|  |  |  |
| --- | --- | --- |
|  | WIPO-E | **E** |
| CWS/8/4 | | |
| ORIGINAL: English | | |
| DATE: october 19, 2020 | | |

**Committee on WIPO Standards (CWS)**

**Eighth Session**

**Geneva, November 30 to December 4, 2020**

Proposal for a new standard on trademark legal status data

*Document prepared by the Legal Status Task Force Leader*

## BACKGROUND

At its seventh session held in 2019, the Committee on WIPO Standards (CWS) requested the Legal Status Task Force to begin work on a proposed standard for trademark legal status data. This work was prioritized over other items in Task No. 47 which reads: "Prepare proposals for revisions to WIPO Standards ST.27 and ST.87 as needed; prepare a proposed guidance document for industrial design legal status data; prepare a recommendation for the exchange of legal status data on trademarks by industrial property offices; and support the XML4IP Task Force to develop XML components regarding legal status event data". The International Bureau is the Task Force Leader. (See paragraphs 111 to 112 of document CWS/7/29.)

## PROPOSED STANDARD

The Legal Status Task Force prepared a proposed Recommendation for the exchange of trademark legal status data, for consideration and adoption by the CWS as a new WIPO Standard. The proposal is presented in the Annexes of this document. The International Bureau recommends the new Standard be designated as ST.61, since other WIPO trademark standards are grouped together in the 60s. The other legal status standards end with seven (27 and 87), but ST.67 is already used for Electronic management of the figurative elements of trademarks.

The proposed Standard follows the model of WIPO ST.27 for patent legal status data and ST.87 for industrial design legal status data. The proposed new standard fulfills a similar purpose. Namely, the availability of up-to-date, reliable, and understandable legal status information on Industrial Property (IP) rights will support improved knowledge of IP right landscapes. Industrial Property Offices (IPOs) currently provide this information in different formats and languages, inconsistently, and in various timeframes due to differing national and regional trademark laws and practices. Therefore, a standardized model to describe the legal status of trademark applications and registered trademarks in a universal manner is highly desirable.

The proposed standard is intended to promote efficient exchange between IPOs in a harmonized manner of legal status data for trademarks. It should facilitate access to that data by IP information users, IPOs, IP data providers, the general public and other interested parties. The proposed Standard aims at improving worldwide availability, reliability and comparability of legal status data for trademarks in registration systems, including the Madrid System.

Following the model of existing WIPO Standards ST.27 and ST.87, the proposed Standard makes use of the same basic approach: a general prosecution model that broadly describes trademark prosecution practices among IPOs worldwide; categories that describe groups of events which share a common theme; key events that describe the most important and relevant general practice within a category; and detailed events that describe particular practices shared by many IPOs. This creates a consistent approach across all types of IP legal status data, which reduces the burden for Offices and users.

Within that framework, the language of the prosecution model, categories, and events have been adapted to the realm of trademarks, while preserving much of the terminology devised by Standards ST.27 and ST.87 to describe different national practices in a universal manner. The proposed new standard and its annexes are presented in the Annex to the present document.

WIPO Standard ST.87, in particular, is a closer model, since trademark systems are more similar to industrial design registration systems than to patent systems. One category (G. Protection beyond IP right term) in ST.27 is missing from both ST.87 and the proposed standard because it does not apply to designs and trademarks. Likewise, a few detailed events that do not apply to trademarks are not used in the proposed standard, such as event A11. Provisional application filed in ST.27. Otherwise category letters and event numbering remain the same. To preserve compatibility with ST.27 and ST.87, gaps in numbering are maintained when an event is not used in the proposed standard, so that, for example, event "A12. National or regional application filed" has the same number in all three legal status standards.

## RELATION TO TM5 COMMON STATUS DESCRIPTORS

In 2018, the Five Trademark Offices[[1]](#footnote-2) (TM5) published results of their Common Status Descriptors (CSD) project, which aims to reflect current legal status of trademarks and applications. Each of the 15 status descriptors[[2]](#footnote-3) includes text and an icon to visually indicate different statuses, such as Awaiting Examination, Published for Opposition, Issued and Active, or Withdrawn/Abandoned.

The Legal Status Task Force determined that the TM5 CSD project and the proposed WIPO Standard serve different purposes. The CSD icons serve a general audience by providing a user-friendly visual indication of current status for human beings. In contrast, the proposed WIPO Standard provides a detailed history of legal status events in a machine-readable format for automated processing, as well as use by human specialists. The two approaches thus complement each other by addressing different needs of the IP community.

The International Bureau has been working with TM5 members on a mapping between TM5 CSD and the proposed WIPO Standard, demonstrating the compatibility of the two systems. The result of this work is intended to be shared with IPOs when it is finalized by the Legal Status Task Force.

## PLANNED IMPROVEMENTS

The licensing events in Category S of the proposed standard were preserved from ST.27 and ST.87, even though some may not apply to trademarks. Category S is a known area for improvement, including in ST.27 and ST.87. The Task Force decided that Category S should be revised consistently across all three standards together, so that compatibility can be maintained. The Task Force plans to work on this during the next year, with the goal of proposing revisions at the next session of the CWS.

To implement the legal status data described in the proposed standard, XML components must be developed to store and process the data. The Legal Status Task Force will assist the XML4IP Task Force with developing XML components for both trademark legal status data in the proposed Standard, and industrial design legal status data in ST.87. Task No. 47 already contains language for this purpose: "support the XML4IP Task Force to develop XML components regarding legal status event data". The Legal Status Task Force plans to work on this during the coming year.

*The CWS is invited to:*

*(a) note the content of this document;*

*(b) consider and approve the proposed name of the WIPO Standard ST. 61: "Recommendation for the exchange of trademark legal status data", as reproduced in the Annex to this document; and*

*(c) consider and adopt the proposed new WIPO Standard ST. 61, as reproduced in the Annex to this document.*

[Annex follows]

1. The National Intellectual Property Administration, PRC (CNIPA), the European Union Intellectual Property Office (EUIPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO) and the United States Patent and Trademark Office (USPTO) [↑](#footnote-ref-2)
2. See <http://tmfive.org/tm-5-common-status-descriptors-tm-5-midterm-meeting-beijing-china-4/> for more information and <https://www.uspto.gov/sites/default/files/documents/CSD.pdf> for a complete list of CSD icons and meanings. [↑](#footnote-ref-3)