

WIPO



SCT/21/8

ORIGINAL: English

DATE: November 26, 2009

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

**Twenty-First Session
Geneva, June 22 to 26, 2009**

REPORT*

adopted by the Standing Committee

* This report was adopted at the twenty-second 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 twenty-first session, in Geneva, from June 22 to 26, 2009.
2. The following Member States of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Afghanistan, Angola, Argentina, Australia, Austria, Barbados, Belarus, Brazil, Cambodia, Canada, Chile, China, Colombia, Costa Rica, Côte d’Ivoire, Croatia, Cuba, Czech Republic, Democratic People’s Republic of Korea, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, Finland, France, Germany, Greece, Guatemala, Guinea, Haiti, Hungary, India, Indonesia, Iran (Islamic Republic of), Ireland, Italy, Jamaica, Japan, Jordan, Kenya, Kyrgyzstan, Latvia, Lebanon, Lesotho, Libyan Arab Jamahiriya, Lithuania, Luxembourg, Malaysia, Mexico, Morocco, Myanmar, Namibia, Netherlands, Nigeria, Norway, Oman, Paraguay, Philippines, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Senegal, Serbia, Singapore, Slovenia, Spain, Sri Lanka, Sweden, Switzerland, Thailand, the former Yugoslav Republic of Macedonia, Turkey, United Kingdom, United States of America, Uruguay, Viet Nam, Yemen, Zimbabwe (83). 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: Benelux Organisation for Intellectual Property (BOIP) and the World Trade Organization (WTO) (2).
4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Association for the Protection of Industrial Property (AIPPI), Centre for International Intellectual Property Studies (CEIPI), China Trademark Association (CTA), European Brands Association (AIM), International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), Knowledge Ecology International (KEI) (12).
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. Ernesto Rubio, Assistant Director General, reported on the work done by the International Bureau in preparation for the 21st session of the Standing Committee in connection with each of the topics proposed for discussion.
9. Mr. Marcus Höpferger (WIPO) acted as Secretary to the Standing Committee.

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

10. Mr. Park Seong-Joon (Republic of Korea) was elected as Chair of the twenty-first session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), and Mr. Adil El Maliki (Morocco) was elected as Chair of the twenty-second session of the SCT. Mr. Imre Gonda (Hungary) and Mr. Joseph Kahwagi Raga (Mexico) were elected as Vice-Chairs for the twenty-first and the twenty-second sessions of the SCT.

Agenda Item 3: Adoption of the Agenda

11. The SCT adopted the Draft Agenda (document SCT/21/1 Prov.) without modifications.

Agenda Item 4: Adoption of the Draft Report of the Twentieth Session

12. The SCT adopted the Draft Report of the Twentieth Session (document SCT/20/5 Prov.2) with modifications as requested by the Delegations of Guatemala, Jamaica, Japan, Spain, the Republic of Korea and the United States of America.

Agenda Item 5: Industrial Designs

13. The discussion was based on document SCT/21/4.

Possible Area of Convergence on the Form of Reproduction of Industrial Designs

14. The Delegation of Spain expressed support for the text as it stood.
15. The Delegation of Japan, while indicating that it agreed with the gist of this area of convergence, expressed the view that the use of dotted lines or shading should be made under the regulations of each office, and suggested adding a reference to that effect at the end of the last two sentences.

16. The Delegation of the United States of America said it understood that the use of dotted lines and shading was governed by individual office regulations. Inserting such a reference would mean that this would have to be inserted at the end of each possible area of convergence.

17. The Representative of FICPI proposed replacing the words “*color photographs*” by “*color representations*”.

18. The Representative of INTA suggested replacing the words “color photographs” by “color graphic or photographic reproductions”.

Possible Areas of Convergence on the Views of Industrial Designs and on the Number of Copies of each Reproduction

19. The Delegation of Japan, noting that a minimum number of views was required in Japan, said that the Office required additional views where the application did not comply with the minimum, although it did not accept views reflecting new matter. The Delegation suggested amending the second line of the text so as to reflect that, under certain conditions, the applicant should be free to decide the number and types of views which are needed to fully disclose the industrial design.

20. The Delegation of Colombia stated that, while this possible area of convergence did not pose any problem from the point of view of the compatibility with Andean Community legislation, it favored a minimum number of views for three-dimensional designs.

21. The Delegation of Austria, indicating that Austrian legislation provided for a maximum number of 10 views, suggested adding the following words: “without prejudice to the fact that the office should be free to limit the number of published representations”.

22. The Delegation of Germany, observing that it should be possible for an applicant to disclose a design with 10 or 20 views, considered that a maximum number of views should be prescribed, in order to avoid problems with publication.

23. The Representative of FICPI said that it agreed with the text as set out in the document, and concurred with the Delegation of Japan in that any additional view requested by an office should not add new matter. The Representative said that a high maximum number of views would be acceptable to users, but that no minimum number should be required, insofar as many designs, including three-dimensional designs, could be adequately disclosed with one view.

24. The Delegation of the Russian Federation said that, while the national legislation did not restrict the number of views, superfluous representations were not published, in agreement with the applicant.

25. The Delegation of Spain, indicating that a maximum of seven views was accepted under national legislation and that no complaint had ever been filed in this regard, stated that it would be ready to accept a greater number of views, for the sake of reaching a consensus. The Delegation added that one copy of each view was required.

26. The Delegation of Argentina suggested that the document remain open for future comments by delegations.
27. The Delegation of the United States of America pointed out that under national legislation there was no minimum or maximum number of views, and that all views received were published without any further fee. However, where additional views containing new matter were submitted, those views were not accepted. The Delegation said that it considered the language of the text to be acceptable, but suggested that it include a reference to the concept of non acceptable new matter in the views.
28. The Delegation of Jordan indicated that it required at least three views for three-dimensional designs.
29. The Delegation of Australia stated that, while five copies of the reproduction of the industrial design were required under current legislation, it would not rule out any possible change in the future.
30. The Delegation of Canada, pointing out that one copy of each reproduction was required under national legislation, said that it had no objection to the text.
31. The Delegation of France, indicating that an application could contain an overall of 100 reproductions filed in two copies, expressed support for the text.
32. The Delegation of India, pointing out that four copies of each reproduction were required under national legislation, declared that the number could be brought down to three at the next amendment of legislation.
33. The Representative of INTA, considering that any view filed or used by the examiner for the purpose of examination should be published, expressed reservations with regard to the suggestion that offices would have latitude to decide whether or not to publish certain views. The Representative further considered that the issue of new matter should be addressed in the possible area of convergence.

Possible Area of Convergence on Specimens

34. The Delegation of the United States of America, while agreeing in principle to a possible area of convergence that would leave examiners the option to request specimens, expressed concern about the possibility of leaving that option to the applicant. Pointing out that it would not be feasible for its office to accept specimens, the Delegation expressed the view that digital reproduction had rendered specimens unnecessary.
35. The Delegation of Canada said that specimens were not accepted under national legislation and that it would not wish to open the door to that possibility.
36. The Delegations of India said that examiners should be in a position to request the furnishing of a specimen, but that this option should not be given to applicants.
37. The Delegation of Morocco declared that national law did not provide for the possibility of filing specimens.

38. The Delegation of Spain said that digital reproduction methods and e-filing had rendered specimens unnecessary.
39. The Delegation of the Russian Federation indicated that, while specimens were allowed for two-dimensional designs, it would be problematic to accept them for three-dimensional designs.
40. The Representative of FICPI, indicating that the requirement of specimens by certain offices entailed difficulties for applicants, expressed the view that offices should not be allowed to require specimens.
41. The Delegation of Sweden, replying to a question by the Representative of CEIPI, said that there was no indication that the textile industry was the main user of the possibility of presenting specimens. It further explained that, where the applicant chose to present a specimen, an extra fee to cover the cost for storing the specimen would have to be paid and an adequate reproduction of the design would nonetheless have to be presented. However, a filing date was granted upon receipt of a specimen only. Finally, the Delegation observed that the office never required an applicant to file a specimen.
42. The Delegation of Germany, specifying that specimens could only be filed in respect of two-dimensional designs and in case of deferment of publication, indicated that in nearly 100 percent of cases in which specimens were used, they were filed by the textile industry.

Possible Area of Convergence on Other Contents of the Application Generally Required

43. The Delegation of Japan, supported by the Delegation of Canada, observed that an indication of the class under the International Classification for Industrial Designs under the Locarno Agreement was not required by national legislation, and requested therefore that the last sentence of this possible area of convergence be deleted.
44. The Delegation of the United States of America supported the Delegation of Japan and suggested adding the words “or the protection” to item (i).
45. The Delegation of Spain, observing that the indication of the class was optional, said that the office did not encourage applicants to include it, in order to avoid classification errors.
46. The Delegation of Brazil said that the office attributed the class of the design, in order to prevent mistakes.
47. The Delegation of Slovenia noted that the indication of the class by the applicant, while mandatory, gave rise to many errors, and that the office preferred to do it jointly with the applicant. The Delegation suggested that the classification should be done either by the office or in consultation with the applicant.
48. The Representative of FICPI, observing that there was no convergence as to the effect of the indication or classification of the product, expressed the view that this fact should be mentioned in the document.

Possible Area of Convergence on Other Contents of the Application Required in Certain Jurisdictions

49. The Delegation of Japan indicated that it had no problem with the text. It noted that, while not a mandatory element of the application, a description played an important role when determining the scope of protection of the design.

50. The Delegation of the United States of America proposed to limit this area of convergence to a description, and expressed concern about the proposal that neither a claim nor the identity of the creator should constitute a filing date requirement.

51. The Delegation of Brazil indicated that a claim and a description, but not a statement of novelty were mandatory under national legislation.

Possible Area of Convergence on the Filing of the Application in the Name of the Creator

52. In reply to a request for clarification by the Representative of FICPI, the Secretariat explained that the possible area of convergence aimed at avoiding the need to supplement the application with transfer documents, and suggested that it would be sufficient for the applicant to declare, in the application, that the design had been assigned by the creator, as identified in the application.

Possible Area of Convergence on Unity of Design or Unity of Invention

53. The Delegation of India said that Indian legislation did not provide for multiple applications and that the possibility of allowing them was not considered.

Possible Area of Convergence on Multiple Applications

54. The Delegation of Canada, noting that Canadian legislation did not allow multiple applications, declared that it could not support this possible area of convergence.

55. The Delegation of the Russian Federation declared that it had no objection to the text proposed.

Possible Area of Convergence on the Definition of Filing Date Requirements

56. The Delegations of Austria and Japan stated that payment of the fee should not constitute a filing date requirement.

57. The Delegation of Japan further indicated that, in order to obtain a filing date, an application had to be filed in Japanese by a representative with an address in Japan.

58. The Delegation of the United States of America proposed to amend the fourth line of the text to include a reference to the protection of an industrial design. The Delegation also declared that the text did not reflect a possible area of convergence, as in the United States of America only a clear reproduction and a claim were required to obtain a filing date.
59. The Delegation of Sweden expressed support for the declaration of the Delegation of the United States of America.
60. The Delegation of India, indicating that a fee and a claim were required to obtain a filing date in India, concurred with the declaration made by Delegation of the United States of America.
61. The Delegation of Germany said that the indication of the product constituted a filing date requirement in its country.
62. The Delegation of France said that a justification of the payment of the filing fee was mandatory to obtain a filing date.
63. The Delegation of Spain declared that only the first three elements set out in the text were required to obtain a filing date.
64. The Delegation of Canada said that it would not be in favor of including the fee as a filing date requirement.
65. The Delegation of the Russian Federation observed that the requirements for obtaining a filing date in Russia were very stringent, but that national legislation was currently under revision, which might result in a loosening of those requirements. Expressing the view that a description and the fee should not be a filing date requirement, the Delegation declared that, although the text did not fully reflect the Russian system, it was happy with it to a certain extent.
66. The Delegation of Kenya said that the indication of the product and the payment of the fee were filing date requirements.
67. The Delegation of the United Kingdom, noting that United Kingdom legislation did not provide for specific filing date requirements, expressed the view that it would be difficult to reach a minimum level of agreement in this area.
68. The Delegation of Uruguay said that the identification of the applicant and a graphic or photographic representation were the minimum requirements to obtain a filing date.

Possible Area of Convergence on Deferment of Publication and Secret Design

69. The Delegation of Colombia declared that it could not support this possible area of convergence, as Andean legislation did not provide for deferment of publication.
70. The Delegation of Slovenia stated that the use of deferment of publication was not frequent.

71. The Delegation of India, noting that there were no provisions concerning deferment of publication in India, said that it could not support this possible area of convergence.
72. The Delegation of Australia stated that the proposed text seemed acceptable, but that it would prefer replacing the words “filing date” by “priority date”.
73. The Delegation of the United States of America indicated that designs were published when protection was issued and that there was no possibility of requesting deferment of publication. The Delegation said that, in practice, designs remained unpublished for six months or more, as the pendency period was currently of 14 months. However, expedited examination could be requested, which could mean that the design patent could issue and be published almost in six months or in less than six months in certain circumstances. Consequently, the Delegation proposed adding the following words at the end of the text: “provided that the application has not been yet examined and that the grant of protection has not been awarded”.
74. The Delegation of the Russian Federation, indicating that there was no deferment of publication as such in the Russian Federation, stated that it could not support the text.
75. The Delegation of Singapore said that, while the national legislation did not provide for deferment of publication, it did not oppose to the text as it was drafted widely and did not impose any requirement.
76. The Delegation of Canada declared that it could not support the text, and suggested adding “where provided by the legislation of a country”.
77. In reply to a question by the Delegation of Canada concerning the practical use of deferment, the Representative of FICPI explained that deferment of publication enabled the applicant to control the first release of the design. The Representative further observed that the rights of the applicant were limited before publication. Finally, with respect to the wording proposed by the Delegation of the United States of America, the Representative expressed doubts as to whether it would work in respect of those systems in which registration had been completed.
78. The Chair suggested dividing the possible area of convergence into two paragraphs, the text as it stood in respect of non examination systems and the text proposed by the Delegation of the United States of America in respect of examination systems.

Possible Area of Convergence on Grace Period in the Event of Disclosure

79. The Delegation of Japan, supported by the Delegations of Belarus, India, Indonesia, Malaysia, Morocco and Uruguay, suggested replacing the period of 12 months by a period of six months, so that more jurisdictions would be able to comply with the area of convergence.
80. The Delegation of Australia observed that Australia did not provide for a grace period as such, and that disclosure within a period exceeding six months prior to the date of filing would amount to prior art and invalidate the design.

81. The Delegation of the Russian Federation, supporting the proposal by the Delegation of Japan, noted that Russian legislation for industrial designs was the same as for patents and, as a result, amending the grace period with regard to industrial designs only would result in an awkward situation, with different periods for each category of rights.

82. The Delegation of Colombia declared that it could support the text, but requested that the term “originality” be removed, as it considered that it referred to the field of copyright.

83. The Delegation of the United States of America concurred with the Delegation of the Russian Federation in that, at the national level, changing the grace period with regard to patent designs would require changing it also for utility patents, as the legislation was very much the same for both types of rights. The Delegation indicated that the grace period in its country was 12 months, and that there was no interest on the part of industry to have it changed. It also suggested that the text be amended to read “that at least any disclosure made by the creator and any disclosure of the creator’s design by his or her successor in title or another within 12 months prior to the date of filing should be without prejudice to the novelty/originality of the industrial design”.

84. The Delegations of Mexico and Sweden pointed out that the grace period in their respective jurisdictions was 12 months.

85. The Delegation of Mexico further expressed support for the amendment proposed by the Delegation of the United States of America.

86. The Chair proposed replacing the words “six months” in the text by “at least six months”.

87. The Representative of FICPI, referring to the proposal by the Delegation of the Colombia, suggested replacing “novelty/originality” by “protectability”.

88. The Delegation of India suggested keeping only “novelty”.

89. The Delegation of Uruguay expressed its support to the proposals concerning a period of “at least six months” and the removal of the term “originality”.

90. The Delegation of the United States of America was in agreement with the proposal to remove the term “originality,” and requested time to consider the proposal concerning a period of “at least six months”.

91. The Delegation of Norway said that, although it had a grace period of 12 months, it supported the proposal for a period of “at least six months”. Moreover, it said that it wished to retain the word “novelty”.

92. The Delegation of Kenya said that it supported a grace period of six months, as well as maintaining the rest of the text as it stood, given that the use of a slash between the words “novelty” and “originality” allowed for the use of whichever term applicable.

