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

**Twentieth Session
Geneva, December 1 to 5, 2008**

REPORT*

adopted by the Standing Committee

* This report was adopted at the twenty-first session of the SCT.

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”) held its twentieth session, in Geneva, from December 1 to 5, 2008.
2. The following Member States of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Algeria, Argentina, Armenia, Australia, Austria, Belarus, Brazil, Cambodia, Canada, Chile, China, Colombia, Costa Rica, Côte d’Ivoire, Czech Republic, Cuba, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, Finland, France, Germany, Greece, Guatemala, Holy See, Hungary, Iran (Islamic Republic of), Italy, Jamaica, Japan, Latvia, Libyan Arab Jamahiriya, Lithuania, Mexico, Montenegro, Morocco, Netherlands, Norway, Oman, Pakistan, Poland, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Sao Tome and Principe, Saudi Arabia, Serbia, Singapore, South Africa, Spain, Sudan, Sweden, Switzerland, Thailand, The Former Yugoslav Republic of Macedonia, Trinidad and Tobago, Tunisia, Turkey, Ukraine, United Arab Emirates, United Kingdom, United Republic of Tanzania, United States of America, Uruguay, Uzbekistan, Viet Nam (71). The European Community was represented in its capacity as member of the SCT.
3. The following intergovernmental organizations took part in the meeting in an observer capacity: African Intellectual Property Organization (OAPI), Benelux Organization for Intellectual Property (BOIP) and the World Trade Organization (WTO) (3).
4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), Inter-American Association of Industrial Property (ASIPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA) and Japan Trademark Association (JTA) (9).
5. The list of participants is contained in Annex II of this Report.
6. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions on the basis of all observations made.

Agenda Item 1: Opening of the Session

7. Mr. Francis Gurry, Director General, opened the session and welcomed the participants.
8. Mr. Marcus Höpferger (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 2: Adoption of the Agenda

9. The SCT adopted the Draft Agenda (document SCT/20/1) without modifications.

Agenda Item 3: Adoption of the Draft Report of the Nineteenth Session

10. The SCT adopted the Draft Report of the nineteenth session (document SCT/19/9 Prov.) with modifications as requested by the Delegations of Canada, the Russian Federation, Spain, the United States of America and the Representative of the International Trademark Association (INTA).

Agenda Item 4: Industrial Designs

11. The discussion was based on documents WIPO/Strad/INF/2 Rev.1 and SCT/19/6.
12. The Delegation of Spain, referring to paragraph 20 of document SCT/19/6, pointed out that the Spanish version should use the term “solicitudes múltiples”.

The Application

Contents of the Application

The Reproductions

13. The Delegation of Norway considered that the questionnaire provided an overview of the current systems and procedures and constituted a basis for any future work aiming at convergence in the field of industrial designs. It recalled that Norway had opted for a restrictive approach concerning the acceptance of moving images or still pictures representing a moving image or a movie. The reason was that they were considered as graphical representations of several designs and not of the same design. The Delegation expressed its interest in learning from the practice of other Member States.
14. The Delegation of Japan expressed the view that a limitation of the number of views would not be appropriate, insofar as applicants were required to disclose the overall appearance and features of the design claimed, for which more than seven views might be needed.
15. The Delegation of the Republic of Korea stated that national legislation required a perspective view of each design, in order to enable examiners to compare similar designs. Views such as sectional or detailed views, though allowed, were not required.

16. The Delegation of the United States of America, while not supporting a restriction of the number of views, pointed out that it was unnecessary and that it could even be confusing to include views that did not show any ornamentation or feature of the claimed design.
17. The Delegation of Italy declared that Italian legislation required a graphic reproduction of the design or, where the design was two-dimensional, a sample.
18. The Delegation of Germany indicated that the limit of permitted views had been recently changed from seven to 10.
19. The Delegation of Singapore said that, for practical reasons, a maximum of 10 views was allowed.
20. The Representative of FICPI recalled the key issues listed by the FICPI designs working group, in particular the need for applicants to file a single set of representations. The Representative expressed the wish that the SCT would reach convergence on an acceptable standard for representations, including issues such as the maximum number of views, the required views, the acceptability of dotted lines for parts not claimed, shading and the use of colors.
21. The Delegation of Uruguay stated that the number of views depended on the nature of the claimed design.
22. The Delegation of France indicated that under its national law an application could contain an overall of 100 reproductions.
23. The Delegation of Egypt indicated that national legislation allowed a maximum of 50 representations on condition that they belonged to the same class of products.
24. The Delegation of El Salvador said that two views were required but that applicants could submit more.
25. The Delegation of Italy stated that, although there was no limit to the number of views, applicants usually filed one view for two-dimensional designs and not more than three or four views for three-dimensional designs.
26. The Representative of the European Community declared that, under the registered Community Design system, a maximum of seven views was allowed.
27. In reply to a question from the Representative of the European Community, the Delegation of Germany indicated that the maximum number of views allowed had been changed from seven to 10, on November 1, 2008, upon request of some applicants who argued that more views were needed to clearly show certain designs, such as those of complex products with movable parts.
28. The Delegation of the Republic of Korea explained that seven views, including a perspective view, were required for three-dimensional designs. Regarding two-dimensional designs, only two views (front and rear) were required, and only one where the front and rear sides of the design were identical.

29. The Delegation of Spain said that a maximum of seven views was allowed, and that this number was satisfactory for users.
30. In reply to a question by the Chair concerning the required number of views, the Delegation of Brazil stated that, while no specific number of views was required, the number had to be sufficient to clearly show the claimed design. It further added that applicants generally filed between three and six views.
31. The Delegation of Japan explained that the only requirement for applicants was to disclose the overall appearance of the design. To meet that requirement, applicants were free to determine the number of views needed and whether or not sectional views had to be filed.
32. The Delegation of South Africa said that seven views were required.
33. The Delegation of the United States of America indicated that the drawings had to contain a sufficient number of views to disclose the complete appearance of the design claimed. The Delegation further specified that perspective views could be submitted to clearly show the appearance of three-dimensional designs. Where a perspective view was submitted, it would not be required to illustrate with further views the surfaces shown, if the surfaces were clearly understood and fully disclosed in the perspective. Views that were merely duplicative of other views, or that were flat and included no surface ornamentation could be omitted from the drawing, if a statement made it explicitly clear. Finally, the Delegation stated that sectional views presented solely for the purpose of showing the internal construction or functional mechanical features were unnecessary and could lead to confusion as to the scope of the claimed design.
34. The Representative of BOIP said that there was no minimum number of views required and that applicants were free to provide the number which they considered appropriate. In practice, an average of three views was filed.
35. The Delegation of Latvia considered that it was important not to limit the number of views where there was a requirement to disclose fully and clearly the features of the design and the scope of protection of the design depended on the published views. The Delegation indicated that, in practice, the number of views depended on the complexity of the design, and that the maximum number received so far in Latvia was 15 views.
36. The Delegation of Chile said that the drawings should at least show six views and the perspective of the product. Depending on the complexity of the item, more views could be filed, without any limit as to the maximum.
37. The Chair, noting that a number of jurisdictions required perspective or sectional views, wondered whether there were jurisdictions which would not accept a perspective or sectional view if presented to them.
38. The Delegation of the United States of America indicated that a sectional view would be accepted if it clarified the shape of the claimed design. The Delegation further specified that a sectional view would not be rejected if it was merely duplicative of another view, but would be rejected if it added new matter that was not claimed in the design.

39. The Representative of the European Community, recalling that a maximum of seven views was allowed for a registered community design, indicated that where more than seven views were filed, the Office for Harmonization in the Internal Market (OHIM) would not refuse the application, but would only take the first seven views into account.
40. The Chair wondered whether problems could arise from the numbering or order in which the views were presented.
41. The Representative of FICPI pointed out that the issue under consideration concerned the basis for the enforcement of the design. He wondered whether any extra views not taken into account by an Office would nevertheless be part of the record of the design as registered, to be presented before the courts in case of enforcement. For instance, in the case of designs where a part of the product could move, several perspective views, possibly more than seven, would be relevant and crucial in determining infringement.
42. The Delegation of Latvia said that sectional views generally showed the inner construction of the product and would not be necessary when the claim referred to the outside appearance of the product.
43. The Delegation of the Republic of Moldova, considering that it was very difficult to set a maximum number of views, explained that, in general, only the first views filed were registered.
44. Referring to paragraph 7 of document SCT/19/6, the Chair asked whether there was any jurisdiction in which either drawings or photographs were not allowed as a form of representation.
45. The Delegation of the United States of America explained that the USPTO required the submission of drawings in black ink on white paper and that photographs were acceptable only when the invention could not be clearly illustrated by an ink drawing.
46. The Representative of FICPI pointed out that, in the past, the use of photographs was complicated, in particular when applying in several countries, but that in the future, digital reproduction would probably shift the balance towards photographs.
47. The Delegation of South Africa said that, when submitting a photograph, a very clear description of the claimed protection was required.
48. The Delegation of Japan, referring to paragraph 8 of document SCT/19/6, expressed the view that representations should not be excluded for the reason that they were made by a given technology. The Delegation said that computer-generated representations were accepted in Japan, provided that they fully disclosed the design.
49. The Delegation of the United States of America said that the USPTO accepted computer-aided design (CAD) drawings, as they allowed non draftspersons to produce accurate drawings at low cost, and expressed an interest over the reasons why some offices might refuse such drawings.
50. The Representative of the European Community said that any drawing meeting the requirements set out in the rules with respect to paper or electronic reproductions would be accepted by OHIM, irrespective of the technology used to reproduce it.

