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

Seventeenth Session
Geneva, May 7 to 11, 2007

DRAFT REPORT

prepared by the Secretariat

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INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”) held its seventeenth session, in Geneva, from May 7 to 11, 2007.

2. The following Member States of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Algeria, Argentina, Australia, Austria, Bahrain, Barbados, Belgium, Botswana, Brazil, Canada, Chile, China, Colombia, Côte d’Ivoire, Croatia, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, Finland, France, Gabon, Georgia, Germany, Hungary, Indonesia, Iran (Islamic Republic of), Ireland, Israel, Italy, Japan, Jordan, Kenya, Kuwait, Latvia, Lesotho, Lithuania, Mexico, Morocco, Moldova, Mozambique, Niger, Nigeria, Netherlands, Norway, Pakistan, Paraguay, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, Rwanda, Serbia, Singapore, Slovenia, South Africa, Spain, Sweden, Switzerland, Thailand, The former Yugoslav Republic of Macedonia, Trinidad and Tobago, Turkmenistan, Turkey, Uganda, Ukraine, United Kingdom, United States of America, Uruguay, Uzbekistan, Viet Nam and Zambia (77). The European Community was also represented in its capacity as member of the SCT.

3. The following intergovernmental organizations took part in the meeting in an observer capacity: African Intellectual Property Organization (OAPI), Benelux Organization for Intellectual Property (BOIP) and the World Trade Organization (WTO) (3).

4. Representatives of the following international non-governmental organizations took part in the meeting in an observer capacity: Asian Patent Attorneys Association (APAA), Center for International Industrial Property Studies (CEIPI), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), European Law Students’ Association (ELSA International), Exchange and Cooperation Centre for Latin America (ECCLA), German Association for Industrial Property and Copyright (GRUR), Institute of International Trade Law and Development (IDCID), Inter-American Association of Industrial Property (ASIPI), International Association for the Advancement of Teaching and Research in Intellectual Property (ATRIP), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), International Wine Law Association (AIDV), Japan Patent Attorneys Association (JPAA) and Japan Trademark Association (JTA) (16).

5. The list of participants is contained in Annex II of this Report.

6. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions on the basis of all observations made.

Agenda Item 1: Opening of the Session

7. Mr. Ernesto Rubio, Assistant Director General, opened the session and welcomed the participants on behalf of the Director General of WIPO.
8. Mr. Marcus Höpperger (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 2: Election of a Chair and two Vice-Chairs

9. The Delegation of the Russian Federation, on behalf of the Group of Certain Countries of Eastern Europe and Central Asia proposed as Chair of the SCT, Mr. Michael Arblaster (Deputy Registrar, Trade Marks and Designs, Hearings and Legislation, IP Australia, Woden ACT, Australia) and as Vice-Chairs Mr. Maximiliano Santa Cruz (Counsellor, Permanent Mission of Chile to the WTO, Geneva) and Mr. Louis Chan (Director, Legal Counsel, Intellectual Property Office of Singapore (IPOS) for the year 2007.
10. The Delegations of Ecuador and Germany supported the proposal made by the Delegation of the Russian Federation.
11. Mr. Michael Arblaster (Australia) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) for the year 2007. Mr. Maximiliano Santa Cruz (Chile) and Mr. Louis Chan (Singapore) were elected as Vice-Chairs for the same period.

Agenda Item 3: Adoption of the Agenda

12. The SCT adopted the Draft Agenda (document SCT/17/1 Prov.) without modifications.

Agenda Item 4: Adoption of the Draft Report of the Sixteenth Session

13. The SCT adopted the Draft Report of the Sixteenth Session (document SCT/16/9 Prov.2) with modifications as requested by the Delegations of Brazil, France, Italy, the Russian Federation, Sweden and the Representative of the African Intellectual Property Organization (OAPI).

Agenda Item 5: Trademarks

Methods of Representation and Description of New Types of Marks

14. Discussion was based on document SCT/17/2.
15. The Chair suggested using the terms “non-traditional marks” instead of “new types of marks”. He noted that many of these signs were already known and used in several jurisdictions. Thus it would not be appropriate to refer to them as “new”.

16. The Secretariat said that document SCT/17/2 was prepared following a request from the SCT at its last session. The paper sought to identify areas of convergence among SCT members and any other issues such as the possibility of additional costs, particularly in developing countries. Document SCT/17/2 was based on information drawn from the Questionnaire on Trademark Law and Practice (document WIPO/STRAD/Inf.1) and on a number of additional specific submissions that the Secretariat had received. The Secretariat noted that all the contributions received were published on the SCT Electronic Forum. The Secretariat clarified that the document made a broad reference to the Member State submissions and did not indicate a specific or particular point of law which should be attributed to a specific country. The Secretariat also noted that the structure of this document was similar to that of document SCT/16/2 (New Types of Marks) of the previous session, which described in a more general way new or non-traditional marks. Document SCT/17/2 went a step forward in trying to identify existing methods of representation and description of those marks. The Secretariat mentioned that, as background to this discussion, the Singapore Treaty on the Law of Trademarks identified a certain number of new types of signs that can be registered in some of the Member States of WIPO, without creating for those States an obligation to accept such signs. The Regulations to the Singapore Treaty made provision for certain methods of representation and description of those signs. Thus, it was felt appropriate and timely to inquire amongst the membership of WIPO to identify what were the existing methods of representation and description of non-traditional marks and see whether there could be areas of convergence or particular issues that could be dealt with at the SCT.

17. The Chair asked Delegations to provide comments of a general nature, before discussing the document in detail.

18. The Delegation of Denmark declared that it had prepared a substantive contribution on new types of marks, which was sent to the Secretariat by electronic means. The Delegation regretted that its submission could not be reflected in document SCT/17/2. The Delegation noted that both its contribution and those of other members of the SCT contained a number of images, which could be included as an Annex in an updated version of the document, reflecting all contributions received and probably new contributions to come.

19. The Chair noted that there were no other comments of a general nature. He suggested to reserve the suggestion of the Delegation of Denmark against the background of the discussion on document SCT/17/2. The Chair recalled that a possible direction in which this discussion could go was mentioned in paragraphs 77 and 78 of the document. In other words, that SCT members identify what could be sensible arrangements for the representation and description of non-traditional marks. The Chair called for comments on methods of representation and description of specific types of marks.

Three-Dimensional Marks

20. The Chair noted that one of the issues concerning the representation of three-dimensional marks was the number of representations to be submitted, sometimes from different perspectives. He encouraged delegations to share their experience as to whether they required a number of views or whether their Office or their Courts had found that one view was sufficient.

21. The Delegation of Mexico declared that applications concerning three-dimensional marks had increased over the years. In Mexico, the application had to be accompanied by a reproduction, a drawing or a photograph of the three-dimensional object for which registration was sought. The representation should clearly depict the three-dimensional character of the object (its length, breadth and height), as well as the base of the object, so that the examiner might clearly perceive the three dimensions. If a simple drawing was submitted, which did not clearly represent the three-dimensional object, photographs were required. Once registered, the reproduction of the mark was published, so that the user and the public may clearly understand the three-dimensional character of the protected object.

22. The Chair noted that perhaps the first principle was that the representation had to make it clear to both the examiner and the consuming public what was being claimed.

23. The Delegation of Chile said that it understood from the document that the representation had to be sensible. In that context, the Delegation considered that it was important to identify who should be satisfied with that representation, namely, the examiner, the register, the consumer, the user or the public in general. It was also important to bear in mind that under the legislation of some countries, certain non-traditional signs were not accepted for registration. Under national law in Chile, certain three-dimensional signs were not acceptable and there was a specific provision to that effect. While other non-traditional signs were provided for in national law, the Office considered them rather exceptional and the regulations did not specify exactly what type of representation was deemed acceptable. In the view of the Delegation, such representations could be sufficiently technical, as long as they were not subjective and could be combined with a representation that was indeed accessible to the public. As an example, the Delegation mentioned that in the case of a sound mark, many offices required a pentagram, however, not everyone was able to read a pentagram and such requirement could be combined with access to an MP3 file uploaded on the Office website, so that the representation is available to the public. The Delegation further noted that after a recent amendment of the trademark law, it was possible to register non-traditional marks in Chile. For this reason, the Office was interested in defining useful and sensible means of representation of those signs.

24. The Delegation of Brazil declared that under the law of Brazil, only visually perceivable signs were accepted for registration as trademarks. Many three-dimensional marks had already been granted and the procedure applied in Brazil was similar to that described by the Delegation of Mexico. The applicant was requested first to declare that he was applying for a three-dimensional mark by filling out the appropriate field in the trademark application. Secondly, the applicant had to attach a picture to the application depicting the three-dimensional character of the trademark. That same picture or drawing was published in the official Intellectual Property Gazette.

25. The Delegation of Paraguay explained that in Paraguay, the procedure to register three-dimensional marks was similar to that described by the Delegation of Mexico. National law in Paraguay also allowed the registration of sound and scent marks. As far as sound marks were concerned, the Office asked for the notes on a pentagram and a magnetic tape containing the recording. Musical experts might be called to assist the examiners in such cases. No scent mark had yet been filed and currently the Office had not devised any specific criteria to be able to issue the examination report.

26. The Delegation of Spain said that, in principle, the Spanish Patent and Trademark Office examined three-dimensional marks in a way similar to any other mark. However, some specific requirements were noted. The reproduction of the mark to be submitted with the application consisted of a graphic or photographic bidimensional representation that included up to six different views, which could be grouped in order to produce a single image (8 x 12 cm). If that representation is not considered sufficient, the applicant might be asked to provide six separate views together with a written description of the mark.

27. The Delegation of Mexico said that the reproduction of three-dimensional marks was particularly important for those applications claiming priority. In such cases, the reproduction in the country of origin and in the country of new application should coincide. Therefore, at least some basic elements of the reproduction should be common to all offices.

28. The Chair noted that this was a very important issue, not only in the framework of priority claims under the Paris Convention, but also in the context of the Madrid Agreement and Protocol. It was necessary to maintain the validity of the rights that were being claimed and ensure that offices were working towards that objective. The Chair further noted that holders had a reasonable expectation that the rights they obtained in one jurisdiction could also be obtained in other jurisdictions. Even though there were limitations to that principle, it seemed possible and desirable that the principle itself not be constrained by purely administrative requirements. It also seemed sensible to find ways of simplifying the registration process, as it seemed that in many jurisdictions the relative unfamiliarity with these signs meant that offices had introduced requirements that were more complex than they needed to be. The Chair considered that the end point of the discussion could be that the Standing Committee request the Secretariat to prepare a document setting out key learnings or areas of convergence, but only about those signs on which the exchange of experiences amongst SCT members would yield enough material.

