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NOTES

prepared by the Secretariat

The present document contains Notes on the provisions of the draft revised Trademark Law Treaty and the draft revised Regulations contained in documents SCT/11/2 and SCT/11/3.

[Annex follows]

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NOTES

*Notes on Article 1
(Abbreviated Expressions)*

- 1.01 *Item(i)*. The term “Office” includes both the national Office of any State that is a Contracting Party to the Treaty, and the regional Office of any intergovernmental organization that is a Contracting Party, in accordance with Article 25(1) of the Treaty. For example, the Treaty would apply to the European Community (EC) Office for Harmonization in the Internal Market if, the European Community became a Contracting Party.
- 1.02 *Item(iv)*. The term “communication” is used in the Treaty and Regulations to refer only to matters which relate to a procedure before the Office, as this is defined in the Treaty (see Note 1.07). Accordingly, a notification or other correspondence sent by the Office to an applicant, holder or other interested person does not constitute a “communication” as defined under this item.
- 1.03 *Item(v)*. Neither the Treaty nor the Regulations contain a definition of what constitutes a legal entity. This is left to the applicable law of the Contracting Party where protection of a mark is sought. The question of whether an entity other than a natural person or a legal entity, for example a firm or partnership that is not a legal entity, is considered a person for the purpose of any procedure covered by the Treaty and the Regulations, remains a matter for the applicable law of the Contracting Party concerned.
- 1.04 *Item(vi)*. Where the applicable law of a Contracting Party provides that several persons may jointly be holders, the word “holder” must be construed as including “holders”.
- 1.05 *Item(vii)*. The term “address for service” may be construed, depending on the applicable law, as including reference to an address for correspondence or an address for legal service. What constitutes an address for correspondence or an address for legal service is a matter for the applicable law of the Contracting Party concerned. It is also a matter for the applicable law of a Contracting Party whether, and in what circumstances, the Office will require an address for correspondence or an address for legal service, or both, and in what communication such address(es) must be indicated.
- 1.06 *Item(viii)*. The term “register of marks” is restricted to the collection of data concerning registered marks, excluding therefore the collection of data concerning pending applications.
- 1.07 *Item(ix)*. The expression “procedure before the Office” covers any procedure in which an applicant, holder or other interested person communicates with the Office, either to initiate proceedings before the Office or in the course of such proceedings. It covers all procedures in proceedings before the Office and is therefore not restricted to those procedures which are referred to in express terms. Examples of such procedures are the filing of an application, the filing of a request for recording of a license, the payment of a fee, the filing of a response to a notification issued by the Office, or the filing of a translation of an application. It also covers procedures in which the Office contacts an applicant, holder or other interested person in the course of proceedings relating to an application or a registration, for example, the issuance of a notification that an application does not comply with certain requirements, or

the issuance of a receipt for a document or a fee. It does not cover procedures which, for legal purposes, are not part of the proceedings before the Office with respect to an application or a registration, for example, the purchase of a copy of a published application or the payment of a bill for information services provided by the Office to the public.

*Notes on Article 2
(Marks to Which the Treaty Applies)*

2.01 *Paragraph(1)(a)*. This Treaty applies only to marks consisting of visible signs. The expression “visible signs” includes words, designs, letters, numerals or their combinations, as well as a color as such or a combination of colors as such. In respect of three-dimensional signs, a Contracting Party is only obliged to apply the Treaty to such signs, including the possibility of their registration as marks, if the applicable law in that Contracting Party allows the registration of three-dimensional marks.

2.02 *Paragraph(1)(b)*. Non-traditional marks, for example, hologram marks, sound marks and olfactory marks are not covered by the Treaty. One of the reasons for this is that they cannot be easily represented in graphical form. However, if a Contracting Party provides for the registration of such marks, it should, to the extent possible, apply the provisions of the Treaty to those marks.

2.03 *Paragraph(2)(a)*. Service marks are marks used to identify services, as opposed to products. Service marks function in the same way as trademarks. Contracting Parties are obliged under the Treaty to also register service marks.

2.04 *Paragraph(2)(b)*. Contracting Parties are not bound to apply the Treaty to collective marks, certification marks and guarantee marks. The reason is that the registration of those marks often requires the fulfillment of special, varying conditions in the different countries, a fact that would make harmonization particularly difficult. Furthermore, the number of such marks as compared to the total number of marks is very small.

*Notes on Article 3
(Application)*

3.01 *Paragraph(1)(a)*. This provision contains a list of indications and elements that may be required in respect of an application. It establishes a maximum list of formal requirements that Contracting Parties are allowed to provide for purposes of obtaining a registration. As follows from the introductory phrase of paragraph (4), that the list is exhaustive, except where the applicant claims the benefit of Article 6quinquies of the Paris Convention. In this case a Contracting Party may require, before deciding on the registration of the mark, a certificate of the registration in the country of origin, as provided in item (iv) of paragraph (4). Contracting Parties may, however, require only some of the indications and elements listed in this article.

3.02 *Item(i)*. An Office can consider that an application which does not contain an express request for registration is defective. It is to be noted that it may even be an implicit request for registration is sufficient under Article 5(1)(a)(i) for the purposes of according of a filing date.

3.03 *Item(ii)*. The details concerning the indication of the name and address of the applicant are specified in the Regulations (see Rule 2(1)(a) and (2)).

3.04 *Item(iii)*. The indication of a State of nationality, of a State of domicile and of a State of real and effective industrial or commercial establishment may be relevant for the application of international conventions (see, for example, Articles 2 and 3 of the Paris Convention). It follows from the introductory phrase of paragraph (1)(a) that a Contracting Party has freedom not to require those indications, or to require only some of them.

3.05 *Item(iv)*. Where, in a State, a legal entity may be constituted under the particular law of a territorial unit existing within such State, the name of that territorial unit must be given. A Contracting Party may require the indication of both the name of the State, and, where applicable, the name of the territorial unit within that State (for example, United States of America and California).

3.06 *Item(v)*. The details concerning the indication of the name and address of the representative are specified in the Regulations (see Rule 2). The representative can be a natural person, a legal entity or a partnership.

3.07 *Item(vi)*. The details concerning the indication of an address for service are specified in the Regulations (see Rule 7(2)).

3.08 *Item(vii)*. This item does not affect the applicable provisions of a Contracting Party concerning the cases where the priority is claimed subsequent to the filing of the application, a possibility which is allowed under Article 4D(1), last sentence of the Paris Convention. Moreover, this item does not affect the possibility of asking, subsequent to the filing of the application, for proof under Article 4(D)(3) and (5) of the Paris Convention. Finally, in view of Article 16 of this Treaty, it should be noted that Contracting Parties must apply the provisions of the Paris Convention relating to the claiming of priority not only to trademarks but also to service marks.

3.09 *Item(viii)*. This item would apply where the temporary protection referred to in Article 11 of the Paris Convention may be invoked. Its inclusion in Article 3(1)(a) does not mean, however, that a Contracting Party is prevented from allowing the benefit of such temporary protection to be invoked at a later stage. Nor does it affect the possibility of requiring, under Article 11(3) of the Paris Convention, documentary evidence as proof of identity of the article or article exhibited and of the date of its or their introduction in the international exhibition. Furthermore, in view of Article 16 of this Treaty, Contracting Parties must apply the provisions of Article 11 of the Paris Convention also to services. Finally, this provision enables an applicant to take advantage of a temporary protection resulting from the presentation of goods or services in an international exhibition if the law of the Contracting Party allows for such a possibility.

3.10 *Item(ix)*. The consequences of such a statement are specified in the Regulations (see Rule 3(1)).

3.11 *Item(x)*. The fact that the applicant claims color has consequence on the number of reproductions of the mark which have to be furnished (see Rule 3(2)).

3.12 *Item(xi)*. A Contracting Party may require that the applicant state that the mark is a three-dimensional mark, even if this could be inferred from the reproduction of the mark.

3.13 *Item(xii)*. The details relating to the number and type of reproduction are dealt with in the Regulations (see Rules 3(2) and (3)). Rule 3(3) defines what is meant by “reproduction” in the case of a three-dimensional mark. This provision does not restrict a Contracting Party’s freedom to refuse a reproduction the quality of which is insufficient for the purposes of, *inter alia*, publication.

3.14 *Item(xiii)*. The details concerning transliteration are contained in the Regulations (see Rule 3(4)).

3.15 *Item(xiv)*. Contracting Parties may wish to require a translation of the mark, for example, in order to evaluate the distinctive character of the mark or a possible conflict with public order. The details concerning translation are contained in the Regulations (see Rule 3(5)).

3.16 *Item(xv)*. Whereas a grouping of names of goods and/or services according to the classes of the Nice Classification is required, the use of the precise terms of the Alphabetical List established in respect of that Classification is not required. The goods and/or services must be listed in the language, or in one of the languages, admitted by the Office where the application is filed. As regards the terms used by an applicant to designate the goods and services in the application, a Contracting Party is free, in the course of examination of that application, to require that any term that is general or too vague be replaced by a term or term that is or are specific and clear. /or

3.17 *Item(xvi)*. The words “as required by the law of the Contracting Party” indicate that such a declaration would have to be worded in the terms and in the language prescribed by the law of the Contracting Party. For example, in the United States of America, the declaration of *bonafide* intention to use the mark forms part of a more general statement. of

3.18 The expression “law” is to be understood to include, in this provision and throughout the Treaty and the Regulations, all binding norms issued by the legislative or executive branches of the Contracting Party, including any rules issued by the Office, as well as court decisions.

