

WIPO



SCT/18/10

ORIGINAL: English

DATE: July 28, 2008

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Eighteenth Session
Geneva, November 12 to 16, 2007

REPORT*

adopted by the Standing Committee

* This report was adopted at the nineteenth 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 eighteenth session, in Geneva, from November 12 to 16, 2007.
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, Australia, Austria, Bangladesh, Belarus, Belgium, Brazil, Bulgaria, Cameroon, Canada, Chile, China, Colombia, Costa Rica, Croatia, Czech Republic, Cuba, Denmark, Dominican Republic, Ecuador, El Salvador, Estonia, Finland, France, Germany, Ghana, Greece, Hungary, Indonesia, Iran (Islamic Republic of), Iraq, Italy, Japan, Kenya, Kyrgyzstan, Latvia, Libyan Arab Jamahiriya, Lithuania, Malaysia, Mexico, Morocco, Moldova, Namibia, Netherlands, New Zealand, Norway, Oman, Panama, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sweden, Switzerland, Syrian Arab Republic, Thailand, The former Yugoslav Republic of Macedonia, Tunisia, Turkey, Ukraine, United Kingdom, United States of America, Uruguay (74). The European Community was 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) and the World Trade Organization (WTO) (3).
4. Representatives of the following international non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), German Association for Industrial Property and Copyright (GRUR), 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) and Japan Trademark Association (JTA) (11).
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: Adoption of the Agenda

9. The SCT adopted the Draft Agenda (document SCT/18/1 Prov.) with one modification as suggested by the Delegation of New Zealand, namely the addition of a new Agenda Item 7 entitled “Future Work”.

Agenda Item 3: Adoption of the Report of the Seventeenth Session

10. The SCT adopted the Draft Report of the Seventeenth Session (document SCT/17/8 Prov.) with modifications as requested by the Delegations of France (concerning paragraphs 67, 84 and 89), Romania (concerning paragraph 125), the United Kingdom (concerning paragraph 106) and the Representatives of the European Community (concerning paragraph 202) and the International Trademark Association (INTA) (concerning paragraphs 82 and 150).

Agenda Item 4: Trademarks

Methods of Representation and Description of Non-Traditional Marks

11. Discussion was based on documents SCT/17/2 and SCT/18/2.

12. The Chair recalled that at its seventeenth session, the SCT had discussed three types of non-traditional marks, namely three-dimensional, color *per se* and sound marks. The Chair also recalled that the SCT had asked the Secretariat to reflect the nature of that discussion in a new document setting out “key learnings” associated with those types of marks.

13. The Secretariat noted that the terminology used in document SCT/18/2 followed the advice given by the Standing Committee at its last session to replace “new types of marks” with “non-traditional marks”. The document focused on questions of representation and description of three-dimensional, color *per se* and sound marks, on the basis of the information provided by Members of the SCT at its seventeenth session and other information contained in the Questionnaire on Trademark Law and Practice and in individual contributions from the Member States. Regarding three-dimensional marks, two issues had been discussed at length, namely the size of the representations and the number of different views which may be required for a trademark application. With regard to color marks, this section distinguished between color claimed as a distinctive feature of a mark and color *per se* or single color marks and it also dealt with the possibility of using color codes as a form of identification. The section on sound marks distinguished between musical or other sounds and described various means that were accepted by Trademark Offices for the representation of those signs.

Three-Dimensional Marks

14. The Delegation of Bangladesh indicated that Offices might require additional views of the three-dimensional sign if they considered that a single view was not sufficient to demonstrate the features of the mark applied for. For this reason, the Delegation considered that the wording of the last sentence of paragraph 9 could limit that possibility for Offices.

15. The Delegation of Slovenia asked other delegations to share their experiences in relation to the number of views of the sign to be provided to the Office. The Delegation wondered whether in other Members, the Office had the capacity to decide if the applicant should provide one or several views and how many views should be published.

16. The Delegation of Panama expressed satisfaction with the work so far achieved by the Standing Committee in the area of non-traditional marks. However, the Delegation suggested that the SCT request the Secretariat to prepare a table summarizing the information contained in all preceding documents on this subject. One way of presenting such information in a more visible manner could be to place, next to each non-traditional mark, the choice of possible modes of representation. The table would be a useful and visually helpful synopsis of the information contained in the documents.

17. The Delegation of the Russian Federation declared that it might need additional time to study the document. The Delegation noted, however, that after a first reading it seemed that the SCT could request the Secretariat to supplement future documents with examples of various forms of representation of non-traditional marks. The Delegation further noted that the Russian Federation was in the process of drafting new legislation concerning procedures for the registration of these signs, the information contained in SCT documents was very useful in that process.

18. The Delegation of The former Yugoslav Republic of Macedonia stated that, according to national legislation, applicants were required to provide a two-dimensional presentation of the sign, to be placed in the 8 x 8 cm designated area in the application form. The shape should be shown by a single perspective view. If multiple views were provided, they were not published. National law did not require a written description of the features of the mark and if provided, it was not published. However, the Delegation asked for additional clarifications as to the practice of other Offices in this regard. In particular, whether the Office decided which views should be published if the applicant submitted several views.

19. The Delegation of Uruguay noted that it was advisable to allow a sufficient number of views of the three-dimensional sign to be provided. The number should be decided by the Office on a case-by-case basis, so as to ensure an appropriate and clear representation of the mark.

20. The Delegation of Bulgaria declared that national legislation did not limit the number of views to be submitted with a three-dimensional mark application. At the same time, that law provided that the number of views should be sufficient to allow a proper analysis by the Office on a case-by-case basis. Sometimes one view was considered sufficient, other times additional views were necessary. Also, during the examination, additional views could be required and all views submitted were published. In practice, applicants did not submit more than 4 or 5 views and there was no problem as to publication.

21. The Representative of GRUR noted that it seemed clear from the discussion at the current session and at previous sessions of the SCT that the requirements for the representation of three-dimensional and other types of marks differed substantially among Member States. Such differences seemed problematic for users seeking protection in more than one jurisdiction, particularly when the proper representation of the mark was a filing date requirement in the designated country. This led to the conclusion that efforts should be engaged to facilitate the filing of trademarks in more than one jurisdiction, for example by

suggesting that countries accept the representations which have been properly filed in the country of origin. Against this background, the Representative wondered whether the representation of a three-dimensional, or any other mark fell under the application of Article 6*quinquies* of the Paris Convention for the Protection of Industrial Property. The Representative also wondered whether the “*telle quelle*” principle established in that provision limited the power of Offices to reject such representations, allow or require additional ones, where those marks were subsequently applied for in other Paris Union members. The Representative further noted that there also seemed to be different representation requirements, in particular regarding the size of representations between offices of origin and the International Bureau of WIPO, which administered the Madrid system. Under that system, the size of the representation could not exceed 8 x 8 cm and only one view was allowed. The Representative wondered whether Members were authorized, under the Madrid system to refuse representations in Madrid applications and/or registrations which did not conform to their own internal legislation.

22. The Delegation of Colombia indicated that the national trademark Office distinguished between a picture or representation showing the three-dimensional mark from different perspectives and all other technical drawings or octagonal views which may be required for registration purposes. According to Office practice, only the first picture would be published. The Delegation informed the SCT that so called “mixed three-dimensional marks” had raised some concern among the examiners. Such marks were composed by a usual three-dimensional mark and other elements such as colors or labels. There seemed to be little information on how these signs should be assessed, and the Delegation believed that the SCT could also consider this issue as part of its future work.

23. The Chair noted that the issue raised by the Delegation of Colombia in relation to trademarks that contained more than one sign could be dealt with when the Standing Committee discussed the remainder of document SCT/17/2. Equally, the question raised by the Delegation of Slovenia regarding the number of views of the three-dimensional mark to be published could be dealt with in the section of that document dealing generally with issues of publication.

24. The Secretariat, referring to the issue raised by GRUR in relation to Article 6*quinquies* of the Paris Convention, recalled that it did not have the mandate to issue interpretations of the treaties administered by WIPO. Such interpretations were reserved to the Member States of the Paris Union. The Secretariat noted, however, that Article 6*quinquies* was a very special provision of the Paris Convention, which had given rise to abundant literature. In essence, the provision meant that trademarks which were duly registered in the country of origin should be accepted for filing and registered as they were in other countries of the Paris Union. This reference to the acceptance of the trademark “as is” or “*telle quelle*” in French, which was the original language of the Paris Convention, admitted a number of exceptions, which were indicated in paragraphs 2 and 3 of the provision. The question of whether Article 6*quinquies* applied to the type of representation of the sign, which might or might not be accepted by an Office as part of the registration procedure, seemed to refer to a different matter. In the specific case of three-dimensional marks, Member States could be in a position that they needed several views to determine the distinctive character of the mark. Thus, the interpretation of Article 6*quinquies* should point to the end result, which was acceptance of the sign for protection. With regard to the practice under the Madrid System for the International Registration of Marks, the Secretariat said that there was no specific requirement in relation to the number of views to be submitted, but there was a requirement regarding the

size of the reproduction (8 x 8 cm). The International Bureau of WIPO would accept a reproduction of the mark certified by the Office of origin, even if it contained several views. There might be an issue as to the clarity of such reproductions and the Office of a designated Contracting Party might refuse an application/registration on the basis that it could not determine the scope of protection of the mark. The International Bureau had also noted that Contracting Parties issued refusals on the grounds that the number of views contained in the international application did not meet the number of views required by that designated Contracting Party.

25. The Chair noted that although the SCT was not the forum to discuss the legal development of the Madrid system, to the extent that discussions were held in this forum on the convergence of laws and on minimizing burdens for users of the system across multiple jurisdictions, it seemed sensible to keep a parallel with the former discussions. The Chair also noted the explanation given on the Secretariat to the effect that there were jurisdictions in the context of the Madrid system which refused trademark applications on the grounds that the number of views did not match the number of views required in their national jurisdiction, although that was not a basis for refusal under the Common Regulations. The Chair further noted that, given the great diversity of approaches in this field, one possibility might be to suggest that one representation of the mark could be sufficient to secure a filing date, provided that, where an Office required other views, those views would be provided to clarify the state of the claims.

26. The Representative of GRUR said that an internationally accepted view on the interpretation of Article 6*quinquies* was that a sign which had been accepted for registration as a trademark in the country of origin could not be refused by other members of the Paris Union on the grounds that it was not a sign. This interpretation had traditionally been applied for word and device marks and it currently also applied to three-dimensional marks. The issue was, however, whether such an interpretation could apply to other non-traditional marks such as sound, taste or touch. On the question of whether Article 6*quinquies* should apply in relation to the requirement of furnishing one or more representations, the Representative thought that if one looked at it as just a formality issue, members of the Paris Union were free to require compliance with their domestic rules on the issue of formalities. However, it would be helpful to consider the suggestion by the Chair that a single representation should be sufficient for the purpose of securing the filing date, leaving members freedom to ask for more if they so wished. It was important nevertheless, to look at the kind of additional requirements which might be provided under national law. With regard to the required 8 x 8 cm size of the representations under the Madrid system, an issue could be raised as to whether it was necessary to maintain such a requirement in relation to non-traditional marks, namely three-dimensional or sound marks, for which there were either multiple views or oversize representations, such as the musical score. The Representative also said that members of the Madrid system should not be entitled to refuse a trademark which was properly registered internationally on the grounds that the representation did not comply with their national rules. However, as the Chair noted, this discussion belonged in a separate forum.

27. The Chair suggested that the Standing Committee discuss what should be the maximum requirements regarding the number of views of a three-dimensional mark to be submitted to the Office in order to secure the filing date.

28. The Delegation of Kenya said that this was an important question and depended on the types of procedures which were applied by Offices. In some cases, the number of views could not be considered as a simple question of formalities but rather a question which determined whether the sign applied for registration as a three-dimensional mark satisfied the test of distinctiveness. In the view of the Delegation, each Office should be free to determine the number of views required, on the basis of its own procedures.

29. The Chair said that this question should be discussed in greater detail. It seemed, however, that both the Regulations under the Trademark Law Treaty of 1994 and the Singapore Treaty of 2006 contained provisions to the effect that, where the application referred to a three-dimensional mark, the reproduction of the mark should consist of a two-dimensional graphic or photographic reproduction, but an Office might require additional reproductions thereafter.

30. The Representative of INTA supported the concerns expressed by the Representative of GRUR on the issue that a member of the Madrid Union could refuse an international registration on the basis that the number of reproductions of a three-dimensional mark did not correspond to the number of reproductions required under national law. The Representative hoped that this issue could be discussed in further detail by the Working Group for the Legal Development of the Madrid System.

31. The Representative of the JPAA said that it might be difficult and quite burdensome to customize applications depending on the requirements of each national jurisdiction. Therefore, it seemed desirable that there should be a minimum requirement, for example, that a single representation of a three-dimensional mark be enough to secure the filing date. This minimum requirement would be most welcome from the perspective of the users, even if at a later stage, when the mark was found to be not sufficiently clear, a national authority might issue an Office action requesting a further reproduction.

32. The Chair noted that in some cases, Offices required more than one representation because they considered that the scope of the rights being claimed was not clear. In particular, where the representation became indecipherable if reduced to an area of 8 x 8 cm, it seemed reasonable to seek for clarifications as to the scope of the rights.

33. The Delegation of Sweden said that it wished to make a broader remark, concerning not only the representation of three-dimensional marks, but more generally speaking, the need for harmonization of procedures among Offices, particularly when it came to the way in which they examined formalities and the importance of formalities in substantive examination and in determining, for example, distinctiveness. The Delegation noted that the national Office had been faced with a situation in which the six pictures provided with a trademark application were of such poor quality that the Office could no longer appreciate the distinctive character of the sign. In such a situation and given that the application had been made via the Madrid Protocol, the Office wondered whether or not it could refuse the application due to lack of distinctiveness. The Delegation further noted that there were a number of problematic areas, besides three-dimensional marks, for example holograms and moving marks, and for this reason it suggested to give priority to the analysis of formalities, methods of description and representation of these types of marks during the upcoming nineteenth and twentieth sessions of the SCT. The Delegation called upon members of the Standing Committee to take the Singapore Treaty as a standpoint for further discussion.

Color Marks

34. The Delegation of Slovenia said that in relation to color *per se* marks there seemed to be divergence among Offices on one important aspect, namely whether it was necessary to classify the figurative elements or shapes that contained the color representation. The Delegation noted that the practice of some Offices was to classify not only the color but also the geometrical figure in which the color was shown. The classification of figurative elements was important as it assisted users in carrying out searches. If those shapes were not classified, the mark was not accurately reflected and therefore the Delegation suggested looking into the experiences of other delegations in this field.

35. The Representative of the JPAA said that the method of representation of color marks was a very difficult issue. The Representative noted that a color mark was inherently not distinctive and usually became registrable only if it acquired secondary meaning. Thus, it was not appropriate to designate it by using a color code but the name of the color through which that mark acquired secondary meaning.

36. The Delegation of New Zealand wondered to what extent this question was already covered by the text of the Singapore Treaty on the Law of Trademarks.

Sound Marks

37. The Representative of INTA said that it might be interesting for the work of the Standing Committee to take stock of the experience of any country or organization which accepted or intended to accept digital recordings or other type of recordings of sounds as an alternative to a graphic representation of sound marks. The Representative noted that it would be particularly interesting to determine whether a recording was a real alternative to the graphic representation of sound or only an additional possibility.

38. The Representative of the European Community noted that in the European Community Trademark System it was possible, when filing electronically, to attach a sound file to a sound mark application. However, the sound file did not replace the graphic representation but only complemented it. The Representative added that the experience of the Office in this field was limited, since sound marks were still a very rare form of trademark application. The possibility to submit a sound file had been introduced as a response to concerns from applicants regarding the adequacy of the graphical representation and the new system seemed beneficial to users.

39. The Delegation of Panama said that the national Office had some experience regarding the registration of sound marks. In one case concerning an application for an animal sound, the applicant was required to indicate the type of sign in the application. The sound was also described and that description corresponded to a recording in cassette, which allowed the Office to properly register this mark.

40. The Delegation of Slovenia said that it had limited experience with sound marks as it had only registered two of those signs as trademarks. In such cases, the graphic representation was published and where the applicant provided a sound file (such as an MP3 file), it was also made available on the Office Internet site. However, the applicant was not required to provide a sound file.

41. The Delegation of Uruguay explained that the national Office also required a graphic representation, together with a recording of the sound on a CD. In cases where the Office perceived a discrepancy between the graphic representation and the actual reproduction of the sound, it asked for expert advice. This applied for musical sounds only.
42. The Delegation of Sweden inquired which Offices published the sound file on their Internet sites, in a way that the general public could actually click on an icon and hear the sound.
43. The Delegation of Norway informed that the national Office published an electronic Gazette on the Internet every week. In the case of sound marks, the Office published both the musical notes, if they were submitted, and the MP3 file. This file was made available through an icon on the Website where any interested party could click and listen to the sound. The Office also required a precise description of the sound in words, to have a graphical representation. While it was optional for the applicant to submit musical notes, it was a requirement to submit a sample of the sound in an MP3 file.
44. The Delegation of Colombia indicated that, according to national procedures, every trademark application was published. When the application concerned a sound mark, the sound was not published at that stage but only when the mark was registered and then any interested person could verify the nature of the sound. The Delegation said that another issue that the Standing Committee might wish to consider as part of its future work, were the modalities to be used for conducting historical searches for the purpose of examination of non-traditional marks (sound, olfactory, etc.), once the volume of such marks became more important.
45. The Delegation of the United States of America explained that the national Office did not require a graphic representation of the mark in order to grant a filing date. However, a complete description of the mark was required and also some form of sound recording in order to allow the examination of the mark. Those sound files were available on the Office Internet site. The Delegation noted that there were still many technical issues involved in sound marks, and searching was one where the Office continued to work on.
46. The Delegation of the Russian Federation recalled that at the last session of the SCT, it had informed the Standing Committee that the national Office published a database of registered marks on its Internet site. The database was free of charge and accessible to any interested person. The Delegation noted that with regard to sound marks, the database included a file with a recording of the sound, which could be accessed via a hyperlink. It was important to note that the sign indicated in the application had to correspond exactly to the registered sound.
47. The Representative of GRUR noted that sound marks were certainly not the most common type of mark applied for. The perception of these marks was by the sense of hearing and this basic difference with visually perceptible marks meant that the graphic representation requirement had to be seen in relation to the nature of the mark. It seemed that having an MP3 or other sound file was the best representation for that type of mark. An audible representation for a sound mark equaled to a visually perceptible graphic representation for a word or device mark. In addition, sounds might be digitized and reproduced in a sequence of numbers. Thus, the difficulties in perception or reproduction which existed with analog files had subsequently disappeared. Against this background, the Representative held the view that

an additional requirement for graphic representation of the sign seemed excessive, especially in those Offices around the world which were able to make sounds audible through their Internet sites. The Representative wondered whether it could be argued that for a sound mark application, the sound file was itself the graphic representation of the mark.