29. The Delegation of the United States of America said that the most important principle in the United States of America regarding drawing requirements was notice to the public as to what was being claimed in the mark. For a three-dimensional mark, the United States Patent and Trademark Office (USPTO) required a two-dimensional drawing and allowed for dotted lines to be used in a drawing to identify areas that were not being claimed. When the examiner or the public would not be able to ascertain what the actual nature of the mark was, the examiner might ask for a written description of the mark and that appeared to be very helpful in identifying the particular features that were being claimed. The USPTO only allowed for one view of the mark to be submitted. An applicant would actually have to petition for more views to be submitted if the one view was not enough. The reason behind this was to ensure there was no confusion as to the nature of the mark or the number of marks. It was felt that overly technical drawings were not necessarily understandable to the public, so these were not required. Regarding the issue raised by the Delegation of Mexico concerning a priority claim under the Paris Convention, the Delegation noted that such issue might arise, for example, if the USPTO required one view and other countries would ask for more than one view. Thus, when an applicant from the United States of America was requesting priority in another country, and was asked to submit three views of the mark previously registered at the USPTO, the question arose as to which one was the operative view. The Delegation noted that in such cases, a USPTO registrant might probably be submitting the one-view drawing that was in the USPTO registration along with various photographs that were submitted to the USPTO as specimens of use. The Delegation explained that the USPTO required specimens of use to identify how the mark was actually being used in commerce. However, such

specimens were not a drawing but only an indication of how the mark was being used, which was a different analysis. In conclusion, the Delegation said that the one view in the drawing of the USPTO registration would be the operative one for purposes of the Paris Convention priority.

30. The Representative of INTA considered that it would be most welcome if the discussion in the Standing Committee could lead to some form of agreement or standard on the kind of reproduction that was required: either a single perspective view or views from the top, the base and from each of the four sides, or any other requirement. Another point on which some form of standardization would be welcome was the size of reproductions.

31. The Chair asked Delegations if they could indicate firstly, whether a description of the mark could be acceptable instead of a representation, if the former was sufficiently clear, or whether a description was routinely required along with a reproduction of the mark.

32. The Delegation of Ecuador declared that under national law, the applicant was required to provide a graphic representation within a 6 x 6 inch frame, in addition to a written description.

33. The Chair asked Delegations whether their national offices considered that more than one view was essential to ensuring the clarity of the claim and thus they routinely required more than one representation. The Chair wondered if it would be possible to draw from the experience of several countries as to whether in most cases one representation would be enough and only in those cases where the representation was not clear the Office could have the opportunity to ask for additional representations.

34. The Delegation of Latvia said that the experience of the national Office in Latvia concerning the number of views necessary for the appropriate representation of a three-dimensional mark indicated that this question had to be decided on a case by case basis. For example, a single front view would not be sufficient to depict a round or elliptic object and the Office might require additional views. Otherwise, the one view should be good enough to display all the features of the mark.

35. The Delegation of Norway explained that regarding the number of reproductions, the Office in Norway left it up to the applicant to decide how many views he wished to submit. It seemed to be in the interest of the applicant to supply the number of reproductions necessary to show the full shape of the mark.

36. The Chair said that in relation to the issue raised by the Delegation of Latvia it would seem sensible to have a principle that where the Office considered that the reproduction provided by the applicant was not clear enough, it could require additional representations or other requirements to make sure that the scope of the right claimed was clear.

37. The Delegation of Uruguay said that a three-dimensional mark should be clearly represented and all the characteristics of the shape should be indicated through the different views.

38. The Chair asked delegations if they wished to make any specific comments, indicate their experiences or problems, or simply provide information regarding the size of representations for three-dimensional marks.

39. The Representative of INTA noted that one of the typical problems which arose in relation to the size of representations was where the country of origin in the framework of the Madrid System or the country of the first filing authorized a large format, for example an A4 sheet or the submission of several reproductions in free format. Then the applicant who submitted several reproductions in that format would be confronted with the difficulty of fitting those reproductions into the smaller format of the office of the second filing or the International Bureau format (8 x 8 cm) under the Madrid Agreement and Protocol. The Representative said that these size requirements did not in many cases allow fitting several reproductions in a sufficiently distinguishable and clear manner.

40. The Delegation of Germany explained that problems regarding the size of representations affected not only the users but also the offices, when they had to examine three-dimensional marks. If those pictures were small it was difficult to read any text included in the images. For the purposes of examination it did make a difference if something was written and, therefore, small formats were a problem for the national Office.

41. The Chair considered that in light of these comments, it might be worth considering whether at the next session of the SCT, the International Bureau could be invited to share its experiences with the Madrid System.

Color Marks

42. The Chair noted that document SCT/17/2 outlined specific issues in relation to color mark applications. The first one related to the requirement of supplying a sample of the color on paper or as applied. The second concerned color combinations, where a systematic arrangement of the colors in a predetermined form could be required. The Chair asked Delegations to share their experiences as to why those requirements were introduced and whether they were helpful.

43. The Delegation of Chile recalled that at the previous session of the Standing Committee, some delegations noted that they did not use the PANTONE® system because it was a proprietary system. The Delegation considered that there was a question concerning the copyright on the use of the colors in that system. The Delegation wondered if any office had encountered problems with the use of such proprietary systems.

44. The Delegation of the United States of America said that the USPTO would accept a drawing in black and white with a color claim, together with a description of the mark identifying the color and where it is applied to the mark. That office would also accept a color drawing and the indication of a PANTONE® code or any of those proprietary systems if the applicant wished to do so. However, the office would not require the use of any proprietary systems, because according to government contracting rules, the Office would have to call bidders and decide which one of them had the best contract, which seemed like a burdensome requirement in that particular instance.

45. The Chair asked the Delegation of the United States of America whether in the case where a proprietary system was used the national office was satisfied that it sufficiently distinguished the color or the range of colors being chosen. The Chair also wondered whether in such a case, the Office would allow several shades or a combination of shades. For example, if the mark consisted of a combination of three colors whether the Office would accept only three numbers or for each of those colors it would also accept a range.

46. The Delegation of the United States of America explained that in a color mark application, the applicant supplying a particular PANTONE® number, would also have to identify which color that number represented. The USPTO would in principle accept those indications, until the specimens of use were submitted, to show how the applicant was using the mark in commerce. If an applicant specified a range of PANTONE® numbers, they would have to identify by name to what color they corresponded. If the range was large, the examiner would have to check if the range of numbers was perceived by the consuming public as the color claimed. In the end, the colors identified in the application could be checked against the specimens of use and if the applicant were using colors different from those identified in the registration, the mark could be subject to cancellation.

47. The Delegation of Chile noted that in the definition of a color mark, perhaps a distinction was needed between marks that were colored in a much smaller area and marks which consisted of color *per se*. In the second case, a number of issues could be raised, for example, whether or not the color was functional and not distinctive of the product, etc. The Delegation believed that it was important to hear the experiences of those countries where color *per se* marks were indeed accepted for registration.

48. The Secretariat said that some of the issues raised by the Delegation of Chile were partially covered by document SCT/16/2, which was presented at the last session of the SCT, and document SCT/17/3, which was prepared for the current session. The issues contained in document SCT/17/2 under consideration seemed to be of a more administrative nature, namely if offices accepted color *per se* marks for registration how should that color be indicated. The Secretariat recalled that at the last session of the SCT, the Representative of the European Community had declared that following a decision from the European Court of Justice, the European Community Trademark Office recommended applicants to indicate the color by using a color code. Against that background, it seemed appropriate to hear the experiences of other delegations as to whether the use of color codes should be optional or mandatory.

49. The Delegation of Germany said that Germany was one of the jurisdictions where the use of color codes was recommended. The advantage of using such color codes was that behind the number there was always a specific recipe or mixture of chemical ingredients which resulted in the same color. It seemed, however, that at least in the RAL™ system the existing codes did not cover all the possible colors. Thus if the shade of color was not covered by the system, a method of description would be needed to identify it. Another problem stemmed from the use of communications by electronic means, whereby the fact of scanning color representations could alter the original colors used.

50. The Delegation of the Republic of Korea said that under the recently amended legislation in the Republic of Korea, hologram, motion and color marks would be accepted for registration. For all these marks, the applicant would have to submit a drawing or a picture showing the characteristics of those marks. The national Office did not require the indication of PANTONE® codes and wondered whether such indications would facilitate the procedure. In any event, if there was a problem with a particular application, the examiner was allowed to ask for additional documents or explanations. The Delegation considered that it was important to hear the experiences of other countries on this matter.

51. The Delegation of Latvia noted that a precise indication of the shade of the color was important in the case where the mark concerned a color *per se*, but not when the mark consisted of a label containing different colors or color shades. In such a case, it would not be practical to have a precise indication of the shade, because a later mark including similar shades could be considered confusingly similar, even if the colors differed in some details. For this reason, the Delegation believed that the use of color codes should be recommended only for trademarks which consist of color *per se*. The Delegation noted that the national Office seemed to have problems with the representation of two specific colors, namely silver and gold. It seemed difficult to have a sufficiently clear representation of such colors from the application filed in electronic form to the publication of such applications. The Delegation wondered whether other offices faced similar problems and what solutions they might have adopted to solve such problems.

52. The Delegation of Ecuador declared that Article 195 of the Intellectual Property Law of Ecuador expressly prohibited the registration of a color *per se* as a mark. Only color delimited by a specific shape could be registered and there was a limitation as to the chromatic possibilities to be used even in the case of color combinations. The Delegation noted that, for example, the total number of color shades in the PANTONE® system were not more than 200,000 and this limitation, even when considered in terms of color combinations would undoubtedly create conflict, since there could be a limited number of owners of color marks. The Delegation also noted that the exact reproduction of the color on all marked products would be extremely difficult to achieve. There was also a question as to the durability of the color, since colors could fade away over time and this could also affect the durability of a color *per se* mark.

53. The Chair noted that industry standards for color codes were likely to change over time and the evolution of such standards could be another issue.

54. The Delegation of Chile noted that under national legislation, signs which consisted of purely figurative or denominative elements could be registered as trademarks. Their representation could be either in black and white or in color and at least six representations were required. The applicant had the choice to describe the colors, either through a PANTONE® or similar system, or with a written description. The Office in Chile had also experienced problems with gold and silver colors, which were often used in wine labels. When these labels were uploaded electronically, the gold and silver tones became greenish and had little resemblance with the original colors of the label. The same problem occurred when the Office published the labels in the Gazette. In the view of the Delegation, the PANTONE® system could be used to describe more accurately color representations on paper. However, it was not helpful in the case of electronic reproductions.

55. The Delegation of The former Yugoslav Republic of Macedonia said that, according to the practice of the national industrial property office, the applicant was required to provide a sample of the color and designate that color by using its common name. The applicant was not required to refer to an international color code or define different parts of the mark that were in different colors. The Delegation noted that applicants were using international color codes only recently, therefore if the designation of the color was accompanied by the relevant internationally recognized color code, such an indication would be accepted and published,

but it would not be a requirement. The Delegation also noted that its Office had experienced similar problems as those described by the Delegation of Latvia with regard to scanned representations including silver and gold since the colors did not correspond to those on the representation as filed.

56. The Delegation of Denmark said that the national Office accepted color marks to be represented by a reproduction of the color itself and by stating an international color code, for example PANTONE®. If the application consisted of a color *per se*, this would be noted in the remarks.

57. The Chair asked delegations whether their national Offices accepted only one code or several codes that formed a range of color. The Chair explained that, for example, the color purple could range from reddish purple to bluish purple and therefore included a number of color codes, which are all purple from the point of view of the viewer. It did not seem to be settled whether in such a case an Office should accept only the middle color code, several codes or the entire range. The question seemed relevant in terms of defining the scope of the rights and eventually determining cases of infringement. However, it was also interesting from the point of view of formalities whether Offices were allowed to accept a single color code or a range of codes.