3.19 *Paragraph(1)(b)*. If an applicant makes actual use of his mark in respect of all the goods and/or services listed in the application, he may file his application on the basis of actual use. He may also file his application on the basis of both intention to use and actual use where he actually uses the mark in respect of some of the goods and/or services listed in the application and intends to use the mark in respect of the other goods and/or services listed in the application. This provision corresponds to a provision existing, for example, in the law of Canada and the United States of America.

3.20 *Paragraph(1)(c)*. In addition to the fee to be paid in respect of the application, there may be separate fees for the publication of the application and the registration. However, it is also possible (and compatible with the Treaty) to combine those fees and require payment of such a combined fee (which may nevertheless be called “application fee”) at the time of filing the application.

3.21 *Paragraph(2)*. It is to be noted that Contracting Parties are free to base the amount of the fee to be paid for an application on the number of classes to which belong the goods and/or services included in the application. Thus, for Contracting Parties at present practicing a single class applications system, the transition to the multi class applications system provided for by the Treaty need not cause any loss of fee income.

3.22 *Paragraph(3)*. A requirement relating to the furnishing of evidence of actual use of the mark prior to the registration of the mark, in cases where the application was not filed on the basis of actual use, exists in a few countries (for example, Canada and the United States of America).

3.23 The Regulations provide in Rule 3(6) for a minimum time limit for furnishing evidence of actual use under paragraph (3), which time limit can be extended under the law of a Contracting Party.

3.24 *Paragraph(4)*. This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) and (3) and Article 8 not only at the time of filing of the application but also throughout the application stage ending with registration, subject to the possibility of requiring under paragraph (5) the furnishing of evidence. It should, however, be understood that paragraph (4) does not preclude a Contracting Party from requiring, where necessary, during the examination of an application, additional indications from the applicant concerning the registrability of the mark, for example, a statement of consent from a person whose name is the same as, or appears in the mark, documents to the effect of ensuring compliance with Article 6ter of the Paris Convention or documents concerning the ability of a certain person (such as a minor or a person under tutelage) to file an application.

3.25 *Items(i)to(iv)*. The examples given in items (i) to (iv) concern information or documents which cannot be required during the whole pendency of an application. The list is not exhaustive. The items listed merely serve to illustrate the effects of the Treaty with respect to some formalities which are particularly unnecessary and undesirable.

3.26 Under item (i) requirements to furnish a certificate of, or an extract from, a register of commerce is prohibited because an applicant's *bonafide* existence and legal standing under the law of the applicant's country of establishments should be presumed by the Office. The likelihood that fictitious persons or irregular entities would go through the process of applying for the registration of marks seems very low, and does not seem to justify the inconvenience of requiring that all applicants submit certifications from a registry of commerce. Moreover, any obligation to submit a certification of establishment in the country where registration is sought would be proscribed by virtue of Article 2(2) of the Paris Convention.

3.27 Under item (ii) the requirement to submit an indication of the carrying on of an industrial or commercial activity, and the furnishing of evidence to that effect, is prohibited because marks may be owned by entities which themselves do not carry on any industrial or commercial activity, for example, holding companies.

3.28 Under item (iii) a requirement to submit an indication or evidence that the applicant is carrying on an activity corresponding to the goods and services listed in the application is prohibited because very often trademark applications are filed before the corresponding goods or services are actually put on the market. Many laws establish a period of time to allow the trademark owner to start using his mark in respect of the specified goods or services. Such

periods may vary between three years counted from the date of filing and five years after registration. Failure to use the mark for the goods and/or services listed in the application or registration after those periods have expired may entail consequences under the applicable laws, including refusal or cancellation of registration.

3.29 Item (iv) reflects the rule of independence of marks under Article 6 of the Paris Convention. It therefore prohibits making the protection of a mark dependent on its registration in another country party to the Paris Convention, including the country of origin. Therefore, evidence to the effect that the mark has been registered in another Contracting Party or in a State party to the Paris Convention which is not a Contracting Party of the TLT cannot be required. However, Article 6 *quinquies* of the Paris Convention establishes a special right to obtain registration of a mark on the basis of a prior registration in the home country. A Contracting Party would therefore be entitled to require a certificate of registration in the country of origin where the applicant invokes the benefit contemplated in that provision.

3.30 *Paragraph (5)*. Evidence may be required whenever the application contains an allegation the veracity of which is doubtful. This applies even in the case of an allegation which is not required to be made under the law of the Contracting Party concerned. In the case of an allegation which is required to be made under that law, the provision of paragraph (5) constitutes an exception to the prohibition contained in paragraph (4). Such would be the case, for example, where the applicant claims the benefit of Article 3 of the Paris Convention but there is doubt as to the veracity of the applicant's allegations as to his domicile, etc.

3.31 The term "examination of the application" includes any opposition procedure (which may take place before or after the registration of a mark). This provision does not relate to the correction of mistakes, but to cases where the Office believes that an indication or element is not true.

3.32 The Office of a Contracting Party which is a party to the Paris Convention may also invoke this paragraph when it has to fulfill an obligation under the Paris Convention (for example, where there is reasonable doubt concerning the right of the applicant to file an application for a mark which consists of a sign, or is similar to a sign, protected under Article 6 *ter* of the Paris Convention).

*Notes on Article 4
(Representation; Address for Service)*

4.01 *Article 4*. This Article does not apply to representatives who are employees or officials of a legal entity (whether applicant or holder), for example, in-house counsel of a corporation. It typically applies to trademark agents and attorneys in private practice. This Article relates only to the appointment itself and to the possible limitation of the appointment, but does not deal with the termination of the appointment. In the latter respect, and in respect of any other matter relating to representation which is not covered by the Treaty, a Contracting Party will apply its own law. For example, a Contracting Party may provide that the appointment of a new representative terminates the appointment of all previous representatives. Or, a Contracting Party may allow sub-representation and in that case, require that, where the power of a representative extends to the appointment of one or more

sub-representatives, the power of attorney expressly authorize a representative to appoint such sub-representatives.

4.02 *Paragraph(1)(a)*. Under this provision, a Contracting Party is allowed to require that the appointed representative be a person admitted to practice before its Office and that such person provide an address in a specified territory. A Contracting Party may however, have a less strict requirement and may, for example, require only one of those conditions, neither of them, or establish other requirements.

4.03 *Paragraph 1(b)* defines the legal effect of acts performed by an appointed representative in the context of procedures before the Office, under the Treaty. This provision would override any provisions in the law of the Contracting Parties that might establish a different effect for acts performed by representatives.

4.04 *Paragraph 2(a)* recognizes the Contracting Parties' basic freedom to require that applicants be mandatorily represented before the Office for the purposes of procedures under the Treaty. However, it also establishes three cases in which a person must be allowed to present himself directly before the Office, i.e. without necessarily being represented by an appointed representative. *Item (i)* refers to the filing of an application for registration of a mark. Because this action determines the attribution by the Office of a filing date, and time for filing may often be critically short, a trademark owner must be allowed to file an application even if he has not had time to select and appoint a local representative. *Item (ii)* refers to the payment of a fee. This is a simple procedure that can often be performed by simple bank transfer or other inexpensive procedure. Requiring a representative merely to pay a fee would not only entail costs that may be higher than the fee itself, but may entail loss of rights due to a missed deadline for the payment of a fee. *Item (iii)* refers to the act of requesting to or receiving from the Office a receipt for the filing of an application or the payment of a fee. Requiring a representative for this purpose would effectively defeat the purpose of exempting those two procedures from mandatory representation.

4.05 *Paragraph(2)(b)*. The laws of some countries do not require that a representative be appointed before their Offices even where the applicant or the new holder has neither a domicile nor a real and effective industrial or commercial establishment on the territory of those countries. The laws of some of those countries however require, for the purposes of facilitating correspondence with the person concerned, that an address for service in their territory be indicated.

4.06 *Paragraph(3)(a)*. It follows from this paragraph that a Contracting Party may refuse the appointment of a representative made by oral communication or in a written communication other than a power of attorney, for example, a statement in the application itself, in the request for renewal, or in the request for recording of a change, a correction (since the communication may be required to be separate) a license, or any other procedure. The reference, in this provision, to "any other interested person" covers, for example, an opponent.

4.07 *Paragraph(3)(b)*. This provision puts an obligation on Contracting Parties to accept a single power of attorney in respect of several applications, several registrations or both applications and registrations of the same person. Contracting Parties must also accept what is sometimes referred to as a "general power of attorney," that is, a power of attorney that relates to all existing and future applications and/or registrations of the same person. In

respect of the latter type of power of attorney to which the words “subject to any exception indicated by that person” relate, a Contracting Party must allow the person making the appointment to indicate possible exceptions in the power of attorney itself (for example, appointment only for future applications and registrations) or to make exceptions at a later time.

4.08 *Paragraph(3)(c)*. An applicant or holder could appoint a representative in respect of certain matters (for example, filing of applications and renewal of registrations) and appoint another representative in respect of other matters (for example, treatment of objections and oppositions). Alternatively, where the applicant or holder does not need to appoint a representative (for example, for domestic applications and registrations), he could carry out certain operations (for example, filing of applications) himself and appoint a representative only for the remaining matters. The possibility for a Contracting Party to require that the right for a representative to withdraw an application or surrender a registration be expressly mentioned in the power of attorney is justified in view of the particularly important consequences of such acts.

