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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

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

**Fourth Session**  
**Geneva, March 27 to 31, 2000**

DRAFT REPORT

*prepared by the International Bureau*

### 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 fourth session, in Geneva, from March 27 to 31, 2000.

2. The following States members of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Algeria, Argentina, Armenia, Australia, Austria, Belarus, Belgium, Belize, Bolivia, Brazil, Cape Verde, Chile, China, Colombia, Croatia, Czech Republic, Denmark, Ecuador, Egypt, El Salvador, Equatorial Guinea, Estonia, Finland, France, Germany, Greece, Guatemala, Honduras, Hungary, India, Indonesia, Iraq, Ireland, Italy, Jamaica, Japan, Kazakhstan, Kenya, Kuwait, Kyrgyzstan, Latvia, Malaysia, Malta, Mauritius, Morocco, Netherlands, New Zealand, Norway, Pakistan, Panama, Papua New Guinea, Peru, Philippines, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Seychelles, Slovakia, Slovenia, South Africa, Spain, Sri Lanka, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, Tunisia, Uganda, United Kingdom, United States of America, Uzbekistan, Venezuela, Yemen, Zimbabwe (76). The European Communities were also represented in the capacity of a member of the SCT.

3. The following intergovernmental organizations took part in the meeting in an observer capacity: Benelux Trademark Office (BBM), Organization of African Unity (OAU), 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), Asian Patent Attorneys Association (APAA), Association of European Trade Marks Owners (Marques), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), International Anti-Counterfeiting Coalition (IACC), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Federation of the Phonographic Industry (IFPI), International League of Competition Law (LIDC), International Trademark Association (INTA), International Wine Law Association (AIDV), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademarks Association (JTA), Union of European Practitioners in Industrial Property (UEPIP), World Association for Small and Medium Enterprises (WASME) (18).
5. The list of participants is contained in Annex 1 of this Report.
6. Discussions were based on the following documents prepared by the International Bureau of WIPO: “Agenda” (document SCT/4/1), “Draft Provisions on Trademark Licenses” (document SCT/4/2), “Provisions of the Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters” (document SCT/4/3), and “Draft Provisions Concerning Protection of Trademarks and Other Distinctive Signs on the Internet” (document SCT/4/4).
7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

## GENERAL DISCUSSION

### Agenda Item 1: Opening of the Session

8. The session was opened by Mr. Shozo Uemura, Deputy Director General, who welcomed the participants.

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

9. The Standing Committee unanimously elected Ms. Lynne Beresford (United States of America) as Chair, and Mrs. Agnès Marcadé (France) and Mr. Vladimir García-Huidobro (Chile) as Vice-Chairs. Mr. Denis Croze (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 3: Adoption of the Agenda

10. The Agenda (document SCT/4/1) was adopted without modification.

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

11. The Report of the third session (document SCT/3/10) was adopted without modification.

Agenda Item 5: Draft Provisions on Trademark Licenses (see document SCT/4/2)

12. The Standing Committee discussed document SCT/4/2 containing draft Provisions on Trademark Licenses.

*Form of Adoption*

13. The International Bureau stated that the provisions could be proposed either as a protocol to the Trademark Law Treaty, or to be included in a revision of that treaty. Both options would require a Diplomatic Conference. A third option would consist in presenting the provisions to the Paris Union Assembly and the WIPO General Assembly for adoption as a Joint Recommendation at the next session of the Assemblies of the Member States of WIPO in September 2000. This would not preclude the provisions from being proposed in one of the above forms at a later stage.

14. The Delegations of Australia, Chile, France, Kenya, Romania, Spain and the United Kingdom favored the third option, noting that the provisions could later be reconsidered in the context of a comprehensive revision of the Trademark Law Treaty (TLT). This view was supported by the Representatives of AIPPI, AIPLA, CCI and INTA. The Delegations of Brazil and Japan stated that they agreed in principle, but that their support was subject to an examination of the final version of the draft provisions.

15. As a result of these discussions, the SCT decided to present the final version of the draft provisions to the Paris Union Assembly and the WIPO General Assembly for adoption as a Joint Recommendation at the next session of the Assemblies of the Member States of WIPO in September 2000.

16. The International Bureau stated, and the SCT agreed, that, as a consequence of this decision, the word "Contracting Party" would have to be replaced by Member State throughout the text of the provisions.

*Joint Recommendation*

17. The International Bureau proposed the following text:

*“Joint Recommendation*

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO);

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property and of the Trademark Law Treaty (TLT);

*Recommend* that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its fourth session, as guidelines concerning trademark licenses;

*It is further recommended* to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring these provisions to the attention of that organization.”

18. One delegation questioned whether it was necessary to refer to the TLT since many of the Contracting Parties of the Paris Convention or Member States of WIPO were not yet party to the TLT. In response, the International Bureau explained that the reference to the TLT was meant to call attention to that treaty, without which the draft provisions could hardly be understood. Another delegation and the representative of an observer organization supported this explanation.

19. The representative of an observer organization suggested including a statement to the effect that the draft provisions provide maximum requirements for the recordal of trademark licenses. This suggestion was supported by one delegation, but opposed by three others. These delegations stated that they preferred the language proposed by the International Bureau because it was similar to that adopted by the WIPO Assemblies when they considered the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

20. As a result of these discussions, the text of the Joint Recommendation was adopted as proposed by the International Bureau.

*Draft Article 1: Abbreviated Expressions*

21. One delegation suggested to delete item (iii) which defines “application” since, under its national law, the licensing of applications is not possible. In response, the Chair pointed out that nothing in the provisions obliged Member States to allow the licensing of applications.

22. The same delegation also proposed to add a definition of the term “licensor,” which appeared in Model International Form No. 2. After some discussion, in the course of which it was pointed out that it had been agreed not to deal with sub-licenses and that, therefore, the licensor would always be the holder of the registration, the SCT agreed to delete the term “licensor” from Model International Form No. 2 instead of defining it in Article 1.

23. In response to a proposal put forward by one delegation to define the concept of licenses which concern only a limited part of a territory referred to Article 2(1)(a)(ix), the SCT agreed instead to clarify the drafting of the latter provision.

24. Another delegation remarked that the definitions in items (ix) to (xi) seemed unclear and proposed to delete the words “any other person” in items (ix) and (x), and to clarify, in item (xi), that the holder is excluded from granting licenses to any other person.

25. After some discussion the SCT agreed to redraft items (ix) to (xi) and to order them as follows:

“(ix) “exclusive license” means a license which is only granted to one licensee, and excludes the holder from using the mark and from granting licenses to any other person;

(x) “sole license” means a license which is only granted to one licensee and excludes the holder from granting licenses to any other person, but does not exclude the holder from using the mark;

(xi) “non-exclusive license” means a license which does not exclude the holder from using the mark or from granting licenses to any other person.”