58. The Delegation of Denmark noted that the national Office had limited experience in the use of international color codes but most likely it would accept only one code.

59. The Delegation of Singapore explained that in cases of a color *per se* mark, the national Office required the applicant to provide a description on how the color was applied to the goods or used in relation to the services for clarity. The Delegation provided two examples of color *per se* applications that had been accepted by the national Office, one had a color sample in a square box and a description that the color was applied on the goods and used in the course of trade. The other had a black and white drawing of a service station with a color indicated in the drawing, accompanied by a description that the mark consisted of the color “green neon street light” applied to the canopy of a service station and used in the course of trade for the provision of the services. The Delegation noted that the national Office had also experienced the problem described by the Delegation of Latvia regarding the gold color, especially in Madrid notifications from the International Bureau of WIPO. The color gold usually appeared as either dark yellow or mustard and the Office had to rely on the description provided by the applicant to ascertain the actual color applied for.

60. The Delegation of the Russian Federation said that its national Office did not have stringent requirements concerning the representation and registration of marks containing color. A simple representation of the mark was required together with a list of the colors used. The colors were indicated with their common names and no international color codes were required. The Delegation noted that the national Office had also experienced problems with the scanning of reproductions, since the colors got distorted. The Delegation considered that this could be a relevant issue for publication but it was not so important for examination and registration purposes. When examining combinations of color, experts relied on an electronic database for checking similarities with previously registered signs. Where the combinations differed only by the shades of color, the signs were not suitable for protection. The Delegation further noted that signs were to be used in advertising and different printed publications reproduced colors in a different way, which could result in the consumer not having an accurate perception of the color in a given mark. The national Office had not

accepted for registration trademarks consisting of a color *per se*. The Delegation believed that a single color could not be registered as a mark because it lacked distinctive character, except for the case of acquired distinctiveness over a long period of time.

61. The Chair asked whether the national Office of the Russian Federation required the applicant to provide a sample of the color as used.

62. The Delegation of the Russian Federation confirmed that the national Office required a sample of the trademark. This sample could consist of an image of the mark on paper.

63. The Chair noted that the point made by the Delegation of the Russian Federation about consumer perception was a critical one since different people could perceive colors differently, depending on a number of factors, such as the amount and the quality of light.

64. The Delegation of Portugal said that according to national legislation, it was possible to present an application either for a single color or for a combination of colors. However in the case of a single color, it was necessary to associate that color with a shape or figure. The Office considered it important to avoid the risk of confusion with any other sign already filed or registered with the Office. The indication of a PANTONE® code was not mandatory. As to the administrative procedure, the applicant was required to fill out a special form available on the Office website. The form provided for a reproduction of the sign for publication on the Office Gazette, which was posted on the Office website every week.

65. The Delegation of Chile considered that the identification and appreciation of color was a very subjective matter. Not everyone saw the same amount of color shades. For this reason, national law in Chile provided that the different color ranges in trademarks would not be essential when applying for renewal.

66. The Delegation of Mexico noted that the perception of color could be subjective and, therefore, the Office in Mexico required a reproduction of the color exactly as it was to be used in trade, in order to avoid confusingly similar trademarks. The Delegation further noted that the reproduction of gold and silver colors could not be achieved by using the normal mixture of basic colors. In order to print such colors, the actual silver or gold mixtures needed to be provided.

67. The Delegation of France informed the Standing Committee that national authorities in France had acquired considerable experience in the registration of color marks. In a 1944 decision, the Paris Court of Appeals had recognized the validity of a mark which consisted of a simple pink wrapping with a blue stripe and darker blue printing. In 1974, another judicial decision considered that trademark protection could be granted to a shade of color “Congo red” to the Exxon corporation, and in 1977 a shade of yellow was granted protection as a trademark for the Kodak company, in relation to photographic materials. The Intellectual Property Code of France identified three types of color marks: color arrangements, color combinations and shades of color. Color arrangements consisted of a particular presentation of several colors or a single color within a shape or drawing. Combinations of color, which were defined as the gathering of several colors in a specific order, according to a certain composition (bands, checkerboards, etc.) and shades of color, which concerned one specific color. With regard to formalities, the applicant needed to furnish a color reproduction of the mark. The national Office did not accept black and white reproductions. In addition, following a 2003 decision of the European Court of Justice, the simple reproduction of the

color on paper was considered insufficient and had to be supplemented by the designation of this color through a description and eventually, the Office would recommend the indication of an internationally recognized color code, such as PANTONE®.

68. The Delegation of The former Yugoslav Republic of Macedonia requested clarification from the Delegation of France as to whether the indication of a color code, such as PANTONE®, was only required in the case of color *per se* trademark applications.

69. The Delegation of France confirmed that the requirement applied only in the case of single colors and not in the other cases described in its intervention.

70. The Delegation of Ukraine declared that national legislation allowed applications for both single color and combinations of color. In practice, most of the applications received by the Office concerned color combinations and color *per se* applications only in cases where the applicant could produce convincing information that the mark had acquired distinctive character as a result of consumer recognition. The national Office did not require the indication of a color code but accepted it when provided. Such indications were welcome especially in the case of shades of complex colors. The Delegation believed, however, that in many countries a single color was seldom mentioned as a sign.

Sound Marks

71. The Delegation of Slovenia informed the Standing Committee that the national Office had recently published two applications for sound marks. The applicant was required to provide musical notation and an indication of the type of mark. The Delegation noted that the publication of these marks had led to some discussion as to whether it was necessary to indicate the number of the Vienna Classification corresponding to musical notes. Opinions were divided on the issue of whether such indication might lead to the conclusion that these were figurative instead of sound marks. However, the national Office also looked at the practice of other offices and observed that some of them used the Vienna Classification for sound marks, thus the Delegation believed that an exchange of ideas on this question would be helpful.

72. The Delegation of the Russian Federation noted that under national legislation film titles, book titles and sounds were accepted for registration as marks. The national Office had registered 26 sound marks and these were generally musical sounds. There had been no applications for the other non-traditional marks such as taste and movement. These marks could be found in the database published on the Rospatent Website and they appeared as they were applied for on paper. It was foreseen to establish an electronic register but currently the Office faced problems with the notification and publication of non-traditional marks. The Delegation believed that it was difficult to foresee all legal consequences which might derive from the registration of these marks and the Standing Committee should go into greater depth on this issue. The question of non-visible signs which could not be represented graphically on paper but could only be described was a critical one. The Delegation said that musical notation of a sound mark was not the mark itself, because musical notes could be interpreted differently depending on the performer. At present, description was the only way of providing information to third parties and there were no clear guidelines on how to achieve such descriptions. The Delegation believed that the Standing Committee could work towards the elaboration of guidelines or recommendations to be later included in the Singapore Treaty.

73. The Delegation of Chile said that the recently amended national legislation (2005) no longer required that marks consist of visible signs. Following that amendment, seven applications for sound marks had been received by the Office and they were all musical sounds with an average duration of about 30 seconds. The Office had not received any applications for sound marks which did not consist of melodies. It seemed that the application for such sounds as trademarks was not prohibited under the law. The representation of sound marks consisted of a pentagram together with a magnetic support in MP3. Both the pentagram and the sound were uploaded on the Office website and the pentagram was published in the Gazette. The delegation sought information regarding the representation of non-melodic sounds, for example animal sounds, and wondered if indeed these needed to be represented graphically because an office could simply require the magnetic support.

74. The Chair noted that, following the interventions made by previous speakers, two issues seemed to require additional comments. Firstly, the representation of non-melodic sounds, for which the question had been raised as to whether it was sufficient to provide either a sample in digital or magnetic media or a simple description of the sound. Secondly, the issue had been raised of whether for musical sounds there was a limitation as to the length of the sound. The Chair recalled that according to the Delegation of Chile, the average duration in that jurisdiction was 30 seconds and the question could be raised as to whether offices in different jurisdictions could accept musical sounds which were significantly longer.

75. The Delegation of Chile explained that in fact the longest melodic sound mark was 30 seconds and others were 15 or 20 seconds. The Delegation wondered whether the national Office in Chile could register a three-minute long song as a sound mark. There was no specific guideline under national law, but it seemed that such a registration might encroach into the field of copyright, as had been mentioned by the Delegation of Chile at the previous session of the SCT.

76. The Delegation of Uruguay said that under the legislation currently in force in Uruguay, non-visible signs were accepted for registration. With regard to sound marks, the national Office had received several applications but none of them was yet registered as a mark. As to formal requirements, the applicant had to provide a graphic representation of the sound by using the corresponding sound code and where possible a brief description of the sound. In addition, the applicant must also provide a magnetic support (CD) which would allow the reproduction of the sound. In case of discrepancy between the representation and the actual sound, the Office could ask for expert advice.

77. The Delegation of Chile said that perhaps an additional issue to be resolved was the case where a sound was accompanied by words. Thus far, the national Office in Chile had refused such applications, but the Delegation wondered how other offices would treat those applications.

78. The Delegation of Serbia noted that regarding the duration of a musical mark, it would be much clearer to adopt the terminology used in music. The national Office in Serbia used the notion of “musical phrase”, which was a phrase from the musical dictionary and it meant a piece of about 5 to 10 measures in length, which was the usual duration of a musical mark.

79. The Chair asked delegations whether they had experience with applications for sound marks having a length greater than those noted by the Delegations of Chile and Serbia.

80. The Delegation of The former Yugoslav Republic of Macedonia said that according to national law, a mark was registrable only if it could be graphically represented. This also applied to sound marks. Musical notation was considered as appropriate graphical representation only if it included a separate musical stave, treble, clefs, musical tones showing the relative duration, the increase and decrease in the tones. In addition, the duration and the pitch of the tones had to be expressed in a clear manner. A sound would not be eligible for registration as a mark if it was only described in written form. For example, a claim that the sign comprised a separate musical piece or a list of tones, or a claim that the sign consisted of the sound made by an animal would not be acceptable. Nevertheless, the Delegation declared that the national Office had not yet received any sound mark applications and could benefit from the experience of other offices that had already handled such cases.

81. The Chair asked delegations whether they could provide examples of applications for sound marks consisting of animal tones.

82. The Representative of INTA recalled that a sound mark application concerning the roar of a lion for the Metro Goldwyn Meyer (MGM) Corporation had been accepted in several countries. The Representative considered that the requirement of a maximum length for sound marks which consisted of a melody was perhaps not necessary as long as the criteria for distinctiveness determined that the consuming public perceived a sound mark and not a song and understood the sign as indicating the origin of the goods and services. The Representative added that the representation of sound marks was perhaps one of the areas where the users of the system hoped to see national legislation adjusting to the speed of technological progress. The Representative held the view that the best way of reproducing a sound was to tape or record it, especially since industrial property offices were well equipped to record not only characters but also sounds and even make them available over the Internet. The Representative further noted that one could wonder whether a sonogram could be considered the graphic representation of sound, but accepting this type of means would facilitate matters for offices, for applicants and for third parties.

