

# WIPO



SCT/4/2

ORIGINAL: English

DATE: January 12, 2000

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

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

**Fourth Session**  
**Geneva, March 27 to 31, 2000**

DRAFT PROVISIONS ON TRADEMARK LICENSES

*prepared by the International Bureau*

## INTRODUCTION

1. The present document contains draft provisions on trademark licenses, with accompanying notes. The Annex contains model international forms concerning the presentation of a request for recordal of a trademark license or the cancellation of such a recordal and the presentation of a certificate of license. The draft Articles were considered by the WIPO Committee of Experts on Trademark Licenses at its first session, which took place from February 17 to 20, 1997 (see document TML/CE/I/3) and by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its third session (see document SCT/3/5), which took place from November 8 to 12, 1999.
2. It is hoped that the draft provisions could be finalized at the fourth session of the SCT (March 27 to 31, 2000). The SCT will, at that time, have to take a decision as to the form in which these provisions shall be adopted, and in particular whether to recommend them to the Assembly of the Paris Union and the WIPO General Assembly for adoption, for example as a Joint Recommendation, at the meetings of the WIPO Assemblies in October 2000.
3. Differences between the text of the draft Articles, Model International Forms and Notes submitted to the third session of the SCT and the text of the draft Articles, Model International Forms and Notes as contained in the present document have been highlighted as follows: (i) words which did not appear in document SCT/3/5 but appear in the present document are underlined and (ii) the omission of words which appeared in document SCT/3/5 from the present document is indicated by the sign \_.

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*Notes on Article 1*

1.01 *Items (i) to (x) seem to be self-explanatory. Items (i), (ii), (iii), (iv) and (v) correspond to the abbreviated expressions used in the Trademark Law Treaty. They have, therefore, been put into square brackets pending a decision as to the form in which the provisions will be adopted.*

1.02 The terms defined in items (vi) to (xi) are used in Article 2(1)(a)(vi) and in Section 8 of the Model International Form contained in the Annex.

*Article 1*

*Abbreviated Expressions*

For the purposes of these draft Provisions, unless expressly stated otherwise:

[(i) “Office” means the agency entrusted by a Contracting Party with the registration of marks;]

[(ii) “registration” means the registration of a mark by an Office;]

[(iii) “application” means an application for registration;]

~~(iii)~~ (iv) “mark” means a mark relating to goods (trademark) or to services (service mark) or to both goods and services;

~~(iv)~~ (v) “holder” means the person whom the register of marks shows as the holder of the registration;]

~~(v)~~ (vi) “Nice Classification” means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised and amended;]

~~(vi)~~ (vii) “license” means a license for the use of a mark under the applicable law of a Contracting Party;



[Article 1, continued]

(~~vii~~ viii) “licensee” means the person to whom the holder grants a license;

(~~viii~~ ix) “exclusive license” means a license which is only granted to one licensee and excludes the holder and any other person from using the mark;

(~~ix~~ x) “non-exclusive license” means a license which does not exclude the holder from using the mark or from granting further licenses to any other person;

(~~x~~ xi) “sole license” means a license which is only granted to one licensee but does not exclude the holder from using the mark.

*Notes on Article 2*

2.01 *Paragraph (1)(a)*. This provision sets out the elements which an Office may require to be presented in a request for recordal of a license for the use of a mark. The list of those elements constitutes a maximum; an Office is free to require some only of those elements, but it may not require other or additional requirements (see paragraph (2)).

2.02 *Items (i), (ii) and (iv)*. As far as the manner of indicating names and addresses is concerned, Rule 2 (*Manner of Indicating Names and Addresses*) of the TLT would apply.

2.03 *Items (ii) and (iii)*. Article 4(2) of the TLT would apply to these items, because recordal of a license is a “procedure before the Office.” Thus, under that Article, representation or an address for service may be required.

2.04 *Item (v)* has been added in order to allow a Contracting Party to determine, where necessary, if reciprocity is offered *vis-à-vis* its nationals in the country of which the licensee is a national. Since Article 3 of the Paris Convention for the Protection of Industrial Property provides that nationals of countries not members of the Paris Union are entitled to national treatment if they have a real and effective industrial or commercial establishment or are domiciled in one of the Paris Union countries, this item allows those indications to be required.

