

WIPO



SCT/16/9

ORIGINAL: English

DATE: May 25, 2007

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Sixteenth Session
Geneva, November 13 to 17, 2006

REPORT*

adopted by the Standing Committee

* This report was adopted at the seventeenth session of the SCT

INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”) held its sixteenth session, in Geneva, from November 13 to 17, 2006.
2. The following Member States of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Algeria, Argentina, Armenia, Australia, Austria, Bangladesh, Barbados, Belarus, Belgium, Benin, Bosnia and Herzegovina, Brazil, Bulgaria, Cambodia, Canada, Chile, China, Colombia, Congo, Costa Rica, Croatia, Czech Republic, Denmark, Ecuador, Egypt, El Salvador, Estonia, Ethiopia, Finland, France, Gabon, Germany, Greece, Guatemala, Haiti, Hungary, Indonesia, Iran (Islamic Republic of), Iraq, Ireland, Israel, Italy, Jamaica, Japan, Jordan, Kenya, Kuwait, Latvia, Libyan Arab Jamahiriya, Lithuania, Madagascar, Malaysia, Mali, Mexico, Moldova, Morocco, Myanmar, Nepal, Netherlands, Norway, Paraguay, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sudan, Sweden, Switzerland, Syrian Arab Republic, Thailand, The former Yugoslav Republic of Macedonia, Tunisia, Turkey, Uganda, Ukraine, United Kingdom, United States of America, Venezuela and Zimbabwe (88). The European Community was also represented in its capacity as member of the SCT.
3. The following intergovernmental organizations took part in the meeting in an observer capacity: African Intellectual Property Organization (OAPI), Benelux Organization for Intellectual Property (BOIP), World Health Organization (WHO) and the World Trade Organization (WTO) (4).
4. Representatives of the following international non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Centre for International Industrial Property Studies (CEIPI), China Trademark Association (CTA), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), International Wine Law Association (AIDV), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA) and MARQUES (Association of European Trademark Owners) (14).
5. The list of participants is contained in Annex II of this Report.
6. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions on the basis of all observations made.

Agenda Item 1: Opening of the Session

7. Mr. Ernesto Rubio, Assistant Director General, opened the session and welcomed the participants on behalf of the Director General of WIPO.
8. Mr. Marcus Höpperger (WIPO) acted as Secretary to the Standing Committee.

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

9. The Delegation of Switzerland, on behalf of Group B proposed as Chair of the SCT, Mr. Michael Arblaster (Deputy Registrar, Trade Marks and Designs, Hearings and Legislation, IP Australia, Woden ACT, Australia).
10. The Delegation of Australia proposed as Vice-Chairs of the SCT Mr. Maximiliano Santa Cruz (Counselor, Permanent Mission of Chile to the WTO, Geneva) and Mrs. Karima Farah (Head, Trademarks Service, Commercial Names and Trademarks Department, Moroccan Industrial and Commercial Property Office (OMPIC), Casablanca, Morocco).
11. The Delegations of El Salvador and Kenya supported the proposals made by the Delegations of Australia and Switzerland.
12. Mr. Michael Arblaster (Australia) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT). Mr. Maximiliano Santa Cruz (Chile) and Mrs. Karima Farah (Morocco) were elected as Vice-Chairs.

Agenda Item 3: Adoption of the Agenda

13. The SCT adopted the Draft Agenda (document SCT/16/1 Prov.2) without modifications.

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

14. The SCT adopted the Revised Draft Report of the fifteenth session (document SCT/15/5 Prov.2) without modifications.

Agenda Item 5: Trademarks

Questionnaire on Trademark Law and Practice

15. The Secretariat recalled that the Questionnaire on Trademark Law and Practice had been on the Agenda of the SCT for the last four sessions. Replies to the Questionnaire had been compiled into a summary document, which was first made available to the SCT as document SCT/13/5 and subsequently re-issued as revised versions taking into account comments from Member States. At the fifteenth session of the SCT in November 2005, the Committee had agreed that that document be kept available for all interested parties and be

updated periodically on the basis of submissions from Members of the SCT. Since the fifteenth session of the Committee, the Secretariat had received two requests for updating, and a revised document had been issued (document WIPO/STrad/INF/1). The document was available for consultation on the Webpage of the SCT Electronic Forum. The Secretariat would continue to update that document on the basis of new communications from Members.

16. The Chair invited the Members of the SCT to verify the information contained in document WIPO/STrad/INF/1, in respect of their jurisdictions and to provide any comments to the Secretariat. The Chair also invited delegations to look for issues which might arise from the document, with a view to the future work of the Standing Committee.

17. The Chair concluded that document WIPO/STrad/INF/1 would be updated periodically on the basis of information provided by SCT Members.

New Types of Marks

18. The discussion was based on document SCT/16/2.

19. The Chair noted that the document contained both an overview of the situation in various jurisdictions and an analysis of some of the horizontal issues that cut across this topic in general. The issue of new types of marks was likely to remain a topic of interest for trademark offices, as they seemed to be under pressure from two directions. Firstly from manufacturers, who wish to publicize their products and identify their brands and secondly from consumers, who would like to prevent free-riding or deceptive confusion. Although new types of marks were not the dominant signs applied for registration, they seemed to be important for those brand owners who used them nationally and wished to use them across markets. Therefore, it appeared that the Committee could work on developing common approaches for dealing with these new types of marks.

20. The Secretariat said that the new types of marks considered in document SCT/16/2 were grouped in two main categories, namely visible and non-visible signs. The listing was however not intended to be exhaustive. The section on cross-cutting issues included items that applied to all types of marks alike and that appeared to deserve some form of consideration. The annexes to the document contained a number of examples of these new types of marks which had been provided by Members of the SCT on an *ad hoc* basis.

21. The Delegation of Switzerland recalled that at the fifteenth session of the SCT it had proposed that the Committee discuss new types of marks and, in particular, color, shape and olfactory marks. The Delegation noted that discussions which took place during the Diplomatic Conference for the adoption of the Singapore Treaty on the Law of Trademarks, as well as document SCT/16/2, had allowed it to have a better understanding of the issue and in particular, to understand the specific national practices with regard to the registration of new types of marks. In that context, the Delegation believed that two issues could be considered by the SCT, firstly, the harmonization of criteria for the registration of these marks, and whether an office that accepts for registration new types of marks could apply to them by analogy the same criteria it applied to traditional marks. Secondly, the harmonization of modalities for registration, in particular what would be considered an appropriate representation of the sign. The Delegation considered that a discussion on new types of marks was timely and would help identify new developments in commercial

practices, which would bring about the development of new signs. The Delegation said that it was most interested in listening to other members of the Committee and learning about their experience in this field.

22. The Delegation of Slovenia thanked the International Bureau of WIPO for the high quality of the document on new types of marks, which had allowed it to get a better insight into the problems and questions that arose in this connection. The Trademark Office of Slovenia had limited experience with the new types of marks mentioned in the paper, except for three-dimensional marks and color *per se* marks. The Delegation mentioned that three-dimensional marks were rather numerous and should perhaps no longer be included in the category of new marks. However, a number of problems derived from the overlapping protection with design, and examiners in Slovenia had great dilemmas between the innovation that is required for the protection of design and distinctiveness, which is a specific requirement for trademark protection. It seemed difficult to establish a boundary between these two types of protection. With regard to color marks, the main question was whether the color should be delimited by a shape, such as a square, in which case one could use the Vienna Classification, but this would not help in the case of color *per se*. The Delegation believed that the Standing Committee should deal with these matters under Section III(c) of document SCT/16/2, namely the application of trademark principles, in order to clarify what kind of representation should be provided to the office. Harmonization in this area would be very beneficial to users.

23. The Delegation of Singapore thanked the International Bureau of WIPO for the very comprehensive documents prepared for the current session of the SCT. In the area of new types of marks, the Delegation shared the notion that these marks were not dominant in the Register. However, they posed certain difficulties in terms of interpretation and application of trademark principles. It should be clarified whether the Office should apply the same criteria of distinctiveness than for more traditional marks and what the criteria would be for graphical representation, particularly of non-visible signs. For example, in the case of olfactory marks, whether the Office could accept a chemical formula and/or other means of representation. As for color *per se* marks, would the plain reproduction of that color suffice or would the color code need to be provided, or should the Office require that the colors as applied in the packaging or as applied to the goods be detailed in the application form. The Delegation concluded that the Committee could explore various guidelines concerning graphical representation of these new types of signs.

24. The Delegation of Ecuador wished to join previous speakers in thanking the International Bureau of WIPO for the high quality of the documents prepared for the current session. With regard to document SCT/16/2, the Delegation wished to note that a texture mark had already been registered with its office.

25. The Delegation of Brazil said that national legislation in Brazil excluded the registration of non-visible signs, as probably also did the legislation of many other members. Therefore, the issue of new types of marks required an in-depth analysis, as there could be an implication that several members would eventually have to change their legislation to cover these marks. The Delegation believed that there could be a surcharge of additional demands placed on Patent and Trademark Offices, particularly in developing countries, because the examination of these marks required additional expertise from the examiners or specific and sophisticated technologies. The Delegation recalled that in the context of the proposals for a Development Agenda for WIPO, several members of the Organization had stressed the need to establish

benchmarks or impact assessment studies prior to engaging in the discussion of additional levels of protection, new treaties or even amendments to existing treaties. As to document SCT/16/2, the Delegation considered it a very important starting point to discuss the issues pertaining to new types of marks. However, the document could be expanded to cover the following aspects: (a) the potential economic relevance of these marks for less developed markets; (b) the possibility of overlapping protection, for example with copyright, in the case of motion marks, and (c) the need to consider the exhaustion of rights and limitations and exceptions to protection, for example in the case of color, which may be viewed as a public good over which there should not be, at least in principle, any proprietary rights. The Delegation noted that colors could be used for artistic or educational purposes and could be culturally relevant in many countries. The Delegation suggested that the Secretariat produce a more comprehensive version of document SCT/16/2, by elaborating on these issues.

26. The Chair clarified that the objective of the discussion on new types of marks was not to require at any point in the future the introduction of protection for this or any other type of mark in jurisdictions that currently did not provide for it. The essence of the discussion was to find common approaches for dealing with new types of marks in those markets where they are present and probably to avoid the use of sophisticated technologies for the examination of those signs.

27. The Delegation of Norway declared that the Trademarks Act of Norway required the graphical representation of signs that were applied for registration as trademarks. With regard to non-visible signs, and in particular sound marks, the Delegation mentioned that the Trademark Office of Norway had 21 sound mark applications and all of them were accompanied with musical notes for publication. The Office required a description of the sound in words to be published together with the musical notes. It was considered that the public would more easily understand the description in words stating for example the notes, the instruments used, the volume, the beat and the length of the sound, than the notes alone. The Office also required that the applicant submit the sound on an MP3 file to be published electronically on the office website, that had a sound icon through which the sound was available. The Trademark Office of Norway had received only one application for a moving image mark, which was under examination and it had received no scent mark applications. The Delegation joined previous speakers in welcoming a discussion on the harmonization of requirements for the graphical representation of new types of signs.

28. The Delegation of the United States of America said that it had relied on the document prepared by the International Bureau to elaborate on the practice of the United States Patent and Trademark Office (USPTO) with regard to new types of marks. The Delegation declared that the USPTO had received applications for non-traditional marks over the years and had developed specific examination practices to deal with them in an *ad hoc* manner. For that reason, the Delegation considered that a discussion on this matter was useful in order to share experiences, learn from others and develop a better conceptual framework for approaching new types of signs. The USPTO had recently received the first taste mark application and a few texture marks could be found in the register. Although non-traditional marks did not comprise a large segment of the register, it was expected that pressure from the private sector would increase to register these signs in the future. The Office had found, however, that no new technology was needed to examine these marks, but a combination of practical examination techniques, basic trademark analysis and some policy discussion to set the boundaries between different intellectual property rights. The critical question to be answered

was whether the sign functioned as an indication of source of the goods or services and whether consumers perceived it as a mark. The United States Trademark Act encompassed non-traditional marks as eligible subject matter by not excluding them from the definition. Also, the Supreme Court of that country had ruled in the mid-1990's that "it is the source-distinguishing ability of a mark not its ontological status as a color, shape, fragrance, word or sign that permits it to serve basic purposes of a trademark". Two main aspects were considered to determine whether the sign was capable of distinguishing: (a) whether the sign served as a mark and (b) whether it was functional for the goods and services applied for. The first aspect was particularly relevant for the examination of non-traditional signs because they might not be used or perceived as source identifiers. Factors to determine whether these signs could be registered, included: the commercial impression of the mark, the relevant practices in the trade, for example, to see whether the sign is unique in the particular field or is only a refinement of a common feature and whether there are any secondary uses of the sign. In addition, for matter that did not inherently function as a mark because of its nature, evidence of acquired distinctiveness would be required. As to the second test of functionality, even if a sign was used and could possibly serve as a mark, it might not be capable of distinguishing as a public policy matter, if it was essential to the use or purpose of the product or if it affected its cost or quality. The functionality doctrine in the United States of America was intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. This doctrine ensured that the protection for utilitarian product features was properly sought by a limited duration utility patent and not through the potentially unlimited protection of a trademark registration. With regard to the representation of these marks, the Delegation noted that there had been some discussion in the WIPO Standing Committee on Information Technologies (SCIT). However, it was interested in working on this matter in the SCT. The Delegation declared that in the United States of America, the main purpose of the drawing was to provide notice of the nature of the mark sought to be registered. Consequently, in the case of a mark that consisted only of a sound, a scent or some other completely non-visual subject matter, the applicant had to submit a detailed written description that clearly explained the mark. No drawing was required in that case. As to the representation of color, the USPTO did not require the indication of a PANTONE® code or other similar color code, because these were proprietary systems. However, such indications would be acceptable if the applicant wished to include them in the record. The Office accepted specimens of use to be included in the search databases, so that notice of the mark was provided. The Delegation concluded that the representation of new types of marks was not a big challenge for the Office as long as a description could be provided.

29. The Delegation of Chile, recalling the intervention by the Delegation of Brazil, said that the subject was rather complex and required caution. Important issues of public interest were involved and they demanded that any requests for harmonization of procedures for the registration of new types of signs be given careful consideration. Although harmonization seemed to deal only with formalities, the distinction between those and more substantive matters was very subtle. For example, regarding the question of color. There were reasons of public interest to prevent the registration of color *per se* marks because the number of colors available was limited. According to one of the international color codes, the number of existing colors was 1,800. Some delegations had also expressed that they did not advise the use of these systems because they were proprietary. The Delegation indicated that amongst the conditions of use of those systems, it was stated that the colors contained in the system were protected under Copyright. Document SCT/16/2 dealt with the question of shades of color. However, in the view of the Delegation, it was very difficult for the general public to recognize different shades of the same color. Thus, it would be relatively easy to infringe a

color *per se* mark. There were also well-known color marks for which protection was extended beyond the class or classes of products and services covered by the registration. The Delegation noted that there were problems with overlapping protection on the same object, for example three-dimensional marks and color marks were also protected under Copyright. In document SCT/16/2 the International Bureau had mentioned certain aspects of overlapping protection. However, it had not specified that there were real problems with the distinctiveness or the functionality of these signs. The Delegation did not believe that distinctiveness acquired through use was enough to justify protection, because certain objects, like INNs, should not be liable for protection as marks. In the opinion of the Delegation, the issue of overlapping protection was far too limited in the document prepared by the Secretariat and this point should be further developed by bringing aspects of competition law, instead of creating new standards of protection.

30. The Delegation of El Salvador indicated that the Trademark Law of El Salvador had been recently amended to cover new types of marks. The Delegation announced that it would forward this information to the Secretariat for its inclusion in document WIPO/Strad/INF/1. The Trademark Office of El Salvador was also working on certification marks and appellations of origin. Protection for sound marks was provided under national law, and although no applications had been received, it was foreseen to require as representation of the mark the notes on a stave and a recording of the sound. Combinations of color were protected, but not color *per se* on the grounds that the number of colors available was limited. Holograms were also protectable. The Delegation noted that one interesting aspect of the new law was the possibility to request the cancellation of a mark for lack of use. In this case, there was a reference to the law regulating uniform procedures, whereby users were entitled to request the revocation, opposition or cancellation of a registration.

31. The Delegation of Australia joined other delegations in thanking the International Bureau of WIPO for the preparation of the document on new types of marks. Since 1995, following the adoption of new legislation in Australia, it was possible to register a wider range of signs as trademarks, and since then over 2,300 such applications had been received. They amounted to about 1% of total applications, but in spite of the small numbers, users often requested the Office to provide guidance. The national Trademark Act clearly set out the requirements for new kinds of signs in the Regulations. The legislation required that a trademark be represented graphically. The representations had to demonstrate the nature of the mark and show each feature clearly enough to permit proper examination, in particular, where the trademark contained or consisted of a sign that was a color, scent, shape, sound or an aspect of packaging or any combination of those features. The application or registration should include a concise and accurate description of the trademark and that description was entered as an endorsement on the registration. It was clear from the Regulations that new kinds of signs needed both pictorial representations of the trademark –where possible– and a clear description before the scope of the application could be properly defined and effective examination could take place. Sound marks had to be provided to the Office in an audible form. A breakdown of the statistics for these marks was: 1,500 applications for shape marks, over 700 applications for color, 53 applications for sound and 7 for scent marks. The Delegation noted that in Australia there was a much higher rate of lapsing relating to new kinds of signs. In fact, around 51% had lapsed and this was dramatically different to the normal rate, which was less than 20%. The Delegation further noted that the Trademark Office in Australia had learned a great deal about the examination of new kinds of signs over the last 10 years and it had been able to provide improved advice to users of the system about what would be acceptable. However, the area where consensus was lacking was whether

certain signs could be protectable in other jurisdictions. Therefore, the Delegation strongly supported the analysis of commonalities in relation to new types of signs, with a particular focus on descriptions and endorsements. It also welcomed the development of guidelines or best practices in this area.

32. The Representative of the European Community said that he would support discussions on new types of marks, with a priority on the harmonization of formalities for the registration of these marks, to achieve common approaches in that field amongst members of the SCT. The Representative believed that this was a key interest for trademark owners, who would wish to see a majority of States applying the same or similar criteria for the formality assessment of these signs. As to the question of distinctiveness, namely how far these signs may be seen as functioning like sources of origin of the goods or services, the Representative believed that although this question was interesting, it depended to a large extent on the individual market situation and consumer perception. The Representative noted that one particular aspect of the formalities assessment of new types of marks was the requirement of graphic representation, which was developed in document SCT/16/2. The document made reference to a judgement from the European Court of Justice in the Sieckmann Case, where the Court established criteria for the proper representation of an olfactory mark. The Court ruled that the representation of a mark had to be clear, precise, self-contained, easily accessible, durable and objective. The Representative believed that these were very useful principles in assessing the adequacy of a graphic representation and suggested that the Standing Committee include them in its discussion on this topic.

