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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Fourth Session Geneva, March 27 to 31, 2000

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. The session was opened by Mr. Shozo Uemura, Deputy Director General, who welcomed the participants.

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

2. The Standing Committee unanimously elected Ms. Lynne Beresford (United States of America) as Chair, and Mrs. Agnès Marcadé (France) and Mr. Vladimir García-Huidobro (Chile) as Vice-Chairs. Mr. Denis Croze (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 3: Adoption of the Agenda

3. The Agenda (document SCT/4/1) was adopted without modification.

Agenda Item 4: Adoption of the Report of the Third Session

4. The Report of the third session (document SCT/3/10) was adopted without modification.

Agenda Item 5: Draft Provisions on Trademark Licenses (see document SCT/4/2)

5. The Joint Recommendation and the provisions were adopted as presented in the Annex, by a consensus of the SCT, subject to reservations by India with regard to Article 2(7)(iii), and by the European Community with regard to Article 3. Brazil stated that it could not join the consensus at this time concerning Article 2(7)(ii) and (iii), pending further discussion and instructions from its capital. The Explanatory Notes and Forms will be revised by the International Bureau and will be circulated on the electronic forum for comments.

6. The SCT proposed that the Joint Recommendation Concerning Trademark Licences be presented for adoption to the Paris Union Assembly and the WIPO General Assembly in September 2000.

Agenda Item 6: Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (see document SCT/4/3)

7. The SCT agreed that it was appropriate for the issues raised by certain provisions of the preliminary draft Convention on International Jurisdiction and the Effects of Judgments in Civil and Commercial Matters, as adopted by the Special Commission of the Hague Conference on Private International Law, to be taken up by the Member States of WIPO in a separate WIPO forum which covered all areas of intellectual property law, and that experts in private international law as well as in all types of intellectual property law should be involved. The International Bureau indicated that the SCT would be kept informed of the work of that separate forum, especially in regard to the law of trademarks, geographical indications, and industrial designs, and the separate forum would be kept informed of the related work of the SCT, especially in regard to the protection of trademarks and other distinctive signs on the Internet. The comments of Delegations which spoke regarding specific provisions of the preliminary draft Convention will appear in the report of this session.

Agenda Item 7: Draft Provisions on the Protection of Trademarks and Other Distinctive Signs on the Internet (see document SCT/4/4)

8. The SCT discussed the draft provisions contained in document SCT/4/4, and agreed that the International Bureau would produce a revised draft for the fifth session of the SCT, on the basis of these discussions.

Agenda Item 8: Future work

9. The SCT agreed that its fifth session would tentatively be held from September 11 to 15, 2000, in Geneva, and would last five full days.

10. The SCT further agreed that the agenda of the next meeting would consist of the following substantive items:

- Use of Trademarks and other distinctive signs on the Internet, including the issue of Unfair Competition on the Internet
- Geographical Indications.

[Annex follows]

ANNEX

PROPOSED JOINT RECOMMENDATION CONCERNING
TRADEMARK LICENSES

Joint Recommendation

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO);

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property and of the Trademark Law Treaty (TLT);

Recommend that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its fourth session, as guidelines concerning trademark licenses;

It is further recommended to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring these provisions to the attention of that organization.

Article 1

Abbreviated Expressions

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

- (i) “Office” means the agency entrusted by a Member State with the registration of marks;
- (ii) “registration” means the registration of a mark by an Office;
- (iii) “application” means an application for registration;
- (iv) “mark” means a mark relating to goods (trademark) or to services (service mark) or to both goods and services;
- (v) “holder” means the person whom the register of marks shows as the holder of the registration;
- (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;
- (vii) “license” means a license for the use of a mark under the applicable law of a Member State;

[Article 1, continued]

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

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

(x) “sole license” means a license which is only granted to one licensee and excludes the holder from granting licenses to any other person, but does not exclude the holder from using the mark;

(xi) “non-exclusive license” means a license which does not exclude the holder from using the mark or from granting licenses to any other person.