26. Article 1 was adopted with the above-mentioned modifications.

*Draft Article 2: Request for Recordal/Cancellation of the Recordal of a License*

27. The Delegation of Brazil stated that the Brazilian Institute of Industrial Property may have a broader scope of responsibility than most Offices in that it is responsible for the registration of licenses, fiscal deduction, the delivery of royalties, and the identification of economic abuses as regards license contracts. Consequently, the Delegation proposed that such a possibility be reflected in the Notes. The Delegation cited, as an example, Note 2.12 (SCP/4/2, page 10) which indicates that other authorities of Contracting Parties may require additional information from parties to a license contract.

28. Another delegation replied that the definition of “Office” in Article 1, item (ii), was limiting the applicability of the requirements in Paragraph 1(a) to the agency entrusted by a Member State with the registration of marks, and thus did not prevent the recordal of licenses by other agencies for different purposes.

29. *Paragraph (1)(a)*. One delegation proposed that two additional requirements relating to the contents of the request for recordal be added: (1) where the licensee has a representative, the name and address of the representative, and (2) where the licensee is required to have an address for service, an address for service of process. The delegation stated that similar conditions might be found in Article 11(1)(f)(vii) and (viii) of the TLT. Two other delegations supported the proposal.

30. As a result, the SCT decided to insert the following two new items, with consequential renumbering of former items (v) to (x), and mention in the Model International Forms:

“(v) where the licensee has a representative, the name and address of that representative;

(vi) where the licensee has an address for service, such address;”

31. The SCT also agreed to split former item (ix) into two items as follows:

“(xi) where applicable, that the license is an exclusive license, a non-exclusive license, or a sole license;

(xii) where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;”.

32. *Paragraph (1)(a)* was adopted with these modifications.

33. *Paragraph (1)(b)*. The International Bureau introduced the paragraph by noting that the draft text reflected the apparent consensus at the end of the last session that either the holder or his representative could sign the request. If, however, the request is signed by the licensee and not by the holder, Offices should be able to require that one of the documents referred to in items (i) to (iii) be filed together with the request. The licensee could choose any one of them. The International Bureau also suggested that the text in item (ii) should read, "an extract of the license contract, indicating the parties and the rights being licensed."

34. In response to an observation by one delegation that item (iii) mistakenly refers to "Regulations" that do not exist, the International Bureau proposed to replace the word "Regulations" by the words "certificate of license Form provided for in the Annex to these provisions."

35. The Delegations of Brazil, India and Spain pointed out that their national laws required that the license contract be filed together with a request for recordal, and that they, therefore had problems with the provision as proposed. A number of other delegations observed that the purpose of the draft provisions was to simplify the recordal of trademark licenses, and to avoid the submission of the full license contracts which was considered particularly burdensome since these contracts often contained confidential information.

36. Two delegations proposed to require that the copy and the extract of the contract referred to in items (i) and (ii) be certified, as was the case in Article 11(1)(b)(i) and (ii) of the TLT which deals with transfer of ownership. This was supported by the representatives of two observer organizations who pointed out that the licensee would still be free to file the uncertified certificate of license referred to in item (iii).

37. Two delegations stated that the draft could be improved by expressly stating that, if the request was not signed by the holder, it would have to be signed by the licensee and accompanied by one of the documents referred to in items (i) to (iii).

38. The Delegation of Japan, supported by the Delegations of Chile and Korea and the Representative of JPAA, stated that, in their view, the consent of the holder should always be required, at least where the recordal was not mandatory. This could prevent the licensee from filing a request for recordal against the wishes of the holder. Another delegation suggested adding the words “unless the contract expressly states otherwise”. Both proposals were opposed by a number of other delegations who stated that they did not know of a situation in which the holder had a valid interest in not having the license recorded, and that any dispute in this regard would have to be resolved *inter partes*. The representative of an observer organization explained that the holder might well have an interest to prevent that the licensee file a complete copy of the license contract. A proposal by one delegation to protect that interest by deleting item (i) was supported by another delegation and a number of observer delegations, but opposed by the Delegations of Spain and India on the grounds that their national law always required the filing of a copy of the license contract. After it was pointed out that even the previous draft would not allow the Office to require a copy of the license contract, but only allowed the licensee to file it together with his request for recordal, the SCT decided to delete item (i).

39. One delegation noted that the words “uncertified certificate” used in item (iii) were contradictory, and proposed to replace the word “uncertified” by “unauthenticated.” Since a number of delegations and representatives of observer organizations felt that this wording would be less clear, the SCT agreed instead to replace the word “certificate” by “statement,” with consequential modification of the Model International Forms.

40. As a result of these discussions, the International Bureau suggested to renumber paragraph (1)(a) and (b) as paragraphs (1) and (2) and to include, in new paragraph (1), the following new item:

“(xiv) a signature as specified in paragraph (2).”

41. The International Bureau also suggested to redraft paragraph (2) as follows:

“(2) [*Signature*] (a) A Member State shall accept the signature of the holder or his representative, whether or not it is accompanied by the signature of the licensee or his representative.

(b) A Member State shall also accept the signature of the licensee or his representative, if it is not accompanied by the signature of the holder or his representative, provided that it is accompanied by one of the following:

(i) an extract of the license contract indicating the parties and the rights being licensed, certified by a notary public or any other competent public authority as being a true extract of the contract;

(ii) an uncertified statement of license, drawn up in the form and with the content as prescribed in the statement of license Form provided for in the Annex to these provisions, and signed by both the holder or his representative and the licensee or his representative.”

42. After some discussion, the SCT adopted new paragraphs (1) and (2) with the text as proposed by the International Bureau, subject to inclusion of the word “even” before the words “if it is not” in the introductory words of new paragraph (2)(b).

43. *Paragraph (1)(c)*. This provision was adopted as proposed in document SCT/4/2, but, following a suggestion by the International Bureau, renumbered as new paragraph (5).

44. *Paragraph (2), item (i)*. No comments were made on that provision.

45. *Paragraph (2), item (ii)*. The Delegation of Brazil stated that, under the law of its country, it was mandatory to present the original of the license contract together with a translation. However, that delegation said that it was giving consideration to the item under discussion and that it intended to show flexibility to continue the discussion.

46. The Delegation of Egypt regretted that the working documents of the SCT were not available in Arabic and asked for the text of the Joint Recommendation to be sent to his country in Arabic. Concerning this provision, he said that under the law applicable in his country, it was necessary to file a translation of the license contract in the official language accepted by the Office.

47. *Paragraph (2), item (iii)*. The Delegation of Brazil stated that, under the law of its country, the Patent Office acted on behalf of the central bank in controlling whether a license agreement provided for the transfer of royalties outside of the country. Therefore, it was necessary for the Office to know of the financial terms of the license contract.