2.05 *Item (vi)* has been added in order to allow a Contracting Party to require that, where the holder, the licensee, or both parties are legal entities, the legal nature of the entity be specified. This provision mirrors Article 3(1)(a)(iv) of the TLT, which allows a similar requirement with regard to trademark applications.



*Article 2*

*Request for Recordal/Cancellation of the Recordal of a License*

(1) [*Contents of the Request for Recordal*] (a) Where the law of a Contracting Party provides for the recordal of a license with its Office, that Contracting Party may require that the request for recordal indicate:

- (i) the name and address of the holder;
- (ii) where the holder has a representative, the name and address of that representative;
- (iii) where the holder has an address for service, such address;
- (iv) the name and address of the licensee;
- (v) the name of a State of which the licensee is a national if he is a national of any State, the name of a State in which the licensee has his domicile, if any, and the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any;
- (vi) where the holder or the licensee is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

[Notes on Article 2, continued]

2.056 *Paragraph (1)(a), items (~~vii~~ vii) and (~~viii~~ viii).* These items seem to be self-explanatory.

2.067 *Item (~~viii~~ ix).* Definitions of “exclusive license,” “non-exclusive license” and “sole license” are contained in Article 1(~~viii~~ ix) to (~~x~~ xi). This item also allows a Contracting Party to require an indication that the license concerns only part of the territory for which the registration has effect, together with an explicit indication of that territory. It is to be noted that, as indicated by the words “where applicable,” if the law of a Contracting Party does not provide for one or more such indications, information corresponding to the item under consideration would not have to be furnished.

2.08 *Item (~~ix~~ x).* This item seems to be self-explanatory.

2.09 *Paragraph (1)(b).* In the interest of simplifying, to the extent possible, the formal requirements relating to the recordal of licenses, Contracting Parties may only require that the request be either signed by the holder of the registration or his representative, or that it be accompanied by one of the documents referred to in that provision. It seems justified to allow such requirements in order to ensure, on the one hand, that the holder has actually consented to the license, and, on the other hand, that there is a way for the licensee to file the request for recordal independently of the holder if the latter, after having concluded the license contract, refuses to record it. The documents listed can replace the signature of the holder on the request. The requesting party may file any one of them. The list is inspired by the list contained in Article 11(1)(b) of the TLT regarding formal requirements for the recordal of changes in ownership resulting from a contract. Attention is drawn to the obligation to apply Article 8(4) (*Signature, Prohibition of Requirement of Certification*) of the TLT to the request for recordal, which prohibits the attestation, notarization, authentication, legalization or other certification of any signature or seal.

[Article 2(1)(a), continued]

(~~vii~~ vii) the registration number of the mark which is the subject of the license;

(~~viii~~ viii) the names of the goods and/or services for which the license is granted, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification;

(~~viii~~ ix) where applicable, the fact that the license is an exclusive license, a non-exclusive license, a sole license, ~~or~~ and that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;

(~~ix~~ x) the ~~term~~ time period of the license;

(b) A Contracting Party may require that the request be either signed by the holder or his representative or that it be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the license contract;

[Notes on Article 2, continued]

2.10 *Paragraph (1)(bc)*. As regards the amount of fees that an Office may charge for the recordal of a license, it should be noted that nothing in the text would prevent an Office from charging varying fees depending on the number of registrations and/or applications to which the request relates.

2.0911 *Paragraph (2)*. The effect of this paragraph is that, for the purposes of the recordal of a license with its Office, a Contracting Party may not require that the applicant give information in addition to what may be required under paragraph (1), or that he furnish any additional document, such as evidence showing the existence of quality control clauses (as regards quality control, see note 4.03).

2.102 By way of example, *items (i) and (ii)* mention certain items of information whose furnishing to an Office is usually regarded by the parties to a license contract as particularly burdensome or as revealing confidential business information (*item (iii)*). It should be noted, however, that paragraph (2) does not prevent other authorities of Contracting Parties (for example, tax authorities or authorities establishing statistics) from requiring the parties to a license contract to furnish information in accordance with the applicable law.

[Article 2(1)(b), continued]

(ii) an extract of the contract, showing the change in ownership;

(iii) an uncertified certificate of license drawn up in the form and with the content as prescribed in the Regulations and signed by both the holder and the licensee.

(c) Any Contracting Party may require that, in respect of the recordal of a license, a fee be paid to the Office.

