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

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REPRESENTATION OF NON-TRADITIONAL MARKS
AREAS OF CONVERGENCE

document prepared by the Secretariat

INTRODUCTION

1. From its sixteenth session (November 13 to 17, 2006) through to its nineteenth session (July 21 to 25, 2008), the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) considered a number of working documents dealing with the representation of non-traditional marks (see documents SCT/16/2, SCT/17/2, SCT/18/2 and SCT/19/2).

2. Those working documents are based on information contained in the Summary of Replies to the Questionnaire on Trademark Law and Practice (document WIPO/STrad/INF/1, hereinafter referred to as the “Questionnaire”), which reflects the replies received from 73 Member States and three intergovernmental organizations, and take into consideration specific contributions submitted by the following members of the SCT: Australia, Belgium (through the Benelux Organization for Intellectual Property (BOIP)), Brazil, Bulgaria, Chile, China, Croatia, Denmark, Ecuador, Finland, France, Germany, Italy, Japan, Luxembourg (through the BOIP), Morocco, Netherlands (through the BOIP), Norway, Republic of Korea, Republic of Moldova, Russian Federation, Slovenia, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, Turkey, United Kingdom, United States of America, and the European Community.

3. At its nineteenth session, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) agreed on the areas of convergence relating to the representation of non-traditional marks reproduced in the Annex to this document. In so doing, the SCT noted that the areas of convergence 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 such marks.

4. The SCT understood that the areas of convergence constituted a body of reference that could be used by Offices, as well as by trademark owners and practitioners, who were moving into new marketing and advertising techniques, for which they required flexibility as to the available subject matter that may be used to identify their goods and services.

5. The SCT is invited to take note of the areas of convergence on the representation of non-traditional marks as agreed by the SCT at its 19th session and presented in the Annex to this document.

[Annex follows]

ANNEX

REPRESENTATION OF NON-TRADITIONAL MARKS
AREAS OF CONVERGENCE

Area of Convergence No. 1
Three-dimensional Marks

With regard to an application for the registration of a three-dimensional mark, a sufficiently clear representation showing one single view of the mark is 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.

Notes

1.01 If additional views and other elements, such as a description of the three-dimensional mark, are required, the applicant should be given reasonable time limits to supply them. Rule 5(1) of the Singapore Treaty on the Law of Trademarks (the Singapore Treaty) provides that the Office may invite an applicant to supply missing requirements within a time limit indicated in the invitation, which time limit shall be at least one month from the date of the invitation where the applicant's address is on the territory of the Contracting Party concerned and at least two months where the applicant's address is outside the territory of the Contracting Party concerned.

1.02 Opinions as to how many views of a three-dimensional mark should be published by the Office when multiple views are submitted remain divergent.

Area of Convergence No. 2
Color Marks

With regard to an application for the registration of a color per se mark or a combination of colors without delineated contours, Offices may require that a representation of such marks consist of a sample of the color(s) on paper or in an electronic format. Offices may require a designation of the color(s) by using their common names. Furthermore, Offices should allow the indication of recognized color codes to be chosen by applicants. Offices may also require a written description on how the color is applied to the goods or used in relation to the services.

Notes

- 2.01 In the case of color combinations, certain Offices require the applicant to indicate the ratio or distribution of the colors used.
- 2.02 Internationally recognized color codes are deemed to be precise and stable and their use in trademark applications contributes to clarify the nature and the scope of color marks.

Area of Convergence No. 3
Hologram Marks

With regard to an application for the registration of a hologram mark, the representation of such a mark may consist of one single view of the sign which captures the holographic effect in its entirety or, where necessary, multiple views of the hologram from different angles. Offices may require an applicant to include a description of the hologram mark where a single drawing or a series of drawings does not accurately represent the hologram.

Note

- 3.01 Opinions as to how many views of a hologram mark should be published by the Office when multiple views of the hologram are submitted remain divergent.

Area of Convergence No. 4
Motion or Multimedia Marks

With regard to an application for the registration of a motion or multimedia mark, the representation of such marks may consist of a series of still images, which put together, will depict movement. Offices may require that the application include a written description explaining the movement. Alternatively, Offices may require a recording of the sign in analog or digital format. Where electronic filing is available, an electronic file may be submitted with the application.

Note

4.01 Experience with the registration of motion or multimedia marks suggests that the character of such marks is best captured if the mark is represented in motion.

Area of Convergence No. 5
Position Marks

With regard to an application for the registration of a position mark, the representation of such a mark may consist of a single view of the mark. It may be required that matter for which protection is not claimed, be represented in broken or dotted lines. A written description explaining the position of the mark in relation to the product may also be required if the graphic representation supplied is not sufficient.

Note

5.01 Under certain national systems, position marks are treated as a subset of other types of marks, such as figurative or three-dimensional marks.

Area of Convergence No. 6
Gesture Marks

With regard to an application for the registration of a gesture mark, the representation of such a mark may consist of a single picture when the mark is treated as a figurative mark or several frames depicting the gesture if the mark is considered a motion mark. A written description explaining the gesture may also be submitted. For the rest, the considerations under possible area of convergence No. 4 would apply.

Note

6.01 The area of convergence concerning gesture marks is based on the understanding that the term gesture mark is used by industry, but not necessarily in legal statutes.

Area of Convergence No. 7
Sound Marks

With regard to an application for the registration of a sound mark, Offices may require that the representation of such marks consist of a musical notation on a stave, 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 is available, an electronic file may be submitted with the application. However, for some jurisdictions, only a musical notation on a stave may be considered as adequately representing the mark.

Note

7.01 Electronic files such as MP3 or .WAV (Wave form audio format) may be filed with certain Offices. However, national legislation may still include the possibility to submit analog recordings.

Area of Convergence No. 8
Olfactory marks

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

Area of Convergence No. 9
Taste Marks

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

Area of Convergence No. 10
Texture or Feel Marks

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

Publication of Non-Traditional Marks

On the publication of non-traditional marks, the SCT 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.

[End of Annex and of document]