48. The Delegation of India stated that the Office of its country had to levy a charge of 2% of the total of the license fee and, for that reason, had to be aware of the financial terms of a license contract.

49. Following a suggestion by the International Bureau, the SCT decided to follow the model of Articles 3(7) and 11(4) of the TLT, by applying paragraph (2) to all paragraphs of Article 2, and to renumber it as new paragraph (7). The Delegation of Brazil stated that it could not join the consensus at this time concerning items (ii) and (iii), pending further discussion and instructions from its capital. The Delegation of India reserved its position regarding item (iii).



50. *Paragraph (3)*. One delegation declared that a provision requiring that an office shall accept a request for the recordal of a license where that request was presented on paper was too limited, especially with a view to future technical developments that would lead offices to accept electronic filing only. The delegation therefore suggested that the choice of the medium in which a request had to be represented to the Office be left to the Member State, as what was important was not that the request was filed via a particular means, but that it contained all the elements of the Form.

51. Several delegations and two representatives of observer organizations supported the proposal.

52. Two delegations were of the opinion that the needs of applicants from all countries should be taken into consideration and that Offices should, therefore, always have to accept requests filed on paper.

53. The International Bureau stated that the issue of whether Offices could move to 100% electronic filing and refuse filings on paper was of a general nature and might better be considered in the context of a comprehensive revision of the TLT. It suggested that this provision not refer to particular means of filing, but simply require Offices to accept requests that contained all the elements provided for in the Model International Form. The International Bureau suggested the following wording, which was adopted by the SCT:

“(3) [*Presentation of the Request*] As regards the requirements concerning the presentation of the request, no Member State shall refuse the request where the presentation and arrangement of indications and elements in the request correspond to the presentation and arrangement of indications and elements in the request Form provided for in the Annex to these provisions.”

54. *Language, Translation*. The Delegation of Japan proposed to include, in Article 2, a provision allowing an Office to require that the request, and any accompanying documentation, be either in a language accepted by the Office, or accompanied by a translation. The Delegation explained that a similar provision was contained in Article 11(2)(b) TLT. This proposal was supported by two other delegations.

55. Following that proposal, the SCT discussed whether the statement of license referred to paragraph (2)(b)(ii) would always have to be filed in a language accepted by the Office, or whether users should be given the possibility to submit the statement of license in their own language, supplemented by a translation. One delegation and the representative of an observer organization asked whether there was any compelling reason for requiring the holder to sign the statement of license in a language he or she is unable to understand. Such a requirement would also be impracticable because, if the license covered several countries, the holder would have to sign individual statements in the official languages of all the Offices where that license would have to be recorded.

56. As a result of these discussions, the SCT decided that the provisions allow the filing of a translation of the statement of license. It also decided to allow Offices to require that any such translation be certified, on the understanding that Offices would be free to confine themselves with an uncertified translation. The SCT agreed that this latter point would be reflected in the notes to Article 2.

57. As a result of these discussions, the SCT adopted the following new paragraph (4):

“(4) [*Language; Translation*] (a) A Member State may require that the request be in the language, or in one of the languages, admitted by the Office.

(b) A Member State may require that, if the document referred to in paragraph (2)(b)(i) or (ii) is not in the language, or in one of the languages, admitted by the Office, the request be accompanied by a certified translation of the required document in the language, or in one of the languages, admitted by the Office.”

58. *Paragraph (4)*. Following an intervention by one delegation, which pointed out that the scope of the license would have to be indicated with respect to all registrations, the International Bureau suggested to replace the words “(viii) and (xi)” by the words “with respect to all registrations”, and to renumber the provision as new paragraph (6). The provision was adopted with these modifications.

59. *Paragraph (5)*. Following a proposal by one delegation, the International Bureau suggested to add, at the end of the provision, the words: “, where the applicable law of a Contracting Party provides for such recordal”, to renumber the paragraphs referred to therein and to renumber the provision as new paragraph (8). The SCT adopted the provision with these modifications.

60. *Paragraph (6)*. Two delegations were in favor of extending Article 2 to requests for the amendment of the recordal of a license, and not only to requests for cancellation of a recordal of a license, and proposed to delete the square brackets around the words “Amendment or” in paragraph (6). This was opposed by the Delegation of the European Communities, which explained that Article 35.4 of the Implementing Regulations regarding the Community Trademark Regulation required that requests for the amendment or the cancellation of the recordal of a trademark license be accompanied by documentation showing the consent of the other party. Since the extension of Article 2 to requests for the amendment of a recordal would, therefore, require that these provisions be changed, the Delegation reserved its position pending further consultations with its authorities.

61. The representative of an observer delegation noted that the extension of Article 2 to amendments would either have to be reflected in the title of that article and the Model Forms, or that it might even justify the creation of a new article dealing with cancellations and amendments of recordals. Following that intervention, the SCT decided to move the contents of paragraph (6) to a new Article 3, with consequential renumbering of the following articles and change in Model International Form 1. The SCT adopted new Article 3 with the following wording:

“*Article 3*  
*Request for Amendment or Cancellation of a Recordal*”

Article 2 shall apply, *mutatis mutandis*, where the request concerns the amendment or cancellation of the recordal of a license.”

*Other Proposals Regarding Draft Article 2*

62. *Consent of Co-Holders.* The Delegation of Japan proposed to include the following new requirement in Article 2: “Where there is a license made by one or more, but not all, of several co-holders, any Member State may require that any co-holder, in respect of which there is no license, give his express consent to the license in a document signed by him.” The Delegation explained that a similar requirement was contained in Article 11(1)(d) TLT which dealt with change in ownership. This proposal received support from two other delegations and the representative of an observer organization, but was opposed by another delegation on the grounds that the request for recordal of a license was different in nature from the request for a recordal of the change in ownership of registration of a mark. That delegation also pointed out that such a requirement could not effectively protect co-holders against the unauthorized recordal of license agreements, since the licensee would always be in a position to file the request independently.

63. The International Bureau explained that the question as to whether all co-holders have to give their consent to the recordal of the license had been left to the applicable law of the Member States because national laws seemed to differ in this respect; while some countries require all co-holders to sign the license agreement, others permit only one of the several co-holders to license a registered mark. Under the current draft, it would be up to the national law to determine whether the signature of one or several co-holders satisfies the requirement that the request be signed by “the holder”, or whether signatures of all co-holders were needed for that requirement to be satisfied.

64. As a result, it was agreed not to insert such a requirement, and to reflect the discussion in the notes to Article 2.

65. *Evidence.* The Delegation of Japan, supported by two other delegations, proposed to allow an Office to require evidence in cases where it may reasonably doubt the veracity of any indication contained in the request or in any document filed with the request. The Delegation explained that the TLT regularly provided Offices with that possibility.

