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

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**PROPOSED JOINT RECOMMENDATION CONCERNING
TRADEMARK LICENSES**

prepared by the International Bureau

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Explanatory Notes prepared by the International Bureau

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).

[Article 2, continued]

(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;

[Article 2(7), continued]

(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.

[Annex follows]

ANNEX

MODEL INTERNATIONAL FORM No 1

**REQUEST FOR
RECORDAL OF LICENSE**

**REQUEST FOR AMENDMENT/CANCELLATION
OF RECORDAL OF LICENSE**

in respect of application(s) and/or registered mark(s),

submitted to the Office of

FOR OFFICE USE ONLY

Reference indication of holder/applicant and/or licensee: ¹
Reference indication of representative of holder/applicant
licensee: ¹

1. Request²

- The recordal of the fact that the registration(s) and/or application(s) mentioned in the present request is (are) the subject of a license is hereby requested.
- The amendment of the recordal of the license(s) concerning the registration(s) and/or application(s) mentioned in the present request is hereby requested.
- The cancellation of the recordal of the license(s) concerning the registration(s) and/or application(s) mentioned in the present request is hereby requested.

¹ Any reference indication allotted by the holder and/or licensee and/or any reference indication allotted by any of the representatives to the present request may be given in this space.

² Check the appropriate box.

2. Registration(s) and/or Application(s) Concerned

The present request concerns the following registration(s) and/or application(s):

2.1 Registration and/or application number(s):

2.2 If the space under item 2.1 is not sufficient, check this box and provide the information on an additional sheet.

3. Holder(s)/Applicant(s)

3.1 If the holder/applicant is a natural person, the person's

(a) family or principal name:³

(b) given or secondary name(s):³

3.2 If the holder/applicant is a legal entity,

(a) the entity's full official designation:

(b) the legal nature of the legal entity:

(c) the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

3.3 Address (including postal code and country):

Telephone number(s):⁴

Telefacsimile numbers(s):⁴

3.4 Check this box if there is more than one holder; in that case, list the additional holders on a separate sheet and indicate, in respect of each of them, the data referred to in items 3.1 or 3.2 and 3.3.

³ The names to be indicated under (a) and (b) are those which appear in the records of the Office in respect of the holder of the registration(s) to which the present request relates.

⁴ Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

4. Representative of Holder(s)/Applicant(s)

4.1 Name:

4.2 Address (including postal code and country):

Telephone number(s)⁵:

Telefacsimile number(s)⁵:

4.3 Registration number, if registered with the Office:

4.4 Number allotted to the power of attorney:⁶

5. Address for Service of Holder(s)/Applicant(s)⁷

6. Licensee

6.1 If the licensee is a natural person, the person's

(a) family or principal name:

(b) given or secondary name(s):

6.2 If the licensee is a legal entity,

(a) the entity's full official designation:

(b) the legal nature of the legal entity:

(c) the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

⁵ Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

⁶ Leave blank if the power of attorney has not, or has not yet, been allotted a number or if the number is not known to the holder/applicant or the representative.

⁷ According to Article 4(2)(b) of the TLT, an address for service must be indicated in the space available under the title of item 5 where the holder/applicant does not have, or has not indicated, a domicile or a real and effective industrial or commercial establishment on the territory of the Contracting Party whose Office is the Office named on the first page of the present request, except where a representative is indicated in item 4.

6.3 Address (including postal code and country):

Telephone number(s):⁸

Telefacsimile numbers(s):⁵

6.4 State of nationality of the licensee:

6.5 State of domicile of the licensee:

6.6 State of real and effective industrial or commercial establishment of the licensee:

6.7 Check this box if there is more than one licensee; in that case, list each additional licensee on a separate sheet and indicate, in respect of each of them, the data referred to in items 6.1 to 6.6.

7. Representative of Licensee

7.1 Name:

7.2 Address (including postal code and country):

Telephone number(s)⁹:

Telefacsimile number(s)⁹:

7.3 Registration number, if registered with the Office:

7.4 Number allotted to the power of attorney:¹⁰

⁸ Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

⁹ Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

¹⁰ Leave blank if the power of attorney has not, or has not yet, been allotted a number or if the number is not known to the holder/applicant or the representative.

