

Working Group on the Review of Model International Form No. 1 of the Singapore Treaty on the Law of Trademarks

**First Session
Geneva, January 31, 2012**

Report

prepared by the Secretariat

INTRODUCTION

1. The Working Group on the Review of Model International Form No. 1 of the Singapore Treaty on the Law of Trademarks (hereinafter referred to as "the Working Group") met in Geneva, on January 31, 2012.
2. The following Contracting Parties of the Singapore Treaty Assembly were represented at the session: Australia, Denmark, France, Mongolia, Poland, Romania, Russian Federation, Singapore, Spain, Sweden, Switzerland, United States of America and Ukraine (13).
3. The following States were represented as observers: China, Czech Republic, Dominican Republic, Germany, Haiti, Hungary, Ireland, Japan, Lithuania, Mexico, Myanmar, United Kingdom, Rwanda and Turkey (14).
4. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: American Intellectual Property Law Association (AIPLA), European Communities Trade Mark Association (ECTA), International Association for the Protection of Intellectual Property (AIPPI) and International Trademark Association (INTA) (4).

5. The list of participants is contained in Annex II of this document.
6. The Secretariat noted the interventions made and recorded them. This report summarizes the discussions on the basis of all observations made.

AGENDA ITEM 1: OPENING OF THE SESSION

7. Mr. Francis Gurry, Director General, opened the first session of the Working Group on the Review of Model International Form No. 1 of the Singapore Treaty on the Law of Trademarks and welcomed the participants.
8. Mr. Marcus Höpferger (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 2: ELECTION OF A CHAIR AND A VICE-CHAIR

9. Mr. Mikael Francke Ravn (Denmark) was elected Chair of the first session of the Working Group and Ms. Mei Lin Tan (Singapore) was elected Vice-Chair of the first session of the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

10. The Working Group adopted the Draft Agenda (document STLT/WG/MIF1/1/1 Prov.) without modifications.

AGENDA ITEM 4: REVIEW OF MODEL INTERNATIONAL FORM No. 1 OF THE SINGAPORE TREATY ON THE LAW OF TRADEMARKS

11. Discussion was based on document STLT/WG/MIF1/1/2.
12. The Delegation of the Russian Federation considered that document STLT/WG/MIF1/1/2 constituted a good basis for the Working Group discussions. The Delegation suggested that the indication "8 cm x 8 cm" corresponding to the size of the reproduction of the mark be kept in the form to serve as a reference for the expression "larger" contained in footnote 10 of the form.
13. The Chair proposed retaining the indication of the size of the representation and moving the reference to footnote 10 after that indication.
14. The Delegation of Germany pointed to old item 8.1.1 "Reproduction of the mark", which appeared as deleted in the revised form and wondered whether this indication could be retained as it would help the applicant to know what he is expected to do when filling out the form.
15. The Delegation of China asked whether the square for the reproduction of the mark under item 8 and the indication "8 cm x 8 cm" would be kept in the form and in such a case whether the different views of a three-dimensional mark should be included in that square. It seemed that under section 9 "Type of mark", item 9.1.1 included the possibility of attaching different views of the mark and footnote 13 explained that the option under that item should be ticked when the different views were not included under item 8.
16. The Chair clarified that footnote 13 applied when additional views showing the three-dimensional character of the mark were attached to the form.

