

Committee on WIPO Standards (CWS)

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REPORT ON THE PREPARATION OF A NEW WIPO STANDARD FOR THE ELECTRONIC MANAGEMENT OF MOTION AND MULTIMEDIA MARKS

Document prepared by the Secretariat

1. The Committee on WIPO Standards (CWS) at its reconvened fourth session held from March 21 to 24, 2016, noted the results of the discussion of the Trademark Standardization Task Force, in particular, the need to monitor the developments in the area of electronic management of motion and multimedia marks. It requested the Task Force to report on the progress in the preparation of the recommendation under Task No. 49 at the fifth session of the CWS (see paragraphs 88 and 89 of document CWS/4BIS/16).
2. In July 2016, the Trademark Standardization Task Force conducted a survey among its members on the practices related to motion and multimedia marks. The summary of survey results is presented as the Annex to this document.
3. The Task Force also revisited the definition of “multimedia mark”, in particular, whether the scope of “multimedia mark” should be limited to the combination of movement and sound only, or it may include other elements.
4. Some Task Force members proposed to postpone the development of the recommendations on electronic management of motion and multimedia marks until the implementation of the directive 2008/95/EC of October 22, 2008, by industrial property offices concerned. The implementation of this directive is planned for the year 2019 (see paragraphs 2 and 10 (a) of the Annex to this document). Considering the lack of experience with motion and multimedia marks (see paragraph 3 of the Annex to this document), other Task Force members did not object to this proposal.

5. *The CWS is invited to*

(a) note the content of the present document and its Annex, in particular, comments and proposals listed in paragraph 10 of the Annex; and

(b) consider and decide on the postponement of the development of the recommendations on electronic management of motion and multimedia marks until 2019 (see paragraph 4 above) and whether the Task No. 49 should be held in abeyance until then.

[Annex follows]

SUMMARY OF THE SURVEY ON IP OFFICES' PRACTICES RELATED TO MOTION AND MULTIMEDIA MARKS

1. The following six industrial property offices (IP offices) shared their practices of processing motion and multimedia marks:

- Austrian Patent Office (AT);
- IP Australia (AU);
- Canadian Intellectual Property Office (CA);
- German Patent and Trade Mark Office (DE);
- Japan Patent Office (JP); and
- State Intellectual Property Service of Ukraine (UA).

2. Three out of six IP Offices (AT, DE and JP) accepted motion marks, but not multimedia marks, one IP office (AU) accepted both types and two IP offices (CA and UA) did not have corresponding provisions in the national legislation yet, but they had plans to introduce these types of marks in the future. It was expected that the implementation of the directive 2008/95/EC would have an impact on IP offices' practices with respect to multimedia marks.

3. Respondents did not have experience with multimedia marks (no applications filed) and the proportion of motion mark applications was very low.

4. Three out of five IP offices accepting (or planning to accept in the near future) motion marks (AU, CA and JP) required that the indication "motion mark" be included in the applications. One IP office (DE) indicated that it included this type of mark (motion) in the broader category "other trademarks". In two IP offices (AU and, as of entry into force of the new legislation, CA) multimedia marks could be filed as composite marks (combination of motion and sound), where each type: motion and sound, should be claimed (identified).

5. It was noted that textual description was a mandatory part of a motion mark application in all five IP offices (AT, AU, CA, DE and JP) accepting this type of trademark. In three out of five IP offices (AT, DE and JP), submitting a graphical representation of a motion mark was also mandatory; in the other two IP offices (AU and CA), graphical representation could be replaced by (or supplemented with) the recording of the motion as long as it clearly defined the scope of requested protection. Color claims and specimens were indicated as optional parts of a motion mark application.

6. In three out of five IP offices (AT, AU and CA), one single image should be presented as a textual description of a motion mark. In the other two IP offices (DE and JP), multiple images were allowed.

7. MPEG file format was used by both IP offices accepting recording of movement (AU and CA).

8. The following requirements for textual descriptions of motion marks were mentioned in the responses:

- consistent with the graphical representation;
- clearly and objectively describes the subject of protection;
- describes the change of shape, the order of the changes and the timeline;
- describes auxiliary elements of the graphical representation, if any (legend); and
- contains text only, up to 100 words.

9. The publication of motion marks should contain all (mandatory and optional) elements considered essential parts of the representation of the mark. If the recording of the movement was one of them, one IP office (CA) included the link to the online database in the trademark publication instead of the file itself.

10. In their responses to the survey, the Task Force members provided the following comments and proposals:

- a. trade marks directive by the European Commission No. 2008/95/EC should be implemented by IP Offices by 2019. It was proposed to put the development of the standard on hold until then;
- b. the recommendations for electronic management of motion and multimedia marks should not be obligatory and leave the IP Offices flexibility to adopt them partially;
- c. it was proposed that any recommended formats in the standard should be generally-used and that minor type of formats not be adopted;
- d. it was proposed to use one format, MPEG-4, for the purpose of international data exchange; and
- e. the Task Force also clarified the use of category "Combined" in WIPO Standard ST.96, in particular, whether it covered multimedia marks.

[End of Annex and of document]