

# WIPO



SCIT/SDWG/4/4

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

GENEVA

## **STANDING COMMITTEE ON INFORMATION TECHNOLOGIES**

### **STANDARDS AND DOCUMENTATION WORKING GROUP**

#### **Fourth Session**

**Geneva, January 26 to 30, 2004**

#### **REVISION AND ESTABLISHMENT OF WIPO STANDARDS RELATING TO TRADEMARKS**

*Document prepared by the Secretariat*

#### Introduction

1. In July 2001, following the first session of the Standards and Documentation Working Group (SDWG) of the Standing Committee on Information Technologies (SCIT), and as mandated under Task No. 20, the International Bureau issued a circular and questionnaire to industrial property offices (IPOs) for the purpose of collecting data on formats currently in use for figurative elements of marks.
2. At the second session of the SDWG, held from December 2 to 6, 2002, the document SCIT/SDWG/2/9 (which included the questionnaire and its circular) was presented to the SDWG with the collated results of the questionnaire. The SDWG agreed that the results of the questionnaire should further be analyzed and a report be prepared and presented to the third session of the SDWG.
3. At the second session of the SDWG, the Korean Intellectual Property Office (KIPO) also made a proposal to revise existing, or as necessary, create new WIPO Standards relating to trademarks. The SDWG agreed to establish a Trademark Standards Task Force with the mandate to prepare a project brief on the said proposal. KIPO was designated as Task Force Leader.

4. At the third session of SDWG, held from May 5 to 8, 2003, the Secretariat presented the results of the analysis of the data collected from the questionnaire in a document titled "Report on the Survey on Formats Currently in Use by Industrial Property Offices (IPOs) for Figurative Elements of Marks" (SCIT/SDWG/3/5). A number of issues were identified and noted during the discussions, in particular: the capture and manipulation of three dimensional objects, color management, the desired size for images (whether expressed in centimeters or pixels), and software licensing issues, e.g., for GIF software. The SDWG agreed to further work on these issues and to subsume Task No. 20 within the mandate of the Trademark Standards Task Force.

5. As requested by the SDWG, on October 16, 2003, KIPO submitted a project brief for revising or establishing WIPO Standards for trademarks. The project brief is contained in Annex I to this document.

6. The Task Force also carried out a survey to determine which standards have priority. This survey is covered in Annex II, including its Appendix, and Annex III to this document.

7. An oral progress report of the work carried out by the Task Force will be presented at the current session of the SDWG in order to inform the Working Group on the status of the revision or establishment of WIPO Standards for trademarks.

8. *The SDWG is invited:*

*(a) to note the contents of the project brief prepared by the Trademark Standards Task Force as given in Annex I of this document; and*

*(b) to consider and agree to the proposals concerning the elaboration of a standard for the capture and display of the figurative elements of marks and the development of XML standards for electronic processes of trademark data.*

[Annexes follow]

ANNEX I

PROJECT BRIEF FOR REVISING OR ESTABLISHING WIPO STANDARDS  
FOR TRADEMARKS

Clear indication of the problem or specific needs to be addressed

1. The WIPO website highlights the importance of standards:

In the framework of the international cooperation promoted by WIPO in the field of industrial property information and documentation, standardization efforts have resulted in 48 WIPO Standards, Recommendations and Guidelines related to patents, trademarks and industrial designs. These WIPO Standards facilitate the harmonization of practices by industrial property offices (IPOs) regarding electronic data processing in respect of the procedures for filing, examination, publication, granting and registration of industrial property titles. WIPO Standards also facilitate the international transmission, exchange, sharing and dissemination of industrial property information (text and images), as well as the access to and retrieval of the said information.

2. The two important aims of the WIPO Standards are, firstly, to give criteria to IPOs that wish to improve the means of exchanging documents related to intellectual property (IP) and, secondly, to guide IPOs that wish to set up new procedures or improve the quality of their work. Although these standards offer practical guidance for patent documents, they inadequately deal with trademark documents. They should include the same level of detail that is offered for patent documents.

3. The need to create standards or recommendations for the electronic exchange of trademark data is especially urgent. Some trademark offices electronically receive trademark applications and exchange trademark documents with other offices. Under the Madrid Agreement and Protocol, for example, offices can electronically exchange data with WIPO through the Madrid Electronic Communications (MECA). Although MECA is a *de facto* exchange standard, it does not cover all aspects of the electronic management of trademark data, nor does it respond to all the needs of the different offices. Standards are needed for interoperability across offices.

