (a) Any Contracting Party shall require that all of the requirements in respect of which the time limit for the action concerned applied be complied with within the time limit prescribed in paragraph (4).

(b) Any Contracting Party may require that the request for continued processing be signed by the applicant or holder and contain an identification of the time limit in question.

(4) [*Time Limit for Filing a Request for Continued Processing Under Article 13bis(1)(ii)*] The request for continued processing shall be filed within at least [] months from the date of expiration of the time limit.

(5) [*Requirements for Filing a Request for Reinstatement of Rights Under Article 13bis(2)*] (a) Any Contracting Party shall provide for the reinstatement of the rights of the applicant or holder with respect to an application or registration where the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(b) The request for reinstatement of rights shall:

(i) be filed with the Office within the time limits prescribed in paragraph (6);

(ii) state the reasons for the failure to comply with the time limit as provided for under Article 13 bis(2).

(c) Any Contracting Party may require that:

(i) therequestforreinstatementofrightsbesignedbytheapplica tor
holder;

(ii) adeclarationorotherevidenceinsupportofthereasonsreferredtoin
subparagraph(b)(ii)befiledwiththeOfficewithinatimelimitfixedbytheOffice.

(6) [*TimeLimitforFilingaRequestforReinstatementofRightsUnder
Article 13bis(2)*]Thetimelimitforfilingarequestforreinstatementofrightsshallnotbe
lessthan[]monthsfromthedateoftheremovalofthecauseoffailuretocomplywiththe
timelimitfortheactioninquestionor,notlessthan[]monthsfr omthedateofexpirationof
thetimelimitfortheactioninquestion,whicheveristheearlier.

(7) [*ExceptionsunderArticle13bis(3)*](a)Theexceptionsreferredtoin
Article 13bis(3)arefailuretocomplywithatimelimit:

(i) forwhichrelief hasalreadybeengrantedunderArticle13 bis(1)(i)
or (ii);

(ii) formakingarequestforreliefunderArticle13 bis(1)(i)or(ii) ora
requestforreinstatementunderArticle13 bis(2);

[(iii) forpaymentofarenewalfee;]

(iv) foranactionbefore aboardofappealorotherreviewbodyconstituted
intheframeworkoftheOffice;

(v) foranactionin *interpartes* proceedings;

(vi) forthecorrectionoradditionofapriorityclaim;

(vii) forfilingofthesubsequentapplicationwhichclaimsor couldhave
claimedpriorityofanearlierapplication;or

(viii) forfailuretofileacopyofearlierapplicationrequiredunder
Article 3(a)(vii).

(b) NoContractingPartywhichprovidesamaximumtimelimitforcompliance
withalloftherequirements ofaprocedurebeforetheOfficeshallberequiredunder
Article 13bis(1)(i)or(ii)to grantreliefinrespectofatimelimitforanactioninthat
procedureinrespectofanyofthoserequirementsbeyondthatmaximumtimelimit.

[EndofAlternativeB]

EXPLANATORY NOTES

Notes on Article 8 Communications

8.01. As to the term “communication”, reference is made to Article 1(iii) *bis*).

8.02. Along the lines with the agreed Statement adopted at the Diplomatic Conference regarding the Patent Law Treaty (PLT) and with a view to facilitating the implementation of Rule 5 *bis* (1), it could be envisaged to provide developing and least developed countries and countries in transition, on request and on mutually agreed terms and conditions, technical and financial cooperation.

[Alternative A]

8.03 As decided at the ninth session of the SCT (document SCT/9/9 Prov., paragraphs 161 and 162), Alternative A is similar to the corresponding provision in the Patent Law Treaty (PLT) since SCT Members found some merit in having the same principle for both patents and trademarks, to avoid divergent interpretations in these two fields. This provision had been the subject of intensive discussions during the Diplomatic Conference for the adoption of the PLT and at the end, it gathered consensus as being the language which provided Offices with the freedom to choose the means of communication.

8.04. *Paragraph (1)(a)*. The requirements that a Contracting Party is permitted to apply under this provision are prescribed in Rule 5 *bis*. The exception in respect of the filing date under Article 5(1) is needed because that Article provides for a filing date to be accorded where the prescribed elements of an application are filed, at the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date. The effect of the reference to paragraph (3) is that the requirements in respect of the form or contents of a communication prevail over the provisions under this paragraph.

8.05. The “form” of communication refers to the physical form of the medium which contains the information, for example, papers, sheets, floppy disk, or an electronically transmitted document. It also encompasses physical requirements, and the presentation or arrangement of the information or data in a communication, for example, a format which uses standard data identifiers to facilitate converting data from paper to electronic form. In addition, it also includes the notion of “electronic document formats”, such as pdf, XML, SGML, TIFF. The “means of transmission” refers to the means, for example, the physical or electronic means, used to transmit the communication to the Office. For example, an application on paper mailed to the Office is a communication in paper form transmitted by physical means, while a floppy disk mailed to the Office is a communication in electronic form transmitted by physical means. A telex or facsimile transmission resulting in a paper copy is a communication in paper form transmitted by electronic means, while a telex or facsimile transmission to a computer terminal is a communication in electronic form transmitted by electronic means. In addition, an electronic transmission from computer to computer is a communication in electronic form transmitted by electronic means. The term “filing of communications” refers to the transmission of a communication to the Office. A Contracting

Party is not required to accept the filing of communications in any and all electronic forms, or by any and all electronic means of transmittal, simply because that Contracting Party permits the filing of communications in electronic form or by electronic means.

