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NOTES ON THE DRAFT REVISED TRADEMARK LAW TREATY
AND THE DRAFT REVISED REGULATIONS

prepared by the Secretariat

The present document contains Notes on the draft revised Trademark Law Treaty and the draft revised Regulations contained in documents SCT/13/2 and SCT/13/3, respectively.

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I. NOTES ON THE DRAFT REVISED TRADEMARK LAW TREATY

Notes on Article 1
(Abbreviated Expressions)

1.01 *Item (i).* The term "Office" includes both the national Office of any State that is a Contracting Party to the Treaty, and the regional Office of any intergovernmental organization that is a Contracting Party, in accordance with Article 27(1).

1.02 *Item (iv).* This item covers all communications received by the Office, including communications that are not specified in the Treaty or in the Regulations, for example, a request for recording a security interest or other restriction of the rights of the holder. In accordance with Article 8(6) there is only an obligation to comply with the requirements concerning communications as set out in Article 8(1) to (5).

1.03 *Item (v).* Neither the Treaty nor the Regulations contain a definition of what constitutes a legal entity. This is left to the applicable law of the Contracting Party where protection of a mark is sought. The question of whether an entity other than a natural person or a legal entity, for example a firm or partnership that is not a legal entity, is considered a person for the purpose of any procedure covered by the Treaty and the Regulations, remains a matter for the applicable law of the Contracting Party concerned.

1.04 *Item (vi).* Where the applicable law of a Contracting Party provides that several persons may jointly be holders, the word "holder" should be construed as including "holders".

1.05 *Item (vii).* The term "register of marks" is restricted to the collection of data concerning registered marks, excluding therefore the collection of data concerning pending applications.

1.06 *Item (viii).* The expression "procedure before the Office" covers any procedure in which an applicant, holder or other interested person communicates with the Office, either to initiate proceedings before the Office or in the course of such proceedings. It covers all procedures in proceedings before the Office and is therefore not restricted to those procedures which are referred to in express terms. Examples of such procedures are the filing of an application, the filing of a request for recording of a license, the payment of a fee, the filing of a response to a notification issued by the Office, or the filing of a translation of an application. It also covers procedures in which the Office contacts an applicant, holder or other interested person in the course of proceedings relating to an application or a registration, for example, the issuance of a notification that an application does not comply with certain requirements, or the issuance of a receipt for a document or a fee. It does not cover procedures which, for legal purposes, are not part of the proceedings before the Office with respect to an application or a registration, for example, the purchase of a copy of a published application or the payment of a bill for information services provided by the Office to the public. It is understood that the words "procedure before the Office" would not cover judicial procedures under the applicable law.

Notes on Article 2
(Marks to Which the Treaty Applies)

2.01 *Paragraph (1)(a).* The Treaty does not define what is meant by "mark", nor does it specify what signs have to be registered as marks. However, to the extent that under the applicable law visible signs may be registered as marks, the Treaty would apply to such marks. Hologram marks are excluded from the provision since, as in case of non-visible marks under paragraph (1)(b), they cannot be easily represented in graphical form.

2.02 *Paragraph (1)(b).* Marks that do not consist of visible signs, for example, sound marks and olfactory marks are not covered by the Treaty. One of the reasons for this is that they cannot be easily represented in graphical form. However, if a Contracting Party provides for the registration of such marks, it should, to the extent possible, apply the provisions of the Treaty to those marks.

2.03 *Paragraph (2)(a).* Service marks are marks used to identify services, as opposed to products. Service marks function in the same way as trademarks. Contracting Parties are obliged under Article 16 of the Treaty to also register service marks.

2.04 *Paragraph (2)(b).* Contracting Parties are not bound to apply the Treaty to collective marks, certification marks and guarantee marks. The reason is that the registration of those marks often requires the fulfillment of special, varying conditions in the different countries, a fact that would make harmonization particularly difficult. Furthermore, the number of such marks as compared to the total number of marks is very small.

2.05 Given the specific nature of the procedures established under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, this Treaty does not apply to such procedures.

Notes on Article 3
(Application)

3.01 *Paragraph (1)(a).* This provision contains a list of indications and elements that may be required in respect of an application. It establishes a maximum list of formal requirements that Contracting Parties are allowed to provide for the purposes of obtaining a registration. As follows from the introductory phrase of paragraph (4), the list is exhaustive, except where the applicant claims the benefit of Article 6*quinquies* of the Paris Convention (see Note 3.28).

3.02 *Item (i).* An Office can consider that an application which does not contain an express request for registration is defective. It is to be noted, however, that under Article 5(1)(a)(i) even an implicit request for registration is sufficient for the purposes of according a filing date.

3.03 *Item (ii).* The details concerning the indication of the name and address of the applicant are specified in the Regulations (see Rule 2(1)(a) and (2)).

3.04 *Item (iii).* The indication of a State of nationality, of a State of domicile and of a State of real and effective industrial or commercial establishment may be relevant for the application of international conventions (see, for example, Articles 2 and 3 of the Paris Convention). It follows from the introductory phrase of paragraph (1)(a) that a Contracting Party has freedom not to require those indications, or require only some of them.

3.05 *Item (iv).* Where, in a State, a legal entity may be constituted under the particular law of a territorial unit existing within such State, the name of that territorial unit must be given. A Contracting Party may require the indication of both the name of the State, and, where applicable, the name of the territorial unit within that State (for example, United States of America and California).

3.06 *Item (v).* The details concerning the indication of the name and address of the representative are specified in the Regulations (see Rule 2). The representative can be a natural person, a legal entity or a partnership.

3.07 *Item (vii).* This item does not affect the applicable provisions of a Contracting Party concerning the cases where the priority is claimed subsequent to the filing of the application, a possibility which is allowed under Article 4D(1), last sentence of the Paris Convention. Moreover, this item does not affect the possibility of asking, subsequent to the filing of the application, for proof under Article 4D(3) and (5) of the Paris Convention. Finally, in view of Article 16 of the Treaty, it should be noted that Contracting Parties must apply the provisions of the Paris Convention relating to the claiming of priority not only to trademarks but also to service marks.

3.08 *Item (viii).* This item would apply where the temporary protection referred to in Article 11 of the Paris Convention may be invoked. Its inclusion in Article 3(1)(a) does not mean, however, that a Contracting Party is prevented from allowing the benefit of such temporary protection to be invoked at a later stage. Nor does it affect the possibility of requiring, under Article 11(3) of the Paris Convention, documentary evidence as proof of identity of the article or articles exhibited and of the date of its or their introduction in the international exhibition. Furthermore, in view of Article 16 of the Treaty, Contracting Parties must apply the provisions of Article 11 of the Paris Convention also to service marks. Finally, this provision enables an applicant to take advantage of a temporary protection resulting from the presentation of goods or services in a national exhibition if the law of the Contracting Party allows for such a possibility.

3.09 *Item (ix).* The consequences of such a statement are specified in the Regulations (see Rule 3(1)).

3.10 *Item (x).* The fact that the applicant claims color has consequences on the number of reproductions of the mark which have to be furnished (see Rule 3(2)).

3.11 *Item (xi).* A Contracting Party may require that the applicant state that the mark is a three-dimensional mark, even if this could be inferred from the reproduction of the mark.

3.12 *Item (xii).* The details relating to the number and type of reproduction are dealt with in the Regulations (see Rules 3(2) and (3)). Rule 3(3) defines what is meant by “reproduction” in the case of a three-dimensional mark. This provision does not restrict a Contracting Party’s

freedom to refuse a reproduction the quality of which is insufficient for the purposes of, *inter alia*, publication.

3.13 *Item (xiii).* The details concerning transliteration are contained in the Regulations (see Rule 3(4)).

3.14 *Item (xiv).* Contracting Parties may wish to require a translation of the mark, for example, in order to evaluate the distinctive character of the mark or a possible conflict with public order. The details concerning translation are contained in the Regulations (see Rule 3(5)).

3.15 *Item (xv).* Whereas a grouping of names of goods and/or services according to the classes of the Nice Classification is required, the use of the precise terms of the Alphabetical List established in respect of that Classification is not required. The goods and/or services must be listed in the language, or in one of the languages, admitted by the Office where the application is filed. As regards the terms used by an applicant to designate the goods and/or services in the application, a Contracting Party is free, in the course of examination of that application, to require that any term that is general or too vague be replaced by a term or terms that is or are specific and clear.

3.16 *Item (xvi).* The words "as required by the law of the Contracting Party" indicate that such a declaration would have to be worded in the terms and in the language prescribed by the law of the Contracting Party.

3.17 The expression "law" is to be understood to include, in this provision and throughout the Treaty and the Regulations, all binding norms issued by the legislative or the executive branches of the Contracting Party, including any rules issued by the Office, as well as court decisions.

3.18 *Paragraph (1)(b).* If an applicant makes actual use of his mark in respect of all the goods and/or services listed in the application, he may file his application on the basis of actual use. He may also file his application on the basis of both intention to use and actual use where he actually uses the mark in respect of some of the goods and/or services listed in the application and intends to use the mark in respect of the other goods and/or services listed in the application. This provision corresponds to a provision existing, for example, in the laws of Canada and the United States of America.

