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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Tenth Session
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**FURTHER DEVELOPMENT OF INTERNATIONAL TRADEMARK LAW
AND CONVERGENCE OF TRADEMARK PRACTICES**

Prepared by the Secretariat

INTRODUCTION

1. During the eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from May 27 to 31, 2002, the SCT asked the Secretariat to draft a questionnaire on substantive matters relating to trademark law on the basis of the views expressed by the Committee at its eighth session when discussing the set of principles contained in Document SCT/8/3.
2. Pursuant to the request of the Standing Committee, the Secretariat has prepared a questionnaire (Document SCT/9/3), for discussion at the ninth session (November 11 to 15, 2002) of the SCT. . At this Session, the SCT briefly discussed the nature of the questionnaire and decided that the International Bureau should circulate it, as contained in document SCT/9/3, on the SCT Electronic Forum, inviting for comments from SCT members by the end of January 2003. On the basis of these comments, the International Bureau will then revise and finalize the questionnaire and circulate it for completion by WIPO Member States, intergovernmental and non-governmental organizations.
3. The purpose of the questionnaire, is to collect information regarding the national practices of Member States of WIPO and to identify issues which require to be addressed at the international level concerning the further development of international trademark law and the convergence of national trademark practices. A similar approach was taken in 1985 in the context of preparatory work on a new treaty for the international registration of trademarks. This followed work conducted by WIPO in 1977 regarding Major Provisions of Trademark Legislation in Selected Countries, presented in the form of Summary Tables (WIPO Publication N°113). Considering the norms and standards recently adopted at the international level in the field of trademark law, it may be useful to get at present a clear picture of the current national practices in the field of trademark law. This exercise should not, under any circumstances, be considered as interpreting the provisions of national legislation.
4. The questionnaire should assist in persuing future work of the SCT aimed at further simplifying the work of national intellectual property offices and at providing a clear legal framework for trademark applicants and holders and their representatives, and for third parties and the general public (consumers) through a convergence of national laws or practices. By creating legal certainty through the adoption of common approaches, significant time and cost savings could be achieved for the users of the many different trademark systems that exist worldwide as well as for industrial property offices.
5. The basis for this work may be found in the revised Program and Budget for 2002-2003 which includes under Sub-Program 05.2, “Law of Trademarks, Industrial Designs and Geographical Indications”, the following activities (see document WO/PBC/4/2, page 53):

“Convening of four meetings of the SCT (and any Working Group set up by this Committee) to consider current issues, including: [..]

– the desirability and feasibility of harmonizing substantive trademark law, including the protection for new trademarks (sound, smell, three-dimensional marks, etc.), the requirements for use of a mark prior to registration, substantive grounds for refusal, etc.; facilitation of discussion in the SCT to incorporate in this framework the Joint Recommendation concerning provisions on the protection of well-known marks,

and the Joint Recommendation on the protection of marks and other industrial property rights in signs, on the Internet.”

6. At the eighth Session (May 27 to 31, 2002) of the SCT, Member States initiated discussions on the further harmonization of substantive trademark law. The in-depth exchange of views which took place was based on document SCT/8/3, prepared by the Secretariat, providing preliminary indications of topics to be discussed regarding the substantive harmonization of trademark laws. Discussions illustrated the broad diversity of national systems, procedures and approaches in the field of marks. Various definitions of this term “mark”, including non-traditional marks (olfactory or smell marks, sound marks, holograms and three-dimensional marks) were broadly discussed. Many SCT members noted the difficulties in the examination of such marks, particularly for small IP Offices. The graphic representation of some sound marks or smell marks as well as the determination of the distinctive character of three-dimensional marks was pointed out particularly as being problematic.

7. The SCT also discussed the possibility of establishing an exhaustive list of absolute grounds for refusal, based on the list of Article 6*quinquies*(B) of the Paris Convention. Relative grounds for refusal (conflicts with prior rights) were also thoroughly debated. National trademark laws vary considerably as to nature of the prior rights based on which the registration of a similar mark may be refused. The SCT also discussed the appropriate use of the commonly known symbols TM and ®. The use of these symbols is not currently regulated at the international level and it was felt that some clarification as to the use of those symbols would be useful, particularly because of the development of the Internet.