17. The Delegation of the Russian Federation, referring to item 9.1.3 on motion marks, noted that only one possible option for representing this type of mark was included via footnote number 13. The Delegation considered it would be appropriate to include the remaining options provided for in Rule 3 and in particular, a description of the movement. Concerning item 9.1.4 on color marks, the Delegation suggested including a footnote similar to that inserted under item 8.2.1 to specify that the indication of color may consist of the name of the color or the color code.
18. The Delegation of Germany noted that the word “indication” used in the two sub items under item 9.1.4 did not correspond to the terms “designation” and “description” used in the text of Rule 3. The Delegation held the view that it would be best to keep the same wording in the form. Moreover, the Delegation considered that providing for these two sub items could lead applicants to believe that they had a choice between one and the other indication, when according to Rule 3, the choice was up to offices.
19. Regarding the suggestions made by the Delegation of the Russian Federation, the Chair proposed including two sub items under item 9.1.3, namely one allowing the applicant to supply a description explaining the movement and a second item indicating that additional views depicting the movement were attached. Regarding the suggestion made by the Delegation of Germany, the Chair proposed changing the wording of both sub items under item 9.1.4 in accordance with the text of Rule 3 and including a reference to footnote number 12 next to the first sub item.
20. The Delegation of the Russian Federation pointed out that Rule 3(7) provided the possibility for offices to require a color code using the system accepted by the Office. The addition of a reference to footnote 12, made redundant the sub item concerning the indication of the color claimed.
21. The Chair explained that applicants should be allowed to indicate the colors claimed if offices so required and thus, the first sub item under item 9.1.4 should be kept. In addition, offices had to decide which requirements they wished to include in the forms, in accordance with their national legislation.
22. The Delegation of Switzerland supported the proposals made by the Chair and observed that the sub items represented different options that were open for offices when establishing their own forms.
23. The Representative of INTA said that the wording of footnote 12 was not entirely clear as it did not specify that the indication of the colors claimed was a requirement established by the Office.
24. The Chair suggested clarifying the text of footnote 12 as follows: “The indication of the color may, at the option of the Office, consist of the name and/or code of the colors claimed”.
25. The Delegation of China held the view that the second sub item under item 9.1.4 should be kept as it constituted important information for offices on how applicants used colors in relation to the goods or services.
26. The Delegation of Germany, supported by the Delegation of the Russian Federation suggested adapting the language used in item 9.1.5 to the text of Rule 3, in parallel to what was done with the previous item.
27. The Chair suggested that, in line with the Regulations, item 9.1.5 read: “description explaining the position of the mark in relation to the product”.

28. In reply to a suggestion made by the Delegation of the Russian Federation, the Chair proposed adding a sub item under item 9.1.5 allowing for an indication of “matter for which the protection is not claimed” when such an indication was required under national law.
29. The Delegation of Switzerland proposed adding, under item 9.1.6 a sub item containing the option for an applicant to supply musical notation on a staff or a footnote to that item with the following wording: “The representation of the mark shall, at the option of the Office, consist of a musical notation on a staff, a description of the sound constituting the mark or an analog or digital recording of that sound”.
30. The Chair wondered if it was more appropriate to include a footnote to reflect the possible requirements in relation to sound marks, since the musical notation on a staff could be included in item 8.
31. The Delegation of the Russian Federation considered that a similar approach should be used for indicating the different items of the form. All possible requirements should ideally be included as part of the form and not as footnotes.
32. The Representative of INTA stated that to the extent that there was a possibility to represent a sound mark or a non-visible sign, it was necessary not to confuse the reproduction and the description of the mark. It should be clear for applicants that a graphical representation could be included in the space provided under item 8 if such a type of representation was accepted by the office for sound marks.
33. The Chair explained that in Offices of Contracting Parties where there was a requirement under national law to provide musical notation on a staff, such element would most likely constitute the representation of the mark under item 8. Any additional information concerning the sound mark may constitute the description of the sound.
34. The Delegation of the Russian Federation expressed the view that the musical notation on a staff constituted a description rather than a representation of the mark and suggested restoring the item “reproduction of the mark” allowing applicants to provide either a description or a musical notation attached to the form. The Delegation opined that item 8 was intended to include reproductions of graphic marks and that it should not be used nor referred to non-visible marks. In such cases, applicants should make use of other possibilities like attaching a musical notation on paper.
35. The Chair proposed adding a sub item under item 9.1.6 which could read: “a musical notation on a staff is provided”, as well as a footnote with the following wording “the representation of the mark shall, at the option of the Office, consist of a musical notation on a staff, a description of the sound constituting the mark or an analog or digital recording of that sound or any combination thereof”.
36. The Working Group agreed on the text of a revised Model International Form No. 1, as reproduced in the Annex to the Summary by the Chair of the session. The Working Group further agreed to recommend to the Singapore Treaty Assembly the adoption of Model International Form No. 1, as reproduced in the Annex to that document.