48. The Delegation of the United States of America noted that the practice of its national Office showed that a representation of the first 4 or 5 notes of a jingle, for example, were helpful for examination purposes. It seemed that musical sounds were categorized by the first few notes. Since examiners were not musical experts they could compare the paper representation with the actual notes they listened, in order to determine whether there was similarity.

49. The Delegation of Uruguay supported the views expressed by the Delegation of the United States of America. It seemed that the graphic representation of the sound through the notes made it possible to understand the nature of the sign. It constituted an important element in addition to the recording in a material support, which made it possible to compare the sound.

50. The Delegation of Ukraine said that graphic representation of the sound was needed because according to national practice, trademarks were published through a Bulletin.

51. The Delegation of Italy said that graphic representation was a requirement in Italy because of national law and in compliance with the European Community Directive.

52. The Representative of the JPAA noted that a sound file would seem sufficient in a case where the mark consisted of a pure sound without words. In cases where the sound was accompanied by words, a description would be helpful for the examiner to determine the scope of similarity, between the sign applied for and prior marks.

53. The Delegation of Mexico asked Members to share their experience with sound and marks containing words. The Delegation asked whether non-traditional marks could also be mixed marks. For example, olfactory marks could be combined with a texture or with the actual denomination of the mark. In such a case, would each sign be subject to registration? Or how could one determine if a sound mark was descriptive?

54. The Chair noted that some of the issues raised by the Delegation of Mexico were likely to be raised in the framework of the discussion of document SCT/17/3 on the relationship of established trademark principles to non-traditional signs.

55. The Delegation of the United States of America said that according to national practice, an example of a descriptive sound mark could consist of the sound of a person coughing applied for as a trademark for cough medicine. Such an application would be refused on the grounds of descriptiveness.

56. The Representative of the JPAA said that the combination of a sound consisting of a melody and words would be an example of a mixed non-traditional mark. In some jurisdictions, it might be difficult to prove that the words have acquired distinctiveness if they are only used orally and not in any other way.

Holograms

57. The Delegation of El Salvador said that it did not have a great deal of experience in protecting hologram signs as trademarks. The national Office seemed to have doubts as to the parameters that should be used to differentiate between, for example, a three-dimensional mark combined with animated signs and holograms. For this reason, the Delegation considered it useful to hear the experiences of other delegations.

58. The Delegation of Hungary indicated that although the national Office had very low numbers of hologram signs registered as trademarks, national legislation included, under formalities, a special rule on holograms because these signs seemed to differ according to the position of the viewer. Therefore, at least two pictures taken from different angles were included in the application and the position of the views was also designated in words in the application.

Titles of films and books

59. The Delegation of the United States of America noted that it did not see its national perspective reflected in document SCT/17/2. The Delegation informed that, according to national practice, a single title of a book or a film was not registrable as a trademark. To qualify as a series, there should be at least a second title with the same wording, even if it had additional elements.

60. The Representative of GRUR held the view that titles of films and books were word marks, sometimes combined with devices and were therefore treated like word or device marks, which meant that they were considered as “traditional marks”. For this reason, it did not seem apparent why there were any issues regarding the representation of such marks. The Representative further noted that it was not clear, from his perspective that the length of a title could be limited. It would not seem acceptable that the Office might limit the number of words to be included in a title or refuse a sign that exceeded that length.

61. The Chair said that, as noted by the Representative of GRUR, there did not seem to be any issues concerning the representation of titles of movies and films as trademarks. Thus, perhaps the discussion as to what extent such signs were registrable should be reserved until the Standing Committee dealt with document SCT/17/3 on the application of established trademark principles to non-traditional marks.

62. The Delegation of Spain said that, apart from titles of films and books, the national Office had received applications for trademarks relating to the titles of songs, names of popular composers and groups, particularly of rock and pop music.

63. The Delegation of Ukraine noted that in Ukraine there had recently been a number of questions linked to the registration of trademarks that included the names of groups or songs. The Delegation considered it useful to hear about the experiences of other countries in this particular area.

Olfactory Marks

64. The Delegation of Japan noted that the Japan Patent Office was in the process of collecting information and explored the possibility of introducing the protection of non-traditional marks in national legislation. The Japan Patent Office was studying different types of marks. However, it seemed apparent that for some non-traditional marks, such as olfactory, taste or texture marks, it was not possible to specify the scope of rights, even if they were expressed by means of language. In such a situation, it seemed difficult for third parties to precisely determine the scope of protection of those signs.

65. The Chair noted that the issues raised by the Delegation of Japan were very important and asked other delegations if they wished to share their experience about the policy considerations which might have led them to provide protection for olfactory, taste or texture marks.

66. The Delegation of the United States of America explained that under national practice, the element which was required for these three types of marks was that at the point of sale, the consumer would have to experience the scent, texture or taste of the mark. The Delegation noted that in one example of a scent mark registered with the national Office and consisting of cherry scented oil for cars, it was apparently possible for the customer to smell the product before its purchase. With regard to taste, there was a case where the consumer would accidentally put the product in his mouth, for example flavored thread before threading it into the needle. The Delegation further noted that one texture trademark was protected because the consumer could pick up the product and feel the texture, which was neither a descriptive or functional element of the mark.

67. The Representative of GRUR said that it was a common experience that people could recognize and memorize things not only by having seen them but also by having tasted or smelled them. The question was, however, how to deal with these sensory impressions as Trademark Law issues. The Representative noted that looking at these issues one could ask whether there was a recognized method of representing scent or taste, a technically accepted way of fulfilling the requirement that the trademark should be perceptible and repeatable. The Representative wondered whether the position of “availability at the point of sale” was compatible with systems which were not based on use prior to registration. It did not seem clear either why the client should experience the product at the point of sale and not at the point of consumption.

Possible Areas of Convergence

(a) Existing International Standards

68. The Delegation of Singapore said that a number of issues should be discussed in relation to the representation of new types of marks. It seemed apparent that these issues were also relevant in relation to the Madrid Protocol because that system provided a framework of formalities for the purpose of the international registration of marks. If there was no harmonized approach on the question of the representation of marks among different members, there could be no harmonized framework within the Madrid Protocol. The purpose of that framework would be defeated if designated Contracting Parties refused applications on

the grounds of insufficient or unclear representation. To the extent that the Singapore Treaty dealt with the issue of representation of several non-traditional marks, it seemed adequate to consider what had already been achieved by that treaty and whether there were any gaps to be filled.

69. The Delegation of Sweden said that under the heading “Possible Areas of Convergence”, document SCT/17/2 described issues concerning the representation of non-traditional marks that had been addressed by the Singapore Treaty. It seemed that, to some extent, there were some international standards for holograms and color *per se*, although they were not specifically designed for representing trademarks. The Delegation noted that, with regard to combinations of color, movement marks, position and sound marks, there were really no standards and offices lacked certainty about the direction to take. Against this background, the Delegation proposed that the Standing Committee ask the International Bureau to draw from the work already achieved in document SCT/18/2 and its predecessors, as well as Rule 3(3) of the Singapore Treaty to draft suggested best practices, guidelines or recommendations in this field that would be submitted to the next session of the SCT.

70. The Delegations of Australia, Bulgaria, Denmark, France, Italy, Portugal, Singapore, Slovenia, The former Yugoslav Republic of Macedonia, United Kingdom, United States of America and the Representative of the European Community supported the proposal made by the Delegation of Sweden.

71. The Delegation of Brazil said that while it supported the proposal made by the Delegation of Sweden, it considered premature at that stage to give the document any particular name such as a guideline, directive or recommendation. The Delegation noted that it would probably be best to see more clearly the substance of the issues and develop a better knowledge of them. The Delegation further noted that while guidelines did not imply any international obligation, they might establish some kind of international soft consensus where there is currently none. In addition, a large number of countries did not have experience with non-traditional marks and in the case of Brazil, current legislation did not provide for their protection.

72. The Chair clarified that no proposal had been made that would have the effect of providing protection for any new kind of sign. The Singapore Treaty simply said that if a country chose to protect a particular type of sign, there were maximum requirements to be fulfilled. The Chair noted that the SCT could leave aside the question of the name of the document and work on the basis of the proposal made by the Delegation of Sweden.

73. The Delegation of Bangladesh said that it did not disagree with the proposal made by the Delegation of Sweden. However, many countries, including least developed countries did not protect non-traditional marks. Thus, at this point, the Delegation could not support the elaboration of guidelines or best practices.

74. The Delegation of Brazil explained that its position was not to prejudge the outcome of the exercise by calling it “best practices”. The Delegation noted that a number of developing countries including Brazil had no practice with regard to non-traditional marks, so there was a feeling that the Standing Committee might be moving too fast. The Delegation suggested that the work in this area might be called an evolving document on convergence of practices among those Members that currently protected non-traditional marks.

75. The Delegation of Croatia declared that its national Office did not have a great deal of experience with the registration of non-traditional marks. However, it was very interested in learning the latest developments in those countries which did have experience in dealing with that kind of applications. Setting aside the question of terminology, the Delegation was interested in receiving the know-how developed in other jurisdictions, including practical examples. This information could be made available through the SCT Electronic Forum.

(b) Requirement of “Graphical” Representation

76. The Delegation of New Zealand said that national Trademark Law did not limit the type of sign that might be registered as a trademark. There were two basic requirements, namely graphical representation and ability of the sign to distinguish. It was apparent that the requirement of graphical representation proved difficult in relation to non-traditional marks, with the development of new technologies, with new ways of advertising and different ways in which consumers perceived products as being sourced from a single trader. The Delegation noted that this point was well captured in paragraph 64 of this section. The issue was really that where a country had taken a policy decision to accept non-traditional marks for registration, the graphical representation requirement should not act as a barrier to prevent the registration of those marks.

77. The Chair noted that the fundamental requirement that a trademark be graphically represented could be reconsidered under certain circumstances, in order to allow for the possibility of registering signs which could not be represented in such form.

78. The Representative of GRUR said that a preliminary question in this area would be to look at the mode of publication of trademark applications and/or registrations of non-traditional marks. Offices could have different approaches in this area. For example, publication on an Internet site, electronic publication in CD-ROM, paper publication, or a combination of the former. In the case of sound marks, there would seem to be no problem in mandating those Offices, which accepted sound signs for registration and provided for publication via an Internet site, to make the sign available as a sound file via the Internet. However, if the support in which the sound was provided was not a digital medium and the publication was available on paper only, it was difficult to provide the necessary information to third parties. Exclusive reliance on the paper publication would again raise the issue of whether graphic representation in addition to a description was sufficient. There might be other means of describing non-traditional marks in a printed publication and allow searches by the users of the system or third parties as well as provide the trademark holder itself with a record that he could use in Court or before any other authority. The Representative echoed the comments made by the Delegation of New Zealand to the effect that the publication requirement should not be taken as an obstacle to the registration of non-traditional marks. The purpose of publication was to make trademarks accessible and understandable by anyone consulting the Office databases. The Representative held that, since many Offices followed the move towards publication via the Internet, issues of graphic representation should become much less important than on paper publications.

79. The Chair asked delegations whether they had experience in the use of MP3 files or other forms of digital video files in relation to movement, motion marks or short video clips, and whether they saw merit in relying exclusively on that form of representation or to combine it with graphic representation and/or description.

80. The Delegation of Australia declared that it had only one motion mark registration, which consisted of a piece of video footage including three cartoon characters. The video was available on the Office Internet site and a link to the URL was provided.

81. The Delegation of the United Kingdom noted that movement or motion marks in the United Kingdom were expressed in terms of a sequence of frames. The Delegation considered that the requirement of graphic representation was met in this manner, and also by a description expressing the movement or motion. The national Office would probably not accept a pure electronic file as complying with the graphic representation requirement.

82. The Chair said that two questions arose from the discussion. The first one was whether it could be argued that a digital moving image was not graphic, and if so, what its nature was. The second issue was whether graphical representation should continue to be the sole test, or whether the key issue was that the representation be clear enough for the public to understand the nature of the mark, so that it could be recorded and published in an intelligible form, allowing anyone interested to access the mark. The Chair noted that with changing technologies, perhaps a different definition was needed.

83. The Delegation of the Russian Federation said that the national Office had also registered film and moving image marks. The signs dealt with different themes. Some of them were melodies and others were extracts from film or musical shows. All of these signs were found on the Office Internet site. The public could have access to these registrations through a hyperlink. There were also mixed marks, which consisted of a combination of signs.

84. The Chair asked the Delegation of the Russian Federation whether the Office required only the representations in electronic form to make them available on the Internet site or if it also required a written or other graphical depiction or representation.

85. The Delegation of the Russian Federation said that a critical element of the application was the description of the characteristics of the sign. In all cases, the applicant was required to provide a description and indicate the image of the trademark that best characterized it. This representation indicated by the applicant was published in the Official Bulletin and entered into the State Register.

86. The Chair asked delegations whether there was a jurisdiction that did not require a description.

87. The Delegation of Australia said that its national Office always required a description. The Delegation held the view that at the current stage of technological development, it might be very limiting not to require a graphic representation (i.e., a description). If the digital image was available only on the Internet site of the register, it might be difficult to quote or describe it in other documents. Thus, at the current stage, there were practical limitations around not having a description of the mark.

88. The Delegation of Colombia noted that the national Office accepted for registration only word, figurative or mixed marks and therefore considered the graphic representation to be sufficient, without the need for a description of the sign. The Delegation noted that the Office in Colombia was looking at certain cases of confusion which might make it necessary in the future to require a description besides the graphic representation of the sign.

89. The Delegation of Slovenia noted that national legislation did not require a description for any type of mark. In the case of a sound mark, for example, the Delegation believed that the audio file was far more important, since it enabled the examiner to appreciate exactly the nature of the mark, whereas it might be difficult to describe the nature of a sound in words. It was also considered that requiring a description would engender too much work for the users. The Delegation further noted that, even though the Office did not require descriptions, these were some times admitted, particularly when the sign had been refused.

90. The Chair asked delegations whether in cases where an applicant provided a description and the Office accepted it, such a description formed part of the scope and definition of the mark.

91. The Delegation of Slovenia said that the description formed part of the file and examiners usually considered it. The description might, to a certain extent, influence the examination of the application. However, the description did not play a role with regard to the protection of the mark.

92. The Representative of the European Community said that in relation to descriptions, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) had exactly the same position as Slovenia. In that system, there was no statutory requirement to provide a description, although in the case of certain marks, applicants did supply a description. The mark and the description were published and formed part of the register, but the description was not considered to constitute a graphic representation under European Community legislation. In relation to comments made by the Delegation of Australia, the Representative explained that although OHIM did not currently accept electronic representations for movement marks, it did accept them for sound marks and noted that the OHIM register had become exclusively electronic for a number of years. Publications were also exclusively electronic and although it was possible to print the information contained in the register, the only source of information in respect of the register and of applications was electronic.

93. The Delegation of the United States of America declared that, like many other offices, the national Office had a database of pending applications and registrations and encouraged applicants who might file with the Office to consult this database. Thus, it was very important to have a way for applicants to search prior marks, and the Office did not yet have electronic means of searching by sound or by visual productions. Therefore, a description was needed. In the course of examination, examining attorneys could look at the description of the mark and thereby determine whether they might wish to listen to the audio or watch the video file in order to check if there was confusion. The description was also needed for purposes of publication, as a way to allow users to go through the very large official electronic gazette and determine whether they should further investigate any details of a particular mark.

94. The Chair noted that the intervention of the United States of America pointed out to indexing and searching activities and the comparison of marks in a traditional sense. However, the Chair asked the Delegation of the United States of America whether the national Office required a description to be submitted and to what extent, under national law and jurisprudence a description would either define or even limit the scope of a mark.

95. The Delegation of the United States of America confirmed that the Office required the applicant to submit a description. If in the course of examination, it was considered that the description did not adequately describe the sound, image, film or other sign, the applicant would be required to amend the description. The examining attorney could actually insist on the amendment and decide on the basis of that requirement. Decisions on examination were subject to appeal. The description limited the scope of the mark because it was considered that the applicant was in the best position to determine that scope.

96. The Delegation of Bulgaria said that under national law, there was no obligation to include a description of the mark in the application. A field for the description was however provided in the application form. The description was neither compulsory for examination purposes nor for any subsequent procedures. Nevertheless, a description seemed useful for the classification of the mark and also in the course of examination. The Delegation clarified that under national law, the rights conferred by a mark derived from the graphic representation of the sign itself and not from the description.

97. The Delegation of New Zealand declared that under national practice, a description was only mandatory if the trademark was a color *per se* mark or comprised one or more colors. The description of those color or colors in the trademark had to be acceptable to the Office. Descriptions were also required for non-traditional marks in order to help the examiner understand the nature and scope of the rights.

98. The Delegation of The former Yugoslav Republic of Macedonia said that the experience of the national Office with non-traditional marks was limited to three-dimensional and color marks. A description was not required according to national law and the application form did not contain the corresponding field. The Office accepted a description filed by the applicant, although it did not publish it. Descriptions were considered sometimes useful, but they were never mandatory.

99. The Delegation of the Russian Federation said that the national Office carried out a full examination of trademarks on formal, absolute and relative grounds. For this reason, the sign applied for was checked against all other existing signs. An electronic search was carried out according to the graphic representation or the audio representation in the case of a sound mark. Searches took into account sound signs under the same classification, and also mixed marks including sound. The applicant was required to indicate the type of mark for which he sought protection, from a list of signs contained in the standard application. In the absence of classification or an indication of the type of mark, the description provided key terms that allowed the examiners to establish a list of similar marks. The Delegation wondered whether Offices which did not require descriptions carried out only partial examination. The Delegation considered that in countries carrying out full examination, a description was essential.

100. The Delegation of Germany said that the practice of its national Office resembled the practice explained by the Delegation of Slovenia and the Representative of the European Community, to the extent that an applicant could, if he so wished, file a description. The Delegation declared that the national Office conducted full examination of trademarks, whether or not the application included a description. The description was not published and

there was only an indication in the register that a description had been filed. As opposed to graphic representation, the description was not decisive in determining the scope of the mark. In the case of sound marks, a sample of the sound would be decisive and not a description of the mark.

101. The Delegation of Morocco said that the corresponding provision in national legislation was similar to those explained by the Delegations of Germany and Slovenia and by the Representative of the European Community. If an applicant chose to provide a description, the Office would include it as part of the file but would not publish it. The publication contained the graphic representation. Only two types of non-traditional marks were accepted for registration in Morocco, namely sound and olfactory marks. The graphic representation of sound marks consisted of the musical notes and the applicant could also submit an audio CD. The Delegation was interested in learning from the experience of other countries as to the representation of olfactory marks.

102. The Delegation of Spain said that the applicant was not required to provide a description. However, contrary to what other delegations had stated, if the applicant did provide such a description, national law obliged the Office to include it in the publication and it seemed clear that the description would also define the scope of protection of the mark. The Delegation noted that, at least in one case, a national court had determined that a description did limit the scope of the mark and should be included in the publication.

