

**WIPO**



**STLT/WG/1/2**

**ORIGINAL:** English

**DATE:** February 22, 2010

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

**WORKING GROUP ON THE REVIEW OF RULE 3(4) TO (6) OF  
THE REGULATIONS UNDER THE SINGAPORE TREATY  
ON THE LAW OF TRADEMARKS**

**First Session**

**Geneva, June 28 and 29, 2010**

**REVIEW OF RULE 3(4) TO (6) OF THE REGULATIONS UNDER THE SINGAPORE  
TREATY ON THE LAW OF TRADEMARKS**

*Document prepared by the Secretariat*

## I. INTRODUCTION

1. At its first session, held in Geneva from September 22 to October 1, 2009, the Assembly of the Singapore Treaty on the Law of Trademarks (hereinafter referred to as “the Assembly” and “the Singapore Treaty”) considered document STLT/A/1/3 on “Future Work”, where reference was made to the areas of convergence concerning the representation of non-traditional marks agreed by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) in 2008. Those areas of convergence were submitted to the attention of the relevant WIPO Assemblies in 2009, in document WO/GA/38/7, and are published as WIPO document WIPO/STrad/INF/3 at <http://www.wipo.int/sct/en/wipo-strad>.

2. The Singapore Treaty Assembly approved the initiation of a review of Rule 3(4) to (6) of the Regulations under the Singapore Treaty with a view to align that Rule, where considered possible and appropriate, with the areas of convergence concerning the representation of non-traditional marks agreed by the SCT. The Assembly further approved the convening of one session of a Working Group to meet back to back with the first ordinary session of the SCT in 2010, to undertake preparatory work for the review of Rule 3(4) to (6) (document STLT/A/1/4, paragraph 12).

3. Rule 3 of the Regulations under the Singapore Treaty deals with the representation of the mark in an application for registration. It is a generally accepted feature of trademark registration procedures that a mark for which registration is sought must be presented to the relevant trademark authority.

4. While the Singapore Diplomatic Conference reached agreement on Rule 3(1) to (4) concerning marks reproduced in standard characters (Rule 3(1)), marks claiming color (Rule 3(2)), the number of reproductions (Rule 3(3)) and certain issues relating to the reproduction of three-dimensional marks (Rule 3(4)), questions concerning the reproduction of hologram marks, motion marks, color marks and position marks (Rule 3(5)), as well as the representation of marks consisting of non-visible signs (Rule 3(6)) remained unresolved. In this regard, Rule 3(5) and (6) refer to national law.

5. In this context, it appears useful to recall that the term “representation” includes “reproduction” and, in particular, any graphic or photographic reproduction of a mark and any other means of representation, for example descriptions or electronic data files (see Note 3.09 of document TLT/R/DC/5).

6. The present working document contains suggestions for the possible alignment of Rule 3 with the areas of convergence concerning the representation of non-traditional marks agreed by the SCT, in the form of draft amendments to Rule 3 with accompanying text. In the Annex to this document, all suggested changes from the current text of Rule 3 are recapitulated and indicated by underlining for new text and strikethrough for deleted text.

7. It is recalled that there is no obligation under the Singapore Treaty to provide for the registration of any of the signs contemplated in Rule 3(4) to (6). The effect of those amendments, if adopted, will be that Contracting Parties that accept for registration those types of marks accept the representation of such marks as contemplated in the Rule.

## II. DRAFT AMENDMENTS TO RULE 3 OF THE REGULATIONS UNDER THE SINGAPORE TREATY

### Three-dimensional marks

8. Agreed area of convergence No. 1 (*Three-dimensional Marks*), stipulates that, with regard to an application for the registration of a three-dimensional mark, a sufficiently clear representation showing one single view of the mark is sufficient for the granting of a filing date. Nevertheless, Offices may require more views or a description of the three-dimensional mark for the purposes of examination.

9. Note 1.01 to that agreed area of convergence makes reference to Rule 5(1) of the Singapore Treaty and indicates that, if additional views and other elements are required, the applicant should be given reasonable time limits to supply them.

10. With reference to the agreed area of convergence concerning three-dimensional marks, the following text for a new Rule 3(4)(e) could be considered.

(4) [*Three-dimensional Mark*]

[...]

(e) Notwithstanding subparagraphs (a) to (d), a sufficiently clear reproduction showing one view of the mark shall be sufficient for the granting of a filing date.

[...]

### Hologram marks

11. According to Rule 3(5), if the application contains a statement to the effect that the mark is a hologram mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark, as prescribed by the law of that Contracting Party.

12. With reference to the agreed area of convergence concerning hologram marks, the following text for a new Rule 3(5) could be considered.