3.19 *Paragraph (1)(c).* In addition to the fee to be paid in respect of the application, there may be separate fees for the publication of the application and the registration. However, it is also possible (and compatible with the Treaty) to combine those fees and require payment of such a combined fee (which may nevertheless be called "application fee") at the time of filing the application.

3.20 *Paragraph (2).* Contracting Parties are free to base the amount of the fee to be paid for an application on the number of classes to which belong the goods and/or services included in the application. Thus, for Contracting Parties at present practicing a single class application system, the transition to the multiclass application system provided for by the Treaty need not cause any loss of fee income.

3.21 *Paragraph (3).* A requirement relating to the furnishing of evidence of actual use of the mark prior to the registration of the mark, in cases where the application was not filed on the basis of actual use, exists in a few countries (for example, Canada and the United States of America).

3.22 The Regulations provide in Rule 3(6) for a minimum time limit for furnishing evidence of actual use under paragraph (3), and for the right to extend such time limit, subject to the conditions provided under the law of a Contracting Party.

3.23 *Paragraph (4).* This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) and (3) and Article 8 not only at the time of filing of the application but also throughout the application stage ending with registration, subject to the possibility of requiring under paragraph (5) the furnishing of evidence. It should, however, be understood that paragraph (4) does not preclude a Contracting Party from requiring, where necessary, during the examination of an application, additional indications from the applicant concerning the registrability of the mark, for example, a statement of consent from a person whose name is the same as, or appears in the mark, documents to the effect of ensuring compliance with Article *6ter* of the Paris Convention or documents concerning the ability of a certain person (such as a minor or a person under tutelage) to file an application.

3.24 *Items (i) to (iv).* The examples given in items (i) to (iv) concern information or documents which cannot be required during the whole pendency of an application. The list is not exhaustive. The items listed merely serve to illustrate the effects of the Treaty with respect to some formalities which are particularly unnecessary and undesirable.

3.25 Under item (i) a requirement to furnish a certificate of, or an extract from, a register of commerce is prohibited because an applicant's *bona fide* existence and legal standing under the law of the applicant's country of establishment should be presumed by the Office. The likelihood that fictitious persons or irregular entities would go through the process of applying for the registration of marks seems very low, and does not seem to justify the inconvenience of requiring that all applicants submit certifications from a registry of commerce. Moreover, any obligation to submit a certification of establishment in the country where registration is sought would be proscribed by virtue of Article 2(2) of the Paris Convention.

3.26 Under item (ii) the requirement to submit an indication of the carrying on of an industrial or commercial activity, and the furnishing of evidence to that effect, is prohibited because marks may be owned by entities which themselves do not carry on an industrial or commercial activity, for example, holding companies.

3.27 Under item (iii) a requirement to submit an indication or evidence that the applicant is carrying on an activity corresponding to the goods or services listed in the application is prohibited because very often trademark applications are filed before the corresponding goods or services are actually put on the market. Many laws establish a period of time to allow the trademark owner to start using his mark in respect of the specified goods or services. Such periods may vary between three years counted from the date of filing and five years after registration. Failure to use the mark for the goods or services listed in the application or registration after those periods have expired may entail consequences under the applicable laws, including refusal or cancellation of registration.

3.28 Item (iv) reflects the rule of independence of marks under Article 6 of the Paris Convention. It prohibits making the protection of a mark dependent on its registration in another country party to the Paris Convention, including the country of origin. Therefore, evidence to the effect that the mark has been registered in another Contracting Party or in a State party to the Paris Convention which is not a Contracting Party of the TLT cannot be required. However, Article 6*quinquies* of the Paris Convention establishes a special right to obtain the registration of a mark on the basis of a prior registration in the home country. A Contracting Party would therefore be entitled to require a certificate of registration in the country of origin where the applicant invokes the benefit contemplated in that provision.

3.29 *Paragraph (5).* Evidence may be required whenever the application contains an allegation the veracity of which is reasonably doubtful. This applies even in the case of an allegation which is not required to be made under the law of the Contracting Party concerned. In the case of an allegation which is required to be made under that law, the provision of paragraph (5) constitutes an exception to the prohibition contained in paragraph (4). Such would be the case, for example, where the applicant claims the benefit of Article 3 of the Paris Convention but there is doubt as to the veracity of the applicant's allegations as to his domicile or his place of establishment.

3.30 The expression "examination of the application" as used in paragraph (5) includes any opposition procedure (which may take place before or after the registration of a mark). This provision does not relate to the correction of mistakes, but to cases where the Office believes that an indication or an element is not true.

3.31 The Office of a Contracting Party which is a party to the Paris Convention may also invoke this paragraph when it has to fulfill an obligation under the Paris Convention, for example, where it has reasonable doubts concerning the right of the applicant to file an application for a mark which consists of a sign, or is similar to a sign, protected under Article 6*ter* of the Paris Convention.

Notes on Article 4
(Representation; Address for Service)

4.01 *Article 4.* This Article does not apply to representatives who are employees or officials of a legal entity (whether applicant or holder), for example, executive officers or in-house counsels of a corporation. It typically applies to trademark agents and attorneys in private practice. This Article relates only to the appointment itself and to the possible limitation of the appointment, but does not deal with the termination of the appointment. In the latter respect, and in respect of any other matter relating to representation which is not covered by the Treaty, a Contracting Party will apply its own law. For example, a Contracting Party may provide that the appointment of a new representative terminates the appointment of all previous representatives. Or, a Contracting Party may allow sub-representation and in that case, require that, where the power of a representative extends to the appointment of one or more sub-representatives, the power of attorney expressly authorize a representative to appoint such sub-representatives.

4.02 *Paragraph (1)(a).* Under this provision, a Contracting Party is allowed to require that the appointed representative be a person entitled to practice before its Office and that such person provide an address in a specified territory. A Contracting Party may however, have a

less strict requirement and may, for example, require only one of those conditions, neither of them, or establish other requirements.

4.03 *Paragraph (1)(b)* defines the legal effect of acts performed by an appointed representative in the context of procedures before the Office, under the Treaty. This provision would override any provisions in the laws of the Contracting Parties that might establish a different effect for acts performed by representatives.

4.04 Under *paragraph (2)(a)* a Contracting Party may require representation for any procedure before the Office where an applicant, a holder or an interested person has neither a domicile nor a real and effective industrial or commercial establishment on its territory.

4.05 *Paragraph (2)(b).* The laws of some countries do not require that a representative be appointed before their Offices even where the applicant or the new holder has neither a domicile nor a real and effective industrial or commercial establishment on the territory of those countries. In each case, those countries may require, for the purposes of facilitating correspondence with the person concerned, that an address for service in their territory be indicated.

4.06 *Paragraph (3)(a).* It follows from this paragraph that a Contracting Party may refuse the appointment of a representative made by oral communication or in a communication other than a power of attorney, for example, a statement in the application itself, or in any other communication under Articles 10 to 13, 17 and 18. The reference, in this provision, to "any other interested person" covers, for example, an opponent.

4.07 *Paragraph (3)(b).* This provision puts an obligation on Contracting Parties to accept a single power of attorney in respect of several applications, several registrations or both applications and registrations of the same person. Contracting Parties must also accept what is sometimes referred to as a "general power of attorney", that is, a power of attorney that relates to all existing and future applications and/or registrations of the same person. In respect of the latter type of power of attorney to which the words "subject to any exception indicated by that person" relate, a Contracting Party must allow the person making the appointment to indicate possible exceptions in the power of attorney itself (for example, appointment only for future applications and registrations) or to make exceptions at a later time.

4.08 *Paragraph (3)(c).* An applicant or holder could appoint a representative in respect of certain matters (for example, filing of applications and renewal of registrations) and appoint another representative in respect of other matters (for example, treatment of objections and oppositions). Alternatively, where the applicant or holder does not need to appoint a representative (for example, for domestic applications and registrations), he could carry out certain operations (for example, filing of applications) himself and appoint a representative only for the remaining matters. The possibility for a Contracting Party to require that the right for a representative to withdraw an application or surrender a registration be expressly mentioned in the power of attorney is justified in view of the particularly important consequences of such acts.

4.09 *Paragraph (3)(d).* As regards the time limit to present the power of attorney, see Rule 4.

4.10 *Paragraphs (5) and (6).* Paragraph (5) establishes the exhaustive character of the list of requirements under paragraphs (3) and (4) and in Article 8 with respect to the matter of representation as covered by the Treaty, subject to the possibility of requiring under paragraph (6) the furnishing of evidence in cases of reasonable doubt.

Notes on Article 5
(Filing Date)

5.01 *Article 5.* This Article establishes an exhaustive list of requirements for according a filing date to an application. The fact that, for the purpose of according a filing date, a Contracting Party cannot require more indications and elements than those mentioned in paragraph (1)(a) (subject to paragraph (2)) follows from paragraph (4).

