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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Fourteenth Session
Geneva, April 18 to 22, 2005

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. Mr. Ernesto Rubio, Assistant Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the delegates on behalf of the Director General of WIPO.

Agenda Item 2: Election of a Chair and two Vice-Chairs

2. Mr. Li-Feng Schrock (Germany) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) for the year 2005. Mr. James Otieno-Odek (Kenya) and Ms. Luz Celeste Ríos de Davis (Panama) were elected as Vice-Chairs for the same period.

Agenda Item 3: Adoption of the Agenda

3. The SCT adopted the Draft Agenda (document SCT/14/1 Prov.2) without modifications.

Agenda Item 4: Accreditation of Certain Non-Governmental Organizations

4. Discussion was based on document SCT/14/6 (Accreditation of Certain Non-Governmental Organizations).
5. The SCT approved the representation in sessions of the Committee of the non-governmental organizations referred to in the Annex to document SCT/14/6.

Agenda Item 5: Adoption of the Draft Report of the Thirteenth Session

6. The SCT adopted the Draft Report (document SCT/13/8 Prov.2) without modifications.

Agenda Item 6: Revision of the Trademark Law Treaty

7. Discussion was based on the following documents: SCT/14/2 (Draft Revised Trademark Law Treaty (TLT)), SCT/14/3 (Draft Revised Regulations under the Draft Revised Trademark Law Treaty) and SCT/14/4 (Notes on the Draft Revised Trademark Law Treaty and the Draft Revised Regulations).

Article 1
Abbreviated Expressions

items (i) to (xxii). These provisions were approved as proposed on the understanding that the term “or persons” in item (v) would be omitted.

item (xxiii). It was agreed to redraft this provision as follows:

“‘TLT 1994’ means the Trademark Law Treaty done at Geneva on October 27, 1994”.

It was agreed to add a new item providing a definition of the term “Assembly”.

Article 2
Marks to Which the Treaty Applies

(1) [*Nature of Marks*]

The Chair concluded that it was agreed to replace subparagraphs (a), (b) and (c) with one single provision having the following wording:

“Any Contracting Party shall apply this Treaty to marks consisting of signs that can be registered as marks under its law”.

(2) [*Kinds of Marks*]

This provision was approved as proposed.

Article 3
Application

(1) [*Indications or Elements Contained in or Accompanying an Application; Fee*]

Subparagraph (a), items (i) to (viii). These provisions were approved as proposed.

items (ix) to (xiv). The Chair concluded that it was agreed to replace these provisions with two items. The first item should become item (ix) and have the following wording:

“*item (ix)* at least one representation of the mark, as prescribed in the Regulations;”.

The second item should become item (x) and have the following wording:

“*item (x)* where applicable, a statement, as prescribed in the Regulations, indicating the type of mark as well as any specific requirements applicable to that type of mark, indicating that the applicant wishes that the mark be registered and published in the standard characters used by the Office, or indicating that the applicant wishes to claim color as a distinctive feature of the mark;”.

items (xv) to (xviii). These provisions were approved as proposed subject to renumbering in accordance with the replacement of items (ix) to (xiv).

Subparagraphs (b) and (c). These provisions were approved as proposed.

Paragraphs (2) to (5). These provisions were approved as proposed.

Article 4
Representation; Address for Service

This provision was approved as proposed.

Article 5
Filing Date

This provision was approved as proposed.

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

This provision was approved as proposed.

Article 7
Division of Application and Registration

This provision was approved as proposed.

Article 8
Communications

(1) [*Means of Transmittal and Form of Communications*]

This provision was approved with the following wording:

“Any Contracting Party may choose the means of transmittal of communications and whether it accepts communications on paper, communications in electronic form or any other form of communication”.

Paragraphs (2) to (4). These provisions were approved as proposed.

(5) [*Presentation of a Communication*]

This provision was approved with the following wording:

“Any Contracting Party shall accept the presentation of a communication the content of which corresponds to the relevant Model International Form, if any, provided for in the Regulations”.

Paragraph (6). This provision was approved as proposed.

Article 9
Classification of Goods and/or Services

This provision was approved as proposed.

Article 10
Changes in Names or Addresses

This provision was approved as proposed.

Article 11
Change in Ownership

This provision was approved as proposed.

Article 12
Correction of a Mistake

This provision was approved as proposed.

Article 13
Duration and Renewal of Registration

This provision was approved as proposed.

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

(1) [*Relief Measure Before the Expiry of a Time Limit*]

This provision was approved as proposed.

(2) [*Relief Measures After the Expiry of a Time Limit*]

This provision was approved as proposed. However, the Secretariat was entrusted with the task of checking for consistency, throughout the Treaty, the use of the words “interested party” or “interested person”.

(3) [*Exceptions*]

This provision was approved as proposed, subject to deletion of the reference to paragraph (1).

(4) [*Fees*]

This provision was approved as proposed.

(5) [*Prohibition of Other Requirements*]

This provision was approved as proposed, subject to deletion of the reference to paragraph (1).

