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GENEVA

STANDING COMMITTEE ON THE LAW OF TRADE MARKS, INDUSTRIAL DESIGN AND GEOGRAPHICAL INDICATIONS

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DRAFT REVISED REGULATIONS UNDER THE DRAFT REVISED
TRADEMARK LAW TREATY (TLT)

Document prepared by the Secretariat

INTRODUCTION

1. The present document contains a revised version of the Draft Regulations under the Draft Revised Trademark Law Treaty (TLT). It takes into account the views expressed in the Standing Committee on the Law of Trademarks at its ninth session (November 11 to 15, 2002) and at its tenth session (April 28 to May 2, 2003).
2. Following a decision of the SCT at its tenth session, the present document reproduces the full text of the Draft Revised Regulations, presented separately from the text of the Draft Revised Treaty and the Notes.
3. Proposed changes to the original text of the Regulations under the TLT have been underlined for ease of reference. Proposed deletions are shown as struck-through.
4. *The SCT is invited to consider and comment on the proposals as contained in the Annex to this document.*

[Annex follows]

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Rule 1
Abbreviated Expressions

(1) [“Treaty”; “Article”]

(a) In these Regulations, the word “Treaty” means the Trademark Law Treaty.

(b) In these Regulations, the word “Article” refers to the specified Article of the Treaty.

(2) [Abbreviated Expressions Defined in the Treaty] The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of the Regulations.

Rule 2
Manner of Indicating Names and Addresses

(1) [Names]

(a) Where the name of a person is to be indicated, any Contracting Party may require,

(i) where the person is a natural person, that the name to be indicated be the family or principal name and the given or second ary name or names of that person or that the name to be indicated be, at that person's option, the name or names customarily used by the said person;

(ii) where the person is a legal entity, that the name to be indicated be the full official designation of the legal entity.

(b) Where the name of a representative which is a firm or partnership is to be indicated, any Contracting Party shall accept as indication of the name the indication that the firm or partnership customarily uses.

(2) [Addresses] (a) Where the address of a person is to be indicated, any Contracting Party may require that the address be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, consist of all the relevant administrative units up to, and including, the house or building number, if any.

(b) Where a communication to the Office of a Contracting Party is in the name of two or more persons with different addresses, that Contracting Party may require that such communication indicate a single address as the address for correspondence.

(c) The indication of an address may contain a telephone number ~~and a~~ telefacsimile number ~~and an~~ e-mail address and, for the purposes of correspondence, an address different from the address indicated under subparagraph (a).

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(d) Subparagraphs (a) and (c) shall apply, *mutatis mutandis*, to [addresses for service].

(3) [*Script to Be Used*] Any Contracting Party may require that any indication referred to in paragraphs (1) and (2) be in the script used by the Office.

Rule 3
Details Concerning the Application

(1) [*Standard Characters*] Where, pursuant to Article 3(1)(a)(ix), the application contains a statement to the effect that the applicant wishes that the mark be registered and published in the standard characters used by the Office of the Contracting Party, the Office shall register and publish that mark in such standard characters.

(2) [*Number of Reproductions*]

(a) Where the application does not contain a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than

(i) five reproductions of the mark in black and white where the application may not, under the law of that Contracting Party, or does not contain a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of the said Contracting Party;

(ii) one reproduction of the mark in black and white where the application contains a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of that Contracting Party.

(b) Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than five reproductions of the mark in black and white and five reproductions of the mark in color.

(3) [*Reproduction of a Three-Dimensional Mark*]

(a) Where, pursuant to Article 3(1)(a)(xi), the application contains a statement to the effect that the mark is a three-dimensional mark, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction.

(b) The reproduction furnished under subparagraph (a) may, at the option of the applicant, consist of one single view of the mark or of several different views of the mark.

(c) Where the Office considers that the reproduction of the mark furnished by the applicant under subparagraph (a) does not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, up to six different views of the mark and/or a description by words of that mark.

(d) Where the Office considers that the different views and/or the description of the mark referred to in subparagraph (c) still do not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, a specimen of the mark.

(e) Paragraph (2)(a)(i) and 2 (b) shall apply *mutatis mutandis*.

(4) [Transliteration of the Mark] For the purposes of Article 3(1)(a)(xiii), where the mark consists of or contains matter in script other than the script used by the Office or numbers expressed in numerals other than numerals used by the Office, a transliteration of such matter in the script and numerals used by the Office may be required.

(5) [Translation of the Mark] For the purposes of Article 3(1)(a)(xiv), where the mark consists of or contains a word or words in a language other than the language, or one of the languages, admitted by the Office, a translation of that word or those words into that language or one of those languages may be required.