8. Address for Service of Licensee¹¹

9. Goods and/or Services for Which the License Is Granted¹²

- 9.1 The license is granted for all the goods and/or services listed in the registration(s) and/or application(s) referred to in item 2.
- 9.2 Only one registration or application is mentioned in item 2 and the license is only granted for some of the goods and/or services listed in that registration or application. The following goods and/or services that are covered by the license:
- 9.3 More than one registration and/or application is mentioned in item 2, and in respect of at least one of them, the license covers less than all the goods and/or services listed. In this case, indicate on an additional sheet, separately in respect of each registration and/or applications, whether the license covers all the goods and/or services or only some of them.
-

10. Kind of License¹²

- 10.1 The license is an exclusive license.
- 10.2 The license is a sole license.
- 10.3 The license is a non-exclusive license.
- 10.4 The license concerns only the following part of the territory covered by the registration:
-

¹¹ According to Article 4(2)(b) of the TLT, an address for service must be indicated in the space available under the title of item 68 where the holder/applicant/licensee does not have, or has not indicated, a domicile or a real and effective industrial or commercial establishment on the territory of the Contracting Party whose Office is the Office named on the first page of the present request, except where a representative is indicated in item 57.

¹² Check the appropriate box.

11 Time Period of License¹²

11.1 The license is limited in time and granted

fromto

11.1.1 The license is subject to automatic extension.

11.2 The license is granted for an unlimited period of time.

12. Signatures or Seals¹³

12.1 Signature(s) or seal(s) of the holder(s)/applicant(s):

12.1.1 Name of the holder or, if the holder is a legal entity, name of the person who acts on behalf of the holder:

12.1.2 Date of signature or of sealing:

12.1.3 Signature or seal:

12.2 Signature(s) or seal(s) of the licensee(s):¹⁴

12.2.1 Name of the licensee(s) or, if the licensee(s) is a legal entity, name of the person who acts on behalf of the licensee(s):

12.2.2 Date of signature or of sealing:

12.2.3 Signature or seal:

¹³ If there is more than one person signing or whose seal is used, all of the indications under subitems 12.1 to 12.4 should be given on an additional sheet.

¹⁴ The signature of the licensee is only necessary if the request is not signed by the holder. In this case, the request must be accompanied, at the option of the requesting party, by one of the following: (i) an extract of the contract, showing the change in ownership, which extract may be required to be 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 this Annex and signed by both the holder or his representative, and the licensee or his representative.

12.3 Signature or seal of the representative of the holder(s)/applicant(s):

12.3.1 Name of the natural person who signs or whose seal is used:

12.3.2 Date of signature or of sealing:

12.3.3 Signature or seal:

12.4 Signature or seal of the representative of the licensee(s):

12.4.1 Name of the natural person who signs or whose seal is used:

12.4.2 Date of signature or of sealing:

12.4.3 Signature or seal:

13. Fee

13.1 Currency and amount of the fee paid in connection with the present request:

13.2 Method of payment:

14. Additional Sheets

Check this box if additional sheets are enclosed and indicate the total number of such sheets:

MODEL INTERNATIONAL FORM No 2

STATEMENT OF LICENSE

in respect of application(s) and/or registered mark(s),
submitted to the Office of

FOR OFFICE USE ONLY

Reference indication of holder/applicant
and/or licensee:¹⁵

Reference indication of representative of
holder/applicant

licensee:¹

1. Statement

The holder(s)/applicant(s) and licensee(s) hereby state that the registration(s) and/or application(s) identified below is (are) the subject of a license

¹⁵ Any reference indication allotted by the holder and/or licensee and/or any reference indication allotted by any of the representatives to the present request may be given in this space.

2. Registration(s) and/or Application(s) Concerned

The present statement concerns the following registration(s) and/or application(s):

2.1 Registration and/or application number(s):

2.2 If the space under item 2.1 is not sufficient, check this box and provide the information on an additional sheet.

3. Holder(s)/Applicant(s)

3.1 If the holder/applicant is a natural person, the person's

(a) family or principal name:¹⁶

(b) given or secondary name(s):¹⁶

3.2 If the holder/applicant is a legal entity,

(a) the entity's full official designation:

(b) the legal nature of the legal entity:

(c) the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

3.3 Address (including postal code and country):

Telephone number(s):¹⁷

Telefacsimile numbers(s):¹⁷

3.4 Check this box if there is more than one holder/applicant; in that case, list the additional holders/applicants on a separate sheet and indicate, in respect of each of them, the data referred to in items 3.1 or 3.2 and 3.3.