93. The Delegation of the Russian Federation endorsed the proposals for a period of “at least six months” and for using the term “protectability”.

94. The Delegation of Germany, supported by the Delegation of Austria, indicated that the grace period in its country was 12 months and suggested using the following terms: “novelty and/or originality”.
95. The Delegation of Brazil pointed out that the grace period in Brazil was six months, and that both novelty and originality were required.
96. The Delegation of Serbia expressed support for a period of 12 months and for retaining only the term “novelty”.
97. The Delegation of Australia suggested retaining only the term “novelty” or any other term including that concept.
98. The Representative of FICPI observed that there seemed to be agreement in that the idea of a grace period was that the early disclosure did not count as prior art against a later filing, whether the criteria for protectability was novelty, originality, a combination or something else. He therefore suggested the following rewording of the text: “any disclosure of the design made by the creator and/or his successor in title should not be relevant as prior art against a filing made within at least six months of that disclosure”.
99. The Delegation of Singapore, pointing out that national legislation did not provide for a grace period, suggested inserting the words “where available” after “with regard to a grace period in the event of disclosure”.
100. The Delegation of the United States of America, observing that there seemed to be three different regimes regarding grace period and that the debate over the issue had been going on for many years, said that it did not feel comfortable with the proposal of inserting a period of “at least six months”. It further indicated that, although it could accept language suggesting that the period of grace would be decided under national law, without any reference to a given period, it would prefer that the document did not address the issue.
101. The Delegation of the Russian Federation stated that it did not object to the proposal by FICPI.
102. The Delegations of Colombia and Uruguay requested more time to hold consultations on this issue.
103. The Chair noted that, while there was no agreement on the duration of a grace period, there seemed to be agreement on the principle that a grace period was desirable for a reasonable period. He thus suggested that the text be revised to reflect that general agreement. In addition, he suggested replacing the words “without prejudice to the novelty/originality” by “without prejudice to the novelty and/or originality, as the case may be”.

Unregistered Design

104. The Representative of the European Community indicated that the subject of unregistered designs should be seen as an item of information which provided some context to some of the other issues under discussion.

105. The Delegation of the United States of America said that, with respect to the Vessel Hull Design Protection Act, the protection afforded under this Act was more akin to copyright.

106. The Delegation of Serbia observed that there was no unregistered design system in its country, but that the shape of goods was protected through unfair competition law.

107. The Chair added that unregistered designs were protected under unfair competition law in the Republic of Korea.

Possible Area of Convergence on Term of Protection

108. The Delegation of Japan, explaining that in Japan the initial payment period was one year and that applicants could thereafter choose the payment periods, up to 20 years, suggested that the issue of period of protection be left to national legislation.

109. The Delegation of Australia expressed support for this possible area of convergence.

110. The Delegation of the Russian Federation said that, while a design was initially protected in its country for 15 years, a maintenance fee had to be paid every year, which struck a balance between the right of the patent holder and the interest of third parties. The Delegation declared that, as a result, it could not support the proposal.

111. The Delegation of Uruguay said that industrial designs were registered for an initial 10-year term from the date of filing, and could be renewed for five more years.

112. The Delegation of Colombia, pointing out that industrial designs were registered for a single 10-year period, declared that it could not support the proposed possible area of convergence.

113. The Delegation of the United States of America stated that it could not support the text, as industrial designs were granted in the United States of America for a non-renewable period of 14 years.

114. The Delegation of Norway said that the text was compatible with Norwegian legislation.

115. The Delegation of India suggested amending the third line so as to reflect that the initial term should be at least five years.

116. The Delegation of Canada expressed support for the text as it stood.

117. The Delegation of Belarus noted that, while industrial designs were registered for an initial 10-year term, maintenance fees had to be paid every year.

118. The Delegation of Australia indicated that it did not favor the possibility of renewing every year, as it would be an administrative burden on the office.

119. The Delegation Mexico suggested replacing the word “should” by “could” and the words “additional five-year terms” by “partial periods.”

120. The Delegation of the United States of America, explaining that the examination cost for a design patent was fully recovered with the filing fee, said that adding renewal fees would simply add to the cost of the design patent.

121. The Representative of FICPI said that, although applicants would prefer to have a long term of protection with no maintenance fees, such fees existed to strike a balance between the rights of the proprietor and of third parties, in that designs no longer required by the holder would not be renewed and would be subject to be used by third parties.

122. The Delegation of the Russian Federation, supported by the Delegations of Germany and the United States of America, expressed the view that the text of this possible area of convergence should not be maintained.

Possible Area of Convergence on Communications

123. The Delegation of El Salvador said that national legislation required certification or authentication of documents for industrial designs.

124. The Delegation of Colombia indicated that documents had to be signed and certified.

125. The Delegation of Australia confirmed that no certification was required.

126. The Delegation of Brazil, pointing out that Brazilian legislation required authentication under certain circumstances, expressed the view that the text might be too radical.

127. The Delegations of Belarus, Canada, Norway, Spain and the United Kingdom expressed their support to the text as it stood.

Possible Area of Convergence on Relief Measures

128. The Delegation of the United Kingdom suggested amending the text so as to make it clear that at least one of the three relief measures mentioned should be provided.

129. The Representative of FICPI, recalling the analogy between designs and patents as regards the requirement of novelty and the impossibility of re-filing 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.

130. The Chair observed that the approach taken by the PLT was provided for as an alternative in the text of this possible area of convergence.

131. The Delegation of Chile, observing that Chilean legislation did not provide for any relief measure, stated that it did not support such measures, as they could lead to an unnecessary extension of the procedures.

132. The Delegation of Serbia pointed out that, under national legislation, reinstatement of rights could be applied only in case of rejection of the application.

133. The Delegations of Canada, Italy, Kenya and Norway expressed support for the text as it stood.

134. The Delegation of Colombia said that, under Andean Community legislation, a relief measure could neither be automatic nor apply after the expiry of the time limit. Moreover, it could only apply in certain, specific cases.

135. The Delegation of Germany declared that it supported the second alternative, subject to certain exceptions.

136. The Representative of the European Community, observing that only one of the two alternatives suited European Community legislation, suggested keeping both alternatives instead of making a divisive choice at this stage.

137. The Delegations of Chile and Uruguay indicated that they could not support the text as it stood.

138. The Chair, taking note of the fact that certain delegations could not support the text as it stood, noted that the SCT agreed to maintain the topic for discussion, while indicating that it was not a possible area of convergence at this stage.

139. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-first session of the SCT. The Secretariat was requested to prepare a revised working document on possible areas of convergence on industrial design law and practice in SCT Members to be considered by the SCT at its twenty-second session. This document should indicate the changes suggested during the twenty-first session of the SCT and contain a summary of the comments made by delegations at that session. The preparation of this revised working document will be without prejudice to the position delegations may have with regard to any possible area of convergence on industrial design law and practice.

Relationship Between Industrial Designs and Other Rights

140. The Chair noted that there were not comments on this topic.

Priority Document Access Service

141. The Secretariat presented the “Digital Access Service for Priority Documents” administered by the International Bureau of WIPO.

142. The Delegation of Japan said that its office needed to reflect on the possibility of extending the electronic exchange of priority documents to the field of designs, from a cost-effectiveness perspective.

143. The Delegation of the United States of America, pointing out that design applicants in the United States of America were very interested in this service, proposed that a paper be prepared by the Secretariat, for discussion at the next meeting, containing more detailed information on the system.

144. The Representative of INTA suggested that the paper proposed by the Delegation of the United States of America include also a study on a possible extension of the service to priority documents for trademarks.

145. The Chair noted that the SCT requested the Secretariat to prepare a working document, for consideration at its twenty-second session, examining the possible extension of the WIPO Digital Access Service for Priority Documents “DAS” to priority documents for industrial designs and for trademarks.

Agenda Item 6: Trademarks

Grounds for Refusal of all Types of Marks

146. The discussion was based on document SCT/21/2.

147. The Delegation of Colombia expressed the view that the document should remain general in nature and indicated that it had not any particular comment.

148. The Delegation of the United States of America indicated that its office received a large number of requests for training in trademark examination. Against this background, it pointed at the importance of sharing information on the topic under consideration. The Delegation further said that it would be useful if that work could go into more depth, in particular as far as the determination of specific grounds of refusal and the way in which they were applied was concerned. That work could start at a general level and, based on further submissions, could become more and more specific. Ideally, this would lead to the compilation of a new document for further discussion, which could eventually constitute a body of reference.

149. The Delegations of Australia, Mexico, Serbia and Slovenia supported the statement made by the Delegation of the United States of America.

150. The Delegation of Japan stated that it expected to learn from the discussion, to get a deep understanding of the grounds for refusal that were discussed by the Committee and, hopefully, to reach a non-binding guideline. The Delegation felt that it was difficult to make a binding agreement on that subject for the following reasons. Firstly, this topic covered very broad issues. Some grounds listed in the working document were not found in the Trademark Law of Japan, as for example, functionality, conflicts with copyright or other industrial property rights, which were not grounds for refusal in Japan. Secondly, grounds for refusal were critically important issues for most States and should be considered in a careful manner from the point of public interest. Lastly, if the purpose of this meeting was to achieve a non binding guideline, more contributions from various States could be expected.

151. The Delegation of Hungary said that it was in favor of a detailed discussion on absolute grounds for refusal. It considered that it would be useful to point out the particular grounds for refusal, in particular bad faith and deceptiveness, and to discuss them in depth.

152. The Delegation of Slovenia noted that in paragraph 9(2) of the French version of document SCT/21/2, the words “dépourvue de tout caractère” should be omitted.

153. The Delegation of Mexico asked for the same precision to be done in the Spanish version of document SCT/21/2, so that paragraph 9(2) of the Spanish version would read “sea descriptiva”.

GROUND FOR REFUSAL

(a) Signs not constituting a trademark

154. The Delegation of Australia declared that according to national legislation the definition of “sign” was an open or inclusive definition and was therefore understood to include any means of distinguishing the goods or services of one person from those of another as long as it was capable of being perceived by the senses. It further noted that the task of the Office was to provide for the registration of anything that could operate in the market place as a trademark.

155. The Delegation of Chile asked the SCT Members to share their practice concerning the registration of a single color and combinations of colors. The Delegation noted that, according to its legislation, only combination of colors were registrable. Moreover, a simple combination of two colors was not registrable if it did not have a specific shape.

156. The Delegation of Uruguay indicated that according to national legislation a single color could not be registered as trademark, but a combination of colors could be protected. The Delegation explained that a single color without any additional element cannot be used as a trademark, regardless of whether it is used on a product, a container or its packaging.

157. The Delegation of Australia expressed the view that, theoretically, any color could be registered, as national legislation relating to trademarks was not restrictive. However, one single color would be difficult to register, unless the applicant could show that the sign had acquired distinctiveness.

158. The Delegation of Malaysia stated that national law did not accept a single color to be registered as trademark, but color marks were accepted for registration.

159. The Delegation of Serbia pointed out that, according to national legislation, a single color would be registered only in case of proved acquired distinctiveness.

160. The Delegation of El Salvador indicated that national legislation prohibited registration of signs comprised of one color. Nevertheless, isolated colors which contained a certain geometrical form would fulfill the registrability criteria.

161. The Representative of the European Community said that, according to the practice of the Office for Harmonization in the Internal Market (Trademarks and Designs) (OHIM), the registration of one single color as a trademark would generally be refused. Nevertheless, in two cases a single color could be registered: namely if either the particular color was unusual in the context in which was used, or acquired distinctiveness was shown.

162. The Delegation of the United States of America declared that for registration of colors *per se* two different analyses were made. The first test was referring to the distinctiveness of the sign and, according to United States case law, a color *per se* was never considered

inherently distinctive. Nevertheless, a color could function as a mark if used and promoted in a manner of a trademark, and when perceived by the public as a trademark. The second test was referring to the functionality of the sign. A color could acquire distinctiveness, but also could be functional and, therefore, not be registrable. This was found, for example, in the case of the color orange applied for registration in respect of safety suits.

163. The Delegation of Singapore stated that in Singapore a trademark consisting of a single color *per se* was generally not considered to be inherently distinctive. Evidence of pre-filing acquired distinctiveness needed to be lodged to overcome an objection based on such a ground. The public policy reason for not registering such marks *prima facie* was to not unduly restrict the availability of colors for other traders who offered goods and services of the same type as those in respect of which registration was sought. Furthermore, the Delegation added that a combination of two or more colors might be registrable *prima facie* depending on how unusual the color combination was in relation to the goods and whether the combination was likely to strike the relevant consumer as an indication of trade source. This would also involve a consideration of whether the colors served a function or were common in the market place or relevant trade.

164. The Delegation of the United Kingdom referred to case law concerning the concept of what could be considered to constitute a sign functioning as a trademark. Complete songs or entire books, strings of 25 letters could actually constitute a sign, as they could be perceived by the senses, but the question was if they possessed the qualities of a sign functioning as a mark. The Delegation further said that if the United Kingdom Registry felt that a particular “sign” was simply incapable of performing the function of a trademark under any circumstances, for any goods or service, as it might be the case, for example, for a complete song or a whole film, the UK Registry would be unlikely to accept that such complex media would have the required impact to function as a trademark.

165. The Delegation of Spain commented that according to national legislation the requirement for signs to be represented graphically was not fulfilled for olfactory marks, but sounds could be registered as they could be represented by musical notes.

166. The Delegation of the United States of America said that, from its perspective, there were two different determinations to be made: first, what was eligible subject matter, and according to its national law the answer was – any sign; and second, did it function as a trademark, that was to say if the sign was used as a mark and if was perceived by the consumer as a mark. If the sign met both of those tests, then it did function as a trademark. Matters like informational slogans, colors, background designs, shapes, generally were not perceived as marks, but if used in a trademark manner, and provided they were as such perceived by public, they could function as marks.

167. The Delegation of Sweden stated that, under national law, a sign had to have trademark character in order to function as a trademark. This definition was not static. For example, in the 1960ies, a shop decoration was not considered to be a trademark. However, more recent case law admitted, for example, the registration of barrels as trademarks. In essence, the test which applied today was to determine whether the sign was capable of graphic representation, was distinctive and was non – functional.

168. The Delegation of Brazil stated that, according to national law, any distinctive and visually perceptible sign, if not prohibited by law, was eligible for registration as a mark. Furthermore, the law established the list of signs which should not be registrable as marks.

(b) Lack of distinctiveness

169. The Delegation of Mexico explained that according to national law, signs devoid of any distinctive character were not registrable as marks and this ground for refusal could not be overcome by the proof of acquired distinctiveness, for example an entire phrase could not be registered as trademark, even if it was used and always was associated with the producer or holder of the mark.

170. The Delegation of Australia stated that trademarks which lacked distinctiveness, for example, single colors, were nonetheless potentially registrable under Australian legislation. Even trademarks with no inherent adaptation to distinguish might be registered if it could be demonstrated via evidence of use that they were distinctive in fact at the time of filing the application for registration.

171. The Delegation of India said that, under national legislation, signs that were not inherently distinctive could be registered upon a showing of acquired distinctiveness.

(c) Descriptiveness

172. The Delegation of Uruguay reiterated that signs that were descriptive, but had acquired distinctiveness or secondary meaning, could be registered as trademarks.

173. The Delegation of Spain said that trademarks consisting of abbreviations if composed of terms which on their own were purely descriptive and commonly used, as for example, TV applied for TV sets, could not be registered.

174. The Delegation of Mexico declared that with regard to the general aspects of descriptiveness, the Office did register marks that had a descriptive element, but only when accompanied by distinctive words. However, when granting the registration, no distinction was made between the distinctive and descriptive elements. The Office granted the registration of the mark just because of the presence of the distinctive word. A disclaimer, moreover, would enable to distinguish the part of the sign which was protectable and the part of the sign which was not.

175. The Delegation of Serbia supported the view that objections on grounds of descriptiveness and genericness might also give rise to an objection on the ground of lack of distinctiveness.

176. The Delegation of Hungary pointed out that it was not possible to use a disclaimer for a trademark which consisted of a purely descriptive term. However, if the mark consisted of a descriptive and a distinctive element, the scope of protection was limited to the distinctive part.

177. The Delegation of Spain indicated that it did contemplate the introduction of the use of disclaimers for non-protectable elements of the mark.