(6) [Time Limit for Furnishing Evidence of Actual Use of the Mark] The time limit referred to in Article 3(3) shall not be shorter than six months counted from the date of allowance of the application by the Office of the Contracting Party where that application was filed. The applicant or holder shall have the right to an extension of that time limit, subject to the conditions provided for by the law of that Contracting Party, by periods of at least six months each, up to a total extension of at least two years and a half.

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Rule 4 *Details Concerning Representation*

The time limit referred to in Article 4(3)(d) shall be counted from the date of receipt of the communication referred to in that Article by the Office of the Contracting Party concerned and shall not be less than one month where the address of the person on whose behalf the communication is made is on the territory of that Contracting Party and not less than two months where such an address is outside the territory of that Contracting Party.

Rule 5 *Details Concerning the Filing Date*

(1) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with any of the applicable requirements of Article 5(1)(a) or 5(2)(a), the Office shall promptly invite the applicant to comply with such requirements within a time limit indicated in the invitation, which time limit shall be at least one month from the date of the invitation where the applicant's address is on the territory of the Contracting Party concerned and at least two months where the applicant's address is outside the territory of the Contracting Party concerned. Compliance with the invitation may be subject to the payment of a special fee. Even if the Office fails to send the said invitation, the said requirements remain unaffected.

(2) [Filing Date in Case of Correction] If, within the time limit indicated in the invitation, the applicant complies with the invitation referred to in paragraph (1) and pays any required special fee, the filing date shall be the date on which all the required indications and elements referred to in Article 5(1)(a) have been received by the Office and, where applicable, the required fee referred to in Article 5(2)(a) has been paid to the Office. Otherwise, the application shall be treated as if it had not been filed.

(3) [Date of Receipt] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document or the payment of a fee shall be deemed to constitute receipt by or payment to the Office in cases in which the document was actually received by or payment was actually made to

- (i) a branch or sub-office of the Office,
- (ii) a national Office on behalf of the Office of the Contracting Party, where the Contracting Party is an intergovernmental organization referred to in Article 25(1)(ii),
- (iii) an official postal service,
- (iv) a delivery service, other than an official postal service, specified by the Contracting Party.

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(4) [Use of Telefacsimile] Where a Contracting Party allows the filing of an application by telefacsimile and the application is filed by telefacsimile, the date of receipt of the telefacsimile by the Office of that Contracting Party shall constitute the date of receipt of the application, provided that the said Contracting Party may require that the original of such application reach the Office within a time limit which shall be at least one month from the day on which the telefacsimile was received by the said Office.

(5) [Electronic Filing] Where a Contracting Party allows the filing of an application in electronic form or by electronic means of transmittal, the date of receipt of the communication by the Office of that Contracting Party shall constitute the date of receipt of that application, provided that the said Contracting Party may require that the original of such application reach the Office within a time limit which shall be at least one month from the day on which the electronic communication was received by the Office.

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Rule 6
Details Concerning the Signature Under Article 8(4)

(1) [Indications Accompanying Signature] Any Contracting Party may require that the signature of the natural person who signs be accompanied by:

(i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person

(ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

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Supprimé : Where a communication is signed on behalf of a legal entity, a

Supprimé : , or the seal,

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Supprimé : (2) . [Communication by Telefacsimile] The period referred to in Article 8(2)(b) shall not be less than one month from the date of the receipt of a transmittal by telefacsimile. ¶

(2) [Date of Signing] Any Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so allows, a date earlier than the latter date.

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(3) [Signature of Communications on Paper] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party:

(i) shall, subject to item (iii), accept a handwritten signature;

(ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;

(iii) may, where the natural person whose sign the communication is anational of the Contracting Party and such person's address is in its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment in its territory, require that a seal be used instead of a handwritten signature.

(4) [Signature of Communications Filed in Electronic Form or by Electronic Means of Transmittal Resulting in Graphic Representation] Where a Contracting Party allows the transmittal of communications in electronic form or by electronic means of transmittal, it shall consider such a communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on that communication as received by the Office of that Contracting Party.

(5) [Signature of Communications Filed in Electronic Form Not Resulting in Graphic Representation of Signature] Where a Contracting Party allows the transmittal of communications in electronic form, and a graphic representation of a signature accepted by that Contracting Party under paragraph (3) does not appear on such a communication as received by the Office of that Contracting Party, the Contracting Party may require that the communication be signed using a signature in electronic form as prescribed by that Contracting Party.

(6) [Exception to Certification of Signature Under Article 8(4)(b)] Any Contracting Party may require that any signature referred to in paragraph (5) be confirmed by a process for certifying signatures in electronic forms specified by that Contracting Party.