51. The Delegation of the Republic of Korea said that the national Office accepted both black and white and color photographs, as well as computer-generated representations. However, experience showed that few applications included color photographs or CAD representations.
52. The Delegation of Uruguay said that, since no application containing a CAD representation had been so far received by the national Office, it would not be in a position to state whether or not such representations would be accepted by the national Office.
53. The Chair noted that the results of the survey indicated that in seven percent of the respondents to the questionnaire CAD drawings would be acceptable, but that no conclusion could be drawn as regards the acceptability of such drawings by the remaining 93 percent of the respondents.
54. The Representative of INTA, observing that there was no direct question in the questionnaire as regards the acceptability of CAD drawings, said that under the Geneva Act of the Hague Agreement and the Common Regulations under the three Acts of that Agreement, the only filing date requirement was that there be an adequate representation of the industrial design, with no restriction over the type of representation or the number of views.
55. The Chair noted that the discussion had revealed that offices require an adequate representation, which is open to interpretation, and that jurisdictions should develop general criteria concerning the acceptability of representations.
56. Reacting to a question by the Delegation of Costa Rica regarding an apparent discrepancy between the replies on technical drawings and CAD drawings, the Delegations of the United Kingdom and the United States of America, and the Representative of BOIP explained that their negative reply to the question on the acceptability of technical drawings was based in the understanding that those were drawings showing dimensions, angles or symbols for the materials used.
57. The Delegation of Germany said that technical drawings were accepted in Germany only when they were annexed to photographs.
58. With respect to the required number of copies of the representations, the Delegation of Germany declared that, since November 1, 2008, only one copy was required.
59. The Delegation of Brazil said that three copies were required, two of which were used for publication purposes.
60. The Delegation of Latvia pointed out that, while two copies were requested in order to facilitate the work of the office at the time of scanning, one copy was enough to secure a filing date.
61. The Delegation of Morocco said that three copies were required in Morocco to obtain a filing date.
62. The Delegation of the Republic of Moldova said that, while two copies were required, one was enough to secure a filing date. The Delegation also noted that technical drawings were accepted in Moldova.

63. The Delegation of Belarus said that broken lines were not accepted in Belarus and that an application containing a representation with those lines would have to be filed again.
64. The Delegation of Uzbekistan said that drawings were preferred to photographs in its country, particularly in respect of certain designs, such as those for clothing. The Delegation also stated that dotted lines were accepted by the national office. As to the reason why several copies of the representation had to be submitted, the Delegation explained that some of the copies were used by the examiners to compare the scanned image with a paper representation.
65. The Delegation of Brazil said that broken lines were accepted in Brazil when they were used to show where the design would be applied.
66. The Delegation of the United States of America said that in its country broken lines were understood to serve illustrative purposes only and formed no part of the claimed design. Structures which were not part of the claimed design, but were considered necessary to show the environment in which the design was used could be represented by broken lines. When the claim was directed to just surface ornamentation for an article, the article in which it was embodied had to be shown in broken lines.
67. The Delegation of Uruguay indicated that broken lines were accepted, insofar only as they were not part of the claimed design.
68. The Delegation of Germany, observing that the national office would not raise the issue of whether or not the dotted lines contained in a reproduction reflected in an appropriate manner the scope of the claimed design, pointed out that the said scope would only be determined by a court in the course of a law suit.
69. The Delegation of Sweden explained that in its country shading could be used to represent matter which was not part of the design, provided that it was clear in the representation which part was not covered by the claim.
70. The Delegation of the United States of America said that, while surface shading was not required, it could be necessary in certain cases to show clearly the character and contour of all surfaces of a three-dimensional design and to distinguish between any open and solid areas of the article. Lack of appropriate surface shading in the drawing could render the design indefinite. Moreover, if the surface shape was not evidenced from the disclosure, the addition of surface shading after filing might comprise new matter.
71. The Chair, noting that the use of surface shading was very different in Sweden and in the United States of America, said that this area warranted further exploration by the SCT, with a view to promoting consistency of outcomes across jurisdictions.
72. The Delegation of Uzbekistan said that in its country shading was used in order to more clearly show the volume, color and shadow of the design.
73. The Delegation of Norway observed that the national office restrictively accepted a moving image or several still pictures of a moving image as a reproduction of a design, as it viewed the different still pictures as graphic representations of several designs. The Delegation inquired about the practice of other Members.

74. The Delegation of the United States of America said that, according to the practice of the USPTO, simple movement could be indicated on a single view with arrows showing the direction of the movement. With respect to complex movement, there would be two or more views showing the different moves in the design. The images would be understood as viewed sequentially, and no ornamental aspect would be attributed to the process in which one image changed into another. A descriptive statement would have to be included in the specification describing the transitional nature of the design.

75. The Delegation of Australia stated that the situation in Australia was similar to that in the United States of America.

76. The Delegation of Uzbekistan said that, while moving objects were usually represented through a sequence of static images, objects with variable form were currently excluded from design protection, as not being capable of representation. However, it could not be discarded that new technologies would in the future enable the representation of such designs.

77. The Delegation of Latvia, considering that it was difficult to protect a moving or changing object through a design right, expressed the view that there might be other mechanisms which were better suited to the protection of those objects.

Other Contents of the Application Generally Required

78. The Delegation of Japan declared that in its country an indication of the product constituting the industrial design or in relation to which the industrial design was to be used was a filing date requirement. The Delegation explained that in Japan a design right was granted in respect of a specific article, and that the scope of the registered design was determined on the basis of the indication of the product mentioned in the application and on the representation or specimen submitted.

79. The Delegation of Australia said that the design right in its country was expressly limited to products in relation to which the design was registered.

80. The Delegation of El Salvador explained that, where the indication of the product was missing in an application, the filing date would be maintained if the indication was submitted within a period of two months.

81. The Delegation of Uruguay said that the link between the design and the product was a fundamental element in its legislation.

82. The Delegations of the Republic of Korea and Singapore said that the indication of the product was an essential element in a design application, necessary to secure a filing date.

83. The Representative of FICPI observed that a number of comments from delegations suggested that the indication of the product determined the scope of protection of the industrial design. He indicated that in the European Community, the scope of protection was not limited to the product. The applicable test was to ask whether the design produced, on the informed user, an overall impression that was different from any other design. In connection with this, the Representative drew attention to a question included in the list of issues drawn by FICPI, namely whether the class of goods in which the design was registered was limiting.

84. The Delegations of France and Morocco said that the indications concerning the identity of the creator were optional in their respective countries.

85. The Delegation of the United States of America said that in its country, the applicant had to be the creator of the design and submit an oath stating that fact. However, that oath was not a filing date requirement and could be submitted after the application had been filed.

Additional Contents Required in Certain Jurisdictions

86. The Delegation of El Salvador stated that it was compulsory to indicate the name of the creator in the application, even if the applicant was a legal entity.

87. The Delegation of the United States of America indicated that, while a description was an optional element of an application, a claim was required in order to obtain a filing date. The Delegation also explained that the question of whether or not the creator was the owner of the design was determined by the contract between employer and creator.

88. The Delegation of Sweden said that a legal entity could file a design application, but would need to show that the right to the design had been transferred to it by the creator.

89. The Delegations of Uzbekistan and Ukraine explained that the applicant could be a physical or a legal person, and that the indication of the name of the creator was optional.

90. The Delegation of Norway said that, where the applicant was not the creator, the latter would have to be indicated in the application. However, such indication was not a filing date requirement.

91. The Delegation of Serbia said that, while the creator had a moral right to be named in the application, the applicant could be either the creator himself or anyone deriving the right from the creator.

92. The Delegation of Egypt indicated that a description of the design was mandatory and subject to revision by the examiner.

93. The Delegation of Italy said that a description of the design was not mandatory, but could be required by the office in order to understand the design.

94. The Delegations of Spain and Algeria indicated that their respective legislations did not require a description of the design, which was merely optional.

95. The Delegation of Guatemala stated that the national legislation required a description.

96. The Delegation of the Russian Federation explained that the national legislation required a description of the design and a list of its characteristic features, but that it was envisaged that the said list and description would become optional in the future. The Delegation expressed its interest in the experience of other delegations relating to the purpose of the description, its publication and its use in litigation.

97. The Delegation of Uruguay indicated that, although not required, a description was often provided in practice, and could in some cases be used to define the scope of the claim, particularly where the graphic representation was not sufficiently clear.

98. The Delegation of Brazil said that a description was optional, except where different variations of the same article were filed.

99. The Delegation of the United States of America explained that the Office only required an indication of the views presented (front, back, side, and perspective view), and that the description of the drawing was optional. The Delegation indicated that only one percent of applications contained a characteristic feature description, as such descriptions could result in a limitation of the scope of the claim and of the right acquired.

100. The Delegation of Singapore said that applicants had to make a statement of novelty describing the features of the design considered as new, which served to define the scope of the rights. The statement was essential to secure a filing date, except in the case of textile articles, lace, wallpaper and similar wall coverings. The Delegation also observed that applicants were encouraged to disclaim generic elements.

101. The Delegation of Australia said that a statement of novelty and distinctiveness was optional, but had to be considered in the examination if submitted. The said statement could either narrow down or broaden the scope of the design.

102. The Representative of the European Community, indicating that the description was optional, explained that it could not exceed one hundred words, could not contain statements of novelty, individual character or technical value, and was limited to the features appearing in the reproduction. The Representative added that the description was not published and had no impact on the scope of protection of the design.

103. The Delegation of Uzbekistan said that a description was mandatory and had to indicate the use and basic attributes of the object.

104. The Delegation of Ecuador said that a full description was mandatory in order to avoid any misinterpretation of the design by examiners.

105. The Representative of FICPI raised the issue of consistency in interpretation of designs, which was related to statements of novelty and claims. The Representative pointed out that a description could range from a mere depiction of what was shown in the figures to a statement of novelty, in which the applicant had to pick out the features that were novel. The latter was an effective form of claim, though it was not identified as such. The Representative was of the opinion that applicants could live with different requirements, provided that they could know what was actually required by each jurisdiction. In this regard, the Hague system was of great assistance as it provided for members to indicate, by means of declarations, the requirements in their jurisdiction. However, as regards the interpretation of designs, the Representative expressed the wish that the SCT reach some convergence.

106. Replying to a question by the Chair as to the contents of a required claim, the Delegation of the United States of America indicated that the USPTO required a single claim, which would generally read “the ornamental design for [the article of manufacture which embodies the design or to which it is applied] as shown and described”. In addition, the Office required a description which was merely an explanation of the different views shown in the drawing and would permit descriptions indicating that there were broken lines in the drawing or disclaiming particular parts of the drawing. Moreover, the applicant would be allowed to submit a description of the characteristic features, which may be used to determine patentability, and could also be used to limit the claim in infringement actions.

107. The Delegation of Uruguay said that, as a design was considered to be a patent, a claim was required.

Specimens

108. The Delegation of Italy said that samples could be filed instead of graphic representations with respect to two-dimensional designs, with the exclusion of handicraft products.

109. The Delegation of Guatemala indicated that samples of two-dimensional products could substitute a graphic representation.

110. The Delegation of Japan said that applicants could submit specimens limited in size, instead of a paper reproduction. Where a specimen was filed, the office assumed its reproduction for the purpose of publication. However, the scope of protection remained determined by the specimen itself.