66. Two delegations and the representative of an observer organization opposed this proposal on the grounds that allowing an Office to require additional evidence might constitute a substantive examination of the request, which would fall out of the scope of these provisions. It was also pointed out that such a provision would enable an Office to require evidence even where the request was filed by the holder, who was not obliged to include any additional documents.

67. Two delegations and the representative of an observer organization pointed out that Offices could always subject the request to a formalities examination and, if an Office considered that any of the indications or elements fail the examination, contact the requesting party for clarification and/or amendment before going forward with the recordal. For that reason, a provision allowing Offices to require formal evidence would not appear to be necessary.

68. After some discussion the SCT decided not to include a provision on evidence, but to state in the notes that Offices may subject the request to a formalities examination and, if any of its indications or elements fails the examination, would not be prevented from requiring clarification. The SCT agreed to the following wording of Note 2.01:

“This Article provides a maximum list of indications and elements that may be required by a Member State with respect to a request for recordal of a license. It is understood that a Member State may, in addition to requiring that these indications and elements be supplied by the requesting party, subject the request to a formalities examination and, if the Office considers that any of the indications or elements fails the examination, contact the requesting party for clarification and/or amendment.”

*Draft Article 3: Effects of the Non-Recordal of a License*

69. *Paragraph (1)*. This provision was adopted without modifications.

70. *Paragraph (2)*. The Delegations of Brazil, Chile, Egypt, France, India and Spain stated that, under their national laws, a license agreement had to be recorded in order to have effect against third parties, and that this was contrary to the paragraph under consideration.

71. One delegation, supported by two observer organizations, pointed out that a provision requiring recordal of the license before allowing the licensee to recover damages for trademark infringements, would only be beneficial to trademark infringers. Therefore, they strongly supported the text of Article 3(2) as proposed in document SCT/4/2.

72. A number of other delegations and representatives of observer organizations, recognizing the difficulties of some countries whose national law was incompatible with such a provision, suggested, by way of compromise, to leave the substance of the provision in the draft, but to make it optional for Member States to comply with it.

73. As a result of this discussion, the SCT agreed to retain the current wording of paragraph (2) as paragraph (2)(a), and to add the following new paragraph (2)(b):

“(b) If subparagraph (a) is not compatible with the national law of a Member State, that subparagraph shall not apply in respect of that Member State.”

74. The Representative of an observer organization pointed out that this new drafting would still have a substantive effect since it encourages Member States to interpret their legislation in a way that complies with subparagraph (a).

75. The SCT adopted the Article with these modifications.

*Draft Article 4: Use of a Mark on Behalf of the Holder*

76. *Paragraph (1)*. The Delegation of Australia stated that, while it was not opposed to the idea expressed in this provision, Member States should be aware that it went beyond the TRIPS Agreement in that it required Member States to recognize every use with the holder's consent as use that could maintain a trademark registration, whereas, under Article 19.2 of the TRIPS Agreement, Member States could require that such use was "subject to the control of the holder." The Delegation explained that draft Article 4 would require a change in Australian law, and that it could not commit the Australian Government or legislature to this provision. The Delegation nevertheless supported the provision as an indication of the direction in which international trademark law would develop.

77. Two delegations and the representative of an observer organization voiced concern regarding the reference to "tacit consent" in Note 4.03, because these words might be interpreted too broadly. As a result, the SCT decided to delete the words "whether expressly or tacitly" from Note 4.03.

78. One delegation suggested to clarify in the notes that Article 4 only applies where the use of the mark by a third person accrues to the benefit of the holder; the provision should not be understood as making the holder automatically liable for trademark infringements committed by third persons. The representative of an observer organization suggested to state explicitly in the notes that the provision is applicable only "in the context of the acquisition or maintenance of the rights of the holder."

79. After some discussion, Article 4(1) was adopted as proposed in document SCT/4/2.

80. *Paragraph (2)*. Several delegations pointed out that paragraph (2) might be interpreted as requiring Member States to regard unwritten licenses as valid, whereas under their national law written licenses had to be in writing in order to be valid.

81. Following a suggestion put forward by the representative of an observer organization who pointed out that the provision merely served to illustrate the general principle expressed in paragraph (1) without adding anything in substance, the SCT decided to move paragraph (2) to the notes, utilizing the following language:

"Article 5 would apply independently of whether or not a license exists or, if a license exists, whether or not the license is recorded."

*Draft Article 5: Indication of the License*

82. The SCT adopted the provision as proposed in document SCT/4/2, subject to the consequential amendment of "Article 4(1)" to "Article 4."

*Model International Forms*

83. *Model International Form No. 1.* The representative of an observer organization noted that the form would have to be amended in order to cover requests for the amendment of a recordal.

84. One delegation proposed to provide, in item 3, space for details regarding the representative of the licensor, and to refer in item 5 only to the representative of the licensee.

85. One delegation proposed to provide additional space under item 9 for licenses granted for an unlimited period of time. The representative of an observer organization asked how that item could be applied to licenses, which, even though granted for a limited period of time, were automatically renewed after that period had lapsed. The representative of another observer organization pointed out that in such a case the parties would have to inform the Office of the renewal.

86. Another delegation proposed to delete the word “applicant” in item 10 since it indicated the requesting party, rather than the applicant for the registration of a trademark as suggested by the definition of “application” in draft Article 1(iii).

87. *Model International Form No. 2.* One Delegation proposed to add space for the indication of the address for service of the parties.

88. In conclusion, the Chair stated that the SCT had adopted the Provisions Concerning Trademark Licenses (attached as Annex 2), and had decided to recommend these provisions to the Assembly of the Paris Union and the General Assembly of WIPO for adoption as a Joint Recommendation on the occasion of the next Assemblies of the Member States of WIPO in September 2000. It was agreed that the International Bureau circulate the redrafted Model International Forms and notes to the provisions on the Electronic Forum.

Agenda Item 6: Preliminary Draft Convention on Jurisdiction and Foreign Judgements in Civil and Commercial Matters (see document SCT/4/3)

89. The International Bureau introduced document SCT/4/3 by stating that its purpose was merely to bring to the attention of the delegations and their Governments certain provisions in the preliminary draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters (preliminary draft Convention) of the Special Commission of the Hague Conference on Private International Law, which were relevant for intellectual property rights.

90. The International Bureau also reported that it had recently received two requests to look into the matter on a broad scale, not limited to trademark law. As a result of these requests, it seemed that the issue should be taken up in a WIPO forum that could address all intellectual property rights. The International Bureau noted that the SCT would be kept informed of all further developments, including the work of any other forum within WIPO that might address these issues.

91. The Chair noted, therefore, that there were two issues to be discussed by the SCT: (1) whether the issues raised in the preliminary Draft Convention should be considered by a committee other than the SCT that would deal with all types of intellectual property, and (2) whether there were any comments by Delegations on the specific provisions of the preliminary draft Convention.