8.06. *Paragraphs (1)(b) and (c)*. These provisions ensure that no Contracting Party is obliged, against its wishes, to accept the filing of communications in electronic form or by electronic means of transmittal, or to exclude the filing of communications on paper. The Office of any Contracting Party may choose to accept filings on paper only, or both on paper and electronic filing. This will continue to be the case after the deadline to be defined in Rule 5 bis, even though after that date any Contracting Party will be permitted, under Rule 5 bis(1), to exclude the filing of communications on paper, except as provided under Article 8(1)(d) and Article 5(1).

8.07. *Paragraph (1)(d)*. Under this provision, a Contracting Party is obliged to continue to accept the filing of communications on paper for the purpose of complying with a time limit, even where, after the date fixed in Rule 5 bis, a Contracting Party excludes the filing of communications on paper. This provision has no effect on the countries which do not accept applications other than on paper (document SCT/8/7, paragraphs 40 and 41). The phrase “on paper” refers to paper form transmitted by physical means (see Note 8.05). Where, for the purposes of complying with a time limit, an applicant files a communication on paper with an Office that requires the filing of communications in electronic form or by electronic means of transmittal, that Office will be permitted to treat the filing on paper as a formal defect, and to require, under paragraph (7), that the communication be re-filed in an electronic form or by electronic means of transmittal complying with the requirements applied by that Contracting Party under Rule 5 bis(1).

[End of Alternative A]

[Alternative B]

8.03 *Paragraph (1)*. At the ninth session of the SCT (document SCT/9/9 Prov., paragraph 164), a number of delegations stated that provisions should make it clear that the Contracting Parties have the right to choose the means of transmittal by which they receive communications. This provision therefore states that any Contracting Party may determine how it wishes to receive communications, either on paper or electronically, according to its specific development requirements. However, this provision obliges a Contracting Party to choose the means of transmittal of communications in accordance with the requirements contained in Rule 5 bis(1) relating to the filing of communications on paper for the purpose of establishing a filing date and complying with a time limit.

8.04 The “means of transmittal” refers to the means, for example, to the physical or electronic means, used to transmit the communication to the Office. For example, an application on paper mailed to the Office is a communication in paper form transmitted by physical means, while a floppy disk mailed to the Office is a communication in electronic form transmitted by physical means. A telefacsimile transmission resulting in a paper copy is

a communication in paper form transmitted by electronic means, while a telefacsimile transmission to a computer terminal is a communication in electronic form transmitted by electronic means. In addition, an electronic transmission from computer to computer is a communication in electronic form transmitted by electronic means.

[End of Alternative B]

[Alternative C]

8.03. *Paragraph(1)*. As suggested at the ninth session of the SCT (document SCT/9/9 Prov., paragraph 164), this alternative states that any Contracting Party can determine how it wishes to receive communications, either on paper or electronically, according to its specific development requirements. It was further noted at the ninth session of the SCT (document SCT/9/9 Prov., paragraphs 166 and 167) that, although in some instances resorting to the language of the PLT could be useful, there was a need to go beyond that treaty and thus it was suggested (document SCT/9/9 Prov., paragraph 175) that all references to filing date and complying with that time limit should be taken out and to have only a general provision stating that Offices may choose the means of transmittal of communications.

[End of Alternative C]

8.08. *Paragraph(2)(a)*. This paragraph provides, generally, that a Contracting Party may require that any communication be in the language or one of the languages admitted by the Office. As agreed at the eighth session of the SCT (document SCT/8/7, paragraphs 72, 73 and 74) this provision deals globally with the language requirements for all the communications before the Office. Therefore the language provisions which were contained in Articles 3(3) (*Application*), 4(4) (*Power of Attorney*), 10(1) (c) (*Change in Name and Address*), 11(2) (*Change in Ownership*), 12(c) (*Correction of Mistakes*), 13(3) (*Renewal of Registration*) of the TL have been deleted. However, Article 5(1) (b) expressly provides that, for the purposes of the filing date, the indications and elements referred to in Article 5(1)(a) may be received in a language other than the language admitted by the Office under the present paragraph. The expression “the language or one of the languages admitted by the Office” refers to a verbal language and not, for example, to a computer language. What constitutes a language admitted by the Office remains a matter covered by the applicable law of the Contracting Party concerned.

8.09. The second sentence of Article 8(2) enables multilingual countries which allow the filing in different languages, to require the applicant, holder or other interested person, to comply with any other language requirements applicable with respect to their Offices, provided that the communication may not be required to be more than in one language.

8.10. *Paragraph(2)(b)*. At the ninth session of the SCT (document SCT/9/9 Prov., paragraph 196), it was suggested to add a provision to this Article according to which declarations or agreements written in a language which was not accepted by the Office, could be translated into the language of the Office. This provision is inspired from Article 11(2) of the TL and Article 2(4) (b) of the Joint Recommendation Concerning Trademark Licenses.

8.11. *Paragraph(3)*. As for the provisions related to the languages of communications, the SCT has decided that a generic provision within Article 8 should deal with the presentation of communications for all the different procedures relating to a mark before an Office. Therefore, the provisions previously contained in Articles 3(2) (*Application*), 4(3) (*Power of Attorney*), 10(1) (*Change in Name and Address*), 11(1) (*Change in Ownership*), 12(1) (*Correction of Mistakes*), 13(2) (*Renewal of Registration*) of the TLT have been deleted.