103. The Representative of INTA referred to comments made earlier by the Chair, in relation to the representation of motion marks. The Representative noted that the reproduction requirements remained driven by the constraints of the traditional publication on paper. Yet, at least one delegation had declared that its Office had abandoned that type of publication altogether and moved to publication by electronic means. The Representative held the view that video clips were definitely graphic representation, and it could even be said that sound files were phonographic in essence. The Representative further noted that the user community wished to see the requirements for the representation of marks evolve at some pace with the progress of technology. In the view of the Representative, this could be done either by way of interpretation or by legislative change, so as to allow Offices to accept representation by means other than purely graphic or through image on paper. It seemed clear, however, that an electronic representation of the sound or motion would not lend itself for indexing and searching and for that purpose, a description of the mark would certainly be useful.

104. The Delegation of Colombia said that it might be risky to make mandatory a requirement for description. The Delegation believed that descriptions might contain subjective elements and that the same sign or figure could be described differently by different people. Descriptions might even be manipulated and not faithful of the sign represented. They might also affect previously registered signs. Thus, it was best not to make them mandatory. The important element for a trademark registration was its graphic representation and the scope of protection should not be limited by a description.

105. The Delegation of Italy supported the views expressed by the Delegation of Colombia. The Delegation noted that, according to Article 3 of the TLT 1994, the reproduction was the important and necessary element. A description was not required and could therefore not be requested from applicants. Nevertheless, the national Office in Italy accepted a description when it was provided.

106. The Chair said that it seemed to be agreed by the international community that a description might not be required in relation to traditional marks. The challenge was for the Standing Committee to grapple with the issue of whether and to what extent in relation to some non-traditional marks a description might in fact be necessary. However, in understanding the reasons and the extent to which a description might be needed, it was also pertinent to find ways of limiting the impacts of such a requirement, for example, on the filing date. It was also sensible to think about the nature of the description that would be allowed, e.g., in terms of its length.

107. The Delegation of Ukraine said that national legislation did not require a description at filing. Since the national Office had not registered too many non-traditional marks, the practice in Ukraine related mostly to traditional marks. If the applicant, on his own initiative provided a description, the Office considered it useful for examination and search purposes, since a description might contain key words. The Delegation noted that it would not be appropriate to require descriptions.

108. The Delegation of the Russian Federation drew the attention of the Standing Committee to the relevance of descriptions when examining sound marks which contained words in a foreign language. In such cases, the examiner had to determine whether the words were contrary to public order or morality. The examiner had to determine whether the words themselves were aggressive, violent or in any way contrary to those principles. Office experts did not always master the foreign languages involved and therefore a description of the sound mark was useful in understanding the meaning of the words.

Other Issues

(a) Special Considerations on Publication

109. The Representative of GRUR said that generally, the publication of word or figurative marks did not present any problem. However, the publication of non-traditional marks raised a number of questions, particularly for applicants who wished to obtain protection in different jurisdictions. Such users of the system were interested in receiving as much information from the publication as possible, without having to look at the trademark files themselves or at other sources of information. The Representative held the view that the information about a trademark should be complete and self-contained. It should be easy to determine the subject matter of protection. For example, a color trademark should preferably be published in color and not in black and white with a reference to color, because the latter would imply a consultation of the file to determine the actual nature of the mark. In the case of a three-dimensional mark, there should be an indication of the type of mark. With regard to sound marks, the user community would appreciate, to the extent possible, that Offices made available the sound file rather than the mere description of the sound. The Representative further noted that it would be helpful if all Offices used WIPO INID codes in their publications. Although the codes were not mandatory, a more generalized use of them would simplify and standardize bibliographical indications across the world.

110. The Delegation of Sweden asked what would be the right forum, within WIPO, to address a possible change to the seemingly important rule that the representation of a mark should be published in a space of 8 x 8 cm.

111. The Secretariat noted that this was a standard in the framework of the international trademark registration procedure under the Madrid system. A change to that standard would have to be addressed by the Madrid Union and in particular by the Working Group for the Development of the Madrid System. The Secretariat further noted that the 8 x 8 cm standard was also included in the Trademark Law Treaty and in the Singapore Treaty on the Law of Trademarks. However, in the latter treaties, the standard did not appear in the substantive provisions, but was included in the Model International Forms, and there was an understanding that Contracting Parties were allowed to change those models. In the framework of the Singapore Treaty, the 8 x 8 cm standard could be revisited through the Assembly of the Treaty once it entered into force. The Secretariat further noted that another WIPO body, namely the Standing Committee on Information Technologies (SCIT) was working on a number of industrial property information standards through its Working Groups and dedicated Task Forces. The adopted standards were then published in the WIPO Industrial Property Information Handbook. This was the case, for example, of the INID Codes and the minimum bibliographic information to be made available in Office publications. Other work of the SCIT Working Groups related to standards for the publication of non-traditional marks, such as color, of which there was a reference in document SCT/18/2.

112. The Delegation of Morocco noted its understanding that under the Madrid system, the representation of the mark could not be larger than 8 x 8 cm, although it could be smaller.

113. The Chair said that the Standing Committee was not competent to engage in a discussion towards changing the 8 x 8 cm standard. The SCT could however note the discussion on that representation requirement. The Chair mentioned that the size of the reproduction seemed to be losing significance, especially in relation to electronic communications. The Chair asked the Secretariat to further explain INID Codes.

114. The Secretariat informed that “INID” was the acronym used to refer to “Internationally Agreed Numbers for the Identification of Bibliographic Data”, which was one of the standards adopted by the WIPO Standing Committee on Information Technologies and included in the WIPO Handbook on Industrial Property Information and Documentation. Standard number ST 60 was a recommendation concerning bibliographic data relating to marks. Some Offices, including the International Bureau of WIPO in its ROMARIN database for International Trademark Registrations used INID codes. The Secretariat explained that INID codes were used in industrial property publications, such as trademark and patent gazettes. Those codes were used to replace titles, for example, the code “732” was used for “trademark holder”. One of the advantages of using INID codes was enabling the users of the system to consult gazettes in languages that they did not necessarily master.

115. The Delegation of Croatia asked whether it was possible to use INID codes as search criteria for non-traditional marks in Office trademark databases.

116. The Secretariat replied that INID codes did not seem to be a valid search criteria in the ROMARIN database. There was, however, a possibility to carry out searches according to the classes of the Vienna Classification for the Figurative Elements of Marks, i.e., in the case of color as a distinctive feature of the mark. According to the practice of some Offices, the applicant was required to indicate the type of mark in the application and this element was included as an option in the search mask of the trademark databases.

(b) Possibility of Additional Costs

117. The Delegation of Bangladesh declared that the national Office published only traditional marks and only on paper. Publication was done through an official gazette issued by the central Government every week, and trademarks were published only quarterly. The publication had very limited circulation and the issuing authority could decide whether or not to publish, for example a two-dimensional representation. The Delegation believed that any shift from this mode of publication to any other, such as an electronic system, would pose real challenges for countries like Bangladesh.

118. The Delegation of The former Yugoslav Republic of Macedonia said that, previously, its national Office published trademark applications in an official gazette every three months. This system was replaced by publication in CD-ROM format and on the Office Internet site. In the old system, an applicant who wished that its mark be published in color was asked to pay additional fees. With the CD-ROM publication, there was no issue of additional costs. The Delegation noted that there were two additional advantages of the new system. One was the reduction of storage space and another was to offer a better alternative for the publication of non-traditional marks.

119. The Delegation of Bangladesh noted that perhaps the additional costs of publication could be realized from the application fees and in this connection requested other delegations to share their experience.

120. The Delegation of Panama said that trademarks were published in the Official Bulletin of the Industrial Property Registry. In the past, this was a paper publication that was often overdue and implied a high cost for the Office. Such problems were resolved by publishing the Gazette on the Office Internet site, where the information was available for users and for the general public without any cost. A flat and inexpensive publication fee was charged to the applicant. The Delegation declared that the Office received descriptions submitted with trademark applications, but did not publish them. With regard to non-traditional marks, only one sound mark was registered with the Office and the sound file was available on the Office Internet site for authorized agents. However, it was foreseen that such files would be available to the general public in the future.

121. The Delegation of New Zealand declared that the national Office did not charge an additional fee for publication.

122. The Delegation of Morocco declared that the national Office published the gazette in the second and the fourth week of every month. There were three different modes of publication: on paper, CD-ROM and on the Office Internet site. The latter had proved to be the preferred mode for users. There was no separate fee for publication and the only non-traditional marks thus far registered were sound marks, for which graphic representation (i.e., the notes) was provided.

123. The Representative of the European Community said that with regard to publication, OHIM did not distinguish among different types of marks. While there were application and registration fees, there was no separate fee for publication. OHIM published electronically only and the frequency was once a week, every Monday. It was expected to move to a daily

publication in the near future. Access to the publication over the Internet was free of charge. The Representative declared that moving from paper and CD-ROM to publication on the Internet saved the Office millions of Euros each year.

124. The Delegation of Chile noted that there was a separate publication fee, which varied depending on the type of mark applied for. Publication took place once a week and was available on-line. However, the only official publication was the gazette on paper.

125. The Delegation of the United States of America said that as the USPTO was moving to a totally electronic system, almost 97% of applications were filed electronically and the Office rewarded those applicants by reducing the application fee. There was no separate fee for publication.

126. The Representative of GRUR declared that the users preferred publications which were in themselves complete and needed no reference to another source of information. Electronic publication, where available, was the preferred means by trademark owners and their representatives, because it provided a possibility to better use the information. On the issue of cost, it seemed that the preferred situation was not to include a separate publication fee, in particular for non-traditional marks. Collecting fees separate from the application or registration fees could delay the registration process. The Representative noted that publications in black and white had the same cost as color publications, especially when they were done electronically. Thus, there was no real reason to charge additional fees.

127. The Secretariat noted that an additional source of information concerning national fees could be the schedule of individual fees to be paid under the Madrid system. That schedule constituted a very easily accessible source of information of the fees charged by countries which had opted to ask for an individual fee. The Secretariat also noted that under the Resolution Supplementary to the Singapore Treaty on the Law of Trademarks, the possibility was open for developing and least developed countries to receive assistance, on a preferential basis to implement systems of electronic communications and publication. This type of assistance followed the same principle of other technical assistance provided by WIPO in that it was demand-driven.

128. The SCT requested the Secretariat to prepare a new document for the nineteenth session in relation to methods of representation and description of non-traditional marks.

129. The document would identify possible areas of convergence, based on documents SCT/17/2 and SCT/18/2 and the report of the current session. In particular, the document would focus on those areas where there had been less widespread experience and which had not been addressed comprehensively in the Singapore Treaty on the Law of Trademarks.

Relation of Established Trademark Principles to New Types of Marks

130. Discussion was based on document SCT/17/3.

131. The Secretariat recalled that document SCT/17/3 was prepared for the seventeenth session of the SCT. However, due to time constraints, the Standing Committee was unable to address the document at that session. Generally speaking, the document attempted to look in

further detail at how non-traditional signs functioned as trademarks, since most delegations declared that they did not have sufficient experience in this field. The Secretariat noted that the document identified some established trademark law principles such as functionality, speciality and distinctiveness and dealt with them first in a general manner, and then in relation to specific types of non-traditional marks, while taking into account that those principles might be more or less relevant to specific types of marks. The Secretariat further noted that even when the discussion was centered on questions of the representation of non-traditional marks, a connection was made with the application of those principles, which indicated that there was perhaps some room for discussing them in a broader way. The last part of the document covered two issues, namely the public interest and safeguarding the public domain, which were raised by delegations at previous sessions of the SCT.

132. The Chair opened the discussion on the document and noted that the first section entitled “Introduction” referred to the submissions provided to the Secretariat by a number of SCT members. The Chair thanked those members for the effort invested in preparing those submissions, which constituted the basis of the work that the Standing Committee was trying to collectively achieve.

Overview

133. The Chair drew the attention of the Standing Committee to the statement contained in the second line of paragraph 3 which read “national and regional case law does not appear to require authorities a stricter assessment of the registrability of new types of marks...”. The Chair noted that it seemed to be the general impression of national offices that they should not apply a stricter set of criteria in dealing with the registration of non-traditional marks. Nonetheless, there also seemed to be a generalized impression among the user groups that Offices did indeed apply a stricter test. The Chair considered that it might be interesting to comment on this apparent dichotomy.

134. The Delegation of Slovenia said that its national Office had received cases in which the users complained that a stricter test was applied for non-traditional marks. However, the Delegation believed that perhaps the proof of distinctiveness acquired through use – a necessary requirement for certain types of marks – was in such cases mistaken for an additional or more stringent test.

135. The Delegation of Uruguay said that under national law, only sound marks were considered. Legislation stipulated that these marks should be treated in the same manner as traditional marks. Even though examiners could make their own personal evaluation, they were not allowed to establish separate criteria for assessing sound marks.

136. The Delegation of the United States of America expressed the view that any trademark had to be distinctive or capable of distinguishing in order to be protected. Therefore, the national Office did not treat non-traditional or traditional marks differently. In the United States of America, jurisprudence had determined that a color *per se* could not be inherently distinctive because there was a competitive need for that color, which should not be restricted. Hence, acquired distinctiveness was required in such cases. The Delegation noted that trade dress, on the other hand, could be inherently distinctive from the beginning. In fact, the basic principles of distinctiveness and capacity to distinguish could be present from the start, but

the applicant might have to go through an additional hurdle because national jurisprudence had determined that certain signs were not inherently distinctive. The Delegation further noted that even in the area of traditional marks, certain signs were not inherently distinctive and secondary meaning was required.

137. The Delegation of the Russian Federation mentioned that the national Office did not put any barriers to the registration of any marks, whether they were traditional or non-traditional. National law applied to all types of marks and a very detailed examination was carried out to determine any grounds for refusal.

138. The Delegation of Colombia said that the national Office asked for the same minimum requirements both for traditional and non-traditional marks, namely that the sign be distinctive and capable of graphic representation. The Delegation indicated that the national Office had noted that in the case of three-dimensional mark applications, users tended to be more lax in terms of interpreting the requirements. Sometimes the Office had received applications concerning three-dimensional signs that seemed to lack distinctiveness. If the Office refused those applications, it did not necessarily mean that the Office was applying a stricter test.

139. The Delegation of the United Kingdom said that the jurisprudence of both the European Community and the United Kingdom was essentially one of a non-discriminatory approach to non-traditional marks. It was however acknowledged that the average consumer did not necessarily perceive those signs as trademarks. That had to be established as fact in many cases where acquired distinctiveness was relied upon and in certain cases, these non-traditional marks were considered secondary, tertiary or less prominent signs than primary word trademarks. The Delegation believed that this could be a more difficult question if the applicant had to face the trial of proving acquired distinctiveness, because it had to show that the particular sign applied for, be it a color, slogan or shape “functioned” of itself as a trademark.

140. The Representative of GRUR recalled that when the users of the system sought trademark protection in different jurisdictions, they were faced with a number of difficulties and obstacles. Some of those difficulties were natural, such as a language, culture or different formalities. Other difficulties were not the result of different legal standards but different practices regarding those legal standards. The Representative said that a recurrent problem was that while a sign was accepted for protection in one country, it was subsequently refused when applied for in a neighboring country, on the grounds, for example, that it lacked distinctive character or was descriptive. In most cases, these differences in appreciation did not seem justified on the basis of language or perception. The Representative believed that at least where common standards existed they should be applied equally in different jurisdictions. The Representative noted that the argument had been made during the discussion on non-traditional marks that consumers or market participants were not accustomed to perceiving a three-dimensional shape, color, or any other non-traditional sign as a source indicator. In the view of the Representative, this was a statement of fact which was not necessarily backed by evidence, because it was not proven that consumers did not, for example, make a choice on the basis of shape. As the argument had been included in several judicial decisions, the burden of proving otherwise was on the users.

141. The Representative of the JPAA said that national law in Japan required both traditional and non-traditional marks to be distinctive. With regard to three-dimensional marks, there was a very strict assessment of distinctiveness, since Courts had already determined that a pure shape was not inherently distinctive. Therefore, the applicant was always required to prove secondary meaning through considerable use of the trademark in commerce.

142. The Delegation of Uruguay said that in the experience of the national Office, applicants seeking protection for three-dimensional marks sometimes went beyond the requirements for proving distinctiveness and specialty, and submitted signs which were practically patents, utility models or even industrial designs.

143. The Delegation of Sweden said that it wished to illustrate the difficulties that its Office faced when totally new subject matter was applied for registration as a trademark. The Delegation explained that the natural first reaction of an examiner was to consider the sign registrable because there was no evidence in the Office indicating, for example, that the sign lacked distinctiveness. When the matter came to the supervisor, it might be deemed necessary to establish a new policy in relation to the new sign in the absence of any applicable law or jurisprudence. In such cases, the Office would become proactive in order to resolve the issue submitted to it, but it would only be able to assess the appropriateness of its policy decisions in retrospect. The Delegation believed that this would probably explain why different Offices applied different practices.

144. The Delegation of Panama expressed concern on the fact that there seemed to be discrepancies as to the way in which different jurisdictions examined non-traditional marks. The Delegation considered that both the information contained in the documentation prepared by the Secretariat and the discussion of the Standing Committee were very useful for the work that SCT Members had ahead of them. However, additional efforts should be invested to minimize the different approaches.

145. The Delegation of Australia declared that under national law, the same standards applied for traditional and for non-traditional marks. This approach was supported by national Courts in a landmark decision relating to shape marks. The Delegation noted that, for over 10 years, national law contemplated a very broad definition of trademark, on the basis of which the Office conducted a review of its practice over that period of time. The review indicated that non-traditional marks had a much lower registration rate and the Office decided to inquire why this was so. The Office found, however, that the lower registration rate was not due to the application of a higher or more stringent test but to the signs applied for lacking the capacity to distinguish. The Delegation informed that in respect of the comment made by the Chair as to the capacity of Offices to bring their practices together and get consistent outcomes for trademark applicants, the national Offices of Australia and New Zealand had undertaken joint efforts. At a first stage, they looked at trademarks which had been completed and finalized in both countries to see if the outcome was the same. It was estimated that in about 25% of the cases the outcome should have been similar and yet the decisions were different. The second stage of the work was introducing changes in Office practices in order to give applicants a better chance of getting the same outcome for applications of the same marks in both jurisdictions.

146. The Delegation of Colombia said that with regard to three-dimensional marks, there was a concern among the examiners of the national Office to register as a three-dimensional mark subject matter which was in fact an industrial design. The examiners were perhaps overcautious because trademark rights could be renewed indefinitely, while design rights were limited in time.

147. The Delegation of Spain noted that its national Office had detected certain difficulties with regard to the registration of color marks. Although in theory, a color *per se* could constitute a trademark it was very difficult to prove inherent distinctiveness and therefore distinctiveness had to be acquired through use. In many cases, the list of products was too broad and it was virtually impossible to prove use in relation to such a list. Applications of this type would normally be rejected. The Delegation believed that most problems of assessment had to do with the type of application that was submitted to the Office.