33. The Delegation of Denmark considered that document SCT/16/2 was a very important and interesting starting point on the issue of new types of marks. According to the legal system applied in Denmark, there was a requirement for the graphical representation of trademarks. The national trademark office had thus far registered sound and moving image marks. The Delegation expressed support for the comments made by the Delegation of the United States of America on the point that whether or not a sign applied for registration constituted a mark, depended on whether consumers saw it as a source identifier. This perception was likely to change over time. The Delegation noted that there was currently a tendency towards the development of brands rather than just relying on trademark protection. This tendency would place new types of marks higher on the agenda. In conclusion, the Delegation welcomed further discussions of this issue in future meetings of the SCT.

34. The Delegation of Madagascar thanked the International Bureau for elaborating document SCT/16/2, which it found very useful and complete. The Delegation wished to support comments made by the Delegation of Slovenia regarding the question of overlapping protection between three-dimensional marks and industrial design. The Delegation hoped that discussions in the SCT would help cast some light on this question. The Delegation declared that, for the time being, its Office had not received applications for taste, sound or olfactory marks.

35. The Delegation of Italy expressed satisfaction with the text prepared by the International Bureau. The Delegation said that currently, non-traditional marks, namely sound, olfactory and taste, or any other type of mark could be filed with the Trademark Office of Italy. However, if the requirement of graphical reproduction was not fulfilled for any such signs, the application would be declared non-receivable. The Delegation noted that its position was the same as that reflected in the report of the previous session.

36. The Delegation of Japan expressed its appreciation to the International Bureau for the remarkable document prepared on this issue. The Delegation declared that even though authorities in Japan had had a thorough discussion on new types of marks, namely sound and olfactory marks, it was not clearly determined whether the protection of such marks was urgently required by users in that country. Nevertheless, the Delegation considered that it would be fruitful to discuss and clarify issues concerning new types of signs in the light of harmonization. The Delegation noted, however, that with regard to some of these marks, it was difficult or almost impossible to clearly specify the scope of the trademark rights, and that could lead to difficulties in the examination process and in the enforcement of the corresponding trademark rights. Therefore, the Delegation considered that it was important to develop guidelines concerning all these aspects of the new types of marks.

37. The Delegation of the Russian Federation pointed out that national legislation in the Russian Federation did not contain limitations as to the types of signs which may be applied for registration as trademarks. The corresponding regulations specified the requirements that had to be fulfilled for the registration of all types of marks, including non-traditional signs. However, the regulations specified detailed requirements that had to be fulfilled for the registration of certain new types of marks such as sound and three-dimensional marks, and did not specify those for the registration of other non-traditional marks. This constituted a problem for both applicants and examiners who received those applications. For the trademark office, the main practical problem was how to publish these marks. Publication could be achieved where the application contained a detailed description showing the main elements of these marks. The Delegation believed that it would be useful for the Standing Committee to work on the elaboration of common approaches for the classification, the representation and description of these new signs. In the view of the Delegation the same basic requirements of the law should be applied to both traditional and non-traditional trademarks. Examiners should also consider absolute grounds for refusal, conflicts with prior rights, overlap with other types of intellectual property rights and exclusions and limitations to protection. As other delegations had also mentioned, one key element was to determine whether the sign applied for could function as a trademark and be perceived as such by consumers. The Delegation concluded that document SCT/16/2 was useful for the Standing Committee to formulate common approaches in this area.

38. The Delegation of the Republic of Korea said that there were a lot of interesting but difficult issues around non-traditional marks. With regard to three-dimensional marks in particular, the Delegation wished to raise a question and seek some useful experience from other SCT members. The Delegation noted that there were two types of three-dimensional marks, one which had distinctive three-dimensional shape or configuration, and another which, not having such a distinctive three-dimensional shape, had other distinctive elements, such as letters or figures displayed on the shape. The Delegation wondered whether or not this second type of mark should be accepted for registration as a three-dimensional mark and what would be the rationale for an Office to accept such registration. The Delegation also wondered whether in any jurisdiction this type of three-dimensional mark would be refused and asked for any useful insight from other delegations.

39. The Representative of INTA declared that generally, the position of that organization was that any sign which could function as a trademark should, in appropriate circumstances, be entitled to trademark recognition, protection and registration. In this connection, the Board of Directors of INTA had adopted in November 2006 a resolution supporting the recognition and registration of “touch” marks. Therefore, INTA followed with great interest the

consideration of this item by the Standing Committee. The Representative mentioned that the Board of Directors of INTA had also adopted a resolution welcoming the further harmonization of trademark administrative procedures brought about by the Singapore Treaty and supporting adherence to that Treaty.

40. The Chair invited delegations to share any experience they may have or provide any comments regarding the questions raised by the Delegation of the Republic of Korea.

41. The Delegation of Mexico said that national legislation allowed the registration of three-dimensional marks which were accompanied by other symbols, such as denominations and designs. These were known as mixed or complex marks.

42. The Delegation of Argentina said that the Trademark Office in Argentina took a rather liberal approach in accepting for registration marks that consisted of either visible or non-visible signs. The interpretation was that as long as their registration was not expressly prohibited under the law, it was allowed. Since there were no specific prohibitions on new types of signs, they were accepted for registration. The Delegation also noted that this practice had been well received by the professional and academic sectors in Argentina. National trademark law dated back to some years and discussions were currently engaged to amend it. One of the points considered in the amendment was how to fight the infringement of trademark rights and integrate questions of unfair competition.

43. The Delegation of Bulgaria, referring to the issues raised by the Delegation of the Republic Korea, said that in Bulgaria, there were special regulations for three-dimensional marks. The most important point for the Office was to determine whether the sign applied for was distinctive *per se*. In that case, the rules applied were identical for any other type of mark. Where the sign was not in itself distinctive but it was accompanied by other signs, a disclaimer was made of the shape and therefore the shape was not protected. However, the office in Bulgaria did accept these signs for registration because it considered that the shape accompanied by other signs could be distinctive as a whole. The Delegation considered that this practice was close to the concept described in document SCT/16/2 in relation to position marks.

44. The Delegation of Portugal said that its position with regard to three-dimensional marks was very similar to the position explained by the Delegation of Bulgaria. In Portugal, three-dimensional marks that were accompanied by verbal compositions were protected if they were found to be distinctive. Three-dimensional signs could also be protected, even if they were not distinctive, when they were accompanied by other elements. In the view of the Delegation, the substantive question was to determine whether signs which had no distinctivity *per se* could be protected as three-dimensional marks.

45. The Delegation of Turkey said that according to national legislation in Turkey, three main requirements had to be fulfilled for the registration of any type of trademark. The sign had to be distinctive, non-descriptive and capable of being represented graphically. In application of this rule, three-dimensional marks, color marks, holograms, slogans, titles of films and books, names of books, motion and multimedia signs were all registrable if they fulfilled the criteria. The situation was not the same for the non-visible signs, namely sound marks, olfactory marks, taste and texture marks. The main question on these types of signs was whether they were distinctive, in other words, whether they could serve to identify the goods or services of one undertaking and distinguish them from those of others and whether

they could be represented graphically. The Delegation noted that, having heard previous speakers, it seemed that the questions around these types of signs were generally similar and the problems were common. In conclusion, the Delegation believed that an assessment of formalities with a view to achieving a common approach for harmonizing the representation of non-visible signs, in particular, was very important.

46. The Delegation of Finland noted that the Trademark Office in Finland had faced some difficulty in assessing color marks in relation to services. The Delegation noted that a mere color could not be presumed to constitute a sign and very often the applicant was required to provide an indication as to how the person or company had used the color, so that the color acquired distinctiveness through use. It seemed difficult for a company to provide proof of use of a color in the course of its trade, where the trade was a service. The Delegation illustrated this difficulty with the following example. A real estate agency in Finland was known for the fact that its employees drove cars painted in a particular color. The company applied to register that color as a trademark and the Trademark Office assessed the application on the basis of use of the color. However, there seemed to be a difficulty in establishing a link between the real state services provided by the company and the automobiles used by its employees. The company had used that same color in various other aspects, thus the issue was not entirely clear. The Delegation wondered what the situation would be if the color were finally registered as a trademark, namely, the scope of protection and the types of uses of the same color by other parties that could be prevented. Although these would be issues to be dealt with by the Courts, the Delegation wished to hear the views and experiences of other members of the SCT.

47. The Delegation of the United States of America said that the difficulty with color for service marks seemed to be whether the mark had acquired distinctiveness. When dealing with color marks for services, the USPTO focussed on being able to determine whether the applicant could prove that consumers recognized the color as a service mark. To prove this, the applicant would submit consumer surveys or affidavits from consumers who would explain how they perceived the color sign as a trademark. The Office would also look at advertising that promoted the mark, for example: “UPS, look for the brown truck!” or any other examples where the company was specifically promoting their color as a service mark.

48. The Delegation of the United Kingdom said that its trademark office had acquired experience with new types of marks since 1994, when the new Trademark Act was introduced. This legislation allowed the registration of any sign that was capable of being represented graphically and lifted any restrictions on protectable subject matter. The Delegation noted that the main problem with all the new types of signs was whether or not they could be represented graphically and from the practice of the United Kingdom Trademark Office it could be seen that some types of trademarks were easier to represent than others. A second question that had been asked was whether new types of marks should be treated in a different manner or had different hurdles to overcome in order to be registered. The answer to that question had been negative, following decisions of national courts and of the European Court of Justice. Regarding distinctiveness, the criteria was exactly the same as for all types of marks, namely whether the sign was seen as a trademark or as a badge of origin. With regard to the representation of color marks, the Delegation mentioned that the United Kingdom Trademark Office had changed its practice and currently required the indication of an international color classification code for a color mark application. It appeared from document SCT/16/2 that this Office was the only registry that would accept a color mark without a representation of the actual color. Thus, for example in the United

Kingdom, a formulation such as “the mark consists of the color orange PANTONE[®] reference #...” would be acceptable as a proper graphical representation of a color mark. This was based essentially on two European Court of Justice decisions, namely *Sieckmann* and *Libertel*, which set out the requirements for graphical representation of scent and color marks, respectively. In this connection, the Delegation believed that it would be extremely useful to develop agreed standards for the representation of color marks, because the fact that different countries accepted different signs for registration could create problems if such marks were used for Madrid Protocol applications. In relation to the issue raised by the Delegation of Finland, the Delegation said that the United Kingdom practice on color marks for services was exactly the same as that described by the Delegation of the United States of America.

49. The Delegation of Italy wished to support the positions expressed by previous speakers. In Italy, a sign was registered as a trademark if it was represented graphically and was capable of distinguishing the goods and services of a particular person or undertaking in the market place. Therefore, in Italy even one color alone could be registered as a mark. Indeed, the determining factor as to whether a sign was registrable was distinctiveness and not the total number of colors. However, color could also be descriptive, for example the colors red or white for wine would be refused, as these were the normal colors of wine. On the other hand, a special shade of brown applied for delivery services had been registered in Italy and was even considered a strong mark. In that case, the color was not descriptive of the services it applied to.

50. The Delegation of Finland thanked all delegations which had shared their experiences in relation to color marks applied to services. The Delegation noted that its position was similar to that expressed by the Delegations of the United Kingdom and the United States of America. The Trademark Office of Finland had, like other offices, registered the color mark brown for delivery services. However, the Delegation believed that there was a small difference between the latter case and the situation described in relation to the mark applied for in Finland for real estate services. In the case of transportation or parcel services, the use of automobiles was essential but it was not so for real state services, even where the real state agents would use cars painted in a specific color. The Delegation concluded that perhaps the difficulty continued to be how particular signs would pass the hurdle of sufficient distinctiveness.

51. The Chair noted that another issue raised by the Delegation of Finland was that of the scope of protection of color marks and the nature of the rights that could be enforced. The Chair asked Delegations to share their experiences or case law on this matter.

52. The Delegation of Italy said that in Italy, the Supreme Court of Appeals had issued a ruling on the scope of protection of one single color mark. The Delegation would forward the text of that decision to the International Bureau.

53. The Delegation of Germany said that in Germany there was no case law on this subject, but the Delegation could provide some elements of its Office practice. In determining the scope of rights of a color mark, and whether use of the color by another party constituted infringement of the mark, it was essential to determine the extent of such use. For example, if all the staff of a competitor firm wears a T-shirt in the same color as that registered, there would be an infringement. However, this would not be the case if only one staff member happened to wear a T-shirt which was, by chance, of the same color or nearly the same color as the mark. The key point was whether the color was used as an identifier of the business.

In relation to the point made by the Delegation of Finland as to what type of use of the color the applicant needed to prove, the Delegation said that in Germany, it would be enough that the applicant firm had used the color in its means of transportation, the clothes of its employees or even its printed documents. The rationale was that services did not have color and therefore, color had to relate to them in some way. The Delegation noted that, as mentioned by the Delegation of the United States of America, a survey would be required to prove that the public related a specific color to a firm. In nearly all cases, color was not distinctive *per se* but became distinctive through use.

54. The Delegation of the United States of America noted that an applicant who wished to register color as a trademark with the USPTO, had to show acquired distinctiveness, because color *per se* was not inherently distinctive. In the case of the UPS registration of the color brown for delivery services, the applicant had actually evolved from a situation of refusal of the application to one where he managed to provide evidence that the color brown was associated with delivery services. This was done so through a marketing approach where the company actually used the word “brown” in its advertisements, and slowly developed the idea in the minds of the consumers that brown was associated with delivery services.

55. The Chair invited Delegations to share their experiences on three-dimensional marks.

56. The Delegation of the United Kingdom said that its Trademark Office accepted three-dimensional marks since 1994, the date of application of the new Trademarks Act. The primary consideration with these marks was the perception of the average consumer when looking at them. Often, a three-dimensional mark would not be perceived by a consumer on first encounter as being a trademark because of its non-conventional aspect. The consumers were not used to seeing a bottle, for example, as an indication of trade origin. However, according to the Delegation, certain three-dimensional marks stood out as indicators of origin. The Delegation mentioned as an example the Jean-Paul Gauthier perfume bottle, which consisted of the bust of a woman or the bust of a man. This shape was clearly registrable as a trademark without a use requirement. The Delegation indicated that the more standardized the bottle was, the more likely it was to be refused as a three-dimensional mark. The Delegation added that the practice of its Office was based on the ruling by the European Court of Justice in the case of *Philips v. Remington*, in which the question of functionality was also mentioned. With three-dimensional marks, it was important to determine whether or not the shape was a functional requirement of the goods. The Delegation declared that amongst the new types of marks, three-dimensional mark applications were the most numerous that the Office had received.

57. The Chair then asked whether the United Kingdom Office had any experience of two-dimensional mark registrations before 1994, which were then replaced with three-dimensional mark registrations after the passage of the new legislation.

58. The Delegation of the United Kingdom replied that the Trademark Office had received some of these cases and mentioned the Coca-Cola bottle as example of a sign which was registered as a two-dimensional mark under the previous Trademark Act and was reapplied under the new act to as a three-dimensional mark. The Delegation noted, however, that under the new Act, an application for a two-dimensional mark that was represented by a picture which was in fact the two-dimensional representation of a three-dimensional mark, would be considered by the Office as a three-dimensional mark.

59. The Delegation of the United States of America referred to national jurisprudence on three-dimensional marks and how they related to “trade dress”. Product design was distinguished from product packaging, both of which were protected under the United States Trademark Act. If the trade dress fell within the category of product design, the Supreme Court had ruled that it could never be inherently distinctive and therefore the applicant had to show acquired distinctiveness. It was difficult sometimes to figure out if the matter applied for was a product design or if it was the product packaging. In such cases, caution was recommended and the Office would consider ambiguous trade dress as product design and it would require secondary meaning. Product design almost invariably served purposes other than source identification and consumers were aware that even the most unusual product design was intended not to identify the source but to render the product itself more useful or appealing. Unlike product design, trade dress (product packaging) could be inherently distinctive and be registrable if it did identify source to the consumers. USPTO examiners used four different factors to determine whether product packaging would be registrable: (a) whether the design was a common basic shape, (b) whether it was unique or unusual in the field in which it was used, (c) whether it was a mere refinement of a commonly adopted and well known form of ornamentation for a particular class of goods perhaps viewed as ornamentation, and (d) whether the design was capable of creating a commercial impression distinct from any accompanying words. Functionality was a separate question to be addressed. The main point was to determine whether the feature was essential to the use or purpose of a product or if it affected the cost or quality. If this was the case, the trade dress was functional. Thus USPTO examiners checked if there was a utility patent that disclosed the utilitarian advantages of the design sought to be registered, or whether in the advertising the applicant talked about the utilitarian advantages of the design. Examiners asked for facts pertaining to the availability of alternative designs and also checked if there were any facts pertaining to whether the design resulted from a comparatively simple or inexpensive method of manufacture. When the Office believed that a proposed mark might be functional in the first office action, the examining attorney asked the applicant to provide all of this information to determine registrability and also asked if the design was the subject of a utility patent or a pending or abandoned patent application. In addition, the Office also asked for advertising or promotional materials. A design patent in the United States of America was a factor that weighed against a finding of functionality because a design patent, by definition, protected only ornamental and non-functional features. However, ownership of a design patent itself did not necessarily establish that a product feature was non-functional and could be outweighed by other evidence supporting a functionality determination. The Delegation concluded that, by considering the questions of whether a design served as a mark and whether or not it was functional, a balance was struck between the needs of owners and competitors.

60. The Delegation of Italy said that in Italy it was possible to file for registration of a three-dimensional mark since 1942. There was no problem with the registration of these trademarks as long as they were distinctive and capable of graphical representation. The Delegation mentioned as an example of a clearly distinctive shape mark registered by the Trademark Office, the bottle of an Italian aperitif, which had a triangular shape. The Delegation noted, however that the Office had not received a large number of three-dimensional mark applications.

61. The Chair then asked Delegations to share their experiences on the issues raised by the Delegation of the United States of America concerning product packaging. In particular, the fact that where product packaging rendered the article more attractive, this counted against the registrability of the sign.

62. The Delegation of the United Kingdom said that attractiveness was a difficult question because one could say that the attractiveness of a shape could give it the distinctiveness. In the United Kingdom, three basic principles were considered to determine whether or not a shape mark could be registered: (a) whether the sign consisted exclusively of the shape which resulted from the nature of the goods themselves, (b) whether it was the shape that was necessary to obtain a technical result or (c) whether the shape gave substantial value to the goods. Thus, if the sign was an ornamentation for which the client had to pay more, it would generally fall under the last heading. The Delegation concluded that the Office would always analyze each case on its merits.