(2) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraph (1) be complied with in respect of the recordal of a license with its Office. In particular, the following may not be required:

(i) the furnishing of the registration certificate of the mark which is the subject of the license;

(ii) the furnishing of the license contract or a translation of it;

(iii) an indication of the financial terms of the license contract.

[Notes on Article 2, continued]

2.14~~3~~ *Paragraph (3)*. The requirements for the presentation of a request for recordal of a license are similar to those set out in the TLT for other kinds of requests. It is to be noted that a request may be presented by either the holder or the licensee (or their respective representatives), provided that it is either signed by the holder or his representative, or that it is accompanied by any one of the documents listed in paragraph (1)(b), at the option of the requesting party (see Note 2.08 above). The effect of *item (i)* is that the Office of a Contracting Party must accept a request for recordal of a license where that request is presented on a form corresponding to the form provided for in the Annex of this document.

2.12~~4~~ *Item (ii)*. The Office of a Contracting Party is not obliged to accept the transmittal of communications by telefacsimile. However, where it accepts such transmittals, it must apply Article 8(2) (*Signature, Communication by Telefacsimile*) and Rule 6(2) (*Details Concerning the Signature, Communication by Telefacsimile*) of the TLT where a request for recordal of a license is so transmitted. Those provisions require Contracting Parties to accept signatures on requests transmitted by telefacsimile, but allow them to request that a paper copy of the document transmitted by telefacsimile be presented within a period of time which must be at least one month. The provision does not yet refer to requests filed by other electronic means, since this appears to be a horizontal problem which is of relevance not only for these provisions but also for the TLT, and would, therefore, seem to require a harmonized response.

2.15 *Paragraph (4)* is in line with the approach adopted by the TLT in Articles 10(1)(e) and 11(1)(h), namely, to allow that requests for recordal can refer to more than one registration. This is an important simplification in cases where a license is granted for several marks (for example, a series of marks). However, this is subject to the following conditions: The holder and the licensee must be the same for all registrations covered by the license for which recordal is requested and, where applicable, the scope of the license as indicated in Article 2(1)(a)(viii) and (ix) (i.e., exclusive, non-exclusive, sole, limited to a part of the territory covered by the registration, term) must be the same for all registrations covered by the license for which recordal is requested. If these conditions are not met, for example, if the holder and the licensee are not identical in respect of all registrations contained in the request, the Office may require that separate requests must be made filed. Since paragraph (4) only describes the situations in which an Office is obliged to accept a single request for several registrations, an Office is free to accept a single request even if the conditions outlined in paragraph (4) are not met.

2.16 *Paragraph (5)*. Article 2 and the model request form contained in the Annex are applicable to requests for the recordal of licenses of applications, if the national or regional law of a Contracting Party provides for such recordal. ~~The Rule which is referred to in this paragraph is~~ It should be noted that in this context, Rule 7 of the Regulations under the TLT (*Manner of Identification of an Application Without Its Application Number*) would be applicable.

[Article 2, continued]

(3) [*Presentation of the Request*] As regards the requirements concerning the presentation of the request, no Contracting Party shall refuse the request,

(i) where the request is presented in writing on paper, if it is presented on a form corresponding to the request Form provided for in the Annex to these Provisions, or

(ii) where the Contracting Party allows the transmittal of communications to the Office by telefacsimile and the request is so transmitted, if the paper copy resulting from such transmittal corresponds to the request Form referred to in item (i),

provided that the request is presented in the language, or in one of the languages, admitted by the Office and is either signed by the holder or his representative or accompanied by any one of the documents referred to in paragraph (1)(b).

(4) [*Single Request Relating to Several Registrations*] A single request shall be sufficient even where the license relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request, the holder and the licensee are the same for all registrations, and the request indicates the scope of the license ~~as indicated~~ in accordance with paragraph (1)(a)(viii) and (ix) is the same for all registrations.

(5) [*Request Relating to Applications*] Paragraphs (1) to (4) shall apply, *mutatis mutandis*, to requests for recordal of a license for an application.

[Notes on Article 2, continued]

2.17 *Paragraph (6)*. Where the recordal of a license has been effected, such recordal may at a certain point in time be the subject of a request for cancellation. For this reason, paragraph (6) provides that Article 2(1) to (5) and the model request form contained in the Annex are applicable, *mutatis mutandis*, to requests concerning the cancellation of the recordal of a license. Following discussions at the third session of the SCT, amendments of the recordal (see the Report in document SCT/3/10, paragraph 120) has been added to the text and put into square brackets. It should be noted, however, that an amendment can only concern those elements of a license contract that a Contracting Party may require to be indicated under Article 2, such as the goods or services covered, the nature of the license, or its time period.