111. The Delegation of Sweden explained that the submission of specimens was optional, on the condition that they were made of sustainable material and were limited in weight (4 kg) and size (40 cm). The Delegation indicated that the Office received about one specimen per week, which represented almost 10 percent of all applications filed, and that specimens were destroyed five years after the end of the term of protection. It added that a specimen would determine the scope of protection of the design.

112. The Delegation of Iran (Islamic Republic of) said that the Office could request a sample of three-dimensional products.

113. The Delegation of Germany, observing that specimens could be submitted instead of the drawings in case of deferment of publication only, pointed out that the drawings would be required at the time of publication. The Delegation further indicated that specimens were submitted in 15.5 percent of the applications.

114. The Delegation of Morocco said that specimens were generally not allowed.

115. The Delegation of the Republic of Korea stated that, although applicants could file specimens instead of drawings for two- and three-dimensional designs, this possibility was rarely used.

116. The Representative of the European Community, indicating that specimens were allowed for two-dimensional designs in the case of deferred publication, explained that they had to be presented on an A4 sheet of paper, not be thicker than three millimeters and weigh less than 30 grams. The Delegation indicated that a reproduction of the design was required for publication purposes, and that the possibility of filing specimens was rarely used.

117. The Delegation of Australia, indicating that specimens were allowed but very rarely filed, expressed its interest in the experience of other members which received them. The Delegation also said that specimens had to be presented on a sheet of paper and be able to be reproduced, photocopied or scanned.

118. The Delegation of Singapore said that specimens were not allowed, unless requested by the Registrar.

119. The Delegation of Uzbekistan explained that the Office could request a sample, for example of pieces of clothing or patterns, when the graphic representations were not precise enough.

120. The Delegation of the Russian Federation said that, although the submission of specimens was not set out in the law, the Office accepted them for two-dimensional designs and scanned them for electronic publication.

121. The Delegation of Egypt said that the national law did not include any provision concerning specimens, which were however submitted in very rare cases. It further explained that whenever a specimen was presented during an opposition procedure, the Office could request another specimen to carry out a comparison.

122. The Delegation of Guatemala said that the possibility of submitting specimens was not commonly used.

123. The Delegation of Pakistan stated that the submission of specimens was optional for two-or three-dimensional designs, to supplement the graphic representation.

124. The Delegation of El Salvador said that specimens were permitted but had to be presented on paper.

125. The Delegation of the United States of America stated that specimens were generally not permitted, but could be requested by the examiner in certain cases or be submitted by the applicant upon petition, which did not generally happen. The Delegation indicated that specimens had to be accompanied by photographs and that, where they did not correspond to the drawing, the specimens prevailed.

126. The Delegation of Chile, indicating that photographs were allowed in addition to drawings, pointed out that specimens or scale models were allowed upon request by the Office.

127. The Representative of FICPI wondered what form of priority document was issued by offices in which the first filing had been accompanied only by a specimen.

128. The Representative of INTA, recalling that the textile industry had often favored the possibility of using specimens in connection with deferment of publication, expressed the view that the current needs of that industry in respect of the use of specimens should be assessed prior to reaching any conclusion over the issue.

129. The Delegation of France indicated that, although specimens were generally not allowed, the Office accepted samples of tissues or fabrics not thicker than three millimetres.

130. In reply to a question by the Chair as regards the documents requested when priority was claimed, the Delegation of Egypt indicated that the Egyptian Office requested a certificate from the office where the first application was made and the date of filing of that application.

131. The Delegation of Italy said that, when priority was claimed from an application in respect of which a specimen had been filed, the applicant had to provide a copy of the first application, as well as the same specimen.

132. The Delegation of the United States of America explained that, when claiming priority, applicants had to indicate the foreign application number and date, the country in which the application was filed and, where applicable, the treaty under which priority was claimed. The applicant would eventually have to submit a certified copy and an English translation of the application.

133. The Delegation of Australia said that, while applicants had to indicate the date and number of the basic application, as well as the name of the country where that application was made, a copy thereof would only be required at the time of examination.

134. The Delegation of Guatemala stated that applicants had to submit a certified copy of the application from which priority was claimed, as well as a Spanish translation thereof.

135. The Representative of the European Community indicated that, when claiming priority, applicants had to supply the file number of the previous application and file a copy of that application within three months.

136. The Delegation of the Republic of Korea said that applicants had to file a written statement certified by the office where the earlier application had been filed, a certified copy of the drawing of the design, as well as a translation, if applicable, within three months of the filing date.

137. The Delegation of Uruguay said that applicants had to provide within 180 days, a certified copy of the application from which priority was claimed and a Spanish translation thereof.

138. The Delegation of Spain stated that applicants had to indicate the number of the application from which priority was claimed, the country and the date of priority, as well as provide a certified copy and a Spanish translation thereof within three months.

139. The Delegation of the United Kingdom said that applicants wishing to claim priority had to indicate the date of the prior application and the name of the country where it had been filed. A certified copy of the representation of the design and a translation would also have to be filed within three months.

140. The Delegation of Norway explained that applicants wishing to claim priority had to make a statement to that effect in the application and indicate the name of the country where the first application was filed, as well as its date and number. Specifying that priority documents did not have to be submitted unless required by the Office, the Delegation added that priority could not be claimed at a later stage.

141. The Delegation of Pakistan said that, when claiming priority, applicants had to submit a certified copy or proof of the first filing, as well as an English translation.

142. The Delegation of Singapore said that, while an applicant claiming priority had to indicate in the application the date of the prior filing and the name of the country where that filing had been made, he did not have to submit a copy of the priority document, unless required by the Registrar.

143. The Chair, noting that there was a fair number of jurisdictions which required priority documents, considered that it would be useful if the Secretariat enquired about the state of the project to share priority documents in the field of patents, with a view to assessing whether it was worth proposing a similar project in the field of designs.

Filing Date Requirements

144. The Delegations of El Salvador and Guatemala indicated that, in addition to the elements mentioned in paragraphs 18 and 19 of document SCT/19/2, the signature and seal of a legal representative were required to obtain a filing date.

145. The Delegation of Morocco said that, in addition to the elements mentioned in paragraphs 18 and 19 of document SCT/19/2, the signature of the applicant or his representative was required to obtain a filing date.

146. The Delegation of Brazil said that, provided that an application contained sufficient particulars concerning the applicant, the industrial design and the author of the design, other required elements could be submitted within a period of five days from the date of a letter issued by the Office, without the filing date being affected.

147. The Representative of the European Community stated that there were three filing date requirements, namely a request for registration, information identifying the applicant and a representation of the design or, in certain cases, a specimen.

148. The Delegation of Egypt said that the following elements were required in order to secure a filing date: a registration form, indications concerning the identity of the applicant, four representations of the design, proof that the applicant had created the design, a power of attorney of a representative, where applicable, and a certified translation of any document not in Arabic. Where any of those elements was missing, the applicant would have four months from the filing date to submit them. If the documents were submitted during that period, the filing date would be maintained.

149. The Delegation of the United States of America explained that, in order to secure a filing date, the applicant had to submit a clear reproduction and a claim.

150. The Delegation of Australia said that the minimum information required in Australia to accord a filing date was the following: indication that the filing was intended to be a design application, sufficient information to allow the identity of the applicant to be established and to contact him, and a representation of each design.

151. The Delegation of Italy indicated that the following were filing date requirements: a request that the registration of the industrial design was sought, indications allowing the identity of the applicant to be established, a clear reproduction of the design and the payment of the fee.

152. The Delegation of Algeria explained that, in order to obtain a filing date, the application had to contain or be accompanied by a signed statement of protection of the design, the payment of the fee and a representation of the design. Those requirements could be met within a four-month time limit without affecting the filing date.

153. The Delegation of Iran (Islamic Republic of) said that the filing date was the date on which an application was submitted, provided that it contained indications allowing the identity of the applicant to be established and the graphic representation of the industrial design.

Multiple Applications and Division

154. The Delegations of Japan and Mexico stated that their national systems provided for single-design applications. The Delegation of Japan further indicated that the reason was to simplify the determination of the scope of the design right and the resolution of infringement disputes.

155. The Delegation of Egypt said that multiple design applications were accepted, up to a maximum of 50 designs per application, provided that the designs belonged to the same class or were related to each other.

156. The Delegation of Uzbekistan said that the national system provided for one application per product, even though the number of variants of each design could be unlimited. However, for each variant, a complementary application was required.

157. The Delegation of the Republic of Korea explained that the national system provided for substantive and non-substantive examination, depending on the product. Multiple applications were allowed only in respect of the design of products with short-life cycles,

which classified for non-substantive examination. A maximum of 20 designs per application was permitted.

158. The Delegations of Guatemala, Italy and Spain said that multiple applications were accepted, provided that the products belonged to the same class. The Delegation of Spain further explained that a maximum of 50 designs was admitted in a multiple application, provided that, in the case of three-dimensional designs, they all belong to the same class. That restriction did not apply to two-dimensional designs, which could belong to different classes, but of which only a maximum of 50 designs could be admitted in a multiple application, as was the case for three-dimensional designs.

159. The Delegation of Uruguay said that multiple applications were admitted, provided that the designs belonged to the same concept. Where that was not the case, division would be required within a period of 90 days.

160. The Delegation of Brazil said that an application had to refer to a single article, of which a plurality of variations was permitted up to a maximum of 20, provided that such variations were intended for the same purpose and possessed the same predominant distinctive character.

161. The Delegation of Iran (Islamic Republic of) said that an application could contain two or more designs, provided that all the designs belonged to the same class or to the same set or composition of articles.

162. The Delegation of Australia said that an application could contain an unlimited number of designs, provided that they belonged to the same class. The applicant had six months to request publication or registration before examination. The advantage of the system was that manufacturers could file several designs in one application, use the six-month period to test the product, and then decide which designs were likely to succeed and proceed to registration. The system contributed to minimizing costs and reducing the need for a non-registered design right.

163. The Representative of the European Community said that the regional system allowed multiple applications, with no limitation as to the number of designs that could be included in one application, but provided that the products fell within the same class. That limitation did not however apply to designs which were mere ornamentation. The Representative observed that a small majority of the applications received by OHIM were multiple applications.