5.02 *Paragraph (1).* The words "subject to subparagraph (b) and to paragraph (2)" mean that Contracting Parties may require less indications and elements than those referred to in items (i) to (vi) of subparagraph (a), and may require, in addition to those indications and elements, the payment of a fee.

5.03 *Item (i).* "Implicit" means that a Contracting Party must accord a filing date even where the request is not express but can be inferred from the circumstances.

5.04 *Item (ii).* Such indications could, for example, consist of the applicant's identification code (rather than his name) in Offices that allow the use of such codes, for example, in the case of electronic filings.

5.05 *Item (iii).* Such indications could, for example, consist of less than the full address or an e-mail address.

5.06 *Item (iv).* Although in certain circumstances more than one reproduction of the mark may be required, the filing date could not be denied if only one reproduction is furnished or if among the reproductions furnished, only one reproduction is "sufficiently clear".

5.07 *Item (v).* The list of goods and services must be accepted even if at the time of filing it is not presented as required under Article 3(1)(a)(xv).

5.08 *Paragraph (2).* The requirement that fees be paid as a condition for the filing date still exists in some countries. This paragraph allows the continuation of that requirement in those countries where it already exists. However, a Contracting Party may not introduce this requirement once it has become bound by the Treaty.

5.09 *Paragraph (3).* The details are provided for in Rule 5(1) .

5.10 *Paragraph (4).* The requirements under paragraphs (1) and (2) are exhaustive in respect of the filing date of an application. This, however, does not affect the freedom of Contracting Parties in respect of the means of transmittal of applications, as provided under Article 8(1).

Notes on Article 6
(Single Registration for Goods and/or Services in Several Classes)

6.01 This provision prevents single applications from being subsequently split *ex officio* into two or more registrations. However, an application will result in a registration only if all the conditions for allowance are fulfilled. If the application is divided into several applications under Article 7, there will be as many registrations as there are applications.

Notes on Article 7
(Division of Application and Registration)

7.01 *Paragraph (1)(a).* A division of the initial application may relate to only one or some of the goods or services included in the initial application (which may be either a single class or a multiple class application) or to one or several classes of goods and/or services covered by the initial application. The words "decision by the Office on the registration" or "decision on the registration", respectively appearing in items (i) and (iii), concern a decision to register or not to register. Typically, the applicant is interested in dividing the application where an objection by the Office or an opposition filed against the registration of the mark affects only some of the listed goods and services. In such a situation, a division into two divisional applications could allow one of the divisional applications to proceed immediately to registration, while the objection or opposition proceedings would continue only with respect to the other divisional application.

7.02 Article 7 does not oblige Contracting Parties to allow division of the applications after a (positive or negative) decision has been taken by the Office regarding the registration of the mark. This is so because, if a positive decision is made, any request for division would hamper the registration of the mark and its publication and if a negative decision is made, division may be requested during appeal proceedings against the decision but not if no appeal is filed. Of course, each Contracting Party would be free to allow for the division of an application also in situations where this is not required by the Treaty.

7.03 *Paragraph (1)(b).* The words "requirements for the division" mean, in particular, the elements or the indications to be given in the request for division.

7.04 *Paragraph (2).* Typically, the possibility of dividing a registration is needed in cases where an opposition can only be filed after the mark has been registered ("post-grant opposition"). If the opposition affects only some of the goods and/or services covered by the registration, the holder should have an opportunity to divide his registration. This will be useful to him, for example, if he intends to negotiate a partial transfer or license agreements in respect of the goods and/or services which are not affected by the said procedure. It is to be noted that the proviso of this paragraph allows a Contracting Party to exclude post-grant division if the law of that Contracting Party allows opposition to applications (that is, pre-grant opposition).

7.05 The need to divide a registration may also arise out of business or commercial considerations. Nothing in the Treaty prevents Contracting Parties from allowing such division at any point in time during the life of the registration.

Notes on Article 8
(Communications)

8.01 As to the meaning of theterm “communication”, reference is made to Article 1(iv) (see Note 1.02).

8.02 *Paragraph (1).* The expression “means of transmittal” refers to the physical or electronic means used to transmit a 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. An electronic transmission from computer to computer is a communication in electronic form transmitted by electronic means. The expression “transmittal of communications” refers to the transmission of a communication to the Office.

8.03 *Paragraph (2)(a).* This provision deals globally with the language requirements for all communications before the Office. Consequently, 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 original TLT have been deleted. The expression “a language 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 is determined by the Contracting Party concerned. Nothing in paragraph (2)(a) would prevent a Contracting Party from considering a communication accompanied by a translation as being transmitted in a language admitted by the Office.

8.04 The second sentence of Article 8(2)(a) enables countries or intergovernmental organizations (such as the European Communities) which allow the filing of applications 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 an indication or an element of the communication may not be required to be in more than one language. It also enables a Contracting Party to require that some indications or elements of the communication, such as the list of goods and services, be in a language admitted by the Office which does not necessarily have to be the official language of the Office, and that some other indications or elements of the communication be in the official language of the Office. However, no element or indication may be required to be in more than one language.

8.05 *Paragraph (2)(b).* By virtue of this provision a Contracting Party could not require a translation to be, for example, certified by a notary public or by a consular authority.

8.06 *Paragraph (2)(c).* Where the Office accepts a communication in a foreign language, it may require that a translation by an official translator or a representative be submitted to the Office. The Office may require that the translation of the communication be supplied within a reasonable time limit as may be defined by the Contracting Party.

8.07 *Paragraph (3)* applies whenever a Contracting Party requires a signature or other means of self-identification on a communication on paper. The possibility for Contracting Parties to require the signature of the applicant, holder or other interested party, as the case may be, on a specific communication, is explicitly forseen by the TLT 1994 in the articles

dealing with application (Article 3(1)(a)(xvi) and (4)), representation (Article 4(3)(a)), filing date (Article 5(1)(a)(vi)), changes in names or addresses (Article 10(1)(a)), changes in ownership (Article 11(1)(a)), correction of a mistake (Article 12(1)(a)) and renewal (Article 13(1)(a)(ix)). Because of the cross-cutting nature of Article 8, the reference to signature was deleted in those provisions. It is to be noted that the term "signature" is only used in relation to communications on paper, whether or not such communications are transmitted by physical or electronic means of transmittal. When a Contracting Party provides for the filing of communications in electronic form, it has complete freedom to require use of a system of electronic authentication preserving the confidentiality and integrity of the communication as it wishes to prescribe (e.g., an electronic key and lock system). In order to avoid confusion, the term "electronic signature" is not used for this type of electronic authentication system. It is implicit that the "signature" of a communication must be that of a person who is authorized to sign the communication concerned. Accordingly, an Office may, in accordance with the applicable law, reject the signature of a person who is not so authorized.

8.08 *Paragraph (3)(a).* Details concerning the signature of communications on paper are prescribed in Rule 6(1) to (3). Certain forms of signature that a Contracting Party must or may accept, or may require, are expressly referred to under Rule 6(3), namely a hand-written, printed or stamped signature, a seal or a bar-coded label.

8.09 *Paragraph (3)(b).* This provision obliges a Contracting Party to accept the signature of the person concerned as sufficient, without the need for further authentication by way of, for example, attestation or notarization of that signature. The only exception that may be envisaged under national law refers to signatures on communications on paper that concern the surrender of a registration, if the law of the Contracting Party so provides.

8.10 *Paragraph (3)(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 be in the form of certification of the signature or by any other means allowed by the law of the Contracting Party.

8.11 *Paragraph (4).* Details under this paragraph are prescribed in Rule 6(4) to (6).

8.12 *Paragraph (5*). This paragraph contains a general provision dealing with the presentation of communications in respect of the different procedures for which Model International Forms are contemplated in the Regulations. Therefore, the corresponding provisions previously contained in Articles 3(2) (*Application*), 4(3)(e) (*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 original TLT have been replaced by this paragraph.

8.13 Under paragraph (5) a Contracting Party is obliged to accept a communication -whether transmitted to the Office on paper or in electronic form or by electronic means-if its contents correspond to the Model International Form provided for in the Regulations in respect of such a communication. The Model International Forms correspond to the maximum requirements that a Contracting Party may provide for under the Treaty and the Regulations in respect of a particular procedure or document. The obligation for an Office to accept a communication, the contents of which correspond to the Model International Form

does not affect any requirements established by that Office concerning the means of transmittal of communications, language of communications, signature of communications on paper or communications filed in electronic form or by electronic means of transmittal, under paragraphs (1) to (4). On the other hand, an Office may prepare its own "Individualized International Forms" for use by applicants, provided such forms do not require mandatory elements that would be additional to the elements referred to in the corresponding Model International Forms and would therefore be contrary to the Treaty or the Regulations. This point was clarified in the Agreed Statement N° 5, adopted at the Diplomatic Conference for the Conclusion of the Trademark Law Treaty.

8.14 *Paragraph (6).* The reference to paragraphs (1) to (5) does not prevent the Contracting Parties from applying the requirements permitted under other articles, such as Articles 3, 10 to 14, 17 and 18.

