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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Nineteenth Session
Geneva, July 21 to 25, 2008

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. Mr. Francis Gurry, Deputy Director General, opened the session and welcomed the participants.
2. Mr. Ernesto Rubio, Assistant Director General, reported on the work done by the International Bureau in preparation for the 19th session of the Standing Committee in connection with each of the topics proposed for discussion.
3. Mr. Marcus Höpperger (WIPO) acted as Secretary to the Standing Committee.

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

4. Mr. Michael Arblaster (Australia) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) for the year 2008. Mr. Louis Chan (Singapore) and Mr. Imre Gonda (Hungary) were elected as Vice-Chairs for the same period.

Agenda Item 3: Adoption of the Agenda

5. The SCT adopted the Draft Agenda (document SCT/19/1 Prov.2) without modifications.

Agenda Item 4: Accreditation of a Non-Governmental Organization

6. Discussion was based on document SCT/19/7 (Accreditation of a Non-Governmental Organization).
7. The SCT approved the representation in sessions of the Standing Committee of the Brazilian Association of Intellectual Property.

Agenda Item 5: Adoption of the Draft Report of the Eighteenth Session

8. The SCT adopted the Draft Report of the Eighteenth Session (document SCT/18/10 Prov.2) with modifications as requested by the Delegations of China and the Russian Federation.

Agenda Item 6: Trademarks

Representation and Description of Non-Traditional Marks – Possible Areas of Convergence

9. Discussion was based on document SCT/19/2.
10. The Chair indicated that this discussion did not impose any obligation on Members of the SCT to provide for the registration of non-traditional marks. Each Member may decide whether and when to provide for the registration of non-traditional marks.
11. The Chair noted that the work of the SCT on possible areas of convergence for the representation and description of non-traditional marks had already proved to be useful and was worthwhile pursuing in order to create a body of reference that would promote consistency of outcomes under various national procedures. Concerning the debate on individual areas of possible convergence, and with reference to the text provided in document SCT/19/2, he noted:

Possible area of convergence No. 1 (three-dimensional marks):

12. There was agreement in the SCT that a sufficiently clear representation showing one single view of a three-dimensional mark was sufficient for the granting of a filing date. Nevertheless, Offices may require more views or a description of the three-dimensional mark for the purposes of examination. However, there were diverging opinions as to the number of different views of a three-dimensional mark that should be published by the Office.

Possible area of convergence No. 2 (color marks):

13. The SCT was in agreement with the text for an area of convergence on color marks, subject to amending the words: “a representation of such marks could consist of ...” to “Offices may require that a representation of such marks consist ...”.

Possible area of convergence No. 3 (hologram marks):

14. The SCT was in agreement with the text for an area of convergence on hologram marks, subject to amending the text to the effect that Offices may require a description of the hologram mark where a single drawing or a series of drawings did not accurately represent the hologram.

Possible area of convergence No. 4 (motion or multimedia marks):

15. The SCT was in agreement with the text for an area of convergence on motion or multimedia marks, subject to amending the text to the effect that Offices may require that the application include a written description explaining the movement. Furthermore, the Chair noted that a number of delegations that had experience with the registration of motion or multimedia marks had observed that the character of such marks was best captured if the mark was represented in motion. Where electronic filing was available, an electronic file could be submitted with the application.

Possible area of convergence No. 5 (position marks):

16. The SCT was in agreement with the text for an area of convergence on position marks as presented.

Possible area of convergence No. 6 (gesture marks):

17. The term gesture mark was used by industry, but not necessarily in legal statutes. Based on this understanding, the SCT was in agreement with the text for an area of convergence on gesture marks as presented.

Possible area of convergence No. 7 (sound marks):

18. There was agreement by the SCT that an area of convergence for sound marks would not distinguish between musical and non-musical sounds. Offices may require that the representation of sound marks could consist of a musical notation on a staff, or a description of the sound constituting the mark, or of an analog or digital recording of that sound, or of any combination thereof. Where electronic filing was available, an electronic file could be submitted with the application. However, for some jurisdictions, only a musical notation on a staff could be considered as adequately representing the mark.

Possible area of convergence No. 8 (olfactory marks):

19. The SCT could not identify an area of convergence as regards the representation of olfactory marks. Some jurisdictions had accepted that such marks could be represented through a description, whereas for other jurisdictions, a description could not adequately represent the character of such marks.

Possible area of convergence No. 9 (taste marks):

20. The SCT could not identify an area of convergence as regards the representation of taste marks. Some jurisdictions had accepted that such marks could be represented through a description, whereas for other jurisdictions, a description could not adequately represent the character of such marks.

Possible area of convergence No. 10 (texture or feel marks):

21. The SCT could not identify an area of convergence as regards the representation of texture or feel marks. Some jurisdictions had accepted that such marks could be represented through a description, whereas for other jurisdictions, a description could not adequately represent the character of such marks.