164. The Delegation of the United States of America, observing that the concept of unity of invention was applied in its country, explained that a design patent application could only have a single claim, and that designs that were independent and distinct had thus to be filed in separate applications. Designs were independent if there was no apparent relationship between two or more articles. However, a design claim could cover embodiments of different scope directed to the same inventive concept within a single application if the designs were not patentably distinct. Designs were not distinct inventions if they had overall appearances with basically the same design characteristics and if the differences between the designs were insufficient to patentably distinguish one design from the other, that is, if the differences were obvious to a designer of ordinary skill in the art.

Grace Period for Disclosure

165. The Delegation of Egypt said that there was no grace period for disclosure, except where a permission to disclose was obtained from the Office up to six months before disclosure.

166. The Delegation of Italy indicated that disclosure made by the designer, his successor in title or any third party would not destroy novelty if it was made during a period of 12 months prior to the date of filing of the application or to the priority date.

167. The Delegation of South Africa pointed out that there was a period of six months before filing within which the applicant could release the product into the market without such disclosure affecting novelty.

168. The Delegation of Australia observed that national legislation did not provide for a grace period for disclosure, except in the case of internationally recognized exhibitions or of other specific disclosures. In the case of unauthorized disclosure, for instance, the filing of the application would have to intervene within six months of the unauthorized disclosure, and the applicant would have to prove the unauthorized nature of such disclosure.

169. The Delegation of Guatemala indicated that the grace period was of six months. It further informed that the Guatemalan legislation also provided, in certain cases, for the protection without formalities of industrial designs for three year, from the date of disclosure.

170. The Delegation of Uruguay said that the national system provided for a grace period of six months, where a disclosure was made by the designer, an authorized third party or the person who commissioned the design.

171. The Delegation of the United States of America said that there was a one-year grace period for disclosure prior to filing. Disclosure would be a first offer for sale, the first illustration of the design or the first public use of the product in which the design was embodied.

172. The Delegation of Mexico, observing that the national legislation provided for a grace period of 12 months, expressed the view that such grace period complicated the examination of novelty.

173. The Representative of FICPI stated that the issue of a grace period for disclosure was one over which FICPI hoped to see harmonization. From an international point of view, harmonization had a practical effect, since an applicant who relied on a grace period in the market of the first application could have his registration invalidated in other countries which did not allow for such a grace period, on the ground that the design had been disclosed before the filing of the first application.

174. The Delegation of Spain stated that the national legislation provided for a grace period which applied even in the case of unauthorized disclosure.

175. The Delegation of the Republic of Korea, observing that national legislation provided for a six-month grace period for disclosure, explained that applicants intending to benefit from the grace period had to submit documents proving the relevant facts within 30 days from the date of application. The time limit did not however apply when the disclosure had taken place against the applicant's will, as in that case the documents could be submitted any time until the final decision.

Examination

Contents of Formal Examination

176. The Delegation of Egypt said that national legislation excluded a number of elements from design protection, for example, religious or commercial slogans, State flags, numbers or trademarks not owned by the applicant.

177. The Delegation of the United States of America said that examination by the USPTO focused on three main elements: novelty, originality and ornamentality. The Delegation explained that an ornamental design had been defined as one created for the purpose of ornamenting, and could not be the result of functional or mechanical considerations. As for originality, a design that simulated an existing object or person was not considered original. Novelty was determined by the degree of difference from the prior art by the average observer. The USPTO also refused, based on public order considerations, designs disclosing subject matter that could be deemed offensive to race, religion, sex, ethnic group or nationality.

178. The Delegation of the Republic of Korea said that, in addition to the criteria mentioned in document SCT/19/2, national legislation provided for examination to determine whether the design consisted solely of a shape that was essential to secure the function of the product. In that case, the design could not be registered.

179. The Representative of FICPI, underlining the importance of fully searchable and user-friendly design databases, said that examination for novelty *ex officio* depended upon the quality of the records available to an office.

Timing of Substantive Examination

180. The Delegation of Egypt indicated that examination was carried out prior to registration since 2002.

Opposition

181. The Delegations of Japan, Mexico and Uruguay said that there was no opposition system in their countries, but an invalidity procedure before the respective offices.

182. The Delegation of Mexico explained that, while there was no time limit to request the invalidity of a design for lack of novelty, a request for invalidity based on a prior right had to be filed within a time limit of three and five years.

183. The Delegation of Uruguay specified that the national system provided for the possibility of observations by a person not party to the procedure.
184. The Delegation of the Czech Republic said that invalidity of a design could be applied for before the Office.
185. The Delegations of Algeria and Italy said that there was no opposition procedure before the respective offices, but an invalidity system before the courts.
186. The Delegation of Pakistan explained that any person who had a legitimate interest could lodge a post-registration opposition before the Registrar of designs within a period of two years.
187. The Delegation of the Russian Federation said that there was no opposition procedure, but only a procedure for invalidation which could be initiated throughout the lifetime of the patent. The Delegation indicated that the introduction of a pre-registration opposition procedure was under consideration.
188. The Delegation of Egypt said that an opposition could be filed within 30 days from the publication of the design.
189. The Delegation of Guatemala indicated that national legislation did not provide for an opposition procedure, but for the possibility of filing observations within three months from publication. The invalidity of an industrial design could also be requested before a court.
190. The Delegation of Norway said that there was no opposition procedure, but an administrative review procedure which could be undertaken anytime during the period of protection, upon payment of a fee to the Office.
191. The Delegation of Singapore said that there was no opposition procedure, but a post-registration revocation procedure, which could be initiated by any interested person before the Registrar or a court, without any time limit.
192. The Delegation of the United States of America, pointing out that no pre-registration opposition procedure existed in its country as designs were not published until they were issued as design patents, explained that third parties could file a letter of protest, which was not, however, an *inter partes* proceeding. In addition, re-examination could be requested at any time during the period of enforceability of the design patent, raising an issue of prior art where the patent examiner finds a substantial new question of patentability. Finally, invalidity proceedings could also take place before the courts.
193. The Delegation of Australia indicated that, while rights were provided after formalities examination, the ability to enforce the rights on the design was not available until after the design had passed substantive examination. The Delegation specified that examination was available on request by the owner or a third party who could demonstrate that the design was not new or distinctive.
194. The Delegation of Iran (Islamic Republic of) explained that national law provided for a pre-registration opposition procedure before a commission.

195. The Representative of the European Community said that the registered Community Design system established an invalidity procedure which could be conducted before the Office or could result from a counterclaim in an infringement proceeding before a Community Trademark Court.

196. The Delegation of the Republic of Korea indicated that Korean law provided for a post-registration opposition which had to be filed within three months from the publication date. In addition, an invalidation procedure was available before the trial and appeal board.

Publication and Deferment

197. The Representative of the European Community stated that publication of design registrations currently took place on a daily basis.

198. The Delegation of Mexico said that, as from January 1, 2009, publication of industrial designs would be made on the Office Website, and a paper gazette would be printed only on request.

199. The Representative of FICPI, underlining the need for fully searchable and user-friendly design data bases, noted that publication was a crucial step towards that goal, as it was at that time that the material was classified and made accessible.

200. The Delegation of Japan explained that there was no deferment in its country, but a secret design system, under which the right holder could keep a *registered* design secret for a maximum period of three years from the date of registration. Should the holder wish to enforce his design right before the expiry of that period, he would need to provide evidence of the registration to the alleged infringer, without it been necessary to publish the design at that time.

201. The Delegation of the Republic of Korea stated that national law provided for keeping a registered design secret in a way that was similar to the law of Japan.

202. The Delegation of Egypt said that a design was kept secret until publication, and that there was no legal protection before publication.

203. The Delegation of Latvia stated that there was a maximum deferment period of 30 months from the date of filing or priority. In addition, observing that deferment was applicable to any type of design, the Delegation explained that, while the design was not published or registered until the end of the deferment period, the applicant could request publication earlier, where he wished to initiate infringement or opposition proceedings.

204. The Delegation of Italy said that national law provided for the possibility to defer publication for 30 months.

205. The Delegation of Iran (Islamic Republic of) stated that the maximum deferment period in its country was 12 months from the filing or priority date.

Term of Protection and Renewal

206. The Delegations of Algeria, Ecuador and El Salvador said that industrial designs were registered for a single ten-year period.
207. The Delegations of Guatemala, Uruguay and Uzbekistan said that industrial designs were registered for an initial ten-year term from the date of filing, and could be renewed for five more years.
208. The Delegation of Japan noted that industrial designs were registered for a maximum period of twenty years from the date of registration, but had to be renewed every year.
209. The Delegations of Italy and Norway said that industrial designs were registered for an initial period of five years from the date of filing, renewable for additional five-year periods, up to a maximum of 25 years.
210. The Delegations of Iran (Islamic Republic of), Morocco and Singapore said that there was an initial term of protection of five years from the filing date, which could be renewed for two consecutive periods of five years.
211. The Delegation of Pakistan said that there was an initial term of protection of 10 years, which could be renewed for two additional periods of 10 years.
212. The Delegation of South Africa explained that the national system provided for two types of designs, namely aesthetic designs, protected for 15 years, and functional designs, protected for 10 years.
213. The Delegation of the Republic of Korea said that there was an initial protection period of 30 years, which could thereafter be renewed every year, up to a maximum of 50 years.
214. The Delegation of Brazil said that an industrial design was registered for 10 years from the filing date, and could be renewed for three successive five-year periods.
215. The Delegation of Australia said that industrial designs were registered for an initial term of five years, which could be renewed once for another five years. The Delegation explained that the national system recently moved from a sixteen-year period of protection, structured in an initial one-year period, renewable for three additional five-year periods. Experience indicated that only around five percent of designs were extended for the third and final term.
216. The Delegation of the United States of America said that, while industrial designs were presently registered for a non-renewable period of 14 years, the period would probably change to 15 years when the United States joined the Geneva Act of the Hague Agreement.
217. The Delegation of Canada said that industrial designs were registered for a period of 10 years from the date of registration, subject to the payment of a maintenance fee at the end of five years.
218. The Delegation of Sudan said that industrial designs were registered for an initial term of five years from the date of filing, and could be renewed once for another five years.

219. The Chair, recalling that terms of protection had been standardized in the treaties dealing with other types of rights, observed that there was no convergence regarding the initial and maximum periods of protection of design rights, and wondered whether the SCT could reach some uniformity on this issue.

220. The Representative of FICPI, noting that more standardization of the initial and subsequent renewal periods would be of practical benefit for users, considered that, from the point of view of the balance between owners and third parties, it was important not to protect a design for a longer period than that required by the commercial interest of the owner. The Representative also recalled that there had been agreement in the Geneva Act about an initial period of five years and the possibility of renewing for two consecutive five-year periods, with freedom for Contracting Parties to add further periods of protection.