Article 2

Request for Recordal of a License

(1) [*Contents of the Request for Recordal*] Where the law of a Member State provides for the recordal of a license with its Office, that Member State may require that the request for recordal contain some or all of the following indications or elements:

- (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) where the licensee has a representative, the name and address of that representative;
- (vi) where the licensee has an address for service, such address;
- (vii) 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;

[Article 2(1), continued]

(viii) 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;

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

(x) 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;

(xi) where applicable, that the license is an exclusive license, a non-exclusive license, or a sole license;

(xii) where applicable, 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;

(xiii) the time period of the license;

(xiv) a signature as specified in paragraph (2).

[Article 2, continued]

(2) [*Signature*] (a) A Member State shall accept the signature of the holder or his representative, whether or not it is accompanied by the signature of the licensee or his representative.

(b) A Member State shall also accept the signature of the licensee or his representative, even if it is not accompanied by the signature of the holder or his representative, provided that it is accompanied by one of the following:

(i) an extract of the license contract indicating the parties and the rights being licensed, certified by a notary public or any other competent public authority as being a true extract of the contract;

(ii) an uncertified statement of license, drawn up in the form and with the content as prescribed in the statement of license Form provided for in the Annex to these provisions, and signed by both the holder or his representative and the licensee or his representative.

(3) [*Presentation of the Request*] As regards the requirements concerning the presentation of the request, no Member State shall refuse the request where the presentation and arrangement of indications and elements in the request correspond to the presentation and arrangement of indications and elements in the request Form provided for in the Annex to these provisions.

[Article 2, continued]

(4) [*Language; Translation*] (a) A Member State may require that the request be in the language, or in one of the languages, admitted by the Office.

(b) A Member State may require that, if the document referred to in paragraph (2)(b)(i) or (ii) is not in the language, or in one of the languages, admitted by the Office, the request be accompanied by a certified translation of the required document in the language, or in one of the languages, admitted by the Office.

(5) [*Fees*] Any Member State may require that, in respect of the recordal of a license, a fee be paid to the Office.

(6) [*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 in accordance with paragraph (1)(a) with respect to all registrations.

(7) [*Prohibition of Other Requirements*] No Member State may demand that requirements other than those referred to in paragraphs (1) to (6) 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;

[Article 2(7), continued]

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

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

(8) [*Request Relating to Applications*] Paragraphs (1) to (7) shall apply, *mutatis mutandis*, to requests for recordal of a license for an application, where the applicable law of a Member State provides for such recordal.

Article 3

Request for Amendment or Cancellation of a Recordal

Article 2 shall apply, *mutatis mutandis*, where the request concerns the amendment or cancellation of the recordal of a license.

Article 4

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 Member State 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) A Member State may not require the recordal of a license as a condition for any right that the licensee may have under the law of that Member State 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.

(b) If subparagraph (a) is not compatible with the national law of a Member State, that subparagraph shall not apply in respect of that Member State.

Article 5

Use of a Mark 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.

Article 6

Indication of the License

Where the law of a Member State requires 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 5.

Notes on Article 2

XX This Article provides a maximum list of indications and elements that may be required by a Member State with respect to a request for recordal of a license. It is understood that a Member State may, in addition to requiring that these indications and elements be supplied by the requesting party, subject the request to a formalities examination and, if the Office considers that any of the indications or elements fails the examination, contact the requesting party for clarification and/or amendment.

XX *Paragraph (2)*. The request for recordal of a licence is different in nature from the request for a recordal of the change in ownership of registration of a mark, as provided for in Article 11(1)(d) of the TLT. For example, some countries require all co-holders to sign the license agreement, while others permit only one of the several co-holders to license a registered mark. Therefore, unlike the TLT provision, the question as to whether all co-holders have to give their consent to the recordal of the license is left to the applicable law of the Member States. In particular, the question whether the signature of one or several co-holders satisfies the requirement that the request be signed by “the holder”, or if signatures of all co-holders are needed for that requirement to be satisfied, is left to the applicable law. In any event, if one co-holder refuses to sign and, under the applicable law, the request cannot be accepted, the licensee would be able to request recordal under paragraph (2).

Note on Article 5

XX Article 5 would apply independently of whether or not a license exists or, if a license exists, whether or not the license is recorded.

[End of Annex and of document]