83. The Chair said that the issue around the length of the sound seemed relevant in relation to the form of graphic representation required by the Office, for example if the Office required musical notation, but if the Office accepted digital or other forms of recording, the issue of length seemed far less important. However, an Office could determine that at a certain length the sound would not be perceived as serving to identify the origin of goods or services.

84. The Delegation of France said that as it had been mentioned by a previous speaker, the National Institute of Industrial Property (INPI) of France had already accepted sounds for registration as trademarks and one of the most famous was precisely the roar of a lion of the MGM Corporation, which was used for different goods and services. The Delegation noted that at the time, INPI accepted a sonogram as graphic representation of the animal sound. However, after a European Court of Justice decision dated November 27, 2003, it was considered that only a transcription of the sound consisting of a musical stave fulfilled the requirement that graphic representation should be clear, precise, self-contained, easily accessible, intelligible, durable and objective. At present, INPI faced a situation where sounds were accepted for registration as marks and not only musical phrases, but there were no accessible and intelligible methods to graphically represent such sounds.

85. The Delegation of Brazil said that the national Office in Brazil did not have any experience with the registration of non-visible signs, since national law only allowed for the registration of visually perceivable signs. The Delegation wished to take the opportunity to ask other Delegations what was the method used for publishing sound marks. The Delegation explained that the Office in Brazil published first the application and then the registration with the registration number. The Delegation inquired what were the methods used firstly to represent a trademark on paper and secondly how offices resolved the issue of publication.

86. The Delegation of Serbia noted that one additional problem which might arise in respect of the so called “graphic representation” of the musical mark was that in fact musical notation was not graphic but symbolic and not only the duration of the musical mark was relevant but also how many instruments play the musical score. For example, just a few measures of the Beethoven “Ninth Symphony” would take several pages of the musical score. The Delegation believed that it was important to highlight this question which had not been covered by the document prepared by the Secretariat.

87. The Chair said that there was clearly a difference where the sound was produced by one instrument, an ensemble of the same instrument or an orchestra. However, the issue went back to how the sign that was meant to be a mark would be perceived in the marketplace.

88. The Delegation of Chile said that the national Office in Chile considered that the graphic representation of a sound mark was the pentagram together with a magnetic audio support, which was normally an MP3 file. For the purposes of publication and making the mark available to the consuming public, the national Office considered publishing the pentagram in the Gazette. However, it seemed that the public preferred to have access to the Internet website of the Office, where a support MP3 was available and allowed the public to hear the melody. The Delegation asked whether other Delegations had experience with sound mark applications which consisted of a melody with words. In particular, whether there was a specific protection for the words alone or for a melody with words as different from a mark consisting of a melody only.

89. The Delegation of France said that given the fact that the national Office had a requirement for the graphic representation of the mark, it seemed that there could be two possibilities in this regard. First, to protect the tune with a graphic representation consisting of the musical notation, and maybe the words could be included in another application and second, to include the words in the musical score. However, there was no established practice on this and the Office was not allowed to accept sonograms or MP3 files due to the requirement of graphic representation.

90. The Delegation of Norway said that the national Office had only received applications for musical marks and all the applicants had provided notes for publication. Under the legislation of Norway, the applicant was required to provide a written description of the mark and a sample of the sound in an MP3 file. The written description would indicate the instruments used, the notes that were played, the tempo, the beat and the length of the sound. If the mark was registered, the Office would publish it electronically, together with the notes, the description and a sound icon on the webpage for the public to hear the sound. The Delegation had a query concerning the scope of protection of sound marks. The national Office held the view that when the written description limited the sound to be played by a

specific instrument (e.g. piano or flute) this also limited the scope of protection of the sound. The Delegation wondered whether in cases where there were no such requirements or even a description, the holder received an exclusive right over the notes, which could be played with any instrument.

91. The Delegation of The former Yugoslav Republic of Macedonia held the view that even though a sound played with different instruments might sound differently, the melody would be the same. Thus to limit the scope of protection to one instrument might not seem like an appropriate limitation, as long as the public could recognize the melody.

92. The Delegation of Serbia said that it was important to determine the object of protection in the case of a sound or musical mark. Music itself was just one particular kind of sound that had some specific features, namely the “color” or characteristic of the sound. This was related to the type of instrument with which it was played and became a distinctive part of the melody. However, for the purposes of trademark registration, it seemed that the melody itself was protected and that other characteristic of the sound was of secondary importance.

93. The Delegation of Australia said that under national law, it would be possible to have both the musical score and the words. The national Office also accepted a combination of a verbal description and a digital copy of what was being claimed. The digital copy could contain, for example, the sound of somebody singing and the description would normally state the nature of the sound, in accordance with the attached score and using the following words. The Delegation noted that the issue raised by the Delegation of Norway as to whether the sound would be perceived differently if played with different instruments was still untested in Australia, but perhaps the question would be solved by whether the consuming public would be likely to be confused that there was a connection between the two owners. The Delegation further noted that the national Office had a fairly broad understanding of the graphic representation of sound. This would normally include words, musical notation and digital supports would also be allowed. It seemed that publication of these elements was relatively easy. For an animal sound, such as the MGM roar of a lion, the Office had accepted a description. The Delegation believed that it would be more difficult to rely on a stored copy of the sound, as had been suggested by the Representative of INTA. With regard to publication generally, the national Office published the description of the sound and indicated that a copy of the actual sound could be found by going to one of the branches of the Trademark Office, which were located in each State capital. There was also a possibility of accessing the Office database on the Internet, where there was usually a link to the sound.

94. The Chair noted, in relation to comments made earlier by the Delegation of Brazil, that there were a number of issues raised and comments made about publication on page 13 of document SCT/17/2.

95. The Chair concluded that the SCT had considered certain portions of document SCT/17/2 namely those relating to three-dimensional marks, color marks, and sound marks. The SCT noted that nothing in the document or the subsequent discussion implied an obligation on any Member to protect any type of mark.

96. The SCT requested the Secretariat to prepare a working document for consideration at its eighteenth session, taking into account the deliberations of the present session and presenting key learnings for Member States in relation to the representation of those types of marks that the SCT had considered during the seventeenth session. As regards the portions of document SCT/17/2 that could not be dealt with during the present session, the SCT would resume work at the eighteenth session.

97. The Committee further agreed to invite delegations that had not yet done so to make submissions on those subjects by the end of June 2007, at the latest.

Relation of Established Trademark Principles to New Types of Marks

98. The Chair concluded that the discussion of document SCT/17/3 was postponed to the eighteenth session of the SCT.

Trademark Opposition Procedures

99. Discussion was based on document SCT/17/4.

100. The Chair noted that the purpose of document SCT/17/4 was an exchange of information in order to identify learnings on opposition procedures. The Chair invited delegations to comment on the relationship between opposition and examination procedures.

101. The Delegation of Pakistan sought clarification of the term “parallel structure” used in paragraph 6 of document SCT/17/4.

102. The Secretariat said that the expression “parallel structure” meant to describe a situation in which an opposition could be based on grounds already examined by the office. The expression “parallel structure” was used in a sense that it was opposed to systems in which a trademark application was examined by the office only as to limited grounds for refusal, or an opposition could be based only on limited grounds, such as a conflict with a prior right.

103. The Delegation of the United States of America explained that the national Office examined both absolute and relative grounds for refusal. An appeal against the examining attorney’s decision could be lodged before the administrative tribunal of the Office. The Delegation noted that therefore the system in the United States of America could be described as a parallel system. Third parties, such as representatives of industry, could submit additional evidence to the examining attorney during an opposition procedure, for example on the descriptive character of signs that needed to be used by the industry.

104. The Delegation of Zambia stated that under national legislation, there was a parallel system of examination and opposition. The Office examined formal, relative and absolute grounds for refusal, and oppositions could be based on the same grounds.

105. The Delegation of Spain noted that the examination of absolute and relative grounds in Spain took place within the framework of a parallel structure.

106. The Delegation of the United Kingdom observed that the national Office had a parallel system. The Office examined both absolute and the relative grounds, and oppositions by third parties could be lodged on the same grounds. However, following consultations with users, a complementary system would replace the current system in the United Kingdom by October 2007. In the new system, the examination would only refer to the absolute grounds of refusal, whereas oppositions might be based both on absolute and relative grounds for refusal. The Delegation indicated that the current rate of oppositions was 3% and it was expected to go up by 2 or 3%.

107. The Delegation of Slovenia raised a question concerning the relationship between observations by third parties and oppositions. The Delegation explained that, although the law of Slovenia provided for observations, the time limit for filing observations was not prescribed in its law. The Delegation asked whether opposition procedures could be applied to observations, or whether observations might be filed when filing the application, or after the expiry of the opposition period. The Delegation expressed interest in hearing the experiences of other SCT Members.

108. The Delegation of Japan considered it useful to clearly identify and to deal with the issues concerning opposition systems, such as the purpose of the systems and the differences between pre-registration and post-registration opposition systems. The Delegation recalled that Japan had introduced a post-registration opposition system in order to reduce the time period counted from filing to registration. The number of cancellations of registrations resulting from a decision on opposition accounted for only 0.2% of all the registrations in Japan. Given that the possibility of a cancellation was rare, the Delegation was convinced that it was pointless to publish all the applications in the Gazette and to wait for the period of opposition to pass. The Delegation recognized that an opposition system served public interests in enabling the Office to review the appropriateness of the trademark registration. However, the Office of Japan might correct a mistake without being restricted to the grounds on which an opposition was based. The credibility of the registration was strengthened and the burden on users was reduced since the application could be refused on both absolute and relative grounds or the registration might be cancelled at the opposition stage. The Delegation believed that a system which allowed registrations to be reviewed by third parties could be introduced and appropriately administered in every country.

109. The Delegation of Italy said that in accordance with national law, observations might be based on absolute grounds for refusal.

110. The Representative of the European Community said that in the Community Trademark System only formal and absolute grounds for refusal were dealt with *ex officio*. In the course of opposition proceedings, only relative grounds could be raised on the intervention of the holder of an earlier right during the three-month period from the publication of the application. Following the publication of the application third parties could submit observations explaining on which grounds, in particular, absolute grounds, the application should not be registered. There was no time limit established by the law within which such observations must be filed. However, as a matter of practice, observations would not be considered if they were filed later than one month after the end of the opposition period when no opposition was filed or where there was an opposition filed after the opposition

procedure had ended. In the Community Trademark System, observations were much less frequent than oppositions. In 2006, for example, the Office for the Harmonization of the Internal Market (OHIM) received about 14,000 oppositions and only some hundred observations.

111. The Delegation of the Republic of Korea explained that the national law on opposition was amended the previous year. The opposition period was extended from 30 days to two months from the publication date of the application in order to protect the applicants from foreign countries and to prevent trademark disputes. The Delegation said that in the Republic of Korea a pre-registration opposition system was introduced to complement the examination process.

112. The Delegation of Norway said that national law contemplated a post-registration opposition system. In addition, the legislation of Norway provided for observations by third parties, which might be based on both absolute and relative grounds. The Office communicated the observation to the applicant for comments. The possible comments of the applicant were not sent to the party having filed the observation. In the case the mark applied for was registered, the Office notified the party having filed the observation of the registration to enable it to file an opposition against the registration. There had been only a few observations raised by third parties before the Office.