AGENDA ITEM 5: ADOPTION OF THE SUMMARY BY THE CHAIR

37. The Working Group approved the Summary by the Chair as contained in Annex I to the present document.

AGENDA ITEM 6: CLOSING OF THE SESSION

38. The Chair closed the session on January 31, 2012.

[Annexes follow]



STLT/WG/MIF1/1/3
ORIGINAL: ENGLISH
DATE: JANUARY 31, 2012

Working Group on the Review of Model International Form No. 1 of the Singapore Treaty on the Law of Trademarks

First Session
Geneva, January 31, 2012

SUMMARY BY THE CHAIR

adopted by the Working Group

AGENDA ITEM 1: OPENING OF THE SESSION

1. Mr. Francis Gurry, Director General, opened the first session of the Working Group on the Review of Model International Form No. 1 of the Singapore Treaty on the Law of Trademarks and welcomed the participants.
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4. The Working Group adopted the Draft Agenda (document STLT/WG/MIF1/1/1 Prov.) without modifications.

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5. Discussion was based on document STLT/WG/MIF1/1/2. The Working Group agreed on the text of a revised Model International Form No. 1, as reproduced in the Annex to this document. The Working Group further agreed to recommend to the Singapore Treaty Assembly the adoption of Model International Form No. 1, as reproduced in the Annex to this document.

AGENDA ITEM 5: ADOPTION OF THE SUMMARY BY THE CHAIR

6. The Working Group approved the Summary by the Chair as contained in the present document.

AGENDA ITEM 6: CLOSING OF THE SESSION

7. The Chair closed the session on January 31, 2012.

MODEL INTERNATIONAL FORM No. 1

APPLICATION FOR THE REGISTRATION OF A MARK

submitted to the Office of

FOR OFFICE USE ONLY

Reference number of applicant¹:

Reference number of representative¹:

1. Request for Registration

Registration of the mark reproduced in the present application is hereby requested.

¹ The reference number allotted by the applicant and/or the reference number allotted by the representative to the present application may be indicated in this space.

2. Applicants(s)

2.1 If the applicant is a natural person, the person's

(a) family or principal name²:

(b) given or secondary name(s)²:

2.2 If the applicant is a legal entity, the entity's full official designation:

2.3 Address (including postal code and country):

Telephone number(s):
(with the area code)

Telefacsimile number(s):
(with the area code)

E-mail address:

2.4 State of nationality:

State of domicile:

State of establishment³:

2.5 Where the applicant is a legal entity, indicate

- the legal nature of the legal entity:
- the State, and, where applicable, the territorial unit within that State, under the law of which the legal entity is organized:

2.6 Check this box if there is more than one applicant; in that case, list them on an additional sheet and indicate, in respect of each of them, the data referred to in items 2.1 or 2.2, 2.3, 2.4 and 2.5⁴.

² The names to be indicated under (a) and (b) are either the full names of the applicant or the names customarily used by the applicant.

³ "Establishment" means a real and effective industrial or commercial establishment.

⁴ Where several applicants are listed on the additional sheet with different addresses and there is no representative, the address for correspondence must be underlined on the additional sheet.