221. The Chair pointed out that accession to the Hague Agreement would tend to have a harmonizing influence in the acceding countries, and indicated that this area would require further work in order to attain a degree of convergence.

222. The Delegation of the United States of America expressed the view that the question was premature, as the discussion on industrial designs was still at an early stage.

223. The Delegation of Serbia said that, when examining the question of the term of protection, it would be important to take account of the number of renewals that actually took place.

224. The Delegation of El Salvador expressed the view that the question should not be addressed from the perspective of the Hague Agreement, to which not all members of the SCT were party, but rather from the standpoint of the minimum standard set out in the TRIPS Agreement.

225. The Delegation of Latvia said that, while no more than 15 years of protection were needed for a majority of products, a longer period of protection could be required in certain cases.

Communication with the Office

Signature requirements

226. The Delegation of El Salvador confirmed that certification of the applicant's signature by a notary was required in its country.

227. The Delegation of the United Kingdom, pointing out that there was a signature requirement in its country, said that a negative reply had been provided to this question in the questionnaire, insofar only as an agent's signature could replace the applicant's.

228. The Delegation of Guatemala said that the application had to be signed by the applicant or an authorized agent, with participation of a lawyer.

229. The Delegation of Germany observed that Germany did not require certification of the signature in case of surrender, but only in other special cases. In this regard, it pointed out that the corresponding question in part II of the questionnaire had been responded in the affirmative by Germany, insofar only as it referred to “surrender” as one example in which certification of the signature was required.

230. The Representative of INTA indicated that users would be satisfied if at an appropriate time convergence would be reached along the same lines as Article 8(3)(b) of the Singapore Treaty and the corresponding provision of the TLT, whereby certification of signature should not be required, except in the case of surrender of registration.

231. The Delegation of Italy indicated that design applications could be filed electronically in Italy.

Electronic communications

232. The Chair noted that there were significant differences regarding the formats used for the reproduction of designs, and expressed the wish that the Standing Committee on Information Technologies (SCIT) would make progress in the discussion leading to uniformity or interchange of formats.

Relief measures

233. The Representative of FICPI, recalling the analogy between designs and patents as regards the requirement of novelty and the impossibility of filing again an application, expressed the view that, should the SCT consider relief measures in the area of designs, it should examine the corresponding provisions under the PLT, rather than those under the Singapore Treaty.

234. In reply to a question by the Chair with respect to the functional features of a design, the Delegation of Egypt indicated that a design could not be registered in Egypt where the only characteristic was functional, but could be registered where it presented some other characteristic.

235. The Delegations of Brazil and Uruguay said that an industrial design could not be registered in their countries if the shape could be determined essentially by technical or functional considerations.

236. The Delegation of the United States of America, recalling that a design had to be primarily ornamental in its country in order to be patentable, pointed out that in determining whether a design was primarily ornamental or functional, the claimed design was viewed in its entirety. However, while ornamentality had to be based on the entire design, in determining whether a design was primarily functional, the purposes of the particular elements of the design necessarily had to be considered. The Delegation further explained that there was a distinction between the functionality of an article and the functionality of a particular design of such article. The design for the article could not be assumed to lack ornamentality merely because the article of manufacture would seem to be primarily functional.

237. In reply to a question by the Chair as to the future work in the field of industrial designs, the Delegation of Singapore, supported by the Delegations of Guatemala, Norway and by the Representative of OAPI, suggested that the Secretariat present an issues paper to the next session of the SCT, identifying possible areas of convergence, areas of divergence that may present a problem to users and other relevant issues.

238. The Delegation of the United States of America suggested that the paper include an overview of the existing international norms in the field of industrial designs.

239. The Delegation of the Russian Federation indicated that other topics of interest to it were the subject matter of industrial designs, the scope of protection and the overlap with other rights.

240. The SCT requested the Secretariat to prepare a working document for consideration by the SCT at the twenty-first session that would be based on documents SCT/19/6 and WIPO/STrad/INF/2 Rev.1 as well as on the report of the twentieth session of the SCT, and which would identify possible areas for convergence on industrial design law and practice in SCT Members, highlighting particular issues to be addressed in that context and taking into account existing international instruments.

Agenda Item 5: Trademarks

Representation of Non-Traditional Marks – Areas of Convergence

241. The discussion was based on document SCT/20/2.

242. The Chair recalled that the areas of convergence on non-traditional marks had been discussed by the Standing Committee during previous sessions and he proposed that the current session agree that document SCT/20/2 reflected the outcome of those discussions.

243. The Delegation of Iran (Islamic Republic of) said that with regard to the terms “non-traditional marks” as a title of this document, it wished to note that subparagraph 3(i) of the Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks and the Regulations Thereunder referred to marks covered by Rule 3, paragraphs (4), (5) and (6) of the Regulations under that Treaty as “new types of marks”. The Delegation believed that this term should be used in order to comply with the Resolution. The Delegation also believed that there could be significant costs for offices when determining the distinctive features of new types of marks, even where the Singapore Treaty did not impose an obligation on Members to register such marks. In fact, offices might require several reproductions of the mark or specimens in order to clarify the nature of those signs that were the product of modern technology. This would require offices and courts to acquire additional technical and professional expertise, which may also imply additional costs, particularly for developing countries.

244. The Chair noted that during several sessions, the SCT had been using the expression non-traditional marks, mainly because in certain jurisdictions some of those signs had been used for a long period of time and it was not meaningful to call them new.

245. The Chair suggested clarifying the matter by introducing an explanation in the form of a footnote to the term “non-traditional marks”. He also suggested that the SCT note the issue raised by the Delegation of Iran (Islamic Republic of) concerning the examination of non-traditional marks for its further discussions on this subject.

246. The Delegation of Egypt said that under national legislation, only visible signs could be registered as trademarks. Although three-dimensional marks were visible signs, no such mark had been registered in Egypt. The Delegation noted, however, that under the legislation of certain countries, three-dimensional marks were considered to be non-traditional.

247. The Delegation of Uruguay supported use of the expression “non-traditional marks” as it reflected the agreement of the Standing Committee in past sessions.

248. The Delegation of Latvia noted that the new types of marks referred to in the Singapore Resolution were three-dimensional marks, hologram marks, motion marks, color marks, position marks and marks consisting of non-visible signs, as stated in Rule 3, paragraphs (4), (5) and (6) of the Regulations. However, it seemed that the Standing Committee had discussed a larger range of non-traditional marks.

249. The Delegation of Norway supported the suggestion made by the Chair to keep the term non-traditional marks and to include a footnote referring to new types of marks as mentioned in the Singapore Resolution.

250. The Delegation of the United States of America declared that at the national level these marks were known since the late 1800s and from that perspective, they were not considered new. The Delegation noted that while discussing non-traditional marks, it was found that many of the traditional trademark principles were applied to those marks. Issues of representation seemed to be the more challenging aspect and that was precisely addressed in the areas of convergence. The Delegation expressed doubts as to whether it was necessary that the title of the areas of convergence and the language of the Singapore Resolution be equivalent.

251. The Delegation of Germany referred to the notes on area of convergence No. 1 and suggested adding an explanation to the effect that if the one view submitted by the applicant in order to secure a filing date was not sufficiently clear, additional views may be submitted later, although the scope of protection would always be limited to the aspects shown in the first view.

252. The SCT confirmed the areas of convergence on the representation of non-traditional marks as agreed by the SCT at its nineteenth session and presented in document SCT/20/2. It further agreed to introduce, in the title of the Annex to that document, a footnote to the term “Non-Traditional Marks” with the following text: “The Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks and the Regulations Thereunder refers to three-dimensional marks, hologram marks, motion marks, color marks, position marks and marks consisting of non-visible signs as ‘new types of marks’”. It also agreed to add a new Note 1.02 with the following text: “In some jurisdictions, the scope of protection will be restricted to those characteristics disclosed in the original representation”.

Trademark Opposition Procedures – Areas of Convergence

253. Discussion was based on document SCT/20/3.

254. The Delegation of Japan suggested including an indication in document SCT/20/3 that the areas of convergence on trademark opposition procedures would constitute a body of reference, in a manner similar to what was done with the areas of convergence on non-traditional marks. The Delegation recalled the contents of paragraph 11 of the Summary by the Chair of the seventeenth session (document SCT/17/7), namely that “to the extent that the document identified the approach in specific jurisdictions, it was purely illustrative and was not intended to serve as a comprehensive or authoritative guide”. The Delegation thus suggested that an explanation of equivalent effect be included in document SCT/20/3, and explained that its comment was intended to seek confirmation that the areas of convergence on trademark opposition procedures did not impose any obligations on SCT Members, in the same manner as the areas of convergence on non-traditional marks.

255. The Delegation of Uruguay expressed concern about the wording of area of convergence No. 7 stating that the “cooling-off” period was a useful means of encouraging the settlement of cases. In spite of the reasoning included in the notes, it seemed that the text should be clarified to state that not all cases could be settled by agreement and it was not always possible to provide for a “cooling-off” period. One way of dealing with that concern could be to include an exception in the notes to the effect that the “cooling-off” period could be granted, depending on the case, and only in those cases where Member States believed that it was appropriate and timely.

256. The Chair stated his understanding that area of convergence No. 7 did not impose an obligation on any Member State of WIPO to provide for a “cooling-off” period or to grant it in every case.

257. The Delegation of Germany noted that even though national legislation did not provide for a cooling-off period, it believed there was an area of convergence because of the second part of the text, which read “or the extension of time limits to the same effect”. National legislation provided for the extension of time limits, which was the second alternative and this allowed the Delegation to join the consensus around area of convergence No. 7.

258. The Representative of the INTA noted that on September 22, 2008, the Board of Directors of INTA had adopted a Resolution affirming the benefits of having opposition proceedings within a country’s trademark laws and procedures. The Resolution indicated the minimum features that such procedures should include from the point of view of the users. The Representative informed that copies of that Resolution had been made available through the Secretariat.

259. The SCT confirmed the areas of convergence on trademark opposition procedures as agreed by the nineteenth session of the SCT and presented in document SCT/20/3. It further agreed to add a slight amendment to the second sentence of Note 7.02, so as to read: “This could be considered a positive or negative feature, depending on the case and the overall design and management of each specific trademark system.”