178. The Delegation of Croatia said that its Office encountered some difficulties assessing non-distinctiveness and the descriptiveness of the sign. As requests for registration originating from many countries were filed with the Office, the descriptiveness of the sign in its original language could have a decisive meaning in Croatia. Furthermore, a sign could be considered descriptive for some of the goods and services and not descriptive for other products.

179. The Delegations of Brazil, Kenya and Uruguay all indicated that, in cases in which a mark contained a non-distinctive element, the Office granted the mark applying a disclaimer for that element.

180. The Delegation of Australia explained that its Office did not apply disclaimers on non-distinctive, descriptive or generic elements of the trademark. It simply would presume that the holder would not have exclusive rights for those elements.

181. The Delegation of the Russian Federation stated that a mark would be refused registration if it consisted of matter which, when used on or in connection with the goods of the applicant, was descriptive. However, for other goods these terms could be registered. For example, “ampère” could not be registered for electric devices, but could be registered for perfume. The Delegation further said that State symbols, incorporated into trademarks could be registered under a disclaimer. Registration, however, was subject to the authorization by the competent authorities.

182. The Delegation of Malaysia said that the national Office allowed disclaimers in order to facilitate registration in cases of trademarks containing non-distinctive and descriptive signs.

183. The Delegation of Mexico explained that, according to national legislation, trademarks which contained or consisted of descriptive terms concerning the geographical origin of goods and services that were misleading could not be protected.

184. The Delegation of the United States of America stated that under national law, the test for determining whether a mark was geographically deceptive was whether: (1) the primary significance of the mark was a generally known geographic location; (2) the goods and/or services did not originate in the place identified in the mark; (3) purchasers would be likely to believe that the goods and/or services originated in the geographic place identified in the mark; and (4), the misrepresentation was a material factor in the consumers decision to buy the goods and/or use the services. For example, if geographic matter in a proposed mark identified a specific good and/or service to US consumers with a particular quality, reputation or other characteristic and it was a material element to the purchasing decision that the goods and/or services have that quality, reputation or other characteristics attributable to the origin of the goods and/or services, and the goods and/or services did not originate from the place identified in the proposed mark, a geographically deceptive refusal under this provision might be appropriate. If a mark was misdescriptive and prospective purchasers were likely to believe the misdescription, but the misdescription would not lead consumers to purchase the goods and/or services, the mark was misdescriptive but not deceptive. Unlike deceptive marks, misdescriptive marks might be registered because the misdescriptive matter was not salient to the purchasing decision. If the applicant could show that the mark had acquired distinctiveness, it could be registered on the Principal Register.

185. The Delegation of the United Kingdom, in a response to the Delegation of Mexico concerning the probability of registering a particular future year for wines or other goods that could have a particular link with that year, pointed out that when examining signs capable to designate some characteristics, the applications were considered also in the context of the marketplace as it might be in the future.

(d) Genericness

186. The Delegation of Croatia indicated that its Office refused to register as trademarks signs, which, although they were invented words, had become generic for certain goods or services.

187. The Delegation of Mexico confirmed a practice that was similar to that pointed out by the Delegation of Croatia, and gave some examples of marks which were refused registration due to the fact that those terms became generic for the goods concerned.

(e) Functionality

188. The Delegation of Cuba recalled that the issue of functionality might arise in relation to color *per se* and asked other delegations to give examples of trademarks which consisted of a single color and were refused on the basis of functionality.

189. The Delegation of Australia cited as an example for a functional color the color red for fire extinguishers.

190. The Delegation of the United States of America referred to a case in which the color red for training hand guns was refused, as this color was chosen in order to signal that the hand guns were training devices. Another example concerned the color black for outboard boat motors, since this was a very common color in the commercial field concerned, as it could be easily matched with any boat hull color.

191. The Delegation of Canada cited as an example for a functional color the color purple for asthma inhalers, because, in the pharmaceutical field, the color purple was generally understood to signal daily application.

192. The Delegation of Belarus stated that, according to national legislation, a sign which was generic, functional or descriptive could be registered upon a showing of acquired distinctiveness.

193. The Delegation of Australia said that, from an Australian perspective, any sign that was operating as a trademark and had become distinctive should be recognized and registered as a trademark. In relation to the question of functionality, if the sign was totally functional it would attract strong objections, but if it had some element of functionality it might be still registrable because of the other elements of the mark.

194. The Delegation of Japan recalled that national legislation did not contemplate functionality as a ground for refusal, except the case of signs which consisted exclusively of the shape which was necessary to obtain a technical result.

195. The Delegation of the United Kingdom explained that a sign which consisted exclusively of the shape of goods which was necessary to obtain a technical result would be refused from registration.

196. The Delegation of the United States of America expressed the view that the issue of distinctiveness was entirely separated from the issue of functionality. Perhaps the shape could be distinctive and the consumer perceived this particular shape as a mark, but if the shape had a utilitarian character, it could not be monopolized. However, the applicant might have the choice to patent those particular functional features.

(f) Public order and morality

197. The Delegation of Mexico pointed out that public order and morality was a subjective issue and was depending on national laws and remained applicable according to the social, political or religious circumstances of each country.

198. The Delegation of Serbia recalled that this particular ground for refusal should be examined in relation to the nature of the goods or services on which the trademark would be used. For instance, signs that would contain religious matter would be assessed in a different way in connection with charity services than in relation to goods such as alcohol and tobacco.

199. The Delegation of Singapore declared that national law was very cautious in not allowing the registration of trademarks containing ethnic, racial or religious disparagement.

200. The Delegation of Hungary declared that, according to national legislation, this ground for refusal could apply in relation to three different categories of signs, such as religious symbols, signs contrary to accepted principles of morality, and signs the registration of which was against the public order and was prohibited by special laws.

(g) Deceptiveness

201. The Delegation of El Salvador asked the Members of the SCT to share their experience in relation to signs which were geographically deceptive, in particular, the criteria used for determining that those signs were deceptive. Furthermore, the Delegation asked how deceptiveness was determined, as deception could arise in regard to character of the goods or services including their composition, nature or other properties.

202. The Delegation of Mexico stated that the Office did not question the product as such. It simply denied the registration of a trademark when it was obvious from the information contained in the application that the trademark would be deceptive in relation to the goods or services concerned.

203. The Delegation of Spain indicated that in cases of certain indications contained in the trademark, for instance, "EKO" or "BIO" the applicant was asked to limit the list of goods to goods produced in line with those specific legal regulations on ecological agriculture and production.

204. The Representative of the European Community said that the approach on the issue of deceptiveness was to start from the presumption that the applicant was acting in good faith. If it was clear from the facts that it was not the case, the trademark registration would be refused. For instance, if somebody applied for a distinctive trademark which included the word "leather shoes" and the registration was sought for plastic shoes, the trademark would be refused.

205. The Delegation of Hungary declared that the most difficult cases of trademark refusal in its Office were based on deceptiveness as to geographical origin of the goods and services. Even if the Office assumed that the applicant was acting in good faith, it carried out an examination, in particular, using different references and facts from the file. Information indicating whether the sign made reference to a particular geographical place, goods and service claimed in the application and, also, information regarding the residence of the applicant might be useful. Another important aspect was that the Office carried out the same examination with regard to a geographical term in cases of a trademark assignment or transfer.

206. The Delegation of Singapore stated that a deceptiveness objection in Singapore would be raised if, because of some connotation or sign contained in the mark, the use of the trademark in relation to the goods or services claimed in the application would be likely to deceive the public. Considerations under this item related to the matter within the trademark that could deceive the relevant buying public. The deception could arise with regard to, for example, a characteristic of the goods or services such as their composition, nature or other properties; the quality or quantity of the goods or services; the geographical origin of the goods or services; the intended use or purpose of the goods or services. An objection might be raised under this item even if the mark did not consist exclusively of the deceptive element. In deciding whether a deceptiveness objection should be raised, the following was considered. (1) Was there a false implication? A trademark might be deceptive if it included a word or sign which was descriptive of any of the characteristics of the goods or services but the characteristic was not in fact present. (2) Were prospective purchasers likely to believe in the false statement? There must be a real potential of the buying public being deceived by the misrepresentation.

207. The Delegation of Singapore continued saying that there were a number of factors to be taken into consideration when assessing whether the use of a trademark was likely to be deceptive in respect of goods. These included the nature of the goods, the nature of the ordinary persons purchasing the goods and the likely nature of the transaction. Referring to the nature of the goods it should be determined if the goods were readily inspectable. If they were, then this lessened the likelihood of deception occurring. It should be established also if the goods were of an immediately apparent composition. If they were, then this also lessened the likelihood of deception. Furthermore, it should be determined if the goods were very cheap and therefore likely to be casually inspected prior to purchase or if they were expensive and hence carefully inspected prior to purchase. Referring to the nature of the ordinary persons purchasing the goods it should be determined if they were persons with some special training, such as doctors, engineers or scientists and if they were likely to be some social group. For example, children would have limited consumer education in respect of some goods and/or services (e.g. financial services) but not in others, such as electronic games and other playthings where they might have very specific knowledge of products. It was also important to establish the likely nature of the transaction. For example, some transactions might offer less opportunity to inspect goods, e.g. mail-order or telephone-order.

(h) Specially protected emblems and symbols

208. The Delegation of Hungary referred to the use of the word “Olympic” and attempts to register it as a trademark. However no problems were identified with the Olympic symbol, which enjoyed special protection under the Nairobi Treaty on the Protection of the Olympic Symbol, of September 26, 1981.

209. The Delegation of the Russian Federation pointed out that a special legislation was enacted in the Russian Federation regarding the protection of the Olympic symbol, which included also a list of designations related to the Olympic symbol. Those provisions prohibited the registration of the Olympic symbol and all designations included in the list, without authorization of respective authorities. Moreover, signs which could be associated with the Olympic symbol and those designations would be refused registrations as trademarks. Where there was no likelihood of confusion or association between an applied trademark and the Olympic symbol, the trademark could be protected.

210. The Delegation of United Kingdom confirmed that in its country a similar piece of legislation was enacted, prohibiting the registration of Olympic symbol and other signs related to the Olympic Games.

(i) Geographical indications

211. The Delegation of Japan indicated that according to national law the registration of a trademark which contained or consisted of a geographical indication might be refused with respect to goods not originating in the territory indicated, if use of that designation for such goods was of such a nature as to mislead the public as to the true place of origin. Also, additional protection for geographical indications identifying wines and spirits, as stipulated in the Article 23 of the TRIPS Agreement, was provided by national law.

212. The Delegation of Germany expressed the view that trademarks which consisted exclusively of geographical indications would be refused from registration. However, if there were other distinctive elements of the mark, the trademark could be registered.

213. The Delegation of the Russian Federation pointed out that a trademark, which contained an appellation of origin, could be registered if certain conditions were respected. Firstly, the applicant must have the right to use the respective appellation of origin. Secondly, the trademark itself must be claimed for those products for which the appellation of origin was protected in the Russian Federation. The national legislation of the Russian Federation permitted the registration of trademarks that were not deceptive or false, that was to say that the applicant was indeed located in the place of the respective appellation of origin and the products were limited to the respective goods. However, the designation itself of the appellation of origin would be disclaimed in order to exclude a monopoly right over that name.

214. The Delegation of Malaysia recalled that national legislation prohibited the registration of a trademark which contained or consisted of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods was of such a nature as to mislead the public as to the true place of origin.

215. The Delegation of Spain said that national legislation contained special provisions for the protection of appellations of origin for food, wine and spirits. The registration of trademarks would be possible if the applicant would provide the authorization from the authority governing the respective appellation of origin.

216. The Delegation of Mexico indicated that according to national legislation a trademark which contained a geographical indication would be denied from registration if it was misleading. The protection would be limited for goods produced in the area of the concerned geographical indication.

217. The Delegation of Uruguay declared that besides the prohibition of registration for misleading trademarks which contained or consisted of a geographical indication with respect to goods not originating in the territory indicated, the protection of geographical indications was also available for those geographical indications recognized by bilateral treaties which Uruguay signed with different countries.

(k) Shapes

218. The Delegation of Australia stated that, regarding functional shapes, it could be difficult to prove acquired distinctiveness of such shapes, but this was not necessarily impossible.

219. The Delegation of Mexico expressed the view that for signs consisting exclusively of shapes, two situations had to be distinguished. First one referred to three-dimensional trademarks which constituted the product itself, for example, a bottle or packaging, and the trademark was claimed for recipients and bottles. In that particular case it was clear that the shape had a direct link with the product claimed, and therefore the trademark would be rejected. The second case referred to the trademarks claimed for other products, like for alcoholic beverages. In that particular case, the shape was no longer considered functional and the protection for the trademark could be granted, if the shape was distinctive and no similar shape was registered before.

(l) Bad faith

220. The Delegation of Hungary pointed out that this particular ground for refusal was very complicated and asked the SCT to share its experience with regard to that issue. The Delegation further said that bad faith was introduced into Hungarian Trademark Law as a ground for refusal. Accordingly, a sign could not be granted trademark protection, if its registration was applied for in bad faith. As trademark applications filed in bad faith constituted an absolute ground for refusal, the Office carried out an *ex officio* substantial examination also with regard to that particular ground for refusal. Generally, the Office needed further information in order to be able to determine whether the application was filed in bad faith. That was the reason why in most of the cases bad faith trademark applications were only detected and refused after an observation was filed by a third party. Any person could submit an observation without the necessity to prove a legal interest in the case. Furthermore, if a sign was registered in spite of the malicious intent of the trademark applicant, a cancellation could still be submitted on that ground by any person.

221. The Delegation of Serbia supported the view that bad faith was a complicated issue and recalled that the Office was authorized to examine the trademark but was not in position to appreciate the good or bad faith of the trademark applicant. Bad faith was not listed as a ground for refusal in the Serbian Trademark Law. The Office had just the capacity to stop the proceeding in cases when an action regarding the bad faith of the applicant had been brought in Court. Depending on the decision of the Court, the Office would act respectively.

222. The Delegation of Australia said that the Trademark Act allowed for the removal of a registered trademark on the basis that, at the date of application, there was no intention in good faith to use, authorize the use or to assign the trademark. Bad faith was considered to be the opposite of good faith and the intentional dishonesty of use or representation was considered to be an essential compound of it. Given the gravity of the ground, it was considered more properly assessed in the opposition context, which enabled both parties to argue the case.

223. The Delegation of Spain indicated that according to national law, a ruling of a court was necessary in order to deny a registration of a trademark on the ground that it was applied in bad faith.

224. The Delegation of El Salvador declared that in its legislation bad faith was not deemed to be a ground for refusal. The law said explicitly that if the application was made in view of perturbation of the fair competition, this could be considered as bad faith. However a ruling of a court was necessary in order to deny a registration of a trademark on the ground that it was applied in bad faith.

225. The Delegation of Sweden stated that bad faith was an absolute ground for refusal. An application to register a trademark should be refused where the applicant was aware of the fact that the mark was used by another party at the time of the application and that use was commenced before the use of the applicant.

226. The Delegation of the Russian Federation expressed the view that, if the owner of the trademark was shown to be involved in unfair competition and if this behavior was connected precisely with the registration of its trademark, that was to say if it was proven that the request for registration was by itself an act of unfair competition, than the registration was not granted. Moreover, a special body, namely the antimonopoly service, was in charge of establishing if a particular act constituted an act of unfair competition. Based on the decision of the antimonopoly service confirming unfair competition behavior, the person concerned could request from the Office the cancellation of a particular trademark registration.

227. The Delegation of the United States of America pointed out that US practice did not contemplate bad faith as ground for refusal within the examination. However, this existed as a ground for opposition or cancellation on the basis of fraud to the Office. At the time when the applicant submitted an application, it had to submit also a verified statement, which required the applicant to state that to the best of its knowledge and belief that the facts in the applications were accurate. Moreover, the applicant must state that it was using the mark in commerce on all of the goods and services claimed or that it had an intention to use it. Also, a statement regarding that the applicant believed itself to be the owner of the mark and no one else to the best of its knowledge had the right to use the mark in commerce as of the date of filing. All the statements were made under the penalty of US Criminal Law.

228. The Delegation of Mexico said that during the trademark registration process there was no possibility of cancellation based on bad faith, unless a judicial order was suspending the procedures. However, the law provided a possibility for invalidating registered trademarks. In particular, a trademark could be recognized invalid if it was registered by the representative or the distributor of the trademark holder registered abroad, without the consent of the holder. In that case the registration might be considered as obtained in bad faith.