8.12. Under paragraph(3)a Contracting Party is obliged to accept the presentation of a communication when the contents of this communication – whether transmitted to the Office on paper or in electronic form or by electronic means – correspond to the Model International Form provided for in the Regulations in respect of such a communication. The International Model Forms correspond to the maximum requirements that a Contracting Party may provide for under the Treaty and the Regulations. They constitute a safeguard for applicants and holders because they cannot be required to provide indications or elements additional to those set out in the Model Form. At the same time use of the Model International Forms simplifies procedures for applicants, holders and Offices. However, the fact that a Contracting Party is obliged to accept a communication presented on a Form contained in the Regulations does not imply that the format or the language of the Form may not be changed by the Office. What matters here is the content of the communication more than its format. This point was clarified at the Diplomatic Conference for the Conclusion of the Trademark Law Treaty in two agreed statements (N°5 and 6) adopted by the Diplomatic Conference according to which any Contracting Party may provide for “Individualized International Forms” as long as these forms do not “contain references to mandatory elements that would be additional to the elements referred to in the corresponding International Model Forms and would be contrary to the Treaty or the Regulations.”

[Alternative A]

8.13. *Paragraph(3)*. As far as the presentation of the communication is concerned, Alternative A does not establish a distinction between the transmittal of a communication on paper and the transmittal of a communication in electronic form or by electronic means. This alternative gives more emphasis to the “contents” of the communication than to its format in order to comply with the specific technical requirements of the transmittal of communications in electronic form.

[End of Alternative A]

[Alternative B]

8.13 *Paragraph(3)*. Alternative B reproduces the structure of the different provisions of the TLT dealing with the requirements concerning the presentation and contents of communications, whether application, power of attorney, change in name or address, change in ownership, correction of mistakes or renewal of registration. As in Alternative A, emphasis

is given under subparagraph (ii) to the “contents” of the communication in order to comply with the specific technical requirements for the transmittal of communications in electronic form.

[End of Alternative B]

8.14. *Paragraph(4)*. The term “signature” which may be defined under Article (1), means any means of self-identification. It is implicit that the “signature” of a communication must be that of a person who is authorized to sign the communication concerned. Accordingly, the Office may reject the signature of a person who is not so authorized. Certain forms of signature that a Contracting Party shall accept, or may require, are expressly referred to under Rule 6(3) and (4), namely a hand-written, printed or stamped signature, a seal, a bar-coded label, or a signature filed in electronic form or by electronic means of transmittal. Since discussions on electronic signature are still underway at the international level, this provision is conceived in broad terms and makes an express reference to the Regulations where details may be fixed.

8.15. *Paragraph(4)(a)*. Regulations concerning the signature of communications filed on paper, in electronic form or by electronic means of transmittal are prescribed in Rule 6(4), (5) and (6).

8.16. *Paragraph(4)(b)*. This provision obliges a Contracting Party, unless otherwise provided in its national law, to accept the signature of the person concerned as sufficient authentication when the communication concerns the surrender of a registration without the need for further authentication by way of, for example, attestation or notarization of that signature, thereby reducing the burden on applicants and holders.

8.17. *Paragraph(4)(c)*. In case of reasonable doubt as to the authenticity of the signature, the Office may require the applicant, holder or other interested person filing the communication to file evidence of authenticity. Such evidence may, at the option of the applicant, holder or other interested person, be in the form of certification. The Office may be obliged to inform the applicant of the reason for its doubt.

8.18. *Paragraph(5)*. The indications that a Contracting Party may require under this paragraph are prescribed in Rule 6 *bis*(1). This provision has been redrafted in negative form as in the rest of the TLT as requested by the SCT at its ninth session (document SCT/8/7, paragraphs 90 and 91).

8.19. *Paragraph(6)(i) and (ii)*. What constitutes an address for correspondence or an address for legal service under these items is a matter for the applicable law of the Contracting Party concerned. It is also a matter for the applicable law of the Contracting Party concerned whether, and in what circumstances, the Office requires an address for correspondence or an address for legal service, or both, and in what communications such address(es) shall be indicated.

8.20. *Paragraph(6)(iii)*. This item is intended to provide for any future developments which necessitate a Contracting Party to require an address other than those under items (i) and (ii), for example, an e-mail address or other electronic location. At present, no provision for such other address is included in the Regulations.

8.21. *Paragraph(7)*. It is to be noted that, under this paragraph, the Office is required to notify either the applicant, holder or other interested person who filed the communication. The time limit provided for in this paragraph is prescribed under Rule 6 *ter*.

8.22. *Paragraph(8)*. The effect of the reference to Article 5 is that, where an application complies with the requirements under that Article for according a filing date, a Contracting Party is obliged to accord that filing date and cannot revoke the filing date for failure to comply with requirements applied under paragraphs (1) to (6), even where the application is subsequently refused or considered withdrawn under this paragraph. The time limit provided for in this paragraph is prescribed under Rule 6 *ter*.