3. Representative

3.1 The applicant is not represented.

3.2 The applicant is represented.

3.2.1 Identification of the representative

3.2.1.1 Name:

3.2.1.2 Address (including postal code and country):

Telephone number(s):
(with the area code)

Telefacsimile number(s):
(with the area code)

E-mail address:

3.2.2 The power of attorney is already in the possession of the Office.
Serial number⁵:

3.2.3 The power of attorney is attached.

3.2.4 The power of attorney will be furnished at a later date.

3.2.5 No power of attorney is needed.

4. Address for Service⁶

⁵ To be left blank if the power of attorney has not, or has not yet, been allotted a serial number or if the serial number is not yet known to the applicant or the representative.

⁶ An address for service must be indicated in the space available under the title of item 4 where the applicant does not have or, if there is more than one applicant, where none of the applicants has 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 application, except where a representative is indicated in item 3.

5. Claiming of Priority

The applicant hereby claims the following priority:

5.1 Country (Office) of first filing⁷:

5.2 Date of first filing:

5.3 Application number of first filing (if available):

5.4 The certified copy of the application the priority of which is claimed⁸

5.4.1 is attached.

5.4.2 will be furnished within three months from the filing date of the present application.

5.5 The translation of the certified copy

5.5.1 is attached.

5.5.2 will be furnished within three months from the filing date of the present application.

5.6 Check this box if there is more than one filing whose priority is claimed; in that case, list them in an additional sheet and indicate, in respect of each of them, the information referred to in items 5.1, 5.2, 5.3, 5.4 and 5.5 and the goods and/or services mentioned in each of them.

6. Registration(s) in the Country (Office) of Origin⁹

The certificate(s) of registration in the country (Office) of origin is (are) attached.

⁷ Where the application the priority of which is claimed was filed with an Office other than a national Office (e.g., OAPI, the Benelux Trademark Office and the Office for Harmonization in the Internal Market (trade marks and designs)), the name of that Office has to be indicated instead of the name of a country. Otherwise, not the name of the Office but the name of the country must be indicated.

⁸ "Certified copy" means a copy of the application the priority of which is claimed, certified as being in conformity with the original by the Office which received such application.

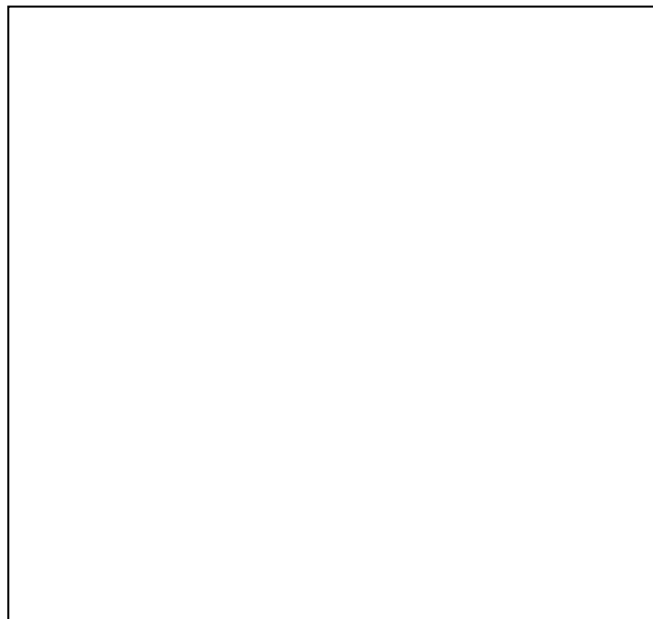
⁹ To be filled in where the applicant wishes to furnish evidence under Article 6*quinquies* A(1) of the Paris Convention when filing the application.

7. Protection Resulting From Display in an Exhibition

- Check this box if the applicant wishes to take advantage of any protection resulting from the display of goods and/or services in an exhibition. In that case, give the details on an additional sheet.
-

8. Representation of the Mark

(8 cm x 8 cm)¹⁰



- 8.1 The applicant wishes that the Office register and publish the mark in the standard characters used by it¹¹.

- 8.2 Color is claimed as a distinctive feature of the mark.