4.09 *Paragraph (3)(d)*. As regards the time limit to present the power of attorney, see Rule 4.

4.10 *Paragraph(5)*. This paragraph establishes the exhaustive character of the list of requirements under paragraphs (3) and (4) and in Article 8 with respect to the matter of representation as covered by the Treaty, subject to the possibility of requiring under paragraph (6) the furnishing of evidence in cases of reasonable doubt.

4.11 *Paragraph(7)*. The office is required to notify the applicant, holder or other interested person in case the applicable requirements are not complied with.

Notes on Article 5 (Filing Date)

5.01 *Article 5*. This Article establishes an exhaustive list of requirements for according a filing date to an application. The fact that, for the purpose of according a filing date, a Contracting Party cannot require more indications and elements than those mentioned in paragraph (1)(a) (subject to paragraph (2)) follows from paragraph (4).

5.02 *Paragraph(1)(a)*. The words “subject to subparagraph (b) and to paragraph (2)” mean that Contracting Parties may require less indications and elements than those referred to in items (i) to (vi), and may require, in addition to those indications and elements, the payment of a fee.

5.03 *Item(i)*. “Implicit” means that a Contracting Party must accord a filing date even where the request is not express but can be inferred from the circumstances.

5.04 *Item(ii)*. Such indications could, for example, consist of the applicant’s identification code (rather than his name) in Offices that allow the use of such codes, for example, in the case of electronic filings.

5.05 *Item(iii)*. Such indications could, for example, consist of less than the full address or an e-mail address.

5.06 *Item(iv)*. Although in certain circumstances more than one reproduction of the mark may be required, the filing date could not be denied if only one reproduction is furnished or if among the reproductions furnished, only one reproduction is “sufficiently clear”.

5.07 *Item(v)*. The list of goods and services must be accepted even if at the time of filing it is not presented as required under Article 3(1)(a)(xv).

5.08 *Paragraph(2)*. There is only one additional requirement permitted for the purposes of according a filing date, namely that the required fees be paid. Such requirement still exists in some countries. This paragraph allows the continuation of the said requirement in those countries where it already exists. However, a Contracting Party may not introduce this requirement once it has become bound by the Treaty.

5.09 *Paragraph(3)*. The details are provided for in Rule 5(1).

*Notes on Article 6
(Single Registration for Goods and/or Services in Several Classes)*

6.01 This provision prevents single applications from being subsequently split *ex officio* into two or more registrations. However, an application will result in a registration only if all the conditions for allowance are fulfilled. If the application is divided into several applications under Article 7, there will be as many registrations as there are applications.

*Notes on Article 7
(Division of Application and Registration)*

7.01 *Paragraph(1)(a)*. A division of the initial application may relate to only one or some of the goods or services included in the initial application (which may be either a single class or a multiple class application) or to one or several classes of goods and/or services covered by the initial application. The words “decision by the Office on the registration” or “decision on the registration”, respectively, appearing in items (i) and (iii), concern a decision to register or not to register. Typically, the applicant is interested in dividing the application where an objection by the Office or an opposition filed against the registration of the mark affects only some of the listed goods and services. In such a situation, a division into two divisional applications could allow one of the divisional applications to proceed immediately to registration, while the objection or opposition proceedings would continue only with respect to the other divisional application. Article 7 does not oblige Contracting Parties to allow division of the applications after a (positive or negative) decision has been taken by the Office regarding the registration of the mark. This is so because, if a positive decision is made, any request for division would hamper the registration of the mark and its publication and if a negative decision is made, division may be requested during appeal proceedings against the decision but not if no appeal is filed. Of course, each Contracting Party would be free to allow for the division of an application also in situations where this is not required by the Treaty.

7.02 *Paragraph(1)(b)*. The words “requirements for the division” mean, in particular, the elements or the indications to be given in the request for division.

7.03 *Paragraph(2)*. Typically, the possibility of dividing a registration is needed in cases where an opposition can only be filed after the mark has been registered (“post-grant opposition”). If the opposition affects only some of the goods and/or services covered by the registration, the holder should have an opportunity to divide his registration. This will be useful to him, for example, if he intends to negotiate a partial transfer or license agreements in respect of the goods and/or services which are not affected by the said procedure. It is to be noted that the proviso of this paragraph allows a Contracting Party to exclude post-grant division if the law of that Contracting Party allows opposition to applications (that is, pre-grant opposition).

*Notes on Article 8
(Communications)*

8.01 As to the term “communication”, reference is made to Article 1(iv).

8.02 *Paragraph (1)*. The term “means of transmittal” refers to the physical or electronic means used to transmit a communication to the Office. For example, an application on paper mailed to the Office is a communication in paper form transmitted by physical means, while a floppy disk mailed to the Office is a communication in electronic form transmitted by physical means. A telex or facsimile transmission resulting in a paper copy is a communication in paper form transmitted by electronic means, while a telex or facsimile transmission to a computer terminal is a communication in electronic form transmitted by electronic means. An electronic transmission from computer to computer is a communication in electronic form transmitted by electronic means.

The term “transmittal of communications” refers to the transmission of a communication to the Office. A Contracting Party is not required to accept the transmittal of communications in any electronic form, or by any electronic means of transmittal, just because that Contracting Party permits the filing of communications in a particular electronic form or by particular electronic means.

8.03 *Paragraph(2)(a)*. This paragraph provides, generally, that a Contracting Party may require that any communication be in the language or one of the languages admitted by the Office. This provision deals globally with the language requirements for all communications before the Office under this Treaty. Therefore the language provisions which were contained in Articles 3(3) (*Application*), 4(4) (*Power of Attorney*), 10(1)(c) (*Change in Name and Address*), 11(2) (*Change in Ownership*), 12(c) (*Correction of Mistakes*), 13(3) (*Renewal of Registration*) of the original TL have been deleted. The expression “a language admitted by the Office” refers to a verbal language and not, for example, to a computer language. What constitutes a language admitted by the Office is determined by the applicable law of the Contracting Party concerned. Nothing in paragraph 2(a) would prevent a Contracting Party from considering a communication accompanied by a translation as being transmitted in a language admitted by the Office.

8.04 The second sentence of Article 8(2)(a) enables multilingual countries which allow the filing of applications in different languages, to require the applicant, holder or other interested person, to comply with any other language requirements applicable with respect to their

Offices, provided that an indication or an element of the communication may not be required to be in more than one language. It also enables a Contracting Party to require that some indications or elements of the communication, such as the list of goods and services, be in a language admitted by the Office which does not necessarily have to be the official language of the Office, and that some other indications or elements of the communication be in the official language of the Office. However, no element or indication may be required to be in two languages.

8.05 *Paragraph(2)(b)*. This paragraph aims at making the procedures before the Office more simple and economical. In particular, a Contracting Party is not allowed to require a translation to be certified by a notary public.

8.06 *Paragraph(2)(c)*. Where the Office accepts a communication in a foreign language, it may require that a translation by an official translator or a representative be submitted to the Office. Article 5(1)(b) expressly provides that, for the purposes of the filing date, the indications and elements referred to in Article 5(1)(a) may be received in a language other than the language admitted by the Office under paragraph 2(a) of the present Article. The Office may require that the translation of the communication be supplied within a reasonable time limit as may be defined by the Contracting Party. However, as per paragraph (2)(b), the translation may not be required to be certified, notarized or legalized.

8.07 *Paragraph(3)*. This paragraph contains a general provision dealing with the presentation of communications for all the different procedures relating to a mark before an Office. Therefore, the provisions previously contained in Articles 3(2) (*Application*), 4(3)(e) (*Power of Attorney*), 10(1) (*Change in Name and Address*), 11(1) (*Change in Ownership*), 12(1) (*Correction of Mistakes*), 13(2) (*Renewal of Registration*) of the original TL have been replaced by this paragraph (3).

8.08 Under paragraph (3) a Contracting Party is obliged to accept a communication when the presentation and arrangement of indications and elements in the communication – whether transmitted to the Office on paper or in electronic form or by electronic means – correspond to the presentation and arrangement of indications and elements in the Model International Form provided for in the Regulations in respect of such a communication. The International Model Forms correspond to the maximum requirements that a Contracting Party may provide for under the Treaty and the Regulations. They constitute a safeguard for applicants and holders because they cannot be required to provide indications or elements additional to those set out in the Model Form. At the same time use of the Model International Form simplifies procedures for applicants, holders and Offices. The obligation for an Office to accept a communication that corresponds to the Model International Form does not affect any language requirements established by that Office. On the other hand, an Office may prepare its own “Individualized International Forms” for optional use by applicants, provided such forms do not contain reference to mandatory elements that would be additional to the elements referred to in the corresponding International Model Forms and would be contrary to the Treaty or the Regulations. This point was clarified in the Agreed Statement N°5, adopted at the Diplomatic Conference for the Conclusion of the Trademark Law Treaty. However, the preparation of such “Individualized International Forms” by an Office would not allow it to avoid the obligation to accept a communication if the presentation and arrangement of indications and elements therein correspond to those in the Model International Form, even if such communication is not presented on the Individualized International Form prepared by that Office.

8.09 As far as the presentation of the communication is concerned, paragraph (3) does not establish a distinction between the transmittal of a communication on paper and the transmittal of a communication in electronic form or by electronic means. It emphasizes the contents of the communication in order to comply with the specific technical requirements of the transmittal of communications in electronic form.

