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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

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COMPILATION OF PROPOSALS FOR FUTURE WORK OF
THE STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL
DESIGNS AND GEOGRAPHICAL INDICATIONS

Document prepared by the Secretariat

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I. INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”), at its fourteenth session (Geneva, April 18 to 22, 2005), decided to invite members of and observers to the SCT to submit to the Secretariat, in writing, concise proposals for future work of the SCT, including the issues to be dealt with and priorities for addressing them (see document SCT/14/8 Prov., paragraph 354).

2. The following members of the Standing Committee submitted proposals: Barbados, France, Latvia, Mexico, Morocco, New Zealand, Norway, Russian Federation, Slovakia, Switzerland, the former Yugoslav Republic of Macedonia, United Kingdom, United States of America and the European Community (14).

3. Proposals were also received from the following observers to the Standing Committee: European Brands Association (AIM), International Federation of Industrial Property Attorneys (FICPI) (2).

4. The proposals submitted to the Secretariat concern the following topics: harmonization of substantive trademark law (3 proposals); new types of marks (4 proposals); well-known marks (7 proposals); collective and certification marks (1 proposal); protection of trademarks on the Internet (1 proposal); work on a joint recommendation concerning trademark opposition proceedings (1 proposal); marks and international nonproprietary names of pharmaceutical substances (1 proposal); Article 6*ter* of the Paris Convention (4 proposals); industrial designs and three-dimensional marks (5 proposals); work on a design law treaty seeking to harmonize registration procedures in the field of industrial designs (3 proposals); geographical indications (8 proposals); Internet domain names (total: 6 proposals), in particular, Internet domain names and geographical indications (4 proposals), country names (1 proposal) and trademarks/trade names (1 proposal).

5. A more detailed presentation of the proposals is contained in Chapter II of this document.

6. The texts of all proposals submitted are reproduced as Annexes to this document.

7. In addition, attention is drawn to proposals made by members of and observers to the SCT at earlier sessions of the SCT, and not referred to above. In particular, the Delegation of Denmark suggested at the thirteenth session of the SCT, continuation of the work on document SCT/9/6 titled “Industrial Designs and Their Relation with Works of Applied Art and Three-Dimensional Marks” (see document SCT/13/8, paragraph 323). At the same session, the Delegation of Australia suggested that work on the harmonization of substantive trademark law should be given priority in the future activities of the SCT (see document SCT/13/8, paragraph 324).

II. PRESENTATION OF PROPOSALS BY SUBJECT MATTER

8. The following presentation provides an overview of the topics proposed by members of and observers to the SCT and submitted to the Secretariat in accordance with the decision taken by the Standing Committee at its fourteenth session. With a view to facilitate the work of the Committee, the various proposals are grouped according to their subject matter into the following sub-chapters: (a) Trademarks, (b) Article 6*ter* of the Paris Convention, (c) Industrial Designs, (d) Geographical Indications and (e) Internet Domain Names.

(a) Trademarks

(i) Harmonization of Substantive Trademark Law

9. The Delegations of Mexico and the Russian Federation and the Representative of AIM propose that the Standing Committee consider work on the harmonization of substantive trademark law issues.

10. The Delegation of Mexico suggests that the Standing Committee continue its analysis of and follow up on the substantive harmonization of trademark law. In this context, it refers to the Questionnaire on Trademark Law and Practice (see document SCT/14/5 for a summary of replies to the Questionnaire).

11. The Delegation of the Russian Federation proposes that besides work on new types of trademarks, well-known marks and trademarks on the Internet, as mentioned under the respective headings below, the Standing Committee explore the feasibility of harmonizing grounds for refusal.

12. The Representative of AIM submits that the harmonization of substantive trademark law issues, such as the potential for legislation to deal with parasitic copies and look-alikes, should remain on the agenda of the Standing Committee.

(ii) New Types of Marks

13. The Delegations of France, the Russian Federation and Switzerland and the Representative of the European Community propose that the Standing Committee undertake work in the field of new types of marks.

14. In particular, the Delegation of the Russian Federation suggests exploring the feasibility of harmonizing substantive trademark law in the field of the protection of new trademarks.

15. The Delegation of Switzerland suggests that the Standing Committee discuss the question of new types of marks, such as movement marks and olfactory marks, with a view to harmonizing, on the one hand, the criteria for their registration and, on the other hand, the registration procedure.

(iii) Well-Known Marks

16. The Delegations of Mexico, Morocco, the Russian Federation, Slovakia, the former Yugoslav Republic of Macedonia and the United States of America and the Representative of AIM propose that the Standing Committee deal with certain issues related to well-known marks.

17. The Delegation of Mexico proposes in its submission that the Standing Committee continue its analysis and follow up on the issue of national registers of well-known marks.

18. The Delegation of Morocco proposes that, besides work on geographical indications, the Standing Committee give priority to well-known marks.