*Consideration of Private International Law Issues within WIPO*

92. The Delegation of the United Kingdom stated that, although its Government has not completed consultation on the preliminary draft Convention, some of the comments it has received to date show that there are questions as to whether trademarks should be treated differently from patents or copyrights. The Delegation also noted that the whole range of intellectual property rights should be considered at the same time, and that the delegates to a broader committee would be able to take advantage of the expertise in their capitals more easily than the delegates to the SCT. The Delegation recommended to consider the preliminary draft Convention in relation to other instruments that cover jurisdiction in intellectual property matters, such as regional arrangements.

93. Two delegations and three representatives of observer organizations supported the proposals by the Delegation of the United Kingdom, stating that all intellectual property rights should be considered together preferably under the purview of WIPO. The delegations suggested that these issues should be discussed by experts in private international law as well as intellectual property law, and that there should be a close coordination between WIPO and the Hague Conference.

94. The Delegation of Japan stated that it would be appropriate for WIPO, as a specialized agency in the field of intellectual property law, to undertake a broad and balanced consideration of private international laws in relation to all types of intellectual property, such as patents, industrial designs, trademarks, copyright and neighboring rights, trade secrets and unfair competition. The Delegation also stated that, inasmuch as the closely-related issues of jurisdiction and choice of law are among the first to arise in any international or transnational dispute regarding intellectual property rights, it is appropriate to consider both issues together. The Delegation recommended, given the complexity of these two issues, to invite organizations with relevant expertise.

95. Two delegations and the representatives of two observer organizations, while agreeing that the issues should be discussed by experts in private international law as well as intellectual property law, requested that time be allowed for discussion at the national level first, because these issues were complex and required detailed analysis with regard to enforcement and electronic commerce, and in order for the intellectual property community to reach consensus at the national level. The representative of the observer organization noted that the most important and practical side of the issue is the enforcement of judgments after courts decide that rights have been violated, and expressed the hope that the enforcement sector should be well represented.

96. The representatives of two observer organizations agreed that these issues should be addressed in another forum than the SCT, but stressed that issues pertaining to trademarks should not be neglected by the other committee. They added that the SCT should keep the broader forum informed of the continuing deliberations of the SCT on the use of trademarks on the Internet, which implicates certain issues relating to jurisdiction over trademark infringement actions which are specific to trademarks and which are not covered by the preliminary draft Convention.

97. The Chair noted that there was consensus within the SCT that it would be appropriate to move the issue to another forum within WIPO that would have experts in all intellectual property rights as well as in private international law, but that the SCT should be kept informed of the work of that forum.

*Comments on Specific Provisions of the Preliminary Draft Convention*

98. *Article 10.* The Delegation of Japan stated that the provision on specific jurisdiction (Article 10) deserves careful consideration in proceedings involving intellectual property rights, especially in view of the proposal to apply exclusive jurisdiction under Article 12(4) to infringement proceedings. The Delegation also expressed disagreement with the conclusions reached by the International Bureau in paragraphs 7 and 8 of document SCT/4/3. Using the example of sales over the Internet, the Delegation suggested that the limitation of "foreseeable injury" in Article 10 would reduce some of the uncertainty as to which jurisdictions one might be sued. The Delegation also stated that the effect of a disclaimer as to which jurisdiction a seller is willing to supply or deliver goods or services should be taken into consideration when addressing the procedural questions of choice of forum and choice of law as well the substantive question of liability. The Delegation also stated that, given the uncertainty of the place of the tort as a basis for jurisdiction, further discussion should take place regarding the place where the injury arose, the place where the injurious act occurred, the place where information is uploaded, and the place where the web-server is located.

99. *Article 12.* The Delegation of Japan stated that its government did not yet have a definite position regarding Article 12, other than that the provision deserves careful consideration in regard to intellectual property rights, and reserved its position on the issue.

100. The Representative of AIPPI noted that, if infringement cases were subject to exclusive jurisdiction, this would preclude a single court from deciding a number of infringement cases that resulted from the use of a mark registered in multiple countries. Such an effect would be particularly problematic in trademark cases. If, however, infringement proceedings were not subject to exclusive jurisdiction, a court might be able, in an infringement case, to decide on the validity of the allegedly infringed right with *inter partes* effect.

101. The Delegation of Germany expressed concern regarding the wording of Article 12, paragraph 4, and on the introduction of an exclusive competence on infringement proceedings.



Agenda Item 7: Draft Provisions on the Protection of Trademarks and Other Distinctive Signs on the Internet

102. The SCT discussed the draft Provisions on the Protection of Trademarks and Other Distinctive Signs on the Internet, contained in document SCT/4/4.

103. A number of delegations expressed their support for the provisions on the protection of trademarks and other distinctive signs on the Internet, although some delegations had some concerns with regards to the provisions relating to the exception to liability. Two delegations stressed that it was important to find a balance between the interests of right holders in an effective protection of their rights, and the interests of those who intend to use signs on the Internet not to be subjected to unreasonably high burdens and to the risk of litigation in multiple jurisdictions, particularly for small businesses.

104. Three Delegations referred to alternative dispute resolution procedures as a possible means to solve trademark conflicts on the Internet.

*Draft Section 1. Definition*

105. With respect to the scope of the phrase “trademarks and other distinctive signs,” one delegation, supported by another delegation noted that the concept of “distinctive signs” appeared unclear, and that conflicts between different types of rights posed a number of intricate and unresolved problems. The delegation therefore proposed to limit the scope of the provisions to the protection of registered trademarks and unregistered well-known marks. This was opposed by a number of delegations and the representative of an observer organization, who were in favor of not limiting the scope of the debate in advance.

106. The representatives of two observer organizations pointed out that the notion of “distinctive signs” could be clarified by referring to “industrial property rights in distinctive signs.” One representative also noted that the title should rather read “Protection of Trademarks and Other Industrial Property Rights in Distinctive Signs in Relation to the Use of Signs on the Internet.” One delegation disagreed with the use of the term “distinctive signs” since its national law protected not only signs that were already distinctive, but also signs that were capable of being distinctive.

107. Following a suggestion by the Chair, the SCT decided not to limit the discussion, but to examine, with respect to each individual provision, whether there was a need to limit its scope to registered trademarks and unregistered well-known marks.

*Draft Section 2. Scope of the Present Provisions*

108. One delegation suggested to clarify that the provisions not only apply to visible use of signs on a web site, but also to use in relation to digital contents and services distributed directly over the Internet.

109. One delegation referred to Note 2.02 which states that in certain cases the draft provisions “claim priority over national and regional laws.” The delegation asked what legal nature the provisions were intended to have. The International Bureau replied that this question would have to be decided by the SCT, and that one possible option would consist in adopting the provisions in the form of a Joint Recommendation. In this case, the provisions could, of course, not claim legal priority over national laws. One delegation was in favor of adopting the provisions in that form, whereas another delegation expressed a preference for first determining the exact scope and content of the provision before taking a decision on the legal nature of the provisions.