Notes on Article 13 bis and 13 ter

[Alternative A]

Article 13 bis
(Relief in respect of Time Limits Fixed by the Office)

13bis.01. This Article obliges a Contracting Party to provide relief in respect of time limit fixed by the Office. Such relief may be in the form of an extension of a time limit under paragraph (1) (a) and/or continued processing under paragraph (1) (b). Such relief is only subject to the filing of a request in accordance with the requirements of paragraph (1) and Rule 9, and the payment of any fee required under paragraph (3). Accordingly, the applicant or holder cannot be required to state the grounds on which the request is based. In addition, in contrast to the reinstatement of rights under Article 13 *ter*, a Contracting Party is not permitted to make the grant of relief under Article 13 *bis* conditional on a finding of due care or unintentionality by the Office.

13bis.02. The relief that a Contracting Party is obliged to provide under paragraphs (1) (a) and (b) is restricted to time limits “fixed by the Office for an action in a procedure before the Office.” It is further subject to certain exceptions under paragraph (2) and Rule 9(5). It is for each Contracting Party to decide which time limits, if any, are fixed by the Office. An example of a time limit that is fixed by some Offices is the time limit for response to an examiner’s substantive examination report. It follows that Article 13 *bis* does not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation. It also does not apply to time limits for actions that are not before the Office, for example, actions before a court. Accordingly, although a Contracting Party is free to apply the same requirements in respect of such other time limits, it is also free to apply other requirements, or to make no provision for relief (other than reinstatement of rights under Article 13 *ter*), in respect of those other time limits.

13bis.03. Paragraph (1) obliges a Contracting Party to provide for relief after the applicant or holder has failed to comply with that time limit fixed by the Office. The phrase “after the applicant or holder has failed to comply with that time limit” has been deleted from the Article as it is implicit.

13bis.04. *Paragraph(1)*. This paragraph has been redrafted in order to reflect the suggestions made at the ninth session of the SCT. At that session, clarification was sought (document SCT/9/9 Prov., paragraph 212) about the difference between a request in respect of an extension of the time limit filed after the expiration of the time limit and continued processing. Revised paragraph (1) states that a Contracting Party may choose whether it provides for relief in the form of the extension of a time limit fixed by the Office and/or of continued processing. Under subparagraph (a), extension of a time limit has to be requested prior to the expiration of the time limit, and under subparagraph (b) continued processing may be requested after the expiration of the time limit and within the time limit prescribed in Rule 9(4). A Contracting Party may, of course, provide for both types of relief under subparagraphs (a) and (b). The possibility to file a request for an extension of a time limit after the expiration of the time limit has been deleted since, as noted above, an extension of a time limit requested after the expiration of the time limit has in fact the same effect as continued processing.

13bis.05. The requirements in respect of the request for the extension of a time limit under subparagraph (a) and the period of extension are prescribed in Rule 9(1) and (2). Concerning the request for continued processing under subparagraph (b), the requirements and the time limit for filing a request are prescribed in Rule 9(3) and (4). In particular, a Contracting Party shall, under Rule 9(3) (a), require that all of the requirements in respect of which the time limit to be extended applied be complied with, within the time limit prescribed in Rule 9(4). In this respect, any Contracting Party may require that all of the above requirements be complied with at the same time as the request is filed.

13bis.06. The effect of continued processing is that the Office continues with the procedure concerned as if the time limit had been complied with. Also the Office must, if necessary, reinstate the rights of the applicant or holder with respect to the application or registration concerned.

13bis.07. *Paragraph(2)*. The exceptions under this paragraph are prescribed in Rule 9(5).

13bis.08. *Paragraph(3)*. Although a Contracting Party is permitted to charge a fee under this paragraph, it is not obliged to do so.

13bis.09. *Paragraph(4)*. This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1) and (3). In particular, the applicant or holder concerned cannot be required to state the ground on which the request is based or to file evidence with the Office. The requirements referred to in this paragraph which are "otherwise provided for by this Treaty or prescribed in the Regulations" are, in particular, those under Articles 4 and 8 and Rules 4, 5 bis and 6.

13bis.10. *Paragraph(5)*. This paragraph only gives the requesting party the right to make observations on the intended refusal of a request under paragraph (1) (a) or (b), for example, to assert that a fee required under paragraph (3) had in fact been paid. The term "intended refusal" does not imply that a Contracting Party would have to notify an applicant prior to refusal, giving him the opportunity to show the cause why a request should not be denied. This paragraph does not provide an additional time limit to comply with any requirement under Article 13bis or Rule 9 that was not complied with in making the request. This

paragraph does not regulate the form of observations which an applicant or holder must be given an opportunity to make. The term “refusal” is meant to also cover sanctions which are of equivalent effect to refusal of the request under paragraph (1), such as the request being treated as abandoned or withdrawn.

Article 13ter

(Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office)

13ter.01. This Article obliges a Contracting Party to provide for the reinstatement of rights with respect to an application or registration following failure to comply with a time limit for an action in a procedure before the Office. In contrast to Article 13bis, such reinstatement is subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or, at the option of the Contracting Party, was unintentional. Also in contrast to Article 13bis, Article 13ter is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (2) and Rule 10(3).

13ter.02. *Paragraph (1), Introductory Words*. The phrase “that failure has the direct consequence of causing a loss of rights with respect to an application or a procedure concerning a mark” is intended to cover the situations where a failure to comply with a time limit causes a loss of rights with respect to the ability to obtain or maintain a registration.

