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

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OVERVIEW OF THE POSSIBLE ISSUES TO BE CONSIDERED BY THE STANDING
COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND
GEOGRAPHICAL INDICATIONS (SCT)

Document prepared by the International Bureau

1. At its fifth session, which took place in Geneva from September 11 to 15, 2000, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) decided to include an item on the agenda for the sixth session, relating to its future work during the current biennium and beyond (see the draft report, document SCT/5/6 Prov., paragraph 140).
2. To assist the SCT in that discussion, this document contains a list of possible issues, proposed by the SCT at its fifth session, along with further details on the background of those issues, and the possible work that may be undertaken by the International Bureau and the SCT in relation to each.

I. ISSUES CURRENTLY BEING CONSIDERED
BY THE STANDING COMMITTEE

Provisions on the Protection of Marks and Other Industrial Property Rights in Relation to the Use of Signs on the Internet

3. The SCT has extensively discussed draft provisions on the protection of marks and other industrial property rights in relation with the use of signs on the Internet. At its fifth session (September 11 to 15, 2000), the SCT asked the International Bureau to refine the text of the draft provisions for the sixth session of the SCT on the basis of its discussions.

4. The draft provisions are now before the SCT for consideration of the accuracy of the redraft, on the understanding that they will not be reopened thoroughly for substantive discussion. If the SCT agrees on these provisions, they could then be adopted at its sixth session, and the SCT will have to decide whether these provisions should be recommended to the Assembly of the Paris Union and the WIPO General Assembly for adoption as a Joint Recommendation in September 2001.

Geographical Indications

5. The SCT agreed at its fifth session that, in order to create a better understanding of the legal issues related to the protection of geographical indications, the International Bureau should supplement document SCT/5/3 for discussion at the sixth session of the SCT. The supplement would deal with the following issues: the historical background of the protection of geographical indications; clarification of the nature of the rights in geographical indications; description of the different existing systems for the protection of geographical indications; and investigation of the problems existing in obtaining effective protection for geographical indications in other countries.

6. The relevant working document has been prepared and was presented to the SCT for consideration (document SCT/6/3).

II. POSSIBLE FUTURE ISSUES FOR CONSIDERATION
BY THE STANDING COMMITTEE

Revision of the Trademark Law Treaty (TLT)

7. The Trademark Law Treaty (TLT), which now binds 26 member States, was adopted in Geneva on October 27, 1994. Since then, the evolution of technology, the solution of questions concerning voting rights, and the recent adoption of international norms on trademark licenses, have raised the need for a revision of the TLT to address, at least, the creation of an Assembly, provisions on electronic filing, the incorporation of the WIPO Joint Recommendation concerning Trademark Licenses, and further simplification of formalities in the TLT.

8. The following issues could therefore be addressed:

Establishment of an Assembly

9. Article 18 of the TLT (Revision; Protocols) reads:

“(1) [*Revision*] This Treaty may be revised by a diplomatic conference.

(2) [*Protocols*] For the purpose of further developing the harmonization of laws on marks, protocols may be adopted by a diplomatic conference in so far as those protocols do not contravene the provisions of this Treaty.”

10. So far, the only possibility to revise the TLT, including its regulations, is to convene a diplomatic conference. The TLT has no assembly competent to decide changes to the regulations. The creation of an assembly, like in other international instruments such as the PCT, Madrid Protocol or the Patent Law Treaty (PLT), was prevented in 1994 by a lack of consensus concerning the voting rights of intergovernmental organizations. In view of recent developments in the context of the Madrid Union and the adoption of the Geneva Act of the Hague Agreement, and considering the provisions adopted in the framework of the Patent Law Treaty (PLT), it appears that a consensus may now be possible on this issue. It should be noted that the said issue is being considered by WIPO’s Working Group on Constitutional Reform.

Electronic Filing

11. In 1994, the TLT only envisaged, in Article 3(2), presentation of the application for the registration of a mark on paper or by telefacsimile. Recent developments of electronic communications, paperless policies regarding applications of national or regional offices, and consensus in international agreements such as the PLT (Article 8), have stressed the need for introducing specific provisions concerning electronic filing.

Incorporation of the Joint Recommendation Concerning Trademark Licenses

12. Provisions concerning trademark licenses were adopted as a Joint Recommendation at a joint session of the WIPO General Assembly and of the Paris Union Assembly, in September 2000. Since simplification of the formalities concerning the recordal of trademark licenses should have been included in the scope of the TLT in 1994, the incorporation of the adopted provisions on trademark licenses in the revised TLT is therefore particularly appropriate.