8.10. *Paragraph(4)*. The term “signature” means any means of self-identification. It is implicit that the “signature” of a communication must be that of a person who is authorized to sign the communication concerned. Accordingly, an Office may, in accordance with the applicable law, reject the signature of a person who is not so authorized. Certain forms of signature that a Contracting Party must or may accept, or may require, are expressly referred to under Rule 6(3) to (6), namely a hand-written, printed or stamped signature, a seal, a bar-coded label, or a signature filed in electronic form or by electronic means of transmittal.

8.11 *Paragraph(4)(a)*. Regulations concerning the signature of communications filed on paper, in electronic form or by electronic means of transmittal are prescribed in Rule 6(3) to (6).

8.12 *Paragraph(4)(b)*. This provision obliges a Contracting Party, to accept the signature of the person concerned as sufficient, without the need for further authentication by way of, for example, attestation or notarization of that signature, thereby reducing the burden on applicants and holders. The only exception that may be provided under national law refers to signatures on communications that concern the surrender of a registration, as the case of signature in electronic form not resulting in graphic representation of the signature (see Rule 6(6)).

8.13 *Paragraph(4)(c)*. In case of reasonable doubt as to the authenticity of the signature, the Office may require the applicant, holder or other interested person filing the communication to file evidence of authenticity. Such evidence may be in the form of certification, or by other means allowed by the law of the Contracting Party.

8.14 *Paragraph(5)*. The indications that a Contracting Party may require generally in any communication are prescribed in Rule 7.

8.15 *Paragraph(6)*. What constitutes an address for correspondence or an address for legal service is a matter for the applicable law of the Contracting Party concerned. It is also a matter for the applicable law of the Contracting Party concerned whether, and in what circumstances, the Office may require an address for correspondence or an address for legal service, or both, and in what communications such address(es) must be indicated.

8.16 *Paragraph(7)*. Where, for example, a document is prepared on a computer and directly transmitted by telefacsimile, a printout of that document from the computer could be considered as the original.

8.17 *Paragraph(8)*. The Office is required to notify the applicant, holder or other interested person who filed the communication in case the communication does not comply with the applicable requirements. This provision is consistent with Article 14, that requires the applicant to have an opportunity to comply with any missing requirements or make observations.

*Notes on Article 9
(Classification of Goods and Services)*

9.01 *Paragraph(1)*. This provision obliges Offices of Contracting Parties to refer by name to the goods and services specified in the registration of a mark, and in any publication of an application or registration relating to a mark. It also requires that the relevant class number(s), as established by the Nice Classification, be indicated, and that the goods and services belonging to the same class be grouped together under the corresponding class number. The Nice Classification was established by the Nice Agreement of 1957. Its 8th edition (in force since 2002) consists of 34 classes for goods and eleven classes for services, each having a number (from 1 to 45).

9.02 *Paragraph(2)*. This provision allows the Contracting Parties to disregard the class or classes under which the specified goods or services are grouped as a criterion to determine similarity or dissimilarity among those goods or services. This recognizes that goods or services classified in different classes may, in the circumstances of a particular case, be found to be similar or related, while under other circumstances goods or services covered in the same class may be found to be dissimilar or unrelated. The issue of similarity between goods or services can be relevant to determine the scope of protection in cases of conflict between two marks.

*Notes on Article 10
(Changes in Names or Addresses)*

10.01 *Paragraph(1)(a)*. It follows from the wording of this paragraph that a Contracting Party may refuse a request to record a change of name or address of the holder of a mark if the request is made by oral communication. It is also clear that this Article applies to changes in names, changes in addresses and changes in both names and addresses.

10.02 *Paragraph(1)(b)*. The names and addresses referred to in paragraph (1)(b) must be those which are recorded in the register of marks of the Office concerned. If that is not the case, the Office can require either the furnishing of evidence under paragraph (5) or that another change be recorded beforehand.

10.03 *Paragraphs(1)(c) and(d)*. The amount of the fee could differ depending on the number of the registrations or applications involved.

10.04 *Paragraph(2)*. In respect of a request relating to one or several applications, a Contracting Party is free not to record the change in its register of marks but to record it in a database concerning pending applications; in such a case, the change would be included in the register of marks once the mark is registered.

10.05 *Paragraph(4)*. This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (3) and Article 8(2) and (3) with respect to a request for a change in name or address. This would prohibit, for example, the requirement to furnish a certified copy of the recording of the change in a register of companies, or a certified copy of the decision to change the name or address.

*Notes on Article 11
(Change in Ownership)*

11.01 *Article 11.* This Article only deals with the procedures which should be fulfilled before an Office and not before other authorities of a Contracting Party, for example, the fiscal authorities or a public registry of companies.

11.02 *Paragraph 1(a).* The term “new owner” is used rather than “new holder” because, at the time of the request for recording of the change in ownership, the person who has acquired the rights is not yet a holder since she or he is not recorded as such in the register of marks.

11.03 *Paragraphs 1(b) to (e).* These paragraphs distinguish three cases, namely, a change in ownership resulting from a contract, a change in ownership resulting from a merger and a change in ownership resulting from the operation of law or from a court decision (inheritance, bankruptcy, etc.).

11.04 *Paragraph 1(b)* relates to a change in ownership that results from a contract. Any Contracting Party may require that the request indicate the fact that the change in ownership results from a contract and that the request be accompanied by a document evidencing the change in ownership. Items (i) to (iv) list four different documents, and it is up to the requesting party to choose one of them to substantiate this request. Where the requesting party chooses to furnish a certificate of transfer or a transfer document (items (iii) and (iv)), no Contracting Party may require that this certificate or document be the subject of any form of certification. On the other hand, where the requesting party chooses to furnish a copy of the contract or an extract of the contract (items (i) and (ii)), a Contracting Party is free to require that the copy or the extract be certified. The Regulations provide for a model certificate of transfer and a model transfer document. The latter can effectively function as a model contract (in a short version).

11.05 *Paragraph 1(c)* relates to a change in ownership that results from a merger. The request must, if the Contracting Party so requires, indicate the fact that the change in ownership results from a merger and be accompanied by a copy of a document evidencing the merger. This document must originate from the competent authority. It may, for example, be an extract from a register of commerce. The Contracting Party may only require that a copy of the merger document be furnished; it may not require the original of the document. However, it may require that the copy be certified.

11.06 *Paragraph 1(d).* Where a co-holder transfers his share in a registration, he may under the applicable law, need the consent of any other co-holder. The Treaty allows Contracting Parties to require the furnishing of a document in which the said consent is given.

11.07 *Paragraph 1(e).* This paragraph relates to any change in ownership that results neither from a contract nor from a merger. In such a case, the Contracting Party may require that the request indicate the legal cause of the change in ownership (operation of law, court decision, etc.) and be accompanied by a copy of any document which it deems appropriate to evidence the change. Although the Contracting Party may not require that the original of such a document be furnished, it may require that the copy emanate from the authority that issued the document or that it be certified.

11.08 *Paragraphs(1)(g) and(h)*. The explanations given on Article 10(1)(c) and (d) are also applicable to these paragraphs (see Note 10.03).

11.09 *Paragraph(1)(i)*. This provision deals with the consequences of a request for the recording of a change of ownership in the case where the change concerns only some of the goods and/or services covered by the registration. In such a case, the Office must split the registration: the original registration will continue to exist, without reference to the goods and/or services in respect of which the ownership has changed, and a separate registration has to be created in the name of the new owner for those goods and/or services. It is left to each Contracting Party to decide how these separate registrations should be identified. This can be done, for example, by giving it the same number as the original registration, together with a capital letter. This would be in accordance with the practice under the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating thereto. Paragraph (1)(i) only applies where a Contracting Party allows the said kind of partial change in ownership. Since this Treaty does not cover the substantive conditions relating to the change in ownership or a registration, a Contracting Party is free to refuse a partial change in ownership and consequently, a request for recording of such a partial change in ownership. A Contracting Party that admits in principle a partial change in ownership of a mark, could refuse such change in specific cases on grounds of public order, for example, if the split of goods or services among the original and new owner is such that it is likely to cause confusion or is misleading.

11.10 *Paragraph(2)*. The explanations given on Article 10(2) are also applicable to this paragraph. (see Note 10.04).

11.11 *Paragraph(3)*. This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) to (3) and in Article 8(2) and (3) with respect to a request for the recording of a change in ownership, always subject to the possibility of requiring under paragraph (4) the furnishing of evidence. The examples given in items (i) to (iv) are not exhaustive. Another example of a prohibited requirement could be making the admissibility of the request dependent on an advertisement of the change in ownership in one or several newspapers. Since the Treaty does not regulate the substantive requirements relating to the validity of a change in ownership, a Contracting Party may require the fulfillment of additional conditions, for example, in situations concerning inheritance, bankruptcy or tutelage.

11.12 *Items(i) to (iii)*. The explanations given on Article 3(4) items (i), (ii) and (iii) are also applicable to these items (see Notes 3.26 to 3.28).

11.13 *Item(iv)*. This provision does not deal with the question of validity of a transfer in the absence of a simultaneous transfer or assignment of the relevant business or goodwill. It only specifies that certain formal requirements are not allowed in respect of the request for recording of the transfer. The question of assignment of goodwill in conjunction with the transfer of marks is a matter that may be dealt with under national law. As regards the transfer of the relevant business, Article 21 of the TRIPS Agreement provides that the owner of a registered mark shall have the right to assign the mark with or without the transfer of the business to which the mark belongs.