¹⁶ The names to be indicated under (a) and (b) are those which appear in the records of the Office in respect of the holder of the registration(s) to which the present request relates.

¹⁷ Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

4. Representative of Holder(s)/Applicant(s)

4.1 Name:

4.2 Address (including postal code and country):

Telephone number(s)¹⁸:

Telefacsimile number(s)¹⁸:

4.3 Registration number, if registered with the Office:

4.4 Number allotted to the power of attorney:

5. Licensee

5.1 If the licensee is a natural person, the person's

(a) family or principal name:

(b) given or secondary name(s):

5.2 If the licensee is a legal entity,

(a) the entity's full official designation:

(b) the legal nature of the legal entity:

(c) the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

5.3 Address (including postal code and country):

Telephone number(s):¹⁹

Telefacsimile numbers(s):¹⁹

5.4 State of nationality of the licensee:

5.5 State of domicile of the licensee:

¹⁸ Even where the Office elects to request this information, the holder/applicant or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

¹⁹ Even where the Office elects to request this information, the licensee or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

5.6 State of real and effective industrial or commercial establishment of the licensee:

5.7 Check this box if there is more than one licensee; in that case, list each additional licensee on a separate sheet and indicate, in respect of each of them, the data referred to in items 5.1 to 5.6.

6. Representative of Licensee

6.1 Name:

6.2 Address (including postal code and country):

Telephone number(s)²⁰:

Telefacsimile number(s)²⁰:

6.3 Registration number, if registered with the Office:

6.4 Number allotted to the power of attorney:²¹

7. Goods and/or Services for Which the License Is Granted²²

7.1 The license is granted for all the goods and/or services listed in the registration(s) and/or application(s) referred to in item 2.

7.2 Only one registration or application is mentioned in item 2 and the license is only granted for some of the goods and/or services listed in that registration or application. The following goods and/or services that are covered by the license:

7.3 More than one registration and/or application is mentioned in item 2, and in respect of at least one of them, the license covers less than all the goods and/or services listed. In this case, indicate on an additional sheet, separately in respect of each registration and/or applications, whether the license covers all the goods and/or services or only some of them.

²⁰ Even where the Office elects to request this information, the licensee or his representative has the option to refrain from providing such indications. Where they are given, they should include the country code (where appropriate) and area code.

²¹ Leave blank if the power of attorney has not, or has not yet, been allotted a number or if the number is not known to the licensee or the representative.

²² Check the appropriate box.

8. Kind of License²²

- 8.1 The license is an exclusive license.
- 8.2 The license is a sole license.
- 8.3 The license is a non-exclusive license.
- 8.4 The license concerns only the following part of the territory covered by the registration:
-

9. Time Period of License²²

- 9.1 The license is limited in time and granted
fromto
- 9.1.1 The license is subject to automatic extension.
- 9.2 The license is granted for an unlimited time.
-

10. Signatures or Seals²³

- 10.1 Signature(s) or seal(s) of the holder(s)/applicant(s):
- 10.1.1 Name of the holder/applicant or, if the holder/applicant is a legal entity, name of the person who acts on behalf of the holder/applicant
- 10.1.2 Date of signature or of sealing:
- 10.1.3 Signature or seal:
- 10.2 Signature(s) or seal(s) of the licensee(s):
- 10.2.1 Name of the licensee or, if the licensee is a legal entity, name of the person who acts on behalf of the licensee:
- 10.2.2 Date of signature or of sealing:
- 10.2.3 Signature or seal:

²³ If there is more than one person signing or whose seal is used, all of the indications under subitems 10.1 to 10.4 should be given on an additional sheet.

10.3 Signature or seal of the representative of the holder(s)/applicant(s):

10.3.1 Name of the natural person who signs or whose seal is used:

10.3.2 Date of signature or of sealing:

10.3.3 Signature or seal:

10.4 Signature or seal of the representative of the licensee(s):

10.3.1 Name of the natural person who signs or whose seal is used:

10.3.2 Date of signature or of sealing:

10.3.3 Signature or seal:

11. Additional Sheets

Check this box if additional sheets are enclosed and indicate the total number of such sheets:

[Explanatory Notes follow]

EXPLANATORY NOTES^{*}
prepared by the International Bureau

^{*}These notes were prepared by the International Bureau of the World Intellectual Property Organization (WIPO) for explanatory purposes only.