113. The Delegation of Ecuador observed that the terms “opposition”, “observation” and “objection” were sometimes used as synonyms in document SCT/17/4. The opponent was at times considered to be a party of the procedure before the Office whereas the person having raised an observation was considered as a third party. The Delegation pointed out that the law of Ecuador provided for oppositions, and that the opponent became a party to the procedure. However, Decision No. 486 of the Andean Community made a reference to observations. The Delegation sought clarification of the scope of the different concepts.

114. In reply to the intervention of the Delegation of Ecuador, the Chair noted that an opposition procedure implied an *inter partes* procedure. On the other hand, an observation was a statement providing information where the person having raised the observation was not a party to the procedure.

115. The Delegation of Spain said that the legislation of Spain provided for both oppositions and observations. The oppositions and observations might be filed within two months from the publication of the application. An observation might be raised only on absolute grounds by official bodies, such as the Ministry of Agriculture or the Olympic Committee of Spain.

116. The Delegation of Mexico stated that it was preferable to grant the registration as quickly as possible. The Office in Mexico examined applications as to form as well as to absolute and relative grounds for refusal. A refusal might be appealed to a court, which could maintain the decision or grant the registration. The parties of the procedure before the court were the applicant, the holder of a prior registration on which the refusal was based and the Office. For this reason, the procedure before the court could be defined as a kind of an opposition procedure. The registration of the mark might be invalidated in a post-registration procedure before the Office.

117. The Delegation of Uruguay said that the national Office applied a parallel structure. Oppositions might be lodged on absolute and relative grounds by persons having a legitimate interest within 30 days from the publication of the application in the official gazette. The Office examined formal grounds as well as absolute and relative grounds.

118. The Delegation of the United States of America underlined that the national Office applied a process called “letter of protest”, which was filed with an independent reviewer. The independent reviewer considered the evidence, which was attached to the letter of protest and determined whether it should be submitted to the examining attorney. One of the prerequisites for the submission was the finding that the letter of protest did not refer to an *inter partes* matter. In the case that the evidence made clear that, for example, a word was used in the industry as a descriptive term and it might be supposed that the examining attorney was not aware of the descriptive meaning of the term, the independent reviewer would submit the letter of protest to the examining attorney. However, the application of the process of “letter of protest” was very restricted, since the examining attorney was usually able to find descriptive terms through the Internet. If the independent reviewer did not consider the evidence pertinent, the letter of protest would never be submitted to the examining attorney. Third parties might, however, lodge an opposition against the application on the grounds mentioned in the letter of protest. The Delegation expressed interest in learning of the experiences of other countries in respect of observations, in particular, whether observations were reviewed by the examiner at the examination stage.

119. The Delegation of Latvia said that the national Office applied a post-registration opposition system. The oppositions were submitted within three months from the publication of the registration based on relative and absolute grounds. The Office carried out *ex officio* examination as to formal and absolute grounds. The rate of oppositions was less than 2% of all the registrations and some 100 decisions on oppositions were made by the appeal board in a year. The number of oppositions filed before the appeal board was greater than the number of invalidation proceedings before the court. Trademark attorneys in Latvia preferred the administrative procedure to the civil courts when the case was complicated.

120. The Delegation of Singapore explained that national legislation provided for a parallel structure. The examination by the Office was carried out in respect of absolute and relative grounds. Oppositions by third parties might be raised on absolute and relative grounds. However, the application would have normally been objected to at the examination stage on the basis of absolute grounds. Nevertheless, an opposition based on absolute grounds was still potentially available for third parties.

121. The Delegation of Mexico noted that the terms “opposition” and “observation” were used in the same sense in Mexico. An observation filed at the opposition stage was submitted to the examiner. However, the person who filed an observation was not a party to the procedure.

122. The Delegation of Sweden explained that the procedure concerning observations before the Office was similar to the procedure in Norway. Observations were submitted to the examiner, but the person who filed an observation was not formally a party to the procedure during *ex officio* examination. The Office did not notify the applicant of the

observation neither did it notify the person who filed an observation of the registration or refusal of the mark applied for. The Office informed the person having filed an observation that it was his responsibility to monitor the official gazette in order to raise a possible opposition against the registration.

123. The Delegation of Paraguay referred to the intervention of the Delegation of Spain concerning the parallel structure and to the interventions of the Delegations of Ecuador and Uruguay as regards the terminology used. The Delegation pointed out that an observation by a third party contained information to be taken into account by the examiner whereas the context of an opposition procedure was different.

124. The Delegation of Ecuador concurred with the position of the Delegation of Paraguay stating that an opponent was an integral party to the procedure having rights and obligations prescribed by the national law.

125. The Delegation of Romania explained that the national Office examined absolute and relative grounds for refusal. However, relative grounds were limited to prior marks. The examination did not include works protected by copyright, industrial designs or geographical indications. Oppositions might be filed within two months from the publication of the registration. In the future, a pre-registration opposition system would be introduced in Romania as well as the possibility of formulating observations.

126. The Delegation of the United States of America observed that most refusals issued by examining attorneys were based on relative grounds. In the case that the examination as to relative grounds was eliminated, the number of oppositions would probably increase considerably. Given a statutory requirement that the registration was *prima facie* evidence of the ownership of the mark, the Office examined both absolute and relative grounds. The Delegation stated that during the examination of the application in the pre-registration opposition system, the examining attorney might have limited resources or time constraints. Opposition procedures allowed for additional issues to be brought before the Office before registration, for example, marks based on use, unregistered well-known marks and unregistered geographical indications, which were dealt with during the opposition procedure.

127. The Delegation of Slovenia sought a clarification of the term “the trademark concerned has been abandoned”, in paragraph 11 of document SCT/17/4.

128. In reply to the intervention of the Delegation of Slovenia, the Delegation of the Republic of Korea observed that if the holder of the registration had cancelled the registration, the trademark was considered abandoned.

129. The Delegation of the United States of America explained that the claim of abandonment was a situation where the holder was no longer using the mark and had no intention to resume the use. In the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) a period of at least three years of non-use was prescribed, after the expiry of which a claim of abandonment could be filed. The intention to abandon the use of the mark had to be established during the period of abandonment. During the opposition procedure a claim for abandonment might be filed, for instance, if the business had gone under and there was no intention to resume use. An opposition might as well be based on the ground that the applicant never had a *bona fide* intention to use the mark in commerce. In the case of a claim based on the absence of any intention to resume the use of

the mark, it was presumed that the mark had been used at some time. If there was no excuse for the non-use and the applicant or holder of the mark had no intention to resume the use at the time of non-use, the mark would be subject to cancellation.

130. The Delegation of Italy said that the national law stipulated that a registration was subject to cancellation after a period of five years of non-use. The cancellation procedure took place before a tribunal.

131. The Delegation of Ecuador explained that in Ecuador the abandonment of the mark could be declared in an invalidation procedure or in an opposition procedure. The mark could be declared abandoned if it was not used during a specified number of years.

132. The Delegation of Paraguay noted that national legislation stipulated that a mark might be declared abandoned upon an official request. After the expiry of a period of five years of non-use, a court might decide that the mark had been abandoned.

133. The Delegation of the Dominican Republic noted that the abandonment of the mark was not a ground for opposition. The abandonment had to be subject to a request for invalidation by a third party because of non-use of the mark.

134. The Delegation of Mexico expressed interest in discussing marks contrary to morality or public order. In particular, a word could have a second meaning of which the applicant might not be aware.

135. The Delegation of Ecuador cautioned against entering into a discussion of signs contrary to morality, such as religious signs. The Delegation emphasized that moral values were a subjective matter.

136. The Delegation of Egypt raised a question concerning use of a mark. If a mark was registered in another country, would the use of the mark by migrant workers constitute use in Egypt.

137. In reply to an intervention of the Delegation of Egypt, the Chair explained that a mark might have a reputation in a country without having ever been used in that country.

138. The Delegation of Uruguay pointed out that national law prohibited the registration and use of signs, which were contrary to morality or public order. When determining the nature of the mark, the time context as well as the use of the mark at the international level should be taken into account.

139. The Delegation of Jordan explained that national law stipulated a time limit for requesting the invalidation of a mark based on non-use. The case law of the country determined whether the mark was being used in the market.

140. The Delegation of Ecuador said that a declaration by the competent authority was required to establish that the application for registration of the trademark was made in bad faith, was obtained by fraud or was abandoned.

141. The Delegation of Ukraine referred to the case law in some countries on imitations of well-known marks and on the use of well-known marks for dissimilar goods and services. The decisions of the courts in Ukraine were based on Article 10*bis* of the Paris Convention for the Protection of Industrial Property (Paris Convention) concerning unfair competition and on the provisions of trademark law.

142. The Delegation of the United States of America explained that the application form provided by the national Office contained a statement declaring that the applicant was the only person entitled to the mark for which registration was sought. In the case that there was a prior pending application or a prior registration of an identical mark, a subsequent application was not considered as being in bad faith or obtained by fraud. The statement was required in order to avoid abusive applications which contained incorrect information intended to achieve a registration of the mark, which somebody else owned or in order to have financial benefits. In those cases, during opposition and cancellation procedures third parties might claim that the statement was not true.

143. The Delegation of Egypt said that national law allowed the mark to be registered in the name of several holders. However, according to case-law in Egypt the registration of a mark was cancelled on the basis of bad faith because the mark had been used for private purposes on importation, exportation and publicity.

144. The Delegation of Singapore said that clear and sufficient evidence was required to establish an allegation of bad faith. The opponents often referred to bad faith but seldom succeeded in an opposition procedure to prove that ground.

145. The Delegation of Mexico expressed interest in the experiences of the private sector concerning opposition systems. In the case that offices examined absolute grounds *ex officio*, the Delegation asked whether there was a need for oppositions based on absolute grounds by third parties.

146. The Delegation of the Republic of Korea explained that the registration of the mark in bad faith, the obtaining of the mark by fraud and the abandonment of the mark should be considered as relative grounds, since those grounds were often raised during the opposition procedure.

147. The Representative of GRUR said that there was an overlap between some absolute grounds and relative grounds. The Representative noted that countries applied the concepts of absolute grounds and relative grounds in different ways. The Representative raised a question concerning the meaning of the expression “the conflicts with provisions of international law, such as provisions of the Paris Convention”, in paragraph 11 of document SCT/17/4. Furthermore, the Representative of GRUR referred to possible conflicts between marks and International Nonproprietary Names for Pharmaceutical Substances (INNs). The Representative also referred to the provisions of the TRIPS Agreement, in particular with respect to geographical indications for wines and spirits, and suggested that geographical indications be considered absolute grounds for refusal.

148. In reply to the intervention of the Representative of GRUR, the Chair referred to the protection of the emblems of the International Federation of Red Cross and Red Crescent Societies and of the International Committee of the Red Cross recognized by the Geneva Conventions and their Additional Protocols.

149. The Delegation of Uruguay stated that geographical indications should be classified as relative grounds for refusal.

150. The Representative of INTA suggested that an exhaustive list of absolute and relative grounds be made available. The Representative informed the SCT of the establishment of a subcommittee for opposition procedures within INTA. In the opinion of the Representative, each jurisdiction should provide for an opposition procedure.