8. Issues such as the processing of applications for the registration of a mark (for example, maximum time limit for a first Office action or the possibility of fixing an opposition), the examination procedures (convergence of practices as to the examination of absolute grounds and/or relative grounds for refusal), what constitutes use of a mark for the purpose of determining acquisition or maintenance of a right in a mark and the relevant requirements of use of a mark, were not debated at the eighth session of the SCT, but are, however, included in the attached questionnaire

[Annex follows]

ANNEX

QUESTIONNAIRE ON TRADEMARKS

I. DEFINITION

1. According to the applicable legislation or Trademark Office practices, a mark is defined as:

- A. Any sign or combination of signs, capable of distinguishing the goods or services of an undertaking from the goods or services of another undertaking. YES NO N/A
- B. Signs visually perceptible YES NO N/A
- C. Signs capable of being represented graphically YES NO N/A
- D. Other YES NO N/A

If YES, please explain _____

2. Does the applicable legislation provide for any specific signs to be excluded from registration as a mark YES NO N/A

Please explain: _____

II. TYPES OF MARKS REGISTRABLE

Can the following signs be registered as marks under the applicable legislation or under Trademark Office practices?:

- A. Denominations
 - 1. Words in foreign languages YES NO N/A

If YES, please explain if there are any special requirements (such as translation)

2. Words in foreign script YES NO

If YES, please explain if there are any special requirements
(such as transliteration request) _____

3. Personal names/names of famous people YES NO N/A

4. Letters YES NO N/A

5. Numbers YES NO N/A

B. Non-traditional marks

1. Color marks YES NO N/A

- i. Single color YES NO N/A

- ii. Combination of colors YES NO N/A

- iii. Combination of colors associated with other signs
 YES NO N/A

2. Sound marks

- i. Musical sounds YES NO N/A

- ii. Other sounds YES NO N/A

If YES, please list them and explain how they can be represented
graphically in the application _____

3. Olfactory marks YES NO N/A

If YES, how are they represented graphically? _____

4. Three-dimensional marks

- i. Product packaging/trademark YES NO N/A
- ii. Product shape YES NO N/A
- iii. Others YES NO N/A

If YES, please list them and explain how they may be represented in the application _____

5. Holograms YES NO N/A

If YES, how are they represented graphically? _____

6. Slogans YES NO N/A

7. Movie/Book Titles YES NO N/A

8. Motion/multimedia signs YES NO N/A

How are they represented graphically? _____

9. Others YES NO N/A

If YES, please list them and explain how they are represented graphically? _

10. Do the same examiners examine non-traditional and traditional marks? YES NO N/A

11. If NO, who examines non-traditional marks? _____

12. Is there any special training given to those who examine non-traditional marks? YES NO N/A

If YES, please explain what kind of training _____

C. Service Marks YES NO N/A

1. Are marks for retail services protected? YES NO N/A

D. "Special" Types of Marks

1. Defensive marks? YES NO N/A

2. Associated marks? YES NO N/A

3. A series of marks? YES NO N/A

4. Collective marks? YES NO N/A

If YES, explain how they are defined _____

5. Certification marks? YES NO N/A

If YES, explain how they are defined _____

6. Others YES NO N/A

If YES, please explain which types of marks _____

III. BASIS FOR THE REGISTRATION OF A MARK

1. Must an application be based on use? YES NO N/A

2. Must an application be based on intent to use? YES NO N/A

If YES, what are the requirements ? _____

3. Must evidence of use/intent to use be provided at the time of filing?
 YES NO N/A

4. Is use required before registration? YES NO N/A

IV. APPLICATION PROCEDURE

1. Is there a maximum time limit for a first Office action on a trademark application?
 YES NO N/A

2. Are procedures available to expedite the processing of an application?
 YES NO N/A

If YES, is there an additional fee? YES NO N/A

3. Are multiple-class applications permitted?
 YES NO N/A

4. Is electronic filing permitted? YES NO N/A

If YES, what are the problems you may have encountered?

5. Can applications be assigned? YES NO N/A

V. EXAMINATION PROCEDURE

1. Does the IP office *ex officio* examine applications for marks with regards to:

- A. Formal requirements? YES NO N/A
- B. Absolute grounds /inherent registrability? YES NO N/A
- C. Relative grounds for refusal (prior rights)? YES NO N/A
- D. Grounds for refusal as a whole (with no distinction as to B and C)?
 YES NO N/A
- E. Others: _____

2. Does the ex-officio substantive examination occur:

- A. prior to the publication of the application

Please explain for which grounds _____

- B. after the publication of the application? YES NO N/A

Please explain for which grounds _____

3. Absolute grounds for refusal

If the application is examined to determine whether it meets statutory requirements, what are, according to your legislation, the absolute grounds for refusal?