Subject matter of protection

148. The Chair recalled that certain delegations declared that their national laws defined that the sign had to be capable of distinguishing the goods and services of one trader from those of another while leaving open-ended the list of what might constitute eligible subject matter. Other delegations had declared that their legislation was clearly more prescriptive and either defined the types of signs which could be protected as trademarks or determined that certain signs could not be protected. The Chair asked delegations to share their experiences in this regard.

149. The Representative of GRUR noted that at the current meeting and during previous meetings of the SCT, several delegations had indicated that a number of non-traditional marks were not accepted for registration in their jurisdictions. The Representative said that under existing international standards, visually perceptible signs should not be excluded from protection. The situation was obviously more complex with non-visible signs such as sound or scent, although it was encouraging to hear that many Offices were able to accept the registration of sound marks and admitted the submission of sound files. Against this background, the Representative considered it relevant to discuss what the current status was on subject matter of protection.

150. The Delegation of Panama indicated that the national Trademark Law, contained a very broad definition regarding subject matter of protection. In fact, the enumeration of signs which could be accepted for registration was non-exhaustive and the criteria of capacity to individualize the goods and services in the marketplace allowed the national Office to accept visible and non-visible signs as trademarks.

Distinctiveness, Functionality and Specialty

151. The Chair noted that these three sections of document SCT/17/3 referred to general trademark law principles and their application to non-traditional marks. Therefore, for each of those principles there was a general and a specific part covering particular aspects that related to specific non-traditional marks. The Chair called for comments on paragraphs 7 to 38 of the paper.

152. The Representative of GRUR referred to paragraph 15 of document SCT/17/3 in relation to three-dimensional marks. The Representative noted that it was common practice to file three-dimensional trademarks consisting of the shape of a product, namely a container that carried a distinctive element on them, such as a label, word, device or a combination of them. The Representative considered that in such cases, it would be proper Office practice to accept these signs for registration, even if the shape itself was not distinctive. In the view of the Representative, a container with a label, on which there were distinctive and non-descriptive elements should be registrable.

153. The Delegation of the Russian Federation said that the national Office considered a number of elements to determine whether a three-dimensional sign had distinctive character. In fact, the applicant had to provide amongst other, proof of the geographical distribution, labeling and length of use of the product. The Delegation noted that paragraph 12 of document SCT/17/3 mentioned as one of the possible criteria a degree of familiarity with the product of 50%. However, this percentage might vary depending on whether the product was very selective or a mass consumption item. The Delegation asked the Standing Committee to devote more time to an analysis of the criteria to determine the distinctiveness of trademarks.

154. The Delegation of the United Kingdom expressed the view that in the field of trademark examination, it was difficult to establish “fixed” rules, such as those relating to percentages. In the view of the Delegation, examination was not a science but an art and as such, it could sometimes be imprecise.

155. The Representative of GRUR said that perhaps a more appropriate standard would be that a significant or substantial proportion of the public perceived the sign as an indicator of trade origin. Such assessment would be made on the basis of a case-by-case analysis and an evaluation of the relevant evidence. The Representative noted that another element could be time. Indeed, there seemed to be a rule where if the applicant could demonstrate that he had been using a descriptive or non-distinctive sign for a number of years in a jurisdiction, the sign could be considered to have *prima facie* acquired distinctiveness. The Representative believed that this rule was helpful because use of a sign by one trader over a long period of time meant that no other competitor or market participant needed to use the same sign.

156. The SCT noted the contents of document SCT/17/3 and agreed that it provided a useful overview. The Chair noted that no further work was requested in this area.

Key Learnings in the Field of Trademark Opposition Procedures

157. Discussion was based on document SCT/18/3 Prov.

158. The Chair noted that document SCT/18/3 Prov. was submitted to the SCT in draft form, asking members to review the information contained in the document and provide their views on the nature of any further work to be undertaken.

159. The Secretariat informed that the document was drafted on the basis of information contained in the WIPO Questionnaire on Trademark Law and Practice, as well as the submissions received from Members of the SCT. It was important to note that the document included a table which set out specific information about the time limits for opposition. The fact that the document constituted a compilation could make it liable to include inaccuracies that should be corrected in the final version.

Relation Between Opposition and Examination Procedures

(a) General

160. The Delegation of New Zealand said that the national Office examined applications both on absolute and relative grounds, and in the case of opposition, any of the grounds set out in the Trademark Law could be invoked. The Delegation noted that during examination, the Office was not well suited to deal with some of the grounds that might prevent an application from going forward to registration. Some of those grounds might include, for example, issues concerning ownership of the trademark or issues around prior and existing unregistered trademarks. In the opinion of the Delegation, such issues could be better explored at opposition rather than during examination and for this reason, national law did not limit the grounds of opposition.

161. The Delegation of Mexico declared that the information contained in document SCT/18/3 Prov. was very useful, particularly when countries were considering revising their national legislation. National legislation in Mexico provided for a post-registration opposition system. The system allowed a fast-moving registration procedure, in keeping with other efficiency and development goals set out by the national Government. However, there was only one case of pre-registration opposition, namely where a trademark registration was denied on the basis of prior rights, it could be taken to the Courts and the owner of that prior right was notified by the administrative authority.

162. The Delegation of the United States of America sought a clarification from the Delegation of Mexico with regard to the post-registration opposition system. The Delegation wondered whether in such a system, the rights of the owner of the opposed trademark were suspended while the opposition procedure was taking place.

163. The Delegation of Mexico noted that where a post-registration opposition was filed, the opponent was not, at that point granted any right by the Office and therefore was not allowed to use the mark. On the other hand, the owner of the trademark had the right to take infringement action while the opposition procedure was taking place.

164. The Delegation of Japan said that Japan had also adopted a post-registration opposition system whereby the registrant enjoyed its trademark rights as of the date of registration, even if an opposition was filed.

165. The Delegation of Uruguay noted that national law provided for a pre-registration opposition procedure. This was perceived as a means of protecting third party rights, while providing legal certainty to the applicant and preventing the registration of signs that did not comply with the legislation in force. According to national law, an opponent should have a direct and legitimate interest in the case.

166. The Delegation of Ukraine sought clarification from the Delegation of Mexico as to whether rights which had been granted as a result of registration could be nullified as a result of a post-registration opposition.

167. The Delegation of Mexico clarified that if a registration was cancelled following opposition procedures, the rights resulting from the registration were extinguished and thus, a new applicant could be granted rights on the same sign.

168. The Delegation of Colombia said that the opposition procedure in Andean Community countries (Bolivia, Colombia, Ecuador and Peru) was prior to the registration of the mark and took into account absolute and relative grounds, without prejudice of the substantive examination by the Office on those same grounds. The Delegation considered that this was a very important feature for both the applicant and the opponent and it also contributed to processing trademark applications in a timely manner.

169. The Delegation of Chile declared that the opposition system in Chile was pre-registration. Anyone wishing to file an opposition could do so within 30 days counted from the publication of the application. There were two salient features of the procedure: firstly, any decision by the Industrial Property (IP) Department was subject to appeal before the Appeal Body on Industrial Property, and secondly, the IP Department was not bound to accept the grounds set out in the opposition. In fact, it could dismiss all of those grounds and decide that for other reasons, it is not possible to register the mark.

170. The Delegation of Kenya said that national law provided for a pre-registration opposition procedure, whereby after examination on both absolute and relative grounds, the application was published in the Industrial Property Journal. Within a time limit of 60 days from the date of publication, any member of the public could file an opposition with the Registry. If there was no opposition within that time limit, the application was deemed to be accepted and the registration certificate was issued. After registration, the only way to challenge a trademark was to have it expunged from the register.

171. The Delegation of Morocco declared that Morocco had a pre-registration opposition system. Parties filing an opposition could do so within two months from the date of publication of the application, and the Office had to decide the opposition within six months. The decision by the Office was subject to judicial appeal. The Delegation requested the Secretariat to include this information which was currently missing in the Annex to document SCT/18/3 Prov.

172. The Delegation of Sri Lanka noted that the national system also provided for pre-registration opposition. When a party failed to file the notice of opposition, it could only go to the Commercial Court to have the mark expunged, but it could not undertake such proceedings before the Intellectual Property Commissioner.

173. The Delegation of Hungary said that the opposition system was introduced in Hungary in 2004. At that time, it was considered that a pre-registration opposition system was the best option. However, it was later perceived that this system had the disadvantage of prolonging the processing of the application. After consultation with the users, an amendment was introduced in 2006 allowing for the possibility of an accelerated registration procedure, which would provide the possibility of a post-registration opposition system. Therefore, the system in Hungary became hybrid and although it was not yet in force, it was expected that if a post-registration opposition succeeded, the Office would automatically withdraw its decision on registration.

174. The Delegation of The former Yugoslav Republic of Macedonia declared that oppositions could be filed with the national Office prior to registration and within 90 days from the publication of the application. Oppositions could be filed only on relative grounds, because absolute grounds were examined *ex officio*.

175. The Delegation of Japan said that Japan introduced a post-grant opposition system with a view to reducing the time period from filing to registration. Both absolute and relative grounds could be raised for refusal at the examination stage or for cancellation at the opposition stage. The opposition period was two months. The Delegation noted that when Japan was operating under a pre-grant opposition system, the number of cancellations based on opposition accounted only for 0.2% of the all trademark registrations. Japan was persuaded that it was pointless to publish all applications in the gazette and let the period of opposition pass when there was a rare possibility of cancellation. With the change of system, the first Office action time has reduced dramatically. Moreover, Japan recognized that the opposition system served a public purpose, because it enabled the Office to determine the appropriateness of a trademark registration and allowed it to correct its defective decisions without being restricted to the grounds of opposition that a party may lodge.

176. The Chair drew the attention of the Standing Committee to paragraph 10 of document SCT/18/3 Prov., which read that pre-registration opposition systems tended to limit examination by the Office to formal and absolute grounds. However, it seemed from the debate that several Offices did not limit the grounds to be used at each of those stages. The Chair noted that this paragraph should be revised accordingly.

177. The Delegations of Colombia, Panama, Portugal, the United States of America and Uruguay supported the comment made by the Chair and requested that paragraph 10 be amended.

178. The Delegation of Bulgaria said that, according to national legislation, an application was published for opposition during a period of two months. The application could be opposed on absolute or relative grounds. Only after that time period, the Office carried out the full in-depth examination on absolute and relative grounds. The Delegation noted that the procedure was long and, as a way of accelerating proceedings, the Office required a higher opposition fee.

179. The Delegation of China said that a pre-registration opposition procedure was available in China. The opposition period was three months starting from the date of publication of the preliminary approval. Extensions of that time limit were not available and the Delegation requested that this information be reflected in the table attached to document SCT/18/3 Prov. The Delegation declared that in China, opposition was based on absolute and relative grounds. However, the national Office had encountered difficulties with the examination of prior rights, and in particular copyright. Determining the validity of such rights seemed time consuming and the Delegation wished to hear the experiences of other countries.

180. The Delegation of Germany noted that the national Office in Germany examined only prior rights over trademarks in opposition procedures. All other rights were examined by the Courts because usually such procedures implied the submission of evidence, the analysis of which could be time consuming.

181. The Delegation of the United States of America informed that, for the most part, the national Office did not consider other intellectual property rights, either on examination or in opposition, unless a likelihood of confusion might be involved. The Delegation noted that the Office did not have jurisdiction to consider prior rights in copyright.

182. The Delegation of Bulgaria noted that according to national practice prior rights could not be the basis of opposition but might be invoked in cancellation procedures.

183. The Delegation of Latvia informed that according to national law, copyright could be invoked against a trademark registration in opposition procedures. There was an occurrence of these cases and indeed, it seemed more difficult to deal with such rights.

184. The Delegation of New Zealand said that national law did not provide for relative or absolute grounds in relation to other intellectual property rights. From the experience of the national Office, no oppositions had been based on grounds of a prior copyright in the recent history. The Delegation noted that if an issue was raised around using, for example, an artistic element in a trademark, the copyright owner would be expected to take infringement action against the trademark applicant and perhaps seek an injunction to prevent that the application progress, until the issue of ownership over copyright was dealt with.

185. The Delegation of Slovenia indicated that under national law, copyright may be invoked in opposition procedures. These were very rare instances, but whenever such issues were raised, they took a long time to be settled. The Delegation believed that the courts had better resources to deal with issues around the ownership over copyright. It was difficult for small trademark offices, to deal with rights that were not based on registration, such as copyright.

186. The Delegation of Australia said that under Australian law, it was possible to invoke copyright as a ground for opposition. While there was no express ground relating to copyright, two provisions could be referred to. The first concerned a ground where use of the trademark would be contrary to law in general, including copyright law. The second ground could be that the applicant was not the owner of the trademark. In the latter case, it was possible to prove that another person had copyright in the material applied for, including rights on the basis of use. While cases involving copyright were rare, they did not seem to pose any particular problems. The hearing officers were assisted by expert counsel who would review the necessary copyright provisions.

187. The Delegation of El Salvador said that the national Office was competent for both industrial property and copyright. Under Trademark Law, it was admissible to raise an opposition on the basis of prior copyright and the Office was competent to resolve such cases. The Industrial Property Department could rely on the expertise of the Copyright Office.

188. The Delegation of Uruguay said that national law contemplated copyright as a ground of opposition when use of the sign was not authorized by the copyright owner. In Uruguay, the Trademark Office worked alongside with the Ministry of Culture, which was competent for copyright matters, in order to verify the existence of rights on copyrighted material.

189. The Delegation of Singapore informed that the Trademark Act of Singapore had an explicit provision allowing a third party to oppose a trademark on the basis of prior intellectual property rights other than trademark rights and including copyright or registered designs. However, the provision was not commonly invoked.

190. The Delegation of Ukraine indicated that under national Law, the Office had to take into account copyright in opposition procedures. There seemed to be certain difficulties in this connection, in particular because the Office of Literary and Artistic Works handled its own application and registration procedures. The Delegation further noted that discussions were

underway in Ukraine to move from a pre-registration to a post-registration opposition procedure and in this context, the Delegation would appreciate any information from jurisdictions in which such a transition had taken place.

191. The Delegation of Serbia said that national law did not contemplate an opposition procedure. The Office, however, conducted full examination as to formal, absolute and relative grounds. The Delegation noted that from the discussion of the Standing Committee, it had gathered ample information about the procedural aspects of both pre-registration and post-registration opposition procedures. Nevertheless, it wished to hear what the distinct advantages were of having an opposition procedure as compared to a system of full examination by the Office.

192. The Delegation of the Russian Federation noted that, under national law, the Office carried out full examination on absolute and relative grounds. However, the Office did not verify prior rights on copyright. It was considered that examination was not infallible and thus, all applications were published on the Office Internet site allowing any interested party to make comments on any sign applied for registration. The Delegation further noted that the Office of the Russian Federation had an accelerated procedure to grant of trademarks. Such a procedure had posed a number of problems in relation to prior rights.

193. The Delegation of the United States of America said that under the national system, there was a clear instruction to get the examination handled in a timely fashion. But once an opposition procedure was engaged, extensions could be filed and it was up to parties to settle the matter. The Trademark Trial and Appeals Board (TTAB) would oversee the procedure, but only the parties could make it advance by filing motions. Both the examining attorney in charge of motions and the judges issuing a final decision had time limits to respect. However, it was considered important to reduce the workload on the Board. The Delegation indicated that the time issue had to be seen in relation to the time that the parties needed to get their issues resolved, because once a registration was granted, it served as a constructive notice of ownership and validity of the registration. The registration also provided information to the national customs and border patrol for any enforcement actions and allowed the owner to bring infringement cases before the courts. It also allowed the holder to claim priority under the Paris Convention.

194. The Delegation of Colombia, in reply to the question asked by the Delegation of Serbia, said that a disadvantage of trademark opposition procedures was the presence of so called “reckless oppositions” which only sought to delay the procedure. National legislation provided for ways of deterring such oppositions by establishing a separate opposition fee.

195. The Delegation of Italy said that although national law provided for an opposition procedure, the implementing regulations had not yet been enacted. Nevertheless, in Italy, it would not be possible to invoke copyright in trademark opposition procedures before the Office, but only in cancellation procedures with the courts.

196. The Delegation of Uruguay said that one distinct advantage of trademark opposition procedures was providing legal certainty, protecting acquired trademark rights and protecting the consuming public who may be led to confusion by similar or identical marks belonging to different holders. The Delegation noted that an opposition system did prolong the procedures, but in Uruguay, there was also a separate opposition fee to prevent reckless claims.

197. The Delegation of Australia said that it considered the opposition process important for the certainty of rights. The Delegation noted that the timeliness of the process was important and therefore numerous extensions of time had onerous consequences for all the parties. The Delegation further noted that opposition procedures were currently under review in Australia with the purpose of introducing a case management approach.

198. The Delegation of Mexico expressed the view that one of the functions of trademark Offices was to protect industrial property holders through the recognition and possible registration of trademarks. The Delegation believed that trademarks used in specific areas of business, such as electronics or clothing had a very short useful life and it was necessary for the holder to have a registration as soon as possible and to take infringement action against anyone using the mark without authorization. In this context, a pre-registration opposition system would delay the possibility for the trademark holder to have an enforceable right.

199. The Delegation of New Zealand noted that according to national law and practice, once a trademark was registered, the trademark owner was entitled to bring infringement action any time on or after the date of application for registration. Thus, if an infringement occurred while a trademark application was still pending the infringing party could be liable for infringement as from the date of application or when it started infringement, once the trademark was registered.

200. The Delegation of the United States of America recalled that the national system provided for protection of unregistered trademarks. Therefore, a party that was using a mark in commerce for which there was a pending application could file infringement action in a federal court. Upon notification by one of the parties, the opposition proceeding would be suspended until a decision was taken on the infringement action.

201. The Representative of AIM noted that the last sentence of paragraph 5 in document SCT/18/3 Prov. seemed to imply that opposition procedures always followed examination, while several Delegations had declared that their procedures established a reverse sequence. The Representative suggested adding another sentence in paragraph 5 to reflect the latter situation.

202. The Chair asked Delegations, which had a system of opposition prior to examination, to provide details on the nature of such a system.

203. The Delegation of Bulgaria said that its system provided for examination after opposition. An opposition period was established and the opponent could invoke absolute and relative grounds. In the course of examination, any opposition filed might be taken into consideration. However, the examiner was not bound to decide on that basis and could use a different argumentation.

204. The Chair noted that a clear advantage of this process was that any prior rights might be drawn to the attention of the examiner.

205. The Delegation of Colombia said that the legislation in Andean Community countries provided for examination to take place always after opposition. Substantive examination was carried out only when all arguments were received from the parties and in one single administrative act, the Office declared whether or not the opposition was founded or if for any other reason the mark was not registrable.

206. The Delegation of New Zealand asked the Delegation of Bulgaria what type of action the opponent to a trademark registration might take if the examiner did not consider the matters raised in opposition or if the former was not satisfied with the determination made of the matters raised.

207. The Delegation of Bulgaria replied that after registration of the trademark, the opponent might file invalidation procedures if he disagreed with the decision made by the examiner.