151. The Delegation of Ecuador suggested lists of absolute and relative grounds be reviewed by the Secretariat, because there was overlap between those lists and some terms were not used in a consistent manner, such as “not capable of distinguishing goods and services” and “devoid of distinctive character”.

152. The Delegation of Italy concurred with the position of the Representative of GRUR stating that geographical indications constituted absolute grounds for refusal.

153. The Delegation of Ukraine said that in the context of the registration of trademarks, a better understanding of Article 10*bis* of the Paris Convention concerning unfair competition was needed.

154. The Delegation of the United States of America explained that the terms absolute and relative grounds were not relevant to the practice of its Office, since an opposition before its Office could be based on all grounds. The Delegation said that an application for registration of a mark could be refused as deceptive on the basis of the existence of an unregistered geographical indication that had acquired distinctiveness in the United States of America.

155. The Delegation of Chile said that the purpose of document SCT/17/4 was to summarize the submissions of Member States and not to be an exhaustive document. The Delegation shared the opinion of the Delegation of Ukraine stating that conflicts with provisions of international law might refer to Article 10*bis* of the Paris Convention.

156. The Delegation of Egypt explained that under national law oppositions might be based only on prior rights. In the opposition procedure, the decision by the Office was limited only to the grounds mentioned in the opposition.

157. The Delegation of Norway explained that national law stipulated that the use of the word “pharmacy” in business was subject to the authorization by the State. Consequently, the Delegation suggested the following sentence: “the trademark is contrary to national law, morality or public order”, to be added to the list of absolute grounds.

158. The Delegation of Australia noted that in the national legislation of Australia there was a similar provision in the banking laws concerning the use of the word “bank”.

159. The Delegation of El Salvador underlined that the national Office did not make any distinction between absolute and relative grounds during the opposition procedure. The Delegation concurred with the position expressed by the Delegation of Chile concerning the non-exhaustive character of the document. The Delegation explained that in accordance with the new Trademark Law of El Salvador, appeals were dealt with in an administrative procedure before the Office.

160. The Delegation of Chile reiterated that its understanding was that the lists in document SCT/17/4 were only indicative and not exhaustive.

161. The Delegation of El Salvador said that any person who had legitimate interests could file an opposition against the registration of a sign, which was identical with or similar to a well-known mark. The Delegation made a distinction between a famous mark, which was known by the public at large and a well-known mark, which was known by the relevant sector of the public.

162. The Delegations of Chile, Denmark, El Salvador and Slovenia sought clarification of the term “registered defensive mark”. The Delegation of Slovenia asked about the distinctive nature of the defensive trademark compared with a prior trademark.

163. The Delegation of Australia said that under national practice, the mark to which the defensive mark related had to be registered and obtain a reputation. The defensive mark could be registered in respect of goods and services, on which the mark was not intended to be used. It was not possible to cancel the defensive mark on the basis of non-use. The Delegation noted that in all other aspects the defensive mark had the same status as other marks, in particular, an opposition could be based on a defensive mark.

164. The Delegation of El Salvador asked whether the application form had to state that the application concerned a defensive mark or whether this was assumed by the office. The Delegation believed that the protection of a famous mark in several classes constituted a monopoly.

165. The Delegation of Australia said that the applicant had to indicate in the application form that the application concerned a defensive mark. In addition, the mark to which the defensive mark related had to be indicated in the form.

166. The Delegation of Ecuador inquired at what stage the defensive mark became a speculative mark. The Delegation raised concern about the limits for protection of the defensive mark.

167. In reply to the intervention of the Delegation of Ecuador, the Delegation of Australia explained that the goods in respect of which the defensive mark was registered had to be closely related to the goods of the mark. The office examined *ex officio* the closeness of the goods and services. Opposition and infringement procedures might be based on the grounds that the claim for protection was too broad. There had not been any widespread abuse of the defensive marks in Australia.

168. The Delegation of Zambia stated that national legislation provided for the concept of defensive marks. A defensive mark could be registered in 34 classes for goods, since the registration of service marks was not provided in the law of Zambia. A defensive mark could be registered only if the use of the famous mark by anybody else would be misleading.

169. The Delegation of the United Kingdom said that there was previously a system of defensive marks in the United Kingdom. The concept of defensive marks was no longer needed since the new national legislation provided for protection of marks that had a reputation for dissimilar goods and services.

170. The Delegation of Ukraine explained that further issues could be added to the lists of grounds for refusal. For example, the Delegation referred to the sign “HEL SINKI”, which referred to a place of origin. Both parts of the sign as such were distinctive, but the combination was misleading.

171. The Chair invited delegations to comment on publication practices stating that, in particular, small and medium sized enterprises were not always aware of publications made by the office.

172. The Delegation of El Salvador recalled that, in accordance with national law, an opposition might be filed within two months from publication. The grounds for opposition and the required evidence must be indicated in the opposition. However, an additional time limit might be given in order to submit evidence. The decision of the Office might be appealed to the appeal board.

173. The Delegation of Denmark explained that the national Office offered a service by informing the holder of the registration when its mark was mentioned in later search reports.

174. The Delegation of Spain explained that the national Office informed the holders of prior trademarks of the publication of an application for registration of a similar mark.

175. The Delegation of Uruguay indicated that an opposition was examined by an administrative legal counsel, which was composed of legal attorneys. The decision was given in the form of a report. An appeal could be lodged at the Ministry of Industry, Energy and Mining, which might confirm or invalidate the judgment of the legal counsel.

176. The Delegation of Latvia suggested to add the expression “legitimate users” to paragraph 20 of document SCT/17/4 as follows: “owners or legitimate users of protected geographical indications”.

177. The Delegation of the United States of America pointed out that the national Office provided a 30-day opposition period, which could be extended because of good cause or by the agreement between the parties. The maximum period of extensions was five months, after the expiry of which a decision had to be made whether to lodge an opposition or not. There was no fee for extensions, but there was an opposition fee.

178. The Delegation of Chile suggested that document SCT/17/4 be updated on the basis of the comments raised by the delegations and those comments be included in an addendum to that document.

179. The Delegation of Sweden inquired whether the intention was to draft a separate document on key learnings, on the basis of the comments made and submissions of the delegations, or to prepare an addendum to document SCT/17/4.

180. The Delegation of Ecuador noted that a consolidated document should include the comments raised by the delegations during the discussion, such as the comments on the grounds for opposition.

181. The Delegation of the United States of America noted that the comments of the delegations were reflected in the report. The Delegation suggested that document SCT/17/4 would not be updated but a new document based on the submissions of the Member States be drafted by the Secretariat.

182. The Delegation of Germany was in favor of drafting a new document based on the key learnings of the discussion.

183. The Representative of OAPI explained that the opposition period in the legislation of African countries was often longer than two or three months. As far as OAPI and its Member States were concerned, the opposition period was six months from the date of publication. The office transmitted the oppositions to the right holder, who had a three-month period to respond to the opposition.

184. The Representative of GRUR stated that the length of the opposition period should be reasonable and proportionate. In this respect, the interests of the applicant and the opponent should be taken into account. In the opinion of the Representative a one-month opposition period was too short from the point of view of the opponent and more than a three-month opposition period was too long from the point of view of the applicant.

185. The Representative of OAPI observed that the users and law offices had been consulted in the context of drafting the text of the Bangui Agreement Relating to the Creation of an African Intellectual Property Organization. The six-month period of opposition was established on the basis of interests expressed by users during the consultation. In the future, however, electronic filing and publication might lead to a reconsideration of the time limit for opposition.

186. The Delegation of the United States of America pointed out that national legislation provided for an opposition period of 30 days, during which an extension of the period might be requested. The legislation provided an additional period of six months to file an opposition. Three or four months before the publication of the application a notice was sent to the applicant about the forthcoming publication. The notice was made available on the database at the website of the Office two or three months before the application was published. In most cases, an extension of the opposition period was requested and an extension was granted automatically. The Office notified the potential opponent of the receipt of the request for extension and simultaneously informed the applicant of a possible opposition. Further extensions of the opposition period could be granted on the basis of a good cause. After the expiry of four months, an extension could be allowed only with the consent of the applicant or due to extraordinary circumstances. There was no fee for filing a request for extension of the opposition period.

187. The Representative of GRUR observed that a 30-day period to consider the potential filing of an opposition might be considered too short. Users generally needed more time to decide about the filing of an opposition.

188. The Delegation of Chile explained that national legislation provided for an opposition period of 30 working days. In the case that an opposition was not filed against the application during the opposition period, the cancellation procedure was available after the registration of the mark.

189. The Delegation of the Republic of Korea explained that national law was amended and the amendments would enter into force in July 2007. The opposition period was prolonged from 30 days to two months, since the period of 30 days was considered too short from the point of view of foreign applicants.

190. The Delegation of Slovenia referred to the footnotes in paragraph 27 of document SCT/17/4 stating that there were other countries, including Slovenia, in addition to those mentioned in the footnotes that required a fee to be paid in respect of oppositions. The Delegation explained that according to the law of Slovenia it was not possible to amend the grounds for opposition and no further evidence could be submitted after the expiry of the three-month opposition period. The practice of the Office had been the subject of some criticism whereas small and medium sized enterprises had been in favor of that practice. Court decisions had confirmed that the practice of the Office had been a correct interpretation of the national law.

191. The Delegation of Chile noted the context in which document SCT/17/4 was conceived. The document summarized the replies to the questionnaire on trademark law and practice and the submissions of Member States. The Delegation underlined that the purpose of the document was not to unify all criteria worldwide.

192. The Delegation of El Salvador explained that a written notice of opposition might be filed with the national Office by mail or by facsimile. For the time being, the Office did not provide for electronic filing. The applicant had a 30-day period to respond to the opposition. The grounds on which an opposition could be based and the elements of an opposition were stipulated in national law. The Office carried out a formal and substantive examination of the application. The legislation of El Salvador had been amended to include conflicts with well-known and/or famous marks as grounds for refusal of an application. The examiners took into account the graphic as well as the phonetic aspects of the mark. The Office did not charge a fee for filing an opposition or an appeal.

193. The Delegation of Brazil stated that the national Office carried out a formal examination before the publication of the application. The opposition period was 60 days from the date of the publication. The Office notified the opposition to the applicant through a publication of the opposition in the Gazette. The applicant might submit its comments within 60 days from the publication of the opposition. The information on the opposition was made available to the public on the Internet. After the expiry of the opposition period, the Office carried out the substantive examination.

194. The Delegation of the United States of America observed that an increasing number of oppositions was filed electronically. The system verified automatically whether the fees were paid and whether the time limits had been complied with. The Office verified that at least one ground for opposition was mentioned. At the time of filing, no evidence for opposition was required, since it was the responsibility of the parties to question whether the grounds for opposition were valid. As regards the standing of the opponent, a motion based on the jurisdiction or on the grounds for opposition might be filed against the opponent.