22. On the publication of non-traditional marks, the Chair noted that with the introduction of new technologies and an increased use of non-traditional marks, limitations of the size of representations were becoming less relevant, with Offices indicating that the clarity of the representation was more important.

23. In conclusion of the discussion on document SCT/19/2, the Chair stated that all comments on possible areas of convergence made by delegations would be recorded in the Report of the meeting. The Secretariat was requested to prepare a new document for consideration at the next session of the SCT, taking into consideration all requests for amendments, and consisting of a general introduction, a description of areas of convergence as amended, and, where appropriate, explanatory notes.

Trademark Opposition Procedures – Possible Areas of Convergence

24. Discussion was based on document SCT/19/3. In respect of individual possible areas of convergence, the Chair noted the following:

Possible area of convergence No. 1 (Third Party Intervention in Trademark Registration Procedures):

25. The SCT was in agreement with area of convergence No. 1, subject to adding a reference to interested third parties and the public at large. Furthermore, a note would be added clarifying that this area of convergence did not create a presumption of who had legal standing in the procedures mentioned.

26. The SCT noted that the Delegation of Mexico considers that the invalidation procedures conducted at its industrial property office constituted a post-registration opposition procedure.

Possible area of convergence No. 2 (Relation Between Opposition and Examination Procedures):

27. The SCT was in agreement with area of convergence No. 2.

Possible area of convergence No. 3 (Grounds for Opposition):

28. The SCT was in agreement with area of convergence No. 3, subject to an amendment to the effect that opposition procedures should allow oppositions to be raised at least based on prior trademark rights in the jurisdiction concerned.

Possible area of convergence No. 4 (Entitlement to File an Opposition):

29. The SCT was in agreement with area of convergence No. 4, subject to an amendment to the effect that at least owners of prior trademark rights in the jurisdiction concerned should be entitled to raise an opposition.

Possible area of convergence No. 5 (Opposition Period):

30. The SCT was in agreement with area of convergence No. 5, subject to changing the words “would run over two months” to “would be two months.”

Possible area of convergence No. 6 (Observations):

31. The SCT was in agreement with area of convergence No. 6, subject to omitting the words “to enter into a formal procedure with the person that has made the observation.”

Possible area of convergence No. 7 (“Cooling-Off” Period):

32. The SCT was in agreement with area of convergence No. 7.

International Nonproprietary Names for Pharmaceutical Substances (INNs)

33. Discussion was based on document SCT/19/4.

34. The Chair concluded that the Secretariat would continue to circulate information concerning the publication of new lists of proposed and recommended INNs by way of paper circular and, in addition, by an e-mail alert to all offices of SCT Members and to SCT observers that have subscribed to the SCT electronic forum. Furthermore, the SCT requested the Secretariat to explore together with the WHO Secretariat possibilities of developing a publicly searchable database for INNs.

Article 6ter of the Paris Convention

35. Discussion was based on document SCT/19/5.

36. The Chair concluded that the SCT agreed to recommend the following draft decision for adoption by the Assembly of the Paris Union:

1. The reciprocal communication through the intermediary of the International Bureau, under Article 6ter(3)(a) and (b) of the Paris Convention for the Protection of Industrial Property (“Paris Convention”), of signs for which protection under Article 6ter(1)(a) and (b) is requested will be made through a semi-annual publication, in an electronic database on the website of the World Intellectual Property Organization (“WIPO”).
2. This periodical publication will be made on the last working day* of the months of March and September, respectively, starting in March 2009.

* According to the WIPO calendar.

3. The published signs will be transmitted simultaneously in electronic format stored on a hard carrier to the trademark registration administrations of the States party to the Paris Convention and of the Members of the World Trade Organization (WTO) that are not party to the Paris Convention, which have made an express request to that effect.
4. For the purposes of Article 6ter(4) and (6) of the Paris Convention, the date of the electronic publication shall be considered to constitute the date of receipt of a communication by any State party to the Paris Convention or any other party bound to apply Article 6ter of the Paris Convention.
5. This decision is without prejudice to the application of Article 6ter(3)(a) *in fine*.

Agenda Item 7: Industrial Designs

Summary of Replies to the Questionnaires (Parts I and II) on Industrial Design Law and Practice (SCT/18/7 and SCT/18/8 Rev.)

Industrial Design Law and Practice – Analysis of WIPO Questionnaires and Some Conclusions

37. Discussion was based on documents SCT/19/6 and WIPO/STrad/INF/2.
38. The Chair concluded that work on the documents for the present session would be continued at the next session of the SCT.

Agenda Item 8: Geographical Indications

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

Twentieth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/20)

40. The Chair announced as tentative dates for SCT/20, December 1 to 5, 2008.

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