229. The Delegation of the Russian Federation recalled that, apart from the ground for invalidity explained before, a trademark might be refused if it was similar to a trademark that previously was recognized as applied in bad faith. The ground for refusal would be that such a registration was not in the public interest. Furthermore, the Delegation gave examples of cases where the activities of an applicant could lead to unfair competition, such as applying for registration of a trademark, which was used for a long period of time by another producer or applying for registration a trademark which was famous in other countries for the same goods or services for another holder. It might be the case also when several producers on the market were using the same designation in good faith for a long time, and one of them at one particular moment decided to get a monopoly for that specific designation.

230. The Delegation of Romania indicated that bad faith according to national legislation was a ground for cancellation and not for refusal of a trademark. However, upon opposition by the proprietor of the trademark, a trademark would be refused where an agent or representative of the proprietor of the trademark applied for registration thereof in its own name without the proprietor consent, unless the agent or representative justified his action.

231. The Delegation of India stated that the refusal of a trademark based on the ground that it was applied in bad faith occurred within the opposition proceedings. If the bad faith of the applicant could be shown, the trademark would be refused.

232. The Delegation of Singapore expressed the view that, although bad faith was a potential ground of refusal at the examination stage, it was seldom invoked by an examiner in the national Office. However, it was often invoked during opposition or invalidation proceedings. In order to uphold a bad faith allegation, there must be clear evidence that there has been a misappropriation of the mark by the applicant. Obviously, there must be clear and sufficient evidence to establish such a serious allegation. The facts must lead to an obvious conclusion or strong inference that a case of misappropriation has been established. Given this evidential burden, it is understandable why a trademark examiner would only raise this ground of refusal if that examiner had very strong evidence, which was rare at the examination stage.

233. The Representative of FICPI pointed out that a reference to the Article 6*septies* of the Paris Convention might be usefully included in the document.

234. The Delegation of Norway said that, according to national legislation, a trademark might not be registered if it was liable to be confused with a trademark, which someone else had started to use before the applicant, and the applicant was aware of this use at the date of filing. However this ground was not invoked *ex officio* but only after an observation had been filed. Moreover, a recent court decision said that, in addition to the knowledge regarding the use, the filing of the application had also to be in violation of good business conduct.

235. The Delegation of Brazil recalled that bad faith was not stipulated as a ground for refusal under national law. However, it could be the base of an invalidation procedure within the court.

(m) Prior trademark rights

236. The Delegation of India stated that signs that were similar to the trademarks registered or filed for registration earlier might be accepted for registration on condition that the owner of the prior trademark consented to such registration.

237. The Delegation of Australia explained that conflicts with other trademarks were relative grounds for rejection which, in Australia, must be considered as part of the examination of a trademark application. They resulted from the existence of conflicting trademarks of earlier priority date. These grounds for rejecting an application existed if the subject trademark was substantially identical or deceptively similar to an earlier trade mark application or registration and the goods or services of both are the same or similar. This would also apply where goods were closely related to those services; or services were closely related to goods. The tests for determining both substantial identity and deceptive similarity were set out in the law.

(n) Other industrial property right

238. The Delegation of Serbia indicated that a prior right over an industrial design might be included for references in the document, as well as reference to the Article 8 of the Paris Convention when speaking about trade names.

239. The Delegation of Belarus stated that it supported the idea of including a reference, in the portion of prior rights, to industrial design rights.

240. The Delegation of Japan said that national legislation did not provide for a refusal based on conflicts with copyright or other industrial property rights. Furthermore, that ground could neither be a ground for cancellation or invalidation. However, the fact that the trademark was registered did not protect the trademark owner from infringement actions based on copyright or other prior industrial property rights.

241. The Delegation of the United States of America recalled that a prior copyright or industrial design could not be invoked before the Office in opposition or cancellation proceedings and that the Office did not refuse applications based on prior copyright or industrial design rights. However, those claims could be brought in an infringement case before the court.

(o) Copyright

242. The Delegation of Australia pointed out that the Office did not specifically search for copyright matter as part of the examination. Sometimes the situation was not clear cut, as might occur in the instance of prior copyright. If the ground for rejection was not clearly supportable, the application had to be accepted. However, once accepted, it might be opposed on the ground that use of the trademark was contrary to law.

243. The Delegation of Serbia pointed out that trademark registration of well-known copyrighted material was specifically prohibited by its national law.

(p) Personality right

244. The Delegation of Australia said that there were different legal mechanisms to prevent the unfair appropriation of a personality feature for commercial advantages. Trademarks which contained images of famous people might be confronted with ground for rejection on the basis that use of the trademark would be likely to cause confusion.

245. The Delegation of Kyrgyzstan declared that its legislation provided for the refusal of registration of the surnames and names of famous persons. Also, the titles of famous books and other literary works could not be registered as trademarks.

246. The Delegation of the United States of America expressed the view that marks might not be registered if they disparaged a person and it was not necessary for persons to be well-known. A mark might be refused registration also if it consisted of matter which might falsely suggest a connection with persons, living or dead, or bring them into contempt or disrepute. A mark also would be refused registration if it consisted of or comprised a name, portrait, or signature identifying a particular living individual except by the individual's written consent, or the name, signature, or portrait of a deceased President of the United States of America during the life of his widow, if any, except by the written consent of the widow.

CROSS-CUTTING ISSUES

(a) Acquired distinctiveness

247. The Representative of the European Community indicated that in three cases a trademark should not be refused registration or be declared invalid if, before the date of application for registration and following the use which has been made of it, it had acquired a distinctive character. This provision applied to trademarks devoid of any distinctive character, descriptive trademarks and generic trademarks. This provision also applied where the distinctive character was acquired after the date of application for registration or after the date of registration. All other cases, whether it concerned functionality, deceptiveness, offending against Article 6ter of the Paris Convention, or offending against the rules in relation to protected geographical indications, could not be overcome by acquired distinctiveness.

248. The Delegation of Mexico stated that some grounds for refusal like signs that were contrary to the public order, or signs applied for in bad faith, could not be overcome through acquired distinctiveness.

249. The Delegation of Uruguay said that, according to national legislation, designations that were generic, descriptive or common and had acquired distinctiveness with respect to goods and services associated with specific, physical or legal person would be accepted as trademarks. As for the cases of functionality, deceptiveness, geographical indications, those grounds for refusal could not be overcome by acquired distinctiveness.

250. The Delegation of Australia pointed out that from its perspective it was possible that a ground for refusal based on genericness be overcome by acquired distinctiveness. In those cases, whether it was a generic or a descriptive term, the evidence must show that in the market place this particular term was operating as a trademark. If it was operating as a trademark, it was appropriate to register the sign as a trademark.

251. The Delegation of Singapore said that acquired distinctiveness could overcome the objections based on non-distinctiveness, descriptiveness and genericness, but not any other objection, like functionality, or bad faith, or non-eligible subject matter. The evidence of use should show that the public recognized or associated that trademark exclusively with that proprietor. Use *per se* did not lead to the conclusion that the sign had acquired distinctiveness.

252. The Delegation of the United Kingdom indicated that where acquired distinctiveness was invoked to overcome an objection, the registered trademark might have a narrow scope of protection, which in cases of infringement in theory might not help, in particular where a descriptive or generic term was the base of the registered trademark.

253. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-first session of the SCT. The Secretariat was requested to prepare a revised working document on grounds for refusal of all types of marks to be considered by the SCT at its twenty-second session, taking into consideration the comments made by delegations during the twenty-first session. Moreover, SCT Members were invited to present submissions on individual items of document SCT/21/2 concerning, in particular, trademark office practice in specific cases and, where available, specific graphic examples, by July 31, 2009.

Technical and Procedural Aspects Relating to the Registration of Certification and Collective Marks

254. Discussion was based on document SCT/21/3.

255. The Delegation of the United States of America noted that national applicants and owners of certification and collective marks had encountered a number of differences amongst national systems when they applied to register abroad. Understanding those differences would appear to be helpful in crafting systems that worked together, for filings under the Madrid system or priority claims, and for the benefit of users of different national systems. Where a country did not allow for the registration of certification marks, applicants were forced to either register the mark as “quality assurance services” or as a regular trademark for the goods being certified. However, there was a question of whether the mark was enforceable in an infringement context since the actual use of the mark did not precisely match the goods and services listed in the registration. The Delegation wondered how a certification mark owner should seek protection in a country which did not have a certification mark system and asked whether that owner should apply protection as a collective mark, or an individual mark, and if so, how the goods/services should be identified.

256. The second area of concern for applicants from the United States of America was proof of authority. The Delegation understood that some national offices required that applicants prove that they had “authority” to run a certification program. In some cases, the national

Offices appeared to demand some kind of governmental sanction for the program. Alternatively, national offices requested an exhaustive explanation of the applicant's expertise in the field. Since this requirement was unclear and changed from country to country, it could be very time consuming to develop documentation to satisfy exactly what the trademark offices expected in the way of "expertise". Other national offices required that the applicant describe the "specialized equipment" that the applicant used to test the goods. In most cases, there was no specialized equipment. Thus, the Delegation was interested in understanding the policy rationale for requiring proof of authority by the certifier and wondered whether this was done to avoid that interested parties challenge the validity of the registration. The Delegation also wondered whether offices sent such claims to other agencies for review and if so, what form such proofs would take.

257. A third area of concern was classification. The Delegation understood that for certification mark owners filing internationally, classification could be a difficult issue. Some applicants certified hundreds of different products, covering dozens of different classes. Thus, to register the certification mark for all the products being tested and certified in every country in which the products were sold could be prohibitively expensive. Owners were forced to choose just their "top products" and register only those. The Delegation asked what experience national Offices had with certification mark classification and wondered if it would be useful to explore whether the SCT believed that separate classification requirements should apply to certification or collective marks to provide users with more flexibility. The Delegation also wondered whether that could be something worth exploring in the Nice Working Groups.

258. The fourth area of concern for the Delegation referred to the regulations. Filing "regulations" or "statements" detailing the certification program could lead to major problems and delays. Some national offices appeared to require that the regulations incorporate a great deal of additional matter not usually included in the rules that the applicant actually used. For example, some required a description of the grievance or appeal process available to failed certifiers (or actually required the applicant to institute an appeal process). Others wanted not just the general rules of the program, but specific technical data about what the standards were (which could encompass volumes of information and could be impractical to provide other than in the most summary fashion). Some national offices wanted to be able to approve or reject any changes to the rules of the certification program (which could be very impractical if the standards were constantly being updated). Additionally, some national offices did not actually allow the application to be filed without the regulations. Given the difficulty in drafting regulations that met all the detailed requirements, filing dates were often delayed significantly. This made it difficult for owners to meet Paris Convention deadlines. In that context, the Delegation wondered if these regulations could be provided later in the application process, rather than as a filing date requirement. It also wondered what the purpose was to require technical regulations that the Office may not be able to evaluate. If this was the case, what other agencies were these regulations referred to for comment?

259. The last area where there seemed to be confusion for owners filing internationally was what constituted an applicant for purposes of a certification or collective mark. The Delegation noted its understanding that currently, Australia allowed a certification mark owner to use the mark on certified goods. The Delegation was interested in hearing what problems had prompted that change. Should a producer group file the application, or could it be the certifier who did not actually produce the goods? What if the producer group

contracted out the certification inspection function but remained the certification mark owner? Would that satisfy requirements for the producer group applicant? The Delegation asked other Members of the SCT to discuss their experience on these items.

260. The Delegation of Switzerland held the view that the intervention by the Delegation of the United States of America had gone ahead of the discussion. The issue raised by the latter delegation seemed to be how the holder of a certification mark from a country that provides for that type of protection could obtain equivalent protection in one or more countries that did not have equivalent legal systems. The Delegation believed that it was necessary first to discuss what certification marks really were. SCT Members that provided protection for certification marks could explain to other members how their systems worked. Only after receiving that information could the SCT move on to discuss the issues raised by the Delegation of the United States of America.

261. The Delegation of France supported the views expressed by the Delegation of Switzerland and mentioned that document SCT/21/3 was a good basis to initiate discussion on collective and certification marks. The Delegation explained that under the national system, the same validity conditions applied to collective and certification marks as to individual marks, in particular with regard to distinctiveness. Thus, there was no exception under national law to the ground for refusal of signs which served in commerce to designate the geographical origin of products or services. The Delegation requested that end note number 23 of document SCT/21/3 be amended to reflect this situation.

262. The Delegation of Mexico explained that national legislation provided protection only for collective marks. Associations of producers could apply for such marks and the Office needed to examine the use regulations. The Delegation said that it was interested in knowing the provisions set forth in other legislations to look at the most suitable model for any future amendment of national law. Although certification marks were not admitted for registration, the national Office had accepted to grant ordinary trademark registrations to applications for marks concerning the certification of services. However, the classification was not made in relation to the specific products being certified, but was considered to be in the services class. Absolute grounds for refusal were the same for ordinary marks and for collective marks. This led to problems in relation to marks that had been registered abroad as collective marks and included a geographical indication or an appellation of origin. The Delegation was interested in hearing the practice of other members of the SCT in this regard.

263. The Delegation of Germany supported the views expressed by the Delegation of Switzerland. National law did not provide for the protection of certification marks and any such application in Germany would have to be filed as a collective mark. Therefore, it was important to get more information on the certification marks system.

264. The Delegation of Portugal said that national legislation contemplated the protection for collective marks to be held by associations, which consisted of groups of individuals or entities whose members used or intended to use the collective mark in order to provide goods or services which related to the purpose of the association. Certification marks were granted to a collective body that monitored or controlled products or services or established standards to which certain products should conform.

265. The Delegation of Uruguay declared that the national system provided protection for both collective and certification or guarantee marks. Collective marks identified products or services coming from an association of manufacturers, sellers of products or service providers. The holder of the mark was the association itself and it applied for the collective mark in order to differentiate the products or services of its members from those of non-members. Use of the mark was linked to use regulations, which specified certain conditions that the members should fulfill and determined the persons who were authorized to use the mark, the conditions for affiliation in the organization and any possible grounds for prohibiting use of the mark. Collective marks could not be assigned or transferred to third parties and use could not be authorized to non-officially recognized members of the association.

266. With regard to certification or guarantee marks, the Delegation mentioned that such signs were used to certify the common characteristics of a product or service, looking in particular at the quality, nature, components and methods of production. Certification marks in Uruguay were regulated by a State organization or a private law body authorized by the competent authority. Appellations of origin could not be registered as certification marks. There were also use regulations concerning the conditions of use of the mark and any other relevant detail. A particular feature of certification marks was that they could not be used to certify the products or services produced or sold by the holder of the mark.

267. The Delegation of Spain said that collective mark applicants had to supply use regulations, in addition to the statutes of the association. Requirements for guarantee mark applications included use regulations as well as an indication of the authority in charge of monitoring use of the mark. In Spain, there had been a considerable increase in this type of applications in 2008, totaling 76 applications for collective marks and 55 for guarantee marks.

268. The Delegation of India said that provisions concerning the protection of certification marks had been introduced in national law a long time ago, while protection for collective marks was established since 2003. There were over 25 registered collective marks and a good number of pending applications. Fees were higher than for individual marks. National law contained very detailed provisions and the system functioned without problems.

269. The Delegation of Italy declared that national law did not provide for certification marks but only for collective marks. Application requirements included the statutes of the consortium and the use regulations. It was important that a periodical quality control be established to ensure that the product standards were maintained. The Delegation said that the national government was recently looking into approving a "Made in Italy" quality mark.

270. The Delegation of Sweden stated that there was a special Collective Marks Act in Sweden, which also dealt with the protection of certification marks. According to the Act, an association of tradesmen could acquire the sole right on a trademark or other trade symbol through registration or use, in the same manner as an individual, natural or legal person according to the Trademarks Act. The right so acquired had to be used by members of the association in respect of goods or services which they offered for sale in the course of trade. Certification marks could be applied for by public authorities, foundations, or other corporate bodies exercising control over goods or services. Such entities could acquire the sole right on a trademark or other trade symbol for use in respect of goods and services which were the subject of control. The conditions applied in this case were basically the same as for ordinary trademarks, except that the use regulations had to be filed with the registration Office. The

latter was not a filing date requirement and could be supplied later in the procedure. It was possible to revoke a collective or certification mark if the regulations have been amended but not notified. However, no collective or certification marks had been revoked on this ground.