208. The Delegation of Portugal said that according to national procedures, once an application was received, it was published for opposition. When an opposition was filed, the applicant had a time limit for reply and the Office decided on the basis of all the grounds. The decision of the Office was published and could be subject to review by the courts.

209. In reply to a question from the Delegation of the United States of America, the Delegation of Bulgaria clarified that all applications were published by the Office and at that point, any party might decide whether or not to file an opposition.

210. The Delegation of Belarus declared that in Belarus there was no opposition procedure. National legislation provided for full examination on absolute and relative grounds, and from the start of the procedures, any person – including the holder of prior rights – was entitled to make observations in writing, which might influence the outcome of the examination. After registration, there was an administrative invalidation procedure and the final decision could be appealed before the courts.

211. The Delegation of Uruguay said that under national law and practice, every trademark application was published for opposition within 30 days of the date of publication. The applicant was informed of any opposition received, and in turn, the applicant could file arguments to be considered by the Office. In case of dispute concerning the grounds submitted by the opponent, a further time limit would be provided for the parties to present arguments. The examiner would reach its decision only then and this administrative act was subject to review and to appeal before the courts.

(b) Observations

212. The Delegation of Mexico informed that under national procedure, it was possible for third parties to formulate observations on absolute and relative grounds, with the aim of helping the examiner. The applicant was not required to reply to the observations, but they were taken into account in the final decision of the Office.

213. The Delegation of Colombia declared that observations were not provided for in national legislation. However, in practice, when oppositions were not filed, written observations were received from third parties noting the reasons why the Office should not register a trademark. The Office might take those arguments into account in its final decision, but the person filing the observation would not become a party to the proceedings. There was no fee for filing observations and they were not notified to the applicant or subject to appeal.

214. The Delegation of El Salvador noted that observations had been accepted by the national Office for quite some time. Observations were submitted to draw the attention of the examiner on particular aspects of the distinctive sign filed for registration. The examiner had to determine whether the observation complied with the law and it could be particularly useful in cases concerning well-known marks.

215. The Delegation of Chile noted that national legislation did not contemplate observations. However, parties frequently filed documents in which they made their views known to the registrar with regard to a trademark application.

216. The Delegation of Uruguay indicated that according to national practice, when observations were submitted beyond the opposition period, they were not taken into account in the examination process. However, the third party filing the observation could use it in an administrative appeal of the decision by the Office once the trademark was registered.

217. The Representative of INTA referred to paragraph 14 of the document which stated that observations may be filed by third parties in connection with or in parallel to opposition procedures. The Representative noted that, during the debate, several delegations had indicated that their national systems provided for procedures which were qualified as informal or pseudo opposition and such procedures were more akin to observations. The Representative mentioned that INTA had undertaken a comprehensive review of opposition procedures and practices on an international level and a preliminary conclusion of that review was that opposition procedures, whether before or after registration carried considerable merit from the point of view of both governments and consumers. The review showed a trend to the effect that countries which did not previously have opposition procedures were moving towards introducing such proceedings.

218. The Delegation of Norway said that the system applied in Norway consisted of full examination on both absolute and relative grounds. Norway had a post-registration opposition system, and national legislation allowed third parties to send observations during the examination period on both absolute and relative grounds. The observation was notified to the applicant for comments and the examiner decided on the basis of all the information submitted, together with other examination results. The third person submitting the observation did not become a party to the process, but if the trademark was registered, the Office notified that person in case it might wish to file an opposition.

Grounds of Opposition

(a) Absolute Grounds

219. The Delegation of the United States of America referred to paragraph 25 of document SCT/18/3 Prov., which mentioned that in general, trademarks which were in conflict with geographical indications were barred from registration. The Delegation noted that in the United States of America only a prior registered right on a geographical indication could act as a bar to registration. The Delegation suggested modifying the language of the introductory sentence.

220. The Representative of GRUR suggested that Section (a) be expanded to cover all the grounds on the basis of which Offices might refuse trademark applications. The list of grounds could derive from the accepted common international standard contained in Article 6*quinquies* of the Paris Convention, namely: absence of distinctive character, descriptiveness, generic or deceptive character of the mark, or the fact that the mark violated principles of public policy or morality. The Representative also noted that, in relation to conflicts with geographical indications, the rights concerned should not only be prior, but also referred to the jurisdiction in which the right was invoked and not in an absolute manner. An international treaty such as the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration or bilateral treaties could constitute additional legal basis in this area.

(b) Relative Grounds

221. The Delegation of El Salvador noted that a recurrent issue with regard to relative grounds was the difference between notorious and famous marks. The Delegation recalled that in the framework of the discussion on defensive or preventive marks at the last session of the SCT, other delegations declared that their legislation provided for famous marks as a separate category and it would be interesting to reflect that experience in this section of the document.

222. The Delegation of the Russian Federation considered it useful to mention in this context the experience of its national Office with regard to bad faith registrations. The issue did not constitute absolute or relative grounds in a classical sense but it seemed problematic in terms of good commercial practice. According to the legislation of the Russian Federation, there was a particular procedure to refuse that type of registration, which consisted of two steps. Firstly, an individual statement was made by the interested party with the anti-monopoly service, which took into account all of the information and proof submitted to support the claim. Secondly, if a decision was taken confirming that in fact the registration was based on bad faith, that decision could serve as the basis for a complaint to the Office, which would set in motion a procedure to challenge the registration. The latter decision would be published.

223. The Delegation of Colombia referred to paragraph 28 of document SCT/18/3 Prov. and said that although in national law defensive marks were not a separate category, in practice these cases did arise. The holders of marks usually registered them in different classes, even though they assumed that in some of those classes they might not necessarily use the mark. The Delegation declared that in Colombia a mark might be attacked for non-use and therefore the wording of the paragraph should be amended to cover that situation.

224. The Representative of GRUR suggested that Section (b) should be expanded to cover other relative grounds such as: earlier registered marks or applications, well-known marks, famous marks, marks with reputation, unregistered marks, trade names, copyrights, designs or even geographical indications. Less importance should be given to defensive trademark applications.

225. The Representatives of JPAA and JTA noted that some jurisdictions still had defensive trademark registrations. However, this figure dated back to the time when the concept of well-known mark was still developing. It was suggested to supplement paragraphs 27 and 28 of document SCT/18/3 Prov. with a sentence indicating that a mark which was well-known internationally could be taken into consideration as a relative ground for opposition.

Opposition Procedure

Publication

226. The Delegations of Chile and El Salvador suggested that paragraph 29 of document SCT/18/3 Prov., concerning publication, be clarified by expressly mentioning that the paper publication may be done in an official gazette.

Entitlement to File an Opposition

227. The Delegation of Japan referred to paragraph 32 of document SCT/18/3 Prov. and noted that its national system did not limit the entitlement to file an opposition to a person who had a legitimate interest, either on absolute or relative grounds. In Japan, any person could file an opposition. The objective of this norm was enhancing the trust and confidence in trademark registrations, so that following an opposition by any person, the Office could make an informed decision or correct its previous decisions, if necessary.

228. The Representative of GRUR referred to the question of standing in opposition procedures and suggested that a “key learning” in this matter should state two main issues. Firstly, with regard to absolute grounds, it seemed that the legitimate interest was very low if it existed at all. In fact, there seemed to be a public interest in not having marks on the register which violated the basic precepts of registrability and one might envisage that any person, without having to prove legitimacy or standing, could raise such an opposition. Secondly, and contrary to the former, in case of prior rights, only the proprietor of an earlier right or those expressly authorized by him could raise an opposition on relative grounds, such as an expressly authorized licensee, but not any third person.

Opposition Period

229. The Delegation of Australia suggested that paragraph 34 of document SCT/18/3 Prov. be modified to reflect national practice, whereby the initial time limit for opposition might be counted from the date of acceptance of the application.

230. The Delegation of Sweden requested that the information contained in the Annex to document SCT/18/3 Prov. with regard to the possibility of extensions of the time limit in Sweden be modified to reflect the system currently applied. In fact, it was not possible to extend the 2-month initial period, but it was possible to request for extensions of the time frames once the opposition proceedings had started.

231. With regard to the same issue, the Delegation of Latvia requested that the last column of the Annex, which was currently empty, read “no” as it was not possible to extend the initial time limit for opposition in Latvia.

“Cooling-off” Period

232. The Delegation of the United Kingdom informed the meeting that according to preliminary statistics, one third of oppositions filed in the United Kingdom ended in the cooling off period and during that same period, 40 to 50% of those oppositions were actually

settled. The Delegation noted that although it could not be said that those rates were due to the cooling off period, it certainly provided a window of opportunity for the parties to concentrate on settling their dispute. In addition, both parties had to agree before requesting the cooling off period.

233. The Representative of GRUR noted that the experience of trademark users in Europe had generally been very positive with the cooling off period. It was considered that a new forum had been made available to settle conflicts. The Representative noted that, in systems that provided for a cooling off period, a high rate of opposition cases did not proceed to a final decision and this demonstrated the utility of the system.

234. The Delegation of Sri Lanka wondered whether the relatively long period of time allowed for the cooling off period could lead to abuse of the system.

235. The Delegation of the United Kingdom noted that experience at the national level showed a significant drop off rate during the cooling off period. It seemed to avoid the urgency of shorter time limits when actions had to take place within those deadlines. The Delegation believed that it could not be concluded that longer time limits would necessarily lead to abuse, as reflected by the experience of the United Kingdom.

236. The Representative of GRUR expressed the view that there might be potential for abuse in any opposition system, for example in the case of reckless oppositions which, from the point of view of the applicant, were intended only to prolong the time limits. The Representative noted that the benefit of having a cooling off period on the side of both the opponent and the applicant was that at that stage of the proceedings, no evidence was required by the Office and therefore the parties could save themselves the cost of producing that evidence. There was also a benefit for the Office, which did not have to decide on such individual cases.

237. The Delegation of Australia declared that national authorities had given consideration to introducing in their procedures a modality similar to the cooling-off period.

Letter of consent

238. The Delegation of Uruguay clarified that even though there was no specific provision in national legislation concerning this form of settlement, in case of opposition by the owner of a prior registered trademark, there could be agreement with the applicant to limit the list of products to those not covered by the prior registration. In such a case, the opposition was withdrawn and the new mark was granted. However, the Office could oppose *ex officio* if it considered that even though the products were not competing, the marks were identical and might lead to confusion.

239. The Delegation of Mexico informed the meeting that its national legislation did not contemplate letters of consent. However, this had been a method of solving disputes between the owner of a prior registration and the applicant of a new and confusingly similar trademark. Nevertheless, two potential problems could arise in this case. Firstly, if a confusingly similar trademark registration was granted to a second person on the basis of an agreement with the

prior owner, it was not excluded that a third person might file a similar request. Secondly, a problematic situation could arise when the new owner decided to assign the trademark. Against this background, the Delegation believed that letters of consent seemed to create more problems than they could solve.

Appeal

240. The Delegation of the United States of America referred to paragraph 55 of document SCT/18/3 Prov. and said that according to national procedures, the losing party in an opposition had a double possibility to appeal on the decision of the opposition body. The party could appeal to the Court of Appeals of the Federal Circuit, or request a new trial in a District Court. With the former, the party could not introduce new evidence. However, with a new trial in the District Court, there was an opportunity for the losing party to introduce additional evidence and present additional arguments.

Related Procedures

241. The Delegation of Chile referred to paragraph 58 of document SCT/18/3 Prov. concerning related procedures and informed the meeting that according to national law, use of a mark was not a requirement for maintaining the registration. In fact, the law provided for other causes to request the cancellation of a mark and the paragraph might be enhanced to cover those causes. The Delegation noted that the reference to reasonable time limits would not cover the situation in Chile where there was a five-year time limit to request cancellation, and in the case of bad faith registration, there was no time limit.

242. The Chair explained that the reference to cancellation on the basis of non-use in document SCT/18/3 Prov. was only given as an example of a larger list of grounds. In addition, it could be considered that five years was indeed a reasonable time limit.

Developments

243. The Delegation of the United Kingdom referred to paragraphs 60 to 62 of document SCT/18/3 Prov. concerning the feature called “Preliminary Indication”. The Delegation noted that although the system had worked relatively well and there was a 40% drop-off rate when the system was first put into place, it could not be established whether that rate was due exclusively to preliminary indications. In certain cases, a preliminary indication would not be advisable and it was necessary to include this qualification in the above paragraphs. The Delegation further noted that, in cases where the decision was a very fine one, such as in relation to likelihood of confusion, a preliminary indication would not be helpful and the Office had the discretion not to give an indication. Nevertheless, in cases where the outcome was clear, such a tool could be useful.

244. In relation to paragraphs 63 and 64 of document SCT/18/3 Prov., the Delegation of the United States of America informed the SCT that the national rules concerning the “Mandatory Initial Disclosure” went into effect on November 1, 2007.

245. The SCT requested the Secretariat to finalize document SCT/18/3 Prov. on the basis of the report of the current session. Furthermore, the SCT requested the Secretariat to prepare a new working document for discussion at the nineteenth session, reflecting possible areas of convergence in the field of trademark opposition procedures taking into account administrative cancellation procedures.

Trademarks and Their Relation with Literary and Artistic Works

246. The discussion was based on document SCT/18/4.

247. The Delegation of Uruguay expressed the wish that the SCT might examine in more detail the relationship between copyright and advertising slogans.

248. The Delegation of El Salvador said that the domestic legislation in its country currently provided for the possibility of refusing registration to a mark on the ground of an existing copyright.

249. The Delegation of New Zealand wondered whether the request of the Delegation of Uruguay in terms of examining the relationship between copyright and advertisement was within the scope of the work of the SCT.

250. The Chair noted that, in his view, the request of the Delegation of Uruguay referred to the relationship between trademarks and copyright in advertising.

251. The Delegation of Uruguay said that its request related to the preparation of a document by the Secretariat, which would provide a detailed study on the grey area which exists between copyright, on the one hand, and advertising slogans and melodies, on the other hand, insofar as the latter might fall into the category of new types of marks. In particular, the document would focus on the criteria which are applied to decide that a given slogan or melody falls into the category of a mark or of a work enjoying copyright.

252. Recalling that slogans and sound marks were part of the subject matter of several other documents presented to the SCT, the Chair said that, before adding the request of the Delegation of Uruguay to the agenda under the item "Future Work," the Committee would have to make sure that the issue concerned was not already addressed in one of those documents. Moreover, consideration should be given to the workload involved in the preparation of a document such as the one suggested by the Delegation of Uruguay.

253. The Chair concluded that the SCT had noted the contents of document SCT/18/4 and agreed that it provided a useful overview. The Chair noted that no further work was requested in this area.

Article 6ter of the Paris Convention

254. Discussion was based on document SCT/18/5.

255. The Secretariat underlined that document SCT/18/5 summarized the implementation of the decisions taken at the seventeenth session of the SCT on the administration of Article 6ter of the Paris Convention for the Protection of Industrial Property. In particular, it recalled that further to those decisions, additional information should be provided with a request for

communication, namely relevant contact details concerning the requesting party, information concerning the constituting charter or agreement of international intergovernmental organizations, and information on the nature of the goods and services on which official signs and hallmarks were used. That information would henceforth be required and transmitted to all the States that received Article 6ter communications. The Secretariat drew the attention of the Standing Committee to the annexes of document SCT/18/5 containing templates for various requests. The Secretariat noted that it was recommended to States and organizations seeking protection for signs under Article 6ter to use those templates and provide all the information required. However, it pointed out that the templates were not forms that could not be changed, but merely a suggestion for presenting a particular request. Their format could thus be amended to fit an individual request. In addition, the Secretariat announced two novelties in the field of electronic communications. The first one was a new version of the Article 6ter Express Database, which was available on the WIPO Internet site, free of charge, for search and retrieval of records corresponding to more than 2,100 individual signs. That database would also be available in CD-ROM. It was foreseen to issue the database on CD-ROM once a year. Moreover, the Article 6ter data was available from an ftp server at <ftp://ftpird.wipo.int/wipo/6ter>, for downloading of all Article 6ter data in XML format and updated once a month.

256. The Delegation of Japan said that although it understood that the annexes to document SCT/18/5 were non-binding, it wished to point out the following. In order to better clarify the scope of protection under Article 6ter for each official sign or hallmark indicated in a communication, it would be preferable to state in the second heading of page 3 in Annex I of document SCT/18/5, "Official sign(s) and/or hallmark(s) indicating control and warranty and goods and/or services to which the sign(s) apply", and at the bottom of the form enumerate for each sign, the specific goods and services concerned. With regard to the draft requests for communication, the Delegation believed that mention should be made of States that are party to the Trademark Law Treaty (TLT) and are neither party to the Paris Convention nor members of the WTO. This proposal would concern the first paragraph of annexes I, II and III and the first, third and fifth paragraphs of annex VI. Moreover, the Delegation noted that where signs or abbreviations consisting of three letters were communicated under Article 6ter, it would be necessary to clarify the scope of protection to avoid conflicts with pre-existing trademark registrations. This would be particularly useful in countries using a different alphabet. The Delegation sought information about the practice of other States in this respect.

257. The Chair emphasized that the templates were not binding forms but simply guides, and proposed that the Committee ask the Secretariat to incorporate the suggestions made by the Delegation of Japan into the models that would be sent to States and organizations requesting protection under Article 6ter. With regard to the remark concerning signs and abbreviations consisting of three letters, the Chair asked the Delegation of Japan to present a proposal for discussion at the next session of the SCT.

258. The SCT noted the contents of document SCT/18/5.

International Nonproprietary Names for Pharmaceutical Substances (INNs)

259. The discussion was based on document SCT 18/6.

260. The Delegation of Mexico expressed interest in hearing the experiences of other SCT Members in connection with the examination of trademark applications against prior international nonproprietary names (INNs). In particular, it wished to know whether an application was refused only where the sign appearing in an application was identical to an INN or whether it was refused also where it was similar to an INN.

261. The Chair observed that the Delegation of Tunisia had suggested earlier in the meeting that consideration be given to the possibility of developing guidelines on the application of INNs in the context of examination.

262. The Delegation of Mexico noted that, as regards the comparison of two signs to be used as trademarks, the jurisprudence in its country had clearly established that granting similar trademarks for pharmaceuticals was very dangerous, as it could result in a likelihood of confusion which could put in danger the life of human beings. The Delegation said that its previous question referred rather to the policy in other offices relating to the comparison between a sign to be used as a trademark and an international nonproprietary name. In this regard, the Delegation explained that the Mexican Institute of Industrial Property (IMPI) received notifications of recommended INNs from the World Health Organization (WHO). The Mexican Office interpreted such notifications in the sense that marks which were identical or similar to recommended INNs were to be refused, but other offices might interpret them in the sense that only marks which were identical to such INNs were to be refused. The Delegation considered that it would be sensible that the notifications be interpreted in a harmonized manner. To that end, it suggested that the SCT requested clarification to WHO as to how the notifications were to be interpreted.

263. The Delegation of Colombia said that in its country the registration of a mark was refused, insofar only as the applied-for sign was identical to an INN. In contrast, registration was not refused to a sign which was similar to an INN, for instance where it began or ended with a part of an INN or where it evoked an INN, as long as the said sign was not confusingly similar with a prior mark. The Delegation confirmed that, while there was a higher risk that the marks which were similar to an INN might result in a likelihood of confusion with other marks, they were accepted for registration by the Colombian Office.