*Notes on Article 12
(Correction of a Mistake)*

12.01 *Paragraphs (1) to (4) of this Article* relate to mistakes attributable to the applicant or to the holder, or to his/her representative.

12.02 *Paragraphs (1)(b), (c) and (d)*. The explanations given on Article 10(1)(b), (c) and (d) are also applicable to these paragraphs. (see Notes 10.02 and 10.03).

12.03 *Paragraph (3)*. This paragraph establishes the exhaustive character of the list of requirements under paragraphs (1) and (2) and in Article 8(2) and (3) with respect to a request for the correction of a mistake.

12.04 *Paragraph (4)*. If the Office has reason to suspect that what is submitted as a mistake to be corrected is in fact a change of name, address or ownership, or any other operation, it could require that evidence be supplied to clarify the matter.

12.05 *Paragraph (5)*. In the case of mistakes attributable to an Office, the latter may adopt a procedure such as *ex officio* correction or, where the mistake is noticed by the applicant or the holder, or by his representative, correction following a request made by them in a simple letter.

12.06 *Paragraph (6)*. A Contracting Party is not obliged to accept a request to correct a mistake that may not be corrected under the law of that Party. For example, if the law of a Contracting Party does not admit that a mark may be changed or altered after an application for its registration has been filed, the Office of that Contracting Party would not be obliged under Article 12 to accept a request for change or alteration of the mark on ground that the mark contained a mistake in its spelling or in any of its features.

*Notes on Article 13
(Duration and Renewal of Registration)*

13.01 *Article 13*. This provision provides a maximum list of requirements in respect of requests for the renewal of registrations.

13.02 *Paragraph (1)(a)*. This paragraph contains an exhaustive list of the indications and elements which may be required in respect of a renewal. The exhaustive character of that list follows from paragraph (4). This list constitutes a maximum, and Contracting Parties are free to require fewer indications or elements. For example, Contracting Parties may accept renewal effected by them on payment of the renewal fee, without the submission of a formal request.

13.03 *Item (i)*. The comments relating to Article 3(1)(a)(i) with respect to a request for registration are relevant to this item (see Note 3.02).

13.04 *Item (iv)*. Two dates are indicated in this provision because, according to the law of some countries, the initial duration of a registration is calculated from the date of filing of the application which resulted in the registration, while according to the law of other countries, that duration is calculated from the date of registration. Some Contracting Parties may not

require the furnishing of any date if they consider that the indication of the registration number under item (iii) is sufficient to identify the registration which is the subject of the request for renewal. On the other hand, any Contracting Party requiring the furnishing of a date will have to opt for any of the two dates (filing date or registration date), and could not require both to be furnished.

13.05 *Item(vii)*. Any Contracting Party is free not to allow a limitation of the list of goods and/or services to take place together with the request for renewal. In those Contracting Parties, a limitation of the list of goods and/or services would have to be requested separately, before or after the renewal.

13.06 *Paragraph(1)(b)*. This provision does not prohibit a Contracting Party from requiring an additional fee or a higher renewal fee whereas such a Contracting Party allows, under paragraph (1)(a)(vii), that a limitation of the list of goods and/or services be made in the request for renewal itself and such limitation is requested. These two sentences of this provision make it clear that, for any 10-year period, a Contracting Party is only allowed to require the payment of one set of fees.

13.07 *Paragraph(1)(c)*. Rule 9 deals with the minimum period for requesting renewal and paying the renewal fee.

13.08 *Paragraph(2)*. This paragraph establishes the exhaustive character of the list of requirements under paragraph (1) and in Article 8(2) and (3) always subject to the possibility of requiring under paragraph (3) the furnishing of evidence in case of reasonable doubt.

13.09 The examples given in paragraph (2) are not exhaustive. They serve to illustrate the effects of the Treaty with respect to some formalities which seem to be particularly unnecessary and undesirable at the time of renewal. Other examples could be, for example, the furnishing of the original or a copy of the certificate of the registration of the mark which is the subject of the request for renewal.

13.10 *Item(i)*. An obligation to furnish any reproduction or other identification (for example, the simple indication of a mark published in standard characters) of the mark which is the subject of the request for renewal is prohibited because it would be superfluous. The mark that is to be renewed is the same as the one that was initially registered (if this were not the case, an application would have to be filed) and the publications of a renewal need not contain the mark (it only needs to refer to the number of the initial registration without having to reproduce the mark). The practice of not reproducing the mark is already followed by a number of countries and has advantageous consequences both for the holders of registrations (lower renewal fee, in particular, where there is no reproduction of the mark would have to be in color) and for the Offices (simplification of administrative work and reduction of the space needed in the official bulletin in respect of renewals). Nothing in the Treaty prohibits a Contracting Party from reproducing, in connection with the publication of the renewal, the reproduction of the mark as registered, which the Office has in its files. What is prohibited is to require the holder to furnish a reproduction of the mark for the purposes of the renewal.

13.11 *Item(ii)*. This provision follows the same rationale as that in Article 3(4)(iv). It reflects the rule of independence of marks as derived from Article 6 of the Paris Convention. Consequently, renewal of the registration of a mark in a Contracting Party may not be linked

orsubjectedtoregistrationorren ewalofthatmarkinanyotherContractingParty(SeeNote 3.29).

13.12 *Item(iii)*. ItisunderstoodthatnothingintheTreatypreventsContractingPartyfrom applyingtherequirementsofitslawinrespectoftheuseofthemarkwhichisthesubject ofa registration,providedthatthe compliancewithsuchrequirementsisnotlinkedwiththe procedurefortherenewalofthatregistration.

13.13 *Paragraph(4)*. Theprocedurerelatingtotherenewalofaregistrationcannotinclude anexaminationast osubstance.Therenewalofaregistrationmerelyimpliesanextensionin timeofanexistingregistration.Thefactsthatdeterminedtheregistrationofthemark,as verifiedduringtheinitial examinationofthesign,remainvalidforthepurposesofr enewal. Thiswillensurethatrenewalproceduresremainassimpleandinexpensiveaspossible. NothingwouldpreventContractingPartyprovidingfortheexpungingofamarkfromthe registryifpreexistingornewgroundsforcancellationorinvalidationareestablished. However,thisproceduremaynotbelinkedtoorcombinedwiththerenewalprocedure.

13.14 *Paragraph(5)*. Thisprovisionaimsatharmonizingthedurationoftheinitial registrationandofeachrenewal.Asregardsthedurationofthe initialregistration,the proposedtenyears correspondtothedurationprovidedforinmostnationallaws.

13.15 NeithertheTreatynortheRegulationsdeterminethedatefromwhichtheperiodsof initialregistrationorofrenewal(dateofapplicatio n,publication,Officedecision,registration etc.)aretobecounted.This islefttothelawofeachContractingParty.

*NotesonArticle13bis
(MeasuresinCaseofFailuretoComplywithTimeLimits)*

13bis.01 UnderthisArticle,aContractingPartyi sobligedtoprovidereliefinrespectof timelimits.Suchreliefmaybeintheformofanextensionofthetimelimit,intheformof continuedprocessingorintheformofreinstatementofrights.

13bis.02 *Paragraph(1)*. ContractingPartiesarerequi redtoprovideforatleastoneformof reliefincaseoffailuretocomplywithatimelimitinaprocedurebeforetheOffice, irrespectiveofwhetherthetimelimitisfixedbytheOfficeorbystatute.Thisobligationonly appliestotimelimitsthata relessthansixmonths,sinceitisintheinterestofthirdpartiesand oftheOfficethattheproceedingsbeforetheOfficemetoanendwithinareasonabletime limit.IfatimelimitissixmonthsormoreContractingPartyisnotobligedtoprovi defor reliefbutitmaydos.

13bis.03 AContractingPartyisfreetoprovideforalltypesofreliefcontemplatedin subparagraphs (a),(b)and (c).Areliefundersubparagraph 1(a)and (b)isonlysubjecttothe filingofarequestinaccordancewit htherequirementsofparagraph (1)andRule 10,andthe paymentofanyfeerequiredunderparagraph (3).Accordingly,theapplicantorholdercannot berequiredtostatethegroundsonwhichtherequestisbased.Inaddition,incontrasttothe reinstatementofrightsunderparagraph 1(c),aContractingPartyisnotpermittedtomakethe grantofreliefundersubparagraph(1)(a)or(b)conditionalonafindingofducareor unintentionality.ThereliefthataContractingPartyisobligedtoprovideund erparagraph (1)

does not apply to time limits in procedures that are not before the Office, for example, proceedings before a court or a board of appeal.

13bis.04 An extension of a time limit under subparagraph (a) has to be requested prior to the expiration of the time limit (as provided for in Rule 10(1)(i)). Continued processing under subparagraph (b) may be requested after the expiration of the time limit and within the time limits referred to in Rule 10(4). The possibility to file a request for an extension of a time limit after the time limit has expired is not covered, since an extension of a time limit requested after the expiration of the time limit has in fact the same effect as a request for continued processing.

13bis.05 The requirements in respect of the request for the extension of a time limit under subparagraph (a), the period of extension, and the time limit for filing a request are dealt with in Rule 10(1) and (4). Concerning the request for continued processing under subparagraph (b), the requirements and the time limit for filing a request are dealt with in Rule 10(2) and (4).

13bis.06 The effect of continued processing is that the Office will continue with the procedure concerned as if the time limit had been complied with. Also, the Office must if necessary, reinstate the rights of the applicant or holder with respect to the relevant application or registration.