Notes on Article 9
(Classification of Goods and/or Services)

9.01 *Paragraph (1*). This provision obliges Offices of Contracting Parties to refer by name to the goods and services specified in the registration of a mark, and in any publication of an application or registration relating to a mark. It also requires that the relevant class number(s), as established by the Nice Classification, be indicated, and that the goods and services belonging to the same class be grouped together under the corresponding class number. The Nice Classification was established by the Nice Agreement of 1957. Its eighth edition (in force since 2002) consists of 34 classes for goods and eleven classes for services, each having a number (from 1 to 45).

9.02 *Paragraph (2)*. This provision requires Contracting Parties not to consider the class or classes under which the specified goods or services are grouped as the decisive criterion to determine similarity or dissimilarity among those goods or services. This recognizes that goods or services classified in different classes may, in the circumstances of a particular case, be found to be similar or related, while under other circumstances goods or services covered in the same class may be found to be dissimilar or unrelated. The issue of similarity between goods or services can be relevant to determine the scope of protection in cases of conflict between two marks.

Notes on Article 10
(Changes in Names or Addresses)

10.01 *Paragraph (1)(a).* Contracting Parties are required to accept requests to record changes in names, changes in addresses and changes in both names and addresses.

10.02 *Paragraph (1)(b).* The names and addresses referred to in paragraph (1)(b) must be those which are recorded in the register of marks of the Office concerned. If that is not the case, the Office can require either the furnishing of evidence under paragraph (5) or that another change be recorded beforehand.

10.03 *Paragraphs (1)(c) and (d).* The amount of the fee could differ depending on the number of the registrations or applications involved.

10.04 *Paragraph (2).* In respect of a request relating to one or several applications, a Contracting Party is free not to record the change in its register of marks but to record it in a data base concerning pending applications; in such a case, the change would be included in the register of marks once the mark is registered.

10.05 *Paragraph (4).* This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (3) and Article 8 with respect to a request for a change in name or address. This would prohibit, for example, the requirement to furnish a certified copy of the recording of the change in a register of companies, or a certified copy of the decision to change the name or address.

Notes on Article 11
(Change in Ownership)

11.01 *Article 11.* This Article only deals with procedures to be fulfilled before an Office and not before other authorities of a Contracting Party, for example, fiscal authorities or a public registry of companies.

11.02 *Paragraph (1)(a).* The term "new owner" is used rather than "new holder" because, at the time of the request for recording of the change in ownership, the person who has acquired the rights is not yet a holder since she or he is not recorded as such on the register of marks.

11.03 *Paragraphs (1)(b) to (e).* These paragraphs distinguish three cases, namely, a change in ownership resulting from a contract, a change in ownership resulting from a merger and a change in ownership resulting from the operation of law or from a court decision (inheritance, bankruptcy, etc.).

11.04 *Paragraph 1(b)* relates to a change in ownership that results from a contract. Any Contracting Party may require that the request to record the change indicate the fact that such change results from a contract and that the request be accompanied by a document evidencing the change. Items (i) to (iv) list four different documents, and it is up to the requesting party to choose one of them to substantiate this request. Where the requesting party chooses to furnish a certificate of transfer or a transfer document (items (iii) and (iv)), no Contracting Party may require that this certificate or document be the subject of any form of certification. On the other hand, where the requesting party chooses to furnish a copy of the contract or an extract of the contract (items (i) and (ii)), a Contracting Party is free to require that the copy or the extract be certified. The Regulations provide for a model certificate of transfer and a model transfer document. The latter can effectively function as a model contract (in a short version).

11.05 *Paragraph 1(c)* relates to a change in ownership that results from a merger. The request to record the change must, if the Contracting Party so requires, indicate the fact that such change results from a merger and be accompanied by a copy of a document evidencing the merger. This document must originate from the competent authority. It may, for example, be an extract from a register of commerce. The Contracting Party may only require that a copy of the merger document be furnished; it may not require the original of the document. However, it may require that the copy be certified.

11.06 *Paragraph (1)(d).* Where a co-holder transfers his share in a registration, he may, under the applicable law, need the consent of any other co-holder. The Treaty allows Contracting Parties to require the furnishing of a document in which the said consent is given.

11.07 *Paragraph (1)(e).* This paragraph relates to any change in ownership that results neither from a contract nor from a merger. In such a case, the Contracting Party may require that the request to record the change indicate the legal cause of such change (operation of law, court decision, etc.) and be accompanied by a copy of any document which it deems appropriate to evidence the change. Although the Contracting Party may not require that the original of such a document be furnished, it may require that the copy emanate from the authority that issued the document or that it be certified.

11.08 *Paragraphs (1)(g) and (h).* The explanations given on Article 10(1) (c) and (d) are also applicable to these paragraphs (see Note 10.03).

11.09 *Paragraph (1)(i).* This provision deals with the consequences of a request for the recording of a change of ownership in the case where the change concerns only some of the goods and/or services covered by the registration. In such a case, the Office must divide the registration: the original registration will continue to exist, without reference to the goods and/or services in respect of which the ownership has changed, and a separate registration has to be created in the name of the new owner for those goods and/or services. It is left to each Contracting Party to decide how the separate registration should be identified. This can be done, for example, by giving it the same number as the number of the original registration, together with a capital letter. This would be in accordance with the practice under the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating thereto. Paragraph (1)(i) only applies where a Contracting Party allows for such partial change in ownership. Since this Treaty does not cover the substantive conditions relating to the change in ownership or a registration, a Contracting Party is free to refuse a partial change in ownership and consequently, a request for recording of such change. A Contracting Party that admits in principle a partial change in ownership of a mark could refuse such change in specific cases on grounds of public order, for example if the split of goods or services among the original and new owner is such that it is likely to cause confusion or is misleading.

11.10 *Paragraph (2).* The explanations given on Article 10(2) are also applicable to this paragraph (see Note 10.04).

11.11 *Paragraph (3).* This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (2) and in Article 8 with respect to a request for the recording of a change in ownership, always subject to the possibility of requiring under paragraph (4) the furnishing of evidence. The examples given in items (i) to (iv) are not exhaustive. Another example of a prohibited requirement could be making the admissibility of the request dependent on an advertisement of the change in ownership in one or several newspapers. Since the Treaty does not regulate the substantive requirements relating to the validity of a change in ownership, a Contracting Party may require the fulfillment of additional conditions, for example, in situations concerning inheritance, bankruptcy or tutelage.

11.12 *Items (i) to (iii).* The explanations given on Article 3(4) items (i), (ii) and (iii) are also applicable to these items (see Notes 3.25 to 3.27).

11.13 *Item (iv).* This provision does not deal with the question of validity of the transfer of a mark in the absence of a simultaneous transfer or assignment of the relevant business or goodwill. It only specifies that certain formal requirements are not allowed in respect of a request to record the change in ownership of a registered mark. The question of assignment of goodwill in conjunction with the transfer of marks is a matter that may be dealt with under national law. As regards the transfer of the relevant business, Article 21 of the TRIPS Agreement provides that the owner of a registered mark shall have the right to assign the mark with or without the transfer of the business to which the mark belongs.

Notes on Article 12
(Correction of a Mistake)

12.01 *Paragraphs (1) to (4)* of this Article relate to mistakes attributable to the applicant or to the holder, or to his/her representative.

12.02 *Paragraphs (1)(b), (c) and (d).* The explanations given on Article 10(1)(b), (c) and (d) are also applicable to these paragraphs (see Notes 10.02 and 10.03).

12.03 *Paragraph (2).* The explanations given on Article 10(2) are also applicable to this paragraph (see Note 10.04).

12.04 *Paragraph (3).* This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) and (2) and in Article 8 with respect to a request for the correction of a mistake.

12.05 *Paragraph (4).* If the Office has reasons to suspect that what is submitted as a mistake to be corrected is in fact a change of name, address or ownership, or any other operation, it could require that evidence be supplied to clarify the matter.

12.06 *Paragraph (5).* In the case of mistakes attributable to an Office, the latter may adopt a procedure such as *ex officio* correction or, where the mistake is noticed by the applicant or the holder, or by his representative, correction following a request made by them in a simple letter.

12.07 *Paragraph (6).* A Contracting Party is not obliged to accept a request to correct a mistake that may not be corrected under the law of that Party. For example, if the law of a Contracting Party does not admit that a mark may be changed or altered after an application for its registration has been filed, the Office of that Contracting Party would not be obliged under Article 12 to accept a request for change or alteration of the mark on grounds that the mark contained a mistake in its spelling or in any of its features.

Notes on Article 13
(Duration and Renewal of Registration)

13.01 This provision provides a maximum list of requirements in respect of requests for the renewal of registrations.

13.02 *Paragraph (1)(a).* This paragraph contains an exhaustive list of the indications and elements which may be required in respect of a renewal. The exhaustive character of the list follows from paragraph (2). This list constitutes a maximum, and Contracting Parties are free to require fewer indications or elements. For example, Contracting Parties may accept renewals effected by the mere payment of the renewal fee, without the submission of a formal request.

13.03 *Item (i).* An Office may require an express indication that renewal is sought. Contracting Parties are, however, free to admit an implied indication to that effect.