271. The Delegation of Brazil declared that national law concerning collective and certification marks dated back to 1996. An application for the registration of a collective mark should include use regulations, which determined the conditions of use of the mark and any prohibitions. Certification mark applications should mention the characteristics of the product or the service to be certified and the control measures to be adopted by the applicant. In Brazil, certification marks were classified in class 42 of the Nice Classification.

272. The Delegation of Japan noted that the national system did not contemplate protection for certification marks. However, discussion of this new area was a valuable reference. According to the collective mark system applied in Japan, the owner had to be an association. Application requirements and the extent of protection were almost the same as for individual marks, except that the collective mark could be used by the owner and by the members of the association.

273. The Delegation of Slovenia said that national law provided only for the protection of collective marks. Use regulations should be filed together with the application and could not be admitted during examination. Fees for collective mark applications were slightly higher than for individual marks. Collective marks could not be assigned. The Delegation noted that even though examination criteria were the same as for individual marks, the Office was giving consideration to a change in practice with regard to signs that consisted of geographical indications, in order to align it with the European Community trademark practice on this point.

274. The Delegation of Canada stated that the national system had contemplated the protection of certification marks for many years. The Delegation noted that whereas trademarks distinguished the goods and services of one owner from those of another owner, certification marks were used to distinguish goods and services that were of a defined standard from those that were not. A certification mark owner could not be the person who was producing the goods or delivering the services and it was also possible, under certain circumstances, for a certification mark to be descriptive of the origin of the goods. In reply to one of the questions raised by the Delegation of the United States of America, the Delegation noted that all the goods and services pertaining to a certification mark application were classified according to the Nice Classification system. However, the Office did not charge a fee per class but one single fee per application.

275. The Delegation of Malaysia declared that national law provided for certification marks and not for collective marks. Applications for certification marks were treated as ordinary trademark applications, except that the use regulations had to be filed together with the application and the applicant needed to prove to the Office the authority to certify the goods and services. In Malaysia, certification marks could not be applied for by an individual but only by bodies or institutions which were authorized by government or official organizations.

276. The Delegation of Kyrgyzstan said that the national system did not provide for the notion of certification mark, but the Office registered collective marks and these could be applied for by unions, associations or similar legal entities which produced goods with common features or qualities.

277. The Delegation of Serbia explained that collective marks were contemplated in the national trademark system for a long time, while certification marks had been introduced in 2004 and to date, there had been no applications concerning the latter. The Delegation raised a question in relation to paragraph 54 of document SCT/21/3, where it was stated that certification and collective marks could be assigned to a new holder in the same way as individual marks. The national law of Serbia contained a prohibition to grant licenses on collective or certification marks or to transfer them to another holder.

278. The Delegation of Australia declared that it considered the certification trademark system an ideal way to protect geographical indications, for example for goods like meat and dairy products. The Delegation noted that in this way, the geographical indication would be certified as meeting a particular standard of quality or as having a particular characteristic attributable to its geographical origin.

279. The Delegation of Mexico, in reply to one of the questions asked by the Delegation of the United States of America, said that when the use regulations were not filed together with the application, they could be supplied later in the procedure. However, the filing date would not be modified.

280. The Delegation of Belarus noted that according to national practice, the filing date for a collective mark was accorded upon filing of an application indicating the list of goods. Other documents concerning use, place of origin, etc. could be submitted later in the procedure.

281. The Delegation of the United States of America thanked all the delegations which had answered its questions and asked the Members of the SCT to share their experience with the following situation. If the owner of a collective mark, who was actually selling goods and thus, using the mark in trade decided to apply for registration of that mark as a certification mark in another country, the mark would presumably be refused registration, as in most systems, the certification mark owner could not itself use the mark. However, if the collective contracted out the inspection function and submitted to the Office that the inspector/certifier was a different person, could the registration then be granted to the collective mark owner?

282. The Delegation of Australia replied that it was for this very reason that the practice was changed in Australia, in order to allow the holder of a certification mark to be the user of that mark as well, and on that basis, the system would allow those certification mark owners or the equivalent thereof coming from overseas to be able to use those marks in Australia.

283. The Delegation of India said that if a collective mark holder from abroad would apply for a collective mark in India, registration could be granted, even if the holder was using the mark itself, namely by trading in the goods. However, if the holder applied for a certification mark, the situation would be different as these marks were, by definition, granted to organizations or bodies which were authorized by Government to undertake the certification. Such institutions were usually accredited by a national body and got the permission to allow use of the mark to duly certified individuals.

284. The Delegation of Colombia stated that national law (Decision 486 of the Andean Community) provided that collective marks were used to distinguish the origin or any other common characteristic of the products or services belonging to different enterprises that were formally grouped together. The products had common characteristics, such as geographical origin, material and mode of manufacture. The holders of collective marks (generally

associations, corporations and collectivities) were responsible for ensuring that the products and/or services of their members fulfilled the use regulations, in order to guarantee their quality and characteristics. Use of the mark was reserved to members of the association and could not be licensed to third parties. The application procedure was similar to that of individual trademarks; however, additional requirements had to be supplied, namely: the statutes of the association, as well as the list of members and the use regulations.

285. The Delegation noted that certification marks were considered to be every sign applied to products or used in relation to services the quality or other characteristics of which had been certified by the holder of the mark. National law required that use regulations be filed, indicating the products or services to be certified, defining the characteristics guaranteed by the mark and describing the manner in which control would be exercised. In this context, the Government of Colombia could not identify any additional aspects pertaining to collective and certification marks that could be examined by the Standing Committee.

286. The Delegation of Mexico explained that under the collective mark system applied in Mexico, it was possible that the use regulations provide for certification of product quality and it could also be considered that the person carrying out the certification was different from the collective. In that case, a third party was ascertaining whether the product complied with certain quality criteria or not. One important advantage for producers was that they were authorized to use the mark without the need for an express license. Membership in the association was enough to qualify as a user.

287. The Delegation of Norway declared that the national system provided for protection of collective but not certification marks. However, control and guarantee marks could be registered under the Collective Marks Act. To a large extent, the provisions of the Trademarks Act applied also to collective marks. The applicant had to be an association of traders. The goods or services needed to be listed according to the Nice Classification system. The fee was somewhat higher and it was possible to assign collective marks. In addition, the applicant was required to submit use regulations. Nevertheless, a filing date was granted when the collective mark application was received, even if the goods or services were not specified and the fee was not yet paid. In reply to the question asked by the Delegation of the United States of America, the Delegation noted that it was possible to apply for a collective mark in which the supervisory/certification function was outsourced under the Collective Marks Act of Norway.

288. The Representative of AIPLA declared that, as an organization which represented trademark owners, it would be very much interested in building a body of reference that provided practical information for trademark owners. In particular, the Representative wished to know what the recommended practice would be for a certification mark owner that would not be a collective organization and would not necessarily be certifying something like a geographical indication, but instead would itself be, for example, a laboratory or an inspection body that would certify safety, or humanitarian treatment of animals or environmental regulations. In the absence of a certification program, since there were countries which did not provide for certification marks, what system would apply to this sort of certification mark owner and what would they have to do to get protection in the individual countries?

289. The Delegation of the United States of America, in reply to a question asked by the Delegation of Mexico said that under national practice, there was no minimum or maximum amount of information to be included in the certification standards. These could be either

complex or simple, they could come from a governmental body or a standards organization, or they could be entirely made up by the applicant. The Office sought to establish what the object of certification was and how the applicant exercised or intended to exercise legitimate control over the mark. If something in the application suggested that the applicant was not in a position to control use of the mark or that they were not engaged in a certification program, the Office would conduct enquiries.

290. The Delegation noted that regarding collective marks, the national Office required the bylaws of the collective, in order to see how membership was acquired. It did not necessarily require the standards unless they happened to be contained in the bylaws. So, if a collective was using, for example, a geographic term for a long time and they were able to prove acquired distinctiveness (i.e., substantially continuous and exclusive use), the collective did not have to provide the standards, as this was not something for the public record. On the contrary, with certification marks, the standards were a public record, entirely transparent to the public and subject to challenge.

291. The Delegation further noted that, as mentioned by the Delegation of Sweden, national law also provided for the possibility of amending certification mark regulations, although that option had not been used too often. In that regard, the Delegation wondered whether an Office had to examine those amendments or needed to publish them for opposition, or could simply place them on the record, so that they could be raised in a cancellation action by an interested party who did not agree with the amendment. The question was how to ensure transparency to the public, so that those affected had an opportunity to comment.

292. The Delegation of Portugal, in response to the question raised by the Delegation of Mexico, said that national law expressly provided that the regulations pertaining to collective or certification marks specifically designate the persons entitled to use the mark, the conditions or requirements that they must fulfill as users, and the rights and obligations of interested parties in cases of counterfeiting or misappropriation or misuse. Regarding the question raised by the Delegation of the United States of America, the Delegation said that amendments to the regulations only had effect if they were communicated to the Office by the holder of the mark.

293. The Delegation of Australia said that the rules concerning certification marks were not examined by the Trademark Office but by the Australian Competition and Consumer Commission (ACCC) and that particular organization ensured that the rules were consistent with competition principles and in the public interest. The ACCC also looked at variations of the rules and they tested any changes against those principles before making a decision as to whether the rules should be varied or not. There was an option to invite the public to comment on the rules and any variations thereof, but that seemed unlikely.

294. The Delegation of Germany said that the national system required that the conditions of use of collective marks be filed with the Office.

295. The Representative of the European Community noted, in relation to the question raised by the Delegation of the United States of America that under the Community Trade Mark (CTM) Regulation system, certification marks were not recognized as such. He noted that the proprietors of certification marks would have difficulty in obtaining a collective mark as they were normally not associations or legal persons governed by public law. They might be able to obtain an ordinary community trademark. As to the content of the regulations, they had to

specify the persons authorized to use the mark and the conditions of membership of the association, including any sanctions that might be available. The latter provision was not compulsory and could be omitted in the regulations. It was necessary for changes in the regulations to be notified and for the Office to approve such amendments. The regulations themselves were not part of the Register but were available for public inspection on the Office website. Any changes in the regulations that were not approved nor mentioned in the Register were not effective.

296. The Delegation of Australia referred to the question raised by the Delegation of Mexico in relation to the content of the rules governing use of the certification mark and said that from the Australian perspective, those rules had to specify a number of elements: the requirements that the goods or services should meet for the certification trademark to be applied to them; the process for determining whether goods or services met the certification requirements; the attributes that a person should have to become an approved certifier (i.e., a person approved to assess whether the goods or services met the certification requirements); requirements that the owner of the certification mark or the approved user should meet to use the certification mark in relation to the goods and services; other requirements about use of the certification mark by the owner or an approved user; the procedure for resolving a dispute about whether goods or services met the certification requirements, and lastly, the procedure for resolving a dispute about any other issue relating to the certification mark.

297. The Delegation of Singapore noted, in relation to the question raised by the Delegation of the United States of America that in Singapore, an amendment to the regulations of a certification mark should first be submitted to the Registrar for approval, after which they were accepted and published. The Registrar needed to ensure that the regulations and any subsequent amendments were in accordance with national legislation and accessible, so that third parties could understand the requirements to be met before they could use the certification mark. Like in the European Community Office, all published regulations were available on the Singapore Office online database.

298. The Delegation of Brazil, referring to the question raised by the Delegation of Mexico, said that national law required that a collective mark application be accompanied by use regulations which determined the members who were authorized to use the mark, the products or services that were the object of the application, the conditions of use of the mark and any prohibitions. The applicant for a certification mark should describe in the application the characteristics of the goods or services that were the object of the certification and the control measures that will be adopted by the right holder.

299. The Delegation of Spain raised a question with regard to the terminology used in the Spanish version of document SCT/21/3, paragraph 58, as *revocación*, while it seemed from the explanation given in that paragraph that this item referred to *caducidad*, as was known in Spanish law.

300. The Delegation of Uruguay noted that national law referred to *cancelación* in cases where the collective mark was used by the holder in contravention of the conditions of use and/or when the mark was used only by the holder or only by one of the authorized users. National law in Uruguay did not refer to *caducidad* because that concept meant lapsing of a right due to non-use within a fixed time limit. Therefore, the Delegation understood that the term “revocation” used in paragraph 58 of the Spanish version of document SCT/21/3 is correct.

301. The Delegation of El Salvador suggested that Section IV(e) of document SCT/21/3 be extended to include both cancellation and revocation because many national legislations contemplated both options.

302. The Secretariat said that it would examine the terminology in Spanish to ensure the overall consistency of the use of the terms.

303. The Delegation of the Republic of Korea declared that, according to article 73(1)(10) of the national Trademarks Act, it was possible to request the cancellation of a collective mark when the holder had willfully omitted to take reasonable measures against a non-member who caused a misunderstanding as to the quality of the goods or confusion between his products and the goods associated with another person's business or mark through unauthorized use the collective mark.

304. The Delegation of the United States of America referred to the question of "licensee estoppel" in relation to certification marks. The Delegation explained that with regard to trademark licenses, a trademark owner was normally allowed to put a "do not challenge provision" in the license, which meant that the licensee could not challenge the validity of the mark. With certification mark registrations, and the resulting certification agreements, national Courts had found that a certification mark was more akin to a patent than to a trademark because of the public interest involved that everybody in a particular region or industry needed to be able to use the certification mark if they met the standards. The certification agreements had been found to be invalid when they included a provision on licensee estoppel.

305. The Delegation noted that national Courts had found that the certified parties or those who wanted to be certified should always be allowed to challenge the validity of the mark. However, there was some concern amongst certification mark holders in the United States of America, who were associations, non-profit organizations or non-profit governmental entities which did not wish to face these challenges by their certified users. At times, it became a litigation tactic, when the certified party did not like a particular provision in the agreement, they could threaten to challenge the validity of the registration, thereby setting the costs of trademark enforcement a little higher than some of those non-profit associations could afford. The Delegation said that this issue was being debated in the United States of America and wondered whether another jurisdiction had had a similar discussion or if no challenge provisions were upheld in certification mark certification agreements, or if they were not available.

306. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-first session of the SCT. The Secretariat was requested to prepare a revised working document on technical and procedural aspects relating to the registration of certification and collective marks, taking into consideration the comments made by delegations during the twenty-first session. After reconsideration of the document by the twenty-second session of the SCT, the document would be made available on the WIPO webpage for reference purposes.

307. In that context, the Chair suggested that the Secretariat create a dedicated webpage that would allow users to identify SCT reference documents by subject matter.