19. The Delegation of the Russian Federation proposes in its submission that the Standing Committee discuss and take stock of the protection of well-known marks, taking into consideration the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

20. The Delegation of the Slovak Republic submits that the Standing Committee discuss the area of well-known marks.

21. The Delegation of the former Yugoslav Republic of Macedonia recalls that the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks does not mention the establishment of special registers for well-known marks. It indicates that many countries have established a well-known mark register in order to provide a formal reference tool for the application process, and to assist courts in infringement proceedings. The submission points out that the establishment of a special register of well-known marks might be advantageous in the area of law enforcement. As the introduction of a special register of well-known marks in each country raises a number of difficult questions, it proposes that these questions be discussed in the Standing Committee.

22. The Delegation of the United States of America submits that the Standing Committee put on its agenda the issue of well-known marks, specifically well-known mark registries.

23. The Representative of AIM states that the organization is increasingly concerned about the proliferation of registers of well-known marks, and that this issue merits further debate. AIM requests the International Bureau to conduct a survey on adherence to the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, including specific questions on registers of well-known marks.

(iv) Collective and Certification Marks

24. The Delegation of the former Yugoslav Republic of Macedonia suggests that the Standing Committee devote attention to collective and certification marks. These types of marks do not fall within the scope of the Revised Trademark Law Treaty, as presently drafted, while the summary of replies to the Questionnaire on Trademark Law and Practice in document SCT/14/5 gives evidence of a solid number of countries providing for collective and certification marks in their national laws. Moreover, varied legislation and specific registration requirements concerning collective and certification marks exist at the national level.

(v) Trademarks on the Internet

25. The Delegation of the Russian Federation proposes that the Standing Committee discuss and take stock of the protection of trademarks on the Internet taking into consideration the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet.

(vi) Joint Recommendation Concerning Trademark Opposition Proceedings

26. The Representative of FICPI suggests that the Standing Committee should study harmonization of opposition proceedings with a view to adopting at least a Joint Recommendation that all Member States of WIPO should have a system of opposition at their Trademark Office either before or during a short period after registration. A minimum list of grounds for opposition should be harmonized, including at least basic grounds for refusal based on prior registered marks and well-known marks. Other areas of possible harmonization within opposition proceedings include timeframes for various portions of the process as well as possible extensions of those time periods, particularly to allow settlement. Should harmonization of these more formal aspects of opposition prove possible, evidentiary and other more substantive issues could be considered by the Standing Committee.

(vii) Marks and International Nonproprietary Names for Pharmaceutical Substances

27. The Delegation of Mexico proposes that the Standing Committee deal with the relationship between marks and international nonproprietary names for pharmaceutical substances.

(viii) Industrial Designs and Three-Dimensional Marks

28. Concerning proposals for work on this topic, see paragraphs 32 and 33.

(b) Article 6*ter* of the Paris Convention

29. The Delegations of Mexico, New Zealand, the United Kingdom and the United States of America emphasize the interest of those Delegations in a discussion on Article 6*ter* of the Paris Convention in the Standing Committee.

30. More specifically, the Delegation of New Zealand proposed that the Standing Committee undertake a comprehensive review of the procedure applicable under Article 6*ter*.

31. The Delegation of the United Kingdom submits that it would be of benefit to consider the administrative procedures and certain issues affecting the scope of protection in terms of how consistent such procedures were with the provisions set out in Article 6*ter*. In particular, this submission proposes that, as a first step, the International Bureau conduct a review of provisions concerning the Article 6*ter* regime and to make recommendations on how these provisions could be modernized and improved.

(c) Industrial Designs

(i) Industrial Designs and Three-Dimensional Marks

32. The Delegations of France, Mexico, Switzerland and the former Yugoslav Republic of Macedonia and the Representative of the European Community propose that the Standing Committee examine the issue relating to the relationship between industrial designs and three-dimensional marks.

33. The Delegation of France expressly supports the proposal by the European Community.

(ii) Design Law Treaty

34. The Delegations of Latvia and Norway and the Representative of FICPI suggest that the Standing Committee work on harmonization of design registration formalities and procedures.

35. The Delegation of Latvia proposes in particular to work on an international treaty on industrial designs following the pattern in drafting of the Revised Trademark Law Treaty. That submission refers to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs as an example for the possibility to overcome differences in national procedures for the protection of designs.

36. The Delegation of Norway submits that a design law treaty is a next logical step in the work of the SCT, since the Patent Law Treaty and Trademark Law Treaty already exist. Such a treaty could contain provisions regulating formalities, the maximum requirements for what an application for design registration may contain, the possibilities of time limits, review of refusal and appeal procedures, etc.

37. The Representative of FICPI puts forward detailed proposals for harmonization in the area of industrial designs.

(d) Geographical Indications

38. The Delegations of Barbados, Mexico, Morocco, the Russian Federation, Slovakia, the former Yugoslav Republic of Macedonia and the United States of America and the Representative of AIM suggest that the Standing Committee devote attention to the protection of geographical indications.

39. The Delegation of Barbados emphasizes the interest of developing countries in substantive considerations of geographical indications and suggests that the definition of geographical indications be taken up on the agenda of the Standing Committee.

40. The Delegation of Mexico expresses the wish that the Standing Committee continue to analyze geographical indications and devote attention to the items raised at the ninth session of the Committee, such as the definition of the subject matter of protection, whether the protection should be based on a registration, and conflicts between marks and geographical indications.