63. The Delegation of Sweden said that one case had been decided by the Patent Appeals Court shortly after Sweden joined the European Union and applied the Trademarks Directive. The Case related to the pre-requisite of whether a shape gave substantial value to the goods. An application filed by a manufacturer of silverware and the applicant sought to register the ornamentation at the hand-end piece of a table spoon set. As representation of the sign, the applicant filed paper copies or print-outs of the hand pieces and argued that these elements had acquired distinctiveness through use, which was recognized by the public. Since the shape was considered to give substantial value to the goods, the application was refused on absolute grounds and for competition reasons.

64. The Delegation of Germany indicated that the situation in Germany was similar to that described by the Delegation of the United Kingdom. The national Trademark Office also checked the shape applied in relation to the three points mentioned by the Delegation of the United Kingdom. However, the Trademark Office in Germany did not carry out such a strict examination as that described by the Delegation of the United States of America. The Office did not check whether there was a patent on a similar design. If an element was not dictated by an absolute technical necessity, this obstacle was overcome and the Office went on to examine concrete distinctiveness and to assess whether the three-dimensional shape could be perceived as a mark. The Delegation concluded that there seemed to be quite a large difference in examination practices.

65. The Chair asked delegations to share their experiences generally with all the other new types of signs that were mentioned in document SCT/16/2, or any other type of sign that was not included in that document.

66. The Delegation of Sweden said that it wished to share some general comments on various types of marks. In relation to position marks, the Delegation noted that the Trademark Office of Sweden had registered a series of applications for positioning of pockets on jeans trousers. Since this was a registration under the Madrid System, the Delegation believed that other countries could have also been designated. With regard to olfactory marks, the Delegation noted that between 2000 and 2001, the Trademark Office of Sweden received a number of applications for scent marks, to be applied to perfume. The representation of the mark was a very simple gas chromatogram. The first office action indicated the intention to refuse these applications on grounds of lack of distinctiveness, because a smell applied to perfumes seemed quite generic, and secondly, because there was a

lack of representation. The Office held that the representation was ambiguous, because the gas chromatogram had no scale, it contained no reference as to what objects were measured, nor an indication of the temperatures. Since the applicant did not respond, the case was not tried even in refusal. The Delegation added that, after the Sieckmann case, there were no other olfactory mark applications. In relation to movement marks, the Trademark Office of Sweden had received one application which consisted of a sequence of six or eight pictures, which put together became a short film of a figure in motion. At the time of that application, the Office argued that there was a lack of representation of the mark. The Delegation noted that perhaps currently, the application could be considered differently, since there were a number of similar registrations in other European countries. The Delegation declared that the Trademark Office had registered approximately a dozen sound marks and had received a few other applications. For all registered sound marks, the Office had accepted musical notation as adequate graphical representation. This practice was later confirmed or at least encouraged by the European Court of Justice. In addition, there was also discussion as to whether a piece that was replayed too many times over a period of time lost its distinctiveness, but this discussion was inconclusive. The Delegation said that generally, the Trademark Office had not tested one sound mark against another and therefore did not try the scope of protection or the likelihood of confusion.

67. The Delegation of the United States of America said that in the USPTO there had been similar discussions about the length of a sound mark. It was considered that the longer the sound was, the less likely that it would be perceived as a trademark. The USPTO had not dealt with the issue of likelihood of confusion. However, this and other issues were part of a broader discussion on how to improve the processing of sound mark applications, particularly in view of their increasing numbers. It was foreseen to require the applicant to provide more specificity in describing the sound and in some cases requiring the musical score or a recording of the sound to be incorporated into the Office search database.

68. The Delegation of Slovenia said that its Trademark Office had come across the problem of the length of slogans. Some applicants had actually asked whether there was a requirement in terms of how many words should be included in a slogan. The Delegation believed that very long slogans lacked sufficient distinctiveness, whereas brief and well sounding slogans could be quite distinctive. The Office in Slovenia would be likely to accept a rime, for example, but not a whole poem.

69. In this connection, the Delegation of the United States of America noted that the length of the slogan was important. An application had been submitted to the USPTO to register the "Boy Scouts" oath, which was several paragraphs long. The Office refused that application on the basis that this was not a trademark but a series of statements as to what the club did. This decision was confirmed by the Trademark Trial and Appeal Board.

70. The Delegation of Australia said that, in relation to slogans, the Trademark Office had undertaken some interesting work, the results of which could be made available to the Delegation of Slovenia. In relation to movement marks, the Trademark Office had received an application to register a character as portrayed in a short video clip. The applicant insisted on the video clip on its own to constitute the representation of the mark. A key issue for the Office was to establish whether a moving image in video form on its own could satisfy the requirements for registration and how long the footage should be. Under preexisting legislation, the Office would have registered the character in different poses as a series of marks. However, in that case, it appeared that the applicant desired to protect the nuance of

the way the character moved and any expression that was portrayed during the movement. The Office decided that it would accept the video footage together with an endorsement and the stills of the image.

71. The Delegation of Italy noted that sound marks were on the list of signs that could be registered as trademarks under national legislation, as long as they could be represented graphically. The graphical representation for all sound marks registered with the Office consisted of musical notation, except for a sound mark consisting of the lion's roar. The Delegation said that any other sound mark application which did not provide graphical representation was refused. This was the case of an application where the sound had been recorded on cassette, so that it was necessary to play that material support in order to hear the sound and appreciate the mark. The Office refused the registration of that sound mark and the Supreme Court of Appeal confirmed that decision on the grounds that the Office needed to see the sound in order to examine it, and third parties also needed to see the sign to be able to oppose it. The Delegation would make this decision available to the International Bureau.

72. The Delegation of Madagascar recalled that document SCT/16/2 included some examples of slogan, three-dimensional and color marks registered with its national Office. The Delegation noted that, even though three-dimensional marks or other non-traditional marks were not expressly mentioned in the trademark legislation of Madagascar, these trademarks could be registered if they were sufficiently distinctive. The Delegation thanked previous speakers for their very useful explanations on various new types marks and expressed confidence that in the near future, its Office would also receive those applications.

73. In relation to new types of marks, the SCT agreed to build upon document SCT/16/2 by undertaking further work in two areas:

- the representation and description of these signs; and
- the application of trademark principles to them.

The SCT agreed that it would ask the Secretariat to develop two papers for discussion at the next session based on submissions from SCT Members (to be submitted to the Secretariat by January 7, 2007):

- a paper setting out existing methods of representation and description of new types of marks in SCT Members, identifying where there are areas of convergence and any issues raised including the possibility of additional costs, particularly in developing countries;
- a paper exploring in greater detail the relation of established trademark principles to new types of marks. All principles including, *inter alia*, functionality, specialty and distinctiveness would be considered, as well as issues of public interest, including safeguarding the public domain.

Marks and International Nonproprietary Names for Pharmaceutical Substances (INNs)

74. The discussion was based on document SCT/16/3.

75. The Representative of the World Health Organization (WHO) expressed gratitude to WIPO for the opportunity to present the WHO-INN Programme. The Representative referred to the consultations that took place between WIPO and the WHO-INN Programme Secretariat to improve the accessibility of information on INNs. The Representative encouraged the SCT to endorse the proposals that were outlined in paragraphs 9 to 11 of document SCT/16/3 and were based on those consultations. She emphasized the importance of the activities of trademark offices for the successful implementation of the INN Programme objectives by preventing INNs from being appropriated as trademarks. Although an exchange of information between WHO and national trademark offices already took place, it could still be improved. WHO had established the INN Programme with the aim of creating unique distinct designations for pharmaceutical substances used for medical purposes. Although pharmaceutical substances might be identified by their chemical names, by scientific names, by research codes etc., practice had shown the enormous utility of a globally unified nomenclature on INNs. Drug regulatory authorities used INNs as a communication tool in drug labeling, technical publications like pharmacopoeias, clinical research, etc. Besides, in many countries, INNs were used in drug prescriptions. INNs were newly created words, which permitted to identify substances without ambiguity. In order to be useful in practice they should not be too long or too difficult to pronounce. Due to their global application, they had to be acceptable in all major languages. As INNs had to conform to the linguistic rules of individual languages their word shape in different languages frequently differed. In the process of selecting INNs a search was carried out in order to ascertain that newly coined names were not similar with existing trademarks used in the drug industry. The search was made in order to avoid possible confusion that might lead to errors in dispensation, and in order to recognize the proprietary rights of owners of existing trademarks. In addition, third parties might formally object the proposed INNs within a period of four months from the publication of the proposed INN. Once a recommended INN had been selected, it was important to make it available to all interested parties, such as drug regulatory authorities, the pharmaceutical industry, the medical profession and scientists. In that respect, the Director General of WHO had addressed a formal communication to all WHO Member States, in which they were requested to prevent the acquisition of proprietary rights in the recommended INNs, including prohibition of the registration of the recommended INNs as a trademark or trade name. In rare cases, the INN Secretariat had requested national authorities to refuse an application or invalidate a registration of a recommended INN. In the vast majority of cases such requests had been successful. The reasons to oppose actively the appropriation of INNs as trademarks were, first of all, the importance of free availability of the INNs, especially their free use in labeling pharmaceutical products. Secondly, INNs were coined in a systematic way and formed families of names to indicate a specific type of activity of a group of substances. A trademark identical to an INN would restrict the future application of the systematic approach of INNs. The strict prohibition to register recommended INNs as trademarks pertained to their original versions, including linguistic variants in different languages. The increasing popularity of INNs had prompted many pharmaceutical manufacturers to apply for registration marks that consisted of invented names resembling INNs, or contained word elements, “stems”, which indicated that the substance belonged to a group having similar pharmacological activity. A wide use of INN “stems” in trademarks would be detrimental to a systematic creation of new INNs for substances that were being developed and introduced into therapy. It might also lead to confusion among medical

practitioners as to the exact meaning of “a stem”. For this reason, the World Health Assembly had adopted, in 1993, a resolution requesting WHO Member States to discourage the use as trademarks of names including established INN “stems”. The Representative emphasized that national and regional trademark offices determined the possible similarity between INNs and trademarks on the same basis as they decided about the similarity between two trademarks. The Representative hoped that this information on the INN Programme would be of assistance for trademark examiners when deciding on individual applications, and that safety aspects associated to drug prescription and drug delivery issues related to INNs would be taken into account.

76. The Delegation of El Salvador explained that the practice of its trademark office was to prohibit the use of INN “stems” in trademarks. The Delegation stated that the proposals outlined in document SCT/16/3 were important. An access to the WHO on-line database should be made available, and the Delegation welcomed the proposal for transmission of an updated “CD-ROM/Cumulative list” to national offices.

77. The Delegation of Slovenia informed that its national office examined trademark applications in relation to recommended INNs. Only a few applications had been refused on the basis of a similar INN. While the major pharmaceutical companies respected INNs, the smaller enterprises were not always informed of the INN system. In Slovenia, there had also been some cases of bad faith applications. The decisions on similarity between INNs and trademarks were made on a case-by-case basis. The Delegation said that the Intellectual Property Office was in a process of revising its website and in the new website design the importance of INNs would be highlighted. The Delegation was in favor of approving the proposals outlined in document SCT/16/3.

78. The Delegation of Singapore sought clarification as to whether it would be possible to incorporate the INN database directly into the computer system of its trademark office. The Delegation also inquired, whether the raw data could be transmitted directly to that office and supported the proposals contained in document SCT/16/3.

79. The Representative of WHO said that any Member State could have access to the raw data and that it was sufficient to send an official request to WHO in that respect. The Representative noted that WHO already had a similar arrangement with the Trademark Office of Denmark.

80. The Delegation of Bulgaria suggested that the transliteration of INNs into the Cyrillic alphabet be introduced in the future.

81. The Representative of WHO explained that two lists of proposed and recommended INNs were published twice a year in three languages, namely English, French and Spanish. The cumulative lists of INNs were published in the six official languages of the United Nations, namely Arabic, Chinese, English, French, Russian and Spanish. The transliteration was already done into the Cyrillic alphabet in Russian.

82. The Delegation of Bulgaria observed that there were differences between the Bulgarian and Russian languages, however, the transliteration into Russian would be sufficient.

83. The Delegation of the United States of America supported the proposals contained in document SCT/16/3. The Delegation said that an e-mail notification of new lists of INNs was sufficient for the USPTO. The Delegation highlighted its practice in respect of INNs stating that, in addition to a research in respect of recommended INNs, USPTO examiners carried out research in respect of proposed INNs. In order to protect prior trademark rights, a conflict check was made between proposed INNs and applied or registered trademarks. In the case that conflicting prior trademarks were found, the office would consider whether those marks were “weak” marks, whether the proposed INN might cause confusion with those marks or lead to errors in prescriptions. The office would consult with industry and with the Health Ministry in order to determine whether an objection against a proposed INN was required. The Delegation noted that the United States of America had launched objections against proposed INNs in the past, and the conclusions had been satisfactory, leading to a modification of an INN or having an INN disregarded completely.

84. The Delegation of Brazil informed that its national office took into account the lists on INNs transmitted by WHO. The Delegation supported the proposals laid down in document SCT/16/3, because an improved circulation of information would be useful for the examiners in Brazil.

85. The Representative of INTA stated that there was a need among the interested circles to have a searchable database of INNs, which would include and consolidate proposed as well as recommended INNs. The Representative asked whether it was possible to establish and maintain a database available to all interested parties, including the pharmaceutical industry and trademark agents. The Representative referred to the question raised by the Delegation of Singapore, and asked whether the raw data could also be made available to all interested parties in addition to the trademark offices.

86. The Representative of WHO explained that the major users of the INN database were pharmaceutical companies. The database already included both the proposed and recommended INNs as well as objected INNs. The WHO did not distribute the data to private parties, because it did not wish that any commercial use be done in respect of the database. However, all the pharmaceutical companies that had requested the access to the database, had been granted such access.

87. The Committee approved the proposals outlined in paragraphs 9 to 11 of document SCT/16/3.

Trademark Opposition Procedures

88. The discussion was based on document SCT/16/4.

89. The Secretariat recalled that at its last session, the SCT had asked the International Bureau to prepare an information document on the topic of trademark opposition procedures. In response to this request, the Secretariat had prepared document SCT/16/4 that drew from the replies to the Questionnaire on Trademark Law and Practice, as summarized in document WIPO/STrad/INF/1.

90. The Delegation of the United States of America welcomed the opportunity to discuss practices in the field of opposition in different countries and to have an exchange of ideas in order to identify potential areas of convergence or best practices. The Delegation informed the Committee that the USPTO had a good experience with an internal tribunal for opposition proceedings composed of experts. In the United States of America, an initial opposition period of 30 days could be extended within a time frame of 6 months from publication. During this period, the parties could enter into settlement negotiations which were outside the realm of the USPTO. The Delegation believed that it was advantageous to provide for a pre-registration opposition system. Otherwise, it would be necessary to expunge all the administrative steps leading to a registration. In the United States of America, a registration offered additional protection, such as protection against infringing goods entering the country. It also offered the possibility of filing in foreign countries under the Paris Convention. As to the way in which the opposition procedure was carried out, the Delegation explained that an electronic system determined whether the opposition had been raised in time and whether the necessary fees had been paid. It counted the number of parties that had applied and generated an institution order indicating the times when answers had to be filed, discovery and testimony had to be taken and briefings had to be given. All these periods could be extended. The parties could submit motions to the board if they did not agree on procedural steps or wished to dispose of the opposition. The reduction of work through the motions practice was significant. Only 7 percent of all opposition cases ended with a final decision taken by the opposition judges. Moreover, the online system offered transparency by displaying not only the final decision but also all documentation that had been submitted and had not been declared confidential by a party. The electronic system also showed how motions were handled and served as a tutorial. A newly introduced efficiency measure was a rule of mandatory initial disclosure of the information which the parties sought to present in order to defend their case.

91. The Delegation of El Salvador informed the SCT that the amendments introduced to the Trademark Law of El Salvador in August 2004 also concerned opposition procedures. Once a request for the registration of a mark was presented, the office had to carry out an in-depth examination of the mark. Upon registration of the mark, an opposition could be presented on the basis of the grounds for opposition defined in the law and bearing in mind the interests of third parties. An interested party filing an opposition had to provide proof in support of the opposition within a certain time limit. Then, the person requesting the registration of the mark could offer proof to uphold the registration. The opposition procedure took place before the trademark office, which had an obligation to provide information on opposition procedures. The office decision in opposition cases could be appealed. The new legislation also offered further possibilities for canceling a registration.

92. The Representative of the European Community explained that the Community trademark system provided for pre-registration opposition procedures. After publication of a trademark application in the official journal, the system offered an opposition period of three months that could not be extended. However, objections based on prior rights could also be raised after registration in the course of cancellation procedures. The Representative pointed out that, according to the trademark legislation of the European Community, the *ex officio* examination of trademark applications was limited to absolute grounds for refusal. Relative grounds could only be asserted in the framework of opposition proceedings. There was also a clear tendency among the member States of the European Community to abandon systems of *ex officio* examination of trademark applications on relative grounds. The Representative felt that the opposition system at the level of the European Community was efficient. It provided

for a so-called “cooling-off” period before entering into the adversary part of the opposition procedure. During this period, the parties could settle their dispute without any cost risk. He clarified that, if the opposition procedure was carried out, the losing party had, in principle, to bear the costs. The office could award costs differently.

93. The Delegation of Sudan said that, under the Trademark Law of Sudan, once a trademark had been registered and published, an opposition period of six months for domestic trademarks and an opposition period of eight months for international trademarks began to run. In case that an opposition was lodged, the owner of the registered trademark was informed accordingly and had to answer within 30 days. If the registrar did not receive a reply to the opposition from the trademark owner, or if the registrar rejected the reply, the trademark registration was expunged. In this case, appeal against the office decision to a specialized commercial court in Khartoum was possible.

94. The Delegation of Slovenia informed the Committee that, in Slovenia, a pre-registration opposition system was in place, which provided for an opposition period of three months. There was no time limit for the office to take a decision on the opposition which users saw as a shortcoming of the system. An opposition could only be based on relative grounds. Most oppositions were based on prior trademark rights. Oppositions concerning other earlier rights, such as copyright, were rather rare. The Delegation pointed out that it had encountered problems in determining, for the purposes of opposition procedures, the extent of protection of verbal signs in standard letters. In this regard, it gave the example of an earlier mark consisting of the word “sun” that was asserted against a later trademark application concerning a graphical representation of the sun. The Delegation added that it may also be difficult to decide on whether to suspend opposition procedures in case the opponent’s earlier mark was challenged in court proceedings and might be annulled or invalidated. The Delegation stated that the work of the SCT on the issue of trademark opposition procedures should be continued, in particular, with regard to practical problems encountered by trademark offices.