13bis.07 *Paragraph(1)(c)*. In contrast to the extension of a time limit or the continued processing of a request, the reinstatement of rights is subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or, at the option of the Contracting Party, that the failure was unintentional, as prescribed in Rule 10(3).

13bis.08 *Paragraph(2)*. The exceptions to the obligation to provide for a relief procedure are prescribed in Rule 10(5).

13bis.09 *Paragraph(4)*. This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1) and (3). In particular, the applicant or holder concerned cannot be required to state the grounds on which the request is based or to file evidence with the Office as regards paragraphs (1)(a) and (b). However, this provision allows the Office to require evidence in support of the reasons in accordance with Rule 10(3)(iii). The requirements referred to in this paragraph which are “referred to in this Treaty or in the Regulations” are in particular, those under Articles 4 and 8 and Rules 6 and 8.

13bis.10 *Paragraph(5)*. This paragraph only gives the requesting party the right to make observations on the intended refusal of a request under paragraph (1), for example, to assert that a fee required under paragraph (3) had in fact been paid. This paragraph does not provide an additional time limit to comply with any requirement under Article 13bis or Rule 10, which was not complied with, when the request was filed. This paragraph does not regulate the form of observations which an applicant or holder must be given an opportunity to make. The term “refusal” is meant to also cover sanctions which are of equivalent effect to refusal of the request under paragraph (1), such as the request being treated as abandoned or withdrawn.

13bis.11 *Intervening Rights*. The Treaty and Regulations do not regulate the rights, if any, acquired by a third party for any acts which were restarted, or for which effective and serious preparations were restarted, in good faith, during the period between the loss of rights resulting

from the failure to comply with the time limit concerned and the date on which those rights are reinstated. These remain a matter for the applicable law of the Contracting Party concerned.

*Notes on Article 14
(Opportunity to Make Observations in Case of Intended Refusal)*

14.01 This Article concerns refusals in respect of applications, requests for the recording of a change in names or addresses, requests for the recording of a change in ownership, requests for the correction of a mistake and requests for renewal. The notion of “refusal” includes the cases where those applications or requests are deemed withdrawn, abandoned or not to have been filed. It is to be noted that, where an application did not comply with one of the filing date requirements as provided for in Article 5 and an invitation was issued under Rule 5, the Office of a Contracting Party cannot treat the application as if it had not been filed without having to issue a second invitation to make observations if the applicant had not complied with the first invitation.

14.02 The applicant or holder should be given the possibility to make observations should in all cases, even if the refusal is based on non-payment or insufficient payment of fees or on the late presentation of the request for renewal.

14.03 For the purposes of this Article, the term “Office” does not include an appeal board even if it is part of or is otherwise connected to the Office. Therefore, Article 14 does not allow barring the right to submit observations to the Office merely because it is possible to appeal to such an appeal board.

*Notes on Article 15
(Obligation to Comply with the Paris Convention)*

15.01 Nothing in the Treaty derogates from obligations that Contracting Parties have towards each other under the Paris Convention.

15.02 Likewise nothing in the Treaty derogates from rights that applicants and holders enjoy under the Paris Convention.

*Notes on Article 16
(Service Marks)*

16.01 According to Article 6 *sexies* of the Paris Convention, the countries party to that Convention are obliged to protect service marks, but are free not to register such marks. Article 16 of the TLT means that, by becoming Contracting Parties to this Treaty, Contracting Parties are obliged to register service marks and apply to service marks all the provisions of the Paris Convention that would be applicable to trademarks (i.e. marks for goods). Those provisions include the following:

- Article 2, which deals with national treatment for nationals of countries of the Paris Union;

- Article 3, which assimilates certain categories of persons to the status of nationals of countries of the Paris Union;
- Article 4 A to D, which deal with the right of priority;
- Article 5 C and D, which deal with the questions of failure to use a mark, use of the mark in a form different from the one registered, use of the mark by co-proprietors and marking;
- Article 5 *bis*, which deals with the period of grace for the payment of fees for the maintenance of rights;
- Article 6, which deals with the conditions of registration and the independence of protection of the same mark in different countries;
- Article 6 *bis*, which deals with well-known marks;
- Article 6 *ter*, which deals with the prohibitions concerning State emblems, official hallmarks and emblems of intergovernmental organizations;
- Article 6 *quater*, which deals with the question of assignment of marks;
- Article 6 *quinquies*, which deals with the protection of marks registered in one country of the Paris Union in the other countries of that Union;
- Article 6 *septies*, which deals with the registration of a mark in the name of the agent or representative of the proprietor without the latter's authorization;
- Article 7, which deals with the nature of the goods to which the mark is applied;
- Article 9, which deals with seizure, on importation, etc., of goods unlawfully bearing a mark;
- Article 10 *ter*, which deals with remedies and the right to sue;
- Article 11, which deals with temporary protection at certain international exhibitions;
- Article 12, which deals with special national industrial property services.

16.02 Article 7 *bis* of the Paris Convention is not included in the foregoing list because under Article 2(2)(b) the TLT does not apply to collective marks whether for goods or services.

*Notes on Article 17
(Request for Recordal of a License)*

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

17.02 *Paragraph (1)*. 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 only some of those elements, but it may not require different or additional elements.

17.03 *Items (i) to (vi)*. As regards the manner of indicating names and addresses, Rule 2 (*Manner of Indicating Names and Addresses*) would apply.

17.04 *Items(ii),(iii),(v)and(vi)* .Article 4(2)wouldapplytotheseitems,becauserecordal ofalicenseisa“procedurebeforetheOffice.”Thus,underthatArticle,representationoran addressforservicemayberequired.

17.05 *Items(v)and(vi)* .ItisrelevantinthisrespectthatArticle 17(2)(b)allowsthelicensee tofilearequestforrecordalofalicenseindependentlyoftheholder,andthat,onthebasisof Article4(2),ContractingPartiesmayrequirethatanypersonwhohasneitheradomicileinora realandeffectiveindustrialorcommercialestablishmentonitsterritory,beresentedbya representativeorindicateanaddressforservice.Therefore,ContractingPartiesmayalso requirethattherequestcontaininformationregardingthelicensee’srepresentativeoraddress fors-service.

17.06 *Item(vii)* allowsaContractingPartytodetermine,wherenecessary,ifreciprocityis offered *vis-à-vis* nationalsinthecountryofwhichthelicenseeis-anational.Since Article3oftheParis Conventionprovidesthatnationalsofcountriesnotmembersofthe ParisUnionareentitledtonationaltreatmentiftheyhavearealandeffectiveindustrialor commercialestablishmentoraredomiciledinoneoftheParisUnioncountries,thisitem allowsthoseindications toberequired.

17.07 *Item(viii)* allowsaContractingPartyto requirethat,wheretheholder,thelicensee,or bothpartiesarelegalentities,thel legalnatureoftheentitybespecified.Thisprovision mirrorsArticle 3(1)(a)(iv) whichallowsasimilarrequirementwithregardtotrademark applications.

17.08 *Item(xi)* .Definitions of“exclusive license,”“non -exclusive license”and“sole license”arecontainedinArticle 1(xiv)to(xvi).Itistobenotedthat,asindicatedby the words“whereapplicable,ifthelawoftheContractingPartydoesnotprovideforoneormore suchindications,informationcorrespondingtotheitemunderconsiderationwouldnothave tobefurnished.

17.09 *Item(xii)* allowsaContractingPartyto requireanindicationthatthelicenseconcerns onlypartoftheterritoryforwhichtheregistrationhaseffect,togetherwithanexplicit indicationofthatterritory

17.10 *Item(xiii)* . ContractingPartiesmayrequirethattherequestindicatethetimep eriod forwhichthelicenseisgranted,orthatitisgrantedforanunlimitedperiodoftime.Ifthe licenseisgrantedforalimitedperiodoftimebutrenewedorextendedautomatically,the licensewouldbeconsideredtohavebeen grantedforalimited periodoftime.Itwouldbethe responsibilityofthepartiestoinformtheOfficeofanysubsequentrenewalorex-tensionofthe license.

17.11 *Item(xiv)* allowsaContractingPartyto requireasignature,whichcanbeeitherthe signatureoftheholder orhisrepresentativeor,undercertainconditionssetoutin paragraph(2)(b),thesignatureofthelicenseeorhisrepresentative.Theprovisions of Article8(Communications)andtherelevantruleswillalsoapplytosignaturesrelatingto requestsfortherecordaloflicensecontracts,with-outprejudicetoanyspecificprovisions containedinChapterII(TrademarkLicenses).

17.12 *Paragraph (2)*. The request for recordal of a licence is different in nature from the request for recordal of the change in ownership or registration of a mark, as provided for in Article 11(1)(d). For example, some countries require all co-holdersto sign the license agreement, while others permit only one of these several co-holdersto license a registered mark. Therefore, unlike Article 11(1)(d), 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 Contracting Parties. 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).

17.13 *Paragraph (2)(a)*. In the interest of simplifying, to the extent possible, the formal requirements relating to the recordal of licences, Contracting Parties may only require that the request be signed by the holder of the registration or his representative if the request is filed by the holder himself. His signature suffices to ensure that he has actually consented to the recordal. Attention is drawn to the obligation to apply Article 8(4), which prohibits the attestation, notarization, authentication, legalization or other certification of any signature or seal.