8.2.1 Indication of the color(s) claimed¹²:

8.2.2 Principal parts of the mark which are in that (those) color(s):

¹⁰ The dimension of the field for the representation of the mark is indicative. Offices may allow representations using larger formats.

¹¹ Such a wish cannot be expressed in respect of marks which contain or consist of figurative elements. If, in the opinion of the Office, they do contain such elements, the Office will ignore the wish of the applicant and will register and publish the mark as appearing in the square.

¹² The indication of the color may, at the option of the Office, consist of the name and/or code of the color(s) claimed.

9. Type of mark

9.1 The mark is a

9.1.1 three-dimensional mark.

.....¹³ different views of the mark are attached.

9.1.2 hologram mark.

.....¹³ different views of the mark are attached.

9.1.3 motion mark¹⁴.

description explaining the movement:

.....
.....

additional images depicting the movement are attached.

9.1.4 color mark.

designation of the color(s) claimed¹²:

.....
.....

description of how the color(s) are applied to the goods or used in relation to the services:

.....
.....

9.1.5 position mark.

description of the position of the mark in relation to the product:

.....
.....

¹³ If several different views of the mark are not included in the square provided in item 8 but are attached, check this box and indicate the number of those different views.

¹⁴ In respect of this type of mark, the Office of a Contracting Party has the option to require one image or a series of still or moving images depicting the movement.

indication of matter for which protection is not claimed:

.....
.....

9.1.6 sound mark¹⁵.

musical notation on a stave is provided.

description of the sound constituting the mark:

.....
.....

indication that a recording of the sound is attached.

9.1.7 non-visible sign other than a sound mark¹⁶.

9.2¹⁷ reproduction(s) of the mark in black and white is (are) attached.

9.3¹⁷ reproduction(s) of the mark in color is (are) attached.

10. Transliteration of the Mark

This mark or part of the mark is transliterated as follows:

11. Translation of the Mark

The mark or part of the mark is translated as follows:

¹⁵ Representation of the mark shall, at the option of the Office, consist of a musical notation on a stave, or a description of the sound constituting the mark or an analog or digital recording of that sound or any combination thereof.

¹⁶ If the mark consists of a non-visible sign other than a sound mark, the Office of a Contracting Party may require an indication of the type of mark, one or more representations of the mark and details concerning the mark, as prescribed by the law of that Contracting Party.

¹⁷ Indicate the number of reproductions in black and white and/or color.

12. Goods and/or Services

Names of the goods and/or services¹⁸:

- Check this box if the space above is not sufficient; in that case, give the names of the goods and/or services on an additional sheet.
-

13. Declaration Concerning Intention to Use or Actual Use; Evidence of Actual Use

13.1 Check this box if a declaration is attached.

13.2 Check this box if evidence of actual use is attached.

14. Requirements Relating to Languages

- Check this box if an attachment is enclosed in order to comply with any language requirement applicable with respect to the Office¹⁹.
-

15. Signature or Seal

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

15.2 Check the appropriate box according to whether the signature is given, or the seal is used, by or on behalf of the:

15.2.1 applicant.

15.2.2 representative.

15.3 Date of signature or of sealing:

15.4 Signature or seal:

¹⁸ Where the goods and/or services belong to more than one class of the Nice Classification, they must be grouped according to the classes of that Classification. The number of each class must be indicated and the goods and/or services belonging to the same class must be grouped following the indication of the number of that class. Each group of goods or services must be presented in the order of the classes of the Nice Classification. Where all the goods or services belong to one class of the Nice Classification, the number of that class must be indicated.

¹⁹ This box is not to be used if the Office does not admit more than one language.