[Article 2, continued]

(6) [*Request for [Amendment or] Cancellation of a Recordal*] Paragraphs (1) to (5) shall apply, *mutatis mutandis*, where the request concerns the [amendment or] cancellation of the recordal of a license.

*Notes on Article 3*

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

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

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

*Article 3*

*Effects of the Non-Recordal of a License*

[(1)] [*Validity of the Registration and Protection of the Mark*] The non-recordal of a license with the Office or with any other authority of the Contracting Party shall not affect the validity of the registration of the mark which is the subject of the license, or the protection of that mark.

[(2)] [*Certain Rights of the Licensee*] A Contracting Party may not require the recordal of a license as a condition for any right that the licensee may have under the law of that Contracting Party to join infringement proceedings initiated by the holder or to obtain, by way of such proceedings, damages resulting from an infringement of the mark which is the subject of the license.]

[Notes on Article 3, continued]

3.04 The question whether the non-recorded licensee should have the right to join infringement proceedings initiated by the holder and to recover damages was the subject of an intensive debate during the first session of the Committee of Experts on Trademark Licenses (see document TML/CE/I/3, paragraphs 70 to 74), and during the third session of the Standing Committee on the Law of trademarks Industrial Designs and Geographical Indications (SCT) (see document SCT/3/10, paragraphs 122 to 124). Delegations which opposed paragraph (2) argued that, under the law of their countries, a license had only effect *vis-à-vis* third parties if it was recorded. Delegations and representatives of observer organizations who expressed their support for paragraph (2) emphasized that making the right for the non-recorded licensee to recover damages (in infringement proceedings initiated by the holder) dependent on a recordal would only benefit trademark infringers, since they would not be liable for damages which were caused by the unauthorized use of a trademark. if the right of the licensee to recover damages in infringement proceedings initiated by the holder depended on the registration of the license, this would only benefit trademark infringers, since they might not be liable at all when the only person suffering damages from the the unauthorized use of the mark is the licensee. From the point of view of trademark infringers it should not make any difference whether the protected mark was used under a recorded license. What mattered in such cases was that the mark is protected and this could be checked by reference to the trademark register.

3.05 It is worthwhile to note that, if a Contracting Party considers a licence legally effective *vis-à-vis* third parties only when it was recorded, such a provision would not necessarily have to be interpreted as meaning the requirement to record a license in order to give that license effect *vis-à-vis* third parties must not necessarily mean that a non-recorded licensee shall not have the right to recover damages for the infringement of the licensed mark (as expressed by one delegation in the first meeting of the Committee of Experts (see document TML/CE/I/3, paragraph 72). Such provisions would nevertheless have an effect in cases A potential effect of the non recordal of a license which is not touched by paragraph (2) would be that where a registration was transferred after the conclusion of the license, because a non-recorded licensee would not be able to invoke the license against a transferee. This is not prohibited by paragraph (2) which only deals with one specific situation, namely the right of the unrecorded licensee to join infringement proceedings initiated by the holder, and to recover damages by way of such proceedings.

3.06 As agreed at the third session of the SCT, paragraph (2) has been retained in square brackets (see document SCT/3/10, paragraph 124). In essence, paragraph (2) has been kept in the present draft, thereby esteeming the right of the (lawful) non-recorded licensee to recover damages higher than the potential interest of the public to be informed that a registered trademark is used under a license. From the point of view of the infringing party, it does not seem to make any difference whether the protected mark is used by the holder and/or the licensee or whether or not the mark is used under a recorded license. What really is important is that the mark is protected and this can be checked by a reference to the trademark register.