195. The Delegation of Egypt said that in Egypt the opposition might be made within 60 days from the publication of the application in the Gazette. The applicant had a period of 30 days to respond to the opposition. The Office then reviewed the opposition in order to identify whether the grounds for opposition were valid and whether a hearing between the

parties could be organized. At the hearing new evidence could be presented by the parties but no new grounds for opposition. In the case the grounds for opposition had been misleading or there was an error in respect of goods and services, new grounds could be submitted even at the stage of the hearing.

196. The Delegation of the United States of America explained that according to the motions practice at its Office a response to the opposition by the applicant had to be filed within 40 days, and this period might be extended. In the response the applicant should either affirm or deny each allegation in the opposition. In the case that the applicant failed to respond, the opponent might file a motion of a default judgment or the Office might issue a notice of default.

197. The Representative of GRUR observed that at the examination stage the office was not always aware of the use or non-use of the earlier marks. The Representative emphasized that the applicant should be able to challenge the absence of use of the earlier marks. The Representative suggested that element to be taken into account in the further discussions.

198. The Delegation of Uruguay said the applicant had a 30-day period to respond to the opposition, and that period might be extended by 15 days. The opponent might withdraw its opposition on the basis of an agreement with the applicant, for example, by limiting the list of goods and services of the application. However, the Office might still *ex officio* oppose the application if it considered that there was a possibility of a confusion.

199. The Delegation of Egypt explained that if the applicant did not respond to the opposition, the application was considered to be cancelled. In the case that the application contained several marks, only those marks, against which an opposition was lodged, might be refused, and the other marks were accepted.

200. The Delegation of the United States of America stated that evidence was submitted on paper records to the Trademark Trial and Appeal Board of the Office. Oral hearings were seldom conducted at the request of the parties. The parties had to submit the evidence to the Office within the period provided for.

201. The Delegation of the United Kingdom explained that a “cooling off” period was introduced into its law a few years ago. The opposition period was three months from the publication of the application, which could not be extended. The “cooling off” period was nine months and together with the time period for counter statements it covered 12 months. The Delegation underlined that 50% of the cases were settled during the cooling off period, which proved that it was an effective method for negotiations and to avoid expensive costs for evidence.

202. The Representative of the European Community stated that the opposition period was three months from the publication of the application. The opposition was notified to the applicant after an admissibility check and the two-month cooling off period started from that notification. The parties might enter into negotiations during that period and an extension of the period might be granted upon a joint request by the parties. A maximum time limit of 24 months for the cooling off period had been introduced to the law. In the case of an amicable settlement, the opposition fee would be reimbursed to the opponent. The

Representative underlined that the majority of the cases were settled within the cooling off period. In the case that no settlement was reached between the parties, the possibility of the suspension of the procedure still existed.

203. The Representative of ECTA felt that the experiences of the two-month cooling off period were very positive. As regards the introduction of the 24-month time limit, the Representative noted that according to a survey among the users, they would have preferred other time limits, for example ten months and six months in order to have a certain pressure on the parties.

204. The Representative of GRUR recalled that in the concept of cooling off no evidence had to be submitted to defend the opposition prior to the end of the cooling off period. The Representative emphasized the utility of the cooling off period as part of the opposition system.

205. In reply to an intervention of the Representative of ECTA the Representative of the European Community observed that the time limit of 24 months was the result of a compromise. The Representative observed that it was too early to draw conclusions on the effects of the time limit.

206. The Delegation of Egypt said that national legislation did not provide for the suspension of the procedure. The opposition period was 60 days and the Office then examined the grounds for opposition. The negotiations between the parties might lead to a possible resolution or settlement or to a hearing. However, there were no time limits for the termination of the hearing sessions.

207. The Delegation of Mexico referred to a statement of the Delegation of Uruguay and raised a question whether in the parallel system the Office would grant the registration of an identical mark for identical or similar goods and services on the basis of a letter of consent of the right holder of the previous mark.

208. In reply to the question of the Delegation of Mexico, the Delegation of the Dominican Republic explained that an identical mark could not be registered in respect of identical or similar goods and services, because that would cause confusion among the consumers.

209. In reply to the question of the Delegation of Mexico, the Delegation of Uruguay stated that the interests of consumers had to be taken into consideration in the case of identical marks for identical or similar goods or services.

210. The Delegation of Egypt noted that in the case of identical marks for identical goods or services a letter of consent would not be endorsed by the Office.

211. The Delegation of El Salvador underlined that national law stipulated that the coexistence of similar marks was allowed when there was a written agreement amongst the parties concerned.

212. The Delegation of Spain stated that the coexistence of two identical marks for identical goods and services was not accepted in Spain. However, almost identical marks might be accepted on the basis of a letter of consent.

213. The Representative of GRUR noted that if the owner of the earlier mark consented to the registration of an identical mark for identical or similar goods and services, there was no public interest to be protected by the offices.

214. The Representative of ASIPI shared the opinion expressed by the Representative of GRUR stating that if the prior mark holder had consented to the registration of an identical mark there was no reason to refuse that mark.

215. The Delegation of the United States of America noted that the parties were in the best position to know how to avoid confusion as regards identical marks in the market place. In the case of a letter of consent the examining attorney still examined whether there was a likelihood of confusion. However, if the applicant gave an explanation how to avoid confusion in the market place and clarified the content of the consent, the application was in most cases accepted.

216. The Delegation of Latvia noted that national case law raised some concerns as regards the acceptance of the amicable settlements. In the opinion of the Delegation the interests of the consumers had to be taken into account and explanations were needed about how to avoid confusion among consumers.

217. The Representative of ASIPI assumed that in Uruguay and Mexico the registration of the mark was not subject to the use of the mark. In the opinion of the Representative, the use of the mark in the market place was a matter for the consumer protection organizations rather than the trademark office.

218. The Delegation of Mexico clarified that it had not expressed its position on the question concerning identical marks, which it raised.

219. The Delegation of the Republic of Korea observed that no appeal could be filed against the decision of the opposition body. A mark could be invalidated after the registration. The Delegation invited other delegations to share their experiences in this context.

220. The Chair explained that in Australia the decision on opposition could be appealed to a Federal Court before the registration of the mark. The users were in favor of having the opposition decided prior to the registration.

221. The Delegation of Latvia explained that the decision on opposition of the Office might be appealed to the Administrative Court of First Instance, then to the District Administrative Court and finally to the Supreme Court. In this concept the applicant and the opponent could file an appeal before four instances. In the future, the Board of Appeal would be recognized as the first instance to file an appeal. That concept would lead to costs savings compared to an invalidation procedure before a court.

222. The Delegation of Ecuador noted that in Ecuador there were practically six instances up to filing an appeal with the Supreme Court. The Delegation expressed concern about the duration of the appeal procedure. The Delegation noted that the situation was extremely difficult for the small and medium-sized enterprises.

223. The Delegation of Paraguay underlined that the law of all countries should provide for an appeal procedure. The Delegation explained that an appeal against the decision of its national Office was filed with the Board of Appeal. Subsequent appeals were filed with the Court of the First Instance and the Supreme Court.

224. The Delegation of the United States of America said that the decision by the tribunal of the Office on opposition could be appealed either to a district court, where new evidence could be submitted, or to a special court. The incidents of appeals were relatively low, since the parties normally tried to settle the issue. The parties did not need a lawyer for proceeding before the Office but in court procedures they had to be represented by a lawyer. The decisions of the tribunal and the courts were published.

225. The Delegation of Uruguay emphasized the importance of the appeal procedure. An appeal against the decision on opposition could be filed before an administrative body within the Ministry of Industry, Energy and Mining, which might revoke or maintain the decision.

226. The Delegation of Paraguay noted that in Paraguay there were no fees for filing opposition. However, in the future, fees might be established in order to limit the number of oppositions.

227. The Representative of GRUR noted that regardless of whether a country had an opposition procedure or not, invalidation or cancellation procedures should be available. The result of the opposition procedure should not affect the invalidation or cancellation procedure. The time limit for initiating an action for the cancellation of a registration should not be unreasonable. In this context, for example, one or two years appeared to be reasonable. The cancellation of a registration after long and extensive use of the registered mark would be unreasonable.

228. The Delegation of the United Kingdom explained that in May 2004 the national Office changed its practice regarding the evidence to be submitted. After the cooling off period and when the counter statements had been submitted, the Office gave a preliminary view of the case indicating the likelihood of success in a letter to both parties. There was no appeal procedure against the preliminary view but in 40 % of the cases the preliminary view was accepted. In the case that a party did not agree with the preliminary view, it could submit evidence to the Office. However, if the evidence submitted was unreasonable, it could be a fact to which the other party might refer when the Office decided on the costs. The users of the system had supported the new practice and it had a very positive effect on the workload of the Office.

229. The Delegation of the United States of America explained that national courts applied the concept of mandatory initial disclosure in cases where the applicant or the opponent submitted evidence but it was obvious that they did not have a case. The Office would implement regulations which would coincide with the court practice in order to reduce the claims. The parties would be invited to meet and discuss what would be a viable claim or a viable defense. During the discussion the evidence could be demonstrated and on that basis the parties might conclude who had the better case.

230. The Delegation of Mexico sought a clarification of the meaning of the expression “the organizational difficulties that opposition procedures might cause”, in paragraph 63 of document SCT/17/4.

231. In reply to the question of the Delegation of Mexico, the Delegation of Slovenia said that limitations as to the number of staff and of resources in small offices would cause difficulties in dealing with opposition procedures.

232. The Delegation of Latvia noted that the post-registration opposition system and the cancellation procedure were very similar from the legal perspective. The Delegation observed, however, that the opposition procedure was an *inter partes* procedure in which the Office participated as an intermediary. The Delegation pointed out that during 12 years the Office in Latvia had decided 1,200 cases on opposition and only 2% of them had been reversed by the court.

233. The Delegation of Egypt explained that oppositions were filed before the Office, and the decisions of the Office could be appealed before higher courts. However, the request for invalidation of the registration on the basis of bad faith or non-use of the mark could only be filed before a civil court.

234. The Delegation of Uruguay expressed a preference for a pre-registration opposition system over a post-registration opposition system, since the post-registration opposition system entailed an invalidation of the registration.

235. The Delegation of Paraguay asked how a post-registration opposition system would make the procedure faster as referred to in paragraph 67 of document SCT/17/4. The Delegation noted that the registration of the mark included an exclusive right to use the mark.

236. The Chair explained that through a post-registration opposition system the applicant could quickly obtain a right without being obliged to wait for the expiry of the opposition period. The rate of oppositions in most countries was quite low, therefore the majority of the registrations remained valid.

237. The Delegation of Japan explained that a post-registration opposition system was introduced in Japan in 1997. The Delegation noted that the rate of oppositions was 0,2% of all registrations.

238. The Delegation of Ecuador inquired as to whether in a post-registration opposition system an opposition based on bad faith was sanctioned.

239. The Delegation of Egypt explained that a claim for cancellation of the registration based on bad faith was not sanctioned as such. However, a claim for compensation could be filed on the basis of the damages suffered.

240. The Representative of GRUR pointed out that the post-registration opposition system had been introduced into the law of Germany. An opposition might be filed after the publication of the registration of the mark on the same grounds and within the same time limits as before the amendment of the law. The benefits of the post-registration opposition system was that the holder had an enforceable trademark right even if the possibility of opposition existed.