13.04 *Item (iv).* Two dates are indicated in this provision because, according to the laws of some countries, the initial duration of a registration is calculated from the date of filing of the application which resulted in the registration, while according to the laws of other countries, that duration is calculated from the date of registration. Some Contracting Parties may not require the furnishing of any date if they consider that the indication of the registration number under item (iii) is sufficient to identify the registration which is the subject of the request for renewal. On the other hand, any Contracting Party requiring the furnishing of a date will have to opt for one of the two dates (filing date or registration date), and could not require both to be furnished.

13.05 *Item (vii).* Any Contracting Party is free not to allow a limitation of the list of goods and/or services to take place together with the request for renewal. In those Contracting Parties, a limitation of the list of goods and/or services would have to be requested separately, before or after the renewal.

13.06 *Paragraph (1)(b).* This provision does not prohibit a Contracting Party from requiring an additional fee or a higher renewal fee where such Contracting Party allows, under paragraph (1)(a)(vii), that a limitation of the list of goods and/or services be made in the request for renewal itself and such limitation is requested. The second sentence of this provision makes it clear that, for any 10-year period, a Contracting Party is only allowed to require the payment of one set of fees.

13.07 *Paragraph (1)(c).* Rule 8 deals with the minimum period for requesting renewal and paying the renewal fee.

13.08 *Paragraph (2).* This paragraph establishes the exhaustive character of the list of requirements under paragraph (1) and in Article 8 always subject to the possibility of requiring under paragraph (3) the furnishing of evidence in case of reasonable doubt.

13.09 The examples given in paragraph (2) are not exhaustive. They serve to illustrate the effects of the Treaty with respect to some formalities which seem to be particularly unnecessary and undesirable at the time of renewal. Other examples could be, the furnishing of the original or a copy of the certificate of the registration of the mark which is the subject of the request for renewal.

13.10 *Item (i).* An obligation to furnish any reproduction or other identification (for example, the simple indication of a mark published in standard characters) of the mark that is the subject of the request for renewal, is prohibited because it would be superfluous. The mark that is to be renewed is the same as the one that was initially registered (if this were not the case, a new application would have to be filed) and the publications of a renewal need not

contain the mark (it only needs to refer to the number of the initial registration without having to republish the reproduction of the mark). The practice of not re-publishing the mark is already followed by a number of countries and has advantageous consequences both for the holders of registrations (lower renewal fee, in particular, where the re-publishing of the reproduction of the mark would have to be in color) and for the Offices (simplification of administrative work and reduction of the space needed in the official bulletin in respect of renewals). Nothing in the Treaty prohibits a Contracting Party from republishing, in connection with the publication of the renewal, the reproduction of the mark as registered, which the Office has in its files. What is prohibited is to require the holder to furnish a further reproduction of the mark for the purposes of the renewal.

13.11 *Item (ii).* This provision follows the same rationale as that in Article 3(4)(iv). It reflects the rule of independence of marks as derived from Article 6 of the Paris Convention. Consequently, renewal of the registration of a mark in a Contracting Party may not be linked or subjected to registration or renewal of that mark in any other Office, whether or not in a Contracting Party (see Note 3.28).

13.12 *Item (iii).* It is understood that nothing in the Treaty prevents a Contracting Party from applying the requirements of its law in respect of the use of the mark which is the subject of a registration, provided that the compliance with such requirements is not linked with the procedure for the renewal of that registration.

13.13 *Paragraph (4).* The procedure relating to the renewal of a registration cannot include an examination as to substance. The renewal of a registration merely implies an extension in time of an existing registration. The facts that determined the registration of the mark, as verified during the initial examination of the sign, remain valid for the purposes of renewal. This will ensure that renewal procedures remain as simple and inexpensive as possible. Nothing would prevent a Contracting Party to provide for the expunging of a mark from the registry if preexisting or new grounds for cancellation or invalidation are established. However, this procedure may not be linked to or combined with the renewal procedure.

13.14 *Paragraph (5).* This provision aims at harmonizing the duration of the initial registration and of each renewal. As regards the duration of the initial registration, the proposed 10 years correspond to the duration provided for in most national laws.

13.15 Neither the Treaty nor the Regulations determine the date from which the periods of initial registration or of renewal are to be counted. This is left to the law of each Contracting Party.

Notes on Article 14
(Measures in Case of Failure to Comply with Time Limits)

14.01 This Article deals with different forms of relief in respect of time limits. Such relief may be in the form of an extension of the time limit, in the form of continued processing or in the form of reinstatement of rights. As a result of the discussion that took place at the twelfth session of the SCT (April 2004), Contracting Parties have to provide at least one form of relief for an applicant, holder or other interested party who wishes to avoid or redress the consequences of having missed a particular time limit. However, it is left to the Contracting Party to decide whether the form of relief so made available is an extension of the time limit,

the request for which was filed after the expiry of the time limit concerned (Article 14(1)(ii)), a request for continued processing which can be made during a time period of at least two months from the expiry of the time limit concerned (Article 14(2) and Rule 9(2)(ii)), or a request for reinstatement of rights under Article 14(3).

14.02 It goes without saying that Contracting Parties would be free to provide several or all of the relief measures set out in Article 14. The relief that a Contracting Party is obliged to provide under paragraphs (1) to (3) does not apply to time limits in procedures that are not before the Office, for example, proceedings before a court or a board of appeal.

14.03 *Paragraph (1).* Under item (i), an extension of a time limit may be requested prior to the expiration of the time limit concerned. The possibility to file a request for an extension of a time limit after the time limit concerned has expired is dealt with in item (ii) and Rule 9(1)(ii). However, paragraph (1)(ii) is only mandatory for Contracting Parties that provide neither for continued processing under paragraph (2) nor for reinstatement of rights under paragraph (3).

14.04 *Paragraph (2).* The effect of continued processing is that the Office will continue 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 relevant application or registration. The details for a request for continued processing are prescribed in Rule 9(2).

14.05 *Paragraph (3).* In contrast to the extension of a time limit or continued processing of a request, reinstatement of rights 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, that the failure was unintentional. The interpretation of the terms “due care” and “unintentionality” are left to the applicable law and practice in the Contracting Party. The requirements and the time limits for filing a request for reinstatement of rights are dealt with in Rule 9(3).

14.06 *Paragraph (4).* The cases of failure to comply with a time limit that could be excepted from the obligation to provide for a relief measure are prescribed in Rule 9(4).

14.07 *Paragraph (6).* This provision prevents a Contracting Party from imposing requirements additional to those provided under paragraphs (1) to (3) and Article 8. 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 paragraphs (1) and (2) concerning an extension of the time limit and continued processing. However, this provision allows the Office to require evidence in support of the reasons for the failure to comply with a time limit under paragraph (3).

14.08 The Treaty and Regulations do not regulate the intervening 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.

Notes on Article 15
(Obligation to Comply with the Paris Convention)

15.01 Nothing in the Treaty derogates from obligations that Contracting Parties have towards each other under the Paris Convention.

15.02 Likewise nothing in the Treaty derogates from rights that applicants and holders enjoy under the Paris Convention.

Notes on Article 16
(Service Marks)

16.01 According to Article 6*sexies* of the Paris Convention, the countries party to that Convention are obliged to protect service marks, but are free not to register such marks. Article 16 of the TLT means that, by becoming Contracting Parties to this Treaty, Contracting Parties are obliged to register service marks and apply to service marks all the provisions of the Paris Convention that would be applicable to trademarks (i.e. marks for goods). Those provisions include the following:

- Article 2, which deals with national treatment for nationals of countries of the Paris Union;
- Article 3, which assimilates certain categories of persons to the status of nationals of countries of the Paris Union;
- Article 4A to D, which deal with the right of priority;
- Article 5C and D, which deal with the questions of failure to use a mark, use of the mark in a form different form the one registered, use of the mark by co-proprietors and marking;
- Article 5*bis*, which deals with the period of grace for the payment of fees for the maintenance of rights;
- Article 6, which deals with the conditions of registration and the independence of protection of the same mark in different countries;
- Article 6*bis*, which deals with well-known marks;
- Article 6*ter*, which deals with the prohibitions concerning State emblems, official hallmarks and emblems of intergovernmental organizations;
- Article 6*quater*, which deals with the question of assignment of marks;
- Article 6*quinquies*, which deals with the protection of marks registered in one country of the Paris Union in the other countries of that Union;
- Article 6*septies*, which deals with the registration of a mark in the name of the agent or representative of the proprietor without the latter's authorization;
- Article 7, which deals with the nature of the goods to which the mark is applied;
- Article 9, which deals with seizure, on importation, etc., of goods unlawfully bearing a mark;
- Article 10*ter*, which deals with remedies and the right to sue;
- Article 11, which deals with temporary protection at certain international exhibitions;
- Article 12, which deals with special national industrial property services.

16.02 Article 7*bis* of the Paris Convention is not included in the foregoing list because under Article 2(2)(b) the TLT does not apply to collective marks (whether for goods or services).