How the need was determined

4. At the second session of the Standards and Documentation Working Group (SDWG) of the Standing Committee on Information Technology (SCIT), held in December 2002, the Korean Intellectual Property Office (KIPO) proposed the revision or, if necessary, the creation of 11 standards (see document SCIT/SDWG/2/4). Support for KIPO's proposal was widespread. The SDWG agreed to establish the Trademark Standards Task Force with a mandate to prepare the following:

- (i) a detailed project brief elaborating the objectives of the task;
- (ii) a clear description of the need for and benefits of each proposed standard;
- (iii) a prioritization of the list of proposed standards.

5. At its third session, held in May 2003, the SDWG discussed the progress of Task No. 20 regarding the figurative elements of marks. It agreed that this task fell under the mandate of the KIPO-led Task Force that deals with the standardization of trademarks (see document SCIT/SDWG/3/5).

6. The Task Force held an informal meeting during the third session of the SDWG to discuss how to deal with the proposed standards, and it agreed to conduct a survey to prioritize the proposed standards.

7. The Task Force received a new proposal for an XML standard to address trademark data from its members. It added the two proposed standards regarding the figurative elements and the XML standard to the 11 standards proposed by KIPO. It carried out the survey to provide the order of priority for the 13 proposed standards. It agreed to focus on the two standards with the highest priority, namely, the figurative elements of marks and the XML for trademarks, and to deal with the other proposed standards later on (see Annexes II and III).

#### Objective of the tasks

8. The general objective of the tasks is to revise the WIPO Standards or, as necessary, to create new standards for trademarks to improve procedures for the filing, examination, publication, granting and registration of trademarks.

9. In the first phase, the main objective is to elaborate a standard for the capture and display of the figurative elements of marks and to develop XML standards for electronic processes such as e-filing and the exchange of trademark data.

#### Options for solutions

10. In the first phase, one of the activities of the Task Force is to conduct a survey of States Members of WIPO on their practices regarding image format.

11. The Task Force should survey Members States practices with regard to the capture and manipulation of three-dimensional objects; color management, particularly with respect to the increasing requirements of electronic filing, the desired size for images (whether expressed in centimeters or pixels), and software licensing issues, for example, GIF software.

12. At the beginning of 2004, the Task Force will prepare a questionnaire for the survey in order to set up a new standard (or recommendation) for the capture and display of the figurative element of marks. The International Bureau (IB) will then distribute the questionnaire to IPOs.
13. The newly established standard will be on the results of the survey. Through that standardization, the Task Force will be able to finish SDWG Task No. 20 in 2004.
14. Thereafter, the Task Force should prepare XML standards for e-filing and the electronic exchange of trademark data between trademark offices. This standard will be based on the MECA-XML DTD. The Task Force should modify MECA-XML DTD to cover all the needs of the different offices and to harmonize with the related patent standards. The SDWG needs to set up a new task for this standardization.
15. The Task Force will prepare the draft of the standard and publish the revision of the draft two or three times in 2004. The Task Force will be able to set up the standard in 2005.
16. After the first phase, the Task Force will consider the remaining 11 proposed standards. While establishing the XML standards, the remaining proposed standards can be partially addressed.

#### Expected benefits

17. In general, the standards are expected to provide better guidance on trademarks for IPOs wishing to set up procedures or improve the performance of their work. Through the revised WIPO Standards, WIPO can help IPOs to harmonize their electronic data processing practices for the filing, examination, publication, granting and registration of trademarks.
18. The new standards should facilitate the e-filing of trademarks, as well as the international exchange of trademark data (text and images) between trademark offices.

[Annex II follows]

ANNEX II

SURVEY OF REQUESTS FOR REVISION  
OR ESTABLISHMENT OF WIPO STANDARDS RELATED TO TRADEMARKS

Background

1. In 2002, the Korean Intellectual Property Office (KIPO) submitted a request to the second session of the SCIT/SDWG regarding the revision and establishment of 11 WIPO Standards related to trademarks (see Annex I to document SCIT/SDWG/2/4). The SDWG agreed to set up a Trademark Task Force to deal with the request. The Task Force has received two additional proposals for the establishment of WIPO Standards. The Task Force needs to consider the 13 standards proposed.
2. The Task Force discussed how to manage the proposals and decided to conduct a survey to determine which standards have priority. The Task Force will focus on the two or three standards that have priority.