Other suggestions relating to further simplification of formalities in the TLT:

Limitation of Mandatory Representation

13. Under Article 4(2) of the TLT, “any contracting party may require that, for the purposes of any procedure before the Office, any person who has neither a domicile nor a real and effective industrial and commercial establishment on its territory be represented by a representative.”

14. In order to further simplify the formalities relating to representation, it might be opportune to introduce a provision, along the lines of Article 7(2) PLT, which would not permit a Contracting Party to require representation for the purposes of certain procedures

before the Office, such as the filing of an application for the purposes of the filing date, the mere payment of a fee, or any other procedure that may be as prescribed in the Regulations.

Relief in Respect of Time Limits

15. The TLT does not contain a provision addressing relief in respect of formal mistakes, such as the failure to comply with a time limit for an action in a procedure before the Office. It would be therefore appropriate to introduce a provision, along the lines of Articles 11 and 12 of the PLT, which oblige a Contracting Party, under certain conditions, to provide relief for an extension of a time limit, continued processing or the reinstatement of rights.

Substantive Harmonization of Trademark Law

16. The Program and Budget 2000-2001 includes, under sub-program 09.2, “Law of Trademarks”, the following activities (see document A/34/2, page 83):

“Preparation of studies [...] on the extent to which “new trademarks” such as sound marks, smell marks, feel marks, three dimensional marks, and slogans are presently accepted for registration by relevant administrations, and the scope of the use that industry is actually making of such marks.”

17. These questions relate to the broader issue of substantive harmonization of trademark law which the SCT suggested to address (see document SCT/5/6 Prov., paragraphs 137 to 140).

18. Substantive harmonization of trademark law could create an international common ground for trademark protection. It would make it easier for trademark offices to accept applications for trademarks which have already been registered in another country, thus decreasing their administrative burden and facilitating access to international protection. The recently adopted provisions concerning protection of well-known marks could supplement this protection, particularly in cases where a trademark owner has not yet been able to obtain a registration in a particular jurisdiction.

19. Substantive harmonization should therefore include the protection of registered trademarks, and well-known marks. The protection of both groups of marks could be broken down in criteria for obtaining, maintaining and renewing protection, and in a determination of the scope of protection.

Criteria for obtaining, maintaining and renewing protection

20. It seems preferable to harmonize the criteria, rather than the process, for obtaining, maintaining and renewing trademark protection, since the differences in processes are often due to differences in administrative traditions, and since the TLT already provides significant harmonization of formalities. A harmonization of criteria of protection could include the following questions: registrable signs (including registration of non-traditional signs), grounds for refusal or invalidity (including use), earlier rights, term of protection, renewal and maintenance of trademark registrations, as well as criteria for determining whether a mark is a well-known mark.

21. Considering the increased number of applications filed in national and regional Offices, and the consequent administrative burden on those offices, it might be useful to review the substantive aspect of examination and opposition procedures, as a way of achieving expeditious processing of applications.

Scope of Protection

22. The scope of protection of registered trademarks and registered or unregistered well-known marks would include protection against confusion, dilution, and possible exceptions for “fair” or descriptive use.

Harmonization of substantive and formal aspects of national and regional laws on industrial designs

23. Protection of industrial designs on the international level has obtained new impetus with the successful conclusion, in 1999, of a diplomatic conference for the adoption of a new act for the Hague Agreement Concerning the International Deposit of Industrial Designs. However, the discussion that took place in the forefront of the conclusion of the Geneva Act of the Hague Agreement has uncovered a need for a more harmonized international approach to the protection of industrial designs. The SCT could explore the feasibility of harmonizing national and regional industrial design laws and features of procedure, as well as issues of substantive law. Depending on the outcome of that initial assessment, work on harmonization in accordance with terms of reference defined by the SCT could be initiated.

Other possible issues

24. At the fifth session of the SCT, the following additional issues were mentioned (see document SCT/5/6 Prov., paragraphs 136 to 140):

- Nature of rights in domain names;
- Globalization of trademarks;
- Practicality of establishing a principle of internationally or globally well-known marks.

25. The SCT is invited to express its view on the issues outlined above, to determine priorities and to mention any additional issues for future work.

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