Notes on Article 17
(Request for Recordal of a License)

17.01 This Article applies to requests for the recordal of licenses for the use of a mark with the Offices of Contracting Parties, i.e. the agencies entrusted by Contracting Parties with the registration of marks. A Contracting Party is not required by the Treaty to provide for the recordal of licenses with its Office. However, to the extent that such recordal is contemplated, Article 17 would apply.

17.02 *Paragraph (1).* The list of indications and elements which may be required to be included in a request for the recordal of a license, is prescribed in the Regulations.

17.03 *Paragraph (2).* As regards the amount of fees that an Office may charge for the recordal of a license, it should be noted that nothing in the text would prevent an Office from charging varying fees depending on the number of registrations to which the request relates.

17.04 *Paragraph (3)* is in line with the approach adopted in Articles 10(1)(d),11(1)(h) and 12(1)(d) namely, to allow that requests for recordal can refer to more than one registration. This is an important simplification in cases where a license is granted for several marks (for example, a series of marks). However, this is subject to the following conditions: The holder and the licensee must be the same for all registrations covered by the license for which recordal is requested and, where applicable, the scope of the license in accordance with Article 17(1) must be indicated with respect to all registrations covered by the license for which recordal is requested. If these conditions are not met, for example, if the holder and the licensee are not identical in respect of all registrations contained in the request, the Office may require that separate requests be filed. Since paragraph (3) only describes the situations in which an Office is obliged to accept a single request for several registrations, an Office is free to accept a single request even if the conditions outlined in paragraph (3) are not met.

17.05 *Paragraph (4).* For the purposes of the recordal of a license with its Office, a Contracting Party may not require that the applicant file information in addition to what may be required under paragraph (1), and, by reference, the applicable rule.

17.06 By way of example of information that may not be required, items (i) to (iii) mention certain items whose furnishing to an Office is usually regarded by the parties to a license contract as particularly burdensome, or as revealing confidential business information. It should be noted, however, that paragraph (4) does not prevent other authorities of Contracting Parties (for example, tax authorities or authorities establishing statistics) from requiring the parties to a license contract to furnish information in accordance with the applicable law.

17.07 *Paragraph (6).* Article 17, the relevant rule and the model request Form contained in the Regulations are applicable to requests for the recordal of licenses in respect of applications, if the national or regional law of a Contracting Party provides for such recordal. It should be noted that Rule 7 (*Manner of Identification of an Application Without Its Application Number*) would be applicable.

Notes on Article 18
(Request for Amendment or Cancellation of the Recordal of a License)

18.01 Where a license has been recorded with an Office, such recordal may be the subject of a request for amendment or cancellation. Like Article 17(1), Article 18(1) contains a reference to the Regulations which prescribe the detailed elements and indications which a Contracting Party may require in a request for the amendment or cancellation of the recordal of a license. As regards the general requirements for such a request, paragraphs (2) to (5) of Article 17 apply *mutatis mutandis*.

Notes on Article 19
(Effects of the Non-Recordal of a License)

19.01 *Paragraph (1).* The purpose of this paragraph is to separate the question of the validity of the registration of a mark and the protection of that mark from the question whether a license concerning the said mark was recorded. If the law of a Contracting Party provides for the mandatory recordal of licenses, non-compliance with that requirement may not result in the invalidation of the registration of the mark which is the subject of the license, and may not affect in any way the protection afforded to that mark. It is to be noted that this paragraph concerns the recordal of a license with the Office or other authority of a Contracting Party such as, for example, the tax authority or the authority responsible for the establishment of statistics.

19.02 *Paragraph (2)(a).* This provision does not intend to harmonize the question whether a licensee should be allowed to join proceedings initiated by the licensor, or whether it would be entitled to damages resulting from an infringement of the licensed mark. This question is left to the applicable law. However, where a licensee has the right under the law of a Contracting Party to join infringement proceedings initiated by the holder and to obtain damages resulting from an infringement of the licensed mark, the licensee should be able to exercise those rights independently of whether the license is recorded.

19.03 The question of the entitlement of a licensee to join infringement proceedings initiated by the holder and to obtain damages is distinct from the question whether a licensee is allowed to bring in his own name infringement proceedings concerning the licensed mark. The latter case is not dealt with by the Treaty. Therefore, Contracting Parties would be allowed to require the recordal of a license as a condition for the licensee to bring a legal action in its own name concerning the mark which is the subject of the license. Under paragraph (2)(a), Contracting Parties are free to provide that a non-recorded licensee has the right to obtain damages only where it had joined infringement proceedings initiated by the holder. However, this is a maximum standard and Contracting Parties are of course equally free to adopt a more liberal approach, such as exists where the applicable national or regional law does not provide for the recordal of a license at all.

19.04 *Paragraph (2)(b).* Subparagraph (b) takes account of relevant laws which expressly prohibit a non-recorded licensee from joining infringement proceedings initiated by the holder, and from recovering damages. Therefore, although the provision in subparagraph (a) has been retained as a general principle, subparagraph (b) makes it clear that such laws are not affected. However, laws that can be interpreted as allowing a non-recorded licensee to join infringement proceedings and to recover damages would fall under subparagraph (a) and would, therefore, have to be interpreted in this way.

Notes on Article 20
(Use of a Mark on Behalf of the Holder)

20.01 *Article 20* provides that the use of a mark by a licensee shall accrue to the benefit of the holder, even if the license was not recorded. The effect of this provision is that, whenever the question of use becomes relevant, any use of a mark by a licensee must be deemed to be use of the mark by the holder. The words "use of a mark by a licensee" mean that Contracting Parties may require that, for the purposes of the article under consideration, use of the mark was made under a license agreement.

Notes on Article 21
(Indication of the License)

21.01 *Article 21* concerns specific indications relating to trademark licenses which may be required, under trademark law, under general labeling law or under advertising law, to appear on products or packaging or to be given in connection with the providing of services or in advertising for such goods or services. It is not the intention of this article to regulate general questions of product (or service) information required by labeling, advertising or consumer protection laws. Consequently, national laws and regulations requiring that certain indications relating, for example, to the safety of a product, its composition, its correct use, etc., must appear on its packaging are outside the scope of this article.

21.02 Article 21 leaves it to the law of a Contracting Party to prescribe whether or not goods which are commercialized under a licensed mark, or their packaging, must bear an indication of the fact that the mark is used under a license contract, or whether or not such an indication has to be given in connection with the providing of services or in advertising for such goods or services. However, where such indication is required by the applicable law, non-compliance with that obligation should not entail the invalidation of the registration of the mark in whole or in part. The continued existence of the registration should not depend on compliance with requirements concerning labeling or advertising, irrespective of whether they are contained in trademark laws or in other laws such as laws on labeling or advertising. In particular (and this is the effect of the reference to Article 20 which appears at the end of Article 21), Contracting Parties are not allowed to cancel the registration of a mark because the only use of that mark was use by a licensee who did not mention the license on the goods, or their packaging, or in connection with the providing of services or in advertising for the goods or services, for which the mark was used, even if a requirement to that effect existed in that Contracting Party. The underlying rationale is that the invalidation of the registration of a licensed mark is too severe a sanction for non-compliance with a labeling or advertising requirement and should therefore not be allowed. Furthermore, non-compliance with labeling or advertising provisions should not lessen the possibilities to enforce the rights attached to a

licensed mark. This means that a missing or defective indication regarding the license cannot constitute an argument in favor of the defending party in infringement proceedings, even if such indication is mandatory under the applicable law. The result of Article 21 is that no sanction for non-compliance with a labeling or advertising requirement, even if that requirement concerns the indication of the existence of a license, may affect trademark rights.

Notes on Article 22
(*Observations in Case of Intended Refusal*)

22.01 If an application or a request under Articles 7, 10 to 14, 17 and 18 is to be refused or rejected by the Office, the Office has to give the applicant, holder or other interested person who filed the application an opportunity to make observations on the intended refusal. The notion of "refusal" includes the cases where those applications or requests are deemed withdrawn, abandoned or not to have been filed.

Notes on Article 23
(Regulations)

23.01. *Paragraph (3)(a).* In the draft revised Regulations as contained in document SCT/13/3, no Rules are specified that may be amended by unanimity only.

Notes on Article 24
(Assembly)

24.01 *Paragraph (1)(a).* This provision establishes an Assembly of Contracting Parties. In accordance with Article 1(xvi), the term "Contracting Party" means any State or intergovernmental organization party to the Treaty.

24.02 *Paragraph (2)(i).* Under this provision the Assembly may, for example, establish recommendations concerning the interpretation of the articles of the Treaty.

24.03 *Paragraph (4)(b)(ii).* The question of whether an intergovernmental organization or its Member States should participate in a vote at the Assembly is a matter to be decided between that organization and those States. However, subparagraph (b)(ii) makes it clear that an intergovernmental organization would not have a vote in the Assembly that is additional to the votes of that organization's Member States bound by the Treaty. The third sentence of this item ensures that two intergovernmental organizations with one or more States in common may not both participate in the same vote in place of their Member States.