264. The Delegation of Slovenia pointed out that, while the issue was clear where a sign was identical to a recommended INN, examiners had sometimes difficulties in interpreting the circulars where a sign was similar. The Delegation said that, in examining pharmaceutical marks, the Slovenian Office applied the same criteria as for other marks.

265. The Delegation of the United States of America said that, in determining whether a proposed INN was in conflict with a trademark application or registered trademark, the USPTO conducted a search of the register and made a determination, taking into account the doctrine of greater care standard used in the regular examination of trademark applications for pharmaceutical products. If any application or registration was found during the search, the USPTO proceeded to review the proposed INN against a list of common stems. If the potentially conflicting proposed INN was based on a common stem and there were other INNs that used the same stem with different prefixes, then the conflict would be considered weak and the “cite” would be withdrawn. The Delegation explained that the USPTO also conducted a research to determine if the proposed INN or parts thereof had any significance in the pharmaceutical or medical field.

266. The Delegation of Uruguay said that in its country, registration of a mark was refused where the application was identical to a recommended INN. It considered that the circulars containing the lists of recommended INNs were to be interpreted strictly, and that a mark was therefore to be registered where the sign was only similar to an INN, provided that there was no likelihood of confusion between the sign and a prior mark.

267. Noting that the members of the SCT interpreted the circulars in which WHO notified the lists of recommended INNs in a divergent manner, the Chair suggested that the WHO Secretariat be invited to give a presentation at the next meeting of the SCT, regarding the way in which it intended the said circulars to be interpreted. It could be envisaged that the Secretariat might thereafter prepare a document identifying possible areas of convergence in the interpretation of the circulars.

268. The Delegations of Mexico and New Zealand supported the suggestion.

269. The SCT requested the Secretariat to invite the World Health Organization (WHO) Secretariat to make a presentation to the SCT at its next session concerning the application of the relevant WHO resolutions relating to the non-appropriation of proposed and recommended INNs.

Agenda Item 5: Industrial Designs

Questionnaire on Industrial Design Law and Practice (Part I)

270. The Secretariat informed the SCT that 62 returns to the Questionnaire on Industrial Design Law and Practice (Part I), contained in document SCT/18/7, had been received by the Secretariat by November 2, 2007. It further encouraged members of the SCT which had not replied to that questionnaire to do so.

Questionnaire on Industrial Design Law and Practice (Part II)

271. The discussion was based on document SCT/18/8.

272. The Delegation of Japan declared that the gathering of detailed information on the different design registration systems was an important exercise for the purpose of creating an environment for obtaining and effectively using design rights. Recalling that it had been one of the delegations requesting the creation of a second questionnaire at the seventeenth session of the SCT, the Delegation stated that, in its view, the two questionnaires would contribute significantly to the discussion.

Question 1

273. The Delegation of the Russian Federation requested clarification as to the idea behind the reference to “design patent legislation”.

274. The Secretariat said that question 1 aimed at categorizing the various legislative approaches which existed in the area of the protection of industrial designs. It suggested that the box N/A should be ticked by those countries in which a design patent system was not applicable and that the box “other” should be ticked by countries having a different system to the ones given as options for reply.

275. Replying to a question of the Delegation of the Russian Federation as to the notion of “simple registration system,” the Chair said that, while option 1 in question 1 referred to a design patent system, options 2 and 3 referred to a *sui generis* industrial design system registration.

276. The Delegation of the Russian Federation, observing that industrial designs were protected in its country under patent legislation but were registered as well, asked what was the difference between options 1 and 2.

277. The Secretariat suggested that, in replying to question 1, a country would need to determine whether it followed a procedure which was akin to that followed for utility patents, as it was the case in the United States of America, or rather a *sui generis*, less technical procedure, as that under the European Registered Community Design System. If the country considered that the procedure under its system was yet a different one, then it should reply under “Other”.

278. The Delegation of the Russian Federation, observing that it was important to fully understand the concepts used in the questionnaire, said that question 1 no longer posed a problem to it.

279. The Delegation of Australia, observing that there were jurisdictions in which systems of registered and unregistered designs coexisted, indicated that it would be useful if the members concerned would provide information of the scope of the protection obtained under each system. The Delegation noted, however, that the current design of the questionnaire did not allow for information on two different protection systems to be provided.

280. The Delegations of Panama and Ukraine said that they shared the concerns expressed by the Delegation of the Russian Federation, since designs were protected in those countries under the patent legislation, but were protected as a patent or as a design on a case by case basis.

281. In reply to a question by the Delegation of Germany, the Chair said that a country which recognized protection to industrial designs under three different systems, for instance under a *sui generis* design registration system, copyright and unfair competition, would have to tick the three boxes corresponding to those options in question 1.

282. The Secretariat noted that the purpose of question 1 was to give a broad indication of the system of protection of industrial designs in a given country with a view to enabling the Secretariat to make a quantitative analysis of the type of systems applicable.

283. Replying to a question by the Delegation of Bangladesh as to the possibility of having open questions in the questionnaire, the Chair pointed out that the advantage of a structured questionnaire was that it allowed for an easy analysis of the information, and suggested that open questions be used only where none of the options was suitable.

284. The Delegation of the United Kingdom said that, since more than one regime was available for the protection of industrial designs in its country, it wondered whether a separate paragraph should be introduced in the questionnaire to inform about each regime. The Delegation noted that the questionnaire was framed as if only one regime would be applicable.

285. The Chair said that a way to overcome that problem would be for a country to tick all the applicable options and to add another dash before “Other,” which would say: “More than one of the above”.

286. The Delegation of the United Kingdom said that each regime could protect different subject matter, which might need to be reflected in the main body of the questionnaire.

287. The Secretariat pointed out that the aim of question 1 was to provide at one glance a quantitative, broad idea of the applicable systems, even though there might be different systems for the protection of industrial designs in a given country and there might as a result be deficiencies in the answers. In their replies to the questionnaire, countries were requested to refer to the right in respect of which the Paris Convention afforded a six-month priority period. The Secretariat observed that providing information on each one of the different applicable regimes would render the compilation of replies very difficult.

288. The Delegation of New Zealand, noting that protection for industrial designs in its country could also be obtained by virtue of several regimes, suggested that question 1 be replied to by ticking all the boxes corresponding to the applicable options for protection of industrial design, but that the remaining questions be replied to on the basis of the primary mechanism for protection of industrial designs. The Delegation further proposed the inclusion of an additional question to indicate the primary mechanism for protection under which the questions had been answered.

289. The Delegation of France, noting that its country recognized a system of accumulation of regimes for the protection of industrial designs, said that it would have a problem to indicate a primary mechanism for protection.

290. The Chair suggested that, as opposed to referring to a primary mechanism of protection, the additional question would request a country to nominate the regime under which the replies to the questionnaire would be provided.

291. The Delegation of New Zealand observed that in its country users could choose to obtain protection for industrial designs under industrial designs legislation or, alternatively, under copyright. Illustrating the proposal by the Chair, it said that the replies to the questionnaire would be provided under the industrial designs legislation, although there was no preference in the regime that a person might choose for the protection of industrial designs in New Zealand.

292. The Chair confirmed its proposal in the sense that there would be a part a) of question 1), in reply to which members of the SCT would refer to all the possible options for protection of industrial designs in their territory, followed by a part b), in reply to which members would indicate one regime of protection, namely the one under which the rest of the questionnaire would have been completed.

293. The Delegation of Australia said that, while it understood the original purpose of the questionnaire, it considered that it would be useful to gather complete information on the systems of protection of industrial designs in the different countries. It proposed therefore that countries in which there were different systems available would reply twice to the questionnaire.

294. The Delegation of the United Kingdom, noting that it favored a simple questionnaire, supported the Chair's proposal, but suggested that an additional open text box be included in question 1 to enable a country to broadly describe the other available system.

295. The Delegation of Colombia suggested that there be a first question allowing for two options, namely whether a country had a specific regime for industrial designs or provided protection for designs under other mechanisms. If a country chose the second option, then it would indicate which other mechanisms.

296. The Delegation of Spain supported the Chair's proposal.

297. The Delegation of South Africa suggested adding a first question as to the existence or not of a *sui generis* protection system in the country, followed by a second question as to the other types of protection which were available.

298. The Delegation of the Russian Federation said that, while it supported the Chair's proposal, it considered that the suggestion of the Delegation of Australia was interesting, as it would allow members to see the trends in legislation in the different countries.

299. The Delegation of Croatia noted that it was first of all important to determine the purpose of question 1.

300. The Chair said that another possibility would be to delete question 1 and to reply to the questionnaire under the designs legislation.

301. The Secretariat, recalling that the first part of the questionnaire had already been completed under the *sui generis* industrial design legislation, pointed out that the idea behind part two of the questionnaire was to provide for additional questions, following the same approach as the first part.

302. The Chair proposed that question 1 be moved to the end of the questionnaire, so that offices would tend to reply in the same way as they replied to part one, and that the question be split into two parts, namely one which would indicate the legislation under which the preceding answers had been provided, and a second part enabling countries to indicate the other systems under which protection to industrial designs was also provided.

303. The Delegation of New Zealand expressed its support to the Chair's proposal.

304. The Chair noted that the SCT agreed to the proposal.

Questions 2 and 3

305. The Delegation of New Zealand expressed the view that the term "colors" in question 2 should be in the singular.

306. The Delegation of the Russian Federation suggested that a vast number of elements, such as product shape and packaging, typefaces graphic symbols, colors or textures, be deleted from question 2, as it considered that they were not subject to design protection. It further suggested that question 2 be divided into two questions, one relating to subject matter of industrial design and another one referring to the characteristics used in the description of the industrial design.

307. The Chair observed that there might be jurisdictions in which those elements could be subject matter of industrial design.

308. The Delegation of the European Community suggested the addition of other elements, namely color *per se*, a mere word or sequence of letters without a particular styling, an architectural plan, the interior of a room, cartoon characters and animated icons.

309. The Delegation of Colombia said that it would be difficult to reply to question 2 since a number of the elements listed were susceptible of design protection in the Andean Community, but provided only that they complied with the requirements of the Andean legislation.

310. The Delegation of New Zealand, observing that it would be reluctant to delete shapes as per the proposal of the Delegation of the Russian Federation, supported the proposal of the Delegation of the European Community.

311. Referring to the interventions of the Delegations of Colombia and the Russian Federation, the Chair pointed out that there might be countries in which only one element would be ticked, but that there were jurisdictions in which several elements would need to be ticked. It considered that, since the possibility of replying in the negative was given, it would be preferable to have a broader list.

312. The Delegation of Slovenia considered that a long list would result in a convoluted questionnaire and that by replying to the option "Other", countries would be given the possibility of adding elements which were not included in the list.

313. The Chair said that the criteria to decide whether a given element should or not remain in the list depended on the number of jurisdictions which included that element.

314. The Delegations of Uruguay and the United Kingdom supported the inclusion of further elements in the list, as opposed to narrowing down the list.

315. The Chair noted that the SCT agreed to add the items requested by the Delegation of the European Community.

316. The Delegation of the Russian Federation said that it would be interesting to know, as regards question 3, whether the part of the product which was subject to design protection was one that could be separated from the product or not.

317. The Representative of JPAA suggested that question 3 be divided into two questions, one referring to a part of the product which can be separated from the article, and another one referring to a part which cannot be separated from the article.

318. The Delegation of Australia wondered whether the concern would be addressed by adding a sentence such as “dotted lines can be used to represent matter which is not part of the industrial design”.

319. The Chair, pointing out that the said suggestion would not address the issue, noted that the SCT agreed to proposal of the Representative of JPAA.

Questions 4 to 9

320. The Delegation of Spain, referring to the Spanish version, suggested that the title “División de una solicitud de multiples diseños” be replaced by “División de una solicitud de registro de diseño”.

321. The Chair said that removing the term “multiple” in Spanish would entail its removal in the other languages and change the sense of the question, which was meant to address the situation in which a single application with multiple designs could be divided.

322. The Representative of JPAA suggested that the language be amended to read “where the industrial designs in an application do not meet the requirement of unity of design, the application can be divided”.

323. The Chair, noting that there were jurisdictions which allowed division of an application in circumstances other than lack of unity of design, stated that the current language was more appropriate.

324. The Delegation of Colombia declared that the Andean legislation did not allow for an application of multiple designs, and requested clarification as to how the question would have to be answered by its country.

325. The Chair confirmed that the box “n/a” would have to be ticked by those countries which did not provide for multiple design applications.

326. The Delegation of the Czech Republic, referring to the current language of question 5, said that it did not contemplate the situation in which division of a multiple design application could take place up to registration, as was the case in its country.

327. The Delegation of The former Yugoslav Republic of Macedonia, noting that the situation in its country was the same as in the Czech Republic, suggested that the option “Other” be added.

328. The Chair proposed that the words “months from” be deleted, and noted that the SCT agreed to that proposal.

329. The Delegation of the Russian Federation expressed the view that the third element in question 7, namely “any person”, called for clarification in the sense that the disclosure could not be made by just anybody, but by a person who for some reason had information with regard to the design.

330. The Delegation of Sweden said that there was a need to clarify the question as to whether the element “any person” included also disclosure made in bad faith.

331. The Delegation of New Zealand, observing that the language “any person” was confusing, suggested that the language “any other person” be used instead, supplemented by the sentence “if yes, please specify who and the conditions”.
332. The Delegation of Uruguay suggested that the term “a third non-authorized person” be used instead of “any person”.
333. The Chair proposed that the term “any person” be replaced by “any unauthorized person (bad faith)”, and confirmed, in reply to a question by the Delegation of New Zealand, that the fourth option “Other” would remain.
334. The Delegation of Switzerland said that another option could be added to question 7 to cover the event of abusive disclosure.
335. The Chair wondered whether the option suggested by the Delegation of Switzerland would not be covered by its proposal relating to “any unauthorized person (bad faith)”.
336. The Representative of JPAA suggested adding a further option for reply in question 7, namely “a person entitled to file a design application”.
337. The Delegation of Indonesia suggested adding a question relating to other circumstances under which disclosure was allowed before the filing of the application, for example in an international exhibition.
338. The Representative of GRUR, noting that in its view the questionnaire combined issues of substantive law and procedural points, suggested that at a future stage of the work of the SCT, the Committee would not only look at the procedure for obtaining protection of industrial designs but also at the conditions which applied in the various Members on points of substantive law.
339. The Delegation of Brazil supported the suggestion by the Delegation of Indonesia, and considered that the question should not be limited to the possibility of disclosure in an international exhibition.
340. The Chair proposed to add a question which would read “circumstances in which disclosure is permitted”, followed by yes or no answers, and invited delegations to provide the Secretariat with a list of potential circumstances.
341. The Delegation of Russia, referring to the Chair’s proposal regarding question 7, suggested adding “through negligence” to “bad faith”.
342. The Chair noted that the language used in that question would address all the concerns.

Questions 10 to 17

343. The Delegations of New Zealand expressed the view that, while the first three options given as a possible reply to question 10 referred to the trigger for examination, the fourth one dealt with the extent of the examination and should therefore be separated from that question.

344. The Delegation of the European Community, expressing support to the proposal by the Delegation of New Zealand, suggested adding a question as to the type of examination carried out by a country.

345. The Chair, observing that the proposal of the Delegation of the European Community was covered by question 38 of part I of the Questionnaire, noted that the SCT agreed to create a separate question as suggested by the Delegation of New Zealand.

346. The Delegation of the Former Yugoslav Republic of Macedonia, referring to questions 10, 11 and 14, pointed out that in its country substantive examination could take place either *ex officio* or on the basis of opposition, and that the questions as they stood did not reflect that situation.

347. The Representative of JPAA, referring to question 12, suggested replacing the “essential features of the industrial design” by “the features of the industrial design having an eye appeal”.

348. The Delegations of the European Community, the Russian Federation and Ukraine expressed the view that the language suggested by the Representative of JPAA would unduly narrow the scope of the question, and supported the text as it was.

349. The Representative of INTA requested clarification as to whether the second indent in question 10, namely “upon request of a third party,” was intended to cover opposition procedures or other procedures, and suggested that the questionnaire included such clarification.

350. The Chair indicated that in its understanding the option “upon request of a third party” was not limited to an opposition procedure, but covered also the case in which the requesting person did not become a party to the proceeding.

351. The Representative of INTA suggested that in that case another indent be added to cover a request upon opposition.

352. The Representative of Slovenia requested clarification as to whether there were jurisdictions in which the applicant himself would request examination of the application for compliance with substantive requirements.

353. The Chair confirmed that there were jurisdictions in which substantive examination was carried out only upon request of the applicant, against payment of a fee.

354. The Delegation of Austria suggested adding a further option to read “upon a request for cancellation or invalidation”.

355. The Representative of FICPI observed that the French version of question 10 did not correspond to the English one and suggested adding the option “either in the case of an opposition or an observation made by a third party”.

356. The Delegation of the European Community suggested adding a new question after question 13 to cover the case of examination as to individual character.

357. The Delegation of the Czech Republic supported the proposal by the European Community and suggested adding “lack of individual character” as a further option for reply in question 29.

358. The Delegation of New Zealand suggested deleting the word “months” from question 17.

359. The Chair noted that the SCT agreed to the proposals.

Questions 18 to 23

360. The Representative of JPAA, referring to question 18, suggested adding another option, namely “the date of putting the design in the course of trade or in the market”.

361. The Chair expressed doubt as to whether that circumstance came under the subject of question 18, which dealt only with the registration of an industrial design.

362. The Delegation of South Africa suggested adding “or by any other relevant authority” at the end of question 20.

363. The Chair noted that there was agreement to that proposal.

364. The Delegation of the European Community suggested adding another option for reply in question 22, namely “the overall impression created by the protected design and any other design.”

365. The Chair noted that there was agreement to that proposal.

366. The Representative of JPAA suggested adding a new option in question 23, namely “the consumer”.

367. The Delegation of the Russian Federation noted that it had submitted to the Secretariat a written proposal regarding question 20.

Questions 24 to 26

368. The Representative of INTA pointed out that in questions 25 and 30, the second indent should read “another Administrative Body”.

Questions 27 and 28

369. The Delegations of New Zealand and the Russian Federation expressed confusion as to the meaning of “dispute” in questions 27 and 28.

370. The Chair asked whether any delegation wished those questions to be deleted.

371. The Representative of GRUR said that it understood those questions to relate to alternative dispute settlement mechanisms. It expressed the view that they were useful questions, as they would enable the gathering of information on the use of such mechanisms in a given jurisdiction, including information on whether the said mechanisms were practiced only in respect of infringement or also in respect of issues regarding substantive requirements for protection.

372. The Delegation of Japan said that in its understanding, the word “dispute” referred to appeal or invalidation.

373. The Delegation of Ukraine expressed the view that questions 27 and 28 could be useful and should therefore remain.

374. The Representative of GRUR suggested that the section be called “Alternative dispute settlement mechanisms (mediation, arbitration)” and be followed by the two questions which it had put forward in writing.