13ter.03. *Item (i)*. The requirements under this item are prescribed in Rule 10(1).

13ter.04. *Item (ii)*. The time limit under this item is prescribed in Rule 10(2).

13ter.05. *Item (iii)*. The applicant or holder may be required under paragraph (4) to file a declaration or other evidence in support of the reasons referred to in this item.

13ter.06. *Item (iv)*. This item restricts reinstatement of rights under paragraph (1) to cases where the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances, or, at the option of the Contracting Party, was unintentional, for example, where there had been a loss in the mail or an interruption in the mail service. In making that finding, the Office may allow interested third parties to oppose to the request for reinstatement of rights.

13ter.07. *Paragraph (2)*. The exceptions under this paragraph are prescribed in Rule 10(3).

13ter.08. *Paragraph (3)*. Reference is made to the explanations given under Article 13bis.08.

13ter.09. *Paragraph (5)*. This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1), (3) and (4). This provision allows the Office to require evidence in support of the reasons, in accordance with paragraph (4) but not other requirements which are not allowed under the Treaty or its Regulations. The requirements referred to in this paragraph which are “otherwise provided for by this Treaty or prescribed in the Regulations” are, in particular, those under Articles 4, 5bis and 6.

13ter.10. *Intervening Rights*. The Treaty and Regulations do not regulate the rights, if any, acquired by a third party for any acts which were restarted, or for which effective and serious preparations were restarted, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated. These remain a matter for the applicable law of the Contracting Party concerned.

[End of Alternative A]

[Alternative B]

Article 13bis

(Relief in Respect of Time Limits Fixed by the Office and Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office)

13bis.01 Alternative B combines in one simplified article the provision contained in Article 13 bis (Relief in respect of time limits) and Article 13 ter (Reinstatement of rights). Under this alternative, a Contracting Party is obliged to provide for relief in respect of time limits under paragraph (1) (whether in the form of an extension of the time limit or in the form of continued processing, or both) and for reinstatement of rights under paragraph (2).

13bis.02. *Paragraph (1)*. This paragraph obliges a Contracting Party to provide relief in respect of time limits fixed by the Office. Such relief may be in the form of an extension of a time limit under paragraph (1)(i) and/or continued processing under paragraph (1)(ii). Such relief is only subject to the filing of a request in accordance with the requirements of paragraph (1) and Rule 9, and the payment of any fee required under paragraph (4). Accordingly, the applicant or holder cannot be required to state the grounds on which the request is based. In addition, in contrast to the reinstatement of rights under paragraph (2), a Contracting Party is not permitted to make the grant of relief under paragraphs (1)(i) and (ii) conditional on a finding of due care or unintentionality by the Office.

13bis.03. The relief that a Contracting Party is obliged to provide under paragraphs (1)(i) and (ii) is restricted to time limits "fixed by the Office for an action in a procedure before the Office." It is further subject to certain exceptions under paragraph (3) and Rule 9(7). It is for each Contracting Party to decide which time limits, if any, are fixed by the Office. An example of a time limit that is fixed by some Offices is the time limit for response to an examiner's substantive examination report. It follows that paragraph (1) does not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation. Neither does it apply to time limits for actions that are not before the Office, for example, actions before a court. Accordingly, although a Contracting Party is free to apply the same requirements in respect of such other time limits, it is also free to apply other requirements, or to make no provision for relief (other than reinstatement of rights under paragraph (2)), in respect of those other time limits.

13bis.04 Paragraph (1) has been redrafted in order to reflect the suggestions made at the ninth session of the SCT. At the ninth session of the SCT, clarification was sought (document SCT/9/9 Prov., paragraph 212) about the difference between a request in respect of an extension of a time limit filed after the expiration of the time limit and continued processing. Revised paragraph (1) states that a Contracting Party may choose whether it provides for

relief in the form of the extension of a time limit fixed by the Office and/or of continued processing. Under item (i) extension of a time limit has to be requested prior to the expiration of the time limit (as provided for in Rule 9(1) (a)), and under item (ii) continued processing may be requested after the expiration of the time limit and within the time limit prescribed in Rule 9(4). A Contracting Party may, of course, provide for both types of relief under items (i) and (ii). The possibility to file a request for an extension of a time limit after the expiration of the time limit has been deleted since, as noted above, an extension of a time limit requested after the expiration of the time limit has in fact the same effect as continued processing.

13bis.05. The requirements in respect of the request for the extension of a time limit under subparagraph (1)(i), the period of extension, and the time limit for filing a request are prescribed in Rule 9(1) and (2). Concerning the request for continued processing under subparagraph (1)(ii) the requirements and the time limit for filing a request are prescribed in Rule 9(3) and (4). In particular, a Contracting Party shall, under Rule 9(3)(a), require that all of the requirements in respect of which a time limit to be extended applied be complied with within the time limit prescribed in paragraph (4). A Contracting Party may also require that the above requirements are complied with at the same time as the request under item (ii) is filed.

13bis.06. The effect of continued processing is that the Office continues with the procedure concerned as if the time limit had been complied with. Also, the Office must, if necessary, reinstate the rights of the applicant or holder with respect to the application or registration concerned.

13bis.07. *Paragraph (2)*. Paragraph (2) obliges a Contracting Party to provide for the reinstatement of rights with respect to an application or a registration following failure to comply with that time limit for an action in a procedure before the Office. In contrast to paragraph (1) such reinstatement is subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or, at the option of the Contracting Party, was unintentional. Also in contrast to paragraph (1), paragraph (2) is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (3) and Rule 9(7).