(5) [*Hologram Mark*] Where the application contains a statement to the effect that the mark is a hologram mark, the reproduction of the mark shall consist of one single view of the sign, which captures the holographic effect in its entirety or, at the option of the applicant, of multiple views of the hologram from different angles. Where a single drawing or a series of drawings do not accurately represent the hologram, the Office may require the applicant to furnish a description of the hologram mark.

### Motion or Multimedia Marks

13. Rule 3(5) provides that where the application contains a statement to the effect that the mark is a motion mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark as prescribed by the law of that Contracting Party.

14. With reference to the agreed area of convergence concerning motion or multimedia marks, the following text for a new Rule 3(6) dealing with the reproduction of motion or multimedia marks could be considered.

(6) [*Motion or Multimedia Mark*] Where the application contains a statement to the effect that the mark is a motion or multimedia mark, the reproduction of the mark shall consist of a series of still images, which put together, will depict movement. The Office may require that the applicant furnish a written description explaining the movement. The Office may further require that a recording of the sign in analog or digital format be submitted with the application.

### Color Marks

15. Rule 3(5) provides that where the application contains a statement to the effect that the mark is a color mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark as prescribed by the law of that Contracting Party.

16. A note to the area of convergence on this type of mark states that internationally recognized color codes are deemed to be precise and stable and their use in trademark applications contributes to clarify the nature and the scope of color marks.

17. With reference to agreed area of convergence concerning color marks, the following text for a new Rule 3(7) dealing with the reproduction of marks consisting of color *per se* or of a combination of colors without delineated contours could be considered.

(7) [*Color Mark*] Where the application contains a statement to the effect that the mark is a color *per se* mark or a combination of colors without delineated contours, the reproduction of the mark shall consist of a sample of the color(s) on paper or in an electronic format. The Office may require a designation of the color(s) by using their common names or a written description on how the color is applied to the goods or used in relation to the services. At the option of the applicant, the color or colors may be indicated by a recognized color code.

### Position Marks

18. Rule 3(5) provides that where the application contains a statement to the effect that the mark is a position mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark as prescribed by the law of that Contracting Party.

19. A note to the area of convergence on this type of mark states that, under certain national systems, position marks are treated as a subset of other types of marks, such as figurative or three-dimensional marks.

20. With reference to the agreed area of convergence concerning position marks, the following text for a new Rule 3(8) dealing with the reproduction of position marks could be considered.

(8) [*Position Mark*] Where the application contains a statement to the effect that the mark is a position mark, the reproduction of the mark shall consist of a single view of the mark. Matter for which protection is not claimed shall be represented in broken or dotted lines. If the graphic representation supplied is not sufficiently clear, the Office may require a written description explaining the position of the mark in relation to the product.

#### Gesture Marks

21. Rule 3 does not contain any reference to the reproduction of gesture marks, a type of mark that was not contemplated by the Singapore Diplomatic Conference. Nevertheless, the agreed areas of convergence concerning non-traditional marks refer to gesture marks. A note to the area of convergence on this type of mark refers to an understanding of the SCT that the term gesture mark is used by industry, but not necessarily in legal statutes.

22. With reference to the area of convergence concerning gesture marks, the following text for a new Rule 3(9) dealing with the representation gesture marks could be considered.

(9) [*Gesture Mark*] With regard to an application for the registration of a gesture mark, the reproduction of such a mark shall consist of a single picture when the mark is treated as a figurative mark or several frames depicting the gesture if the mark is considered a motion mark. The Office may require that the applicant furnish a written description explaining the gesture. The Office may further require that a recording of the sign in analog or digital format be submitted with the application.

#### *Marks consisting of a non-visible sign*

23. Rule 3(6) provides that where the application contains a statement to the effect that the mark consists of a non-visible sign, a Contracting Party may require one or more representations of the mark, as prescribed by the law of that Contracting Party.

24. In the area of non-visible signs, the SCT was able to determine only one agreed area of convergence concerning the representation of non-traditional marks, namely area of convergence No. 7 (*Sound Marks*). As regards olfactory marks, taste marks and texture or feel marks, the SCT could not identify areas of convergence concerning their representation. It was noted that some jurisdictions have accepted that such marks may be represented through a description, whereas for other jurisdictions, a description cannot adequately represent the character of such marks.

Sound Marks

25. A note to the area of convergence on the representation of sound marks indicates that electronic files such as MP3 or .WAV (wave form audio format) may be filed with certain Offices. However, national legislation may still include the possibility to submit analog recordings.