Article 15
Obligation to Comply with the Paris Convention

This provision was approved as proposed.

Article 16
Service Marks

This provision was approved as proposed.

Article 17
Request for Recordal of a License

This provision was approved as proposed. It was agreed to replace the word “Contents” for the word “Requirements” in the heading of paragraph (1).

Article 18
Request for Amendment or Cancellation of Recordal of a License

This provision was approved as proposed, subject to the change in the reference to “Article 17(2) to (6)” in paragraph (2). It was agreed to replace the word “Contents” for the word “Requirements” in the heading of paragraph (1).

Article 19
Effects of the Non-Recordal of a License

This provision was approved as proposed.

Article 20
Use of a Mark on Behalf of the Holder

It was agreed to redraft this provision, to integrate it as paragraph (3) of Article 19 with the following wording, and with a new heading, to be proposed by the Secretariat:

“A Contracting Party may not require the recordal of a license as a condition for the use of a mark by a licensee to be deemed to constitute use by the holder in proceedings relating to the acquisition, maintenance and enforcement of marks.”.

Article 21
Indication of the License

This provision was approved as proposed.

It was decided to renumber this Article and the remaining Articles of the Treaty, as a consequence of the merger of former Article 20 and Article 19.

Article 22
Observations in Case of Intended Refusal

This provision was approved with the following wording on the understanding that a clarification reflecting the content of the provision would be added to the Notes:

“An application under Article 3 or a request under Articles 7, 10 to 14, 17 and 18 may not be refused totally or in part by an Office without giving the applicant or the requesting party, as the case may be, an opportunity to make observations on the intended refusal within a reasonable time limit. In respect of Article 14, no Office would need to give an opportunity to make observations where the requesting party has already had an opportunity to present an observation on the facts on which the decision is to be based”.

Article 23
Regulations

This provision was approved as proposed.

Article 24
Assembly

This provision was approved as proposed.

Article 25
International Bureau

This provision was approved as proposed.

Article 26
Revision and Amendment

(1) [*Revision of the Treaty*]

This provision was approved as proposed on the understanding that a clarification as to the powers of a Diplomatic Conference be added to the Notes in conformity with the Vienna Convention on the Law of Treaties.

(2) [*Amendment by the Assembly of Certain Provisions of the Treaty*]

Subparagraphs (a) and (b). These provisions were approved as proposed.

The Delegation of Japan made a reservation with regard to subparagraph (a).

Subparagraph (c). This provision was approved as proposed on the understanding that the words which appeared crossed out in the proposal be retained.

The Delegation of the Islamic Republic of Iran made a reservation with regard to subparagraph (c).

Article 27
Becoming Party to the Treaty

This provision was approved as proposed.

Article 28
Application of the TLT 1994 and This Treaty

This provision was approved as proposed.

Article 29
Entry into Force;
Effective Date of Ratifications and Accessions

(1) [*Instruments to Be Taken into Consideration*]

This provision was approved as proposed.

(2) [*Entry into Force of the Treaty*]

It was agreed to redraft this provision as follows:

“This Treaty shall enter into force three months after five States or intergovernmental organizations referred to in Article 27(1)(ii) have deposited their instruments of ratification or accession”.

(3) [*Entry into Force of Ratifications and Accessions Subsequent to the Entry into Force of the Treaty*]

This provision was approved as proposed.

(4) [*Closing of the Trademark Law Treaty 1994*]

It was agreed that this provision should be omitted.

Article 30
Reservations

This provision was approved as proposed.

Article 31
Denunciation of the Treaty

This provision was approved as proposed.

Article 32
Languages of the Treaty; Signature

This provision was approved as proposed.

Article 33
Depositary

This provision was approved as proposed.

Rule 1
Abbreviated Expressions

This provision was approved as proposed, subject to the addition of the word “Revised” before the words “Trademark Law Treaty”.

Rule 2
Manner of Indicating Names and Addresses

(1) [*Names*]

This provision was approved as proposed.

(2) [*Addresses*]

Subparagraphs (a), (b) and (c). These provisions were approved as proposed.

Subparagraph (d). This provision was approved as proposed on the understanding that its content would be moved to a new paragraph (3) of Rule 2.

Subparagraph (e). This provision was approved as proposed on the understanding that it would be renamed as subparagraph (d) of Rule 2(2).

(3) [*Script to Be Used*]

This provision was approved as proposed on the understanding that it would become a new paragraph (4) of Rule 2.

Rule 3
Details Concerning the Application

(1) [*Standard Characters*]

It was agreed to redraft this provision as follows:

“Where the Office of a Contracting Party uses characters (letters and numbers) that it considers as being standard, and where the application contains a statement to the effect that the applicant wishes that the mark be registered and published in the standard characters used by the Office, the Office shall register and publish that mark in such standard characters”.