Notes on Article 1

1.01 *Items (i) to (xi)* seem to be self-explanatory. *Items (i) to (iii), (v) and (vi)* correspond to the abbreviated expressions used in the Trademark Law Treaty (TLT).

1.02 The terms defined in items (ix) to (xi) are used in Article 2(1)(a)(ix) and in Section 8 of the Model International Form contained in the Annex.

Notes on Article 2

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.

2.02 *Paragraph (1)(a)*. This provision sets out the elements which an Office may require to be presented in a request for recordal of a license for the use of a mark. The list of those elements constitutes a maximum; an Office is free to require some only of those elements, but it may not require other or additional requirements (see paragraph (7)).

2.03 *Items (i) to (vi)*. As far as the manner of indicating names and addresses is concerned, Rule 2 (*Manner of Indicating Names and Addresses*) of the TLT would apply.

2.034 *Items (ii), (iii), (v) and (vi)*. Article 4(2) of the TLT would apply to these items, because recordal of a license is a “procedure before the Office.” Thus, under that Article, representation or an address for service may be required.

2.05 *Items (v) and (vi)* take account of the fact that Article 2(2) allows the licensee to file a request for recordal of a license independently of the holder, and that, on the basis of Article 4(2) of the TLT, Member States may require that any person who has neither a domicile nor a real and effective industrial or commercial establishment on its territory, be represented by a representative or indicate an address for service. Therefore, Member States may also require that the request contain information regarding the licensee’s representative or address for service.

2.06 *Item (vii)* allows a Member State to determine, where necessary, if reciprocity is offered *vis-à-vis* its nationals in the country of which the licensee is a national. Since Article 3 of the Paris Convention for the Protection of Industrial Property provides that nationals of countries not members of the Paris Union are entitled to national treatment if they have a real and effective industrial or commercial establishment or are domiciled in one of the Paris Union countries, this item allows those indications to be required.

2.07 *Item (viii)* allows a Member State to require that, where the holder, the licensee, or both parties are legal entities, the legal nature of the entity be specified. This provision mirrors Article 3(1)(a)(iv) of the TLT, which allows a similar requirement with regard to trademark applications.

2.08 *Paragraph (1)(a), items (ix) and (x).* These items seem to be self-explanatory.

2.09 *Item (xi).* Definitions of “exclusive license,” “non-exclusive license” and “sole license” are contained in Article 1(ix) to (xi). It is to be noted that, as indicated by the words “where applicable,” if the law of a Member State does not provide for one or more such indications, information corresponding to the item under consideration would not have to be furnished.

2.10 *Item (xii)* allows a Member State to require an indication that the license concerns only part of the territory for which the registration has effect, together with an explicit indication of that territory.

2.11 *Item (xiii).* Member States may require that the request indicate the time period for which the license is granted, or that it is granted for an unlimited period of time. If the license is granted for a limited period of time but renewed or extended automatically, the licence would be considered to have been granted for a limited period of time. It would be the responsibility of the parties to inform the Office of any subsequent renewal or extension of the license.

2.12 *Item (xiv)* allows a Member State to require a signature, which can be either the signature of the holder or his representative or, under certain conditions set out in paragraph (2)(b), the signature of the licensee or his representative.

2.13 *Paragraph (2).* The request for recordal of a licence is different in nature from the request for a recordal of the change in ownership of registration of a mark, as provided for in Article 11(1)(d) of the TLT. For example, some countries require all co-holders to sign the license agreement, while others permit only one of the several co-holders to license a registered mark. Therefore, unlike the TLT provision, the question as to whether all co-holders have to give their consent to the recordal of the license is left to the applicable law of the Member States. In particular, the question whether the signature of one or several co-holders satisfies the requirement that the request be signed by “the holder”, or if signatures of all co-holders are needed for that requirement to be satisfied, is left to the applicable law. In any event, if one co-holder refuses to sign and, under the applicable law, the request cannot be accepted, the licensee would be able to request recordal under paragraph (2).