41. The Delegation of Morocco gives priority to discussions on geographical indications.

42. The Delegation of the Russian Federation suggests a reporting on the results of the work done by the Council for the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of the World Trade Organization (WTO) on the protection of geographical indications under Article 23.4 of that Agreement and Item 18 of the Doha Declaration. In addition, it proposes to prepare a World Intellectual Property Organization (WIPO) recommendation on the protection of geographical indications, including the definition of the subject matter of protection, approaches to a system of international registration and the essential features of the registration procedure, and the ways of solutions for conflicts between trademarks and geographical indications.

43. The Delegation of Slovakia suggests discussions on geographical indications to take place in the Standing Committee.

44. The Delegation of the former Yugoslav Republic of Macedonia points out the differences between the national legislations concerning the protection of geographical indications, and suggests harmonization of those legislations.

45. The Delegation of the United States of America proposes to add geographical indications to the agenda of the Standing Committee.

46. The Representative of AIM puts forward for consideration the potential harmonization of certain provisions concerning geographical indications.

47. The Representative of the European Community submits that, on geographical indications, its priority remains the inclusion of geographical indications in the WIPO arbitration system for trademarks and domain names. It recalls that this item was already on the agenda of the SCT.

48. The Delegation of France expressly supports the proposal by the European Community.

49. In this connection, the Delegation of Mexico considers it important that the Standing Committee continue its analysis of and follow up on the issue of Internet domain names, as well as the issue of Internet domain names and geographical indications.

(e) Internet Domain Names

50. The submission from the Delegations of Barbados, France, Mexico and Switzerland and the Representatives of AIM and the European Community propose that the Standing Committee deal with certain issues related to Internet domain names.

51. In particular, the Delegation of Barbados submits that, because of the varying views held by Members of WIPO in prior years, the discussion should be continued within the Standing Committee with a view to reaching a final position *vis-à-vis* protection of country names in the domain name system.

52. The Delegation of France and the Representative of the European Community indicate their priorities for including geographical indications in the WIPO arbitration system for trademarks and domain names (see paragraphs 47 and 48).

53. The Delegation of Mexico submits that the Standing Committee should continue its analysis of Internet domain names and of domain names and geographical indications (see paragraphs 40 and 49).

54. The SCT is invited to consider the proposals for future work presented in this document and to decide on which topic or topics it wishes to initiate work, and in which order they should be dealt with.

[Annexes follow]

ANNEX I

SUBMISSION BY THE DELEGATION OF BARBADOS

Further to your request for the submission of prospective matters to engage the attention of the Standing Committee, we now submit these proposals:

It is of note that geographical indications was excluded from the list of agenda items in the 14th session. It is in the interest of Barbados and developing countries to have this subject substantively considered in the SCT since we stand to benefit from consensus that can be reached within this body if the narrow WTO/TRIPS definition of geographical indications to products other than wines and spirits is brought back to the agenda for future discussions.

Because of varying views held by Members of WIPO in prior years the discussion should be continued within the Standing Committee on Trademarks (SCT) with a view to reaching a final position *vis-à-vis* protection of country names in the domain name system.

[Annex II follows]

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ANNEX II

SUBMISSION BY THE DELEGATION OF FRANCE

On behalf of the French Office, we would like to express our support for the proposal made by the European Community for the future work of the SCT. This proposal contains elements which are particularly interesting and beneficial, both for Offices and for right holders.

[Annex III follows]

ANNEX III

SUBMISSION BY THE DELEGATION OF LATVIA

The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), at its fourteenth session, decided to invite the Members and observers of the Committee to submit their possible proposals for the future work of the SCT.

The Patent Office of the Republic of Latvia would like to propose the following topic.

From our point of view, the most promising issue to work on would be an international treaty on industrial designs, aiming at the harmonization of design registration procedures worldwide. The Trademark Law Treaty in its revised form should be used as a pattern in drafting the proposed design law treaty. The Geneva Act of the Hague Agreement should be a good example of how to overcome differences in design procedures of Member countries.

There have been expressed certain proposals to develop the protection of geographical indications. Nevertheless, our opinion is that, for several reasons, this issue is less promising.

[Annex IV follows]

ANNEX IV

SUBMISSION BY THE DELEGATION OF MEXICO

I refer to the fourteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), at the conclusion of which, Member States and Observers were invited to submit, by July 1, 2005, written proposals for the future work of the SCT and to mention the issues to be dealt with and the priorities for addressing them.

In this regard, I would like to inform you that the Institute considers it important for the Committee to continue the analysis and follow-up of the items hereunder, whose consideration was interrupted when priority was given to work on the Trademark Law Treaty (TLT):

- Geographical Indications
- Trademarks and International Non-Proprietary Names for Pharmaceutical Substances (INN)
- Internet Domain Names
- Internet Domain Names and Geographical Indications
- Article 6^{ter} of the Paris Convention
- National Registers of Well-known Marks
- Industrial Designs and their Relationship with Works of Applied Art
- Substantive Harmonization of Trademark Law (Questionnaire on Trademark Law and Practice)

It is a priority to continue analyzing the issue of “Geographical Indications”. Until the ninth session of the SCT (November 11 to 15, 2002), issues such as: the definition of the subject-matter for protection, the question of whether protection should be based on registration, as well as possible solutions for conflicts between trademarks and geographical indications were considered.