260. The Chair recalled that in previous occasions, the SCT had stated its understanding that the areas of convergence on non-traditional marks and trademark opposition procedures did not oblige Members in relation to any particular practices, but rather constituted a body of reference, which could be used by Offices as well as by owners and practitioners.

261. The Representative of the INTA welcomed the adoption of the two sets of areas of convergence as useful bodies of reference to Offices and other interested parties. The Representative said that this was a significant outcome of the work undertaken by the SCT over the last two years. He trusted that this outcome would be appropriately reported to the competent organs of WIPO and given adequate publicity by the Secretariat so as to serve the intended purpose. The Representative hoped that this commendable achievement would in turn contribute to a greater coherence of laws and practices in the two fields concerned.

262. The SCT agreed that the Secretariat would publish the two aforementioned documents, with the amendments as agreed by the SCT at this session, in the WIPO/STrad/INF series of documents, and bring those documents to the attention of the relevant WIPO Assemblies.

Other Trademark Issues

263. The Chair referred to the Report of the eighteenth session of the SCT (document SCT/18/10). He noted that at that session, the Standing Committee considered taking up additional work relating to the examination of traditional marks and technical aspects concerning the registration of collective and certification marks. The Chair asked the SCT to have a more wholesome discussion of issues on which work should be undertaken.

264. The Delegation of Iran (Islamic Republic of) referred to its earlier intervention on new types of marks and drew the attention of the Standing Committee to Article 10*bis*(3)1 of the Paris Convention. The Delegation noted that this Article obliged the Member States to prohibit all acts that are of such a nature as to create confusion by any means with the establishment, the goods, or the industrial or commercial activities of a competitor. Article 10*bis*(3)1 did not limit the type and kind of acts, so it could cover all the acts to be performed in the scope of trademarks, which might cause confusion for the substantial number of the average consumers. The Delegation believed that new types of marks seemed to present too many ambiguities for trademark offices, and the possibility of using technical expertise to determine the distinctive features of those marks was not enough to meet the public needs. The Delegation considered that if any act of the industrial property office contributed to the confusion of consumers, it would amount to non-compliance with the obligations under Article 10*bis*(3)1. Therefore, work should be undertaken on ways to determine the distinctive features of new types of marks to help the average consumer.

265. The Chair noted that at its eighteenth session, the SCT discussed a document entitled “The Relation of Established Trademark Principles to New Types of Marks” (SCT/17/3), which dealt with the issue of distinctiveness of non-traditional signs. The Chair further noted that paragraphs 130 through to 156 of the report of the eighteenth session (document SCT/18/10) recorded the discussion of the SCT on this issue. The Chair noted that at that point no further work was requested. However, the issue could be reopened if the Standing Committee so requests.

266. The Delegation of Egypt said that the issue raised by the Delegation of Iran (Islamic Republic of) brought up a reflection of whether it was necessary to protect the owners of goods and services as well as to protect consumers. The Delegation stated that the role of IP offices was to examine marks in such a way as to avoid confusion. Their goal was to also encourage creativity in all areas. The Delegation believed that putting too much emphasis on consumer protection could prevent the owner from placing its goods on the market, under the pretext that those goods are not protected.

267. The Chair noted that the comments made by the Delegation of Egypt clearly highlighted the question of examination. The Chair recalled that during the discussion of document SCT/17/3, the majority of delegations held the view that established principles for the examination of so-called “traditional marks” should also be applied to the examination of these newer signs. The Chair also recalled that at a previous session, the Delegation of Uruguay had suggested that the SCT undertake a discussion on examination or grounds of refusal in general. Since the principles were the same, it seemed sensible to consider how they might apply to the types of marks on which members had less experience.

268. The Delegation of Iran (Islamic Republic of) referred to the views expressed by the Delegation of Egypt and said that the goal of intellectual property and the role of national offices was on the one hand to guarantee the effective and efficient protection of owners, and on the other, to avoid the unnecessary extension of protection. In the view of the Delegation, offices should bear in mind the consumer when determining the distinctive features of any kind of mark.

Letters of Consent

269. The Delegation of Mexico said that the question of letters of consent was mentioned during the discussion on opposition as an alternative way of concluding such procedures. However, in some offices, it had become usual to accept letters of consent as part of the registration procedure. As a result, the user of the system found that the IP Office agreed to register an identical mark for identical products and services. Users also found that other offices around the world did not observe this practice. The Delegation noted that the key function of a trademark was allowing the consumer to distinguish the goods and services of one holder from those of its competitors. National offices had the obligation to keep a register and to make available information on who were the holders of marks. In the view of the Delegation, when a letter of consent was accepted in order to grant a registration, it seemed that the order of the register was altered and transparency could no longer be guaranteed to consumers. The Delegation expressed its interest in asking the Secretariat to develop a document around the following issues: (a) if national legislation specifically provides for letters of consent, does the Office accept them and in which cases? (b) what effect would this acceptance have on the distinctiveness of a mark that was granted on the basis of a letter of consent? (c) if a third person should attempt to register a mark that was identical or similar mark to a mark which was already granted to a second person on the basis of a letter of consent, could the Office grant this third trademark registration or should it require a letter of consent from the first two trademark holders? (d) does the Office accept letters of consent when the right holder and applicant are natural or legal persons belonging to the same trade group? (e) once a trademark has been granted on the basis of a letter of consent, is there any prohibition for this trademark to be assigned to a third person who might enter into conflict with the original holder of the mark?

270. The Delegation of Germany said that national legislation did not provide for the possibility of filing letters of consent. The national Office did not examine prior rights *ex officio* but the system provided for opposition procedures after the registration of the mark. If the parties reached an agreement at that stage, the Office did not ask for any document attesting the agreement. The opponent would just withdraw its opposition or the mark holder would limit its list of goods and services according to the agreement reached. The Delegation believed that it was always best if the parties themselves reached an agreement and were able to coexist. Furthermore, the law on unfair competition dealt with consumer protection and this was a set of statutory law independent from trademark law.

271. The Delegation of El Salvador supported the suggestion made and in particular, the questions raised by the Delegation of Mexico. Since the year 2001, national legislation in El Salvador included the possibility of filing letters of consent. The extensive use of this possibility seemed to be an area of concern for the national Office.

272. The Delegation of the Russian Federation said that national law allowed the registration of similar marks for similar goods and services if a letter of consent was submitted to the Office during expert examination. However, several questions had been raised in practice. As other delegations had mentioned, the possibility of leading consumers into confusion was real, and for this reason experts decided to refuse applications for similar marks in some cases. The Delegation noted that several questions remained unresolved. When a previous agreement was rejected before the decision on registration, the expert could consider the letter of consent as not presented. But a letter of consent could also be filed in the event of a dispute concerning the registration of a mark. Perhaps the more dangerous situation was one where a mark was registered following a letter of consent and agreement between the parties,

but as a result of a complaint against the registration, certain owners of earlier rights withdrew their previously accorded consent. An additional question would relate to the form of these documents, namely whether they should be drafted in general terms or make a specific reference to the application number concerned.

273. The Delegation of Ukraine indicated that national legislation did not contain standards on the examination of letters of consent. However, those letters were sometimes presented in trademark opposition procedures and if accepted by the competent authority, they could lead to the registration of marks that were initially contested. The Delegation declared that it was envisaged to introduce standards on the acceptance of letters of consent, because as it was mentioned by the Delegation of the Russian Federation, there could be cases where a letter of consent could be withdrawn by the owner of a mark at a later stage. The Delegation believed it would be interesting to learn about the standards applied by other SCT Members that also admit the presentation of letters of consent.

274. The Delegation of the Republic of Moldova stated that the national Office had an established practice of accepting letters of consent. Some times letters of consent were referred to a specific period, for example 10 years and some times conditions were laid down with respect to the products covered by the registration. The Delegation noted that in the event of confusion, the issue was raised as to who was the owner of the mark. The Delegation believed that it was useful to publish this information in the event that a new application was received and the Office had to decide whether another letter of consent became necessary.

275. The Delegation of Hungary referred to the issue of whether consent could be withdrawn. The Delegation informed the SCT that national legislation in Hungary provided that once consent was granted by the owner of a trademark right, it could not be withdrawn at a later stage. It could be considered that the reason behind this provision could be consumer protection because if there are two similar or identical marks for different owners in the market, the consumer might get familiar with that particular situation over time and a new situation would be misleading. The Delegation said that an owner should probably consider it carefully whether or not to grant a letter of consent for a later trademark application.

276. The Delegation of Ecuador said that under national legislation the Office was bound to accept a letter of consent, except in the case of an identical mark for identical goods and services, in order to protect consumers. The Delegation noted that under national practice these letters were also called transactional agreements.

277. The Delegation of the United Kingdom said that the issue raised by the Delegation of Mexico was interesting both at the practical and at the theoretical level. National legislation in the United Kingdom expressly provided for letters of consent and the Office encouraged parties both in opposition proceedings and in the process of *ex officio* examination to engage in their own settlement which might well result in letters of consent. The Delegation noted that national systems might seek to protect the consumer, the system in the United Kingdom could be characterized as deregulatory and essentially liberal. The national Office was looking into options such as providing material on its Website whereby the parties could actually formulate their own coexistence agreements.

278. The Delegation of Guatemala declared that under national practice, it was not possible to accept letters of consent for identical marks. However, in the event of an objection from the registrar as to the distinctive character of a mark and its similarity to a prior registered mark, agents submitted letters of consent before the examination. Then, during the opposition period, the opponent or a third party affected by the registration of the mark could also present a letter of consent or an authorization allowing that mark to be registered. The Delegation noted that while it was quite common to use letters of consent in Guatemala, no specific provision existed in national legislation.

279. The Delegation of Serbia indicated that there was no specific provision in national law regarding letters of consent. These were dealt with in the Office guidelines and methodology rules. The first question was the legal nature of those letters. The Office treated letters of consent as a form of contract. Those letters were acceptable in the case of similar marks but were refused in the case of identical marks. The Delegation referred to the issue raised by the Delegation of Mexico as to whether the existence of a letter of consent meant that the original owner agreed for a third party to also protect a similar or identical mark. The Delegation noted that if the letter of consent was considered a contract, this could only have effect between the parties and would not oblige the Office to accept that consent with regard to third parties. One outstanding issue was the subsequent withdrawal of consent given by the owner.

280. The Delegation of Uzbekistan said that national legislation provided for the possibility of accepting letters of consent during examination if the expert considered that there could be confusion between the mark applied for and a previously registered mark. It seemed, however, that from the point of view of the consumer it was difficult to distinguish the products of one owner from another, especially if there was not much difference in quality.