16. Fee(s)

16.1 Currency and amount(s) of the fee(s) paid in connection with the present application:

16.2 Method of payment:

17. Additional Sheets and Attachments

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

[Annex II follows]

LISTE DES PARTICIPANTS
LIST OF PARTICIPANTS

établie par le Secrétariat
prepared by the Secretariat

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États/in the alphabetical order of the names in French of the states)

AUSTRALIE/AUSTRALIA

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Alexandra GRAZIOLI (Mme), conseillère juridique principale à la Division du droit et affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne
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Nataliia KOZELETSKA (Ms.), Chief Expert, Industrial Property Division, State Intellectual Property Service of Ukraine (SIPS), Kyiv

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LITUANIE/LITHUANIA

Digna ZINKEVIČIENE (Ms.), Head, Trademarks and Designs Division, State Patent Bureau of the Republic of Lithuania, Vilnius

MEXIQUE/MEXICO

Nelia AMERO TELLO (Sra.), Subdirectora de Examen de Signos Distintivos, Dirección de Marcas, Instituto Mexicano de la Propiedad Industrial (IMPI), Ciudad de México
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Mya SANDAR (Ms.), Attaché, Permanent Mission, Geneva
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RÉPUBLIQUE DOMINICAINE/DOMINICAN REPUBLIC

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RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

Olga ŠVÉDOVÁ (Ms.), Law Department, Industrial Property Office, Prague

ROYAUME-UNI/UNITED KINGDOM

Mike FOLEY, Head, Technical Policy, Trade Marks and Designs Directorate, Intellectual Property Office, Newport
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RWANDA

Alphonse KAYITAYIRE, First Counsellor, Permanent Mission, Geneva
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TURQUIE/TURKEY

Mustafa Kubilay GÜZEL, Trademark Expert, Trademark Department, Turkish Patent Institute (TPI), Ankara
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Bekir GÜYEN, Trademark Examiner, Trademark Department, Turkish Patent Institute (TPI), Ankara
<bekir.guyen@tpe.gov.tr>

III. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association américaine du droit de la propriété intellectuelle (AIPLA)/American Intellectual Property Law Association (AIPLA)

Jonathan MADSEN, Representative, New York
<jmadsen@iplawusa.com>

Association communautaire du droit des marques (ECTA)/European Communities Trade Mark Association (ECTA)

Donald SCHNYDER, Member, Law Committee, Geneva
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Association internationale pour la protection de la propriété industrielle (AIPPI)/International Association for the Protection of Industrial Property (AIPPI)

Peter WIDMER, Chair, Zurich
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Association internationale pour les marques (INTA)/International Trademark Association (INTA)

Bruno MACHADO, Geneva Representative, Rolle
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IV. BUREAU/OFFICERS

Président/Chair: Mikael FRANCKE RAVN (Danemark/Denmark)
Vice-présidente/Vice-chair: Mei Lin TAN (Ms.) (Singapour/Singapore)
Secrétaire/Secretary: Marcus HÖPPERGER (OMPI/WIPO)

V. SECRÉTARIAT DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ
INTELLECTUELLE (OMPI)/SECRETARIAT OF THE WORLD INTELLECTUAL
PROPERTY ORGANIZATION (WIPO)

Francis GURRY, directeur général/Director General

WANG Binying (Mme/Mrs.), vice-directrice générale/Deputy Director General

Marcus HÖPPERGER, directeur de la Division du droit des marques et des dessins et
modèles/Director, Trademark and Design Law Division

Martha PARRA FRIEDLI (Mme/Mrs.), chef de la Section du droit des marques, Division du droit
des marques et des dessins et modèles /Head, Trademark Law Section, Trademark and Design
Law Division

Tobias BEDNARZ, administrateur adjoint à la Division du droit des marques et des dessins et
modèles/Associate Officer, Trademark and Design Law Division

Noëlle MOUTOUT (Mlle/Ms.), juriste adjointe à la Section du droit des marques, Division du
droit des marques et des dessins et modèles/Assistant Legal Officer, Trademark Law Section,
Trademark and Design Law Division

[End of Annex II and of document]