Mexico has several geographical indications of world wide economic and cultural significance, such as Tequila, Mezcal and Talavera. From there stems the interest of the Institute to further work in this area, seeking to promote the international protection of geographical indications.

We also consider a priority to continue the analysis of “Industrial Design and its Relationship with Works of Applied Art and Three Dimensional Marks”.

This topic was discussed for the first and only time at the Ninth Session of the SCT. It was pointed out then, that in most countries, industrial design is subject to regulation in the framework of *sui generis* legislation, given its special character as a product of artistic expression, which distinguishes it from other objects of intellectual property protection. Nevertheless, the double nature of industrial designs, as expressions which contain functional and aesthetic characteristics, and given their sporadic assimilation to works of art, poses the question of determining to what extent copyright protection might overlap with industrial design protection. The latter was also seen in relation to the issue of three-dimensional marks, and it was pointed out that the shape or configuration of a product, its wrapping or packaging,

may be considered three-dimensional marks and therefore may be eligible for protection if they are sufficiently distinctive and fulfill the necessary conditions. It is important for our Institute to learn about the experiences of other national offices in this area.

[Annex V follows]

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ANNEX V

SUBMISSION BY THE DELEGATION OF MOROCCO

For the future work of the Standing Committee, we propose to give priority to well-known marks and geographical indications.

[Annex VI follows]

ANNEX VI

SUBMISSION BY THE DELEGATION OF NEW ZEALAND

SUBMISSION ON THE FUTURE WORK PROGRAM OF THE SCT:
REVIEW OF ARTICLE 6TER OF THE PARIS CONVENTION

Purpose

1. This submission from New Zealand proposes that the WIPO Standing Committee on the Laws of Trademarks, Industrial Designs and Geographical Indications (SCT) undertake a comprehensive review of the regime under Article 6ter of the Paris Convention for recognizing and protecting armorial bearings, flags, State emblems, official hallmarks, and names and emblems of international intergovernmental Organizations (IGOs).

Introduction

2. WIPO's web site offers an explanation on Article 6ter of Paris:

The purpose of Article 6ter is to protect armorial bearings, flags and other State emblems of those States and Members, ..., as well as official signs and hallmarks indicating control and warranty adopted by them. The protection granted by Article 6ter is also extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations, of which one or more countries of the Paris Union are members.

Pursuant to Article 6ter, Members of either or both the Paris Union and the WTO shall refuse or invalidate the registration, and prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems of these Members, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

3. In 1992, the Assembly of the Paris Union adopted "Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) of the Convention for the Protection of Industrial Property". This document gave guidance to the type of entity that may benefit from Article 6ter protection.

4. Since 1992 there has been very little discussion concerning other aspects of Article 6ter, such as the scope and duration of recognition of such notifications, administrative procedures, and how it affects pre-existing trade mark rights.

5. During the Tenth Session of the SCT, the delegation of the United Kingdom (UK) requested that the SCT consider "current procedures as set out in Article 6ter of the Paris Convention for the Protection of Industrial Property, including application, guidelines for interpretation, the possibility of the addition of a specific guideline on withdrawal or deletion procedure, and provision of an online database". This was subsequently put on the Agenda under Future Work, but has not yet been addressed.

6. The Secretariat did make a presentation at the Tenth Session on WIPO's on-line database of Article 6ter notifications (the "6ter Express"). Although extremely useful, it addressed only one aspect of the above request. Now that the SCT has finished its discussions on the revised TLT, it can move towards other agenda items, including the aspects of Article 6ter brought up by the United Kingdom delegation.

7. New Zealand shares the concerns originally raised by the UK delegation and considers that the time is right for the provisions around Article 6ter to be reviewed by the SCT. Such a review could explore both the possibility of modernizing the administrative procedures through taking advantage of modern modes of communication as well as explore a number of fundamental issues surrounding the nature and scope of recognition and protection of notifications under 6ter that have arisen in recent years. These issues are briefly discussed in more detail below.

Administrative procedures

8. The procedures for States and IGOs applying for recognition and protection need to be reviewed with a view to simplifying and modernizing the overall process. For example, the International Bureau requires the communication under paragraph (3) to be comprised of 600 paper reproductions of the notification for which recognition is being sought. Electronic communications could significantly simplify and reduce the cost of making and managing the notification regime.

9. Also, many notifications contain more than one emblem, name, and design element. Many times it is not clear which element is being notified. The SCT should review whether each item being notified should be included in a separate notification. If the process were electronic, there would be less of a deterrent to providing separate notifications for different subject matter.

10. There is no provision for a process for deleting or removing accepted notifications nor is there any incentive for States and IGOs to withdraw recognition for redundant notifications. Recognition appears therefore to be enduring in nature, especially in the absence of any review or renewal procedures for accepted notifications.

11. In addition, there is no process whereby States may challenge or seek revocation of a recognized notification, especially after the initial 12-month period provided for under paragraph (4) for a State to transmit its objections.