*Notes on Article 4*

4.01 *Paragraph (1)*. ~~This provision is especially important, since~~ The question whether use by a person other than the holder can be considered as use by the holder may be relevant in at least three different contexts: (i) for determining whether a mark has acquired distinctiveness, (ii) for determining whether a mark has become well-known, (iii) for determining whether a mark has been sufficiently used to maintain its registration. As far as the latter question is concerned, it should be noted that it is a generally accepted standard in trademark law that registered marks which are not used for a certain period of time are liable to be invalidated. For example, Article 19.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the “TRIPS Agreement”) allows WTO Members to invalidate registered marks which have not been used for more than three years. In general, a mark has to be used by its holder or by a person having the holder’s permission in order to maintain its registration. Certain national or regional laws, however, provide that use by persons other than the holder may be held to constitute use of the mark by the holder only if certain conditions are fulfilled, such as the conclusion of a formal license contract containing quality control clauses or such as the recordal of such a contract. In that respect, it is to be noted that Article 19.2 of the TRIPS Agreement expressly allows a requirement that there be control of a licensee’s use of a mark by the holder in order to consider such use valid for maintaining the registration of the mark.

4.02 The effect of the paragraph under consideration is that, whenever the question of use becomes relevant, any use of a mark by any person other than the holder must be deemed to be use of the mark by the holder, provided that such use is made with the consent of the holder. No other condition, such as control by the holder of the use of the mark, may be required by a Contracting Party. Consequently, if, in the absence of use of the mark by the holder, a third party uses that mark with the consent of the holder, the mark cannot be invalidated on the ground of non-use. However, Article 4 only deals with the specific question under what circumstances use by natural persons or legal entities other than the holder can be deemed as use by the holder. It does not address the validity of licensing agreements in general. Therefore, the ability of Contracting Parties to require quality control clauses in order for a licensing agreement to be valid remains unaffected.

4.023 *Paragraph (2)* makes it clear that it is sufficient for the holder to consent to the use of his mark in order to benefit from such use whenever the question of use becomes relevant, i.e. in the context of a trademark acquiring distinctiveness or becoming well-known, or for the purpose of maintaining a trademark registration. In particular, Contracting Parties are not allowed to require in these contexts that the license be in writing, that it be exclusive, that it contain quality control provisions or that it be recorded by the Office or any other authority. In essence, any use of the mark by any third party to which the holder consents—whether expressly or tacitly—must be considered use ~~in order to uphold the registration of the mark being so used by the holder.~~

*Article 4*

*Use of a Mark on Behalf of the Holder*

(1) [*Use Deemed to Be on Behalf of the Holder*] Use of a mark by natural persons or legal entities other than the holder shall be deemed to constitute use by the holder himself if such use is made with the holder's consent.

(2) [*No Requirements as to Written Form or Recordal*] Paragraph (1) applies even where there is no written license or, if a written license exists, even where the license has not been recorded with the Office or any other authority of the Contracting Party.

[Notes on Article 4, continued]

4.03 — ~~The general idea that underlies Article 4 is that, with regard to the question whether use by someone other than the holder constitutes use by the holder, it should be entirely left to the responsibility of the holder to control the use of his mark. This does of course not apply to product standards which are based on public law such as, for example, product liability, safety or health standards. The kind of control which is envisaged here is, for example, the quality of the cloth which the licensee uses for manufacturing the shirts which he then sells under the trademark of the holder. A responsible holder/licensor will take care that any licensing agreement which he concludes provides for quality control clauses or that his mark is only used under a formal licensing agreement. However, non-compliance with such clauses is a contractual matter and should not be subject to administrative procedures. If the licensee uses the licensed mark on products of an inferior quality, the public will lose confidence in the mark and will, eventually, stop buying those goods. It is not realistic to expect an administrative body to enforce a certain quality of licensed goods, since the holder is free (again within certain parameters of public regulations) to determine the quality of the goods or services which he offers. If the holder decides to lower the quality of certain goods, the consuming public may well turn away from those goods, but this does not entail the invalidation of the registration. The same should be applicable with regard to a licensee.~~





*Notes on Article 5*

5.01 *Article 5* concerns specific indications relating to trademark licenses which may be required, under trademark law, under general labeling law or under advertising law, to appear on products or packaging or to be given in connection with the providing of services or in advertising for such goods or services. It is not the intention of this Article to regulate general questions of product (or service) information required by labeling laws, law on advertising or consumer protection laws. Consequently, national laws and regulations requiring that certain indications relating, for example, to the safety of a product, its composition, its correct use, etc., must appear on its packaging are outside the scope of that Article.