95. The Delegation of Japan underlined that it was an essential feature of trademark systems to offer third parties the opportunity to oppose trademark applications. It informed the Committee that the trademark office of Japan examined trademark applications on absolute as well as relative grounds. There were only a small number of oppositions. The users of the trademark system of Japan preferred a post-registration opposition procedure. The Delegation said that it was understandable that countries in which the trademark office examined applications only on absolute grounds, had different opposition systems. It felt that a careful analysis of the opposition procedure in different trademark systems had to be conducted before turning to a discussion on harmonization. The Delegation indicated its interest in a comparison of the purposes and benefits of pre and post-registration opposition systems.

96. The Delegation of Brazil expressed its understanding that the present exercise was not intended to harmonize opposition procedures. In this regard, it referred to Article 1(1) of the TRIPS Agreement. The discussion on opposition procedures should serve the purpose of exchanging experiences. In Brazil, Article 124 of Industrial Property Law number 9729-96 of 1996 established the instances in which opposition was possible. The law contemplated a pre-registration opposition system. An opposition can be based both on absolute and relative grounds. The opposition period is of 60 days, running from the date of publication of the application (LPI, art. 158). However, the law also contemplated an administrative declaration of nullity, which can be initiated by a third party with legitimate interest or *ex-officio*, within

180 days from the date of registration. The administrative phase terminates by the end of this 180 days period. If a trademark is declared invalid in the course of this procedure, the registration will be deemed never to have been made. The Industrial Property National Institute (INPI) is the body in charge of examining applications and issuing the registration of a trademark. Nonetheless, the Judiciary Power may review the trademark office's decision to accept an application and decide on the cancellation of a registration (a judicial procedure), once the administrative phase is finished.

97. The Delegation of the Russian Federation informed the Committee that an opposition procedure in the sense of document SCT/16/4 did not exist in the Russian Federation. The trademark office of the Russian Federation had broad expert knowledge as to absolute and relative grounds for refusal. However, it did not inquire into all potential conflicts which would include, for instance, collisions with copyright, protected titles and characters, and personal names. These latter cases were nevertheless covered by the applicable national law. The Delegation said that there might be instances in which trademarks were registered even though there was a collision with earlier rights. With regard to these exceptional cases, the introduction of an opposition procedure was conceivable. This question as well as procedural aspects of a future opposition procedure were currently under discussion in the Russian Federation. The Delegation emphasized that the discussion in the SCT was of great interest to the Russian Federation and should be continued to clarify formal aspects, and to obtain information on complex situations that may arise, such as the situations described by the Delegation of Slovenia.

98. The Delegation of Norway explained that, in Norway, a post-registration opposition system concerning absolute and relative grounds was in place. The current opposition period was two months from publication. A draft amendment to the national law provided for an extension of this period to three months. An opposition did not require the payment of fees or imply other costs. The average time, which the trademark office needed to issue a final decision, was six months. Information on the average time needed was made available on the Internet. Currently, there was a certain backlog with regard to oppositions. The Delegation pointed out that the office sought to reduce the time for deciding in opposition cases to one month. Once the opposition procedure had been completed, both parties to the opposition were notified by the office. Besides the opposition procedure, the trademark system of Norway provided for invalidation proceedings before the courts.

99. The Delegation of Singapore said that Singapore operated a pre-registration opposition system providing for an opposition period of two months from publication. The period could be extended up to a maximum of four months. Evidence was exchanged in writing. The opposition hearing was conducted by an internal tribunal within the office. The internal tribunal was composed of one hearing officer who was a legally trained trademark specialist. As the trademark office in Singapore conducted an *ex officio* examination for relative grounds, the opposition rate was relatively low. It amounted to less than one percent of the total number of applications filed with the office. The Delegation pointed out that the opposition system in Singapore allowed for settlement talks. There was a mandatory requirement to issue a final decision on the opposition three months after the hearing. Against the office decision, an appeal to the High Court of Singapore was possible. The Delegation indicated its interest in guidelines on the time frame for issuing decisions. It wondered whether decisions should be in writing. It believed that such guidelines could enhance the efficiency and transparency of opposition systems.

100. The Delegation of Australia informed the Committee that the pre-registration opposition system in Australia provided for an opposition period of three months after publication. An opposition could be based on both absolute and relative grounds. Opposition in Australia typically took nine months or more to reach the hearing because there were three evidentiary periods of three months which could be extended. The hearing was conducted by a single hearings officer who was an experienced trademark examiner and only rarely a person from outside the office. The trademark office sought to issue a decision within three months from the hearing. The Delegation expressed support for further investigations or discussions, in particular, with regard to grounds for opposition and the length of opposition procedures.

101. The Chair asked whether Delegations could provide information on who had standing in opposition procedures. He recalled the issues raised by the Delegations of Japan and Slovenia.

102. The Delegation of the United States of America clarified that, in opposition procedures before the USPTO, anybody who could show an interest might have standing. This amounted to a showing that the opponent would be harmed by the registration of the mark at issue. An opposition could be based on both absolute and relative grounds. With regard to relative grounds, a person with standing would have to claim and prove priority and a similarity of the signs concerned. As to other grounds, the Delegation gave the example of an opposition based on the descriptiveness of the mark at issue. In this case, the opponent had to show a need to use the sign in the regular course of business. An opposition could be suspended if the parties to the opposition were involved in court litigation that may have a bearing on the registrability of the mark. A further reason was that the parties entered into settlement negotiations. In this case, the proceedings would be suspended at the request of one party until a motion to resume was submitted by one of the parties.

103. The Delegation of El Salvador said that, according to national legislation in El Salvador, anyone demonstrating a legitimate interest could present an opposition. The payment of a fee was not necessary. The reasons for opposition had to be substantiated. Against the decision of the office, an appeal to the Trade Court was possible. Once an opposition had been lodged, the opposition procedure had to be continued. The requesting party, however, could desist from the opposition. In this case, the procedure was concluded.

104. The Delegation of Morocco informed the Committee that, in Morocco, there was a pre-registration opposition system. The opposition period of two months started from the publication of the trademark application. The trademark office had to issue a decision within six months. The parties to the opposition procedure could agree on the suspension of the opposition procedure. Suspension was also possible in case of a cancellation action before a court. The Delegation pointed out that the procedure could also be extended if there was agreement between the parties, or if the office expressed a need for extension.

105. The Representative of the European Community clarified that, according to the trademark system of the European Community, an opposition could only be lodged by the owners of earlier rights or licensees that had been authorized by the owner. As to suspension, the Representative recalled that, under European Community legislation, the “cooling-off” period preceded the adversary part of opposition proceedings. This period, which was intended to allow negotiations between the parties, was limited to 24 months. Subsequently, the parties had to enter into the adversary part of the proceedings but could still request suspension. Suspension was also possible if the circumstances of the case made it necessary,

for instance, because the basis of the opposition was not safe. The Representative pointed out that, in the member States of the European Community, both pre and post-registration opposition systems could be found. He indicated that a discussion on the benefits that could be derived from these different systems would be of interest to the European Community.

106. The Delegation of Bulgaria explained that the person lodging an opposition was not a party to the opposition procedure in Bulgaria. National law provided for pre-registration opposition that could be based on absolute and relative grounds. The opposition period was two months. As to the question of verbal signs and graphical representations raised by the Delegation of Slovenia, the Delegation expressed the view that, for determining a potential conflict, for instance, between the word “sun” and an image showing the sun, it would have to be considered for which goods and services the signs were registered, and whether there was a risk of confusion.

107. The Delegation of Ecuador said that the number of requests for the prolongation of opposition procedures was very high in Ecuador. It perceived this as a danger to the functioning of the opposition system. To solve the problem, the introduction of a fee for prolongation requests was currently under discussion.

108. The Delegation of Portugal informed the Committee that, in Portugal, there was a post-registration opposition system providing for an opposition period of two months that could be extended for an additional period of two months. Oppositions could be raised on absolute and relative grounds. The office had to decide in opposition cases on the basis of the evidence provided by the parties. Against the decision of the office, an appeal to the courts was possible.

109. The Chair invited the Committee to identify issues for future work in the area of trademark opposition procedures. He indicated that the objective of further discussion could be a consolidation of existing practices and a learning process rather than the development of a normative instrument. The development of a best practices model, the analysis of pre and post-registration systems and a discussion on grounds for opposition could be considered in this context.

110. The Delegation of Brazil said with regard to the identification of best practices, that it would be more comfortable with the exchange of “best information”. It underlined that there should be no norm setting initiatives.

111. The Delegation of El Salvador indicated its interest in information on procedural aspects of opposition proceedings, the experiences of Member States and the similarities of national practices. It wondered whether information should be provided by the members of the SCT, or whether the Secretariat would make available the information it already had.

112. The Delegation of Turkey expressed support for the intervention made by the Delegation of Brazil. Best practices could differ from country to country in accordance with the specific conditions in place. The Delegation indicated its interest in an exchange of information.

113. The Delegation of the United States of America expressed support for the suggestions made by the Chair. In the United States of America, a questionnaire had been developed recently in order to determine whether domestic practices were still appropriate. The Delegation proposed to make this questionnaire available on the SCT electronic forum.

114. The Delegation of Chile said that Chile had an efficient opposition procedure that went beyond the obligations under the TRIPS Agreement because of bilateral agreements. Regarding the further work of the SCT, the Delegation believed that, as a first step, information on best practices should be exchanged. On this basis, further steps could be considered.

115. The Representative of OAPI supported an exchange of detailed information on opposition procedures as a necessary first step in the further work of the Committee. He emphasized that, since OAPI had 16 member States, the opposition procedure took place at the Office. OAPI had opted for a post-registration system. Anyone asserting prior rights could launch an opposition within six months from the date of publication of the disputed registration. The Legal Service, which received the opposition, transmitted the text of the argumentation to the holder of the disputed mark. The latter was given a time limit of three months to respond. If the holder of the disputed mark did not respond within the time limit, the Office took note of that fact and declared the cancellation of the trademark registration. In case of reply, OAPI transmitted the text of the counter arguments to the opposing party, who may also respond. OAPI fixed the date when the opposition commission should meet. This commission listened to the parties that might wish to be heard. It should be noted that the opposition procedure at OAPI was in writing and that one might not take advantage of oral arguments to claim having responded to the opposing party. After examining the arguments in presence of the parties, the opposition commission submitted a draft decision to the Director General of OAPI. Decisions of the Director General might be appealed to the Superior Appeals Commission, which decided at first and last instance. It should also be noted that oppositions were based on relative grounds. As a general rule, absolute grounds of refusal were notified to the applicant after examination.

116. The Representative of the European Community recalled the proposal by the Delegation of Slovenia to identify problems in the area of trademark opposition procedures. He felt that, before speaking about best practices, the problems to be discussed should be clarified.

117. The Delegation of Australia held the view that it would also be useful to identify key advantages of the different opposition systems. As key problems had to be clarified, the SCT should also exchange information on areas in which opposition procedures worked well.

118. The Delegation of Brazil feared that, by identifying best practices or key advantages, the discussion in the SCT would enter into a phase where opposition systems were assessed and move from a simple exchange of information to an evaluation of the different systems. The Delegation stated that it supported a deep exchange of information but not a determination of whether a system was good or bad.

119. The Chair clarified that an identification of key learnings should include information on whether a procedure worked well or raised problems. Member States were free to provide information in this regard in order to share experience. An evaluation of different systems was not intended.

120. The Delegation of the United States of America said that, instead of a focus on key advantages, reference could be made to the efficiency of opposition procedures.

121. The Committee agreed to ask the Secretariat to prepare a working document on trademark opposition procedures for discussion at the next session, based on submissions by SCT Members (to be submitted to the Secretariat by January 7, 2007), to facilitate an exchange of information in order to identify key learnings.

122. Submissions would focus on providing information about opposition procedures, grounds of opposition, SCT Members' experience with pre-registration or post-registration opposition, and on a discussion of the relationship between a particular type of examination system and the related opposition procedure.

Trademarks and Their Relation With Literary and Artistic Works

123. The discussion was based on document SCT/16/5.

124. The Secretariat recalled that at the last session of the SCT, the issue of the relation of trademarks with literary and artistic works had arisen out of the discussion of other areas in which several intellectual property regimes were applicable to the same subject matter, namely the area of three-dimensional trademarks, works of applied art and industrial designs. The SCT had mandated the Secretariat to prepare an issues paper on the relation of trademarks with literary and artistic works.

125. The Delegation of Chile said that document SCT/16/5 provided a well-balanced overview of the relation of trademarks with literary and artistic works. It demonstrated the advantages and disadvantages of overlapping protection in this area. The document clearly described the objectives and characteristics of trademark and copyright law and identified various differences, for instance, as to the rationales of protection, the nature of exclusive rights, the term of protection, the exhaustion of rights, and exceptions and limitations. It also dealt with problems which, in the case of overlapping protection, flowed from differences in limitations for comparative advertising, parody, political discourse and criticism. The Delegation pointed out that society could derive benefits from the copyright rule of a limited term of protection. After the expiry of copyright protection, a work fell into the public domain and could be used freely also for commercial purposes. This free use by citizens could be impeded if later, trademark rights were acquired in a work in the public domain. The Delegation further drew the attention of the Standing Committee to the issue of differing exhaustion regimes. It stated that an analysis of cumulative trademark and copyright protection was necessary, particularly in view of emerging new kinds of marks. Referring to document SCT/16/2, the Delegation recalled that, initially, trademarks had consisted of words and two-dimensional elements. The notion of trademarks, however, was evolving and gave rise to more and more questions with regard to copyright. The distinction between copyright and trademark protection was becoming increasingly vague. The Delegation thus called upon the SCT to determine how the balance between copyright and trademark protection could be preserved. It proposed that, on the basis of document SCT/16/5, the issue could be further explored by asking the Secretariat to provide an additional document giving examples of relevant jurisprudence.

126. The Delegation of Singapore informed the Standing Committee that in Singapore, artistic copyright could be used as an alternative to registered trademark law in order to protect trademarks and service marks from copying. In a 1992 decision of the High Court of Singapore, it had been held that a mark which was represented in a stylized form with a symbol used as the dot of the letter “i” in a logo constituted an original artistic work enjoying copyright protection. On the facts, the High Court had found copyright infringement in the contentious mark which, accordingly, had been ordered to be removed from the register. In another case, involving a stylized Chinese character reproduced in comparative advertising, the High Court also had held that there was copyright infringement. The Delegation concluded that, in relation to artistic copyright in trademarks, the issue seemed to be rather settled in Singapore. In relation to literary copyright, courts in Singapore were likely to adopt various principles enunciated in cases found in common law jurisdictions. The Delegation gave the example of a case involving the name “Exxon”, where it had been stated that, even if the word “Exxon” was original *per se*, it did not constitute an original literary work intended for either information and instruction or pleasure in the form of literary enjoyment. The Delegation held the view that, from these cases, it would appear that branding of a single word did not attract copyright protection. As an issue for further exploration, it identified the question of whether subject matter of trademark law should be protected under copyright at all. The Delegation added that the issue of the moral rights of authors could be solved through contractual agreements. By mutual agreement between the author of a trademark constituting a work and the trademark owner, moral rights could be waived in order not to hinder the commercial exploitation of the goodwill of the trademark.

127. The Representative of the European Community doubted that the issue of trademarks and copyright should be a priority. He wondered whether there were any problems that needed to be discussed in the SCT. The Representative believed that the issue could be dealt with in applying international rules at the national level.

128. The Delegation of Germany stated that the relationship between trademark and copyright law did not pose problems in Germany. A collision in this area was rare. The Delegation clarified that the issue constituted no priority for Germany.

129. The Delegation of Brazil informed the Committee that intellectual property legislation in Brazil provided for an exclusion of copyrighted literary, artistic and scientific works as well as their titles from trademark protection, except where there was consent by the author. The Delegation believed that this solution constituted an adequate response to the issue of colliding interests of copyright and trademark holders. It wondered whether comparable solutions existed under other legislations. The Delegation stated that the issue of trademarks and copyright could pose greater problems with regard to new types of marks, such as movement marks. It felt that the core idea of discussing new types of marks was to extend the coverage of trademark protection to additional subject matter. This extension may raise more conflicts between copyright and trademarks. The Delegation concluded that the issue of trademarks and copyright was not irrelevant, and that it was important to maintain an intellectual discussion. It proposed to develop document SCT/16/5 in particular with regard to new types of marks.

130. The Representative of INTA expressed support for the interventions made by the Representative of the European Community and the Delegation of Germany. He underlined that trademark and copyright law were of different nature and served different purposes. He cautioned against efforts to harmonize the two areas of law. Both regimes could apply to the same subject matter but should be treated independently.

131. The Chair wondered whether it was agreeable to the Committee to give consideration to the issue of trademarks and copyright in the context of exploring the application of trademark principles to new types of marks.

132. The Representative of the European Community said that the issue of trademarks and copyright should not be linked with the issue of new types of marks. When exploring the latter issue, the focus should be on formal requirements relating to new types of marks. The SCT could revisit the relation with copyright protection at a later stage of its discussion.

133. The Delegation of Chile expressed support for the suggestion by the Chair. It believed that the issue of trademarks and copyright could be included in the discussion on new types of marks. The Delegation recalled that a reference to the issue of trademarks and copyright could already be found in document SCT/16/2.

134. The SCT agreed to ask the Secretariat to develop a paper for consideration by the SCT at its eighteenth session, based, *inter alia*, on submissions by SCT Members (to be submitted to the Secretariat by the end of April 2007), providing an overview of jurisprudence on the overlap between copyright and trademarks, including new types of marks, with a particular focus on identifying existing and potential problems.