- A. Signs which are not capable of distinguishing YES NO N/A
- B. Signs which do not satisfy other requirement of the definition of a mark (e.g., not capable of being graphically represented,..) YES NO N/A
- C. Signs devoid of any distinctive character YES NO N/A

- D. Signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production (descriptive signs). YES NO N/A
- E. Signs which have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed (i.e. have become generic). YES NO N/A
- F. Generic terms YES NO N/A

If YES, describe how the term "generic" is understood _____

- G. Signs contrary to morality or public order YES NO N/A
- H. Signs of such a nature as to deceive the public YES NO N/A
- I. Signs contrary to Article 6ter of the Paris Convention YES NO N/A
- J. Signs benefiting protection from other international conventions (Red Cross, Olympic symbols...) YES NO N/A
- K. Signs protected by national laws
- i. Royal emblems YES NO N/A
- ii. Indigenous signs YES NO N/A
- iii. Others YES NO N/A
- L. Well-known marks/famous marks/marks having a reputation YES NO N/A
- M. Appellations of origin YES NO N/A
- N. Business names/business identifiers YES NO N/A
- O. Names of famous persons YES NO N/A
- P. Foreign words or expressions YES NO N/A

Q. Others: _____

4. Must the examiner follow precedents? YES NO N/A
- i) Decisions of judicial or administrative tribunals YES NO N/A
- ii) Decisions of other examiners YES NO N/A

5. Length of time given to applicant to respond to *ex parte* objections: _____

6. Are extensions of time granted to respond to *ex parte* objections? YES NO N/A

7. Relative grounds (prior rights)

If the application is examined *ex officio* to determine whether the trademark application is in conflict with prior rights, what are, according to the applicable legislation, considered as prior rights?

- A. An identical mark registered or applied for by another person in respect of identical goods or services YES NO N/A
- B. An identical mark registered or applied for by another person in respect of similar goods or services YES NO N/A
- C. A similar mark registered or applied for by another person in respect of identical goods or services YES NO N/A
- D. A similar mark registered or applied for by another person in respect of similar goods or services YES NO N/A

Please explain, whether in all cases a likelihood of confusion is necessary or only in cases B. – D. _____

- E. A well-known mark YES NO N/A
- F. Indigenous signs YES NO N/A
- G. Business names/business identifiers YES NO N/A
- H. Appellation of origin/
Geographical indications YES NO N/A
- I. Industrial designs YES NO N/A

- J. Copyrights YES NO N/A
- K. Personal names YES NO N/A
- L. Collective or certification marks YES NO N/A
- M. Unregistered trademarks YES NO N/A
- N. Others YES NO N/A

If YES, please list them: _____

8. Effective Date of Registration

1. Filing Date of application? YES NO N/A
2. Date of issuance of certificate of registration? YES NO N/A
3. Others: _____

9. Proof of Acquired Distinctiveness

1. Are certain marks registrable only with proof of acquired distinctiveness?
 YES NO N/A

If YES, please list them: _____

2. In the case of composite trademarks with non-distinctive words or elements, may the applicant be asked to disclaim such words or elements of his trademark?
 YES NO N/A

VI. OPPOSITION PROCEEDINGS

1. Does the applicable registration system allow for opposition?
 YES NO N/A

A. Pre-registration (opposition to an application)

i. Before any examination YES NO N/A

ii. During examination YES NO N/A

iii. After the examination of formal requirements
 YES NO N/A

iv. After examination of absolute grounds for refusal
 YES NO N/A

v. After examination of relative grounds for refusal
 YES NO N/A

vi. Are applications published for opposition?
 YES NO N/A

B. Post-registration (opposition to a registration)
 YES NO N/A

2. What is the length of the opposition period?

A. 2 months YES NO N/A

B. 3 months YES NO N/A

C. More than 3 months YES NO N/A

If YES, please specify: _____

D. Are extensions available? YES NO N/A

Please explain under what conditions: _____

3. Publication

Where is the application/registration published for opposition?