5.02 *Article 5* leaves it to the law of a Contracting Party to prescribe whether or not goods which are commercialized under a licensed mark, or their packaging, must bear an indication of the fact that the mark is used under a license contract, or whether or not such an indication has to be given in connection with the providing of services or in advertising for such goods or services. However, where such indication is required by the applicable law, non-compliance with that obligation should not entail the invalidation of the registration of the mark. The existence of the registration should not depend on compliance with requirements concerning labeling or advertising, irrespective of whether they are contained in trademark laws or in other laws such as laws on labeling or advertising. In particular (and this is the effect of the reference to Article 4(1) which appears at the end of Article 5), Contracting Parties are not allowed to cancel the registration of a mark because the only use of that mark was use by a licensee who did not ~~mention~~ indicate the license on the goods, or their packaging, or in connection with the providing of services or in advertising for the goods or services, for which the mark was used, even if a requirement to that effect existed in that Contracting Party. The underlying thought is that the invalidation of the registration of a licensed mark is too severe a sanction for non-compliance with a labeling or advertising requirement and should therefore not be allowed. Furthermore, non-compliance with labeling or advertising provisions should not lessen the possibilities to enforce the rights attached to a licensed mark. This means that ~~the absence of, or a defect in, a mention~~ a missing or defective indication of ~~at~~ the license cannot constitute an argument in favor of the defending party in infringement proceedings, even if such ~~mention~~ indication is mandatory under the applicable law. The result of Article 5 is that ~~any~~ no sanction for non-compliance with a labeling or advertising requirement, even if that requirement concerns the mention of a license, ~~must not~~ may affect trademark rights.

*Article 5*

*Mention Indication of the License*

Where the law of a Contracting Party requires ~~a mention, in connection with the use of the licensed mark, of the fact that the mark is used under a license, the lack of, or any defect in, such mention~~ an indication that the mark is used under a license, full or partial non-compliance with that requirement shall not affect the validity of the registration of the mark which is the subject of the license or the protection of that mark, and shall not affect the application of Article 4(1).

[Annex follows]



**MODEL INTERNATIONAL FORM No 1**

**REQUEST FOR RECORDAL OF LICENSE/CANCELLATION  
OF RECORDAL OF LICENSE**

in respect of application(s) and/or registered mark(s),

submitted to the Office of .....

FOR OFFICE USE ONLY

Reference indication of holder/applicant  
and/or licensee:<sup>1</sup> .....

Reference indication of representative:<sup>1</sup> .....

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**1. Request for Recordal/Cancellation<sup>2</sup>**

- The recordal of the fact that the registration(s) and/or application(s) mentioned in the present request is (are) the subject of a license is hereby requested.
- The cancellation of the ~~renewal~~ recordal of the license(s) concerning the registration(s) and/or application(s) mentioned in the present request is hereby requested.

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<sup>1</sup> Any reference indication allotted by the holder and/or licensee and/or any reference indication allotted by the representative to the present request may be given in this space.

<sup>2</sup> Check the appropriate box.

**2. Registration(s) and/or Application(s) Concerned**

The present request concerns the following registration(s) and/or application(s):

2.1 Registration and/or application number(s):

2.2  If the space under item 2.1 is not sufficient, check this box and provide the information on an additional sheet.

---

**3. Holder(s)/Applicant(s)**

3.1 If the holder/applicant is a natural person, the person's

(a) family or principal name:<sup>3</sup>

(b) given or secondary name(s):<sup>3</sup>

3.2 If the holder/applicant is a legal entity, the entity's full official designation:

3.3 Address (including postal code and country):

Telephone number(s):<sup>4</sup>

Telefacsimile numbers(s):<sup>4</sup>

3.4 Where the holder is a legal entity, indicate

- the legal nature of the legal entity:

- the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

3.45  Check this box if there is more than one holder; in that case, list the additional holders on a separate sheet and indicate, in respect of each of them, the data referred to in items 3.1 or 3.2 and 3.3.

---

<sup>3</sup> The names to be indicated under (a) and (b) are those which appear in the records of the Office in respect of the holder of the registration(s) to which the present request relates.

<sup>4</sup> Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

**4. Licensee**

4.1 If the licensee is a natural person, the person's

(a) family or principal name:

(b) given or secondary name(s):

4.2 If the licensee is a legal entity, the entity's full official designation:

4.3 Address (including postal code and country):

Telephone number(s):<sup>5</sup>

Telefacsimile numbers(s):<sup>5</sup>

4.4 State of nationality of the licensee:

4.5 State of domicile of the licensee:

4.6 State of real and effective industrial or commercial establishment of the licensee:

~~Telephone number(s):~~ ~~Telefacsimile numbers(s):~~

4.7 Where the licensee is a legal entity, indicate

- the legal nature of the legal entity:

- the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

4.7  Check this box if there is more than one licensee; in that case, list each additional licensee on a separate sheet and indicate, in respect of each of them, the data referred to in items 4.1 or 4.2 and 4.3.