110. *Paragraph (1)*. One delegation, supported by another delegation stated that it could not see how the provisions could apply “in addition to national laws”, and that such a formulation would appear particularly problematic for countries that adhered to a dualistic approach in public international law. Another delegation proposed to replace the words “in addition to national laws” by “without prejudice to national laws.” The representative of an observer organization suggested to refer to the principles as “recommended minimum provisions” or “guidelines.”

111. The International Bureau explained that paragraph (1) was intended to indicate that the provisions cannot stand on their own, but that they supplement the existing national and regional laws.

112. *Paragraph (2)*. One delegation and the representative of an observer organization suggested to align paragraphs (1) and (2) by referring, in paragraph (2), to “use of signs on the Internet”, rather than to “use of trademarks and other distinctive signs on the Internet.”

113. Two delegations proposed to change the order of the two paragraphs of Section 2 since paragraph (2) appeared to contain the general principle.

114. Another delegation said that Section 2 did not seem to be necessary. Furthermore, that delegation said that the relationship between paragraphs (1) and (2) of that Section would have to be clarified, since paragraph (1) seemed to be applicable under national law in any case, where as paragraph (2) appeared to set a rule whereby the provisions were only applicable to the extent that they were consistent with national legislation. Another delegation suggested deleting paragraph (2).

*Draft Section 3. Use of a Sign on the Internet in a Member State*

115. One delegation suggested to invert the paragraphs of that section. Another delegation suggested combining both paragraphs.

116. The Delegation of Australia said that, although it did not have a problem with the principles underlying Sections 3 and 4, it was concerned that the introduction of new concepts such as “commercial effect” could be problematic, especially as far as the relation of that concept with the principles of infringement was concerned.

117. The Delegation of Germany, supported by two other delegations expressed concern with regard to the wording “has produced a commercial effect” which might be interpreted as requiring that business transactions have already taken place. The Delegation suggested to clarify that a commercial effect could also be produced by preparatory acts, for example by transferring the substance of Section 4(m) to a new Article 3(3) which could be worded as follows: “The use of a sign on the Internet has produced a commercial effect in a Member State if the user is doing, or has undertaken significant steps to do, business in that Member State.”

118. The International Bureau agreed in principle but observed that a commercial effect could be produced in a Member States even if there was no preparation for doing business in that State. It stated that it would attempt to find a more prominent place for the substance of Article 4(m), in Article 3 or at the beginning of Article 4, without limiting the concept of “commercial effect.”

119. In the ensuing discussion, some delegations proposed to replace the words “has produced a commercial effect” by “has a commercial effect,” or “would result in a commercial effect,” or “involves a commercial effect.” A proposal made by the representative of an observer organization to use the words “has produced or is likely to produce a commercial effect” was opposed by one delegation on the grounds that an actual commercial effect should always be required, even if it was produced by preparatory activities.

120. A proposal by two delegations to define the concept of “commercial effect” in Section 1 met with opposition from another delegation and the representative of an observer organization who pointed out that it would seem hardly possible to define that concept without unduly limiting it, and that it should rather be attempted to identify factors with the help of which courts could determine, in an individual case, whether a commercial effect has been in fact been produced.

121. One delegation, supported by the representative of an observer organization, proposed to limit the application of the provisions to rights in signs that are only protected in a commercial context. The delegation observed that individual names, for example, were also protected in a non-commercial context. The principle of “commercial effect” might, therefore, be understood as limiting the protection available to such rights. The International Bureau stated that this could be clarified by referring to “industrial property rights in distinctive signs.”

122. The representative of an observer organization suggested to delete the word “commercial” since several of the factors listed in Article 4 would equally be applicable in a non-commercial context. This was opposed by two delegations and the representative of an observer organization.

*Draft Section 4. Factors for Determining Commercial Effect*

123. One delegation proposed to order the various factors according to their importance. Another delegation observed that the importance of the various factors was a matter of perspective: whereas some factors were more conducive to positively establishing a commercial effect, others could rather be used negatively to show that no commercial effect had been produced. Three delegations stated that the significance of some factors, such as those mentioned under items (b) and (k), appeared unclear, and that it might be preferable to confine the list to clear factors. Another delegation stressed the importance of item (b) and favored its retention.

124. One delegation noted that item (c) referred to the concept of “disclaimer”, and that it might be necessary to clearly spell out the relationship of that factor to other provisions which, like Section 11(2), also used that concept.

125. With regard to item (i), one delegation proposed to specify that “further commercial activities in the particular Member State which are not carried out over the Internet” are only those which are related to the activities carried out over the Internet.

126. Another delegation proposed to limit the scope of item (m) to business activities relating to identical or similar goods or services.

127. The International Bureau suggested to group the factors into categories, for clarity.

*Draft Section 5. Use for Determining Acquisition and Maintenance of Rights*

128. Two delegations and the representative of an observer organization expressed support for the draft as proposed.

*Draft Section 6. Consideration of Use on the Internet as Infringement of Rights Protected in a Member State*

129. No comments were made on this provision.

*Draft Section 7. New Forms of Uses Made Possible by Technology*

130. One delegation asked whether the provision was necessary, since Section 2 seemed to express the same idea in different words. In response, the International Bureau stated that Section 7 was intended to capture unique forms of use on the Internet.

131. Someone suggested to add “under their national law.”

*Draft Section 8. Exceptions to Liability*

132. *Paragraph (1)*. Several delegations considered that this paragraph dealt with problems that were not Internet-specific but general legal issues which should be left to the applicable national or regional laws. Two delegations, therefore, proposed to delete the paragraph. Some delegations also stated that the exception in item (i) might go too far in exempting non-commercial use from liability, even where it had produced a commercial effect.

133. Another delegation argued that the objective of paragraph (1), as set forth in the Notes, was worth pursuing, and believed that it could provide some legal certainty which was particularly important for small enterprises that tried to do business on the Internet. The Delegation stated that it should be made clear in the note that the provision assumed that the mark was used in good faith.

134. The International Bureau explained that this provision provides for an exception to liability, and not an exception to infringement, and could concern a type of activity on the Internet that fell under an exception in the user's home country, but not in another country. The International Bureau also pointed out that the provisions were designed to clarify the types of activity someone could engage in to avoid being sued in a jurisdiction in which he had no intention of doing business or producing a commercial effect.

135. The representative of an observer organization noted that the exceptions set forth in items (ii) to (iv) would contribute to emphasizing the importance of the application of national law, especially when considering use on the Internet.