281. The Delegation of Singapore expressed support for the suggestion made by the Delegation of Mexico to have a discussion on letters of consent. The Delegation said that national legislation in Singapore had express provisions for the acceptance of letters of consent by the Registrar to overcome a citation. However, the Registrar reserved the discretion of whether or not to accept those letters. The Registrar could refuse letters of consent upon public interest considerations, for example in the case of pharmaceutical goods, which if confused, could lead to dire consequences.

282. The Delegation of Spain noted that national practice was similar to that described by the Delegations of Germany and the United Kingdom. Examination by the Office covered only absolute grounds and relative grounds were dealt with in opposition proceedings. During opposition, the parties could ask for the suspension of proceedings up to a maximum of six months, at the end of which they could reach agreement. The Delegation believed that if an opposition was withdrawn as a result of agreement between the parties, the mark could be granted without any difficulty, and it was immaterial if the mark was identical for identical products. The Delegation considered that conflict resolution should be left to the trademark owners. In addition, consumer protection was achieved by the market and the consumers themselves, which served as correcting factors, rather than having the trademark Office undertake that role.

283. The Delegation of Algeria said that the national system contemplated the full examination of trademarks without opposition. The national Office accepted letters of consent only in cases of prior similar marks and not in cases of identical marks to avoid any difficulties with examination. The Delegation considered that if the owner of a prior trademark right gave more than one letter of consent, examination would become too complicated.

284. The Delegation of Uruguay declared that the national Office examined prior rights *ex officio*. While local legislation did not contain any specific provisions concerning letters of consent, the system was perhaps less liberal than others. It was intended to protect the public by making sure that identical marks for identical goods belonging to different owners would not create confusion as to the origin of the products concerned. The Delegation noted that letters of consent that had been submitted, particularly in cases concerning pharmaceutical products, were rejected in order to protect the public.

285. The Delegation of China said that it seemed from the discussion that several countries had encountered problems relating to letters of consent. In the re-examination of refusals, for example, the national Office had been asked to accept letters of consent and while these were currently admissible, they only served as reference. The primary criteria were whether the registration of similar marks could lead to confusion on the part of the consumer.

286. The Delegation of Mexico recalled that its proposal on this issue was to ask the Secretariat to prepare a working document on the basis of the points raised by that Delegation earlier in the meeting. The Delegation clarified that such a proposal would not extend to asking the Standing Committee to decide whether letters of consent should be part of the trademark registration procedure.

287. The SCT agreed to request the Secretariat to prepare an information document on the subject of letters of consent, for consideration by the SCT at its second session in 2009, and based on information to be collected by the Secretariat by means of a concise list of questions, to be addressed to SCT Members in the first half of 2009.

Trademarks and International Nonproprietary Names for Pharmaceutical Substances (INNs)

288. The Chair recalled the discussion that had taken place at the nineteenth session of the SCT over the examination of trademarks against INNs and INN stems, and asked whether the Standing Committee wished to pursue that discussion.

289. The Delegation of Mexico, recalling that the examination of trademarks against INNs and INN stems differed from one office to another, said that it was important for users that offices should follow similar criteria in this particular aspect of examination.

290. The Delegation of Germany, stating that the issue under consideration did not pose a major problem in Germany, expressed the view that the discussion which had been held so far was sufficient.

291. In reply to a question of the Delegation of Germany, the Secretariat reported that it had initiated contacts with the WHO Secretariat in order to explore possibilities of developing a publicly searchable database for INNs, and indicated that the SCT would be informed of further developments concerning this matter.

292. The Chair, noting that there was no further comment, drew the discussion to a close.

Proposal by the Delegation of Jamaica in relation to Article 6ter of the Paris Convention

293. The Delegation of Jamaica referred to Article 6ter of the Paris Convention, which stipulated the prohibition, through appropriate measure, of the registration and use of armorial bearings, country flags and other State emblems as trademarks or as elements of trademarks. The Delegation recalled that, at the occasion of the last meeting of the WIPO General Assembly, it had informed WIPO Member States of the steps being taken to develop the Jamaica nation branding strategy, and that, as a result, the protection of Article 6ter(1)(a) was central to, and formed the basis of the development of this strategy. Though Article 6ter(1)(a) and the national legislation, as contained in Sections 12, 50 and 52 of the 2001 Trade Marks Act, provided for the prohibition of registration of flags, State emblems and national symbols, the Delegation remained deeply concerned that Article 6ter did not make specific mention and, therefore, had no express provision for the protection of country names. The Delegation considered this fact of great significance because it believed that the protection of the name Jamaica would be vital to the aforementioned branding strategy. It also believed that there were many other delegations which may share its view of the valuable gains that may result from the protection of their State names and, therefore, underscored the importance of this issue for all delegations present, and encouraged their support of this proposal. The Delegation thus anticipated that a re-visitation of Article 6ter to include the protection of official State names may bring this matter to a favorable conclusion, in line with an initiative which was tabled during the Diplomatic Conference on the Revision of the Paris Convention in 1980 where, at the time, the addition of official names of States to the items protected under Article 6ter was recommended. Consequently, the Delegation of Jamaica wished to submit to the membership its proposal for re-visitation of the revision of Article 6ter, and to place on record its request to formally table this proposal at the next session of the SCT. Specifically, the Delegation hoped that with the support of other delegations, the Committee could agree to consider the treatment of official names of States, their translation into other languages of the Union, as well as homonymous sounds with regard to the pronunciation of these official names e.g. names such as the J-A-H-M-A-K-A as requiring the same protection as armorial bearings, flags and other State emblems under Article 6ter(1)(a). In addition, the Delegation of Jamaica said it would prepare a request for communication, under Article 6ter(3)(a), of the State emblems which it wished to protect, as well as a request for the protection of a person's likeness and name as State emblems. In conclusion, the Delegation requested the Secretariat to provide it with some guidelines on how to proceed, and that the matter be included on the agenda of the next meeting of the SCT in order to allow for the formal tabling of its proposal.

294. The Chair indicated that such proposal would have to be submitted by the end of March 2009, and underlined that any revision of Article 6ter of the Paris Convention would require a diplomatic conference.

295. The Delegation of the United States of America, pointing out that the USPTO had encountered difficulties in determining whether some notifications received under Article 6*ter* of the Paris Convention met the requirements of that Convention, considered that it would be useful to discuss the eligible subject matter of that article in a broader context. The discussion should not be limited to the possibility of broadening the scope of that provision, but embrace also the possibility of narrowing it.

296. The Delegation of Switzerland, noting that its country shared the concerns expressed by the Delegation of Jamaica, said that it supported a discussion of the subject under Article 6*ter*, as well as exploring other possible means of finding a solution to the problems mentioned by that Delegation.

297. The Delegations of Italy and Iran (Islamic Republic of) supported the proposal by the Delegation of Jamaica.

298. The Delegation of the United States of America, supported by the Delegation of Germany, expressed its interest in a discussion regarding official names of States in the context of the eligible subject matter and implementation of Article 6*ter*. However, the Delegation considered that the issue of names of States exceeded the boundaries of Article 6*ter* and called for a broader discussion including geographical indications.

299. The SCT agreed to include an item on Article 6*ter* of the Paris Convention in the Agenda for its next session and invited Members to submit any proposal in that respect by March 2009 at the latest.

Continuation of the Work of the SCT in the Area of Trademarks

300. The Chair recalled that at its eighteenth session the SCT identified as its next priority the examination of traditional marks. As a result of the discussions held at the current session, it seemed more sensible to talk about examination of grounds for refusal in general. Moreover, the Chair recalled that at the eighteenth session of the SCT, the Delegation of New Zealand, supported by a number of other delegations, proposed that the SCT discuss the technical aspects relating to the registration of certification marks.

301. The Representative of the European Community explained that the European Community system provided for the protection of collective marks only. In addition to the grounds for refusal of any ordinary trademark, the provisions of Article 66(2) of Council Regulation (EC) No 40/94 stipulated that an application for a community collective mark should also be refused if the public was liable to be misled as regards the character or the significance of the mark, and in particular if it was likely to be taken as something other than a collective mark. The Representative further noted that registration requirements were the same as for ordinary trademarks. In derogation to the principle of distinctiveness, signs or indications which might serve in trade to designate the geographical origin of the goods or services might constitute community collective marks.

302. The Delegation of Mexico said that under national legislation, protection was provided for collective marks only. In Mexico, legally incorporated associations of producers, manufacturers, business people or service providers could apply to register collective marks in order to distinguish their products or services from those of non-members. The Delegation noted that collective trademarks could not be transferred to third parties and their use was reserved for the members of the association. In addition, registration requirements were the same as for ordinary marks and geographical indications could not be registered as collective marks.

303. The Delegation of United Kingdom stated that its national system provided for the protection of both certification and collective marks. Although there were no exact figures on those registrations, it seemed that they were not high. Application requirements included a copy of the regulations governing the use of the mark.

304. The Delegation of Morocco noted that in its country protection was available for both collective and certification marks. Application requirements were the same as those for ordinary marks. In general, corporate bodies and groups which complied with national law could obtain certification or collective mark protection. In the case of collective marks, only the members of the association had the right to use the mark on the basis of special rules. As for certification marks, these were filed by institutions or other bodies, which could not themselves use the mark. However, anyone that complied with the standards would be allowed to use the mark.

305. The Delegation of Guatemala said that under national legislation, collective and certification marks might be protected and the registration criteria were the same as for ordinary marks.

306. The Delegation of Spain noted that both collective and certification marks were admitted for registration. The latter were called “guarantee” marks. The same registrability requirements were applied to these marks with the exception of the prohibition to register geographical names. In Spain, it was required that the regulations concerning use of these marks have the express approval of the competent authorities, according to the subject matter. The Delegation noted that the number of guarantee marks was low although an important increase of those figures was perceptible.

307. The Delegation of Uruguay noted that under its system, collective marks were used to identify goods or services originating from the members of a given collectivity. The application for registration of a collective mark should include: the regulations for use of the mark, the particulars of the requesting association, the list of persons authorized to use the mark, the requirements for membership in the association and the grounds upon which a member of the association might be prohibited from using the mark. The application for registration of a certification mark should include the common characteristics of quality, compounds, methods used and any other elements considered by the owner of the mark to be necessary for certification. The Delegation further noted that geographical indications could not be registered as certification marks.