Article 6ter of the Paris Convention

135. The discussion was based on document SCT/15/3.

136. The Secretariat said that document SCT/15/3 outlined the applicable procedures, relevant legal provisions, current administrative practices and statistical information concerning Article 6ter. Over the years some delegations had expressed concerns about certain administrative aspects in respect of the notification procedures under Article 6ter. There were some areas on which delegations hoped to improve the existing administrative practices, namely to facilitate the flow of information to the receiving States and clarify how detailed that information should be. Receiving States would welcome more information, in particular in respect of official signs and hallmarks indicating control and warranty adopted by Member States, in order to determine the legal effect of the signs that were the subject of a notification. The scope of protection of an official sign and hallmark was more limited than the scope of protection of a State emblem. Article 6ter(2) provided that such protection “shall apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or similar kind.” Currently, the information on products on which an official sign or hallmark was used in the State that had adopted those signs was not transmitted either to the International Bureau or to the receiving States. Another aspect was the question of the constituting agreement or charter of an international intergovernmental organization. In accordance with the Guidelines for the Interpretation of Article 6ter(1)(b) and (3)(b) adopted by the Paris Union Assembly in 1992, these provisions, subject to certain conditions, applied also to programs or institutions established by an international

intergovernmental organization and to conventions constituting an international treaty to which one or more States Members of the Paris Union were party. In order that a receiving State could determine whether the signs of a given organization qualify for protection under Article 6*ter*, it would be useful for them to receive a copy of the constituting agreement or charter of the organization, or the international treaty in question. The current practice of the International Bureau was to request a copy of the constituting agreement, charter or international treaty, in order to define the legal nature of the organization or convention and a list of the Member States. The International Bureau did not distribute those documents, and it would merit consideration, whether they should be made available to Member States as a standard procedure. In addition, the question whether the contact details of international intergovernmental organizations should be communicated to Member States had to be discussed. Finally, the possibility of transmitting electronic reproductions of the signs, for which protection was requested, as well as the possibility of communication in a different format – for example, electronically – could be explored, as currently, all communications were made on paper.

137. The Chair invited delegations to comment the issues raised by the Secretariat, and to indicate other possible areas to be discussed in respect of Article 6*ter*.

138. The Delegation of Japan referred to the statement of the Delegation of the United States of America at the fifteenth session of the SCT concerning the creation of forms that might be used when requesting the communication of signs under Article 6*ter*(3). In the view of the Delegation, the use of forms would enable the trademark offices to clearly define the protected sign and this would facilitate the identification of those signs against which oppositions might be raised. In this respect, the competent bodies within national offices would benefit from the forms. The Delegation noted that the forms would clarify the relationship between trademarks and signs, by defining the protected sign under Article 6*ter*(1).

139. The Delegation of the United States of America explained that the USPTO carried out a search in its database to identify conflicting trademarks. It was vital to have information on which products the official signs and hallmarks would be used, to be able to determine whether there was a likelihood of confusion with existing trademarks. In the case where the notification of an official sign or a hallmark was received without an indication of goods and services, the USPTO would refuse protection.

140. The Representative of the European Community expressed support to receiving more information in communications made under Article 6*ter*. The type of information that had to be supplied in the context of a communication should be clearly defined. The Representative raised a question concerning the *prima facie* determination by the International Bureau in respect of the legal nature of the requesting organization. The Representative held the view that the ultimate decision remained with the States party to the Paris Convention and Members of the WTO, not party to the Paris Convention.

141. The Secretariat referred to the preparatory work of the International Bureau preceding the adoption of the Guidelines for the Interpretation of Article 6*ter*(1)(b) and 3(b), by the Paris Union Assembly, in 1992. A definition of international intergovernmental organization for the purposes of the administration of Article 6*ter* had been proposed, which was however not adopted by the Assembly. The Vienna Convention on the Law of Treaties Between States and International Organizations and Between International Organizations did not provide a

definition either. In the absence of a legally binding definition, the International Bureau relied on the administrative practices of the organization in the past and on records of the Revision Conference of Lisbon in 1958, where the protection of Article *6ter* was extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations. Such organizations were those with their own legal personality, constituting charter, Member States, host agreement with a host State and having legal personality as subjects of public international law. In particular, the United Nations and its specialized agencies would be eligible for the purposes of Article *6ter*(1)(b). The application of Article *6ter* was extended by the Guidelines to certain programs and institutions established by an international intergovernmental organization and conventions constituting an international treaty. Those entities had many similar characteristics with international intergovernmental organizations, such as being subjects of public international law and having their own legal personality. The Secretariat mentioned as examples: the United Nations Development Programme (UNDP), the Office of the United Nations High Commissioner for Refugees (UNHCR), or the Joint United Nations Programme on HIV/AIDS (UNAIDS).

142. The Delegation of Austria indicated that the notifications did not contain all the information which was needed by the trademark applicants. On the one hand, if a modified sign was communicated under Article *6ter*, it remained unclear, whether the previous sign was still protected. On the other hand, trademark applicants would need information on international intergovernmental organizations for possible negotiations on consent to use their signs as a part of a trademark. Finally, a general discussion was needed in respect of the scope of protection under Article *6ter* in connection with market changes. For instance, the abbreviation “BIZ” was protected under Article *6ter*, but it was also a commonly used abbreviation within the business circles. A few trademark applicants wanted to include that abbreviation in their trademarks, which also contained other distinctive elements. In Austria, it was not possible to grant protection for a trademark containing an abbreviation, which was protected under Article *6ter*.

143. The Secretariat pointed out that the protection under Article *6ter* was not of a general nature. In accordance with Article *6ter*(1)(c), protection of signs of international intergovernmental organizations might be limited to cases, in which their use or registration as trademarks would suggest a connection with the organization concerned. The same applied when the use or registration was unlikely to mislead the public as to the existence of a connection between the user of the mark and the organization concerned.

144. The Delegation of Brazil explained that its trademark office had encountered difficulties to oppose the protection of some signs that had been notified to it. In the view of the Delegation, it would be helpful if notifications could be received through electronic means of communication and more information were included in the communications. This would make Article *6ter* procedures more accessible to Member States.

145. The Delegation of El Salvador supported the views expressed by the Delegation of Brazil. The Delegation pointed out that electronic communication systems in trademark offices of the Latin American countries could be improved. The Delegation suggested a WIPO project to make an improved electronic communication available for governments.

146. The Delegation of the United States of America said that receiving a sign in an electronic form would facilitate its downloading in the database instead of having to scan it. The Delegation was in favor of a regularized form, the content of which would always be the same.

147. The Delegation of Canada welcomed the idea of standardized forms and of receiving communications electronically. The Delegation observed however, that keeping lists of e-mail addresses could be difficult. The Delegation considered that trademark offices should be flexible and also accept communications on paper. In the view of the Delegation electronic communications could also be posted on the Internet.

148. The Delegation of Chile was in favor of receiving electronic communications, either in the form of an e-mail, a CD-ROM or a link to the WIPO website. The Delegation informed the Standing Committee that authorities in Chile already received WTO communications via e-mail.

149. The Delegation of Australia supported the suggestion made by the Delegation of the United States of America. The Delegation mentioned that its trademark office had experienced difficulties in defining the scope of protection of the notified signs.

150. The Representative of the European Community expressed agreement on the need to modernize and update Article 6*ter* procedures. The Representative suggested carrying out a further review of the Article 6*ter* regime in order to simplify the procedures and reduce costs for Member States, international intergovernmental organizations and the International Bureau. The Representative supported the proposal to establish standardized forms. There was a need to clearly define the information that was required in the context of a communication. It was also useful to clarify the subject matter eligible for protection and recognition under Article 6*ter*. In addition, some guidance was needed regarding the grounds on which the protection might be refused. In this respect the relationship between signs protected under Article 6*ter* and prior existing trademark rights should be explored. Furthermore, the role of the International Bureau as an intermediary and the adequate funding of the procedure should be clarified. The Representative stressed that the procedures for removing signs from the database had to be explored. Finally, a clear understanding of the database was of vital importance. It was understood that the database did not have any legal effect, however, a question arose as to what extent it could be assumed that the database was complete. For trademark examiners the database was the only real reference tool, and it appeared that there were differences between the coverage of the database and the paper records.

151. The Secretariat recalled that according to Article 6*ter*(3)(a) of the Paris Convention, the publication which had legal effect was that made by the individual Contracting States of the Paris Convention, and it was their responsibility to keep individual records of the communications received. The possibility to raise objections depended on individual Contracting States, and in respect of objections raised in one State, that particular State was responsible for keeping a record of its objections. In many States, communications under Article 6*ter* were incorporated in the national trademark database for search purposes. The Paris Convention did not make any reference to a publication made by the International Bureau. The Article 6*ter* database was created by the International Bureau for information purposes and did not have any legal effect. However, the Article 6*ter* database was perceived as a useful reference tool, in particular for those offices that did not incorporate 6*ter*

notifications into their own search files. The International Bureau ensured that the information in the database was accurate and endeavored to avoid any discrepancy between the paper communications and the database. The International Bureau was aware of certain difficulties encountered by the users of the database and, therefore, had initiated work on a new and improved interface for the database. In any case, the International Bureau would continue to make the information concerning Article *6ter* communications available on CD-ROM.

152. The Delegation of the United States of America asked whether the intention of the European Community was to address the issue of removal of signs from the database, when they were no longer used or when the country in question no longer existed. The Delegation further observed that in one notification, a number of separate signs were communicated. The Delegation proposed that the notifications should clearly indicate whether the protection was requested for all the signs.

153. The Representative of the European Community stated that his intervention related to the term of protection rather than to a sign from a country which had ceased to exist. Currently, a term of protection was not provided and it could be discussed whether it would be desirable to establish such a term.

154. The SCT agreed to request the Secretariat to prepare a working document for consideration by the SCT at the next session, dealing with certain procedural aspects of Article *6ter* communications, in particular:

- information on the nature of goods and services on which official signs and hallmarks indicating control and warranty are used;
- information concerning the constituting charter or agreement of international intergovernmental organizations availing themselves of Article *6ter*(1)(b);
- relevant contact details concerning a party requesting a communication under Article *6ter*;
- ways of making the content of Article *6ter* notifications available through means of electronic communication; and
- draft forms for requesting communications.

155. The Committee noted that there were still some areas where clarification would be beneficial, namely:

- clarification of eligible subject matter;
- duration of protection (term);
- grounds of refusal;
- effect of prior trademark rights;

- role of the International Bureau as intermediary;
- procedure for withdrawal of a communication;
- clear understanding of the status of the database.

156. The Committee agreed to request the Secretariat to provide further information about these issues as a second part of the paper being prepared on Article 6*ter* for the next session.

Communication from the Permanent Mission of Brazil

157. The discussion was based on document SCT/16/7.

158. The Delegation of Brazil thanked the Standing Committee for giving it an opportunity to present the “Non-Exhaustive List of Customary Names Used in Brazil Associated with Biodiversity” and also thanked the International Bureau for having circulated the full content of the list in CD-ROM format. The Delegation noted that the list was an initiative of the Brazilian Government in response to requests from civil society, environmentalists and indigenous groups in Brazil, who were increasingly concerned with the registration of generic names as trademarks in different jurisdictions. Traditional and local communities in the Amazonian region had expressed strong views against the registration of generic names of the Brazilian plant biodiversity in foreign countries – an action that could be regarded as a form of biopiracy. The Delegation said that there had been an upsurge in flawed trademarks consisting of generic terms of Brazil’s biodiversity. As recent examples of terms that had been the object of filing or registration in foreign countries, the Delegation mentioned: “cupuaçu”, “açai” and “guaraná”, names of native fruits of the Amazonian region, as well as “copaiba”, an oil extracted from a South American pinnate-leafed tree. Foreign companies had sought exclusive commercial rights over those terms. In an attempt to prevent the grant of flawed trademarks, the Government of Brazil called on scientists and biodiversity experts from the Brazilian Enterprise for Agricultural Research (EMBRAPA), the Brazilian Institute for the Environment (IBAMA) and the National Institute of Industrial Property (INPI) to develop a generic-name database on the national plant biodiversity. Officials from other areas of government (Agriculture, Health, External Relations, Science and Technology, Industry and Culture) also contributed to the project. The list was made up of more than 5000 generic names of plants, fruits and microorganisms representing the Brazilian plant biodiversity. For each generic term in the Portuguese language, the list indicated: (i) the corresponding scientific name, (ii) the English translation and (iii) the relevant class of the Nice Classification. The Delegation declared that Brazil was willing to support initiatives in WIPO to improve the quality of trademarks. Therefore, the list was aimed at preventing the registration of flawed trademarks, not having sufficient distinctive character, by providing trademark offices and examiners an important basis for consultation. The Delegation recalled that generic names lacked distinctive character, a general legal requirement under national laws for a term to be protected as a trademark, and a requirement contained in the Paris Convention and in the TRIPS Agreement. The Delegation informed the Standing Committee that the Brazilian Government had had to face costly proceedings in different countries to oppose, cancel or invalidate the registration of erroneous trademarks. Those proceedings were burdensome and costly because they needed to be filed in different jurisdictions and

under diverse legislations. Moreover, lengthy negotiations on a case-by-case basis were usually required for both canceling a mark and winning back the generic name or for trying to convince the holder to voluntarily abandon the trademark and avoid litigation. On many occasions, the Government of Brazil had counted on the goodwill and support of lawyers who had opted to work without remuneration. The Delegation noted that, apart from canceling registrations, the Government of Brazil sought to avoid undue losses to exporters. The filing or registration of biodiversity names as trademarks could undermine the commercial exploitation of the fruits or plants and derivative products designated with those names. For example, if a firm obtained exclusive rights over the name “cupuaçu”, that could prevent exporters or Amazonian communities, which had cultivated such fruit for centuries from commercializing it under its original name in the market where protection was granted. The Delegation further noted that the Amazonian region in Brazil was one of that country’s socially less-advanced areas. In recent years, local and indigenous communities in the Amazon had benefited from a large number of multi-stakeholder projects that were developed by local governments and the private sector. Many of those projects were focused on the sustainable exploitation of the forest resources, to take those communities out of poverty. The Delegation believed that, as many of the trademarks that were erroneously registered consisted of the actual names of fruits or plants belonging to the country’s biodiversity, their granting in foreign markets could be considered a practice that hurt the principle of national sovereignty over genetic resources, as recognized by the Convention on Biological Diversity. Moreover, it threatened the social and economic benefits that could legitimately accrue to local or traditional communities in many biodiverse regions of the world, most of them were located in developing countries. In light of the above, the Delegation requested members of the SCT to promote awareness and use of the list by their national trademark offices.

159. The Delegation of Germany said that the German Patent and Trademark Office supported the request of Brazil to prevent the registration of trademarks that were descriptive and consisted of customary names in the Portuguese language. Such trademarks had probably been registered because the examiners did not know the Portuguese language. The Delegation believed that the list of customary names used in Brazil in connection with biodiversity could be very helpful to promote awareness amongst German examiners. Thus the German Office would make every effort so that trademarks using a generic term of the Portuguese language would not be granted in the future.

160. The Delegation of Brazil said that it welcomed the positive and cooperative reaction from the Delegation of Germany. The Delegation wished to clarify that many of the names included in the list were not in the Portuguese language but in the traditional languages of the local indigenous peoples, who were the original inhabitants of the Amazon region and who actually gave the names to the plants and trees. The list had 5000 names because there could be more than one traditional way of designating a particular plant.

161. The Delegation of Iran (Islamic Republic of) expressed support for the initiative taken by the Government of Brazil and its request for the Standing Committee to promote awareness of the list of customary names associated with biodiversity.

162. The Delegation of Colombia supported the declaration made by the Delegation of Brazil. Since Colombia also shared the Amazon basin, the Delegation believed this list was a very important contribution, which would help countries of the region and their native communities to enhance cooperation in the area of medicinal plants that could be used for the preparation of affordable medicines.

163. The Delegation of Ecuador congratulated and thanked the Delegation of Brazil for the elaboration of the list. The Delegation believed, however, that some level of coordination was needed among the Intellectual Property Institutes of the countries sharing the Amazon basin, because it seemed that certain names mentioned on the list corresponded to names also used in Ecuador.

164. The Delegation of Chile thanked the Delegation of Brazil for the elaboration of the document, which would be extremely useful for the purposes of trademark examination.

165. The Delegation of Portugal congratulated the Delegation of Brazil for having submitted this document containing a compilation of names associated with biodiversity. The Delegation believed that the list would be extremely useful for its Trademark Office to analyze names submitted for registration as trademarks.

166. The Delegation of Brazil wished to complement its intervention by acknowledging the fact that many of the names included in the list could be spread out and in use in an area larger than the Brazilian Amazonian region. Therefore, the issue of regional coordination for improving the list was relevant. The Delegation hoped that some form of discussion on this issue could continue in the Standing Committee, because a proliferation of separate lists could result in overlap or repetition of names. Another interesting issue was the question of transposing names to other languages because many of the names were in indigenous languages, for example, “cupuaçu” meant large coconut. Without understanding the language, one could not understand how a given name could be a generic term that simply designates the fruit of a plant. The Delegation believed that there was a need to develop some form of international coordination to deal with this issue, even on a voluntary basis, or through a database that was available to examiners as a reference. The Delegation noted that probably in Africa or Asia, there could be many biodiversity names, written in different alphabets. There could be an issue as to how to transpose names to different alphabets and how to transpose the exact sound of the name, or whether it was legitimate to do so. In the view of the Delegation, these issues could be the subject matter for further discussion in the Standing Committee, and if so agreed, the Secretariat could be asked to prepare a background document on these issues for the next session. The Delegation declared that this topic was of great social and economic relevance to Brazil because it had the potential of actually making redundant any efforts to bring local indigenous communities out of poverty by encouraging exports of the products resulting from their traditional activities, which were in many cases, very closely associated with the local biodiversity. The Delegation concluded that this type of work at the SCT could be linked with the work of other bodies at WIPO that dealt with traditional knowledge, such as the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC). There were common general objectives, such as enhancing the prospects for local indigenous communities –i.e., the bearers of traditional knowledge– to exploit elements of their tradition which may be of some commercial value in the international market.

167. The Delegation of Slovenia thanked the Delegation of Brazil for providing such a useful document, which would be an important tool for the Offices to carry out the task of trademark examination on absolute grounds. The Delegation declared that the practice of its Office was to examine trademark applications for possible conflicts with names of plants or microorganisms. However, it seemed that the document submitted by the Delegation of Brazil was far more substantive and the CD-ROM made available by the Secretariat would be very helpful for examiners. In the past, the Office had relied on information contained in

dictionaries or on the Internet, and wondered about the accuracy of such information. The Delegation noted that the information contained in document SCT/16/7 concerned generic terms which could not be registered as trademarks. The Delegation further noted that the work done by Brazil could prompt other countries to draw up their own lists and thus, it would be useful to develop a guideline for the elaboration of such lists.

168. The Delegation of Colombia expressed support for the proposal made by the Delegation of Brazil to request the assistance of WIPO in order to enhance and complete the list. The Delegation recalled that Colombia, like Brazil and other South American countries shared the Amazon region, which could be considered the lung of the hemisphere. Therefore, any work related to the protection of the biodiversity of that region had a bearing on the protection of the traditional cultures in all those countries.