Article 6ter of the Paris Convention

308. Discussion was based on documents SCT/21/5 and SCT/21/6.

309. The Delegation of Jamaica presented Jamaica's proposal, contained in document SCT/21/6, for the re-visitation of the proposed amendments to Article 6ter of the Paris Convention as contained in document PR/DC/4, that was originally tabled at a Diplomatic Conference on the Revision of the Paris Convention held from February to March 1980, the discussions of which were still pending conclusion. The original proposal had called for the inclusion of the "official names of States" alongside other protected names and symbols, which fall within the categories of armorial bearings, flags, other emblems, abbreviations, and names of international intergovernmental organizations. The Delegation was, therefore, of the view that the exclusion of official State names from protection was a clear oversight that had been highlighted by developments over the last three decades, which had occurred within an increasingly interconnected international trade regime. Other forms of interconnectedness, such as the exponential growth of the Internet, had made access to products and services available at one's fingertips. This prodigious growth in international trade and information and communication technologies (ICTs) had also facilitated the widespread dissemination and access to products which, unfortunately, infringed on the intellectual property rights of others, and which carried with that several consequences related to lost revenue and the exposure of one's reputation to damage. Jamaica's proposal thus sought to revisit this issue in a progressive manner. The first element of that proposal sought to accord equivalent protection to official State names, similar to the protection that was currently provided to other symbols of the State, such as flags and armorial bearings. The second element of the proposal related to an extension of this protection to homonymous sounds of the official names of States, such as, *inter alia*, J-A-H-M-A-K-A or J-A-H-M-E-I-K-A. Furthermore, there were two fundamental objectives regarding the protection of official State names. One related to the protection of the sovereignty, integrity and inviolability of the State through the prevention of the unauthorized use of the official State name. The other related to the protection of the intellectual property rights and related commercial benefits that were likely to accrue to nationals of the State in question, who are permitted to enjoy the reputation of a nation's official State name via its incorporation as a trademark or as an element of a trademark. Protection via this mechanism would, therefore, impose a requirement on natural and juridical persons seeking trademark protection for goods and services, to acquire the explicit authorization of the competent national authorities for the use of the official State name of any member country of the Union, as a trademark or as an element of a trademark. The proposal also allowed States members of the Paris Union and the WTO to freely choose the method by which to provide protection to the official names of States in a manner which was in accordance with their domestic legislative processes and requirements. In that regard, the Government of Jamaica was seeking to accord protection to official State names under its Trade Marks Act of 2001. The Jamaica Intellectual Property Office (JIPO) had, therefore, commenced the process of enacting legislative amendments to Sections 12, 50 and 52 of the Act in order to prohibit the use of official State names in trademarks or as elements of trademarks, where the explicit authorization of the competent national authorities of a member State of the Union had not been received. The Delegation also fully acknowledged that other members of the Paris Union had made very laudable efforts at ensuring protection against the use of official State names as elements of trademarks, where such use constituted grounds for refusal of requests for trademark protection. However, the continued prevalence of such use in other countries provided clear evidence of the inconsistency of the efforts to provide protection to official State names. The

Delegation was, therefore, of the view that an international treaty amending Article 6*ter* of the Paris Convention offered the best opportunity to ensure that the protection granted to official State names is consistent across all Member States of the Union. Furthermore, the cases of misleading use of official State names had created a situation of unfair competition, in which foreign manufacturers of imitated or like products gained an unfair competitive advantage over local producers in both domestic and foreign markets by utilizing official State names, such as Jamaica, as highly visible and well placed elements of their brands. As a result, the Delegation was of the view that the relationship between IP and Competition Law had also to be fully explored, as was recommended by the Provisional Committee on Proposals Related to a WIPO Development Agenda (PCDA) and outlined in paragraph 4(c) of its decision establishing the WIPO Development Agenda, contained in document PCDA/2/2. Therefore, the Committee might wish to note that paragraph 3(1) of Article 10*bis* of the Paris Convention expressly provided for the prohibition of all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor. Furthermore, paragraph 3(3) of the same article also prohibited indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods. However, the clear absence of provisions specifically prohibiting the use of official State names as a means to either create confusion or to mislead the public as to the true nature or characteristics of a particular good or service, was a major setback to international efforts to combat anti-competitive practices. For Jamaica, this concern was of particular economic significance as the country embarked upon a nation branding strategy. At the core of this strategy was the objective of promoting economic development by assisting mainly small and medium sized enterprises, which were recognized engines of growth and development, to penetrate markets by providing a means of product differentiation and niche marketing through the benefits derived from the reputation associated with the use of the official State name “Jamaica”. Therefore, in line with paragraph 1(c) of the Summary by the Chair of the 2nd session of the CDIP, held on July 2008, in which the Chair recalled the General Assembly mandate to establish the CDIP, and to discuss intellectual property and development related issues, and also further noting the decision of the CDIP to infuse the development agenda into all areas of WIPO’s work, the Delegation was of the view that a substantive discussion of the development dimension of the proposed amendment to Article 6*ter* was not only warranted, but timely. In an effort to ensure transparency and to address any concerns, the Delegation requested that the Secretariat prepare a paper outlining the background and history of the proposal for the amendment of Article 6*ter*, as well as an assessment of the benefits and legal consequences of this amendment to the rights and obligations of Member States, particularly in light of the dramatically different international trade and intellectual property protection regimes which Member States were now faced with 30 years later. The Delegation also requested the preparation of a questionnaire in order to determine the state of the protection currently being granted to official State names in national legislations.

310. The Delegation of the Russian Federation stated that its submission circulated in document SCT/21/5 did not constitute a formal proposal but, rather, was presented with a view to provide information to the Committee. The Delegation said that the use of national emblems in trademarks had certain consequences. In the Russian Federation, trademarks that were misleading or false with regard to the places of production or sale of the goods or services concerned could not be registered. However, names of places could be registered as trademarks as long as they did not occupy a dominant place on the products, and Annex II of document SCT/21/5 provided some concrete examples.

311. The Delegation of Jamaica thanked the Delegation of the Russian Federation for its explanation and specified that its proposal was intended to protect the integrity and sovereignty of a State, in order to enable it to permit the use of its name in trademarks, in a way similar to what was already provided for in Article 6*ter* for other symbols. The Delegation also expressed its concern over insufficient protection against infringement, in particular with reference to Article 22 of the TRIPS Agreement, which mentioned the use of geographical indications only in relation to goods. This concern stemmed from evidence of infringing use of the name of its State on goods and services and in a non-commercial sphere. The Delegation further specified that the intention of the proposal was not to create proprietary rights for States but rather to prevent unauthorized use of its name by individuals and companies. Moreover, the Delegation stressed that protection was afforded to names of international intergovernmental organizations and, therefore, should similarly be extended to State names.

312. The Delegation of Iran (Islamic Republic of) declared that it supported the proposal by the Delegation of Jamaica. It referred to Article 32 of the national Patent, Industrial Design and Trademark Registration Act of 2008, which prohibited registration of a mark that was identical, an imitation of, or contained a name, abbreviation or initials of the name of official signs adopted by any State, unless authorized by the competent authorities of that State.

313. The Delegation of Colombia declared that it did not consider convenient to amend Article 6*ter* of the Paris Convention since its national legislation already contained mechanisms for avoiding the registration as trademarks of country designations that would be confusing or deceptive for consumers. Believing that additional protection would limit the possibility to indicate the origin of the goods in marks, it pointed out that a large number of trademarks already contained in their elements names of countries, defining the origin of the product. Prohibiting the use of country names would therefore entail legal uncertainty over the origin of those marks.

314. The Delegation of Cuba welcomed the proposal of Jamaica and added that its trademark legislation prohibited the registration as trademarks of a sign including a reproduction or imitation of the name of any State without any express authorization. The Delegation declared that it was open to debate on the protection of the identity of States, through Article 6*ter* or any other means. However it pointed out that protection extending to sounds or homonyms of country names would be excessive and lead to a burdensome examination process.

315. The Delegation of Australia declared that it did not support an amendment of Article 6*ter* to include protection of country names, since provisions already existed in the Paris Convention and the TRIPS Agreement, permitting to refuse the registration of trademarks containing country names. Considering that the use of Article 6*ter* in this way would go beyond the original intent of this provision, it further said that it did not see any value in undertaking additional work on that topic and that it should not remain on the Agenda.

316. The Delegation of Spain supported the proposal made by the Delegation of Jamaica with regards to the protection of country names, whether isolated or accompanied by other elements, in line with Article 6*ter*(1)(b).

317. The Delegation of South Africa expressed its reservations on the proposal by the Delegation of Jamaica. It recalled that a similar proposal had been rejected in the 1980's and that the reasons for the rejection should be carefully analyzed before considering the current proposal, which should also be evaluated in light of the Paris Convention as a whole. It believed that a country name *per se* did not fall within the scope of Article 1(2) of the Paris Convention and that where said name constituted, in itself, an "indication of source or an appellation of origin", it should already be protected under the relevant provisions. Considering that the proposal of Jamaica would elevate a country name to the status of a trademark, the Delegation stated that a State name was non distinctive given its geographically descriptive connotation and therefore could not constitute a trademark. In addition, it believed that Article 6ter(1)(a) adequately protected the use of signs designating a country. The Delegation added that the use by third parties of a country name like South Africa was already protected and controlled by the South African Trade Marks Act.

318. The Delegation of Germany considered that it was not necessary to amend Article 6ter. A trademark could be misleading if the goods or services did not originate from the country of which the name was indicated and therefore, the issue rather concerned competitors. That particular issue could be taken care of by the law against unfair competition. Furthermore, an amendment of Article 6ter requiring permissions from national authorities would create bureaucratic procedures and obstruct free trade of products.

319. The Delegation of Jamaica stated that although issues concerning the origin of goods were being dealt with under Article 22 of the TRIPS Agreement, this provision concerned only goods whereas services needed protection too. Commenting on the statement made by the Delegation of South Africa, it clarified that the objective of the proposal was not to elevate State names to the level of trademarks, but that any use of such names had to be approved by competent authorities in order to protect the interests of the countries.

320. The Delegation of Brazil welcomed the discussion proposed on the categories of signs protected under Article 6ter and explained that, in Brazil, geographical names not constituting indications of source or appellations of origin could be characteristic elements of trademarks, provided that they did not cause confusion, suggested a false geographical origin or offended the country image. It believed that the existing legal framework established under the Paris Convention and the TRIPS Agreement already provided enough grounds for the protection of State names. However, it expressed its interest for concrete problems faced by Jamaica and its willingness for working with the Committee on possible solutions. In that respect, the Delegation raised the question of translations and meanings of country names in different languages.

321. The Delegation of Japan, expressed appreciation for the documents prepared by the Delegations of Jamaica and the Russian Federation. The Delegation explained that the legislation of Japan prohibited the registration of a trademark consisting solely of the common indication of the place of origin or sale of goods or the location of provision of services, including country names or their abbreviations. In addition, a trademark containing a country name could not be registered if it was likely to mislead as to the quality of the goods or services. Moreover, unfair competition law provided for civil relief measures or penalties in the case where consumers had been misled about the place of origin of goods and services.

The Delegation expressed the view that before envisaging the amendment of the Paris Convention, which would require a diplomatic conference, the Committee should hold discussions on the means of protection of State names and decide whether Article 6*ter* was appropriate to that end, taking into account the respective legislations of the members.

322. The Delegation of Australia said that a country name applied as the single element of a trademark for a whole range of goods and services would not be accepted in Australia. For trademarks comprising among other elements a country name, examination would have to determine whether it was appropriate for that specific trademark. Consideration would be given to the meaning of such a trademark and its relationship with the goods and services, in particular with a view to avoiding deception or confusion. To that end, account had to be taken of the market place in Australia and the different cultures and languages existing in the country.

323. The Delegation of Austria declared that it was open for discussion on the topic but believed that there was no need to amend Article 6*ter*, the existing legal framework being sufficient to protect State names. In Austria, the law prevented registration of a trademark that was misleading or consisted exclusively of a State name, as well as translations thereof that would create confusion.

324. The Delegation of the Republic of Korea said that, regardless the absence in Article 6*ter* of any reference to State names, the Korean legislation contained appropriate standards for refusing the registration of trademarks consisting of State names that falsely indicated a connection with, or were criticizing a country. The same applied where a trademark consisted solely of a sign indicating, in a common way, the origin of goods, or was liable to mislead or deceive consumers on the quality of the goods. The Delegation considered that the issue of registration or use of State names should be addressed by the national legislation.

325. The Delegation of Greece supported the proposal of the Delegation of Jamaica and stated that protection should also apply to translations of names of States.

326. The Delegation of Jamaica agreed that the issue of translation had to be extensively discussed by the Standing Committee, and suggested the creation of a database on WIPO's website containing all official translations of State names. In reply to the concerns raised about names already used, it considered that exceptions for good faith use of State names could be implemented under an international treaty as a mechanism to deal with possible infringements. The Delegation further welcomed a discussion on homonymous sounds and stressed that protection of State names was not consistent in all countries.

327. The Delegation of France thanked the Delegation of Jamaica for the document raising the issue of protection of State names. The Delegation explained that its national legislation permitted to refuse or cancel the registration of designations containing an indication of geographical origin or which were misleading as to the nature of the product. The Delegation believed that the SCT should consider the adaptation of existing legal proceedings before envisaging the amendment of Article 6*ter*.

328. The Delegation of Serbia said that the Serbian Trademark Law stated, as a general rule, that trademark protection included all translations and transliterations of a given mark. Therefore, this rule should also apply to State names.

329. The Delegation of Kenya supported the proposal by the Delegation of Jamaica. It also expressed support for continued deliberations of the Committee on that topic, and requested the Secretariat to prepare a document and a questionnaire to be used in future meetings.

330. The Delegation of Denmark said that it agreed with the opinions expressed by the Delegations of Australia, Austria and Germany.

331. The Delegation of Switzerland supported the idea of a questionnaire in order to continue the work in this field and to obtain a better idea of the current practice in that field. The Delegation also suggested incorporating work on that topic into the work on grounds for refusal of all types of trademarks.

332. The Delegation of India welcomed the proposal made by the Delegation of Jamaica and explained that, since its national law did not include an express provision protecting State names, the Office used other absolute grounds for refusal, such as deception or confusion. The Delegation welcomed a discussion on this point but stated that it remained neutral as to the proposal by the Delegation of Jamaica.

333. The Delegation of Turkey said that it considered the proposal made by the Delegation of Jamaica to be constructive and that, after having listened to the concerns raised by some delegations, believed that there was a need for further discussion, in particular based on a questionnaire.

334. The Chair suggested that the Secretariat prepare a questionnaire for the next session of the SCT, and further produce a document on protection of State names in each country, summarizing the replies to that questionnaire.

335. The Delegation of Austria expressed the view that there was no need for further discussion and did not support the suggestion to discuss that issue at the next session.

336. The Delegations of Australia and Germany shared the opinion of the Delegation of Austria.

337. The Chair suggested separating the issue of protection of State names from Article *6ter*.

338. The Delegations of Brazil, Italy, Jamaica, Spain and the United Kingdom agreed with the proposal made by the Chair concerning the drafting of a questionnaire.

339. The Delegation of the United Kingdom further noted that the potential scope of Article *6ter* was not limited to the registration of trademarks, but concerned also their misleading use. Therefore, a link with Article *6ter* would imply work on consumer protection, which was beyond the expertise of the Standing Committee.

340. The Delegation of the United States of America considered that a discussion or a questionnaire on grounds for refusal related to country names constituted a good opportunity to deal with refusals concerning geographical terms in general. In reply to the clarification made by the Chair that geographical indications were included in the document on grounds of refusal and that the questionnaire will only concern State names, the Delegation specified that it referred to geographical descriptiveness and misdescriptiveness and that it might be useful to learn practices related to geographical terms in general.

341. The Delegation of Hungary clarified that it had previously asked to deal with deceptiveness as to the geographical origin of goods and services. It further supported the connection of those two issues.

342. The Representative of AIPPI asked whether the discussions would focus on nouns such as “Switzerland” or “Jamaica” or also be extended to adjectives of State names, like “Swiss” or “Jamaican”.

343. The Chair concluded that the Secretariat was requested to prepare a draft questionnaire concerning the protection of official names of States against registration or use as trademarks for consideration by the SCT at its twenty-second session. Following the twenty-second session of the SCT, the final version of the questionnaire will be circulated to SCT Members. Returns to the questionnaire will be compiled by the Secretariat and presented for consideration at the twenty-third session of the SCT.

Agenda Item 7: Geographical Indications

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

Agenda Item 8: Summary by the Chair

345. The Standing Committee adopted the Summary by the Chair contained in document SCT/21/7 and reproduced in Annex I of the present document.

Twenty-Second Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/22)

346. The Chair announced as tentative dates for SCT/22, November 23 to 26, 2009

Agenda Item 9: Closing of the Session

347. The Chair closed the twenty-first session of the Standing Committee on June 26, 2009.

[Annexes follow]

WIPO



SCT/21/7

ORIGINAL: English

DATE: June 26, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Twenty-First Session
Geneva, June 22 to 26, 2009

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.
2. Mr. Ernesto Rubio, Assistant Director General, reported on the work done by the International Bureau in preparation for the twenty-first session of the Standing Committee in connection with each of the topics proposed for discussion.
3. Mr. Marcus Höpferger (WIPO) acted as Secretary to the Standing Committee.

E

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

4. Mr. Park Seong-Joon (Republic of Korea) was elected as Chair of the twenty-first session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), and Mr. Adil El Maliki (Morocco) was elected as Chair of the twenty-second session of the SCT. Mr. Imre Gonda (Hungary) and Mr. Joseph Kahwagi Rage (Mexico) were elected as Vice-Chairs for the twenty-first and the twenty-second sessions of the SCT.

Agenda Item 3: Adoption of the Agenda

5. The SCT adopted the Draft Agenda (document SCT/21/1 Prov.) without modifications.

Agenda Item 4: Adoption of the Draft Report of the Twentieth Session

6. The SCT adopted the Draft Report of the Twentieth Session (document SCT/20/5 Prov.2) with modifications as requested by the Delegations of Guatemala, Jamaica, Japan, Spain, the Republic of Korea and the United States of America.

Agenda Item 5: Industrial Designs

Possible Areas of Convergence in Industrial Design Law and Practice

7. Discussion was based on document SCT/21/4.

8. The SCT considered document SCT/21/4 in detail. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-first session of the SCT. The Secretariat was requested to prepare a revised working document on possible areas for convergence on industrial design law and practice in SCT Members to be considered by the SCT at its twenty-second session. This document should indicate the changes suggested during the twenty-first session of the SCT and contain a summary of the comments made by delegations at that session.. The preparation of this revised working document will be without prejudice to the position delegations may have with regard to any possible area of convergence on industrial design law and practice.