A. In a gazette YES NO N/A

- B. On the IP office web site YES NO N/A
- C. Both (A and B) YES NO N/A
- D. Other YES NO N/A

Please describe what is the frequency of the publication: _____

Indicate which publication is “official” (i.e. has legal effect?) _____

4. When is the starting date of the opposition period?

- A. The publication of the application for registration YES NO N/A
- B. The publication of the registration YES NO N/A
- C. Others: _____

5. Who may invoke an opposition?

- A. Any person YES NO N/A
- B. Anyone showing a legitimate interest YES NO N/A
- C. Any competent authorities (IP Offices, others) YES NO N/A

If YES, please specify which authorities: _____

- D. Other: _____

6. Are opposition proceedings available:

- | | | | | |
|----|--------------------------------|------------------------------|-----------------------------|------------------------------|
| A. | Before the registry/IP Office? | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| B. | Before a judicial body? | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| C. | Other? | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |

Please explain: _____

7. Is there a procedure for appeals?

- | | | | | |
|----|--------------------------------|------------------------------|-----------------------------|------------------------------|
| A. | Before the registry/IP Office? | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| B. | Before an administrative body? | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| C. | Before a Court? | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |

8. Within which period of time, appeal is possible?

- | | | | | |
|----|---|------------------------------|-----------------------------|------------------------------|
| A. | 2 months after the registration | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| B. | 3 months after the registration | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| C. | More than 3 months after the registration | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |

Please explain: _____

9. What are the possible grounds for opposition?

- | | | | | |
|----|---|------------------------------|-----------------------------|------------------------------|
| A. | Likelihood of confusion with prior registered mark. | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| B. | Likelihood of confusion with prior unregistered mark. | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| C. | Likelihood of confusion with a pending application. | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| D. | Appellation of origin | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |
| E. | Geographic significance | <input type="checkbox"/> YES | <input type="checkbox"/> NO | <input type="checkbox"/> N/A |

- F. Surname YES NO N/A
- G. Descriptiveness YES NO N/A
- H. Genericness YES NO N/A
- I. Other: _____

10. In opposition proceedings, what factors are considered in determining likelihood of confusion?

Please explain: _____

11. Is it possible to reach settlement agreements in opposition proceedings?

YES NO N/A

12. Is each party held responsible for his/her costs?

YES NO N/A\

13. Does the losing party bear the entire cost of the opposition proceeding?

YES NO N/A

If NOT, please explain, how the costs are dealt with

14. What is the average time it takes to issue a decision after an opposition proceeding is finished (meaning no further submission will be accepted)? _____

VII. RIGHTS GRANTED TO UNREGISTERED MARKS

1. Are unregistered marks protected under national law? YES NO N/A
(If reply is NO, please skip to VIII. Use of a mark)

2. Are unregistered marks protected against infringement?

YES NO N/A

3. Are unregistered marks protected against dilution?

YES NO N/A

4. Does the owner of a prior unregistered mark have any recourse against a subsequent user? YES NO N/A

5. Does the owner of a prior unregistered mark have any recourse against a subsequent applicant/registrant? YES NO N/A

6. Subject Matter Protected:

A. Unregistered Word marks YES NO N/A

B. Unregistered logo and other non-word marks YES NO N/A

C. Packaging YES NO N/A

D. Tradedress YES NO N/A

E. Company names YES NO N/A

F. Others YES NO N/A

If YES, explain _____

7. Criteria for Protection of Unregistered Marks

A. Is a level of awareness/prior recognition required? YES NO N/A

B. Is distinctiveness required? YES NO N/A

C. Other: _____

8. Infringement Standards

A. Is actual confusion required? YES NO N/A

B. Is likelihood of confusion required? YES NO N/A

C. Others: _____

9. What are the penalties/damages provisions for infringement of unregistered marks?

A. Same as registered marks YES NO N/A

B. Others: _____

VIII. USE OF A MARK

1. Does the applicable legislation provide for a use requirement?

YES NO N/A

2. If use is required to maintain a registration what uninterrupted period of non-use is considered? ... years

3. Must use be substantiated during the registration period (for example prior to renewal)

YES NO N/A

If YES, explain how and when: _____

4. Does the legislation define what use is required (e.g., use in advertisements, on product, etc.)

YES NO N/A

If YES, please give definition: _____

5. According to your legislation, do the following acts constitute use to maintain a registration:

A. Sole use in commercials or advertising YES NO N/A

B. Use of a registered mark in a different form, the elements of which do not alter the distinctive character of the mark as registered

YES NO N/A

C. Affixation of a mark to goods or to the packaging thereof in your country solely for export purposes

YES NO N/A

D. Use of a mark by a person other than the holder, if such use is made with the holder's content

YES NO N/A

E. Use of a mark as a business name or a business symbol, and not in relation to the goods or services for which the mark is protected
 YES NO N/A