(2) [*Number of Reproductions*]

This provision was approved as proposed on the understanding that its content would be moved to a new paragraph (3) of Rule 3, and that a clarification reflecting the understanding that the term “representation” used in Article 3(1)(a)(ix) covers the term “reproduction” used in the provision would be added to the Notes. It was agreed that a new paragraph (2) should be inserted in Rule 3 having the following heading and wording:

“(2) [*Mark Claiming Color*] Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, the Office may require that the application indicate the name or code of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color”.

(3) [*Reproduction of a Three-Dimensional Mark*]

It was agreed that the content of this provision should be moved to a new paragraph (4) of Rule 3, and that its heading should be redrafted as follows: “[*Three-Dimensional Mark*]”

Subparagraph (a). This provision was approved as proposed on the understanding that the words “, pursuant to Article 3(1)(a)(xi),” should be omitted.

Subparagraphs (b) to (d). These provisions were approved as proposed.

Subparagraph (e). It was agreed to redraft this provision as follows:

“Paragraph (3)(a)(i) and (b) shall apply *mutatis mutandis*”.

(4) [*Reproduction of a Hologram Mark*]

It was agreed to move this provision to a new paragraph (5) of Rule 3 and redraft its heading and wording as follows:

“(5) [*Hologram Mark, Motion Mark, Color Mark, Position Mark*] Where the application contains a statement to the effect that the mark is a hologram mark, a motion mark, a color mark or a position mark, a Contracting Party

may require one or more reproductions of the mark and details concerning the mark, as prescribed by the law of that Contracting Party”.

(5) [*Representation of a Mark Consisting of a Non-Visible Sign*]

It was agreed to move this provision to a new paragraph (6) of Rule 3 and redraft its heading and wording as follows:

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

Paragraphs (6) to (8). These provisions were approved as proposed on the understanding that they would become paragraphs (7) to (9) of Rule 3 respectively, and that references to Article 3(1)(a) would be adjusted in accordance with the renumbering of the items of that Article.

Rule 4
Details Concerning Representation and Address for Service

This provision was approved as proposed.

Rule 5
Details Concerning the Filing Date

This provision was approved on the understanding that the content of paragraph (3) be moved to Rule 6, and that the word “application” be changed by “communication”.

Rule 6
Details Concerning Communications

Paragraphs (1) to (5). These provisions were approved as proposed.

(6) [*Authentication of Communications in Electronic Form*]

This provision was approved as proposed.

The Delegation of the Islamic Republic of Iran made a reservation with regard to this provision.

(7) [*Date of Receipt*]

The chapeau of this provision was approved as proposed, subject to the deletion of the words “in particular”.

items (i) to (iii) were approved as proposed.

item (iv) was approved with the following wording:

“a delivery service or an agency specified by the Contracting Party”.

It was decided to include a new *item (v)* with the following wording:

“an address other than the nominated addresses of the Office”.

It was also decided to add a new paragraph (8), with the contents of former Rule 5(3), which would have the following wording:

“(8) [*Electronic Filing*] Subject to paragraph (7), where a Contracting Party provides for the filing of a communication in electronic form or by electronic means of transmittal and the communication is so filed, the date on which the Office of that Contracting Party receives the communication in such form or by such means shall constitute the date of receipt of the communication”.

Rule 7

Manner of Identification of an Application Without Its Application Number

This provision was approved as proposed.

Rule 8

Details Concerning Duration and Renewal

This provision was approved as proposed.

Rule 9

Relief Measures in Case of Failure to Comply with Time Limits

This provision was approved as proposed, on the understanding that the Notes on paragraph (4)(vii) would be further clarified and that the word “concerned” would be added at the end of paragraph (3)(a)(ii).

Rule 10

Details Concerning the Request for Recordal of a License or for Amendment or Cancellation of the Recordal of a License

It was decided to change the word “Details” for “Requirements” in the heading of Rule 10.

(1) [*Contents of Request*]

This provision was adopted as proposed, subject to a change of the word “Contents” for “Content” in the heading of Rule 10(1).

It was also agreed to introduce the same change throughout the Treaty, the Regulations and the notes.

(2) [*Supporting Documents for Recordal of a License*]

This provision was approved as proposed, subject to the deletion of the words “or his representative” in item (ii).

It was decided to reverse the order of paragraphs (3) and (4).

(3) [*Supporting Documents for Cancellation of Recordal of a License*]

This provision was approved as proposed, subject to the deletion of the words “or his representative” in item (ii).

(4) [*Supporting Documents for Amendment of Recordal of a License*]

This provision was approved as proposed, on the understanding that a new subparagraph (b) would be added, having the same effect as subparagraph (2)(b), and subject to the deletion of the words “or his representative”.

Agenda Item 7: Questionnaire on Trademark Law and Practice

8. The SCT took note of document SCT/14/5.

Agenda Item 8: Future Work

9. Members and observers of the Committee were invited to submit to the Secretariat, by July 1, 2005, in writing, concise proposals for future work of the SCT, including the issues to be dealt with and priorities for addressing them. The Secretariat will translate these proposals and make them available as SCT working documents.

10. The Chair announced as tentative dates for SCT/15, November 28 to December 2, 2005.

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