9. Furthermore, the SCT requested the Secretariat to prepare a working document, for consideration at its twenty-second session, examining the possible extension of the WIPO Digital Access Service for Priority Documents “DAS” to priority documents for industrial designs and for trademarks.

Agenda Item 6: Trademarks

Grounds for Refusal of all Types of Marks

10. Discussion was based on document SCT/21/2.

11. The SCT considered document SCT/21/2 in detail. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-first session of the SCT. The Secretariat was requested to prepare a revised working document on grounds for refusal of all types of marks to be considered by the SCT at its twenty-second session, taking into consideration the comments made by delegations during the twenty-first session. Moreover, SCT Members were invited to present submissions on individual items of document SCT/21/2 concerning, in particular, trademark office practice in specific cases and, where available, specific graphic examples, by July 31, 2009.

Technical and Procedural Aspects Relating to the Registration of Certification and Collective Marks

12. Discussion was based on document SCT/21/3.

13. The SCT considered document SCT/21/3 in detail. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-first session of the SCT. The Secretariat was requested to prepare a revised working document on technical and procedural aspects relating to the registration of certification and collective marks, taking into consideration the comments made by delegations during the twenty-first session. After reconsideration of the document by the twenty-second session of the SCT, the document will be made available on the WIPO webpage for reference purposes.

14. In that context, the Chair suggested that the Secretariat create a dedicated webpage that would allow users to identify SCT reference documents by subject matter.

Article 6ter of the Paris Convention

15. The SCT considered documents SCT/21/5 and SCT/21/6. The Chair concluded that the Secretariat was requested to prepare a draft questionnaire concerning the protection of official names of States against registration or use as trademarks for consideration by the SCT at its twenty-second session. That questionnaire should also make reference to the concept of geographical deceptiveness. Following the twenty-second session of the SCT, the final version of the questionnaire will be circulated to SCT Members. Returns to the questionnaire will be compiled by the Secretariat and presented for consideration at the twenty-third session of the SCT.

Agenda Item 7: Geographical Indications

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

Twenty-Second Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/22)

17. The Chair announced as tentative dates for SCT/22, November 23 to 26, 2009.

Agenda Item 8: Summary by the Chair

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

Agenda Item 9: Closing of the Session

19. The Chair closed the session on June 26, 2009.

[Annex II follows]

ANNEX II

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

AFGHANISTAN

Said Azim HOSSAINY, Advisor, Ministry of Commerce and Industry, Kabul
<saidazim@hossainy.net>

ALLEMAGNE/GERMANY

Volker SCHÖDEL, Judge at District Court, Division for Trademark Law, Federal Ministry of Justice, Berlin
<schoedel-vo@bmj.bund.de>

Carolin HÜBENETT (Ms.), Counsellor, German Patent and Trade Mark Office, Munich
<carolin.hubenett@dpma.de>

Katharina SCHÄFER (Mrs.), Examiner, Industrial Design Section, German Patent and Trade Mark Office, Munich

Udo FENCHEL, Counsellor, Permanent Mission, Geneva

ANGOLA

Makiesse KINKELA AUGUSTO, troisième secrétaire, Mission permanente, Genève

ARGENTINE/ARGENTINA

Inès Gabriela FASTAME (Srta.), Primera Secretaria, Misión Permanente, Ginebra
<ines.fastame@ties.itu.int>

AUSTRALIE/AUSTRALIA

Robyn FOSTER (Ms.), General Manager, Trade Marks and Designs, IP Australia, Woden ACT
<robyn.foster@ipaustrialia.gov.au>

John BRAYBOOKS, Assistant General Manager, International Policy, IP Australia, Woden ACT
<john.braybrooks@ipaustrialia.gov.au>

AUTRICHE/AUSTRIA

Walter LEDERMÜLLER, Trademark Examiner, Legal Department for International Trademarks, Austrian Patent Office, Vienna
<walter.ledermueller@patentamt.at>

BARBADE/BARBADOS

Schnell RICHARD, Economist, Permanent Mission, Geneva
<srichards@foreign.gov.bb>

BÉLARUS/BELARUS

Anzhela CHVYROVA (Miss), Head, Department of Law and International Treaties, National Center of Intellectual Property (NCIP), Minsk
<a.chvyrova@belgospatent.org.by>

BRÉSIL/BRAZIL

Deyse GOMES MACEDO (Mrs.), Head of Division, Trademark Directorate, National Institute of Industrial Property (INPI), Ministry of Development, Industry and Foreign Trade, Rio de Janeiro
<deyse@inpi.gov.br>

Maria Alice CAMARGO (Mrs.), General Coordinator, Trademark Directorate, National Institute of Industrial Property (INPI), Ministry of Development, Industry and Foreign Trade, Rio de Janeiro
<calliari@inpi.gov.br>

María Lucia MASCOTTE (Mrs.), General Coordinator, Trademark Directorate, National Institute of Industrial Property (INPI), Ministry of Development, Industry and Foreign Trade, Rio de Janeiro
<malu@inpi.gov.br>

Thais Valério de MESQUITA, First Secretary, Permanent Mission, Geneva
<mesquite@delbrasgva.org>

CAMBODGE/CAMBODIA

Rady OP, Deputy Director, Department of Intellectual Property Rights, Ministry of Commerce, Phnom Penh
<oprady@yahoo.com>

CANADA

Lisa POWER (Mrs.), Director, Trade Marks Branch, Canadian Intellectual Property Office (CIPO), Department of Industry Canada, Gatineau
<power.lisa@ic.gc.ca>

Denis SIMARD, Director, Copyright and Industrial Design Branch, Canadian Intellectual Property Office (CIPO), Department of Industry, Gatineau
<simard.denis@ic.gc.ca>

CHILI/CHILE

Cristóbal ACEVEDO, National Director, National Institute of Industrial Property, Santiago de Chile
<cacevedo@inapi.cl>

Mónica REYES RUIZ (Mrs.), Trademark Registrar, National Institute of Industrial Property, Santiago de Chile
<mreyes@inapi.cl>

Carolina SEPULVEDA (Mrs.), Legal Advisor, Intellectual Property Department, Ministry of Foreign Affairs, Santiago de Chile
<isepulveda@direcon.cl>

Maximiliano SANTA CRUZ, Counsellor, Permanent Mission, Geneva

CHINE/CHINA

GUO Lian Lian (Mrs.), Deputy Inspector, Trademark Review and Adjudication Board, State Administration for Industry and Commerce (SAIC), Beijing
<lianlian-guo@hotmail.com>

COLOMBIE/COLOMBIA

Angelino GARZÓN, Embajador, Representante Permanente, Misión Permanente, Ginebra

Martha Irma ALARCÓN LÓPEZ (Srta.), Ministra Consejera, Misión Permanente, Ginebra
<missiondecolombia23@gmail.com>

COSTA RICA

Luis Gustavo ÁLVAREZ RAMIREZ, Director, Registro de la Propiedad Intelectual, Registro Nacional, Ministerio de Justicia, San José
<lalvarez@mp.go.cr>

CÔTE D'IVOIRE

Tiémoko MORIKO, conseiller, Mission permanente, Genève
<morikotiemoko@yahoo.fr>

CROATIE/CROATIA

Višnja KUZMANOVIĆ (Mrs.), Head of Department, State Intellectual Property
Office (SIPO), Zagreb
<visnja.kuzmanovic2dziv.hr>

CUBA

Alina ESCOBAR DOMÍNGUEZ (Mrs.), Third Secretary, Permanent Mission, Geneva
<comercial3ginebra@missincuba.ch>

DANEMARK/DENMARK

Anja M. BECH HORNECKER (Ms.), Special Legal Advisor, Policy and Legal Affairs,
Danish Patent and Trademark Office, Ministry of Economic and Business Affairs, Taastrup
<abh@dkpto.dk>

Tom Meltvedt PETERSEN, Special Legal Advisor, Trademarks and Designs, Danish Patent
and Trademark Office, Ministry of Economic and Business Affairs, Taastrup
<tpe@dkpto.dk>

ÉGYPTE/EGYPT

Mohamed Omar GAD, First Secretary, Permanent Mission, Geneva

EL SALVADOR

Diana Violeta HASBÚN VILLACORTA (Sra.), Directora, Registro de la Propiedad
Intelectual, Centro Nacional de Registros, San Salvador
<diana.hasbun@cnr.gob.sv>

Martha Evelyn MENJIVAR CORTEZ (Srta.), Consejera, Misión Permanente, Ginebra
<emenjivar@minec.gob.sv>

ÉQUATEUR/ECUADOR

Mauricio MONTALVO, Embajador, Representante Permanente, Misión Permanente, Ginebra

Luis VAYAS, Primer Secretario, Misión Permanente, Ginebra

ESPAGNE/SPAIN

Aurora HERNÁNDEZ AGUSTÍ (Sra.), Jefe, Área Modelos y Semiconductores,
Departamento de Patentes e Información Tecnológica, Oficina Española de Patentes y
Marcas (OEPM), Ministerio de Industria, Turismo y Comercio, Madrid
<aurora.hernandez@oepm.es>

Paloma HERREROS RAMOS (Srta.), Jefe, Servicio de Examen de Marcas, Departamento de
Signos Distintivos, Oficina Española de Patentes y Marcas (OEPM), Ministerio de Industria,
Turismo y Comercio, Madrid
<paloma.herreros@oepm.es>

ESTONIE/ESTONIA

Karol RUMMI (Mrs.), Deputy Head, Trademark Department, Estonian Patent Office, Tallinn
<karol.rummi@epa.ee>

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Amy P. COTTON (Mrs.), Attorney-Advisor, Office of Intellectual Property Policy and
Enforcement, United States Patent and Trademark Office (USPTO), Department of
Commerce, Alexandria, Virginia
<amy.cotton@uspto.gov>

John D. RODRIGUEZ, Attorney-Advisor, Office of Intellectual Property Policy and
Enforcement, United States Patent and Trademark Office (USPTO), Department of
Commerce, Alexandria, Virginia
<john.rodriguez@uspto.gov>

Janis C. LONG (Ms.), Staff Attorney, Office of the Commissioner for Trademarks, United
States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria,
Virginia
<Janis.long@uspto.gov>

EX-RÉPUBLIQUE YOUGOSLAVE DE MACÉDOINE/THE FORMER YUGOSLAV
REPUBLIC OF MACEDONIA

Simčo SIMJANOVSKI, Head, Department for Trademarks, Industrial Designs and Geographical Indications, State Office of Industrial Property (SOIP), Skopje
<simcos@ippo.gov.mk>

Biljana LEKIĆ (Mrs.), Deputy Head, Department of Trademarks, Industrial Designs and Geographical Indications, State Office for Industrial Property (SOIP), Skopje
<biljanal@ippo.gov.mk>

FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

Liubov L. KIRIY (Mrs.), Deputy Director General, Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow
<lkiriy@rupto.ru>

Olga KOMAROVA (Mrs.), Director, Trademark and Registration Department, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow
<okomarova@rupto.ru>

Svetlana GORLENKO (Ms.), Assistant to the Director, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

FINLANDE/FINLAND

Olli Pekka TEERIKANGAS, Senior Legal Officer, Trademarks and Designs Division, National Board of Patents and Registration, Helsinki
<olli.teerikangas@prh.fi>

Turkka Matias VAAHTOLAMMI, Lawyer, National Board of Patents and Registration, Helsinki
<turkka.vaahtolammi@prh.fi>

FRANCE

Isabelle CHAUVET (Mme), chargée de mission, Service du droit international et communautaire, Institut national de la propriété industrielle (INPI), Paris
<ichauvet@inpi.fr>

Christine LESAUVAGE (Mme), chargée de mission, Institut national de la propriété industrielle (INPI), Paris
<clesauvage@inpi.fr>

GRÈCE/GREECE

Franciscos VERROS, Ambassador, Permanent Representative, Permanent Mission, Geneva
<mission.greece@ties.itu.iut>

Nikos BEAZOGLOU, Trademark Office, Directorate of Commercial and Industrial Property,
General Secretary for Commerce, Ministry of Development, Athens

Stella KYRIAKOU (Mrs.), Attaché, Permanent Mission, Geneva

GUATEMALA

Ámanda ORTIZ MAYÉN (Sra.), Jefe, Sección Oposiciones, Registro de la Propiedad
Intelectual, Ministerio de Economía, Guatemala
<aomdeescobar@hotmail.com>

Ana Lorena BOLAÑOS (Sra.), Consejera Legal, Misión Permanente ante la OMC, Ginebra
<lorena.mision@wtoguatemala.ch>

GUINÉE/GUINEA

Aminata MIKALA-KOUROUMA (Mme), premier secrétaire (affaires économiques et
commerce), Mission permanente, Genève

HAÏTI/HAITI

Gladys FLORESTAL (Mme), premier secrétaire, Mission permanente, Genève

HONGRIE/HUNGARY

Imre GONDA, Deputy Head, Trademark, Model and Design Department, Hungarian Patent
Office, Budapest
<imre.gonda@hpo.hu>

INDE/INDIA

M. S. DHAKAD, Director, Department of Industrial Policy and Promotion, Ministry of
Commerce and Industry, New Delhi
<ms.dhakad@nic.in> <msdhakad@hotmail.com>

P. H. KURIAN, Controller General of Patents, Designs and Trade Marks and Geographical
Indications, Department of Industrial Policy and Promotion, Ministry of Commerce and
Industry, New Delhi
<cg.ipindia@nic.in>

INDONÉSIE/INDONESIA

Sigit Arry ARDANTA, Director, Copyright, Industrial Design, Lay-out Design of Integrated Circuit and Trade Secret, Directorate General of Intellectual Property Rights, Ministry of Law and Human Rights, Tangerang
<ardanta@gmail.com>

Didik TARYADI, Directorate General of Intellectual Property Rights, Ministry of Law and Human Rights, Tangerang

Yuwono HENDRO NUGRAHADI, Directorate General of Legal Affairs and Treaties, Directorate of Treaties on Economic, Social and Cultural Affairs, Department of Foreign Affairs, Jakarta
<nugrahadi.yuwono@deplu.go.id> <nugrahadi.hy@gmail.com>

IRAN (RÉPUBLIQUE ISLAMIQUE D’)/IRAN (ISLAMIC REPUBLIC OF)

Yazdan NADALIZADEH, Counsellor, Permanent Mission, Geneva
<yazdan-swiss@yahoo.com>

IRLANDE/IRELAND

Brian HIGGINS, Second Secretary, Permanent Mission, Geneva
<brian.higgins@dfa.ie>

Thérèse WALSH (Miss), Administrator, Permanent Mission, Geneva
<therese.walsh@dfa.ie>

ITALIE/ITALY

Sante PAPARO, Director, Industrial Designs and International Patents, Italian Patent and Trademark Office, Directorate General of Industrial Production, Ministry of Productive Activities, Rome
<sante.paparo@sviluppoeconomico.gov.it>

Renata CERENZA (Mrs.), First Examiner, International and Community Trademarks, Italian Patent and Trademark Office, Directorate General of Industrial Production, Ministry of Productive Activities, Rome
<renata.cerENZA@attivitaproduttive.gov.it>

Francesca FUSCO (Ms.), Intern, Permanent Mission, Geneva

JAMAHIRIYA ARABE LIBYENNE/LIBYAN ARAB JAMAHIRIYA

Ibtissam SAAITE (Miss), Second Secretary, Permanent Mission, Geneva

JAMAÏQUE/JAMAICA

Richard BROWN, First Secretary, Permanent Mission, Geneva

JAPON/JAPAN

Masaya SUZUKI, Deputy Director, International Affairs Division, General Affairs
Department, Japan Patent Office (JPO), Tokyo
<suzuki-masaya@jpo.go.jp>

Fumiko HAMAMOTO (Ms.), Deputy Director, Design Design, Japan Patent Office (JPO),
Tokyo
<hamamoto-fumiko@jpo.go.jp>

Aso HIROKI, Assistant Manager, Trademark Division, Japan Patent Office (JPO), Tokyo
<aso-hiroki@jpo.go.jp>