26. With reference to the agreed area of convergence on sound marks, the following text for a new Rule 3(10) could be considered.

(10) [Sound Mark] (a) Where the application contains a statement to the effect that the mark is a sound mark, the representation of the mark shall consist of a musical notation on a staff, or a description of the sound constituting the mark, or an analog or digital recording of that sound, or any combination thereof.

(b) Where electronic filing is available, an electronic file may be submitted with the application.

(c) Notwithstanding subparagraphs (a) and (b), the Office may consider that only a musical notation on a staff may adequately represent the mark.

27. *The Working Group is invited to:*

*(i) consider the suggestions made in this document for the possible amendment of Rule 3 with a view to aligning that Rule with the areas of convergence concerning the representation of non-traditional marks agreed by the SCT; and*

*(ii) indicate whether it would recommend to the Singapore Treaty Assembly some or all of the suggested amendments to Rule 3 of the Regulations under the Singapore Treaty as presented in the Annex to this document or in amended form;*

*(iii) indicate the date as of which any recommended change to Rule 3 should take effect.*

[Annex follows]

ANNEX

REGULATIONS UNDER THE SINGAPORE TREATY ON THE LAW OF  
TRADEMARKS

[...]

*Rule 3*  
*Details Concerning the Application*

[...]

(4) [*Three-dimensional Mark*]

[...]

(e) Notwithstanding subparagraphs (a) to (d), a sufficiently clear reproduction showing one view of the mark shall be sufficient for the granting of a filing date.

~~(d)~~(f) Where the Office considers [...]

~~(e)~~(g) Paragraph (3)(a)(i) [...]

~~(5) [*Hologram Mark, Motion Mark, Color Mark, Position Mark*] Where the application contains a statement to the effect that the mark is a hologram mark, a motion mark, a color mark or a position mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark, as prescribed by the law of that Contracting Party.~~

(5) [*Hologram Mark*] Where the application contains a statement to the effect that the mark is a hologram mark, the reproduction of the mark shall consist of one single view of the sign, which captures the holographic effect in its entirety or, at the option of the applicant, of multiple views of the hologram from different angles. Where a single drawing or a series of drawings do not accurately represent the hologram, the Office may require the applicant to furnish a description of the hologram mark.

(6) [*Motion or Multimedia Mark*] Where the application contains a statement to the effect that the mark is a motion or multimedia mark, the reproduction of the mark shall consist of a series of still images, which put together, will depict movement. The Office may require that the applicant furnish a written description explaining the movement. The Office may further require that a recording of the sign in analog or digital format be submitted with the application.

(7) [Color Mark] Where the application contains a statement to the effect that the mark is a color *per se* mark or a combination of colors without delineated contours, the reproduction of the mark shall consist of a sample of the color(s) on paper or in an electronic format. The Office may require a designation of the color(s) by using their common names or a written description on how the color is applied to the goods or used in relation to the services. At the option of the applicant, the color or colors may be indicated by a recognized color code.

(8) [Position Mark] Where the application contains a statement to the effect that the mark is a position mark, the reproduction of the mark shall consist of a single view of the mark. Matter for which protection is not claimed shall be represented in broken or dotted lines. If the graphic representation supplied is not sufficiently clear, the Office may require a written description explaining the position of the mark in relation to the product.

(9) [Gesture Mark] With regard to an application for the registration of a gesture mark, the reproduction of such a mark shall consist of a single picture when the mark is treated as a figurative mark or several frames depicting the gesture if the mark is considered a motion mark. The Office may require that the applicant furnish a written description explaining the gesture. The Office may further require that a recording of the sign in analog or digital format be submitted with the application.

(10) [Sound Mark] (a) Where the application contains a statement to the effect that the mark is a sound mark, the representation of the mark shall consist of a musical notation on a staff, or a description of the sound constituting the mark, or an analog or digital recording of that sound, or any combination thereof.

(b) Where electronic filing is available, an electronic file may be submitted with the application.

(c) Notwithstanding subparagraphs (a) and (b), the Office may consider that only a musical notation on a staff may adequately represent the mark.

~~(6)~~(11) [*Mark Consisting of a Non-Visible Sign other than Sound Marks*] Where the application contains a statement to the effect that the mark consists of a non-visible sign other than a sound mark, a Contracting Party may require one or more representations of the mark, an indication of the type of mark and details concerning the mark, as prescribed by the law of that Contracting Party.

~~(7)~~(12) [*Transliteration of the Mark*] [...]

~~(8)~~(13) [*Translation of the Mark*] [...]

~~(9)~~(14) [*Time Limit for Furnishing Evidence of Actual Use of the Mark*]

[...]