Purpose of the survey

3. The survey aims to prioritize the standards proposed for trademarks.

How to fill out the table in the Appendix

- Mark your priority in the fourth column of the table from 1 to 13 where 1 is the highest priority and 13 is the lowest;
- Mark *I* (interested) or *U* (uninterested) in the fifth column to indicate if you have an interest in or would potentially implement the particular standard;
- Mark the WIPO Standard ST.3 code for your Office in the sixth column.

[Appendix follows]

List of Standard proposed for Trademarks	Necessity	Relating to the WIPO Standards	Priority (1 to 13)	Interest or Uninterest (I / U)	ST. 3 code
<p>A. Standard (or recommendation) for the electronic management of figurative elements of marks</p>	<p>In the SDWG Task List, Task No. 20 is related to the preparation of a recommendation on how figurative elements of marks should be captured and displayed electronically.</p> <p>At the 3<sup>rd</sup> session, the SDWG discussed the SDWG Task No. 20 and the establishment of a Task Force to deal with Task No. 20. The SDWG also agreed that, in preference to the creation of a new Task Force, this work should be subsumed within the mandate of the existing Task Force dealing with standardization in the field of trademarks, under the leadership of the Korean Intellectual Property Office (KIPO). (Please see paragraphs 38 to 43 of document SCIT/SDWG/3/9.)</p>				
<p>B. Standard (or recommendation) for the XML relating to the electronic process and exchange of trademark data</p>	<p>Some trademark offices have electronically received trademark applications and have exchanged trademark documents with other offices. Under the Madrid Agreement and Protocol, in particular, the offices can electronically exchange data with WIPO through MECA. Although MECA is a <i>de facto</i> standard for the exchange, it does not cover all business relating to the electronic management of trademark data and all needs of the different offices. A standard is needed for the interoperability across offices.</p> <p>The standard (or recommendation) deals with the XML relating to the electronic process and exchange of trademark data.</p>				

List of Standard proposed for Trademarks	Necessity	Relating to the WIPO Standards	Priority (1 to 13)	Interest or Uninterest (I / U)	ST. 3 code
C. Recommendation concerning the minimum data elements required to uniquely identify a trademark document	This recommendation defines the minimum data elements required to uniquely identify all types of trademark documents whether published in paper or electronic form.	ST. 1			
D. Recommendation for the numbering of published trademark documents	The aim of this recommendation is to give guidance to industrial property offices wishing to change their present numbering systems or to start new numbering systems for published trademark documents.	ST. 6			
E. Standard recording of the NICE classification symbols on machine-readable records	This recording convention provides that symbols of the International Classification of Goods and Services for the purposes of the registration of Marks (NICE Classification) should be presented on machine-readable records for the exchange of information in machine-readable form in a fixed-length field.	ST.8			
F. Recommendation for published trademark documents	It has been recognized that, with an increasing international exchange of published trademark documents, there is a need to adopt some uniform procedures relating to the format and physical characteristics of trademark documents, as well as to the layout and presentation of bibliographic data components.	ST.10			
G. Recommendation on the minimum of indexes to be inserted in trademark gazettes or published in association with trademark gazettes	An index is considered to be published in association with trademark gazettes if it contains an indication of how to identify for each of its entries a corresponding announcement in a trademark gazette, e.g., by means of references.	ST.11			



List of Standard proposed for Trademarks	Necessity	Relating to the WIPO Standards	Priority (1 to 13)	Interest or Uninterest (I / U)	ST. 3 code
H. Recommendation for the preparation of name indexes to trademark documents	In spite of the recent emergence of online data bases containing bibliographic data of trademark documents, including names, the use of printed name indexes prepared by industrial property offices is universal and widespread and will continue to be in the foreseeable future. This standard is addressed to industrial property offices producing indexes to trademark documents giving names of applicants, holders, and is designed to promote a uniform presentation of names occurring in name indexes as well as a uniform method of ordering the names in the index itself.	ST.20			
I. Recommendation for the presentation of trademark applications typed in optical character recognition (OCR) format	This recommendation aims to assist the preparation of a trademark application in a typewritten form suitable for the subsequent production of an electronic digitized record of the contents of the trademark application by the use of Optical Character Recognition (OCR) equipment.	ST.22			
J. Guidelines for issuing corrections, alterations and supplements relating to trademark information	These guidelines aim at providing guidance to industrial property offices and other suppliers of trademark information on how to issue corrections, alterations and supplements relating to trademark information published in paper form or on machine-readable media, for the purposes of promoting an unambiguous and uniform presentation of such corrections, alterations and supplements.	ST.50			