Notes on Article 25
(International Bureau)

25.01 This article is a standard provision in WIPO treaties.

Notes on Article 26
(Revision and Amendments)

26.01 *Paragraph (2).* The only articles that may be amended by the Assembly are Articles 24 and 25, which deal with the Assembly and the International Bureau.

Notes on Article 27
(Becoming Party to the Treaty)

27.01 *Paragraph (1)(ii).* Intergovernmental organizations covered by this provision are, for instance, the "African Regional Industrial Property Organization" (ARIPO), the "Organisation africaine de la propriété intellectuelle" (OAPI) and the European Communities (EC).

27.02. *Paragraph (1)(iv).* This provision covers, for example, the member States of OAPI.

27.03 *Paragraph (1)(v).* This provision would apply, for example, to a Benelux State.

27.04 *Paragraph (3)(a)(iv).* The effect of this provision is that a State party to an intergovernmental organization under paragraph (1)(iv) would become bound by the Treaty, at the earliest three months after the accession to this Treaty by that organization.

Notes on Article 28
(Application of the TLT 1994 and This Treaty)

28.01 *Paragraph (1)* clarifies the relationship between Contracting Parties to both the revised TLT and the TLT 1994. *Paragraph (2)* regulates the relationship between the Contracting Parties to the revised TLT and Contracting Parties to the TLT 1994 that are not parties to the revised TLT.

Notes on Article 29
(Entry into Force;
Effective Date of Ratifications and Accessions)

29.01. *Paragraphs (1) and (2).* The Treaty does not come into force even if five States covered by Article 27(1)(i), (iii), (iv) or (v) have deposited their instruments of accession or ratification unless the deposit has an effective date in accordance with Article 27(3). When the States are bound by a regional intergovernmental organization their accessions or ratifications are taken into consideration only as of the date on which the intergovernmental organization by which they are bound has itself deposited its instrument of accession or ratification. For example, if five member States of OAPI deposit their instruments of accession or ratification, the entry into force of the Treaty will depend on whether OAPI itself deposits its intrument of accession or ratification under Article 27(3)(a)(ii).

29.02. It is to be noted that an intergovernmental organization's instrument of accession or ratification is effective only once all its member States are members of the World Intellectual Property Organization (WIPO).

Notes on Article 30
(Reservations)

30.01. *Paragraph (1)* allows making a reservation with respect to associated marks, defensive marks and derivate marks. These special kinds of marks, without such reservation, would be governed by the Treaty and the Regulations. The reason for such a reservation is that the said special kinds of marks can be governed by special provisions of the laws of the Contracting Parties, in particular, as regards the contents of applications and the division, transfer and renewal of applications or registrations, which are not compatible with the Treaty and the Regulations.

II. NOTES ON THE DRAFT REVISED REGULATIONS UNDER THE DRAFT REVISED TRADEMARK LAW TREATY

Notes on Rule 2
(Manner of Indicating Names and Addresses)

R.2.01 *Paragraph (1)(a).* The words “any Contracting Party may require,” which appear in the introductory phrase of this paragraph indicate that any Contracting Party is free to require fewer indications or elements than those mentioned in this Rule.

R2.02 It is left to the law of the Contracting Party to decide whether the family name or principal name has to precede or follow the given or secondary name.

R2.03 *Paragraph (1)(b).* In order to facilitate the administrative procedure before the Office, a firm or partnership needs to indicate its name only in the manner in which such name is customarily used.

R2.04 *Paragraph (2)(b).* This provision does not intend to regulate the question of who has the right to be an applicant. Therefore, as regards applicants, it only applies where the law of a Contracting Party allows applications to be filed by several applicants.

R2.05 *Paragraph (2)(c).* The indication of a telephone number, of a telefacsimile number or an e-mail address is not mandatory. It is, however, to the applicant’s advantage to allow it to provide such indications so that the Office can establish contact with it through the most efficient means of communication.

Notes on Rule 3
(Details Concerning the Application)

R3.01 *Paragraph (1).* A mark that consists of a word, a letter or a numeral, or any combination thereof, which is not depicted in a special form, will normally be registered and published by the interested Office in the standard characters used by that Office. No Office is obliged to register or publish a mark in the characters used in the application if those characters do not correspond to what are regarded as standard characters by that Office.

R3.02 *Paragraph (2).* The number of reproductions which may be required includes the reproduction which is contained in the application. Thus if, under subparagraph (a)(ii), only one reproduction may be required and the application contains the reproduction of the mark, no additional reproduction may be required; if, under subparagraph (a)(i), five reproductions may be required and the application contains the reproduction of the mark, four additional reproductions may be required.

R3.03 *Subparagraph (a)* deals with the case where the mark does not contain a statement to the effect that color is claimed. In the case where the applicant does not wish the mark to be registered and published in the standard characters used by the Office of the Contracting Party concerned, up to five reproductions (in black and white) may be required (item (i)); otherwise, only one reproduction in black and white may be required (item (ii)).

R3.04 *Subparagraph (b)* deals with the case where the application contains a statement to the effect that the applicant claims colors. A maximum of ten reproductions (five in color and five in black and white) may be required.

R3.05 *Paragraph (2)* does not deal with the questions of the size and quality of the reproductions. As regards the quality, see Note 3.12, last sentence, under Article 3(1)(a)(xii).

R3.06 *Paragraph (3)(a).* The words “shall consist” make it clear that the applicant cannot file with the Office a specimen of the three-dimensional mark in lieu of two-dimensional reproductions of that mark. However, any Contracting Party is free to accept that the applicant, in addition to two-dimensional reproductions, also furnish a specimen. Where a Contracting Party allows the transmittal of communications by electronic means, other techniques to satisfy the requirements concerning the reproduction may be available.

R3.07 *Paragraph (3)(b)* enables the applicant to furnish, for the purposes of reproduction of a three-dimensional mark, one single view or several different views of the mark. This provision, however, does not impose any obligation on a Contracting Party as regards the number of views it should publish. A Contracting Party is therefore free to provide that only one view of the three-dimensional mark will be published and, in such a case, it may require that, where the applicant furnishes several different views, he indicates the view which the Office should publish. If the applicant does not give such an indication, the Office may invite him to do so, or select *ex officio* one of the views.

R3.08 *Paragraph (3)(c) and (d).* These provisions deal with the cases where the Office of a Contracting Party considers that the particulars of a three-dimensional mark are not sufficiently shown by the reproductions furnished.

R3.09 *Paragraph (3)(e).* This provision makes it clear that as regards color, in the case of three-dimensional marks, the number of reproductions of each view is the same as for two dimensional marks and that the reference to standard characters does not apply to three-dimensional marks.

R3.10 *Paragraph (6).* A Contracting Party may subject the granting of extensions of the minimum time limit of six months to various conditions, for example, the possible payment of fees or the submission of documents or indications justifying the reason why actual use has not commenced.

Notes on Rule 4
(Details Concerning Representation and Address for Service)

R4.01 *Paragraph (1).* In the event that other addresses have been indicated to the Office, only the address of the representative will be considered as an address for service. If that address is not on the territory of the Contracting Party, the Contracting Party may, in accordance with Article 4(1)(a)(ii), require that the address provided by the representative be on a territory prescribed by it.

R4.02 *Paragraph (3).* The minimum time limit of two months that must be accorded to persons residing abroad takes into account the fact that postal transmittal usually takes more time between two countries than inside one country. The time limits of one month and two months start from the date on which, under Article 4(3)(d), a communication is submitted to the Office of a Contracting Party without the required power of attorney. Neither the Treaty nor the Regulations provide that such Office is obliged to send a notification requesting the furnishing of a missing power of attorney.

Notes on Rule 5
(Details Concerning the Filing Date)

R5.01 *Paragraph (1).* The longer time limit for applicants residing abroad is considered justified not only because more time is required for postal transmittal from abroad than for transmittal inside the country but also because a local representative should be given enough time to communicate with the applicant residing abroad. Where the applicant has a representative, the invitation referred to in paragraph (1) will be sent to that representative instead of, or in addition to, the applicant.

R5.02. The final sentence of paragraph (1) is intended to make it clear that a failure on the part of the Office to send the required invitation does not exempt the applicant from its obligation to comply with any of the applicable requirements of Article 5 of the Treaty. The reasons for such a failure can be, for example, the impossibility for the Office to contact the applicant or a general strike. In any case, the consequence will be that, until such requirements are complied with, the application will not be accorded a filing date.

R5.03 *Paragraph (2).* The expression “shall be treated as if it had not been filed” should be understood as covering also the case where a Contracting Party considers the application withdrawn or abandoned.

R5.04 The last sentence of paragraph (2) does not oblige any Contracting Party to refund the fees paid in connection with the filing of the application.

Notes on Rule 6
(Details Concerning Communications)

R6.01 *Paragraph (1).* This paragraph applies to the signature of any natural person on a communication on paper, 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 signatures on paper communications which were transmitted by electronic means of transmittal, such as communications filed by telefacsimile, or paper communications which were scanned and transmitted, for example, as e-mail attachments.