375. The Delegation of New Zealand supported the proposal by the Representative of GRUR.

376. The Delegation of Japan said that its original intention had been to include a question on alternative dispute resolution.

377. The Delegation of Colombia suggested limiting the scope of the question to the possibility of alternative dispute resolution in the framework of administrative procedures.

378. The Representative of INTA, observing that its association promoted alternative dispute settlement mechanisms, expressed support to the proposal by the Representative of GRUR. Referring to the intervention of the Delegation of Colombia, it noted that including a section on alternative dispute settlement mechanisms would complete the picture as regards the types of proceedings available, considering that the questionnaire included also a section on invalidation and on opposition proceedings.

379. The Delegation of Panama expressed the view that the question on alternative dispute settlement mechanisms should refer, not only to the use of such mechanism in respect of infringement, but also in respect of administrative procedures.

380. The Representative of GRUR confirmed that the idea behind the question was to provide the possibility for delegations to indicate whether in their particular jurisdictions the notion of alternative dispute settlement mechanisms applied, followed by a question on the types of disputes which could be referred to such mechanisms.

381. The Delegation of Panama expressed support to the proposal by the Representative of GRUR.

382. The Delegation of Colombia, expressing the view that all systems tended to provide for the possibility of alternative dispute settlement mechanisms with respect to infringement procedures, considered that the question should focus on what was particular to the field of designs, namely the possibility of applying those mechanisms to administrative procedures. However, it agreed to the formulation of the question which had been proposed by the Representative of GRUR.

Questions 29 and 30

383. The Representative of JPAA suggested splitting the third option in question 29 into two separate options, so as to distinguish between “is dictated entirely by technical or functional consideration” and “is dictated partly by technical or functional considerations.”

384. The Delegation of South Africa suggested adding a further option, namely that “the applicant is not an authorized person”.

385. The Representative of GRUR expressed support to the suggestion by the Delegation of South Africa and suggested adding two other grounds of invalidity, namely that “the design does not fulfill the notion of design” and that “the design is in conflict with an earlier right”.

386. In reply to a request for clarification from the Delegation of New Zealand, the Delegation of South Africa explained that “authorized person” meant either the creator of the design or a person authorized by the creator to file the application, for example the employer.

387. The Delegation of Bangladesh suggested adding another ground for invalidity, namely “is not in accordance with a court order.”

388. The Delegation of Indonesia suggested adding “if the industrial design is contrary to the prevailing laws and regulations”.

389. The Chair, noting that the grounds suggested by Indonesia and Bangladesh were not widespread, suggested that those delegations ticked the box “Other” when replying to the questionnaire.

Questions 31 to 35

390. The Secretariat, in reply to a question by the Delegation of the European Community, said that it was deliberate that questions 2 and 31 did not coincide.

391. The Delegation of Colombia wondered whether it was necessary to include an exhaustive list of items.

392. The Delegation of the Russian Federation expressed the view that the list in question 2 should be reproduced in question 31.

393. The Chair noted that the SCT agreed to that proposal.

394. The Delegation of the Russian Federation noted that it had submitted to the Secretariat a written proposal regarding question 33.

Questions 36 to 38

395. The Delegation of New Zealand suggested adding an item to question 36, namely “may be alternatively protected under copyright law”.

396. The Representative of JPAA suggested adding a new section on the relation between industrial designs and unfair competition, taking the same questions as in the section on the relation with copyright.

397. The Chair noted that the SCT agreed to those proposals.

398. The Delegation of the Russian Federation noted that the questionnaire did not address the question of amendments to the application.

399. The Delegation of New Zealand noted that the questionnaires did not address the law and practice concerning change in ownership of an industrial design.

400. The Representative of INTA expressed interest in having a question on subject matter excluded from protection, for instance spare parts.

401. The Chair invited delegations to provide the Secretariat with the text which they wished to see included in the questionnaire.

402. The SCT requested the Secretariat to modify the questionnaire according to the proposals made by Members of the Committee.

403. The SCT agreed that the revised questionnaire would be distributed to Members by mid-December 2007. Replies to the questionnaire should be provided to the Secretariat by the end of January 2008.

Agenda Item 6: Geographical Indications

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

Agenda Item 7: Future Work

405. The Delegation of New Zealand proposed that the Standing Committee explore a more efficient and cost effective process for the distribution of communications under Article 6ter of the Paris Convention. In this regard, the Delegation suggested that the Secretariat review the existing procedures and present a document for consideration at the next session of the SCT.

406. The Chair noted that any change in this respect would require a recommendation to the Assembly of the Paris Union, the next meeting of which would be held in September 2008. Consequently, the SCT would have to decide on such a recommendation at its next session.

407. The Secretariat thanked the Delegation of New Zealand for its proposal and recalled that the Article 6^{ter} notification procedure had remained unchanged since 1883. After the considerable work achieved in particular with the implementation of a new database and the creation of the ftp server, it was important to keep the momentum and render the administrative procedure more efficient. The Secretariat proposed to develop a short background paper that would summarize the current procedures and raise some ideas on a more efficient and cost-effective process, for discussion at the next session of the SCT.

408. The Delegation of Uruguay requested the preparation of a document relating to the substantive examination of traditional marks. The document could be named guidelines, lessons learned, key learnings or best practices.

409. The Chair noted that the suggestion by Delegation of Uruguay might be linked with a discussion concerning areas of convergence in relation to opposition procedures. The Chair suggested that member States submit proposals to be compiled by the Secretariat in order to develop key learnings.

410. The Delegation of Tunisia supported the proposal made by the Delegation of Uruguay and mentioned some difficulties faced by its national Office in relation with opposition procedures for trademarks covering pharmaceutical products.

411. The Delegation of New Zealand proposed that the SCT discuss in the near future the technical aspects of the registration of certification or guarantee marks. In particular, the Delegation suggested undertaking a discussion on specific requirements for registration of certification marks and the determination of whether those requirements were satisfactory. The Delegation provided some examples of such requirements, namely: the kind of provisions that be included in the rules governing the certification mark; whether the applicant should be required to indicate that the trademark is a certification mark; whether the applicant should be required to be competent to certify the goods and services covered by the mark and who would assess that competence; whether the registration of the mark should be required to be in the public interest; when could a registration be refused on this ground, and under which grounds might a person apply to have an existing registration of a certification mark altered or cancelled.

412. The Delegation of Croatia supported the proposal made by the Delegation of New Zealand and mentioned that its Office was frequently confronted with the questions mentioned by the previous speaker.

413. The Delegation of Colombia pointed out that it was important, in particular for Andean countries, to discuss the issue of geographical indications. This issue was related to collective and certification marks in countries which did not have a *sui generis* system of protection for geographical indications. The Delegation proposed that the SCT undertake a survey, by means of a questionnaire on geographical indications.

414. The Delegation of Mexico supported the proposals made by the Delegations of New Zealand and Colombia on distinctive signs, certification and guarantee marks, collective marks and their relationship with the protection of geographical indications.

415. The Delegation of Slovenia considered that the Standing Committee could not address all of the issues proposed in one meeting and that it should establish priorities. The Delegation supported the proposal made by the Delegation of Uruguay, relating to substantive examination of traditional marks. Traditional marks accounted for the largest part of the work in many Offices. Thus, examining the existing convergences and differences should be the first priority of the Standing Committee. The Delegation suggested, as a second priority, to continue the work on Article 6*ter*, in order to submit a recommendation to the Paris Union Assembly, as suggested by the Delegation of New Zealand. The Delegation observed that a number of documents were already available on geographical indications and felt that the Committee should not include this item in its agenda as a priority.

416. The Delegation of New Zealand clarified that its proposal concerned an analysis of the provisions relating to the registration of certification and guarantee marks, rather than the links of this issue with geographical indications.

417. The Delegation of Ukraine proposed to include in the agenda for future work conflicts between marks and geographical indications and requested information on how other delegations resolved problems arising in this area.

418. The Chair noted that a first set of priorities had already been indicated for the Secretariat, namely to request the WHO to prepare a presentation on INNs for the next session and continue work in relation to Article 6*ter*. Against this background, the Chair suggested that the proposals relating to examination of traditional marks and technical aspects of the examination of certification marks be scheduled for the second session of the SCT in 2008.

419. The Delegation of New Zealand supported the proposal made by the Chair in relation to certification marks. The Delegation also noted that geographical indications were a permanent item on the agenda of the SCT and that the Standing Committee could come back to that particular item in the future.

420. The Delegation of Uruguay supported the proposal by the Chair.

421. The Delegation of El Salvador supported the proposal made by the Delegation of New Zealand and asked that the permanent agenda item concerning geographical indications and appellations of origin be placed under future work.

422. The Delegation of Norway supported the priorities set by the Chair, starting with the administration of Article 6*ter* and INNs and followed by studies on the examination of traditional trademarks and aspects of certification and guarantee marks.

423. The Delegation of Serbia supported the proposals made by the Delegations of Slovenia and Uruguay. However, it seemed that the proposal relating to examination of traditional marks was very broad and needed additional clarifications.

424. The Representative of the JPAA suggested that the Standing Committee continue dealing with the issue of industrial designs at its next session.

425. The Chair confirmed that the proposals just made related to additional areas of work and that the Standing Committee would continue the current work on designs.

426. The Delegation of Panama supported the proposals made in relation to geographical indications since this was an important issue for coffee producers in Panama. The Delegation also supported the proposals made for work on collective and certification marks and underlined that this could constitute a reference for work to be undertaken by the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), for the benefit of countries which did not have *sui generis* systems for protection in that area.

427. The Delegation of New Zealand observed that a discussion on the advantages of certification marks and collective marks, in relation to the protection of traditional knowledge and the development of marks for traditional products, would be more appropriately held in the IGC.

428. The Chair noted that several delegations had made proposals for future work of the SCT and that this would be recorded in the report. He concluded that the nineteenth session would continue work on non-traditional marks, trademark opposition procedures, industrial designs and INNs in accordance with the outcomes of the present session. In addition, the Secretariat was requested to prepare a working document on procedural aspects of communications under Article 6*ter* of the Paris Convention. Furthermore, he noted that proposals were made for additional future work relating to the examination of traditional marks and technical aspects relating to the registration of certification marks to be tentatively taken up at later sessions of the SCT. Geographical indications would continue to be a standing item on the agenda.

Agenda Item 8: Summary by the Chair

429. The Standing Committee adopted the draft of the Summary by the Chair contained in document SCT/18/9 Prov. with the modifications suggested by the Chair. The Summary by the Chair (document SCT/18/9) is reproduced in Annex I.

Nineteenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/19)

430. The Chair announced as tentative dates for SCT/19, June 2 to 6, 2008.

Agenda Item 9: Closing of the Session

431. The Chair closed the eighteenth session of the Standing Committee.

[Annexes follow]

WIPO



SCT/18/9

ORIGINAL: English

DATE: November 16, 2007

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**Eighteenth Session
Geneva, November 12 to 16, 2007**

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 participants on behalf of the Director General of WIPO.
2. Mr. Marcus Höpperger (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 2: Adoption of the Agenda

3. The SCT adopted the Draft Agenda (document SCT/18/1 Prov.) with one modification as suggested by the Delegation of New Zealand, namely the addition of a new Agenda Item 7 entitled "Future Work".

Agenda Item 3: Adoption of the Draft Report of the Seventeenth Session

4. The SCT adopted the Draft Report of the Seventeenth Session (document SCT/17/8 Prov.) with modifications as requested by the Delegations of France, Romania, the United Kingdom and the Representatives of the European Community and the International Trademark Association (INTA).

Agenda Item 4: Trademarks

Methods of Representation and Description of Non-Traditional Marks

5. The SCT requested the Secretariat to prepare a new document for the nineteenth session in relation to methods of representation and description of non-traditional marks.

6. The document would identify possible areas of convergence, based on documents SCT/17/2 and SCT/18/2 and the report of the current session. In particular, the document would focus on those areas where there has been less widespread experience and which have not been addressed comprehensively in the Singapore Treaty on the Law of Trademarks.

Relation of Established Trademark Principles to Non-Traditional Marks

7. The SCT noted the contents of document SCT/17/3 and agreed that it provided a useful overview. The Chair noted that no further work was requested in this area.

Trademark Opposition Procedures

8. The SCT requested the Secretariat to finalize document SCT/18/3 Prov. on the basis of the report of the current session. Furthermore, the SCT requested the Secretariat to prepare a new working document for discussion at the nineteenth session, reflecting possible areas of convergence in the field of trademark opposition procedures taking into account administrative cancellation procedures.

Trademarks and Their Relation with Literary and Artistic Works

9. The SCT noted the contents of document SCT/18/4 and agreed that it provided a useful overview. The Chair noted that no further work was requested in this area.

Article 6ter of the Paris Convention

10. The SCT noted the contents of document SCT/18/5.

International Nonproprietary Names for Pharmaceutical Substances (INNs)

11. The SCT requested the Secretariat to invite the World Health Organization (WHO) Secretariat to make a presentation to the SCT at its next session concerning the application of the relevant WHO resolutions relating to the non-appropriation of proposed and recommended INNs.

Agenda Item 5: Industrial Designs

Questionnaire Relating to Formalities of Industrial Design Registration (Part II)

12. Discussion was based on document SCT/18/8.
13. Following an extended exchange of views, the SCT requested the Secretariat to modify the questionnaire according to the proposals made by Members of the Committee.
14. The SCT agreed that the revised questionnaire would be distributed to Members by mid-December 2007. Replies to the questionnaire should be provided to the Secretariat by the end of January 2008.

Agenda Item 6: Geographical Indications

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

Agenda Item 7: Future Work

16. The Chair noted that several delegations had made proposals for future work of the SCT and that this would be recorded in the report. He concluded that the nineteenth session would continue work on non-traditional marks, trademark opposition procedures, industrial designs and INNs in accordance with the outcomes of the present session. In addition, the Secretariat was requested to prepare a working document on procedural aspects of communications under Article 6*ter* of the Paris Convention. Furthermore, he noted that proposals were made for additional future work relating to the examination of traditional marks and technical aspects relating to the registration of certification marks to be tentatively taken up at later sessions of the SCT. Geographical indications would continue to be a standing item on the agenda.

Nineteenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/19)

17. The Chair announced as tentative dates for SCT/19, June 2 to 6, 2008.

[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

Elena ZDRAVKOVA (Ms.), Acting Registrar, Patents and Design, Companies and Intellectual Property Registration Office (CIPRO), Pretoria

Fleurette COETZEE (Ms.), Interim Manager, Trade Marks Division, Companies and Intellectual Property Registration Office (CIPRO), Pretoria

ALGÉRIE/ALGERIA

Boumediene MAHI, secrétaire diplomatique, Mission permanente, Genève

ALLEMAGNE/GERMANY

Carolin HÜBENETT (Ms.), Head, International Registration Team, Department 3, Trade Marks, Utility Models and Industrial Designs, German Patent and Trade Mark Office, Munich
<carolin.hubenett@dpma.de>

Pamela WILLE (Ms.), Desk Officer, Division for Trademark Law, Law on Registered Designs, Law Against Unfair Competition, Federal Ministry of Justice, Berlin
<wille-pa@bmj.bund.de>

ARABIE SAOUDITE/SAUDI ARABIA

Fahad ALAHMARI, Counsellor, Saudi Customs Riyadh

Feras ABANMI, Industrial Design Examiner, Industrial Directorate, Riyadh
<fabanmi@kacsst.edu.sa>

Fahad ALNAFJAN, Patent Examiner, Industrial Directorate, Riyadh
<fnafjan@kacsst.edu.sa>

ARGENTINE/ARGENTINA

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

AUSTRALIE/AUSTRALIA

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

Michael ARBLASTER, Assistant General Manager, Trade Marks and Designs, IP Australia,
Woden ACT
<michael.arblaster@ipaaustralia.gov.au>

Tanya DUTHIE (Ms.), Assistant Director, Technical Policy and Projects, IP Australia,
Woden ACT
<tanya.duthie@ipaaustralia.gov.au >

AUTRICHE/AUSTRIA

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

BANGLADESH

Mustak Hassan Md. IFTEKHAR, Joint Secretary, Ministry of Industries, Dhaka
<dcheu@agni.com>

BÉLARUS/BELARUS

Eugeny ZINKEVICH, Head, Trademark Examination Department, National Center of
Intellectual Property (NCIP), Minsk
<e.zinkevich@belpatent.gin.by>

BELGIQUE/BELGIUM

Leen DE CORT (Mme), attaché au 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>

BRÉSIL/BRAZIL

María Elizabeth BROXADO (Miss), General Trademark Coordinator I, Trademark Directorate, National Institute of Industrial Property (INPI), Ministry of Development, Industry and Foreign Trade, Rio de Janeiro
<beta@inpi.gov.br>

Maria Alice CAMARGO CALLIARI (Mrs.), General Coordinator, Trademark Directorate, National Institute of Industrial Property (INPI), Ministry of Development, Industry and Foreign Trade, Rio de Janeiro
<calliari@inpi.gov.br>

BULGARIE/BULGARIA

Dobrinka DOBREVA (Mrs.), Director, Marks and Geographical Indications, Patent Office of the Republic of Bulgaria, Sofia

CAMEROUN/CAMEROON

Amin M'HAMED, chef de Service de la promotion, Ministère de l'industrie, des mines et du développement technologique, Yaoundé
<aminmar2000@yahoo.fr>

CANADA

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

Darlene H. CARREAU (Ms.), Legal Counsel, Legal Services, Industry Canada, Department of Justice, Ministry of Justice, Gatineau, Québec

CHILI/CHILE

Andrés GUGGIANA V., Legal Advisor, Intellectual Property Department, General Directorate of International Economic Affairs, Ministry of Foreign Affairs, Santiago
<aguggiana@direcon.cl>

Maximiliano SANTA CRUZ, Counsellor, Permanent Mission, Geneva

CHINE/CHINA

LU Zhi Hua, Director, Legal Affairs Division, Trademark Office, State Administration for Industry and Commerce (SAIC), Beijing
<lvzhihua@saic.gov.cn>

ZHANG Jun Qin (Mrs.), Deputy Director, Supervision Division, Trademark Office, State Administration for Industry and Commerce (SAIC), Beijing
<zhangjunqin@saic.gov.cn>

COLOMBIE/COLOMBIA

Giancarlo Alberto MARCENARO JÍMENEZ, Superintendente Delegado para la Propiedad Industrial, Superintendencia de Industria y Comercio (SIC), Bogotá

Clemencia FORERO UCROS (Sra.), Embajadora, Misión Permanente, Ginebra

Martha Irma ALARCON LOPEZ (Sra.), Ministro Consejero, Misión Permanente, Ginebra

COSTA RICA

Laura THOMPSON (Sra.), Embajadora, Misión Permanente, Ginebra

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>

CUBA

Alina ESCOBAR DOMINGUEZ (Mrs.), Third Secretary, Permanent Mission, Geneva

DANEMARK/DENMARK

Lene Juhl KJERRUMGAARD (Ms.), Special Legal Advisor, Danish Patent and Trademark Office, Ministry of Economic and Business Affairs, Taastrup