Prior existing trademark rights

12. The scope of recognition and protection available under Article 6ter needs to be reviewed with the view to clarifying how recognition should impact upon prior existing trademark rights. For example paragraph (6) limits the application of the provisions under Article 6ter to applying only to trade marks registered more than two months after receipt of the notification provided for in paragraph (3). In some jurisdictions, however, trademark rights are based on use (as noted in paragraph (1) and not on registration), yet paragraph (6) only addresses trademark registrations. It seems that paragraph (6) is an exception to the idea that registration is incumbent upon use.

13. The applicant for the registration of a trade mark appears to be unfairly disadvantaged where, for example, there is a delay in the processing of the application for registering the trade mark, or where a State takes the full 12 months to lodge an objection to a notification under paragraph (4) and an application for registration of a trade mark has been made in the interim.

Such delay can arise under a range of circumstances beyond the control of the applicant because of, for example, examination backlogs or *inter partes* proceedings. It is unclear what should happen with respect to rights to the trademark in such situations.

14. Furthermore, to accept the notification over another person's prior-existing trade mark could prejudice that person's trade mark rights and have the effect of undermining the integrity or diluting value of the trade mark. For example, take the situation where a registered trade mark unintentionally lapses or the trade mark owner filed a new application for registration of the trademark incorporating the original mark. A notification would appear to prevent both the restoration of such a trademark and a new registration incorporating the original trademark. Should the owner of prior existing trademark be required to give his or her consent to the recognition and protection of a notification?

15. Article 16.1 of TRIPS requires that the trade mark owner have the exclusive right to prevent confusion as to the same or similar signs for same or similar goods. Accepting a later notification over a pre-existing trademark would not appear to honor this right of the trade mark owner. Then there is the question of co-existence, which was addressed in the recent WTO ruling on GIs. Article 17 allows for limited exceptions to the rights bestowed in Article 16.1, but the trade mark owner's rights must be taken into account.

Nature of the mark being protected

16. Article 6*ter* does not provide a definition for the terms "armorial bearings", "State emblems", or "official signs" and this leads to uncertainty as to what types of notifications qualify for recognition. For example, what constitutes an armorial bearing, when is an emblem a "State emblem", what is a sign and under what circumstance would it be an official sign?

Service marks

17. It is not clear whether Article 6*ter* applies to official signs and hallmarks indicating control and warranty in relation to services. It is interesting to note that Article 16 of TRIPS addresses only Article 6*bis* of Paris regarding the application to services. This omission could be interpreted as meaning that Article 6*ter* was intended not to apply to services, only to goods. Some notifications do not appear give any indication as to what goods, if any, to which the notification is applicable. It could be assumed that some Article 6*ter* notifications are intended to apply to notifications in relation to services. The recognition given to these notifications under Article 6*ter* may not be valid.

Commercial trade marks

18. Some notifications appear to indicate that recognition is being sought for signs or indications that are more in the nature of a State's or IGO's trademark for the provision of commercial goods or services. Article 6ter does not limit notifications to non-commercial uses. Should some State organizations and IGOs be able to sidestep having to get national registrations for their commercial trade marks and signs, whilst private organizations and businesses competing against these organizations do not have that opportunity?

Marks and signs lacking in distinctive character

19. It is currently unclear whether measures are available to States to refuse to recognize an Article 6ter notification on the basis that the notification lacks distinctive character. This would appear to be important considering the extent of recognition accorded through Article 6ter. States are required to "refuse or invalidate the registration, and prohibit by appropriate measures the use, without authorization by the competent authorities, either as trade marks or elements of trade marks".

20. Yet notifications that are unlikely to qualify for protection as registered trademarks because of their inherent lack of distinctiveness are given significant benefits under Article 6ter. For example, notification 6166 is for the letter "L" as a sign for identification of authenticity for the lipicanec horse. Implementation of Article 6ter might necessitate that trademarks containing the letter "L" are no longer registrable as a result of that notification.

21. What should happen when, for example, an "official sign" in one State consisting of signs or indications that have become customary in the common language or in the *bona fide* and established practices of trade in another State? Furthermore, what should happen when a notification under paragraph (3) contains a sign or indication that is or could be considered to be scandalous, immoral or offensive to another State?

22. Also, it seems strange that official signs indicating quality control and warranty standards would need international recognition. It would seem that these sorts of standards are indicative of attempts to regulate certain industries on a national scale, rather than on an international scale. Why then is international recognition considered necessary?

Lack of information

23. Notifications under paragraph (3) often provide little in the way of information about the party requesting the recognition or how that party might be contacted, such as postal address. For example, notification 6929 does not identify the requesting party, let alone how to contact the party. How then is a State to determine if the notification from an unidentified party qualifies for Article 6ter recognition? How is a State or any other party to communicate with the requesting party if no contact address is provided?

24. As noted above, little information is provided about the nature and use of the notification. This is particularly noticeable with a lot of signs and hallmarks indicating control and warranty where no such information is provided nor is it apparent from the mark as to what goods (or services) the notifications are intended to be used on.

25. This lack of information can make the examination of a notification difficult to consider in relation to the scope of recognition or protection to give a notification. The nature of the goods upon which the notification is placed is something the Paris Convention contemplates under paragraph (2), yet the International Bureau's notification form does not require that information be included nor is this information forwarded to States.