13bis.08. The phrase “that failure has the direct consequence of causing a loss of rights with respect to an application or a procedure concerning a mark” is intended to cover situations where a failure to comply with that time limit causes a loss of rights with respect to the ability to obtain or maintain a registration.

13bis.09. *Paragraph (3)*. The exceptions under this paragraph are prescribed in Rule 9(7).

13bis.10. *Paragraph (4)*. Although a Contracting Party is permitted to charge a fee under this paragraph, it is not obliged to do so.

13bis.11. *Paragraph (5)*. This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1), (2) and (4). In particular, the applicant or holder concerned cannot be required to state the grounds on which the request is based or to file evidence with the Office as regards paragraph (1). However, this provision

allow the Office to require evidence in support of the reasons in accordance with Rule 9(5)(c)(ii). The requirements referred to in this paragraph which are “otherwise provided for by this Treaty or prescribed in the Regulations” are, in particular, those under Articles 4 and 8 and Rules 4, 5 *bis* and 6.

13bis.12. *Paragraph(6)*. This paragraph only gives the requesting party the right to make observations on the intended refusal of a request under paragraph (1) to (2), for example, to assert that a fee required under paragraph (4) had in fact been paid. The term “intended refusal” does not imply that a Contracting Party would have to notify an applicant prior to refusal, giving him the opportunity to show the cause why a request should be denied. This paragraph does not provide an additional time limit to comply with any requirement under Article 13bis or Rule 9, which was not complied with, when the request was filed. This paragraph does not regulate the form of observations which an applicant or holder must be given an opportunity to make. The term “refusal” is meant to also cover sanctions which are of equivalent effect to refusal of the request under paragraphs (1) or (2), such as the request being treated as abandoned or withdrawn.

13bis.13. *Intervening Rights*. The Treaty and Regulations do not regulate the rights, if any, acquired by a third party for any acts which were started, or for which effective and serious preparations were started, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated. These remain a matter for the applicable law of the Contracting Party concerned.

[End of Alternative B]

EXPLANATORY NOTES ON THE REGULATIONS

Notes on Rule 5bis
(Communications Under Article 8)

[Alternative A]

R5bis.01 *Paragraph(1)*. This provision reproduces the PLT provision and guarantees, until [month, day, year], the rights of applicants, holders and other interested persons to file communications on paper with the Office of any Contracting Party. After that date, any Contracting Party will be permitted, but not required to exclude the filing of communications on paper, except for the purposes of a filing date under Article 5(1) and for meeting a time limit under Article 8(1)(d) (see Note 8.07). Accordingly, this provision has no effect for the Office of a Contracting Party that does not accept the filing of communications other than on paper. Moreover, communication with the Office, originating from abroad is generally made through national representatives who have access to electronic filing.

R5bis.02 While discussing this provision, the SCT referred to the agreed Statement adopted by the PLT Diplomatic Conference, with a view to facilitating the implementation of Rule 5bis(1) (document SCT/9/9 Prov., paragraphs 162 and 180). As for the PLT, it was suggested that the Diplomatic Conference should request the General Assembly of the World Intellectual Property Organization (WIPO) and the Contracting Parties to provide developing countries, least -developed countries and countries in transition with additional technical assistance to meet their obligations under this Treaty.

[End of Alternative A]

[Alternative B]

R5bis.01. *Paragraph(1)*. Although Alternative B of Article 8 guarantees that Offices are free to choose the means of transmittal, it introduces the possibility, as in the PLT, for a Contracting Party to accept the filing of communications on paper for the purpose of establishing a filing date under Article 5(1) and of complying with a time limit.

[End of Alternative B]

[AlternativeC]

R5bis.01. *Paragraph(1)*. This provision guarantees the Office a complete freedom to choose the means of transmittal and to accept communication electronically and on paper. Delegations at the ninth session of the SCT (document SCT/9/9Prov., paragraphs 156 and 159) suggested that the wording “no Contracting Party is obliged, against its wishes, to accept a particular form of transmittal of communications” should be transferred to the notes. It was also noted at the ninth session of the SCT (document SCT/9/9Prov., paragraph 177) that, since new means of transmittal of communications may come up in the future, such a broad provision may cover these technological changes.

[End of AlternativeC]

R5bis.02. *Paragraph(2)*. Where a document is prepared on a computer and directly transmitted by telefacsimile, a printout of that document from the computer could be considered as the original.

Notes on Rule 6

(Details Concerning the Signature Under Article 8(4))

R6.01. *Paragraph (1)*. This paragraph applies to the signature of any natural person, including the case where a natural person signs on behalf of a legal entity. Item (ii) applies, in particular, where a person signs on behalf of a legal entity.

R6.02. *Paragraph(4)*. This paragraph applies to cases, for example, where communications are filed by telefacsimile resulting in the filing of communications on paper on which the graphic representation of the handwritten signature appears. It also applies to communications filed by telefacsimile transmission to a computer terminal on which the graphic representation of the handwritten signature appears. In accordance with Rule 5 bis(2) a Contracting Party may, in all cases, require the filing of the original of the transmitted document on which the original signature appears. In addition, where the Office has reasonable doubt as to the authenticity of a signature, it may request evidence under Article 8(4)(c) (see Note 8.17). At the ninth session of the SCT, it was emphasized (document SCT/9/9 paragraph 205) that a signature could be required for any communication. As regards the terms “electronic form” and “electronic means of transmittal,” reference is made to the explanation under Article 8(1) (see Note 8.05 of Alternative A).