169. The Delegation of the United States of America thanked the Delegation of Brazil for providing the list of terms, which was certainly useful information for national offices to use when making determinations of generic terms at the national level. The Delegation noted that the USPTO had many databases of information which were used by examiners when researching applications. The Delegation indicated that the USPTO had checked the list provided by the Delegation of Brazil and found that the terms contained in the list already appeared in the examining tools that were used in that office. In the view of the Delegation, these reference tools were certainly useful when determining whether the consumer in the United States of America would view these terms as generic. While the status of those terms in Brazil was very useful information, the Office would rather look at how these terms were perceived nationally.

170. The Delegation of Austria thanked the Delegation of Brazil for the information submitted, which was of importance for all national offices. The Delegation wondered if the information that had been distributed to the members of the SCT in CD-ROM format would also be made available on-line, for instance through the WIPO website.

171. The Chair noted that the list had been made available on-line. The International Bureau would provide the URL where the information was published to all interested delegations.

172. The Delegation of Switzerland thanked the Delegation of Brazil for the time that was devoted to the preparation of the list. The Delegation also thanked the explanations provided to the members of the SCT, which had allowed them to get a better insight into the concerns expressed by the Government of Brazil. However, the Delegation supported the intervention made by the Delegation of the United States of America on the issue that when examining a mark, the national office took into account the perception of the average consumer in that country to determine whether or not a term entered into the public domain. The list was a useful tool, but it was static as compared to the consumer's perception. Therefore, the former should not override the importance of the latter.

173. The Delegation of Bulgaria thanked the Delegation of Brazil for preparing the list and presenting it to members of the SCT. The Delegation supported the interventions made by the Delegations of Switzerland and the United States of America. The Delegation proposed that in subsequent meetings the SCT discuss the limits between this or similar lists and geographical indications.

174. The Delegation of Brazil declared that it was aware of the international legal requirements established by the TRIPS Agreement and the Paris Convention, and also of the fact that many members would consider the perception of the public as the main criteria for establishing whether or not a particular name was perceived to be in the public domain. For that reason, the Delegation had proposed that the list be used as a voluntary reference. Members were to consider the list as a broad indication of the names that had been used in association with biodiversity and which could have been the object of a trademark registration. The Delegation did not believe that the list could be considered static. The list was “non-exhaustive” since there was always the possibility of adding new names that applied to particular plants. According to the Delegation, biodiversity itself had not been fully identified or described, therefore, it was possible that a plant which was perceived as newly discovered could have already been known by a particular local community that gave it a name and possessed information or traditional knowledge about applications of that plant for food or health purposes. The Delegation believed that the perception of the public could not be considered to be static either, as perceptions were also liable to evolve. Finally, regarding the relation between geographical indications and names linked to biodiversity, the Delegation said that the two notions were different, because biodiversity did not have a clear and precise relationship with geographical origin. The issue was rather to facilitate the knowledge of different names that applied to a particular plant and to determine whether or not those names were generic, according to perception of the public.

175. The Delegation of Australia joined other Delegations in thanking the Delegation of Brazil for the preparation of the list of terms that were generic in Brazil. This would certainly be a useful tool for examiners. The Delegation noted that the practice of its Trademark Office was similar to that explained by the Delegation of the United States of America, so that examiners looked at a range of databases containing the botanical and common names of plants to be able to determine whether a particular name was generic in Australia. The Delegation echoed comments made by previous delegations that the consumer perception in the relevant market was also central to make that determination.

176. The Delegation of Chile said it understood that the document submitted by the Delegation of Brazil did not intend to alter any basic principle of trademark law. Therefore, the list contained in document SCT/16/7 should be appreciated in connection with other principles, such as territoriality and speciality, even independently from the consumer perception.

177. The Committee noted the “Non-Exhaustive List of Customary Names Used in Brazil Associated with Biodiversity”, presented by the Delegation of Brazil. The Committee thanked that Delegation for the substantial work done and for bringing this list to the Committee’s attention.

178. The Committee agreed that the Secretariat would maintain that list as an SCT paper, adding material submitted by other delegations.

Agenda Item 6: Industrial Designs

Formalities Concerning Procedures for Design Registration

179. The discussion was based in document SCT/16/6.

180. The Delegation of Norway referred to the suggestion made at the fifteenth session of the SCT, that the Standing Committee initiate work on a design law treaty. The Delegation felt that the development of a treaty containing provisions to regulate formalities, maximum requirements for design applications, filing date and other aspects, would be of great benefit for applicants, designers, trade circles, agents and national offices. Uniform design legislation would make the design system more user-friendly, efficient and cheaper. The Delegation suggested that this item be further discussed in the next meeting of the SCT. The Delegation proposed that SCT Members exchange with each other information on their practices regarding design registration in order to define areas where a harmonization could be achieved. As a result of that exercise, it might be concluded whether the SCT should undertake work towards guidelines, a joint recommendation, or perhaps a design law treaty.

181. The Representative of the European Community informed the SCT that the process of accession of the European Community to the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs was almost completed. The European Community intended to deposit its instrument of accession at the latest by the end 2007. Furthermore, the Representative expressed support for the proposal of the Delegation of Norway to initiate work on the harmonization of formalities in the field of industrial design. This work was considered useful and could result in a treaty for designs similar to the Singapore Treaty on the Law of Trademarks. The Representative believed that the requirements regarding the filing date could be a starting point for further harmonization.

182. The Delegation of Denmark supported the proposal made by the Delegation of Norway to exchange information on practices concerning formalities for design registration.

183. The Delegation of Germany also supported the proposals made by the Delegation of Norway and the Representative of the European Community. The Delegation noted that areas for harmonization of design registration formalities and procedures should be explored and an exchange of information on different design registration systems would be a good basis for the future work of the SCT.

184. The Delegation of Latvia joined previous delegations in supporting the proposal made by the Delegation of Norway.

185. The Representative of MARQUES supported the proposal of the Delegation of Norway. The Representative expressed particular interest in discussing in the SCT the harmonization of requirements concerning the reproduction of designs, the filing of multiple applications and the deferment of publication. The Representative noted that the date of publication was of vital importance for the design owners.

186. The Representative of CEIPI, speaking also on behalf of ATRIP, supported the idea of initiating work towards the harmonization of national and regional legislations on design formalities and procedures. The Representative recalled that applicants were often individuals and small and medium-sized enterprises, for which differences in national and regional practices created particular difficulties.

187. The Delegation of Japan stated that it did not oppose the exploration of issues concerning design procedures in the SCT. However, the Delegation, explained that the scope of protection of designs varied from country to country and as a consequence, the content of applications and the drawings were different. In addition, there were notable differences in

application procedures and classification structures. Regarding the exploitation of rights, the subject matter to be safeguarded in drawings was interpreted differently in different countries. Concerning the application procedures and the exploitation of rights, the Delegation suggested that the International Bureau collect information on different design systems in order to enable the Member States to understand the differences between systems and to decide which standpoint to take in respect of harmonization.

188. The Delegation of El Salvador referred to the proposals made by the Delegations of Denmark and Norway and by the Representative of the European Community, in favor of engaging work towards the harmonization of design procedures. The Delegation concurred with the position expressed by the Delegation of Japan that it was perhaps not timely to start discussions on a treaty. Countries in Central and South America had already accomplished considerable harmonization of their domestic legislation. The Delegation noted that an exchange of information between Member States could be extremely useful.

189. The Delegation of Chile shared the opinions expressed by the Delegations of El Salvador and Japan, and stated that additional work was required on this issue. Given the different approaches adopted in different countries with regard to design protection, it was difficult at the moment to initiate a discussion on harmonization in this area.

190. The Delegation of Australia said that a discussion on design procedures did not seem to be a high priority. The Delegation was aware of the problems that users experienced because of differences in respect of design practices between countries, such as the use of “dotted lines” in representations. The Delegation explained that Australia was seriously contemplating acceding to the Geneva Act of the Hague Agreement. Currently, the legislation in that country did not provide for deferral of publication, and the Delegation was interested in hearing the experiences of other countries that respect. The Delegation supported the proposal of the Delegation of Norway to work on design registration procedures.

191. The Delegation of Colombia stated support for the interventions made by the Delegations of Chile, El Salvador and Japan.

192. The Delegation of the Russian Federation explained that there were differences between the practices of the Russian Federation and European countries. In accordance with the legislation of the Russian Federation, an application for registration must contain a reproduction of the design. In addition, an application must include a description of the essential features of the design. The scope of legal protection might be determined on the basis of that description. As regards the filing date and the priority date, they would depend on the date of submission of the description. The Delegation said that the Russian Federation was in the process of examining its accession to the Geneva Act of the Hague Agreement. Finally, the Delegation expressed interest in engaging in further work on design formalities and procedures.

193. The Delegation of Ecuador explained that the national office had set up an industrial design and three-dimensional mark database. The current number of design registrations was 197. However, a greater number of applications had been filed. The Delegation noted that in order to harmonize the criteria for examination and granting of design rights, new applications were submitted for consultation to the Directorate of Patents of the national office.

194. The Delegation of Brazil explained that the design registration system in Brazil was fast and simple. The average time for an application to be examined was two months. The Delegation was interested in learning about the experiences and legal systems applied in other countries. However, the Delegation did not believe that it was timely to establish a new treaty on this matter.

195. The Committee agreed to an exchange of information with a view towards promoting better understanding of the various systems. In order to do this the Committee requested the Secretariat to develop a questionnaire relating to the formalities of industrial design registration, for consideration at the next session.

*Industrial Designs and Their Relation with Works of Applied Art and
Three-Dimensional Marks*

196. The discussion was based on document SCT/9/6.

197. The Delegation of Norway proposed to expand document SCT/9/6. The Delegation said that the discussion should not be confined to the relationship between industrial designs and three-dimensional marks but cover all borderlines between industrial designs and trademarks. The relationship between industrial design protection for ornamentation, graphic symbols and icons, and the protection of figurative marks, as well as the relation between the protection of get-up and trade dress could be considered. The Delegation felt that, while there were similarities as to protected subject matter, the scope of industrial design and trademark rights differed. It proposed that the issue be added to the list of items for future work and indicated two approaches that could be taken in this respect. On the one hand, the Secretariat could be asked to prepare a document identifying all borderlines between industrial designs and trademarks. On the other hand, questions on substantive matters could be added to a questionnaire relating to the formalities of industrial design registration which would be developed by the Secretariat.

198. The Delegation of Turkey expressed support for the proposal made by the Delegation of Norway. The Delegation said that not only three-dimensional objects but also other subject matter, that could be registered as an industrial design, such as drawings, should be included in the further work on this issue.

199. The Delegation of the Russian Federation informed the Committee that cross-cutting issues concerning the law of trademarks and industrial designs were currently dealt with in the Russian Federation. The Delegation pointed out that, for this reason, it would be interested in discussing the issue of the relationship between industrial designs and trademarks in the SCT.

200. The Representative of the European Community expressed support for work on the issue of industrial designs and trademarks. He proposed to update document SCT/9/6 in the light of current developments. As the question of three-dimensional shapes was of particular relevance in practice, he felt that further work in this area could focus on this question in order not to create too heavy a workload. The Representative indicated that a functional distinction between the indication of origin on the one hand, and esthetic design objectives on the other, could be of particular interest in this respect.

201. The Delegation of France recalled that, at the fifteenth session of the SCT, it had already indicated that it hoped work could continue on the issue of three-dimensional marks and their relation with industrial designs. The Delegation expressed support for the proposal made by the Delegation of Norway. It believed that it would be useful to expand and update document SCT/9/6. With regard to the situation in France, for instance, the national legislation of July 2001 was not reflected in document SCT/9/6.

202. The Delegation of Switzerland underlined the necessity to analyze the relationship between industrial designs and three-dimensional marks. In this regard, document SCT/9/6 and the replies to the Questionnaire on Trademark Law and Practice, as summarized in document WIPO/STrad/INF/1, could serve as a basis. The Delegation expressed the view that an update of document SCT/9/6 would be useful. It agreed with the Representative of the European Community that this update should focus on well-defined topics, such as the exclusion of functional shapes and a comparison of grounds for refusal. The Delegation indicated that the study of the relation between three-dimensional marks and industrial designs presupposes a good understanding of the three-dimensional marks. The issue of new types of marks, accordingly, should be dealt with before turning to the issue of three-dimensional marks and industrial designs.

203. The Delegation of Slovenia expressed support for the interventions made by the Delegations of France and Switzerland. It recalled earlier interventions in the context of the discussion on new types of marks, in which it had already made clear that it attached particular importance to the question of the relationship between industrial designs and three-dimensional marks.

204. The Delegation of Brazil drew the attention of the Committee to the reference to “industrial designs and certain expressions of traditional knowledge” in the first paragraph of document SCT/9/6. The Delegation wondered whether the SCT had done any further work on this issue since its eighth session.

205. The Chair clarified that the SCT had not undertaken work in the area of industrial designs and expressions of traditional knowledge. He proposed to approach the issue of industrial designs and their relation with works of applied art and three-dimensional marks in two stages. First, a draft questionnaire relating to the formalities of industrial design registration could be expanded to cover substantive matters concerning the borderlines between all types of marks and industrial designs. The broadened draft questionnaire should be presented at the next session of the SCT. Second, an updated and expanded version of document SCT/9/6 should be prepared for the eighteenth session of the SCT.

206. The Delegation of Norway expressed support for the proposal made by the Chair.

207. The Delegation of Brazil believed that the issue was mature enough for further consideration. It pointed out that document SCT/9/6 should also be expanded in the direction of traditional knowledge. The Delegation recalled that this latter aspect had already been recognized during the eighth session of the SCT. Accordingly, it should be explicitly mentioned as an issue of further work.

208. The Chair proposed to clarify in his final conclusions that, in particular, the relationship between industrial designs and certain expressions of traditional knowledge constituted an area to be dealt with in greater detail in the updated and expanded version of document SCT/9/6.

209. The Delegation of Ireland stated that, instead of the expression “in particular”, it preferred a clarification that areas to be dealt with in greater detail “included” the issue of industrial designs and expressions of traditional knowledge.

210. The SCT requested the Secretariat to expand the draft questionnaire in order to further explore the borderlines between all types of marks and industrial designs.

211. The SCT further requested the Secretariat to expand and update document SCT/9/6 for consideration by the SCT at its eighteenth session in response to:

- submissions from SCT Members (to be submitted to the Secretariat by the end of April 2007) wanting areas to be dealt with in greater detail, including the relationship between industrial designs and certain expressions of traditional knowledge, such as works of handicraft;

- submissions from SCT Members (to be submitted to the Secretariat by the end of April 2007) concerning areas where the paper no longer corresponded with their law; and

- answers to the expanded questionnaire.

Agenda Item 7: Geographical Indications

212. The Chair noted that there were no working documents or proposals for discussion at this meeting.

213. The Chair concluded that this item would remain on the agenda as one of the three standing items, i.e., trademarks, industrial designs and geographical indications.

Agenda Item 8: Summary by the Chair

214. The Chair suggested to add, after the word “Members”, the following sentence to the first subparagraph under paragraph 28 “(to be submitted to the Secretariat by the end of April 2007)”.

215. The Chair also suggested to replace the wording “The Chair concluded”, at the beginning of paragraph 29 for “The Committee agreed”, and to reverse the order of paragraphs 29 and 30.

216. The Standing Committee adopted the draft of the Summary by the Chair contained in document SCT/16/8 Prov. with the modifications suggested by the Chair.

Seventeenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/17)

217. The Chair announced as tentative dates for SCT/17, May 7 to 11, 2007.

Agenda Item 9: Closing of the Session

218. The Chair closed the sixteenth session of the Standing Committee.

[Annex I follows]

WIPO



E

SCT/16/8

ORIGINAL: English

DATE: November 17, 2006

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Sixteenth Session
Geneva, November 13 to 17, 2006

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. Mr. Ernesto Rubio, Assistant Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the delegates on behalf of the Director General of WIPO.

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

2. Mr. Michael Arblaster (Australia) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT). Mr. Maximiliano Santa Cruz (Chile) and Mrs. Karima Farah (Morocco) were elected as Vice-Chairs.

Agenda Item 3: Adoption of the Agenda

3. The SCT adopted the Draft Agenda (document SCT/16/1 Prov.2) without modifications.

Agenda Item 4: Adoption of the Draft Report of the Fifteenth Session

4. The SCT adopted the Draft Report (document SCT/15/5 Prov.2) without modifications.

Agenda Item 5: Trademarks

Questionnaire on Trademark Law and Practice

5. The SCT took note of document WIPO/Strad/INF/1.
6. The Chair concluded that this document would be updated periodically on the basis of information provided by SCT Members.

New Types of Marks

7. Discussion was based on document SCT/16/2.
8. In relation to new types of marks, the SCT agreed to build upon document SCT/16/2 by undertaking further work in two areas:
 - the representation and description of these signs; and
 - the application of trademark principles to them.
9. The SCT agreed that it would ask the Secretariat to develop two papers for discussion at the next session based on submissions from SCT Members (to be submitted to the Secretariat by January 7, 2007):
 - a paper setting out existing methods of representation and description of new types of marks in SCT Members, identifying where there are areas of convergence and any issues raised including the possibility of additional costs, particularly in developing countries;
 - a paper exploring in greater detail the relation of established trademark principles to new types of marks. All principles including, *inter alia*, functionality, specialty and distinctiveness would be considered, as well as issues of public interest, including safeguarding the public domain.

Marks and International Nonproprietary Names for Pharmaceutical Substances (INNs)

10. Discussion was based on document SCT/16/3.
11. The Committee approved the proposals outlined in paragraphs 9 to 11 of document SCT/16/3.

Trademark Opposition Procedures

12. Discussion was based on document SCT/16/4.
13. The Committee agreed to ask the Secretariat to prepare a working document on trademark opposition procedures for discussion at the next session, based on submissions by SCT Members (to be submitted to the Secretariat by January 7, 2007), to facilitate an exchange of information in order to identify key learnings.
14. Submissions would focus on providing information about opposition procedures, grounds of opposition, SCT Members' experience with pre-registration or post-registration opposition, and on a discussion of the relationship between a particular type of examination system and the related opposition procedure.

Trademarks and Their Relation With Literary and Artistic Works

15. Discussion was based on document SCT/16/5.
16. The SCT agreed to ask the Secretariat to develop a paper for consideration by the SCT at its eighteenth session, based, *inter alia*, on submissions by SCT Members (to be submitted to the Secretariat by the end of April 2007), providing an overview of jurisprudence on the overlap between copyright and trademarks, including new types of marks, with a particular focus on identifying existing and potential problems.