26. This lack of information acts to undermines businesses in general, as how can trademark owners know whether their marks would infringe notifications where the goods are not listed? This could mean that trade mark owners would need to stay away from those notifications completely, thus giving Article 6ter notifications broader recognition and protection than originally anticipated.

27. Paragraph (4) say that States have 12 months to transmit objections, but as discussed above Article 6ter either does not provide any guidance as to the grounds for such objections or, where those grounds are provided, they are either poorly defined or the information available to States to examine a notification is not available.

Role of the International Bureau

28. Under paragraph (3) States are required to communicate reciprocally, through the intermediary of the International Bureau. Article 6ter, however, does not define the role of the International Bureau nor its duties and responsibilities as the intermediary. It is not clear therefore what role the International Bureau should be playing.

29. If the role of the International Bureau as the intermediary is to be reviewed, and possibly developed further, it would also be appropriate to also review the funding arrangements of the International Bureau for this role.

Proposal

30. New Zealand proposes that the WIPO Standing Committee on the Laws of Trademarks, Industrial Designs and Geographical Indications undertake a comprehensive review of regime under Article 6ter. The objectives of the review could include:

- simplifying the administrative procedures in order to reduce costs to States, IGOs and the International Bureau and to reduce compliance costs generally;
- clearly defining the information that must be contained in a notification to States under paragraph (3);
- clarifying the types of subject matter that may be eligible for 6ter recognition and the duration of that recognition;
- clarifying the grounds under which States could refuse to accept a notification under paragraph (4);

- clarifying the relationship between notifications under Article 6ter and prior existing trade mark rights; and
- defining the role of the International Bureau as the intermediary and ensuring that International Bureau is adequately funded to play the role of intermediary.

[Annex VII follows]

ANNEX VII

SUBMISSION BY THE DELEGATION OF NORWAY

Referring to item 9 in the summary by the chair of the fourteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), we would like to submit a proposal for future work.

The Norwegian Patent Office would like to propose that the SCT consider the feasibility of having a treaty for the design area. A design law treaty seems to be the next logical step, since we already have a Patent Law Treaty and a Trademark Law Treaty.

Such a treaty could contain provisions regulating formalities, the maximum requirements for what an application for design registration can contain, the possibilities of time limits, review of refusal and appeal procedures, etc.

We believe that such a treaty would be of great benefit for applicants, designers, trade circles, agents and national offices. Uniformed design legislation will help the design system to be user-friendlier, more efficient and cheaper.

Since we already have the TLT and the PLT, there must be many provisions we can use also for the design area, so that we do not have to start from scratch.

Even though this process might cost resources from WIPO and the SCT, we believe the benefits of harmonizing the design area will be so great that it will surely be worth the resources spent.

[Annex VIII follows]

ANNEX VIII

SUBMISSION BY THE DELEGATION OF THE RUSSIAN FEDERATION

PROPOSALS FOR THE FUTURE WORK OF THE SCT

Geographical Indications

1. To report on the results of work done by the Council of TRIPS of the WTO on the protection of Geographical Indications (GIs) under Article 23(4) TRIPS and item 18 of the Doha Declaration;
2. To put on the agenda the preparation of WIPO recommendations on the protection of GIs including the following issues:
 - (a) the definition of the subject matter of protection;
 - (b) approaches to a system of international registration and the essential features of the registration procedure;
 - (c) the ways of solving conflicts between trademarks and GIs.

Feasibility of Harmonizing Substantive Trademark Law

The discussion and stocktaking of the following issues taking into consideration the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks and the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet:

- (a) the protection of new trademarks;
- (b) substantive grounds for refusal;
- (c) the protection of well-known marks;
- (d) the protection of trademarks on the Internet.

[Annex IX follows]

ANNEX IX

SUBMISSION BY THE DELEGATION OF SLOVAKIA

At the last session of the SCT in Geneva, representatives of Member States were invited to make proposals of the topics for further meetings of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications.

On behalf of the Slovak Republic, we would like to suggest for discussion at the next meeting of the Committee the following areas:

- well-known marks
- geographical indications.

[Annex X follows]

ANNEX X

SUBMISSION BY THE DELEGATION OF SWITZERLAND

At the fourteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), Geneva, April 18 to 22, 2005, the International Bureau requested members of the Committee to transmit to it concise proposals on issues to be dealt with as future work of the SCT.

Within the deadline agreed by Member States, the Delegation of Switzerland transmits the following proposals to the International Bureau, in their order of priority:

I. RELATIONSHIP BETWEEN MARKS AND DESIGNS

During several sessions of the Standing Committee, the Delegation of Switzerland proposed that the SCT deal with the question of the relationship between industrial designs and three dimensional marks¹. Therefore, our delegation requests that this issue be included in the agenda of the fifteenth session of the Standing Committee, to initiate work on this question.

Document SCT/9/6 would constitute an appropriate basis for that work, and for further consideration by the Standing Committee. In the framework of the analysis of the relationship between industrial designs and three-dimensional marks, it should also be possible to use the vast amount of information contained in the Synthesis of the Replies to the Questionnaire on Trademark Law and Practice (SCT/11/6). This document, which resulted from the impressive work carried out by the International Bureau, will prove to be an essential source for future consideration by the Standing Committee, taking into account the remarkable success that it has met with (75 Member States and International Organizations replied to the questionnaire). Our delegation is therefore interested in examining the results of this exercise in further detail.