Rule 7

Details Concerning Indications Under Article 8(5) and (6)

(1) [Details Concerning Indications Under Article 8(5)]

(a) Any Contracting Party may require that any communication:

(i) indicate the name and address of the applicant, holder or other interested person;

(ii) indicate the number of the application or registration of the mark to which it relates;

(iii) contain, where the applicant, holder or other interested person is registered with the Office, the number or other indication under which he is registered.

(b) Any Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain:

(i) the name and address of the representative;

(ii) a reference to the power of attorney, or other communication in which the appointment of that representative is or was effected, on the basis of which the said representative acts;

(iii) where the representative is registered with the Office, the number or other indication under which he is registered.

(2) [Address for Correspondence and Address for Legal Service] Any Contracting Party may require that the address for correspondence and the address for legal service, referred to in Article 8(6), be a territory prescribed by that Contracting Party.

(3) [Address Where No Representative is Appointed] Where no representative is appointed and an applicant, holder or other interested person has provided, as his address, an address on a territory prescribed by the Contracting Party under paragraph (2) that Contracting Party shall consider that address to be the address for correspondence or the address for legal service, referred to in Article 8(6), as required by the Contracting Party.

(4) [Address Where Representative is Appointed] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for correspondence or the address for legal service, referred to in Article 8(6), as required by the Contracting Party.

(5) [Sanctions for Non-Compliance with Requirements]

(a) No Contracting Party may provide for the refusal of an application on grounds of failure to comply with any requirement to file a registration number or other indication under paragraphs (1)(a)(iii) and (b)(iii).

(b) Where a notification has not been made because indications allowing the applicant, holder or other interested person to be contacted by the Office have not been filed, reasonable time limits shall be granted before the Contracting Party applies such sanctions as is provided for in its law.

Rule 8
*Manner of Identification of an Application
Without Its Application Number*

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(1) [*Manner of Identification*] Where it is required that an application be identified by its application number but where such a number has not yet been issued or is not known to the applicant or his representative, that application shall be considered identified if the following is supplied:

- (i) the provisional application number, if any, given by the Office, or
- (ii) a copy of the application, or

(iii) a reproduction of the mark, accompanied by an indication of the date on which, to the best knowledge of the applicant or the representative, the application was received by the Office and an identification number given to the application by the applicant or the representative.

(2) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraph (1) be complied with in order for an application to be identified where its application number has not yet been issued or is not known to the applicant or his representative.

Rule 9
Details Concerning Duration and Renewal

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For the purposes of Article 13(1)(c), the period during which the request for renewal may be presented and the renewal fee may be paid shall start at least six months before the date on which the renewal is due and shall end at the earliest six months after that date. If the request for renewal is presented and/or the renewal fees are paid after the date on which the renewal is due, any Contracting Party may subject the renewal to the payment of a surcharge.

Rule 10
Requirements Relating to Measures in Case of Failure to Comply with Time Limits

(1) [Request for an extension of a time limit] Where a Contracting Party provides for an extension of a time limit for a reasonable period of time, it shall require that the request :

(i) be filed with the Office prior to the expiration of that time limit ;

(ii) be signed by the applicant or holder;

(iii) contain an identification of the time limit in question.

(2) [Request for Continued Processing] Where a Contracting Party provides for continued processing it shall require that the request :

- (i) be filed with the Office;
- (ii) be signed by the applicant or holder;
- (iii) contain an identification of the time limit in question.

(3) [Request for Reinstatement of Rights] Where a Contracting Party provides for the reinstatement of the rights of the applicant or holder with respect to an application or registration it shall require that the request :

- (i) be filed with the Office;
- (ii) be signed by the applicant or holder;
- (iii) contain a declaration or other evidence in support of the reasons for the failure to comply with the time limit, where the Office finds that such failure occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(4) [Time Limit for Filing a Request] A request under paragraphs (1) to (3) may not be refused if it has been filed within a reasonable time limit prior to or from the expiration of the unextended time limit or from the date of the removal of the cause of failure to comply with the time limit for the action in question.

(5) [Exceptions under Article 13 bis] The exceptions referred to in Article 13 bis are the cases of failure to comply with a time limit:

- (i) for which relief has already been granted under Article 13 bis(1)(a) or (b);
- (ii) for making a request for relief under Article 13 bis(1)(a) or (b) or a request for reinstatement under Article 13 bis(1)(c);
- (iii) for payment of a renewal fee;
- (iv) for an action before a board of appeal or other review body constituted in the framework of the Office;
- (v) for an action in *inter partes* proceedings;
- (vi) for the correction or addition of a priority claim;
- (vii) for filing the declaration referred to in Article 3(1)(a)(vii).

[End of Annex and of document]