Anette TOFTENG (Ms.), Legal Advisor, Danish Patent and Trademark Office, Ministry of Economic and Business Affairs, Taastrup

EL SALVADOR

Silvia Estrella NASSER ESCOBAR (Srta.), Negociador de Propiedad Intelectual, Dirección de Política Comercial, Ministerio de Economía, San Salvador
<snasser@minec.gob.sv>

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

ÉQUATEUR/ECUADOR

Mauricio MONTALVO, Embajador, Representante Permanente, Misión Permanente, Ginebra

Luis VAYAS VALDIVIESO, Primer Secretario, Misión Permanente, Ginebra

ESPAGNE/SPAIN

Luis GIMENO OLCINA, Jefe, Unidad de Recursos, Departamento de Coordinación Jurídica y Relaciones Internacionales, Oficina Española de Patentes y Marcas, Ministerio de Industria, Turismo y Comercio, Madrid
<lui.gimeno@oepm.es>

José-Daniel VILA ROBERT, Jefe, Área de Examen de Modelos y Semiconductores, Departamento de Patentes e Información Tecnológica, Oficina Española de Patentes y Marcas, Ministerio de Industria, Turismo y Comercio, Madrid
<daniel.vila@oepm.es>

ESTONIE/ESTONIA

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

Kätlin ŠAHMATOVA (Ms.), Chief Specialist, Legal Department, Estonian Patent Office, Tallinn
<katlin.sahmatova@epa.ee>

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

Janis LONG (Ms.), Attorney-Advisor, Office of the Commissioner for Trademarks, United States Patent and Trademark Office (USPTO), Department of Commerce, Alexandria, Virginia
<janis.long@uspto.gov>

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

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

Snežana PETKOVSKA (Ms.), Head, Legal Department, Ministry of Economy, Skopje
<snezana.petrovska@economy.gov.mk>

Simčo SIMJANOVSKI, Head, Department for Trademarks, Industrial Designs and Geographical Indications, State Office of Industrial Property (SOIP), Skopje
<simcos@ippo.gov.mk>

Biljana LEKIĆ (Mrs.), Deputy Head, Department for Trademarks, Industrial Designs 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>

Olga KOMAROVA (Mrs.), Director, Department of Trademarks, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow
<okomarova@rupto.ru>

Olga ALEKSEEVA (Mrs.), Deputy Director on Scientific Work, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

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

Marina KORNAUKHOVA (Ms.), Principal Specialist, Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow
<mkornaukhova@rupro.ru>

Valentina ORLOVA (Mrs.), Deputy Rector, Russian State Institute of Intellectual Property (RGIIS), Moscow
<valentine-orlova@mail.ru>

FINLANDE/FINLAND

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

Pirjo ARO-HELANDER (Ms.), Lawyer, Trademarks and Designs Division, National Board of Patents and Registration, Helsinki
<pirjo.aro-henlander@prh.fi>

FRANCE

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

Mathilde MÉCHIN (Mme), chargée de mission au Service des affaires juridiques et contentieuses, Institut national de la propriété industrielle (INPI), Paris
<mmechin@inpi.fr>

GHANA

Loretta ASIEDU (Mrs.), First Secretary, Permanent Mission, Geneva
<laurieasiedu@yahoo.com>

GRÈCE/GREECE

Styliani KYRIAKOU (Mrs.), attaché, Permanent Mission, Geneva

HONGRIE/HUNGARY

Imre GONDA, Deputy Head, Trademark, Model and Design Department, Hungarian Patent Office, Budapest

INDONÉSIE/INDONESIA

S.T. ANDRIENSJAH, Senior Examiner of Industrial Design, Directorate of Copyright, Industrial Design, Layout Design of IC and Trade Secret, Directorate General of Intellectual Property Rights, Department of Law and Human Rights, Jakarta
<andrie_design@yahoo.com>

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

Asad ARDALAN, Legal Expert, Permanent Mission, Geneva
<aardalan2002@yahoo.com>

IRAQ

Ahlam Al-GAILANI, Counsellor, Permanent Mission, Geneva

Ahmed Al-NAKASH, Third Secretary, Permanent Mission, Geneva

ITALIE/ITALY

Riccardo COPPO, Director, Italian Patent and Trademark Office, Directorate General of Industrial Production, Ministry of Productive Activities, Rome
<riccardo.coppo@ministeroattivitaproduttive.it>

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

Vittorio RAGONESI, Legal Advisor, Foreign Office, Ministry of Foreign Affairs, Rome

JAMAHIRIYA ARABE LIBYENNE/LIBYAN ARAB JAMAHIRIYA

Hesham Rohoma HUWISA, Second Secretary, United Nation Department, Tripoli

JAPON/JAPAN

Masaya SUZUKI, Deputy Director, International Affairs Division, General Affairs Department, Japan Patent Office (JPO), Tokyo
<suzuki-masaya@jpo.go.jp>

Keisuke HAYASHI, Trademark Examiner, Trademark Division, Trademark Design and Administrative Affairs Department, Japan Patent Office (JPO), Tokyo
<hayashi-keisuke@jpo.go.jp>

Mari KUBOTA (Ms.), Design Examiner, Household equipment Division, Trademark, Designs and Administrative Affairs Department, Japan Patent Office (JPO), Tokyo
<kubota-mari@jpo.go.jp>

Kenichiro NATSUME, First Secretary, Permanent Mission, Geneva

KENYA

Sylvance Anderson SANGE, Chief Trade Mark Examiner, Kenya Industrial Property Institute (KIPI), Ministry of Trade and Industry, Nairobi
<ssange@kipi.go.ke>

KIRGHIZISTAN/KYRGYZSTAN

Galina DREMINA (Mrs.), Senior Specialist, International Relations Department, State Patent Service of the Kyrgyz Republic (Kyrgyzpatent), Bishkek
<galad2ooi@yandex.ru>

LETTONIE/LATVIA

Dace LIBERTE (Ms.), Director, Trademarks and Industrial Designs Department, Head of the Board of Appeal, Patent Office of the Republic of Latvia, Riga
<dace@lrpv.lv>

LITUANIE/LITHUANIA

Digna ZINKEVIČIENĖ (Ms.), Director, Trademarks and Designs Department, State Patent Bureau of the Republic of Lithuania, Vilnius
<d.zinkeviciene@vpb.gov.lt>

MALAISIE/MALAYSIA

Faridah YAAKOB (Mrs.), Assistant Registrar, Trademark Division, Intellectual Property Corporation of Malaysia, Kuala Lumpur
<faridahy@myipo.gov.my>

MAROC/MOROCCO

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

Mohammed BENJABER, Counsellor, Permanent Mission, Geneva

MEXIQUE/MEXICO

Joseph KAHWAGI RAGE, Director Divisional de Marcas, Instituto Mexicano de la Propiedad Industrial (IMPI), México
<jkahwagi@impi.gob.mx>

José Alberto MONJARAS OSORIO, Subdirector Divisional de Servicios Legales, Registrales e Indicaciones Geográficas, Instituto Mexicano de la Propiedad Industrial (IMPI), México
<amonjaras@impi.gob.mx>

Víctor Manuel GENINA CERVANTES, Consejero, Misión Permanente, Ginebra
<vgenina@delegamexoi.ch>

MOLDOVA

Alexandru ŞAITAN, Senior Expert, Trademark and Industrial Property Department, State Agency on Intellectual Property (AGEPI), Chisinau
<office@agepi.md>

NAMIBIE/NAMIBIA

Edward Tueutjiua KAMBOUA, Director of Internal Trade, Ministry of Trade and Industry, Windhoek

NORVÈGE/NORWAY

Solrun DOLVA (Ms.), Head, Trademark Section 1, Norwegian Patent Office (NPO), Oslo
<sdo@patentstyret.no>

Marie RASMUSSEN (Ms.), Head, Design Section, Norwegian Patent Office (NPO), Oslo
<mra@patentstyret.no>

NOUVELLE-ZÉLANDE/NEW ZEALAND

George WARDLE, Senior Analyst, Intellectual Property Policy Group, Ministry of Economic Development, Wellington
<george.wardle@med.govt.nz>

OMAN

Ali AL-MAMARI, Legal Auditor, IP Department, Ministry of Commerce and Industry, Muscat

PANAMA

Luz Celeste RÍOS DE DAVIS (Sra.), Directora General del Registro de la Propiedad Industrial, Ministerio de Comercio e Industria, Panamá

PAYS-BAS/NETHERLANDS

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

POLOGNE/POLAND

Marta CZYŻ (Mrs.), Director, Trademark Department, Patent Office of the Republic of Poland, Warsaw
<mczyz@uprp.pl>

Andrzej SZCZEPEK, Expert, Trademark Department, Patent Office of the Republic of Poland, Warsaw
<aszczepk@uprp.pl>

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

PORTUGAL

Maria Joana MARQUES CLETO (Mrs.), Counsellor, International Relations Advanced Technician, National Institute of Industrial Property (INPI), Lisbon
<jmcleto@inpi.pt>

QATAR

Ahmed Yousif AL-JETAIRI, Head, Industrial Property Office, Ministry of Economy and Commerce, Doha

RÉPUBLIQUE ARABE SYRIENNE/SYRIAN ARAB REPUBLIC

Hiam DIAB, Head, Department of International Registration, Directorate of Industrial and Commercial Property, Damascus
<syr.d.c.i.p@net.sy>

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

JIN Myoung Sup, Director, Trademark and Design Examination Policy Division, Korean Intellectual Property Office (KIPO), Daejeon
<jms525@kipo.go.kr>

YANG Seung Tae, Director, Trademark and Design Examination Policy Team, Korean Intellectual Property Office (KIPO), Daejeon
<winystar@kipo.go.kr>

RÉPUBLIQUE DOMINICAINE/DOMINICAN REPUBLIC

Gladys Josefina AQUINO (Srta.), Consejera, Misión Permanente, Ginebra

RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Petr OBDRŽÁLEK, Law Department, Industrial Property Office, Prague
<pobdrzalek@upv.cz>

Zlataše BRAUNŠTEINOVÁ (Mrs.), Examiner, Trademarks Department, Industrial Property Office, Prague
<zbraunsteinova@upv.cz>

ROUMANIE/ROMANIA

Constanta Cornelia MORARU (Mrs.), Head, Legal and International Cooperation Department, State Office for Inventions and Trademarks (OSIM), Bucharest
<moraru.cornelia@osim.ro>

Alice Mihaela POSTĂVARU (Ms.), Head, Industrial Designs Section, State Office for Inventions and Trademarks (OSIM), Bucharest
<postavaru.alice@osim.ro>

Livia PUSCARAGIV (Miss), Second Secretary, Permanent Mission, Geneva

ROYAUME-UNI/UNITED KINGDOM

Eileen TOTTLE (Mrs.), Policy Advisor, UK Intellectual Property Office, Newport
<eileen.tottle@ipo.gov.uk>

June DAVIES (Ms.), Policy Officer, UK Intellectual Property Office, Newport
<june.davies@ipo.gov.uk>

Edward Stephan SMITH, Training Manager, Trade Marks Directorate, UK Intellectual Property Office, Newport
<Edward.smith@ipo.gov.uk>

SERBIE/SERBIA

Vladimir MARIĆ, Head, Trademark Department, Intellectual Property Office, Belgrade
<vmaric@yupat.sv.gov.yu>

Marija PETROVIĆ (Ms.), Independent Counsellor, Trademark Department, Intellectual Property Office, Belgrade
<mpetrovic@yupat.sv.gov.yu>

SINGAPOUR/SINGAPORE

LEE Li Choon (Ms.), Director, Trade Marks, Intellectual Property Office of Singapore (IPOS), Singapore

CHAN Louis Ken Yu, Deputy Director, Legal Counsel, Trade Marks, Intellectual Property Office of Singapore (IPOS), Singapore
<louis_chan@ipos.gov.sg>

SLOVAQUIE/SLOVAKIA

Zdenka HAJNALOVÁ (Mrs.), Director, Trademarks and Designs Department, Industrial Property Office of the Slovak Republic, Bratislava
<zhajnalova@indprop.gov.sk>

Ingrid MARUNIAKOVÁ (Mrs.), Dispute Procedure Division, Industrial Property Office of the Slovak Republic, Bratislava
<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>

SRI LANKA

Dinal PHILLIPS, Chairman, Intellectual Property Advisory Commission, National Intellectual Property Office, Colombo
<dphil@sltnet.lk>

SUÈDE/SWEDEN

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

Maria WESTMAN-CLÉMENT (Mrs.), Special Advisor, Division for the Intellectual Property and Transport Law, Ministry of Justice, Stockholm
<maria.westman-clement@jushce.ministry.se>

SUISSE/SWITZERLAND

David LAMBERT, avocat, conseiller juridique à la Division des marques, Institut fédéral de la propriété intellectuelle (IFPI), Berne
<david.lambert@ipi.ch>

Marcel VOLKART, conseiller juridique à la Division des marques, Institut fédéral de la propriété intellectuelle (IFPI), Berne
<marcel.volkart@ipi.ch>

Corinne HOFMANN (Mrs.), stagiaire juridique, Institut fédéral de la propriété intellectuelle (IFPI), Berne

THAÏLANDE/THAILAND

Chaiyavat TANGKROCK-OLAN, Senior Standards Officer, Chief of Information Systems Group, Standards Information Centre, Thai Industrial Standards Institute (TISI), Ministry of Industry, Bangkok
<chaiya@tisi.go.th>

Thanaporn TUNJOY, Foreign Relations Officer, WTO Group, International Relations Division, Thai Industrial Standards Institute (TISI), Ministry of Industry, Bangkok
<thanapon@tisi.go.th>

TUNISIE/TUNISIA

Mokhtar HAMDİ, sous-directeur du 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

TURQUIE/TURKEY

Naim UĞUR, Head, Industrial Design Department, Turkish Patent Institute, Ankara
<nugur@tpe.gov.tr>

Sadettin AKIN, Trademark Examiner, Turkish Patent Institute, Ankara

Tolga KARADENİZLİ, Assistant Trademark Examiner, Trademark Department, Turkish Patent Institute, Ankara

UKRAINE

Tamara SHEVELEVA (Mrs.), Advisor to the Chairman, State Department of Intellectual Property (SDIP), Ministry of Education and Science of Ukraine, Kyiv
<sheveleva@sdip.gov.ua>

Anastasiia MINDRUL (Mrs.), Principal Specialist, Legislation Development Division, State Department of Intellectual Property (SDIP), Ministry of Education and Science of Ukraine, Kyiv
<a.mindrul@sdip.gov.ua>

Vasil K. BANNIKOV, Head, Division of Trade Marks and Production Pieces, Ukrainian Industrial Property Institute, State Department of the Intellectual Property (SDIP), Kyiv
<v.bannikov@ukrpatent.org>

Saida KRYVOSHEY (Ms.), Deputy Head, Law Signs Division, Ukrainian Industrial Property Institute, State Department of the Intellectual Property (SDIP), Kyiv

URUGUAY

Graciela ROAD D'IMPERIO (Sra.), Director Asesoría, Dirección Nacional de la Propiedad Industrial, Montevideo
<dnpiuy@adinet.com.uy>

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

Tomas Lorenzo EICHENBERG, Legal and Policy Affairs Officer, Industrial Property, European Commission, Brussels
<tomas.eichenberg@ext.ec.europa.eu>

Francesco LUCCISANO, Permanent Delegation of the European Commission, Geneva

Vincent O'REILLY, Director, Department for IP Policy, Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Alicante
<vincent.oreilly@oami.europa.eu>

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

Jacqueline HÉLIANG (Mme), juriste au Service des signes distinctifs, Yaoundé

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

Camille JANSSEN, Lawyer, Legal Affairs Department, The Hague

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 allemande de la propriété industrielle et du droit d'auteur (GRUR)/German
Association for Industrial Property and Copyright (GRUR)
Alexander VON MÜHLENDAHL, Attorney-at-Law, Munich
<office@grur.de> <vonmuhlendahl@bardehle.de>

Association américaine du droit de la propriété intellectuelle (AIPLA)/American Intellectual
Property Law Association (AIPLA)
Brett HEAVNER, Attorney-at-Law, Washington, D.C.
<b.brett.heavner@finnegan.com>

Association communautaire du droit des marques (ECTA)/European Communities Trade
Mark Association (ECTA)
Leopold von GERLACH, Chairman, Designs Committee, Hamburg
<leopold.vongerlach@lovells.com>
Sandrine PETERS (Mrs.), Legal Co-ordinator, Antwerp
<sandrine.peters@ecta.org>

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 des industries de marque (AIM)/European Brands Association (AIM)
Jean BANGERTER, Representative, Brussels
<bangerter.jean@citycable.ch>

Association internationale pour la protection de la propriété industrielle (AIPPI)/International
Association for the Protection of Industrial Property (AIPPI)
Peter WIDMER, Attorney-at-Law, Bern
<widmer@fmp-law.ch>

Association internationale pour les marques (INTA)/International Trademark
Association (INTA)
Bruno MACHADO, Geneva Representative, Rolle
<bruno.machado@bluewin.ch>

Association japonaise des conseils en brevets (JPAA)/Japan Patent Attorneys Association
(JPAA)
NAKAYAMA Kenichi, Vice-Chairman, Trademark Committee, Tokyo
<kenichi.nakayama@bakernet.com>

NAKAMURA Tomohiro, Member, Design Practice Committee, Tokyo
<nakamura@ipworld.jp>

Association japonaise pour les marques (JTA)/Japan Trademark Association (JTA)
NAKAYAMA Kenichi, Registered Patent Attorney, Attorney-at-Law (admitted to
New York), Tokyo
<kenichi.nakayama@bakernet.com>

Chambre de commerce internationale (CCI)/International Chamber of Commerce (ICC)
Gonçalo DE SAMPAIO, Intellectual Property Counsellor, 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)
Jean-Marie BOURGOGNON, Representative, Paris
<courrier@cabinet-loyer.fr>

IV. BUREAU/OFFICERS

Président/Chair: Michael ARBLASTER (Australie/Australia)

Vice-présidents/Vice-Chairs: Maximiliano SANTA CRUZ (Chili/Chile)
CHAN Louis Ken Yu (Singapour/Singapore)

Secrétaire/Secretary: Marcus HÖPPERGER

V. **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

Matthjis GEUZE, conseiller principal au Bureau du sous-directeur général/Senior Counsellor,
Office of the Assistant Director General

Marcus HÖPPERGER, directeur par intérim de la Division du droit et des classifications
internationales/Acting Director, Law and International Classifications Division

Martha PARRA FRIEDLI (Mme/Mrs.), chef de la Section du droit, Division du droit et des
classifications internationales/Head, Law Section, Law and International Classifications
Division

Marie-Paule RIZO (Mme/Mrs.), juriste principale à la Division du droit et des classifications
internationales/Senior Legal Officer, Law and International Classifications Division

[End of Annex II and of document]