II. NEW TYPES OF MARKS

As it proposed at the seventh session of the Standing Committee², the Delegation of Switzerland suggests that the SCT discuss the issue of new types of marks (movement, olfactory marks, etc.) with the objective of harmonizing, both the criteria and the modalities for registration of these types of marks.

III. INTERNET DOMAIN NAMES AND GEOGRAPHICAL INDICATIONS

The Delegation of Switzerland recalls that, at the thirteenth session of the Committee³, Member States agreed to maintain, in the mid-term agenda of the Standing Committee, the question of Internet Domain Names and Geographical Indications.

[Annex XI follows]

¹ Notably: documents SCT/8/7 N 428 (p.63), SCT/13/8 N 322 (p. 43)
² See document SCT/7/4 N 87 (p.17)
³ See document SCT/13/7, pt. 6

ANNEX XI

SUBMISSION BY THE DELEGATION OF THE FORMER
YUGOSLAV REPUBLIC OF MACEDONIA

I. OFFICIAL NATIONAL REGISTER OF WELL KNOWN TRADEMARKS

The Joint Recommendation Concerning Provisions on the Protection of Well-known Marks, adopted by the Assembly of the Paris Union and by the General Assembly of the World Intellectual Property Organization, in September 1999, provides a non-exhaustive list of criteria for a mark to be well-known. This list as a guideline is very useful for national authorities, in particular, for courts, in their evaluation whether a mark is well-known. However, at the same time the Joint Recommendation does not mention the establishment of special registers for well-known marks.

In order to provide a formal reference tool for the application processes and to assist courts in infringement cases, national industrial property offices have established registers for well-known marks in many countries. Establishment of a special register for well known marks has certainly advantages, especially in the area of enforcement of well-known marks. However, introduction of a special register for well-known marks in each country raises a number of difficult open questions that have to be discussed.

II. COLLECTIVE MARKS / CERTIFICATION MARKS

Article 2(2)(b) of the Draft Revised Trademark Law Treaty (TLT) provides, that the Treaty shall not apply to collective marks, certification marks and guarantee marks. Therefore the Contracting Parties are not bound to apply the Draft Revised TLT to such marks. The reasons for the exclusion of those marks are, that, on the one hand, the registration of those marks often requires a fulfillment of special conditions in different countries, and, on the other hand, the number of such marks, in comparison with the total number of marks, is much lower. However, according to the Summary of Replies to the Questionnaire on Trademark Law and Practice (document SCT/14/5 Rev.), the number of countries that provide in their national laws protection of certification marks and collective marks is quite solid (see Part II. 5. D. and E. "REGISTRABLE SIGNS", "Special types of marks", "Collective marks" and "Certification marks"). Therefore it appears to be necessary, that the SCT devote some time in the future for discussions on this area in spite of the fact, that the harmonization of provisions concerning certification marks and collective marks is difficult due to a great variety of legislations concerning such marks.

III. GEOGRAPHICAL INDICATIONS

The protection of geographical indications is an undefined area. There are big differences between the national legislations concerning the protection of geographical indications worldwide. The present situation makes the protection of geographical indications at the international level impossible. Documents SCT/9/4 "The Definition of Geographical Indications" and SCT/9/5, "Geographical Indications and the Territoriality Principle" deal with this issue.

At the same time the protection of geographical indications at the national level is not addressed. Therefore, more attention should be devoted to harmonization of national legislations.

IV. THREE-DIMENSIONAL TRADEMARKS / DESIGNS

Document SCT/9/6 “Industrial Designs and their Relation with Works of Applied Art and Three-Dimensional Marks” was briefly discussed in the ninth session of the SCT. This topic may be the subject of further discussions.

[Annex XII follows]

ANNEX XII

SUBMISSION BY THE DELEGATION OF THE UNITED KINGDOM

Review of Procedures Relating to Article 6ter of the Paris Convention

At the fourteenth session of the SCT, the International Bureau invited members and observers to submit in writing concise proposals for future work of the SCT. In this context, the United Kingdom would like to make the following comments:

At the tenth Session of the SCT, the United Kingdom Delegation requested the SCT to consider “current procedures as set out in Article 6ter the Paris Convention for the Protection of Industrial Property, including application, guidelines for interpretation, possibility of addition of a specific guideline on withdrawal or deletion procedure, and provision of an online database”. Since then, the online database has been made available but other issues concerning Article 6ter have not yet been addressed.

The United Kingdom continues to believe that there would be a great benefit to reviewing the processes and procedures relating to Article 6ter. In particular, it would be of benefit to consider the administrative procedures and certain issues affecting scope of protection in terms of how consistent such procedures are with the provisions set out in the Article.

Administrative Procedures

The “Guidelines for the Interpretation of Article 6ter, paragraphs 1(b) and 3(b) of the Convention for the Protection of Industrial Property” does not cover administrative procedures and as such consideration should be given to:

1. the process for deleting redundant signs from the database to avoid the current situation where the database is cluttered by many unused signs;
2. reviewing the notification process, in particular with a view to modernise the mode of communication used to remove the need for 600 copies of the sign to be forwarded to the International Bureau as part of a notification and to speed up the process.