308. The Delegation of Pakistan said that under national law, the most important application requirements for collective marks were for the applicant to qualify as an association and to submit the regulations governing *inter alia*, the use of the mark, the purpose of the association, the conditions of membership and any possible sanctions in case of misuse of the mark or non-compliance with the association’s bylaws.

309. The Delegation of Brazil indicated that according to its legislation, a certification trademark was used to certify that a product or service conformed to pre-determined technical standards or specifications, notably with reference to the quality or nature of the products, the materials used and the methodology employed. Collective trademarks were used to identify products or services from members of a given entity and could be requested only by a representative of such a group.

310. The Delegation of the Russian Federation explained that national law did not provide for the protection of certification marks. The figures on registered collective marks were quite low. The Delegation informed the SCT that the regulations accompanying a collective mark application should contain: the name of the business association authorized to register the mark, the list of enterprises authorized to use this mark, the objective of its registration, the list of goods and common qualitative or other general properties of the goods that would bear the collective mark, the conditions for use and control mechanisms and any liability in case of violation of the regulations. The Delegation noted that a collective mark and the right to use it could not be transferred.

311. The Delegation of China noted that according to national legislation both collective and certification marks could be registered. Geographical indications were protected through certification marks. The registration requirements were the same as for ordinary marks. Regulations currently in force set specific requirements for certification marks, for example that the applicant should be an organization of professionals in the specific field and possess professional testing equipment or facilities. The Delegation noted that a change of ownership required a special procedure in the case of collective and certification marks.

312. The Delegation of Germany explained that its national system resembled that of the European Community in that protection was provided only for collective marks. There were quality indicators or other signs created by the public sector, which did not form part of trademark law. In case of misuse of those signs the law of unfair competition would apply. The Delegation noted that in Germany, a collective mark could consist of a geographical name. The Delegation further noted that from a pragmatic point of view, it was advisable to use a double system of protection of a geographical name, i.e., applying for registration as a collective mark and protecting the name as a geographical indication.

313. The Delegation of Singapore said that the national Office accepted applications for both collective and certification marks. The application process was similar to that of any ordinary mark. Signs applied as both types of marks could consist of geographical indications. However, the proprietor of such marks could not prohibit the use of those signs and indications which was in accordance with honest industrial or commercial practices. Applications should be accompanied by a set of regulations governing the use of the collective and certification marks or applicant may submit them within nine months from the date of filing the application.

314. The Delegation of the United States of America indicated that under the national system, it was possible to protect both collective and certification marks. The Delegation noted that national regulations provided that certification marks could be used to certify the regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization. With regard to a certification mark concerning geographical origin, there was no requirement of acquired distinctiveness of the geographical term. The Delegation further noted that a collective mark

indicated the commercial origin of the goods or services to be that of the members of a group rather than that of one party. A geographical term could not be registered as a collective mark without acquired distinctiveness. Generic terms could not function as certification or collective marks. Owners of collective and certification marks could be bodies or individuals, private organizations or associations, as long as they were able to demonstrate the ability to control the use of the mark and establish that they would not engage in discriminatory practices. The Delegation further noted that the applicant of a certification mark should state in its application that it was exercising the legitimate control over the use of the certification mark. The applicant was also required to state that he was not engaged and would not engage in production and marketing of any goods or services to which the certification mark was applied. In addition, the owner might not permit use of a certification mark for purposes other than to certify.

315. The Delegation of Australia said that it was possible to register both collective and certification marks in Australia. Collective marks were owned collectively, which meant that use by the individual members constituted use by the organization or association as a whole. Ownership of these marks could not be assigned or transferred. A certification mark indicated that the goods had been certified as meeting particular standards of quality, accuracy or having a particular composition, mode of manufacture, geographical origin or some other characteristics. Geographical indications could be protected using certification marks. The application procedure for collective and certification marks was the same as for any ordinary mark, except that a copy of the rules governing use of the marks should also be filed. These rules should include among other things the requirements to be met by the goods or services, the process for determining whether goods or services met the certification requirements, and the attributes that the person should have to become an approved certifier. The Delegation further noted that the Registrar should send a copy of the application and rules, and any other relevant documents to the Australian Competition Consumer Commission. This Commission was required to consider the rules before acceptance, to test for competition principles and to ensure that there was no detriment to the public. The criteria for determining registrability were similar but not entirely the same as for ordinary trademarks.

316. The Delegation of Austria noted that according to national legislation, only collective trademarks were protected. Nevertheless the use of marks which could be seen as certification marks should be approved by the Ministry of Economic Affairs or from the Ministry of Agriculture. Only associations having legal personality and public legal entities were allowed to file applications for collective marks. The applicant had to also file the statutes of the association, stating the persons authorized to use the mark and the conditions of use. The Delegation noted that geographical names could be registered as collective trademarks.

317. The Chair concluded that grounds for refusal and collective and certification marks continued to be priority areas for the Standing Committee and suggested asking the Secretariat to develop a document on each of these topics for the next session of the SCT. Those documents would be based on the Summary of Replies to the Questionnaire on Trademark Law and Practice (document WIPO/Strad/INF/1), submissions to be sent by SCT members and any discussion that the Committee might have on this issue.

318. With regard to the continuation of the SCT's work in the area of trademarks, the SCT agreed to request the Secretariat to prepare two working documents in preparation of the twenty-first session of the SCT, namely one concerning grounds for refusal of all types of marks, and another one on technical and procedural aspects relating to the registration of certification and collective marks. Members were invited to present submissions for those two working documents by February 15, 2009.

Agenda Item 6: Geographical Indications

319. The Chair noted that there were no working documents or proposals for discussion at this meeting.

Agenda Item 7: Summary by the Chair

320. The Standing Committee adopted the draft of the Summary by the Chair contained in document SCT/20/4 Prov. with the modifications suggested by the Delegations of Brazil and Germany. The Summary by the Chair (document SCT/20/4) is reproduced in Annex I.

Twenty-First Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/21)

321. The Chair announced as tentative dates for SCT/21, June 22 to 26, 2009

Agenda Item 8: Closing of the Session

322. The Chair closed the twentieth session of the Standing Committee.

[Annexes follow]

WIPO



SCT/20/4

ORIGINAL: English

DATE: December 5, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Twentieth Session
Geneva, December 1 to 5, 2008

SUMMARY BY THE CHAIR

approved by the Standing Committee

Agenda Item 1: Opening of the Session

1. Mr. Francis Gurry, Director General, opened the session and welcomed the participants.

Agenda Item 2: Adoption of the Agenda

2. The SCT adopted the Draft Agenda (document SCT/20/1 Prov.) without modifications.

Agenda Item 3: Adoption of the Draft Report of the Nineteenth Session

3. The SCT adopted the Draft Report of the Nineteenth Session (document SCT/19/9 Prov.) with modifications as requested by the Delegations of Canada, the Russian Federation, Spain, the United States of America and the Representative of the International Trademark Association (INTA).

Agenda Item 4: Industrial Designs

4. Discussion was based on documents SCT/19/6 and WIPO/STrad/INF/2 Rev.1.

5. The SCT considered documents SCT/19/6 and WIPO/STrad/INF/2 Rev.1 in detail. The Chair concluded that all comments by delegations would be recorded in the report of the twentieth session of the SCT. All requests for amendment of document WIPO/STrad/INF/2 Rev.1 were noted by the Secretariat and would be reflected in the next edition of that document, as would be additional returns to the Questionnaire on Industrial Design Law and Practice.

6. Furthermore, the Secretariat was requested to prepare a working document for consideration by the SCT at the twenty-first session that would be based on documents SCT/19/6 and WIPO/STrad/INF/2 Rev.1 as well as on the report of the twentieth session of the SCT, and which would identify possible areas for convergence on industrial design law and practice in SCT Members, highlighting particular issues to be addressed in that context and taking into account existing international instruments.

Agenda Item 5: Trademarks

Representation of Non-Traditional Marks – Areas of Convergence

7. Discussion was based on document SCT/20/2.

8. The SCT confirmed the areas of convergence on the representation of non-traditional marks as agreed by the SCT at its nineteenth session and presented in document SCT/20/2. It further agreed to introduce, in the title of the Annex to that document, a footnote to the term “Non-Traditional Marks” with the following text: “The Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks and the Regulations Thereunder refers to three-dimensional marks, hologram marks, motion marks, color marks, position marks and marks consisting of non-visible signs as ‘new types of marks’”. It also agreed to add a new Note 1.02 with the following text: “In some jurisdictions, the scope of protection will be restricted to those characteristics disclosed in the original representation”.

Trademark Opposition Procedures – Areas of Convergence

9. Discussion was based on document SCT/20/3.
10. The SCT confirmed the areas of convergence on trademark opposition procedures as agreed by the nineteenth session of the SCT and presented in document SCT/20/3. It further agreed to add a slight amendment to the second sentence of Note 7.02, so as to read: “This could be considered a positive or negative feature, depending on the case and the overall design and management of each specific trademark system”.
11. The SCT agreed that the Secretariat would publish the two afore-mentioned documents, with the amendments as agreed by the SCT at this session, in the WIPO/STrad/INF series of documents, and bring those documents to the attention of the relevant WIPO Assemblies.
12. With regard to the continuation of the SCT’s work in the area of trademarks, the SCT agreed to request the Secretariat to prepare two working documents in preparation of the twenty-first session of the SCT, namely one concerning grounds for refusal of all types of marks, and another one on technical and procedural aspects relating to the registration of certification and collective marks. Members were invited to present submissions for those two working documents by February 15, 2009.
13. The SCT also agreed to request the Secretariat to prepare an information document on the subject of letters of consent, for consideration by the SCT at its second session in 2009, and based on information to be collected by the Secretariat by means of a concise list of questions, to be addressed to SCT Members in the first half of 2009.
14. The SCT further agreed to include an item on Article 6ter of the Paris Convention in the Agenda for its next session and invited Members to submit any proposal in that respect by March 2009 at the latest.

Agenda Item 6: Geographical Indications

15. The Chair noted that there were no working documents or proposals for discussion at this meeting.

Twenty-First Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/21)

16. The Chair announced as tentative dates for SCT/21, June 22 to 26, 2009.

Agenda Item 7: Summary by the Chair

17. The SCT approved the Summary by the Chair as contained in the present document.

Agenda Item 8: Closing of the Session

18. The Chair closed the session on December 5, 2008.

[Annex II follows]

ANNEX II

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

AFRIQUE DU SUD/SOUTH AFRICA

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