R6.03 *Paragraph (5).* Contracting Parties that permit the transmission of paper documents by electronic means of transmittal, such as telefacsimile or electronic image files, must accept under Rule 6(4) the signature that appears on communication transmitted in such manner. However, they can require that the original of any such document be filed with the Office as prescribed in paragraph (5).

R6.04 *Paragraph (6).* In order to avoid any confusion between signatures on paper communications, for which Contracting Parties cannot require any form of certification or authentication, except in cases concerning the surrender of a registration, and systems for protecting the integrity and confidentiality of electronic communications, often referred to as "electronic signatures", the Treaty and Regulations do not use the latter term. Instead the expression "authentication of communication in electronic form" is used. It envisages all systems that may be used by Contracting Parties in order to secure electronic communications between an applicant, holder or other interested person and an Office. It is to be noted that, under this provision as it currently stands, Contracting Parties have complete freedom in prescribing the rules to be followed for this type of communication. However, to the extent that the subject is dealt with in the Regulations, future harmonization in that area may be reached through a decision by the Assembly.

R6.05. *Paragraph (7).* This paragraph does not apply to non-compliance of the requirements specified in respect of the filing date of an application (Article 5). In particular, where an application does not comply with one of the filing date requirements as provided for in Article 5 and an invitation was issued under Rule 5(1), the Office of a Contracting Party can treat the application as if it had not been filed without having to issue a second invitation to make observations if the applicant had not complied with the first invitation.

R6.06. *Paragraph (7)(b).* Where a communication does not comply with Article 8(2), for example, a communication is not in an official language of the Office, the Office is not obliged to notify the applicant, holder or other interested person although, it would be free to do so.

R6.07. *Paragraph (8)(a).* The term "refusal" is intended to also cover sanctions that are of equivalent effect to a refusal, such as the communication being treated as not filed, abandoned or withdrawn. Since a Contracting Party whose Office accepts communications in electronic form has freedom to apply its requirements to this type of communication, paragraph (8) is not applicable to communications falling under paragraph (6).

R6.08. *Paragraph (8)(b).* A notification under paragraph (2)(a) cannot be made where indications allowing the applicant, holder or other interested person to be contacted by the Office have not been filed. In this kind of situation the Contracting Party may, after a reasonable time limit, apply such sanctions as provided for in its national law.

Notes on Rule 8
(Details Concerning Duration and Renewal)

R.8.01 *Rule 8* builds on the provisions contained in Article 5*bis* of the Paris Convention, relating to the obligation to grant a period of grace of not less than six months for the payment of fees to maintain an industrial property right, and to the possibility of requiring the payment of a surcharge in such case.

R8.02. Rule 8 is more detailed than Article 5*bis* of the Paris Convention, since it provides for a grace period not only to pay the prescribed fees for the renewal of the registration of a mark, but also to file the request for renewal before the Office. In this respect, a Contracting Party would be obliged to accept a request for renewal of a registration even if that request is filed after the date on which the renewal is due, namely the date on which the registration expires. The Contracting Party may fix a time limit (grace period) for this, but such limit may not be shorter than six months after the date on which the renewal is due. The question of the status of the registration during the grace period, and the manner in which intervening rights possibly acquired during that period will be recognized, are left to the applicable laws of the Contracting Parties.

R.8.03 Rule 8 also establishes a minimum time period during which the request for renewal may be filed *before* the date on which renewal is due. This aims at ensuring that holders of marks will be able to file their requests for renewal in good time before the expiration of the relevant registrations, thus ensuring a seamless continuation of their registered rights.

R8.04 If the law of a Contracting Party provides that the Office must inform the holder when his registration is due for renewal, the consequences of the failure to inform the holder may be stipulated by the applicable national law.

Notes on Rule 9
(Requirements Relating to Measures in Case of Failure to Comply with Time Limits)

R9.01 *Paragraph (2).* A Contracting Party that allows continued processing may require that the omitted act be completed within the same time period for filing a request for continued processing. This time limit shall be at least two months from the expiry of the time limit which was missed by the applicant, holder or other interested person.

R9.02 *Paragraph (3).* Unlike a request for the extension of a time limit or for continued processing, a Contracting Party may require that the request for reinstatement of rights state the reasons for the failure to comply with a time limit. A Contracting Party is free to require that all of the requirements be complied with within the time limit referred to in paragraph (3)(c). In this respect, the Contracting Party may provide that such requirements be complied with at the time the request is filed, or it may allow the applicant, holder or third party to comply with the requirements after having filed the request but within a specified time limit. Paragraph (3)(b) recognizes a Contracting Party's freedom to establish an absolute time limit to request reinstatement of rights. Such time limit may not, however, be shorter than twelve months counted from the date of expiration of the time limit initially missed.

R9.03 *Paragraph (4).* This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the extension of a time limit, continued processing or the reinstatement of rights under Article 14, although it is free to do so.

R9.04 *Item (i).* A Contracting Party is not obliged to grant more than one instance of relief under Article 14, where a request for relief was made after the expiry of the time limit concerned, although it is free to do so.

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 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, and for the filing of a request for renewal and the payment of renewal fees under Article 13(1)(c) and Rule 8 of the Treaty.

R9.07 *Item (iv).* To the extent that procedures before a board of appeals or other review body constituted in the framework of an Office are considered under the law of a Contracting Party as judicial procedures, that Contracting Party is not obliged to apply the Treaty to such procedures (see Article 1(viii) and Note 1.06). But even where, due to the legal nature of such procedures as determined by the applicable law, the Treaty would apply, a Contracting Party is not obliged to provide for any of the relief measures under Article 14. Moreover, this recognizes that legal certainty in appeal proceedings generally requires that the time limits stipulated by statute should not be subject to extension.

R9.08 *Item (v).* Trademark opposition proceedings generally include one or more submissions by the litigating parties which, in certain cases, might require a succession of reliefs. While it seems appropriate, for reasons of legal security, to exclude actions in relation to *inter partes* proceedings from the obligation to provide relief measures under the TLT, Contracting Parties would be free to provide in their laws for appropriate relief in circumstances where the competing interests of third parties, as well as those interests of others who are not parties to the proceedings, are properly taken into account.

R9.09 *Items (vi) and (vii).* For the sake of legal certainty in the interest of third parties, Contracting Parties may exclude procedures relating to priority claims from the possibility of reliefs or reinstatement of rights. However, a Contracting Party would be free to offer such possibility in its national legislation.

Notes on Rule 10
(Contents of the Request for Recordal of a License)

R10.01 *Paragraph (1)(a).* This paragraph sets out the elements which an Office may require to be presented in a request for recordal of a license. Because of Article 17(4), the list of those elements constitutes a maximum. An Office is free to require only some of those elements, but it may not require different or additional elements.

R10.02 *Items (i) to (vi).* As regards the manner of indicating names and addresses, Rule 2 (*Manner of Indicating Names and Addresses*) would apply.

R10.03 *Items (ii), (iii), (v) and (vi).* Article 4(2) would apply to these items, because recordal of a license is a "procedure before the Office". Thus, under that article, representation or an address for service may be required.

R10.04 *Item (vii).* Since Article 3 of the Paris Convention provides that nationals of countries not members of the Paris Union are entitled to national treatment if they have a real and effective industrial or commercial establishment or are domiciled in one of the Paris Union countries, this item allows those indications to be required.

R10.05 *Item (viii)* allows a Contracting Party to require that, where the holder, the licensee, or both parties are legal entities, the legal nature of the entity be specified. This provision mirrors Article 3(1)(a)(iv) which allows a similar requirement with regard to trademark applications.

R10.06 *Item (xi).* Definitions of "exclusive license", "non-exclusive license" and "sole license" are contained in Article 1(xiii) to (xv). The words "where applicable", indicate that, if the law of the Contracting Party does not provide for one or more such indications, information corresponding to the item under consideration would not have to be furnished.

R10.07 *Item (xii)* allows a Contracting Party to require an indication that the license concerns only part of the territory for which the registration has effect, together with an explicit indication of that territory.

R10.08 *Item (xiii).* Contracting Parties may require that the request indicate the time period for which the license is granted, or that it is granted for an unlimited period of time. If the license is granted for a limited period of time but renewed or extended automatically, the license would be considered to have been granted for a limited period of time. It would be the responsibility of the parties to inform the Office of any subsequent renewal or extension of the license.

R10.09 *Paragraph (2).* A request for recordal of a license is a communication and, therefore, Article 8 and the relevant rule apply. The question of entitlement to file a request for recordal of a license is not dealt with. However, a Contracting Party may require certain documentary evidence to be provided by the requesting party as a condition to record the license. At the option of the requesting party, who will frequently be the representative of the licensor or of the licensee, the request for recordal has to be accompanied, if a Contracting Party so requires, by the documents specified in item (i) or in item (ii).

R10.10 *Paragraph (3).* The question of entitlement to file a request for the amendment or cancellation of the recordal of a license is not dealt with. This paragraph, however, allows a Contracting Party to require that the requesting party submit the documentary evidence in item (i) or (ii), at the choice of that party. The wording of item (i) was kept deliberately broad, because the reason for requesting the amendment or cancellation of a recorded license may be manifold.

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