Article 6ter of the Paris Convention

17. Discussion was based on document SCT/15/3.
18. The SCT agreed to request the Secretariat to prepare a working document for consideration by the SCT at the next session, dealing with certain procedural aspects of Article 6ter communications, in particular:
 - information on the nature of goods and services on which official signs and hallmarks indicating control and warranty are used;
 - information concerning the constituting charter or agreement of international intergovernmental organizations availing themselves of Article 6ter(1)(b);
 - relevant contact details concerning a party requesting a communication under Article 6ter;
 - ways of making the content of Article 6ter notifications available through means of electronic communication; and
 - draft forms for requesting communications.

19. The Committee noted that there were still some areas where clarification would be beneficial, namely:

- clarification of eligible subject matter;
- duration of protection (term);
- grounds of refusal;
- effect of prior trademark rights;
- role of the International Bureau as intermediary;
- procedure for withdrawal of a communication;
- clear understanding of the status of the database.

20. The Committee agreed to request the Secretariat to provide further information about these issues as a second part of the paper being prepared on Article 6ter for the next session.

Communication from the Permanent Mission of Brazil

21. Discussion was based on document SCT/16/7.

22. The Committee noted the “Non-Exhaustive List of Customary Names Used in Brazil Associated with Biodiversity”, presented by the Delegation of Brazil. The Committee thanked that Delegation for the substantial work done and for bringing this list to the Committee’s attention.

23. The Committee also agreed that the Secretariat would maintain that list as an SCT paper, adding material submitted by other delegations.

Agenda Item 6: Industrial Designs

Formalities Concerning Procedures for Design Registration

24. Discussion was based on document SCT/16/6.

25. The Committee agreed to an exchange of information with a view towards promoting better understanding of the various systems. In order to do this the Committee requested the Secretariat to develop a questionnaire relating to the formalities of industrial design registration, for consideration at the next session.

*Industrial Designs and Their Relation with Works of Applied Art and
Three-Dimensional Marks*

26. Discussion was based on document SCT/9/6.
27. The SCT requested the Secretariat to expand the draft questionnaire in order to further explore the borderlines between all types of marks and industrial designs.
28. The SCT further requested the Secretariat to expand and update document SCT/9/6 for consideration by the SCT at its eighteenth session in response to:
- submissions from SCT Members (to be submitted to the Secretariat by the end of April 2007) wanting areas to be dealt with in greater detail, including the relationship between industrial designs and certain expressions of traditional knowledge, such as works of handicraft;
 - submissions from SCT Members (to be submitted to the Secretariat by the end of April 2007) concerning areas where the paper no longer corresponded with their law; and
 - answers to the expanded questionnaire.

Agenda Item 7: Geographical Indications

29. The Chair noted that there were no working documents or proposals for discussion at this meeting.
30. The Committee agreed that this item would remain on the agenda as one of the three standing items, i.e., trademarks, industrial designs and geographical indications.

*Seventeenth Session of the Standing Committee on the Law of Trademarks, Industrial
Designs and Geographical Indications (SCT/17)*

31. The Chair announced as tentative dates for SCT/17, May 7 to 11, 2007.

[Annex II follows]

ANNEX II

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États)
(in the alphabetical order of the names in French of the States)

AFRIQUE DU SUD/SOUTH AFRICA

Victoria Ntombentle Nosizwe DIDISHE (Mrs.), Assistant Registrar, Companies and Intellectual Property Registration Office (CIPRO), Department of Trade and Industry, Pretoria
<vdidishe@cipro.gov.za>

Simphiwe NCWANA, Manager, Trade Marks Examinations and Acceptance, Companies and Intellectual Property Registration Office (CIPRO), Department of Trade and Industry, Pretoria
<sncwana@cipro.gov.za>

Simon Z. QOBO, First Secretary, Permanent Mission, Geneva

ALGÉRIE/ALGERIA

Boumediene MAHI, secrétaire diplomatique, Mission permanente, Genève

ALLEMAGNE/GERMANY

Franziska RAABE (Mrs.), Counsellor, Division for Trade Mark Law, Federal Ministry of Justice, Berlin
<raabe-fr@bmj.bund.de>

Carolin HÜBENETT (Ms.), Head, International Registrations Team, Trade Marks, Utility Models and Industrial Designs, Patent and Trade Mark Office, Munich
<carolin.hubenett@dpma.de>

ARABIE SAOUDITE/SAUDI ARABIA

Nawaf ALMUTAIRI, Director, Trade Marks Section, Ministry of Commerce and Industry, Riyadh

ARGENTINE/ARGENTINA

Alberto USIETO BLANCO, Asesor Jurídico, Dirección de Asuntos Legales, Instituto Nacional de la Propiedad Industrial (INPI), Buenos Aires
<ausietoblanco@utdt.edu>

Inés Gabriela FASTAME (Srta.), Secretaria de Embajada, Misión Permanente, Ginebra
<ines.fastame@ties.itu.int>

ARMÉNIE/ARMENIA

Nune YEGANYAN (Miss), Head, Trademarks and Industrial Designs Department, Intellectual Property Agency, Yerevan
<cright@cornet.am><trademark@cornet.am>

AUSTRALIE/AUSTRALIA

Ruth MACKAY (Ms.), Registrar, Trade Marks and Designs, IP Australia, Woden ACT
<ruth.mackay@ipaaustralia.gov.au>

Michael ARBLASTER, Deputy Registrar, Trade Marks and Designs, Hearings and Legislation, IP Australia, Woden ACT
<michael.arblaster@ipaaustralia.gov.au>

Julie BAXTER (Ms.), Policy Officer, Trade Mark Hearings and Legislation, IP Australia, Woden ACT
<julie.baxter@ipaaustralia.gov.au>

Tegan BRINK (Mrs.), Second Secretary, Permanent Mission to the WTO, Geneva
<tegan.brink@dfat.gov.au>

AUTRICHE/AUSTRIA

Petra ASPERGER (Ms.), Deputy Head, International Trademarks, Legal Department, Austrian Patent Office, Vienna
<petra.asperger@patentamt.at>

BANGLADESH

Nayem U. AHMED, Second Secretary, Permanent Mission, Geneva
<nayem.ahmed@ties.itu.int>

BARBADE/BARBADOS

Corlita BABB-SCHAEFER (Mrs.), Counsellor, Permanent Mission, Geneva
<cbabb-shaefer@foreign.gov.bb>

BÉLARUS/BELARUS

Eugeny ZINKEVICH, chef de la Division des marques, Centre national de la propriété
intellectuelle, Minsk
<e.zinkevich@belpatent.gin.by>

BELGIQUE/BELGIUM

Leen DE CORT, attaché, Service des affaires juridiques et internationales, Direction générale
de la régulation et de l'organisation du marché, Office de la propriété intellectuelle, Bruxelles
<leen.decort@economie.fgov.be>

BÉNIN/BENIN

Yao AMOUSSOU, premier conseiller, Mission permanente, Genève
<amoussouy2000@yahoo.fr>

BOSNIE-HERZÉGOVINE/BOSNIA AND HERZEGOVINA

Lidija VIGNJEVIĆ (Ms.), Director, Institute for Intellectual Property of Bosnia and
Herzegovina, Sarajevo
<l_vignjevic@yahoo.com>

BRÉSIL/BRAZIL

Guilherme de AGUIAR PATRIOTA, Counsellor, Permanent Mission, Geneva

Cristiano FRANCO BERBERT, Second Secretary, Permanent Mission, Geneva

Maria Lucia MASCOTTE (Mrs.), General Trademark Coordinator II, Trademark Directorate, National Institute of Industrial Property (INPI), Ministry of Development, Industry and Foreign Trade, Rio de Janeiro
<malu@inpi.gov.br>

Renato GURGEL, Second Secretary, Intellectual Property Division, Ministry of Foreign Affairs, Rio de Janeiro
<rgurgel@mre.gov.br>

Suzana BARROS GONÇALVES (Mrs.), Trademark Analyst, Trademark Directorate, National Institute of Industrial Property (INPI), Ministry of Development, Industry and Foreign Trade, Rio de Janeiro
<suzanabg@inpi.gov.br>

Bivanilda ALMEIDA TAPIAS (Sra.), Coordinator, Department of Intellectual Property and Agriculture Technology, Secretariat for the Development of Agriculture and Cooperativism, Ministry of Agriculture, Livestock and Food Supply, Brasília
<bivanilda@agricultura.gov.br>

BULGARIE/BULGARIA

Dobrinka Dyankova DOBREVA (Mrs.), Director, Directorate for Examination of Marks and Geographical Indications, Patent Office of the Republic of Bulgaria, Sofia
<ddobрева@bpo.bg>

Dessislava PARUSHEVA (Mrs.), Second Secretary, Permanent Mission, Geneva
<d.parusheva@mission-bulgaria.ch>

CAMBODGE/CAMBODIA

Sovicheat PENN, Deputy Director, Intellectual Property Department, Ministry of Commerce, Phnom Penh
<sovicheatpenn@yahoo.com>

CANADA

Lisa POWER (Ms.), Director, Trade Marks Branch, Canadian Intellectual Property Office (CIPO), Department of Industry Canada, Québec
<power.lisa@ic.gc.ca>

J. Bruce RICHARDSON, Policy Analyst, Intellectual Property Policy Directorate, Canadian Intellectual Property Office (CIPO), Department of Industry Canada, Québec
<richardson.bruce@ic.gc.ca>

Dominique HENRIE (Ms.), Legal Counsel to the Canadian Intellectual Property Office, Department of Justice, Québec
<henrie.dominique@ic.gc.ca>

CHILI/CHILE

Maximiliano SANTA CRUZ, Counsellor, Permanent Mission to the WTO, Geneva

CHINE/CHINA

AN Qinghu, Director General, Trademark Office, State Administration for Industry and Commerce (SAIC), Beijing
<waiban.sbj@saic.gov.cn>

CHEN Yong Sheng, General Affairs Division, Trademark Office, State Administration for Industry and Commerce (SAIC), Beijing
<cysh2008@hotmail.com>

XIE Dongwei, Trademark Office, Legal Affairs Division, State Administration for Industry and Commerce (SAIC), Beijing
<xiedongwei@tom.com>

COLOMBIE/COLOMBIA

Martha Irma ALARCÓN LOPEZ (Mrs.), Minister Counsellor, Permanent Mission, Geneva

CONGO

Delphine BIKOUTA (Mme), premier conseiller, Mission permanente, Genève

COSTA RICA

Carlos GARBANZO, Ministro Consejero, Misión Permanente, Ginebra
<carlos.garbanzo@ties.itu.int>

CROATIE/CROATIA

Višnja KUZMANOVIĆ (Mrs.), Head, Section for International Registration of Trademarks,
State Intellectual Property Office, Zagreb
<visnja.kuzmanovic@dziv.hr>

Josip PERVAN, First Secretary, Permanent Mission, Geneva

DANEMARK/DENMARK

Lene Juhl KJERRUMGAARD (Mrs.), Legal Specialist, Danish Patent and Trademark Office,
Ministry of Economic and Business Affairs, Taastrup
<pjk@dkpto.dk>

Anette TOFTENG (Mrs), Legal Adviser Trademarks, Danish Patent and Trademark Office,
Ministry of Economic and Business Affairs, Taastrup
<aba@dkpto.dk>

ÉGYPTE/EGYPT

Ragui EL-ETREBY, First Secretary, Permanent Mission, Geneva
<ragui.eletreby@ties.itu.int>

EL SALVADOR

Martha Evelyn MENJIVAR CORTEZ (Srta.), Consejera, Misión Permanente, Ginebra
<emenjivar@minec.gob.sv>

ÉQUATEUR/ECUADOR

Mauricio MONTALVO, Ambassador, Permanent Representative, Permanent Mission,
Geneva

Elizabeth Wilma RIVADENEIRA VEGA (Sra.), Examinadora de forma 3, Dirección de
Marcas, Instituto Ecuatoriano de la Propiedad Intelectual (IEPI), Quito
<chabelirivas@yahoo.es>

Luis VAYAS VALDIVIESO, First Secretary, Permanent Mission, Geneva
<onuginebra@mrrree.gov.ec>

ESPAGNE/SPAIN

José María DEL CORRAL PERALES, Subdirector General Adjunto, Departamento de Signos Distinctivos, Oficina Española de Patentes y Marcas, Ministerio de Industria, Turismo y Comercio, Madrid
<josem.delcorral@oepm.es>

ESTONIE/ESTONIA

Ingrid MATSINA (Ms.), Deputy Head, Trademark Department, Estonian Patent Office, Tallinn
<ingrid.matsina@epa.ee>

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Amy P. COTTON (Mrs.), Attorney-Advisor, Office of International Relations, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria
<amy.cotton@uspto.gov>

Nancy L. OMELKO (Ms.), Attorney-Advisor, Office of International Relations, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria
<nancy.omelko@uspto.gov>

Marsh SHARON (Ms.), Deputy Commissioner for Trademark Policy, Office of International Relations, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria
<sharon.marsh@uspto.gov>

David MORFESI, Intellectual Property Attaché, Executive Office of the President, Permanent Mission to the WTO, Geneva
<david_morfesi@ustr.eop.gov>

ÉTHIOPIE/ETHIOPIA

Eftihia MARIO VENETSIA (Miss), Director, Trademark Directorate, Ethiopian Intellectual Property Office (EIPO), Addis Ababa
<eipo@ethionet.et><eftihiamr@yahoo.com>

EX-RÉPUBLIQUE YOUGOSLAVE DE MACÉDOINE/THE FORMER YUGOSLAV
REPUBLIC OF MACEDONIA

Simčo SIMJANOVSKI, Head, Department for Trademark, Industrial Design, Appellation of Origin and Geographical Indication, State Office of Industrial Property (SOIP), Skopje
<simcos@ippo.gov.mk>/<mail@ippo.gov.mk>

Biljana LEKIK (Mrs.), Deputy Head, Department for Trademark, Industrial Design, Appellation of Origin and Geographical Indications, State Office of Industrial Property (SOIP), Skopje
<biljanal@ippo.gov.mk>

FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

Liubov KIRIY (Mrs.), Director, Legal Protection of Intellectual Property Department, Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow
<lkiriy@rupto.ru>

Svetlana GORLENKO (Ms.), Assistant Director, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

FINLANDE/FINLAND

Päivi RAATIKAINEN (Ms.), Deputy Director, Trademarks and Designs, National Board of Patents and Registration, Helsinki
<paivi.raatikainen@prh.fi>

Hilkka NIEMIVUO (Ms.), Deputy Head, Trademarks and Designs Division, National Board of Patents and Registration, Helsinki
<hilkka.niemivuo@prh.fi>

Jaakko Reino Mikael RITVALA, Senior Advisor, Ministry of Trade and Industry, Helsinki
<jaakko.ritvala@ktm.fi>

Sami SUNILA, Senior Government Secretary, Ministry of Trade and Industry, Helsinki
<sami.sunila@ktm.fi>

FRANCE

Marianne CANTET (Mlle), chargée de mission, Service des affaires européennes et internationales, Institut national de la propriété industrielle (INPI), Paris
<mariancetet@inpi.fr>

Christine BONIN (Mlle), chargée de mission, Service des affaires juridiques et contentieuses, Institut national de la propriété industrielle (INPI), Paris
<cbonin@inpi.fr>

GABON

Rose MILENGOUE (Mlle), chargée d'études, Ministère du commerce, de l'industrie, chargé de la promotion des investissements et de l'intégration régionale, Centre de propriété industrielle du Gabon (CEPIG), Libreville
<milengouetrose@yahoo.fr>

GRÈCE/GREECE

Stella KYRIAKOU (Mrs.), Attaché, Permanent Mission, Geneva
<stella.kyriakou@mfa.gr>

GUATEMALA

Lorena BOLAÑOS (Sra.), Consejera, Misión Permanente ante la OMC, Ginebra
<lorena.mision@wtoguatemala.ch>

HAÏTI/HAITI

Pierre Mary-Guy SAINT-AMOUR, conseiller, Mission permanente, Genève

HONGRIE/HUNGARY

Imre GONDA, Head, National Trademark Section, Trademark, Model and Design Department, Hungarian Patent Office, Budapest
<imre.gonda@hpo.hu>

INDONÉSIE/INDONESIA

Emawati JUNUS (Mrs.), Director, Trademarks, Directorate General of Intellectual Property Rights, Ministry of Law and Human Rights, Tangerang
<emawati@dgip.go.id>

IRAN (RÉPUBLIQUE ISLAMIQUE D')/IRAN (ISLAMIC REPUBLIC OF)

Zahra BAHRAINI (Miss), Senior Expert of Trademark, Registration Office for Companies and Industrial Property, State Organization for Registration of Deeds and Properties, Tehran
<zahrabahraini@yahoo.com>

IRAQ

Ahmed AL-NAKASH, Third Secretary, Permanent Mission, Geneva
<mission.iraq@ties.itu.int>

IRLANDE/IRELAND

Frank BUTLER, Higher Executive Officer, Intellectual Property Unit, Department of Enterprise, Trade and Employment, Dublin
<frank_butler@entemp.ie>

ISRAËL/ISRAEL

Sorin Eugen MASSLER, Director, Industrial Designs Department, Israel Patent Office, Ministry of Justice, Jerusalem
<sorinm@justice.gov.il>

ITALIE/ITALY

Sante PAPARO, Director, Trademark Office, Italian Patent and Trademark Office, Directorate General of Industrial Production, Ministry of Productive Activities, Rome
<sante.paparo@ministeroattivitaproduttive.it>

Thomas MICARELLI, Stagiaire, Permanent Mission, Geneva
<thomas.micarelli@gmail.com>

JAMAHIRIYA ARABE LIBYENNE/LIBYAN ARAB JAMAHIRIYA

Hanan Bahgat ALTURGMAN (Mrs.), Head, Intellectual Property Division, National Bureau for Research and Development (NBRD), Tripoli
<hanan_alturgman@yahoo.com>

JAMAÏQUE/JAMAICA

Andrea DUBIDAD-DIXON (Mrs.), First Secretary, Permanent Mission, Geneva

JAPON/JAPAN

Fumihiko HAYAKAWA, Deputy Director, International Affairs Division, General Affairs Department, Japan Patent Office (JPO), Tokyo
<hayakawa-fumihiko@jpo.go.jp>

Kazuyuki TAKANO, Examiner, Trademark Division, Trademark Design and Administrative Affairs Department, Japan Patent Office (JPO), Tokyo
<takano-kazuyuki@jpo.go.jp>

Daisuke KUBOTA, Design Examiner, Trademark Design and Administrative Affairs Department, Japan Patent Office (JPO), Tokyo
<kubota-daisuke@jpo.go.jp>

Kazuyuki TAKANO, Examiner, Trademark Division, Trademark Design and Administrative Affairs Department, Japan Patent Office (JPO), Tokyo
<takano-kazuyuki@jpo.go.jp>