17.15 *Paragraph (2)(b)*. This provision allows the licensee to file the request for recordal independently of the holder, for example, if the holder wants to avoid paying the recordal fees or, after having concluded the license contract, refuses to record it for whatever reason. The documents listed in this paragraph can replace the signature of the holder on the request. The requesting party may file any one of them. The list is inspired from the list contained in Article 11(1)(b) regarding formal requirements for the recordal of changes in ownership resulting from a contract, while taking account of the qualitative difference between a full transfer of ownership and a mere licensing of rights. Since subparagraph (b) only describes the situations in which an Office is obliged to accept requests signed by the licensee or its representative, an Office is free to accept such a request even if the extract mentioned in item (i) is not certified, or if the request is not accompanied by any documents at all. However, with regard to item (ii), the statement of license has to be signed by both the holder and the licensee, or their representatives. A statement of license form is contained in the Regulations.

17.16 *Paragraph (3)*. This provision departs to a certain extent from other provisions in the Treaty that deal with the presentation of a request (such as Article 11(1)(a)), since this provision does not specify the means of transmission, such as paper or telefacsimile, but focuses on the content of the request instead. The effect of paragraph (3) is that the Office of a Contracting Party must accept a request for recordal of a licence where that request (i) contains all the indications or elements specified in the request Form provided for in the Annex, and (ii) presents and arranges these indications or elements in the same way as in that Form.

17.17 *Paragraph (4)*. As regards the amount of fees that an Office may charge for the recordal of a licence, it should be noted that nothing in the text would prevent an Office from charging varying fees depending on the number of registrations to which the request relates.

17.18 *Paragraph (5)* is in line with the approach adopted in Articles 10(1)(d) 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 in accordance with Article 17(1) must be indicated with respect to 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 be filed. Since paragraph (5) 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 (5) are not met.

17.19 *Paragraph (6)*. 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 the applicant furnish any additional document, such as evidence showing the existence of quality control arrangements (as regards quality control, see notes 20.02 and 20.03).

17.20 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 (*items (ii) and (iii)*). It should be noted, however, that paragraph (6) does not prevent the 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.

17.21 *Paragraph (7)*. Article 17 and the model request Form contained in the Regulations are applicable to requests for the recordal of licenses in respect of applications, if the national or regional law of a Contracting Party provides for such recordal. It should be noted that in this context, Rule 8 (*Manner of Identification of an Application Without Its Application Number*) would be applicable.

*Notes on Article 18
(Request for Amendment or Cancellation of a Recordal)*

18.01 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 amendment or cancellation. For this reason, Article 18 provides that Article 17 and the model request Form contained in the Regulations are applicable, *mutatis mutandis*, to requests concerning the amendment or the cancellation of the recordal of a license. 18

*Notes on Article 19
(Effects of the Non-Recordal of a License)*

19.01 *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.

19.02 *Paragraph (2)(a)*. 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 independently of whether the license is recorded.

19.03 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 in his own name infringement proceedings concerning the licensed mark. The latter case is not dealt with by the Treaty. 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)(a), Contracting Parties are free to provide that thenon-recorded licensee has the right to obtain damages only where he has 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.

19.04 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 the provision argued that, under the law of their countries, a license had effect *vis-à-vis* third parties only if it was recorded. Delegations and representatives of observer organizations who expressed their support for the provision emphasized that, 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 persons suffering damages from 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.

19.05 It is worthwhile to note that, if a Contracting Party considers a license legally effective *vis-à-vis* third parties only when it is recorded, such a provision would not necessarily have to be interpreted as meaning that a non-recorded licensee does not have the right to recover damages for the infringement of the licensed mark. Such a provision would nevertheless have an effect in cases 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 in infringement proceedings initiated by the holder, and to recover damages by way of such proceedings.

19.06 *Paragraph (2)(b)*. Subparagraph (b) takes account of relevant laws which expressly prohibit an unrecorded licensee from joining in infringement proceedings initiated by the holder, and from recovering damages. Therefore, although the provision in subparagraph (a) has been retained as a general principle, subparagraph (b) makes it clear that such laws are not affected. However, laws that can be interpreted as allowing an unrecorded licensee to join in infringement proceedings and to recover damages would fall under subparagraph (a) and would, therefore, have to be interpreted in this way.

*Notes on Article 20
(Use of a Mark on Behalf of the Holder)*

20.01 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. Article 20 only deals with situations in which the use by a person other than the holder might accrue to the benefit of the holder. It does not address the question under what circumstances the holder may be held liable for such use.

20.02 It should be noted that it is a generally accepted standard in trademark law that the registration of marks that are not used for a certain period of time makes them liable to be cancelled. For example, Article 19.1 of the TRIPS Agreement allows WTO Member States to cancel the registration of marks that 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 recording of such a contract. In this respect, 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 recognize such use for maintaining the registration of the mark.

20.03 The effect of Article 20 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. To this extent, Article 20 is broader than Article 19.2 of the TRIPS Agreement.

20.04 However, Article 20 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.

20.05 *Article 20* would apply independently of whether or not a license exists or, if a license exists, whether or not the license is recorded. Hence, 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 essence, any use of the mark by any third party to which the holder consents must be considered use by the holder.

*Notes on Article 21
(Indication of the License)*

21.01 *Article 21* 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.

21.02 *Article 21* 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 in whole or in part. The continued 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 a law on labeling or advertising. In particular (and this is the effect of the reference to Article 20 which appears at the end of Article 21), 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 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 rationale 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 a missing or defective indication of the license cannot constitute an argument in favor of the defending party in infringement proceedings, even if such indication is mandatory under the applicable law. The result of Article 21 is that no sanction for non-compliance with a labeling or advertising requirement, even if that requirement concerns the indication of a license, may affect trademark rights.

NOTES ON THE DRAFT REGULATIONS

Notes on Rule 2 (Manner of Indicating Names and Addresses)

R.2.01 *Paragraph(1)(a)*. The words “any Contracting Party may require”, which appear in the introductory phrase of this paragraph indicate that any Contracting Party is free to require fewer indications or elements than those mentioned in this Rule.

R.2.02 It is left to the law of the Contracting Party to decide whether the family name or principal name has to precede or follow the given or secondary name.

R.2.03 *Paragraph(1)(b)*. In order to facilitate the administrative procedure before the Office, the firm or partnership needs to indicate its name only in the manner in which such name is customarily used.

R.2.04 *Paragraph(2)(b)*. This provision does not intend to regulate the question of who has the right to be an applicant. Therefore, as regards applicants, it only applies where the law of a Contracting Party allows application to be filed by several applicants.

R.2.05 *Paragraph(2)(c)*. The indication of a telephone number, of a telefacsimile number or an e-mail address is not mandatory. It is, however, recommended to give such indications so that the Office of a Contracting Party can establish contact through the most efficient means of communication.

Notes on Rule 3 (Details Concerning the Application)

R.3.01 *Paragraph(1)*. A mark which consists of a word, a letter or numeral, or any combination thereof, which is not depicted in a special form will normally be registered and published by the interested Office in the standard characters used by that Office. No Office is obliged to register or publish a mark in the characters used in the application if those characters do not correspond to what are regarded as standard characters by that Office.

R.3.02 *Paragraph(2)*. The number of reproductions which may be required includes the reproduction which is contained in the application. Thus if, under subparagraph (a)(ii), only one reproduction may be required and the application contains the reproduction of the mark, no additional reproduction may be required; if, under subparagraph (a)(i), five reproductions may be required and the application contains the reproduction of the mark, four additional reproductions may be required.

R.3.03 *Subparagraph(a)* deals with the case where the mark does not contain a statement to the effect that color is claimed. In the case where the applicant does not wish the mark to be registered and published in the standard characters used by the Office of the Contracting Party concerned, up to five reproductions (in black and white) may be required (item (i)); otherwise, only one reproduction in black and white may be required (item (ii)).

R3.04 *Subparagraph(b)* deals with the case where the application contains a statement to the effect that the applicant claims colors. A maximum of 10 reproductions (five in color and five in black and white) may be required.

R3.05 *Paragraph(2)* does not deal with the questions of the size and quality of the reproductions. As regards the quality, see Note 3.13, last sentence, under Article 3(1)(a)(xii).

R3.06 *Paragraph(3)(a)*. The words "shall consist" make it clear that the applicant cannot file with the Office as specimen of the three-dimensional mark in lieu of two-dimensional reproductions of that mark. However, any Contracting Party is free to accept that the applicant, in addition to two-dimensional reproductions, also furnish a specimen. Where a Contracting Party allows the transmittal of communication by electronic means, other techniques to satisfy the requirements concerning the reproduction may be available.

R3.07 *Paragraph(3)(b)* enables the applicant to furnish, for the purposes of reproduction of a three-dimensional mark, one single view or several different views of the mark. This provision, however, does not impose any obligation on a Contracting Party as regards the number of views it should publish. A Contracting Party is therefore free to provide that only one view of the three-dimensional mark will be published and, in such a case, it may require that, where the applicant furnishes several different views, he indicate the view which the Office would publish. If the applicant does not give such an indication, the Office may invite him to do so, or select *ex officio* one of the views.

R3.08 *Paragraph(3)(c) and (d)*. These provisions deal with the cases where the Office of a Contracting Party considers that the particulars of a three-dimensional mark are not sufficiently shown by the reproductions furnished.

R3.09 *Paragraph(3)(e)*. This provision makes it clear that as regards color, in the case of three-dimensional marks, the number of reproductions of each view is the same as for two-dimensional marks and that the reference to standard characters does not apply to three-dimensional marks.