136. *Paragraph (2)*. The current text was generally supported by one delegation and the representative of an observer organization, but opposed by a number of other delegations and the representatives of two observer organizations. These delegations stated that their interested circles had objected to a general exemption from liability. They proposed to move toward coexistence by focusing on remedies: the fact that an "infringer" has a valid registration somewhere in the world could be taken into account as a mitigating circumstance. The delegations also suggested that mediation or arbitration might be helpful in cases of conflicts between legitimate right-holders. The representative of an observer organization stated that, if coexistence was drafted as a general exemption from liability, there was no way to prevent damages that might occur as a result of the infringement of a conflicting right.

137. One delegation indicated that it believed that paragraph 8(2) did not go far enough regarding the coexistence of rights. The delegation also stated that it did not favor a system where small enterprises had to search registries around the world, and that the balance of power between the parties should be maintained despite, e.g., a difference in the resources of the parties or the cost of enforcement in any given jurisdiction. The delegation concluded by stating that it thought that a solution was possible, and acknowledged that it might include some form of arbitration as well as guidelines regarding remedies.

138. Other delegations expressed doubts as to the viability of arbitration or mediation procedures in cases of conflicts between legitimate right holders. These delegations pointed out that parties could not be obliged to submit to such proceedings, and that such proceedings could not replace court proceedings.

139. One delegation stressed the need to find a well-balanced approach, taking account of the interests of right holders and electronic businesses. The delegation suggested to distinguish between two closely related questions: (1) in which countries did the user intend to use its sign, and (2) whether or not actual confusion, including dilution, occurred as a result of that use. In this context, three possible factors could be explored: (1) whether the right holder could require the user of the sign to use certain indications in order to avoid confusion; (2) whether an effective disclaimer could prevent a commercial effect from occurring, or whether it could at least exempt the user from liability, and (3) whether the user could be exempted from liability if he takes appropriate steps after receiving notification of conflict. The goal should be to create a list of non-burdensome factors which take due account of the interests of right holders without hindering the development of electronic business.

140. This position was generally supported by another delegation and the representative of an observer organization. That delegation questioned the need for a general principle of coexistence and stated that problematic cases could be resolved by exempting users in good faith from liability up to the point when they are notified of a conflicting right. No enterprise would, therefore, have to undertake a worldwide search for conflicting rights before using a sign on the Internet. However, once the user has been notified of a conflicting right, it would have to take reasonable measures to avoid producing a commercial effect in the country where the conflicting right exists. The delegation suggested to focus on the question of the measures which could reasonably be utilized in such cases without imposing an undue burden on Internet users.

141. Several other comments were made on various issues: The representative of an observer organization suggested changing the title of the section to “Coexistence of Signs.” One delegation suggested to take account of the specialty of trademark rights. Another delegation pointed out that items (ii) and (iii) seemed to pose heavy burdens on Internet users. The delegation stated that the underlying concept behind these items would have to be spelled out. As currently drafted, however, it was not clear whether the indications required in items (ii) and (iii) were meant to restrict the targeted market or to prevent confusion. This was generally supported by two representatives of observer organizations who questioned the viability of using signs like “tm,” as proposed in item (ii), since that sign had different meanings in various jurisdictions, as opposed to “®,” whose use was universally recognized.

142. As regards the alternatives proposed in item (i), one delegation and the representative of an observer organization expressed a preference for Alternative B, but stated that the meaning of “reasonable steps” would have to be clarified. The representative of another observer organization was opposed to both alternatives, and stated that, while alternative A might even contradict the Joint Recommendation Concerning Provisions for the Protection of Well-Known Marks, alternative B imposed an unreasonably heavy burden on Internet users.

#### *Draft Section 9. Bad Faith*

143. *Paragraph (1)*. No comments were made on this provision.

144. *Paragraph (2), item (i)*. One delegation, supported by another delegation, expressed concern regarding the scope of this provision and stated that the user of a sign should not generally be considered to have had “reason to know” of the conflicting right when that right had been published somewhere in the world. The representative of an observer organization suggested to clarify that knowledge alone would never suffice for a finding of bad faith.

145. *Paragraph (2), item (ii)*. The representative of an observer organization suggested to add the words “or unjustifiably impair” after the words “would take unfair advantage of.”

*Draft Section 10. Adapting Remedies to Protect Trademarks and Other Distinctive Signs on the Internet*

146. No comments were made on this provision.

*Draft Section 11. Remedy Commensurate with Use in Member States*

147. One delegation expressed support for the provision as currently drafted and asked whether the contents of Note 11.02 could be transferred to the provision itself since this might provide a solution in conflicts of legitimate rights. The representative of an observer organization suggested to add, in paragraph (2), the words “on the Internet” after “concurrent use.”

*Draft Section 12. Global Injunctions*

148. *Paragraph (1)*. No comments were made on this provision.

149. *Paragraph (2)*. Two delegations were concerned that global injunctions might go too far. One delegation stated that a determination of bad faith in one country should not automatically disentitle the user of any rights it might have in other countries. Another delegation noted that the concept of bad faith in Section 12 was different from the one used in Section 8, and suggested to include additional conditions in Section 12. Another delegation and the representatives of two observer organizations stressed the need for global injunctions in cases of bad faith and pointed out that an injunction to stop every use on the Internet would necessarily have global effect.

150. Following these interventions, the SCT discussed whether it was possible to imagine injunctions having a less than global effect. In the course of this discussion, participants mentioned injunctions obliging the user to place a disclaimer regarding particular countries on the web site, to design the web site in such a way that it specifically addresses customers in a particular country, to add indications for avoiding confusion (analogous to cases of conflicts between homonymous names), or to refuse delivery to particular countries. With regard to the last-mentioned option, it was pointed out that users offering digital goods or services could not easily determine with certainty in which country their customers are located. In such cases it might be considered sufficient if users determined the location of their customers with reference to their credit card billing address.

151. The International Bureau noted that it might be necessary to distinguish, in the area of remedies, between cases where the user has no right to use the sign, cases where he or she has a right to use a sign, and cases where he or she uses the sign in bad faith. With regard to the scope of injunctions, it suggested to distinguish between limitations and prohibitions of use. Only the latter would have global effect. The International Bureau also noted that the list of examples in paragraph (2) might have to be expanded.

152. In conclusion, the SCT agreed that the International Bureau would submit a revised draft of the provisions to the fifth session of the SCT, on the basis of these discussions.

## CONCLUSION OF THE MEETING

### Agenda Item 8: Future Work

153. The SCT agreed that its fifth session would tentatively be held from September 11 to 15, 2000, in Geneva, and would last five full days.

154. The SCT further agreed that the agenda of the next meeting would consist of the following substantive items:

- Use of Trademarks and other distinctive signs on the Internet, including the issue of Unfair Competition on the Internet
- Study on Geographical Indications.