Scope of Protection

The following deficiencies in procedures have possible implications regarding the scope of protection afforded by Article 6ter:

1. The current procedures fail to provide a mechanism for revoking protection if it later transpires that the sign was not what was claimed by the state/IGO seeking protection. For example, where evidence is available to demonstrate that a given sign does not qualify for protection under any of the categories specified in the Article. It is important to ensure that signs notified are appropriate and consistent with the provisions of Article 6ter;

2. Article 6*ter*, paragraph 2 states that “prohibition of the use of official signs and hallmarks indicating control and warranty shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or a similar kind.” However, there is no mechanism for recording which goods a sign is protected for;
3. No process exists for assessing if the party requesting protection is entitled to protection. The preferred process is for the State putting forward a proposal to ensure that the sign put forward does fall within one of the category of signs which may be protected under Article 6*ter*. Such a procedure could be made explicit.

As a first step, we would ask the International Bureau to conduct a review of provisions governing the Article 6*ter* regime and to make recommendations on how these provisions could be modernised and improved.

[Annex XIII follows]

ANNEX XIII

SUBMISSION BY THE DELEGATION OF THE UNITED STATES OF AMERICA

United States Proposal for Future Work Agenda Items for the WIPO Standing Committee on Trademarks, Industrial Designs and Geographical Indications:

1. Geographical Indications
2. Well-Known Marks, specifically Well-Known Mark Registries
3. Paris Convention Article *6ter*

[Annex XIV follows]

ANNEX XIV

SUBMISSION BY THE REPRESENTATIVE OF
THE EUROPEAN COMMUNITY

In the latest WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (April 18 to 22, 2005) the Chair invited Members and observers of the Committee 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.

As a general comment we would like to note that the criteria to decide on proposals for future work in the SCT should be to make progress on technical matters that could be clearly useful for IP right holders.

You can find here enclosed some suggestions:

1. To explore and clarify the boundaries between designs and three-dimensional trademarks;
2. “Non-traditional” trade marks.

On geographical indications the priority remains the inclusion of geographical indications in the WIPO arbitration system for trade marks and domain names. This point is already in the agenda of the SCT.

[Annex XV follows]

ANNEX XV

SUBMISSION BY THE REPRESENTATIVE OF AIM

Further to your invitation to NGOs during the 14th session of the SCT to provide written input on subjects for discussion at forthcoming sessions, on behalf of AIM, the European Brands Association, may I please put forward the following suggestions for your kind consideration:

- AIM and its members are increasingly concerned about the proliferation of registers of Well-Known Marks (see the position paper which was distributed to participants during the 14th session). We believe that this merits further debate. We also request the International Bureau to conduct a survey on adherence to the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, including specific questions on Registers of Well Known Marks.
- The harmonization of substantive trade mark law issues should remain on the agenda, such as the potential for legislation to deal with parasitic copies/look-alikes (e.g. the recently adopted EC Directive on Unfair Commercial Practices).
- Issues relating to Internet domain names v. trade marks (trade names, etc.) remain of concern (see Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet).
- The potential for harmonization of certain geographical indications provisions.

[Annex XVI follows]

ANNEX XVI

SUBMISSION BY THE REPRESENTATIVE OF FICPI

At the 14th Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) in Geneva, April 18-22, 2005, delegations and observers were requested to make concise proposals for future work of the SCT after completion of the revision of the Trademark Law Treaty (TLT). These written suggestions are to be submitted by July 1, 2005.

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the profession in private practice, proposes the following priority topics:

Trademarks

We suggest that the SCT should study harmonization of opposition proceedings with a view to adopting at least a Joint Recommendation that all WIPO Member States should have a system of opposition at their Trademark Office. The opposition proceedings could take place before registration or during a short period after registration. A minimum list of grounds of opposition should be harmonized, including at least basic grounds of refusal based on prior registered marks and well-known marks.

Other areas of possible harmonization within Opposition Procedures include timeframes for various portions of the process as well as possible extensions of those time periods, particularly to allow settlement. Should harmonization of these more formal aspects of Opposition prove possible, it may be useful to consider evidentiary and other more substantive issues.

Designs

At the FICPI 6th Open Forum in Rome, 14-17 November 2001, we held a Design Symposium which served first of all to provide a comparative law analysis of the current systems for protecting Industrial Designs around the world, and secondly to determine some basis for advancing the cause of harmonization of design laws. We have previously provided the International Bureau of WIPO with our recommendations drawn up after that Symposium. In accordance with those recommendations, we suggest that the SCT should study the following areas for harmonization:

1. Number of views in the representations of the design.
2. Scope of protection (same product/same class of products/any product?).
3. Statement of novelty of the design.
4. Definition of prior art for assessment of novelty (local/regional/universal?).
5. Novelty grace period for publications by the applicant.
6. Examination (substantive/formal only?).
7. Term of protection (15/25 years?).

We look forward to participating in discussion of these proposals at the 15th session of the SCT.

[End of Annex XVI and of document]