2.14 *Paragraph (2)(a).* In the interest of simplifying, to the extent possible, the formal requirements relating to the recordal of licenses, Member States may only require that the request be signed by the holder of the registration or his representative if the request is filed by the holder himself. His signature suffices to ensure that he has actually consented to the recordal. Attention is drawn to the obligation to apply Article 8(4) of the TLT, which prohibits the attestation, notarization, authentication, legalization or other certification of any signature or seal.

2.15 *Paragraph (2)(b).* This provision allows the licensee to file the request for recordal independently of the holder, for example, if the holder wants to avoid paying the recordal fees, or, after having concluded the license contract, refuses to record it for whatever reason. The documents listed in this paragraph can replace the signature of the holder on the request. The requesting party may file any one of them. The list is inspired by the list contained in Article 11(1)(b) of the TLT regarding formal requirements for the recordal of changes in ownership resulting from a contract, while taking account of the qualitative difference

between a full transfer of ownership and a mere licensing of rights. Since subparagraph (b) only describes the situations in which an Office is obliged to accept a request signed by the licensee or its representative, an Office is free to accept such a request even if the extract mentioned in item (i) is not certified, or if the request is not accompanied by any documents at all. However, with regard to item (ii), the statement of license has to be signed by both the holder and the licensee, or their representatives.

2.16 *Paragraph (3)*. This provision departs to a certain extent from the provisions in the TLT that deal with the presentation of a request (such as Article 11(1)(a) TLT), since this provision does not specify the means of transmission, such as paper or telefacsimile, but focuses on the contents of the request instead. The effect of Paragraph (3) is that the Office of a Member State must accept a request for recordal of a license where that request (i) contains all the indications or elements specified in the request Form provided for in the Annex, and (ii) presents and arranges these indications or elements in the same way as in that Form.

2.17 *Paragraph (4)*. Subparagraph (a) allows Member States to require that the request be filed in the language, or in one of the languages, admitted by the Office. With regard to the documents listed in paragraph (2)(b)(i) or (ii), however, Member States may merely require that they be accompanied by a translation. The documents themselves may not be required to be in one of the languages admitted by the Office. Member States may, but do not have to, require that the translation be certified.

2.18 *Paragraph (5)*. As regards the amount of fees that an Office may charge for the recordal of a license, it should be noted that nothing in the text would prevent an Office from charging varying fees depending on the number of registrations to which the request relates.

2.19 *Paragraph (6)* is in line with the approach adopted by the TLT in Articles 10(1)(e) and 11(1)(h), namely, to allow that requests for recordal can refer to more than one registration. This is an important simplification in cases where a license is granted for several marks (for example, a series of marks). However, this is subject to the following conditions: The holder and the licensee must be the same for all registrations covered by the license for which recordal is requested and, where applicable, the scope of the license as indicated in Article 2(1)(a)(xi) to (xiii) (i.e., exclusive, non-exclusive, sole, limited to a part of the territory covered by the registration, time period) be indicated with respect to all registrations covered by the license for which recordal is requested. If these conditions are not met, for example, if the holder and the licensee are not identical in respect of all registrations contained in the request, the Office may require that separate requests be filed. Since paragraph (6) only describes the situations in which an Office is obliged to accept a single request for several registrations, an Office is free to accept a single request even if the conditions outlined in paragraph (6) are not met.

2.20 *Paragraph (7)*. The effect of this paragraph is that, for the purposes of the recordal of a license with its Office, a Member State may not require that the applicant give information in addition to what may be required under paragraph (1), or that he furnish any additional document, such as evidence showing the existence of quality control clauses (as regards quality control, see notes 5.02 and 5.03).

2.21 By way of example, *items (i) and (ii)* mention certain items of information whose furnishing to an Office is usually regarded by the parties to a license contract as particularly burdensome or as revealing confidential business information (*item (iii)*). It should be noted, however, that paragraph (7) does not prevent other authorities of Member States (for example, tax authorities or authorities establishing statistics) from requiring the parties to a license contract to furnish information in accordance with the applicable law.

2.22 *Paragraph (8)*. Article 2 and the model request Form contained in the Annex are applicable to requests for the recordal of licenses of applications, if the national or regional law of a Member State provides for such recordal. It should be noted that in this context, Rule 7 of the Regulations under the TLT (*Manner of Identification of an Application Without Its Application Number*) would be applicable.