### Agenda Item 9: Brief Summary by the Chair

155. The SCT adopted the Summary by the Chair (document SCT/4/5), incorporating a number of suggested amendments.

### Agenda Item 10: Closing of the Session

156. Mr. Shozo Uemura, Deputy Director General, offered thanks to all of the delegates and representatives and others who contributed to the success of this meeting, and expressed satisfaction that a successful result could be reported to the General Assembly of WIPO.

157. The Chair closed the fourth session of the Standing Committee.

[Annexes follow]



ANNEXE 1/ANNEX 1

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

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<sup>†</sup> Sur une décision du Comité permanent, les Communautés européennes ont obtenu le statut de membre sans droit de vote.

<sup>†</sup> Based on a decision of the Standing Committee, the European Communities were accorded Member status without a right to vote.

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[Annex 2 follows]

ANNEX 2

PROPOSED JOINT RECOMMENDATION CONCERNING  
TRADEMARK LICENSES

*Joint Recommendation*

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO);

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property and of the Trademark Law Treaty (TLT);

*Recommend* that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its fourth session, as guidelines concerning trademark licenses;

*It is further recommended* to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring these provisions to the attention of that organization.

*Article 1*

*Abbreviated Expressions*

For the purposes of these draft Provisions, unless expressly stated otherwise:

- (i) “Office” means the agency entrusted by a Member State with the registration of marks;
- (ii) “registration” means the registration of a mark by an Office;
- (iii) “application” means an application for registration;
- (iv) “mark” means a mark relating to goods (trademark) or to services (service mark) or to both goods and services;
- (v) “holder” means the person whom the register of marks shows as the holder of the registration;
- (vi) “Nice Classification” means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised and amended;

- (vii) “license” means a license for the use of a mark under the applicable law of a Member State;
- (viii) “licensee” means the person to whom the holder grants a license;
- (ix) “exclusive license” means a license which is only granted to one licensee, and excludes the holder from using the mark and from granting licenses to any other person;
- (x) “sole license” means a license which is only granted to one licensee and excludes the holder from granting licenses to any other person, but does not exclude the holder from using the mark;
- (xi) “non-exclusive license” means a license which does not exclude the holder from using the mark or from granting licenses to any other person.

*Article 2*  
*Request for Recordal of a License*

- (1) [*Contents of the Request for Recordal*] Where the law of a Member State provides for the recordal of a license with its Office, that Member State may require that the request for recordal contain some or all of the following indications or elements:
- (i) the name and address of the holder;
  - (ii) where the holder has a representative, the name and address of that representative;
  - (iii) where the holder has an address for service, such address;
  - (iv) the name and address of the licensee;
  - (v) where the licensee has a representative, the name and address of that representative;
  - (vi) where the licensee has an address for service, such address;
  - (vii) the name of a State of which the licensee is a national if he is a national of any State, the name of a State in which the licensee has his domicile, if any, and the name of a State in which the licensee has a real and effective industrial or commercial establishment, if any;
  - (viii) where the holder or the licensee is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;
  - (ix) the registration number of the mark which is the subject of the license;

(x) the names of the goods and/or services for which the license is granted, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification;

(xi) where applicable, that the license is an exclusive license, a non-exclusive license, or a sole license;

(xii) where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;

(xiii) the time period of the license;

(xiv) a signature as specified in paragraph (2).

(2) [*Signature*] (a) A Member State shall accept the signature of the holder or his representative, whether or not it is accompanied by the signature of the licensee or his representative.

(b) A Member State shall also accept the signature of the licensee or his representative, even if it is not accompanied by the signature of the holder or his representative, provided that it is accompanied by one of the following:

(i) an extract of the license contract indicating the parties and the rights being licensed, certified by a notary public or any other competent public authority as being a true extract of the contract;

(ii) an uncertified statement of license, drawn up in the form and with the content as prescribed in the statement of license Form provided for in the Annex to these provisions, and signed by both the holder or his representative and the licensee or his representative.

(3) [*Presentation of the Request*] As regards the requirements concerning the presentation of the request, no Member State shall refuse the request where the presentation and arrangement of indications and elements in the request correspond to the presentation and arrangement of indications and elements in the request Form provided for in the Annex to these provisions.

(4) [*Language; Translation*] (a) A Member State may require that the request be in the language, or in one of the languages, admitted by the Office.

(b) A Member State may require that, if the document referred to in paragraph (2)(b)(i) or (ii) is not in the language, or in one of the languages, admitted by the Office, the request be accompanied by a certified translation of the required document in the language, or in one of the languages, admitted by the Office.

(5) [*Fees*] Any Member State may require that, in respect of the recordal of a license, a fee be paid to the Office.

(6) [*Single Request Relating to Several Registrations*] A single request shall be sufficient even where the license relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request, the holder and the licensee are the same for all registrations, and the request indicates the scope of the license in accordance with paragraph (1)(a) with respect to all registrations.

(7) [*Prohibition of Other Requirements*] No Member State may demand that requirements other than those referred to in paragraphs (1) to (6) be complied with in respect of the recordal of a license with its Office. In particular, the following may not be required:

- (i) the furnishing of the registration certificate of the mark which is the subject of the license;
- (ii) the furnishing of the license contract or a translation of it;
- (iii) an indication of the financial terms of the license contract.

(8) [*Request Relating to Applications*] Paragraphs (1) to (7) shall apply, *mutatis mutandis*, to requests for recordal of a license for an application, where the applicable law of a Member State provides for such recordal.

### *Article 3* *Request for Amendment or Cancellation of a Recordal*

Article 2 shall apply, *mutatis mutandis*, where the request concerns the amendment or cancellation of the recordal of a license.

### *Article 4* *Effects of the Non-Recordal of a License*

(1) [*Validity of the Registration and Protection of the Mark*] The non-recordal of a license with the Office or with any other authority of the Member State shall not affect the validity of the registration of the mark which is the subject of the license, or the protection of that mark.

(2) [*Certain Rights of the Licensee*] (a) A Member State may not require the recordal of a license as a condition for any right that the licensee may have under the law of that Member State to join infringement proceedings initiated by the holder or to obtain, by way of such proceedings, damages resulting from an infringement of the mark which is the subject of the license.

(b) If subparagraph (a) is not compatible with the national law of a Member State, that subparagraph shall not apply in respect of that Member State.

*Article 5*  
*Use of a Mark on Behalf of the Holder*

Use of a mark by natural persons or legal entities other than the holder shall be deemed to constitute use by the holder himself if such use is made with the holder's consent.

*Article 6*  
*Indication of the License*

Where the law of a Member State requires an indication that the mark is used under a license, full or partial non-compliance with that requirement shall not affect the validity of the registration of the mark which is the subject of the license or the protection of that mark, and shall not affect the application of Article 5.

[End of Annex 2 and of document]