Satoshi FUKUDA, First Secretary, Permanent Mission, Geneva

JORDANIE/JORDAN

Khaled ARABEYYAT, Director, Industrial Property Protection Directorate, Ministry of
Industry and Trade, Amman
<khled.a@mit.gov.jo>

Mohammed Sameer HINDAWI, Second Secretary, Permanent Mission, Geneva

KENYA

Chumo Leonardo K. KOSGEI, Assistant Chief Trademark Examiner, Kenya Industrial
Property Institute (KIPI), Nairobi
<kosgei2000@yahoo.com> <kosgei@kipi.go.ke>

KIRGHIZTAN/KYRGYZSTAN

Farkhat IBRAGIMOV, Head, International Relations Division, State Patent Service of the
Kyrgyz Republic (Kyrgyzpatent), Bishkek
<farhat.ibragim@patent.kg>

LESOTHO

Tsotetsi MAKONG, First Secretary, Permanent Mission, Geneva

LETTONIE/LATVIA

Dace LIBERTE (Mrs.), Director, Trademarks and Industrial Designs Department, Head, Board of Appeal, Patent Office of the Republic of Latvia, Riga
<dace.liberte@lrpv.lv>

LIBAN/LEBANON

Najla RIACHI ASSAKER (Mrs.), Ambassador, Permanent Representative, Permanent Mission, Geneva

Bachir SALEH AZZAM, First Secretary, Permanent Mission, Geneva

Hani CHAAR, Permanent Mission, Geneva

LITUANIE/LITHUANIA

Digna ZINKEVIČIENĖ (Ms.), Head, Trademarks and Designs Division, State Patent Bureau of the Republic of Lithuania, Vilnius
<d.zinkeviciene@vpb.gov.lt>

LUXEMBOURG

Christiane DALEIDEN DISTEFANO (Mme), représentante permanente adjointe, Mission permanente, Genève

MALAISIE/MALAYSIA

Abdul Hamid MOHD RAZLAN, Head, Trademark Search and Examination Division, Intellectual Property Corporation of Malaysia (MyIPO), Kuala Lumpur
<razlanhamid@myipo.gov.my>

Rafiza ABDUL RAHMAN (Miss), First Secretary, Permanent Mission, Geneva

MAROC/MOROCCO

Adil EL MALIKI, directeur général, Office marocain de la propriété industrielle et commerciale (OMPIC), Casablanca
<adil.elmaliki@ompi.org.ma>

MEXIQUE/MEXICO

Joseph KAHWAGI RAGE, Director Divisional de Marcas, Instituto Mexicano de la Propiedad Industrial (IMPI), México
<jkahwagi@impi.gob.mx>

José Alberto MONJARÁS OSORIO, Subdirector Divisional de Servicios Legales, Regístrales e Indicaciones Geográficas, Instituto Mexicano de la Propiedad Industrial (IMPI), México
<amonjaras@impi.gob.mx>

María Victoria ROMERO CABALLERO (Sra.), Primera Secretaria, Misión Permanente, Ginebra
<vromero@delegamexico.ch>

MYANMAR

Khaing THEINGI OO, Deputy Director, Intellectual Property Section, Ministry of Science and Technology, Nay Pyi Taw
<decemberk.o@gmail.com>

Khin Thidar AYE, First Secretary, Permanent Mission, Geneva
<thidark@gmail.com>

NAMIBIE/NAMIBIA

Andima TILEINGE, Registrar, Companies, Close Corporations, Patents, Trade Marks and Designs, Ministry of Trade and Industry, Windhoek
<andima@mti.gov.na>

Linus INDONGO, Examiner of Trade Marks, Industry and Internal Trade, Ministry of Trade and Industry, Windhoek
<indongo@mti.gov.na>

NIGÉRIA/NIGERIA

Nkiru Felicia AGWU (Mrs.), Assistant Registrar, Commercial Law Department, Registry of Trade Marks, Patents and Designs, Federal Ministry of Commerce and Industry, Abuja
<nkaydarling@yahoo.com>

NORVÈGE/NORWAY

Solvår Winnie FINNANGER (Ms.), Senior Legal Advisor, Design and Trademark Department, Norwegian Industrial Property Office, Oslo
<swf@patentstyret.no>

Debbie RØNNING (Ms.), Senior Legal Advisor, Legal and International Affairs, Norwegian Industrial Property Office, Oslo
<dro@patentstyret.no>

OMAN

Fatima AL-GHAZALI (Ms.), Plenipotentiary Minister, Permanent Mission, Geneva

Amina Salim AL-JELANI (Mrs.), Director, Intellectual Property Department, Ministry of Commerce and Industry, Muscat

PARAGUAY

Rigoberto GAUTO VIELMAN, Ambassador, Permanent Representative, Permanent Mission, Geneva
<rigoberto.gauto@ties.itu.int>

Raúl MARTÍNEZ VILLALBA, Second Secretary, Permanent Mission, Geneva
<raul.martinez@ ties.itu.int>

PAYS-BAS/NETHERLANDS

Angela A. M. VAN DER MEER (Mrs.), Senior Policy Advisor, Directorate-General for Enterprise and Innovation Department, Netherlands Patent Office, Ministry of Economic Affairs, The Hague
<a.a.m.vandermeer@minez.nl>

PHILLIPINES

Josephine REYNANTE (Miss), First Secretary, Permanent Mission, Geneva

POLOGNE/POLAND

Marta Donata CZYŻ (Mrs.), Director, Trademark Department, Patent Office of the Republic of Poland, Warsaw
<mczyz@uprp.pl>

Andrzej SZCZEPEK, Expert, Trademark Department, Patent Office of the Republic of Poland, Warsaw
<aszczepk@uprp.pl>

PORTUGAL

Maria Joana CLETO (Ms.), Executive Officer, International Relations Department, National Institute of Industrial Property (INPI), Ministry of Economy and Innovation, Lisbon
<jmcleto@inpi.pt>

Luis Miguel SERRADAS TAUARES, Counsellor, Permanent Mission, Geneva

QATAR

Ahmed Yusif AL-JUFAIRI, Head, Trade Marks Office, Department of Commerce, Ministry of Economy and Commerce, Doha
<ajufairi@mbt.gov.qa>

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

KWAK Min Seob, Judge, The Patent Court of Korea, Daejeon
<kwag@scourt.go.kr>

JUNG Tae-Ho, Deputy Director, Examiner, Trademark Design Examination Policy Division, Korean Intellectual Property Office (KIPO), Daejeon
<jungtho@hanmail.net>

PARK Seong-Joon, First Secretary, Permanent Mission, Geneva

RÉPUBLIQUE DOMINICAINE/DOMINICAN REPUBLIC

Ysset ROMAN, Ministro Consejero, Misión Permanente, Ginebra

RÉPUBLIQUE POPULAIRE DÉMOCRATIQUE DE CORÉE/DEMOCRATIC PEOPLE'S
REPUBLIC OF KOREA

SOK Jong Myong, Counsellor, Permanent Mission, Geneva
<myngsok@yahoo.com>

RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Ludmila ČELIŠOVÁ (Ms.), Head, Industrial Designs Unit, Industrial Property Office, Prague
<lcelisova@upv.cz>

Radka STUPKOVÁ (Ms.), Head, Legal Unit, Industrial Property Office, Prague
<rstupkova@upv.cz>

ROUMANIE/ROMANIA

Gratiela DUDUTA (Mrs.), Legal Counsellor, Law Department, State Office for Inventions and Trademarks (OSIM), Bucharest
<gratiela.duduta@osim.ro>

ROYAUME-UNI/UNITED KINGDOM

Edward Stephan SMITH, Assistant Principal Hearing Officer, Trade Marks Directorate, Intellectual Property Office, Newport
<edward.smith@ipo.gov.uk>

SÉNÉGAL/SENEGAL

Elhadji Ibou BOYE, conseiller, Mission permanente, Genève

SERBIE/SERBIA

Vladimir MARIĆ, Head, Trademark Department, Intellectual Property Office, Belgrade
<vmaric@yupat.sv.gov.yu>

Radmila TEŠIĆ (Ms.), Senior Counsellor, Trademark Department, Intellectual Property Office, Belgrade

Vesna FILIPOVIĆ-NIKOLIĆ (Ms.), Counsellor, Permanent Mission, Geneva
<vesna.filipovic@bluewin.ch>

SINGAPOUR/SINGAPORE

CHAN Louis Ken Yu, Acting Director, Legal Counsel, Registry of Trademarks, Intellectual Property Office of Singapore (IPOS), Singapore
<louis_chan@ipos.gov.sg>

SLOVÉNIE/SLOVENIA

Vesela VENIŠNIK (Mrs.), Head, Trademark and Design Department, Slovenian Intellectual Property Office, Ministry of Economy, Ljubljana
<v.venisnik@uil-sipo.si>

SRI LANKA

Manorie MALLIKARATCHY (Mrs.), Second Secretary, Permanent Mission, Geneva
<manorie@lankamission.org>

SUÈDE/SWEDEN

Anneli SKOGLUND (Ms.), Deputy Director, Division for Intellectual Property and Transport Law, Ministry of Justice, Stockholm
<anneli.skoglund@justice.ministry.se>

Anne GUSTAVSSON (Ms.), Senior Legal Advisor, Designs and Trademark Division, Swedish Patent and Registration Office, Söderhamn
<anne.gustavsson@prv.se>

SUISSE/SWITZERLAND

Sandrine GERBER (Mme), conseillère juridique, Division des marques, Institut fédéral de la propriété intellectuelle (IPI), Berne

David LAMBERT, conseiller juridique, Division des marques, Institut fédéral de la propriété intellectuelle (IFPI), Berne
<david.lambert@ipi.ch>

Bianca MAIER (Mme), conseillère juridique, Division des marques, Institut fédéral de la propriété intellectuelle (IFPI), Berne

THAÏLANDE/THAILAND

Sukonthip SKOLPADUNGKET (Ms.), Trademark Registrar, Trademark Office, Department of Intellectual Property, Ministry of Commerce, Bangkok
<ip.thailand@gmail.com>

Tanyarat MUNGKALARUNGSU (Ms.), First Secretary, Permanent Mission, Geneva

TURQUIE/TURKEY

Yesim BAYKAL, Legal Counsellor, Turkish Patent Institute, Ankara

URUGUAY

Graciela ROAD D'IMPERIO (Sra.), Directora de Asesoría, Dirección Nacional de la Propiedad Industrial (DNPI), Ministerio de Industria, Energía y Minería, Montevideo
<groad@d.n.p.i.miem.gub.uy> <secretaria@dnpi.miem.gub.uy>

VIET NAM

TRAN HUU Nam, Deputy Director General, National Office of Intellectual Property (NOIP), Hanoi
<tranvanhiep@noip.gov.vn>

Duc Dung NGUYEN, Attaché, Permanent Mission, Geneva

YÉMEN/YEMEN

Fawaz AL-RASSAS, troisième secrétaire, Mission permanente, Genève

ZIMBABWE

Garikai KASHITIKU, First Secretary, Permanent Mission, Geneva

COMMUNAUTÉS EUROPÉENNES (CE)* / EUROPEAN COMMUNITIES (EC)*

Sergio BALIBREA, Counsellor, Permanent Mission, Geneva
<sergio.balibrea@ec.europa.eu>

Vincent O'REILLY, Director, Department for IP Policy, Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Alicante
<vincent.oreilly@oami.europa.eu>

* Sur une décision du Comité permanent, les Communautés européennes ont obtenu le statut de membre sans droit de vote.

* Based on a decision of the Standing Committee, the European Communities were accorded member status without a right to vote.

II. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/
INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

ORGANISATION BENELUX DE LA PROPRIÉTÉ INTELLECTUELLE (OBPI)/
BENELUX ORGANISATION FOR INTELLECTUAL PROPERTY (BOIP)

Camille JANSSEN, juriste, La Haye
<cjanssen@boip.int>

ORGANISATION MONDIALE DU COMMERCE (OMC)/WORLD TRADE
ORGANIZATION (WTO)

Wolf MEIER-EWERT, Legal Affairs Officer, Information and External Relations Division,
Geneva
<wolf.meier-ewert@wto.org>

III. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association américaine du droit de la propriété intellectuelle (AIPLA)/American Intellectual Property Law Association (AIPLA)

Brett HEAVNER, Chair, AIPLA Trademark Treaties and International Law Committee, Washington, D.C.

<b.brett.heavner@finnegan.com>

Association des industries de marque (AIM)/European Brands Association (AIM)

Jean BANGERTER, Representative, Brussels

<bangerter.jean@citycable.ch>

Association internationale pour la promotion de l'enseignement et de la recherche en propriété intellectuelle (ATRIP)/International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP)

François CURCHOD, représentant, Genolier

<francois.curchod@vtxnet.ch>

Association internationale pour la protection de la propriété industrielle (AIPPI)/International Association for the Protection of Industrial Property (AIPPI)

Peter WIDMER, Attorney-at-Law, Bern

<widmer@fmp-law.ch>

Association japonaise des conseils en brevets (JPAA)/Japan Patent Attorneys Association (JPAA)

Daisuke MAEDA, Member, Trademark Committee, Tokyo

<d.maeda@ipworld.jp>

Miwa HAYASHI (Ms.), Member, Design Committee, Tokyo

<mhayashi@tmi.gr.jp>

Yoko SAKUMA (Ms.), Member, International Activities Center, Tokyo

<tm@esakipat.co.jp>

Association japonaise pour les marques (JTA)/Japan Trademark Association (JTA)

TANAKA Hideki, Co-chair, International Activities Committee, Tokyo

<bqx10473@nifty.com>

Centre d'études internationales de la propriété intellectuelle (CEIPI)/Centre for International Intellectual Property Studies (CEIPI)

François CURCHOD, chargé de mission, Genolier

<francois.curchod@vtxnet.ch>

Chambre de commerce internationale (CCI)/International Chamber of Commerce (ICC)

Caroline de BUMAN (Ms.), Representative, Geneva

<caroline.debuman@economiesuisse.ch>

China Trademark Association (CTA)

LIU Yan (Ms.), Secretary-General, Beijing
<bj-lyan@sina.com>

WANG Tiger, Partner, GMKIP, Beijing
<whh@gmkip.com>

Fédération internationale des conseils en propriété industrielle (FICPI)/International
Federation of Industrial Property Attorneys (FICPI)

Andrew PARKES, Special Reporter (Trade Marks and Designs), Dublin
<andrew.parker@ficpi.org>

Robert James WATSON, Reporter (Designs Working Group), London
<robert.watson@ficpi.org>

International Trademark Association (INTA)

Bruno MACHADO, Geneva Representative, Rolle
<bruno.machado@bluewin.ch>

Knowledge Ecology International (KEI)

Thiru BALASUBRAMANIAM, Representative, Geneva
<thiru@keionline.org>

IV. BUREAU/OFFICERS

| | |
|-----------------------------|--|
| Président/Chair: | PARK Seong-Joon (République de Corée/ Republic of Korea) |
| Vice-présidents/Vice-chairs | Imre GONDA (Hongrie/Hungary) Joseph KAHWAGI RAGE (Mexique/Mexico) |
| Secrétaire/Secretary: | Marcus HÖPPERGER |

V. SECRETARIAT DE L'ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/
SECRETARIAT OF THE WORLD INTELLECTUAL
PROPERTY ORGANIZATION (WIPO)

Francis GURRY, directeur général/Director General

Ernesto RUBIO, sous-directeur général/Assistant Director General

Marcus HÖPPERGER, directeur par intérim de la Division du droit et des classifications internationales/Acting Director, Law and International Classifications Division

Martha PARRA FRIEDLI (Mme/Mrs.), chef de la Section du droit, Division du droit et des classifications internationales/Head, Law Section, Law and International Classifications Division

Marie-Paule RIZO (Mme/Mrs.), juriste principale à la Division du droit et des classifications internationales/Senior Legal Officer, Law and International Classifications Division

Violeta JALBA (Mme/Mrs.), juriste adjointe, Section du droit, Division du droit et des classifications internationales/Assistant Legal Officer, Law Section, Law and International Classifications Division

Nathalie FRIGANT (Mme/Mrs.), assistante juridique à la Division du droit et des classifications internationales/ Legal Assistant, Law and International Classifications Division

Noëlle MOUTOUT (Mlle/Ms.), assistante juridique à la Division du droit et des classifications internationales/Legal Assistant, Law and International Classifications Division

Kateryna GURINENKO (Mlle/Ms.), consultante à la Division du droit et des classifications internationales/Consultant, Law and International Classifications Division

[End of Annex II and of document]