Notes on Article 3

3.01 Where the recordal of a license has been effected, such recordal may at a certain point in time be the subject of a request for amendment or cancellation. For this reason, Article 3 provides that Article 2 and the model request Form contained in the Annex are applicable, *mutatis mutandis*, to requests concerning the amendment or the cancellation of the recordal of a license. The Delegation of the EC has reserved its position regarding the extension of Article 2 to requests for the amendment of a recordal.

Notes on Article ~~3~~4

4.01 *Paragraph (1)*. The purpose of this paragraph is to separate the question of the validity of the registration of a mark and the protection of that mark from the question whether a license concerning the said mark was recorded. If the law of a Member State provides for the mandatory recordal of licenses, non-compliance with that requirement may not result in the invalidation of the registration of the mark which is the subject of the license, and may not affect in any way the protection afforded to that mark. It is to be noted that this paragraph concerns the recordal of a license with the Office or other authority of a Member State such as, for example, the tax authority or the authority responsible for the establishment of statistics.

4.02 *Paragraph (2)(a)*. This provision does not intend to harmonize the question whether a licensee should be allowed to join proceedings initiated by the licensor, or whether it would be entitled to damages resulting from an infringement of the licensed mark. This question is left to the applicable law. However, where a licensee has the right under the law of a Member State to join infringement proceedings initiated by the holder and to obtain damages resulting from an infringement of the licensed mark, the licensee should be able to exercise those rights independently of whether the license is recorded.

4.03 The question of the entitlement of a licensee to join infringement proceedings initiated by the holder and to obtain damages is distinct from the question whether a licensee is allowed to bring infringement proceedings concerning the licensed mark in his own name. The latter case is not dealt with by the draft Articles. Therefore, Member States would be allowed to require the recordal of the license as a condition for the licensee to bring a legal

action in his own name concerning the mark which is the subject of the license. Under Paragraph (2)(a), Member States are free to provide that the non-recorded licensee has the right to obtain damages only where he had joined infringement proceedings initiated by the holder. However, this is a maximum standard and Member States are of course equally free to adopt a more liberal approach, such as exists where the applicable national or regional law does not provide for the recordal of a license at all.

4.04 The question whether the non-recorded licensee should have the right to join infringement proceedings initiated by the holder and to recover damages was the subject of an intensive debate during the first session of the Committee of Experts on Trademark Licenses (see document TML/CE/I/3, paragraphs 70 to 74), and during the third session of the Standing Committee on the Law of trademarks Industrial Designs and Geographical Indications (SCT) (see document SCT/3/10, paragraphs 122 to 124). Delegations which opposed the provision argued that, under the law of their countries, a license had only effect *vis-à-vis* third parties if it was recorded. Delegations and representatives of observer organizations who expressed their support for the provision emphasized that, if the right of the licensee to recover damages in infringement proceedings initiated by the holder depended on the registration of the license, this would only benefit trademark infringers, since they might not be liable at all when the only person suffering damages from the unauthorized use of the mark is the licensee. From the point of view of trademark infringers it should not make any difference whether the protected mark was used under a recorded license. What mattered in such cases was that the mark is protected and this could be checked by reference to the trademark register.

4.05 It is worthwhile to note that, if a Member State considers a licence legally effective *vis-à-vis* third parties only when it was recorded, such a provision would not necessarily have to be interpreted as meaning that a non-recorded licensee shall not have the right to recover damages for the infringement of the licensed mark. Such provisions would nevertheless have an effect in cases where a registration was transferred after the conclusion of the license, because a non-recorded licensee would not be able to invoke the license against a transferee. This is not prohibited by paragraph (2) which only deals with one specific situation, namely the right of the unrecorded licensee to join infringement proceedings initiated by the holder, and to recover damages by way of such proceedings.

4.06 *Paragraph (2)(b)*. Subparagraph (b) takes account of relevant laws which expressly prohibit a non-recorded licensee from joining infringement proceedings initiated by the holder, and from recovering damages. Therefore, although the provision in subparagraph (a) has been retained as a general principle, subparagraph (b) makes it clear that such laws are not affected. However, laws that can be interpreted as allowing a non-recorded licensee to join infringement proceedings and to recover damages would fall under subparagraph (a) and would, therefore, have to be interpreted in this way.