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<sup>5</sup> Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

## 5. Representative

5.1 Representing<sup>6</sup>  the holder  the licensee

5.12 Name:

5.23 Address (including postal code and country):

Telephone number(s):

Telefacsimile number(s):

5.34 Registration number, if registered with the Office:

5.45 Number allotted to the power of attorney:<sup>7</sup>

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## 6. Address for Service<sup>8</sup>

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## 7. Goods and/or Services for Which the License Is Granted<sup>9</sup>

7.1  The license is granted for all the goods and/or services listed in the registration(s) and/or application(s) referred to in item 2.

7.2  Only one registration or application is mentioned in item 2 and the license is only granted for some of the goods and/or services listed in that registration or application. The following goods and/or services that are covered by the license:

7.3  More than one registration and/or application is mentioned in item 2, and in respect of at least one of them, the license covers less than all the goods and/or services listed. In this case, indicate on an additional sheet, separately in respect of each registration and/or applications, whether the license covers all the goods and/or services or only some of them.

---

<sup>6</sup> Check the appropriate box.

<sup>7</sup> Leave blank if the power of attorney has not, or has not yet, been allotted a number or if the number is not known to the holder/applicant or the representative.

<sup>8</sup> According to Article 4(2)(b) of the TLT, an address for service must be indicated in the space available under the title of item 6 where the holder/applicant does not have, or has not indicated, a domicile or a real and effective industrial or commercial establishment on the territory of the Contracting Party whose Office is the Office named on the first page of the present request, except where a representative is indicated in item 5.

<sup>9</sup> Check the appropriate box.



## 8. Kind of License<sup>9</sup>

- 8.1  The license is an exclusive license.
- 8.2  The license is a non-exclusive license.
- 8.3  The license is a sole license.
- 8.4  The license concerns only the following part of the territory covered by the registration:

---

## 9. ~~Term~~ Time Period of License

The license is granted from .....to .....

---

## 10. Signatures or Seals<sup>10</sup>

10.1 Signature(s) or seal(s) of the holder(s)/~~applicant~~(s):

10.1.1 Name of the holder/~~applicant~~ or, if the holder/~~applicant~~ is a legal entity, name of the person who acts on behalf of the holder/~~applicant~~:

10.1.2 Date of signature or of sealing:

10.1.3 Signature or seal:

10.2 Signature(s) or seal(s) of the licensee(s)/applicant(s):<sup>11</sup>

10.2.1 Name of the licensee/applicant or, if the licensee/applicant is a legal entity, name of the person who acts on behalf of the licensee/applicant:

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<sup>10</sup> If there is more than one person signing or whose seal is used, all of the indications under subitems 10.1 and 10.2 should be given on an additional sheet.

<sup>11</sup> The signature of the licensee/applicant is only necessary if the request is not signed by the holder. In this case, the application must be accompanied, at the option of the requesting party, by one of the following: (i) a copy of the license contract, which copy may be required to be certified, by a notary public or any other competent public authority, as being in conformity with the original contract; (ii) an extract of the contract, showing the change in ownership, which extract may be required to be certified, by a notary public or any other competent public authority, as being a true extract of the contract; (iii) an uncertified certificate of license drawn up in the form and with the content as prescribed in the Regulations and signed by both the holder and the licensee.

10.2.2 Date of signature or of sealing:

10.2.3 Signature or seal:

10.3 Signature or seal of the representative:

10.3.1 Name of the natural person who signs or whose seal is used:

10.3.2 Date of signature or of sealing:

10.3.3 Signature or seal:

---

**11. Fee**

11.1 Currency and amount of the fee paid in connection with the present request:

11.2 Method of payment:

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**12. Additional Sheets**

Check this box if additional sheets are enclosed and indicate the total number of such sheets:

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## MODEL INTERNATIONAL FORM No 2

*NB:*

*New, drafted according to Model International Form (MIF) No 1 above and MIF No 5 of the TLT*

### CERTIFICATE OF LICENSE

in respect of application(s) and/or registered mark(s),

FOR OFFICE USE ONLY

submitted to the Office of .....

