

Committee on WIPO Standards (CWS)

Seventh Session
Geneva, July 1 to 5, 2019

REPORT ON TASK NO.60

Document prepared by the International Bureau

BACKGROUND

1. The Trademark Standardization Task Force was established at the third session of the CWS in April 2013 (see paragraphs 55 to 62 and paragraph 74 (e) of document CWS/3/14). At its fifth session in 2017, the CWS agreed to postpone the Task Force's remaining work on Task No. 49 to prepare recommendations for electronic management of motion and multimedia marks until implementation of directive 2008/95/EC planned for the year 2019 (see paragraph 4 of document CWS/5/10 and paragraph 67 of document CWS/5/22).

2. At the sixth session of the Committee on WIPO Standards (CWS) in 2018, the Committee considered proposals by CWS members to update WIPO Standard ST.60 on '*Recommendation concerning bibliographic data relating to marks*'. The CWS created a new Task No. 60, the description of which reads:

"Prepare a proposal for the numbering of INID codes regarding word marks and figurative marks, on splitting INID code (551), and a potential INID code for combined marks."

The CWS assigned the new task to the Trademark Standardization Task Force for further consideration and requested the Task Force to present a proposal or a progress report at its seventh session (see paragraphs 128 to 133 of document CWS/6/34).

DISCUSSIONS AND OUTCOMES – TASK NO. 60

3. The Trademark Standardization Task Force considered the three issues in Task No. 60 and held online discussions about them. The International Bureau also had internal discussions with relevant work units, including the Madrid System about the issues.

4. On the subject of finding suitable INID codes for word marks and figurative marks, the Task Force proposes adopting the revisions presented in document CWS/7/19. The Task Force explored several options and only found one that it could recommend.

5. On the subject of splitting 551 to distinguish collective marks, certification marks, and guarantee marks, the Madrid System noted a preference for keeping these items together under a single code. The Madrid System provided the following statement in support of this approach:

One single indication as to the fact that the basic mark is a collective, certification or guarantee mark rather than separate indications for these respective kinds of mark

Before January 1, 1989, only collective marks were regulated in the Madrid legal framework, Regulations (Rule 10(1)(i)).

After January 1, 1989 but before April 1, 1996, the legal framework (Rule 14(2)(xii) of the Regulations) referred to "collective mark", "certification mark" or "guarantee mark". There were separate checkboxes to indicate specifically collective marks, certification marks and guarantee marks, but using the same INID code 55 ("(55) Indication to the effect that the mark is a collective mark, a certification mark or a guarantee mark").

While under the former Regulations there had indeed been provision for these marks to be indicated separately, this had, however, caused problems, because some countries do not recognize all these kinds of mark. On that reasoning, the legal framework (now the Common Regulations) was changed.

With a more general indication, the idea is that a country which recognizes collective marks, but not certification marks, may, where the basic mark is a certification mark, accept to protect the international mark as a collective mark, or vice versa. It was recognized at that time though that this could give rise to difficulties where a country protects more than one type of mark but under different conditions.

Re-introducing specific boxes may cause difficulties for users of the Madrid System obtaining protection as some countries would not accept all these types and would then issue provisional refusals. With just one box covering all three types, the Office may interpret the mark to be whatever category they accept under their domestic legislation.

6. The Task Force also noted that INID codes only provide general indications about marks. Newer formats for data exchange such as WIPO Standard ST.96 draw different distinctions. On this issue, WIPO ST.96 provides two categories for these types of marks rather than one. Using three categories for ST.96 was also considered and rejected by the XML4IP Task Force which manages the revision of WIPO ST.96.

7. Based on these factors, the Task Force recommends keeping the items together under one INID code with no changes to WIPO Standard ST.60. Automated tools should use formats such as ST.96 for data exchange, which allow more precise treatment of the data. Introducing a new INID code does not seem to provide sufficient benefit.

8. On the subject of whether to create a separate INID code for combined marks, the Task Force noted that, as with collective / certification / guarantee marks, INID codes are only intended to provide general indications about marks such as combined marks. Newer formats for data exchange such as WIPO ST.96 allow finer distinctions between mark types. WIPO ST.96 provides a "combined" type to indicate combined marks.

9. Based on these factors, the Task Force recommends maintaining the current system of dealing with combined marks and making no changes to WIPO ST.60. Automated tools should use formats such as WIPO ST.96 for data exchange, which allow more precise treatment of the data. Introducing a new INID code does not seem to provide sufficient benefit.

RESUMING TASK NO. 49

10. At its fifth session held in 2017, the CWS agreed to postpone the Task Force's remaining work on Task No. 49 "Prepare a recommendation for the electronic management of motion or multimedia marks for adoption as a WIPO standard" until implementation of directive 2008/95/EC by IPOs concerned in 2019. The International Bureau proposes to resume the Task Force's work on Task No. 49 for consideration at the seventh session of the CWS.

11. *The CWS is invited to:*

(a) note the content of the present document;

(b) consider recommendations made by the Task Force as explained in paragraphs 7 and 9 above;

(c) consider whether Task No.60 should be discontinued, once the proposed revision of WIPO ST.60, which is reproduced in document CWS/7/19, is approved; and

(d) provide input on whether the Task Force should resume its work on Task No. 49 at this time, as described in paragraph 10 above.

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