List of Standard proposed for Trademarks	Necessity	Relating to the WIPO Standards	Priority (1 to 13)	Interest or Uninterest (I / U)	ST. 3 code
K. Recommended standard code for the identification of different kinds of trademark documents	<p>The aim of this recommendation is to provide for groups of letter codes in order to distinguish patent documents published by industrial property offices. The letter codes also facilitate the storage and retrieval of such documents.</p> <p>*The ST.16 belongs to the Group I (General purpose standards for patents, marks and designs) of WIPO Standards. There is no code for trademark</p>	ST.16			
L. Recommendation for the coding of headings of announcements made in official gazettes	<p>Since WIPO Standard ST.17 is to improve the informative value of Official Gazettes, by including standard codes with the various headings, it should include contents about trademark with double letter-coded headings that were related to trademarks and not recorded yet.</p>	ST.17			
M. Recommendation for the publication of indexes issued yearly/half-yearly/quarterly by industrial property offices	<p>For rapid and reliable information on trademarks as well as on the documents of addition thereto and on the published applications, WIPO Standard ST.19 should include contents about trademarks, distinguished from patents.</p>	ST.19			

## RESULTS OF SURVEY

List of Standard proposed for Trademarks	Priority(P) / Interest or Uninterest (I/U)																TOTAL		
	AU		BX		CA		GB		JP		KR		SE		US		sum of 'P'	No. of 'I'	Order
	P	I/U	P	I/U	P	I/U	P	I/U	P	I/U	P	I/U	P	I/U	P	I/U			
A. Standard (or recommendation) for the electronic management of figurative elements of marks	1	I	2	I	1	I	5	I	1	I	1	I	1	I	1	I	14	8	1
B. Standard (or recommendation) for the XML relating to the electronic process and exchange of trademark data	2	I3	1	I	2	I	5	I	2	I	2	I	2	I	2	I	20	8	2
C. Recommendation concerning the minimum data elements required to uniquely identify a trademark document	5	I	13	U	6	U	5	I	13	U	4	I	3	I	3	I	65	5	3
D. Recommendation for the numbering of published trademark documents	11	U	13	U	7	U	13	U	13	U	5	I	11	U	13	U	99	1	9
E. Standard recording of the NICE classification symbols on machine-readable records	3	I	13	U	3	I	13	U	13	U	3	I	5	I	13	U	79	4	5
F. Recommendation for published trademark documents	6	I	13	U	9	U	13	U	13	U	7	I	6	U	13	U	93	2	7
G. Recommendation on the minimum of indexes to be inserted in trademark gazettes or published in association with trademark gazettes	7	I	13	U	11	U	10	I	13	U	11	I	8	U	13	U	99	3	8

List of Standard proposed for Trademarks	Priority(P) / Interest or Uninterest (I/U)																TOTAL		
	AU		BX		CA		GB		JP		KR		SE		US		sum of 'P'	No. of 'I'	Order
	P	I/U	P	I/U	P	I/U	P	I/U	P	I/U	P	I/U	P	I/U					
H. Recommendation for the preparation of name indexes to trademark documents	9	I	13	U	12	U	13	U	13	U	12	I	9	U	13	U	107	2	11
I. Recommendation for the presentation of trademark applications typed in optical character recognition (OCR) format	13	U	13	U	10	U	10	I	13	U	9	I	13	U	13	U	107	2	11
J. Guidelines for issuing corrections, alterations and supplements relating to trademark information	10	I	13	U	4	I	10	I	13	U	6	I	4	I	4	I	77	6	4
K. Recommended standard code for the identification of different kinds of trademark documents	4	I	13	U	5	U	13	U	13	U	8	I	10	U	13	U	92	2	6
L. Recommendation for the coding of headings of announcements made in official gazettes	8	I	13	U	8	U	13	U	13	U	13	I	7	U	13	U	101	2	10
M. Recommendation for the publication of indexes issued yearly/half-yearly/quarterly by industrial property offices	12	U	13	U	13	U	13	U	13	U	10	I	12	U	13	U	112	1	13