R3.10 *Paragraph(6)*. A Contracting Party may subject the obtaining of extensions of the minimum time limit of six months to various conditions, for example, the possible payment of fees or the submission of documents or indications justifying the reason why actual use has not commenced.

*Notes on Rule 4
(Details Concerning Representation)*

R4.01 The time limit of two months for persons residing abroad takes into account the fact that postal transmittal usually takes more time between two countries than inside one country. These time limits of one month and two months start from the date on which, under Article 4(3)(d), a communication is submitted to the Office of a Contracting Party without the required power of attorney. Neither the Treaty nor the Regulations provide that such Office is obliged to send a notification requesting the furnishing of the missing power of attorney.

*Notes on Rule 5
(Details Concerning the Filing Date)*

R5.01 *Paragraph (1)*. The special time limit for applicants residing abroad is considered justified not only because more time is required for postal transmittal from abroad than for transmittal inside the country but also because a local representative should be given enough time to communicate with the applicant residing abroad. Where the applicant has a representative, the invitation referred to in paragraph (1) will be sent to that representative instead of, or in addition to, the applicant.

R5.02. The final sentence of paragraph (1) is intended to make it clear that a failure on the part of the Office to send the required invitation does not exempt the applicant from his obligation to comply with any of the applicable requirements of Article 5 of the Treaty. The reasons for such a failure can be, for example, the impossibility for the Office to contact the applicant or a general strike. In any case, the consequence will be that the application will not be accorded a filing date.

R5.03 *Paragraph (2)*. The expression “shall be treated as if it had not been filed” should be understood as covering also the case where a Contracting Party considers the application withdrawn or abandoned.

R5.04 The last sentence of paragraph (2) does not oblige any Contracting Party to refund the fees paid in connection with the filing of the application.

R5.05 *Paragraphs (4) and (5)*. The Offices of each Contracting Party should, to the extent possible, alert rapidly the sender of an illegible fax or an incomplete electronic filing. This may be done, for example, by way of an automatic “refaxing” system or a reply e-mail.

R5.06 The latter part of these paragraphs is based on the general principle expressed in Article 8(7), for cases where filing by electronic means is admitted. It establishes a time limit within which the original application has to be filed.

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

R6.01 *Paragraph (1)*. This paragraph applies to the signature of any natural person, including the case where a natural person signs on behalf of a legal entity. Item (ii) applies, in particular, where a person signs on behalf of a legal entity.

R6.02 *Paragraph (4)*. This paragraph applies to cases, for example, where communications are filed by telefacsimile resulting in the filing of communications on paper on which the graphic representation of the handwritten signature appears. It also applies to communications filed by telefacsimile transmission to a computer terminal on which the graphic representation of the handwritten signature appears. In accordance with Article 8(7)a Contracting Party may, in all cases, require the filing of the original of the transmitted document on which the original signature appears. In addition, where the Office has reasonable doubt as to the authenticity of a signature, it may request evidence under Article 8(4)(c) (see Note 8.13). A signature could be required for any communication. As

regards the terms “electronic form” and “electronic means of transmittal,” reference is made to the explanation under Article 8(1) (see Note 8.02).

R6.03 *Paragraph (5)*. This paragraph applies to signatures on communications filed in electronic form that are not covered by the provisions under paragraph (4), because the signature does not appear as a graphic representation. A “signature in electronic form” that may be required under this provision may be, for example, a signature in electronic or digital form attached to or logically associated with an electronic record which may be used to identify the signer of the electronic record and indicate the signer’s approval of the information contained in the electronic record.

R6.04 *Paragraph (6)*. A Contracting Party may require that a signature in electronic form be uniquely linked to the signer, be capable of identifying the signer, be created using means that the signer can maintain his sole control and be linked to the information contained in the electronic record in such a manner that any subsequent change of the data is detectable. It could also be a means of self-identification using a personal identification number (PIN) and a password.

Notes on Rule 7
(Details Concerning Indications Under Article 8(5) and (6))

R7.01 *Paragraph (1)(a), item (iii)*. The registration number or other indication referred to in this item may be required for data capture. In the case of electronic communications, it could be a personal identification number (PIN), or a digital certificate containing a registration number.

R7.02 *Paragraph (1)(b), item (iii)*. The explanation on paragraph (1)(a)(iii) above also applies to this item (see Note R7.01).

R7.03 *Paragraph (3)*. This provision obliges a Contracting Party to treat, in the absence of an indication to the contrary, the address of an unrepresented applicant, holder or other interested person as the address for correspondence and the address for legal service under Article 8(6). Paragraph (3) does not prevent a Contracting Party from requiring an unrepresented applicant, holder, or other interested person to indicate an address on its territory if that holder wishes to receive notifications.

R7.04 *Paragraph (4)*. This provision obliges a Contracting Party to treat the address of a representative as the address for correspondence and the address for legal service under Article 8(6). In addition, if that address is not on the territory of the Contracting Party, the Contracting Party may, in accordance with paragraph (2), require that the address provided by the representative be on a territory prescribed by it. Paragraph (4) does not prevent a Contracting Party from requiring a representative to indicate an address on its territory, for purposes of notifications.

R7.05 *Paragraph (5)*. The term “refusal” is intended to also cover sanctions which are of equivalent effect to refusal of the application, such as the application being treated as not filed, abandoned or withdrawn.

*Notes on Rule 9
(Details Concerning Duration and Renewal)*

R.9.01 Rule 9 picks up on the provisions contained in Article 5bis of the Paris Convention, relating to the obligation to grant a period of grace of not less than six months for the payment of fees to maintain an industrial property right, and to the possibility of requiring the payment of a surcharge in such case.

R9.02

Rule 9 is more detailed than Article 5bis of the Paris Convention, since it provides for a grace period not only to pay the prescribed fees for the renewal of the registration of a mark, but also to file the request for renewal before the Office. In this respect, a Contracting Party would be obliged to accept a request for renewal of a registration even if that request is filed after the date on which the renewal is due, namely the date on which the registration expires. The Contracting Party may fix a time limit (grace period) for this, but such limit may not be shorter than six months after the date on which the renewal is due. The question of the status of the registration during the grace period, and the manner in which intervening rights possibly acquired during that period will be recognized, are left to the applicable laws of the Contracting Parties.

R.9.03 Rule 9 also establishes a minimum time period during which the request for renewal may be filed *before* the date on which renewal is due. This aims at ensuring that holders of marks will be able to file their requests for renewal in good time before the expiration of the relevant registrations, thus ensuring a seamless continuation of their registered rights.

R9.04 If the law of a Contracting Party provides that the Office must inform the holder when his registration is due for renewal, the consequences of the failure to inform the holder may be stipulated by the applicable national law.

*Notes on Rule 10
(Details Concerning Relief in Respect of Time Limits Under Article 13bis)*

R10.01 *Paragraphs (1) and (2)*. The request for the extension of a time limit must be filed *prior* to the expiration of that time limit, in contrast to the request for continued processing which may be filed *after* the expiration of that time limit.

R10.02 *Paragraph (3)*. Unlike a request for the extension of a time limit or for continued processing, the request for reinstatement of rights must state the reasons for the failure to comply with that time limit. The Office may require evidence in support of the reasons for the failure. The interpretation of the terms “due care” and “unintentionality” are left to the applicable law and practice in the Contracting Party.

R10.03 *Paragraph (4)*. A Contracting Party may require that all of the requirements be complied with within the time limit referred to in paragraph (4). In other words, the Contracting Party may provide that the requirements be complied with at the same time as the request is filed, or it may allow the applicant, holder or a third party to submit further documents after having filed the request but within a specified time limit.

R10.04 *Paragraph(5)*. This provision lists procedures in respect of which a Contracting Party is not obliged to provide for the extension of a time limit, continued processing or the reinstatement of rights under Article 13bis, although it is free to do so.

R10.05 *Item(i)*. A Contracting Party is not obliged to grant more than one instance of relief under Article 13bis, although it is free to do so. It is similarly not obliged to grant continued processing under Article 13bis(1)(b) after an extension of the time limit concerned has been previously granted under Article 13bis(1)(a). Any second or subsequent instance of relief that is granted is not regulated by Article 13bis(1) or Rule 10, so a Contracting Party would be free to grant shorter extension than, or apply requirements which are additional to, or different from, those under that Article and that Rule.

R10.06 *Item(ii)*. This item is intended to prevent an applicant or holder from obtaining what would be, in effect, double relief in respect of the procedure concerned.

R10.07 *Item(iii)*. Although a Contracting Party is not obliged to provide for the extension of, or continued processing in respect of a time limit fixed for the payment of renewal fees, it is still obliged to provide a period of grace for the payment of such fees under Article 5bis(1) of the Paris Convention, and under Article 13(1)(c) and Rule 9 of the Treaty.

R10.08 *Item(v)*. As regards trademarks, opposition proceedings may include *inter partes* correspondence which under certain circumstances, might require a succession of reliefs. In this connection it is noted that the Patent Law Treaty (PLT) Diplomatic Conference understood that, while it was appropriate to exclude actions in relation to *inter partes* proceedings from the relief provided by the PLT, it was desirable that the applicable law of Contracting Parties provide appropriate relief in those circumstances which take into account the competing interests of third parties, as well as those interests of others who are not parties to the proceedings (Agreed Statement No. 5).

R10.09 *Items(vi) and (vii)*. It is in the interests of the third parties that the priority claim not be the subject of relief or reinstatement of rights. However, a Contracting Party may permit otherwise in the applicable national legislation.

[End of Annex and of document]