Notes on Article 5

5.01 The question whether use by a person other than the holder can be considered as use by the holder may be relevant in at least three different contexts: (i) for determining whether a mark has acquired distinctiveness, (ii) for determining whether a mark has become well-known, (iii) for determining whether a mark has been sufficiently used to maintain its registration. Article 5 only deals with situations in which the use by a person other than the holder might accrue to the benefit of the holder. It does not address the question under what circumstances the holder may be held liable for such use.

5.02 It should be noted that it is a generally accepted standard in trademark law that registered marks which are not used for a certain period of time are liable to be invalidated. For example, Article 19.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the “TRIPS Agreement”) allows WTO Members to invalidate registered marks which have not been used for more than three years. In general, a mark has to be used by its holder or by a person having the holder’s permission in order to maintain its registration. Certain national or regional laws, however, provide that use by persons other than the holder may be held to constitute use of the mark by the holder only if certain conditions are fulfilled, such as the conclusion of a formal license contract containing quality control clauses or such as the recordal of such a contract. In that respect, it is to be noted that Article 19.2 of the TRIPS Agreement expressly allows a requirement that there be control of a licensee’s use of a mark by the holder in order to consider such use valid for maintaining the registration of the mark.

5.03 The effect of Article 5 is that, whenever the question of use becomes relevant, any use of a mark by any person other than the holder must be deemed to be use of the mark by the holder, provided that such use is made with the consent of the holder. No other condition, such as control by the holder of the use of the mark, may be required by a Member State. Consequently, if, in the absence of use of the mark by the holder, a third party uses that mark with the consent of the holder, the mark cannot be invalidated on the ground of non-use. To this extent, Article 5 goes beyond Article 19.2 of the TRIPS Agreement.

5.04 However, Article 5 only deals with the specific question under what circumstances use by natural persons or legal entities other than the holder can be deemed as use by the holder. It does not address the validity of licensing agreements in general. Therefore, the ability of Contracting Parties to require quality control clauses in order for a licensing agreement to be valid remains unaffected.

5.05 Article 5 would apply independently of whether or not a license exists or, if a license exists, whether or not the license is recorded. Hence, it is sufficient for the holder to consent to the use of his mark in order to benefit from such use whenever the question of use becomes relevant, i.e. in the context of a trademark acquiring distinctiveness or becoming well-known, or for the purpose of maintaining a trademark registration. In essence, any use of the mark by any third party to which the holder consents must be considered use by the holder.

Notes on Article 6

6.01 Article 6 concerns specific indications relating to trademark licenses which may be required, under trademark law, under general labeling law or under advertising law, to appear on products or packaging or to be given in connection with the providing of services or in advertising for such goods or services. It is not the intention of this Article to regulate general questions of product (or service) information required by labeling laws, law on advertising or consumer protection laws. Consequently, national laws and regulations requiring that certain indications relating, for example, to the safety of a product, its composition, its correct use, etc., must appear on its packaging are outside the scope of that Article.

6.02 Article 6 leaves it to the law of a Member State to prescribe whether or not goods which are commercialized under a licensed mark, or their packaging, must bear an indication of the fact that the mark is used under a license contract, or whether or not such an indication has to be given in connection with the providing of services or in advertising for such goods or services. However, where such indication is required by the applicable law, non-compliance with that obligation should not entail the invalidation of the registration of the mark. The existence of the registration should not depend on compliance with requirements concerning labeling or advertising, irrespective of whether they are contained in trademark laws or in other laws such as laws on labeling or advertising. In particular (and this is the effect of the reference to Article 5 which appears at the end of Article 6), Member States are not allowed to cancel the registration of a mark because the only use of that mark was use by a licensee who did not indicate the license on the goods, or their packaging, or in connection with the providing of services or in advertising for the goods or services, for which the mark was used, even if a requirement to that effect existed in that Member State. The underlying thought is that the invalidation of the registration of a licensed mark is too severe a sanction for non-compliance with a labeling or advertising requirement and should therefore not be allowed. Furthermore, non-compliance with labeling or advertising provisions should not lessen the possibilities to enforce the rights attached to a licensed mark. This means that a missing or defective indication of the license cannot constitute an argument in favor of the defending party in infringement proceedings, even if such indication is mandatory under the applicable law. The result of Article 6 is that no sanction for non-compliance with a labeling or advertising requirement, even if that requirement concerns the indication of a license, may affect trademark rights.

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