R6.03. *Paragraph (5)*. This paragraph applies to signatures on communications filed in electronic form that are not covered by the provisions under paragraph (4), because the signature does not appear as a graphic representation.

R6.04. *Paragraph (6)*. A “signature in electronic form” that may be required under this provision may be, for example, a signature in electronic or digital form attached to or logically associated with an electronic record which may be used to identify the signer of the electronic record and indicate the signer’s approval of the information contained in the electronic record. A Contracting Party may further require that such a signature in electronic

form be uniquely linked to the signer, be capable of identifying the signer, be created using means that the signer can maintain his sole control and be linked to the information contained in the electronic record in such a manner that any subsequent change of the data is detectable. It also could be a means of self-identification using an ID number and a password.

Notes on Rule 6bis

(Details Concerning Indications Under Article 8(5), (6) and (8))

R6bis.01. *Paragraph(1)(a), item(iii)*. The registration number or other indication referred to in this item may be required for data capture. In the case of electronic communications, it could be a personal identification number (PIN), or a digital certificate containing a registration number.

R6bis.02. *Paragraph(1)(b), item(iii)*. Reference is made to the explanation under paragraph (1)(a)(iii) (see Note R6 bis.01).

R6bis.03. *Paragraph(3)*. This provision obliges a Contracting Party to treat, in the absence of an indication to the contrary, the address of an unrepresented applicant, holder or other interested person as the address for correspondence and the address for legal service under Article 8(6)(i) and (ii). It is to be noted that paragraph (3) does not prevent a Contracting Party from requiring a holder to indicate an address, on its territory, if that holder wishes to receive notifications in respect of the payment of renewal fees.

R6bis.04. *Paragraph(4)*. This provision obliges a Contracting Party to treat, in the absence of an indication to the contrary, the address of a representative as the address for correspondence and the address for legal service under Article 8(6)(i) and (ii). In addition, if that address is not on the territory of the Contracting Party, it may be envisaged that the Contracting Party may require that the address provided by the representative be on a territory prescribed by it. It is to be noted that paragraph (4) does not prevent a Contracting Party from requiring a representative to indicate an address, on its territory, for notifications in respect of the payment of renewal fees.

R6bis.05. *Paragraph(5)*. The term “refusal” is intended also to cover sanctions which are of equivalent effect to refusal of the application, such as the application being treated as abandoned or withdrawn.

Notes on Rules 9 and 10

[Alternative A]

Rule 9

(Details Concerning Relief in Respect of Time Limits Under Article 13bis)

R9.01. *Paragraph(1)*. The request for the extension of a time limit shall always be filed prior to the expiration of that time limit, in contrast to the request for continued processing which may be filed after the expiration of that time limit.

R9.02. *Paragraph(3)(a)*. A Contracting Party shall require that all of the requirements be complied with within the time limit prescribed in paragraph(4). In other words, the Contracting Party may require that the above requirements be complied with at the same time as the request is filed, or it may allow the applicant, holder or a third party to submit further documents after having filed the request but within the time limits prescribed in paragraph(4).

R9.03. *Paragraph(5)(a)*. This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the extension of a time limit under Article 13 *bis(1)(a)* or continued processing under Article 13 *bis(1)(b)* although it is permitted to do so.

R9.04. *Item(i)*. Under this item, a Contracting Party is not obliged to grant more than one instance of relief under Article 13 *bis(1)(a)* or (*b*) although it is permitted to do so. It is similarly not obliged to grant continued processing under Article 13 *bis(1)(b)* after an extension of the time limit concerned has been previously granted under Article 13 *bis(1)(a)*. Any second or subsequent instance of relief that is granted is not regulated by Article 13 *bis(1)* or Rule 9, so that a Contracting Party is permitted to grant shorter extension than, and/or to apply requirements which are additional to, or different from, those under that Article and that Rule.

R9.05. *Item(ii)*. This item is intended to prevent an applicant or holder from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R9.06. *Item(iii)*. Although, under this item, a Contracting Party is not obliged to provide for the extension of, or continued processing in respect of a time limit fixed for the payment of renewal fees, it is still obliged to provide a period of grace for the payment of such fees under Article 5 *bis(1)* of the Paris Convention.

R9.07. *Item(v)*. The PLT Diplomatic Conference understood that, while it was appropriate to exclude actions in relation to *inter partes* proceedings from the relief provided by the PLT, it was desirable that the applicable law of Contracting Parties provide appropriate relief in those circumstances which take into account the competing interests of third parties, as well as those interests of others who are not parties to the proceedings (Agreed Statement No. 5). As regards trademarks, opposition proceedings may include *inter partes* correspondence which, under certain circumstances, might require a succession of reliefs.

R9.08. *Paragraph(5)(b)*. This provision ensures that the provisions of the applicable law in respect of a maximum time limit for the grant of a trademark prevail over relief in respect of a time limit fixed by an administrative action of the Office.