Reference indication of holder/licensor  
and/or licensee:<sup>12</sup> .....

---

#### 1. Certification

The undersigned holder(s)/licensor(s) and licensee(s) hereby certify that the registration(s) and/or application(s) identified below is (are) the subject of a license

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<sup>12</sup> Any reference indication allotted by the holder and/or licensee and/or any reference indication allotted by the representative to the present request may be given in this space.

## 2. Registration(s) and/or Application(s) Concerned

The present certificate concerns the following registration(s) and/or application(s):

2.1 Registration and/or application number(s):

2.2  If the space under item 2.1 is not sufficient, check this box and provide the information on an additional sheet.

---

## 3. Holder(s)/licensor(s)

3.1 If the holder/licensor is a natural person, the person's

(a) family or principal name:<sup>13</sup>

(b) given or secondary name(s):<sup>3</sup>

3.2 If the holder/licensor is a legal entity, the entity's full official designation:

3.3 Address (including postal code and country):

Telephone number(s):<sup>14</sup>

Telefacsimile numbers(s):<sup>4</sup>

3.4 Where the holder/licensor is a legal entity, indicate

- the legal nature of the legal entity:
- the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

3.5  Check this box if there is more than one holder; in that case, list the additional holders on a separate sheet and indicate, in respect of each of them, the data referred to in items 3.1 or 3.2 and 3.3.

---

<sup>13</sup> The names to be indicated under (a) and (b) are those which appear in the records of the Office in respect of the holder of the registration(s) to which the present request relates.

<sup>14</sup> Even where the Office elects to request this information, the holder/licensor or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

#### 4. Licensee

4.1 If the licensee is a natural person, the person's

(a) family or principal name:

(b) given or secondary name(s):

4.2 If the licensee is a legal entity, the entity's full official designation:

4.3 Address (including postal code and country):

Telephone number(s):<sup>15</sup>

Telefacsimile numbers(s):<sup>5</sup>

4.4 State of nationality of the licensee:

4.5 State of domicile of the licensee:

4.6 State of real and effective industrial or commercial establishment of the licensee:

4.7 Where the applicant is a legal entity, indicate

- the legal nature of the legal entity:
- the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

4.8  Check this box if there is more than one licensee; in that case, list each additional licensee on a separate sheet and indicate, in respect of each of them, the data referred to in items 4.1 or 4.2 and 4.3.

---

#### 5. Goods and/or Services for Which the License Is Granted<sup>16</sup>

5.1  The license is granted for all the goods and/or services listed in the registration(s) and/or application(s) referred to in item 2.

5.2  Only one registration or application is mentioned in item 2 and the license is only granted for some of the goods and/or services listed in that registration or application. The following goods and/or services that are covered by the license:

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<sup>15</sup> Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

<sup>16</sup> Check the appropriate box.

- 5.3  More than one registration and/or application is mentioned in item 2 ,and in respect of at least one of them, the license covers less than all the goods and/or services listed. In this case, indicate on an additional sheet, separately in respect of each registration and/or applications, whether the license covers all the goods and/or services or only some of them.
- 

## 6. Kind of License<sup>6</sup>

- 6.1  The license is an exclusive license.
- 6.2  The license is a non-exclusive license.
- 6.3  The license is a sole license.
- 6.4  The license concerns only the following part of the territory covered by the registration:
- 

## 7. Time Period of License

The license is granted from .....to .....

---

## 8. Signatures or Seals<sup>17</sup>

- 8.1 Signature(s) or seal(s) of the holder(s)/licensor(s):
- 8.1.1 Name of the holder/licensor or, if the holder/licensor is a legal entity, name of the person who acts on behalf of the holder/licensor
- 8.1.2 Date of signature or of sealing:
- 8.1.3 Signature or seal:
- 

<sup>17</sup> If there is more than one person signing or whose seal is used, all of the indications under subitems 10.1 and 10.2 should be given on an additional sheet.

8.2 Signature(s) or seal(s) of the licensee(s):

8.2.1 Name of the licensee or, if the licensee is a legal entity, name of the person who acts on behalf of the licensee:

8.2.2 Date of signature or of sealing:

8.2.3 Signature or seal:

---

**9. Additional Sheets**

Check this box if additional sheets are enclosed and indicate the total number of such sheets:

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[End of Annex and of document]