Kenichiro NATSUME, First Secretary, Permanent Mission, Geneva

JORDANIE/JORDAN

Bashar ABU TALEB, Second Secretary, Permanent Mission, Geneva
<braleb@jordanmission.ch>

KENYA

Joseph Mutuku MBEVA, Chief Patents Examiner, Kenya Industrial Property Institute (KIPI), Ministry of Trade and Industry, Nairobi
<mbevajtm@yahoo.co.uk>

Sylvance Anderson SANGE, Chief Trademarks Examiner, Kenya Industrial Property Institute (KIPI), Ministry of Trade and Industry, Nairobi
<sangesyl@yahoo.co.uk><ssange@kipi.go.ke><inform@kipi.go.ke>

KOWEÏT/KUWAIT

Nefal AL-DOESARI, Director, International Organization Department, Ministry of Commerce and Industry, Safat

Ahmad AL-MUTAIRI, Controller, Trademarks and Patent Department, Ministry of Commerce and Industry, Safat
<eng_afhm@yahoo.com>

Hamad AL-GHANIM, Assistant Undersecretary, Ministry of Commerce and Industry, Safat
<hamad@moci-gov-kw>

LETTONIE/LATVIA

Dace LIBERTE (Ms.), Head, Department of Trademarks and Industrial Designs, Patent Office, Riga
<dace@lrpv.lv>

LITUANIE/LITHUANIA

Digna ZINKEVIČIENĖ (Ms.), Director, Trademarks and Design Department, State Patent Bureau, Vilnius
<d.zinkeviciene@vpb.lt>

MADAGASCAR

Henri Juvin RAVELOARISON, chef du Service des marques et des noms commerciaux, Office malgache de la propriété industrielle (OMAPI), Antananarivo
<omapi@wanadoo.mg>

MALAISIE/MALAYSIA

Azwa Affendi BAKHTIAR, Second Secretary, Permanent Mission, Geneva

MALI

Almouctar Baba KOUNTA, chargé des signes distinctifs, Centre malien de promotion de la propriété industrielle (CEMAPI), Ministère de l'industrie et du commerce, Bamako
<mbkounta@yahoo.fr>

MAROC/MOROCCO

Karima FARAH (Mme), chef du Service des marques, Département noms commerciaux et marques, Office marocain de la propriété industrielle et commerciale (OMPIC), Casablanca
<farah@ompic.org.ma>

MEXIQUE/MEXICO

José Alberto MONJARÁS OSORIO, Subdirector, División de Servicios Legales, Registrales e Indicaciones Geográficas, Instituto Mexicano de la Propiedad Industrial (INPI), México
<amojaras@impi.gob.mx>

MOLDOVA

Ion DANILIUC, Deputy Director General, State Agency on Intellectual Property (AGEPI),
Kishinev
<ion.daniliuc@agepi.md><office@agepi.md>

Victoria BLIUC (Mrs.), Director, Trademark and Industrial Property Department, State
Agency on Intellectual Property (AGEPI), Kishinev

Ludmila GOREMÎCHINA (Mrs.), Head, Industrial Design Section, State Agency on
Intellectual Property (AGEPI), Kishinev
<lgoremichina@yahoo.com>

MYANMAR

Hin NWE AYE (Ms.), Assistant Director, WIPO Section, Ministry of Science and
Technology, Yangon
<most16@myanmar.com.mm><hninnweaye@sailormoon.com>

NÉPAL/NEPAL

Niranjan BARAL, Joint Secretary, Ministry of Industry, Commerce and Supplies, Kathmandu
<nibaral@hotmail.com>

NORVÈGE/NORWAY

Debbie RØNNING (Ms.), Senior Legal Advisor, Legal and Political Affairs, Norwegian
Patent Office (NPO), Oslo
<dro@patentstyret.no>

Solrun DOLVA (Ms.), Head, Trademark Section 1, Norwegian Patent Office (NPO), Oslo

OUGANDA/UGANDA

Anne NABAASA (Ms.), Third Secretary, Permanent Mission, Geneva
<mission.uganda@ties.itu.int>

PARAGUAY

Patricia FRUTOS (Mrs.), Counsellor, Permanent Mission, Geneva

PAYS-BAS/NETHERLANDS

Angela VAN DER MEER (Mrs.), Senior Policy Advisor, Innovation Department, Ministry of Economic Affairs, The Hague
<a.a.m.vandermeer@minez.nl>

Irene Pauline Helene KNOBEN (Mrs.), First Secretary, Permanent Mission, Geneva
<irene.knoben@minbuza.nl>

POLOGNE/POLAND

Justyna KARSZ (Mrs.), Expert, Ministry of Finance, Warsaw
<justyna.karsz@mofnet.gov.pl>

Sergiusz SIDOROWICZ, Third Secretary, Permanent Mission, Geneva
<sergiusz.sidorowicz@ties.itu.int>

PORTUGAL

Maria Joana Marques CLETO (Mme), chef du Département des marques et dessins ou modèles, Institut national de la propriété industrielle (INPI), Ministère de la justice, Lisbonne
<jmcleto@inpi.pt>

José Eduardo SOUSA, premier secrétaire, Mission permanente, Genève
<jguedessousa@bluewin.ch>

QATAR

Ahmed Youssef AL-JEFAIRI, Head, Industrial Property Office, Ministry of Economy and Commerce, Doha
<ajufairi@mec.gov.qa>

Masheal AL MOADHADI, Examiner, Industrial Property Office, Ministry of Economy and Commerce, Doha

RÉPUBLIQUE ARABE SYRIENNE/SYRIAN ARAB REPUBLIC

Hiam DIAB, Head, Department Registration of Licensing Section, Ministry of Supply and Internal Trade, Damascus
<tareqsa@hotmail.com><hiam-diab@yahoo.com>

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

Deok-Cheol CHOI, Director, Trademark and Design Examination Policy Team, Korean Intellectual Property Office (KIPO), Daejeon City

Ji-Maeng KIM, Deputy Director, Trademark and Design Examination Policy Team, Korean Intellectual Property Office (KIPO), Daejeon City
<jimaengk@kipo.go.kr>

Myung-Kyu LEE, Presiding Judge, Incheon District Court, Incheon
<leemk@scourt.go.kr>

Joo-Ik PARK, First Secretary, Permanent Mission, Geneva
<hang7200@dreamwiz.com>

RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Kristina KODÁDKOVÁ (Miss), Head, Trademarks Department, Industrial Property Office, Prague
<kkodadkova@upv.cz>

Iveta MATAJOVÁ (Ms.), Head, Dispute Procedures Unit, Industrial Property Office, Prague
<imatajova@upv.cz>

Andrea PETRÁNKOVÁ (Ms.), Third Secretary, Permanent Mission, Geneva

ROUMANIE/ROMANIA

Liviu BULGÁR, directeur, Direction juridique et coopération internationale, Office d'État pour les inventions et les marques, Bucarest
<liviu.bulgar@osim.ro>

Cornelia Constanta MORARU (Mme), chef du Service juridique, Coopération internationale, Office d'État pour les inventions et les marques, Bucarest
<moraru.cornelia@osim.ro>

Alice Mihaela POSTĂVARU (Mme), chef de la Section des dessins et modèles industriels, Coopération internationale, Office d'État pour les inventions et les marques, Bucarest
<postavaru.alice@osim.ro>

Livia Cristina PUSCARAGIU (Mlle), deuxième secrétaire, Mission permanente, Genève

ROYAUME-UNI/UNITED KINGDOM

Stephen ROWAN, Director, Industrial Property Policy, Intellectual Property and Innovation Directorate, The Patent Office, Newport
<steve.rowan@patent.gov.uk>

Duncan WEARMOUTH, Director, Copyright, Intellectual Property and Innovation Directorate, The Patent Office, Newport
<duncan.wearmouth@patent.gov.uk>

Robin STOUT, Policy Advisor, Intellectual Property and Innovation Directorate, The Patent Office, Newport
<robin.stout@patent.gov.uk>

Mark JEFFERISS, Deputy Head, International Examination, *Ex-parte* Hearing Officer, The Patent Office, Newport
<mark.jefferiss@patent.gov.uk>

SERBIE/SERBIA

Mirela BOŠKOVIĆ (Miss), Senior Consultant, Trademark Department, Intellectual Property Office, Belgrade
<mboskovic@yupat.sv.gov.yu>

Radmila TEŠIĆ (Ms.), Senior Consultant, Trademark Department, Intellectual Property Office, Belgrade

SINGAPOUR/SINGAPORE

Li Choon LEE (Ms.), Director, Legal Counsel, Intellectual Property Office of Singapore (IPOS), Singapore

SLOVAQUIE/SLOVAKIA

Zdena HAJNALOVÁ (Mrs.), Director, Trademarks and Designs Department, Industrial Property Office, Banská Bystrica
<zhajnalova@indprop.gov.sk>

Ingrid MARUNIAKOVÁ (Mrs.), Director, Dispute Procedure Division, Industrial Property Office, Banská Bystrica
<imaruniakova@indprop.gov.sk>

SLOVÉNIE/SLOVENIA

Vesela VENIŠNIK (Mrs.), Head, Trademark and Design Department, Slovenian Intellectual Property Office (SIPO), Ljubljana
<v.venisnik@uil-sipo.si>

Andreja ČERNIVEC (Ms.), Senior Trademark Examiner, Slovenian Intellectual Property Office (SIPO), Ljubljana
<andreja.cernivec@uil-sipo.si>

SOUDAN/SUDAN

Nadia ABUBAKR KHALID MUDAWI (Mrs.), Legal Advisor, Registrar General of Intellectual Property, Ministry of Justice, Khartoum
<nadiamudawi@hotmail.com>

Mohamed Hassan KHAIR, Second Secretary, Permanent Mission, Geneva
<baashame@yahoo.com>

SUÈDE/SWEDEN

Göran SÖDERSTRÖM, Legal Adviser and Associate Judge of Appeal, Ministry of Justice, Stockholm
<goran.soderstrom@justice.ministry.se>

Magnus AHLGREN, Deputy Head, Designs and Trademark Department, Swedish Patent and Registration Office (SPRO), Stockholm
<magnus.ahlgren@prv.se>

SUISSE/SWITZERLAND

David LAMBERT, conseiller juridique, Service juridique, Institut fédéral de la propriété intellectuelle (IFPI), Berne
<david.lambert@ipi.ch>

Emmanuel PIAGET, conseiller juridique, Service juridique, Institut fédéral de la propriété intellectuelle (IFPI), Berne
<emmanuel.piaget@ipi.ch>

THAÏLANDE/THAILAND

Kawin NITIMONTREE, Intellectual Property Officer, Department of Intellectual Property (DIP), Ministry of Commerce, Nonthaburi

Supavadee CHOTIKAJAN, Second Secretary, Permanent Mission, Geneva
<supac@mfa.go.th>

TUNISIE/TUNISIA

Mokhtar HAMDI, sous-directeur, Département de la propriété industrielle, Institut national de la normalisation et de la propriété industrielle (INNORPI), Ministère de l'industrie et de l'énergie, Tunis
<inorpi@ati.tu>

TURQUIE/TURKEY

Mustafa DALKIRAN, Trademark Examiner, Turkish Patent Institute, Ankara
<mustafa.dalkiran@tpe.gov.tr>

Yesim BAYKAL (Mrs.), Legal Counsellor, Permanent Mission, Geneva
<yesim-baykal@mfa.gov.tr>

UKRAINE

Inna SHATOVA (Mrs.), Head, Intellectual Property Rights Section, State Department of Intellectual Property (SDIP), Ministry of Education and Science, Kyiv
<inna-shatova@sdip.vov.ua>

Vasyl BANNIKOV, Head, Section of Trademarks and Industrial Designs, Ukrainian Industrial Property Institute, Kyiv

VENEZUELA

Alesandro PINTO DAMIANI, Segundo Secretario, Misión Permanente, Ginebra

ZIMBABWE

Richard CHIBUWE, Counsellor, Permanent Mission, Geneva

COMMUNAUTÉS EUROPÉENNES (CE)* / EUROPEAN COMMUNITIES (EC)*

Tomas Lorenzo EICHENBERG, Administrator, Industrial Property, European Commission,
Brussels

<tomas.eichenberg@ext.ec.europa.eu>

Sergio BALIBREA SANCHO, Counsellor, Permanent Delegation, Geneva

<sergio.balibrea@ec.europa.eu>

Vincent O'REILLY, Director, Office for Harmonization in the Internal Market (Trade Marks
and Designs) (OHIM), Alicante

* Sur une décision du Comité permanent, les Communautés européennes ont obtenu le statut de membre sans droit de vote.

* Based on a decision of the Standing Committee, the European Communities were accorded member status without a right to vote.

II. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/
INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

ORGANISATION MONDIALE DE LA SANTÉ (OMS)/WORLD HEALTH
ORGANISATION (WHO)

Raffaella BALOCCO MATTAVELLI (Mrs.), INN Program Manager, Geneva
<baloccor@who.ch>

ORGANISATION AFRICAINE DE LA PROPRIÉTÉ INTELLECTUELLE
(OAPI)/AFRICAN INTELLECTUAL PROPERTY ORGANIZATION (OAPI)

Hassane YACOUBA KAFFA, chef du Service des signes distinctifs, Yaoundé
<hassane.kaffa@oapi.wipo.net><hykaffa@yahoo.fr>

ORGANISATION BENELUX DE LA PROPRIÉTÉ INTELLECTUELLE
(OBPI)/BENELUX ORGANISATION FOR INTELLECTUAL PROPERTY (BOIP)

Camille JANSSEN, juriste, La Haye
<cjanssen@boip.int>

ORGANISATION MONDIALE DU COMMERCE (OMC)/WORLD TRADE
ORGANIZATION (WTO)

Wolf MEIER-EWERT, Legal Affairs Officer, Intellectual Property Division, Geneva
<wolf.meier-ewert@wto.org>

III. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association américaine du droit de la propriété intellectuelle (AIPLA)/American Intellectual Property Law Association (AIPLA)

Jonathan W. RICHARDS, Chair, AIPLA Trademark Treaties and International Law Committee, Salt Lake City
<jrichards@wnlaw.com>

Association chinoise pour les marques (CTA)/China Trademark Association (CTA)

ZHUANG Peiji, Deputy Director, Tongda Trademark Service Center, State Administration for Industry and Commerce (SAIC), Beijing;
DING Li, Deputy Director, Zhongqi Trademark Development Centre, Beijing

Association communautaire du droit des marques (ECTA)/European Communities Trade Mark Association (ECTA)

Jan WREDE, Member, Law Committee, Antwerp
<info@desimonepartners.com>
Sandrine PETERS (Mrs.), Legal Co-ordinator, Antwerp
<sandrine.peters@ecta.org>

Association des industries de marques (AIM)/European Brands Association (AIM)

Jean BANGERTER, Representative, Brussels
<bangerter.jean@citycable.ch>

Association internationale des juristes pour le droit de la vigne et du vin (AIDV)/International Wine Law Association (AIDV)

Douglas REICHERT, Attorney-at-Law, Geneva
<dreichert@swissonline.ch>

Association internationale pour la protection de la propriété industrielle (AIPPI)/International Association for the Protection of Industrial Property (AIPPI)

Franck CUYPERS, Executive Director, Zurich
<f.cuypers@aippi.org>

Association internationale pour les marques (INTA)/International Trademark Association (INTA)

Bruno MACHADO, Representative, Geneva

Association internationale pour la promotion de l'enseignement et de la recherche en propriété intellectuelle (ATRIP)/International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP)

François CURCHOD, représentant permanent auprès de l'OMPI, Genolier
<francois.curchod@vtxnet.ch>

Association japonaise des conseils en brevets (JPAA)/Japan Patent Attorneys Association (JPAA)

Yasuko KUMON (Ms.), Executive Director, Trademark Committee, Tokyo

Association japonaise pour les marques (JTA)/Japan Trademark Association (JTA)
Keiko IIZUKA (Ms.), Co-Chair, International Activities Committee, Tokyo
<iizuka@soei-patent.co.jp>

Centre d'études internationales de la propriété industrielle (CEIPI)/Centre for International Industrial Property Studies (CEIPI)
François CURCHOD, représentant permanent auprès de l'OMPI, Genolier
<francois.curchod@vtxnet.ch>

Chambre de commerce internationale (CCI)/International Chamber of Commerce (ICC)
Gonçalo DE SAMPAIO, Intellectual Property Counsel, Cabinet J.E. Dias Costa Lda., Lisbon
<diascosta@jediascosta.pt>

Fédération internationale des conseils en propriété industrielle (FICPI)/International Federation of Industrial Property Attorneys (FICPI)
Gonçalo DE SAMPAIO, rapporteur, Groupe des marques, Cabinet J.E. Dias Costa Lda.,
Lisbonne
<diascosta@jediascosta.pt>

MARQUES (Association des propriétaires européens de marques de commerce)/MARQUES (Association of European Trademark Owners)
Jane COLLINS (Mrs.), Vice-Chairman, Bracknell

V. BUREAU/OFFICERS

Président/Chair:	Michael ARBLASTER (Australie/Australia)
Vice-présidents/Vice-Chairs:	Karima FARAH (Maroc/Morocco) Maximiliano SANTA CRUZ (Chili/Chile)
Secrétaire/Secretary:	Marcus HÖPPERGER

VI. **SECRETARIAT DE L'ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/
SECRETARIAT OF THE WORLD INTELLECTUAL
PROPERTY ORGANIZATION (WIPO)**

Ernesto RUBIO, sous-directeur général/Assistant Director General

Secteur des marques, des dessins et modèles industriels et des indications géographiques/Sector of Trademarks, Industrial Designs and Geographical Indications:

Octavio ESPINOSA, directeur-conseiller, Bureau du sous-directeur général/Director-Advisor, Office of the Assistant Director General

Marcus HÖPPERGER, directeur par intérim, Division du droit des marques, des dessins et modèles industriels et des indications géographiques/Acting Director, Trademarks, Industrial Designs and Geographical Indications Law Division

Päivi LÄHDESMÄKI (Mlle/Miss), juriste principale, Division du droit des marques, des dessins et modèles industriels et des indications géographiques/Senior Legal Officer, Trademarks, Industrial Designs and Geographical Indications Law Division

Martha PARRA FRIEDLI (Mme/Mrs.), juriste principale, Division du droit des marques, des dessins et modèles industriels et des indications géographiques/Senior Legal Officer, Trademarks, Industrial Designs and Geographical Indications Law Division

Martin SENFTLEBEN, administrateur adjoint, Division du droit des marques, des dessins et modèles industriels et des indications géographiques/Associate Officer, Trademarks, Industrial Designs and Geographical Indications Law Division

[End of Annex II and of document]