Rule 10

(Details Concerning Reinstatement of Rights After a Finding of Due Care or Unintentionality by the Office Under Article 13ter)

R10.01. *Paragraph(3)*. This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the reinstatement of rights under Article 13ter, although it is permitted to do so.

R10.02. *Item(ii)*. This item is intended to prevent an applicant or holder from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R10.03. *Item(iii)* .ReferenceismadetoNote R09.07.

R10.04. *Item(iv)* .Although,underthisitem,aContracting Partyisnotobligedtoprovideforareinstatementofrights,itisstillobligedtoprovideforaperiodofgraceforthepaymentofsuchfeesunderArticle5 *bis*(1)oftheParisConvention.AttheninthsessionoftheSCT,somedelegationsexpressedtheopinionthatthescopeofthisRulewastoobroadbecauseitalsoappliedtorenewals(documentSCT/9/9Prov.,paragraph250).Otherdelegations(documentSCT/9/9Prov.,paragraphs253,255,256)favoreddthepossibilityofareinstatementofrights,whichcouldgobeyondthegraceperiodinrespectofrenewals.

R10.05. *Items(v),(vi)and(vii)* .ItwassuggestedattheninthsessionoftheSCT(documentSCT/9/9Prov.,paragraphs214,257,258)thatthepriorityclaimsshouldnotbesubjecttoreinstatementofrights.However,theContractingPartiesmaypermitreinstatementofrightsundertheapplicablenationallaw.

[EndofAlternativeA]

[AlternativeB]

Rule9

(DetailsConcerningReliefinRespectofTimeLimitsandReinstatementofRightsAfter FindingofDueCareorUnintentionalitybytheOffice[UnderArticle13bis]) a

R9.01. *Paragraph(1)(a)*. Therequestfortheextensionofatimelimitshallalwaysbefiled *prior* totheexpirationofthattimelimit,incontrasttotherequestforcontinuedprocessingwhichmaybefiled *after*theexpirationofthattimelimit.

R9.02. *Paragraph(3)(a)*. AContractingPartyshallrequirethatalloftherequirementsbecompliedwithwithinthetimelimitprescribedinparagraph(4).AContractingPartymay requirethattheaboverequirementsbecompliedwithatsametimeastherequestisfiledorit mayallowtheapplicant,holderorthirdpartytosubmitfurtherdocumentsafterhavingfiled therequestbutwithinthetimelimitsprescribedinparagraph (4).

R9.03. *Paragraph(5)(b)*. AContractingPartymayprovideforcontinuedprocessing insteadofreinstatementofrightswheretherequirementsinrespectofsuchcontinued processingaremorefavorable,fromthepointofviewofapplicantsorholders, thanthe requirementsconcerningreinstatementofrights.

R9.04. *Paragraph(7)(a)* .ThisprovisionlistsproceduresinrespectofwhichaContracting PartyisnotobligedtoprovidefortheextensionofatimelimitunderArticle13 *bis*(1)(a)or continuedprocessingunderArticle13 *bis*(1)(b)orareinstatementofrightsunder Article13*bis*(2)althoughitispermittedtodoso.

R9.05. *Item(i)* .Underthisitem,aContractingPartyisnotobligedtograntmorethanone instanceofreliefunderArticle13 *bis*(1)althoughitispermittedtodoso.Itissimilarlynot obligedtograntcontinuedprocessingunderArticle13 *bis*(1)(ii)afteranextensionofthetime

limit concerned has been previously granted under Article 13 *bis*(1)(i). Any second or subsequent instance of relief that is granted is not regulated by Article 13 *bis*(1) or Rule 9, so that a Contracting Party is permitted to grant shorter extensions than, and/or to apply requirements which are additional to, or different from, those under that Article and that Rule.

R9.06. *Item(ii)*. This item is intended to prevent an applicant or holder from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R9.07. *Item(iii)*. Although, under this item, a Contracting Party is not obliged to provide for the extension of, or continued processing in respect of a time limit fixed for the payment of renewal fees, it is still obliged to provide a period of grace for the payment of such fees under Article 5 *bis*(1) of the Paris Convention. At the ninth session of the SCT, some delegations expressed the opinion that the scope of this Rule was too broad because it also applied to renewals (document SCT/9/9 Prov., paragraph 250). Other delegations (document SCT/9/9 Prov., paragraphs 253, 255, 256) favored the possibility of a reinstatement of rights, which could go beyond the grace period in respect of renewals.

R9.08. *Item(v)*. The PLT Diplomatic Conference understood that, while it was appropriate to exclude actions in relation to *inter partes* proceedings from the relief provided by the PLT, it was desirable that the applicable law of Contracting Parties provide appropriate relief in those circumstances which takes into account the competing interests of third parties, as well as those interests of others who are not parties to the proceedings (Agreed Statement No. 5). As regards trademarks, opposition proceedings may include *inter partes* correspondence which under certain circumstances, might require a succession of reliefs.

R9.09. *Items(vi), (vii) and (viii)*. It was suggested at the SCT (document SCT/9/9 Prov., paragraphs 214, 257, 258) that the priority claim should not be subject to reinstatement of rights. However, the Contracting Parties may permit the reinstatement of rights under the applicable national law.

R9.10. *Paragraph(5)(b)*. This provision ensures that the provisions of the applicable law in respect of a maximum time limit for the grant of a trademark prevail over relief in respect of a time limit fixed by an administrative action of the Office.

[End of Alternative B]

[End of Annex and of document]