F. Use for the purpose of a market test of good or service
 YES NO N/A

6. What other types of use fulfil the use requirement?

Please explain: _____

7. Periods of use/non-use after registration

A. Is the uninterrupted period of non-use computed from the date of registration?
 YES NO N/A

B. Is the uninterrupted period of non-use computed at any time during the registration?
 YES NO N/A

C. Can the period of non-use be reset by subsequent use?
 YES NO N/A

D. By other means? YES NO N/A

If Yes, please explain: _____

E. What kind of valid reasons shown by the holder of the mark will excuse non-use?
 YES NO N/A

Please explain: _____

F. Does your legislation provide for a “grace” period between the end of the uninterrupted period of non-use and the introduction of an action for cancellation/revocation of the mark for non-use?
 YES NO N/A

G. In such case, does your legislation provide for a specific period during which commencement or resumption of use is not taken into account when the holder of the mark was aware [or could not have been unaware] that an action for cancellation/revocation may be introduced? YES NO N/A

- H. Are there sanctions for unjustified non-use of a registered mark?
 YES NO N/A

If YES, please explain which are the sanctions _____

IX. MARKING REQUIREMENTS (™, ®, marque déposée, marca registrada) ON THE REFERENCE TO THE MARK (NOT ON THE PRODUCT ITSELF)

1. Are markings allowed to indicate registration? YES NO N/A
2. Are markings allowed to indicate use (when mark is unregistered)?
 YES NO N/A
3. Are there optional marking provisions? YES NO N/A

If YES, describe _____

4. Does the law provide for benefits from using optional markings? YES NO N/A

If YES, explain _____

5. Which law applies for cases of false or deceptive usage of marking symbols

Please identify: _____

6. Are there penalties for non use of marking symbols when it is required by law?
 YES NO N/A

If YES, explain _____

X. CANCELLATION OR/AND INVALIDATION PROCEEDINGS

1. Does failure of required use lead to *ex officio* cancellation of the registered mark?
 YES NO N/A

2. Are proceedings available to remove a mark from the register at an administrative level in the Trademark Office?
 YES NO N/A

i. If Yes, what are the standing requirements? _____

ii. By any interested person? YES NO N/A

3. Are appeal procedures available? YES NO N/A

4. Cancellation/Invalidation proceedings can start when within a continuous period of 5 years, the mark has not been put to genuine use in connection with the goods or services in respect of which it is registered. YES NO N/A

If Yes, when does the 5 year period start? _____

5. Are proceedings available to remove a mark from the register by a Court?
 YES NO N/A

What are the standing requirements? _____

6. Are appeal procedures available? YES NO N/A

Please explain: _____

7. Are there restrictions in respect of the time period during which such proceedings may be brought? YES NO N/A

If Yes, give time period restriction: _____

8. Can some registrations become “incontestable?” YES NO N/A

If Yes, please explain how: _____

9. Possible Grounds for Removal:

A. Identity with prior mark, registered for identical goods or services YES NO N/A

B. Likelihood of confusion with prior registered mark YES NO N/A

C. Likelihood of confusion with prior unregistered mark YES NO N/A

D. Likelihood of confusion with pending application YES NO N/A

E. Appellation of origin YES NO N/A

F. Geographic significance YES NO N/A

G. Surname YES NO N/A

H. Descriptiveness YES NO N/A

If YES, what is the decisive date _____

I. Genericness YES NO N/A

J. Others: _____

10. Is there a period of time during which a third party or the owner of the removed mark may not apply to register the mark again? YES NO N/A

If Yes, please explain: _____

XI. RENEWAL OF REGISTRATION

1. Duration of Registration: _____

2. Period for filing renewal applications: _____

3. Payment of renewal fee only required? YES NO N/A

4. How long is the period after expiration of registration during which renewal can still be made?

Please specify: _____

5. Does the IP office contact the owner of the mark to inform him/her when his/her registration is due for renewal? YES NO N/A

6. Restoration

- A. Are there provisions to restore a lapsed registration? YES NO N/A

If Yes, please explain _____

- B. Can restoration affect the rights of intervening users?
 YES NO N/A

If Yes, please explain: _____

- C. Can restoration affect the rights of intervening registrants of identical/similar marks?
 YES NO N/A

If Yes, please explain: _____

7. Is there a period of time after non-renewal during which third parties are prevented from applying to register the same mark?
 YES NO N/A

If Yes, please explain: _____

8. Are unlimited renewals available? YES NO N/A

9. Must marks be used before they can be renewed? YES NO N/A

10. Is evidence of use required upon renewal? YES NO N/A

If Yes, please explain: _____

11. Duration of renewal: _____

12. Is a new number assigned each time a registration is renewed?
 YES NO N/A

13. What other formalities must be observed upon renewal? _____

[End of Annex and of document]