241. The Delegation of the United States of America asked at what stage there was a presumption of the ownership of the mark in the post-registration opposition system. The Delegation inquired whether there was a presumption of ownership once the mark was registered or after the expiry of the opposition period.

242. The Delegation of Germany explained that the registration of the mark was a fully registered right. The legislation of Germany did not provide for protection on the basis of use. The Office carried out the examination as regarded the absolute grounds, and the oppositions could be filed only on relative grounds within three months from the publication of the registration. The procedure was very simple and no evidence was required at the opposition stage.

243. The Delegation of Latvia underlined that among the 1,200 oppositions filed in Latvia there appeared not to be any oppositions filed in bad faith. In the case that an opposition was based on an earlier mark, the applicant was entitled to require evidence of use of the earlier mark.

244. The Committee noted that document SCT/17/4 was designed as a basis for discussion and provided a broad overview of the key features of the different types of opposition procedures. To the extent that the document identified the approach in specific jurisdictions, it was purely illustrative and was not intended to serve as a comprehensive or authoritative guide.

245. The Committee noted that the additional information provided during the meeting would be reflected in the report, and accordingly decided not to revise the document.

246. The SCT requested the Secretariat to draft a new document for the next meeting setting out key learnings in this field. The first draft of this document would be drawn from:

- submissions already received;
- the report of the current session;
- and any further submissions from SCT Members specifically addressing the issue of key learnings.

247. The SCT further requested the Secretariat to provide a draft of the document which would be posted on the SCT Electronic Forum by August 11, 2007, seeking comments from Member States to be used for the final version of that document.

Article 6ter of the Paris Convention

248. Discussion was based on document SCT/17/5.

249. The Delegation of Japan referred to the increasing number of communications under Article 6ter of the Paris Convention and expressed concern over the burden which those communications were placing on offices. The Delegation suggested that criteria for the

determination of official signs indicating control and warranty be established and that the communication procedure be simplified. The Delegation indicated that Article 2 of the TRIPS Agreement prescribed that the Members of the World Trade Organization (WTO) should comply with Articles 1 through 12, and Article 19, of the Paris Convention. Consequently, discussion on the Paris Convention had also a bearing on WTO Members, which, in turn, warranted the sharing of information with WTO.

250. The Chair suggested that the Secretariat prepare a document for consideration by the next session of the SCT, in which the recommendations agreed in the current session would be included together, where necessary, with a proposal for a decision to be submitted to the Paris Union Assembly.

251. In reply to a question raised by the Delegation of El Salvador, the Chair explained that the SCT did not report to the Paris Union Assembly every year and that specific proposals were transmitted for decision of that body on a case by case basis.

252. The Delegation of Switzerland sought clarification of the alleged inconveniences of the solution referred to in paragraph 24 of document SCT/17/5, i.e. an e-mail message as compared to an e-mail alert on the updating of the Article 6*ter* database described in paragraph 23 of that document.

253. In reply to the question raised by the Delegation of Switzerland, the Secretariat explained that, from a technical point of view, the transmission of attachments to e-mails such as data and image files often created problems. Depending on the available storage capacity, particular voluminous documents might block the e-mail systems of the International Bureau or those of receiving offices.

Relevant Contact Details Concerning the Requesting Party

254. The Secretariat indicated that States usually presented requests for communication under Article 6*ter*(3)(a) through diplomatic channels. In that context, the question arose what constituted the “contact address” of a State.

255. The Delegation of Germany said that the States should be contacted through diplomatic channels. The Delegation also emphasized that Article 6*ter* prohibited the registration and use of trademarks identical with or similar to the signs communicated under Article 6*ter*. The law of Germany prohibited unauthorized use of State emblems in the course of trade. The Delegation cautioned against giving the impression that the relevant administration of the State could be contacted in order to negotiate the letter of consent to use a mark.

256. The Delegation of Australia stated that trademark applicants needed the contact details, in particular, of international intergovernmental organizations, in order to be able to start negotiations with them. The Delegation suggested that States might, on a voluntary basis, indicate contact details for certain signs.

257. The Delegation of Spain said that in the event of a conflict between a trademark and a sign protected under Article 6*ter*, it was useful to have information on the contact details. The indication of the contact details could be required in the request for communication. As regards communications already undertaken, the requesting parties could be invited, on a voluntary basis, to update or complete the information originally submitted.

258. The Delegation of the United States of America said that information on contact details was very useful for the national Office and for users. The party that requested the communication of a sign might be contacted directly in order to obtain more information on the signs and on the requesting party. The Delegation indicated that nationally the contact address would be the United States Patent and Trademark Office (USPTO), since it processed the communications under Article 6ter and was in the best position to divert inquiries on the communicated signs to the relevant administration.

259. The Delegation of Chile supported the proposal of the Delegation of Spain, namely to require that contact details be indicated in a request for communication. The Delegation noted that, as regarded States, the government of the State, the Ministry of Foreign Affairs or a mission of the State might be contacted.

260. The Delegation of Singapore expressed support for the proposal to insert the contact details in the communication. In the absence of such information, the burden to search contact details would be on the applicants.

261. The Delegation of the Russian Federation said that it was in favor of including contact details in the communications. The Delegation further suggested that contact details of international intergovernmental organizations be added to the Article 6ter database.

262. The Delegation of Germany highlighted the differences between State emblems and the signs of international intergovernmental organizations. The contact details of organizations might usually be found on the Internet. However, States should be contacted through diplomatic channels.

263. The Delegation of Sweden expressed support for the view expressed by the Delegation of Spain and stated that contact details should be required when making a request for communication. However, the Delegation expressed concern about the proposal in paragraph 9 of document SCT/17/5, concerning the communication or confirmation of contact details for existing communications. The Delegation noted that, if the Office in Sweden had to update the contact details for existing communications, all communications as a whole would have to be reviewed, which would result in a considerable workload.

264. The Delegation of Mexico said that information on the requesting party would facilitate the procedure before the Office. The information was useful for a better understanding of the possible conflict between the communicated sign and a subsequent mark. The Delegation observed that in some cases an identical or a similar mark would be acceptable in the country of origin but could have been refused in other countries.

265. The Representative of INTA pointed out that the channel of communication with a State should be at the discretion of the individual States. The channel of communication for interested third parties might be different than the official channel of communication for a State with the International Bureau.

266. The Delegation of Germany underlined that some State emblems of Germany had been used by foreign companies without authorization. In those cases the Embassy of Germany had contacted the national Industrial Property Office and informed the Ministry of Foreign

Affairs of the infringement in order to have instructions from the relevant administration in Germany.

267. The Delegation of Chile noted that the proposal of the Delegation of Spain did not seem to preclude that contact be established with an embassy or a mission of the State. The Delegation emphasized that there was no need to analyze the different possibilities but to leave it to the discretion of the individual States or of the international intergovernmental organizations to indicate the appropriate channel to contact them.

268. The SCT recommended that contact details be provided as part of the communication under Article 6ter(3)(a) and (b) in order to enable offices and third parties to contact the beneficiary of protection.

269. With regard to existing communications, the SCT requested the Secretariat to invite States and International Intergovernmental Organizations (“IGOs”) to provide contact details for the sake of completeness.

Information Concerning the Constituting Charter or Agreement of International Intergovernmental Organizations

270. The Delegation of Mexico observed that the constituting charter agreement of international intergovernmental organizations (IGOs) could be included in the new Article 6ter database. In the view of the Delegation the distribution of 600 copies of the constituting treaty would be cumbersome.

271. The Delegation of Austria pointed out that, in the case that an international intergovernmental organization whose signs were protected under Article 6ter was dissolved, the successor organization should be indicated. Moreover, the constituting agreement of the successor organization had to be made available, for example, through a link to the website of that organization.

272. The Delegation of Spain expressed support to the proposal of the Delegation of Austria stating that a link to the website of an international intergovernmental organization would be sufficient. As regards those States that had expressed a wish to receive the constituting agreement on paper, the International Bureau could invite the requesting organization to submit paper copies directly to that State.

273. The Delegation of the United States of America noted that a link to the website address of the international intergovernmental organization on the WIPO website or in the database would be sufficient. The Delegation said that a PDF file included in the database could also be a possibility.

274. The Delegation of Portugal observed that it would be most appropriate to indicate the reference to the website of an international intergovernmental organization at the same time as the contact details.

275. The SCT recommended that the communications from IGOs should contain a reference to a website where the constituting agreement or charter of a given IGO could be accessed. This information could also be obtained by requesting it from the International Bureau which would provide it, for example, in paper form or PDF format.

Information on the Nature of Goods and Services on Which Official Signs and Hallmarks are Used

276. The Delegation of the United States of America noted that the national Office would most likely raise objections to the protection of hallmarks with no indication of goods for which they were used. The Delegation suggested that an indication of goods and services be required when communication of such signs was requested. The Delegation did, however, not see a need to use the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (the Nice Classification) in communications under Article 6*ter*.

277. The Delegation of Spain felt that the information on the goods and services to which the official signs and hallmarks applied would contribute to facilitating the examination by offices. The Delegation stressed that the indication of goods and services should be required in respect of official signs and hallmarks.

278. The Delegation of Slovenia asked whether there were any statistics regarding how many official signs and hallmarks were communicated without an indication of goods and services. The Delegation pointed out that the Nice Classification was interpreted differently in different countries and some countries did not use that classification at all. The Delegation noted that not all communications were requested by States but also by international intergovernmental organizations. The Delegation raised concern as to who would be responsible for checking the classification.

279. The Delegation of Uruguay referred to the limitations of protection of official signs and hallmarks prescribed in Article 6*ter*(2) and observed that the goods and services to which the sign applied should be indicated in the request for communication.

280. The SCT recommended that an indication of the goods and services should be a standard requirement for communications in relation to official signs and hallmarks indicating control and warranty.

Electronic Communication

281. The Delegation of Norway proposed that each office inform the International Bureau whether it wished to receive the communication electronically or on paper. The Delegation indicated the Office of Norway preferred to receive communications electronically. The Delegation felt that an e-mail alert concerning an update on the Article 6*ter* database would facilitate the examination of such update by the Office. The Delegation asked whether it was possible to receive the existing communications electronically.

282. The Delegation of Ukraine said that the national Office would prefer the possibility of electronic communications.

283. The Delegation of the United Kingdom supported the proposal made by the Delegation of Norway stating that the form and means of communication should be at the discretion of the receiving country. The Delegation indicated that the national Office would wish to receive the communications electronically.

284. The Delegation of Spain noted that an individual download of the data from an FTP server would be an acceptable option for the national Office. However, the electronic communication should be complementary to the current practice of communication on paper. The Delegation noted that the administration of individual e-mail notifications could bind considerable resources of the International Bureau and might cause technical problems.

285. The Delegation of Germany observed that the national Office preferred the current practice of communications on paper. The Delegation said that its observation did not prevent the other States from opting for an electronic system. The Delegation was in favor of receiving an e-mail alert of new communications.

286. The Delegation of Denmark expressed support for the proposal of the Delegation of Norway, stating that its Office had good experiences with the use of the ROMARIN® database under the Madrid System for the International Registration of Marks.

287. The Delegation of Sweden expressed its support for the proposal of the Delegation of Norway stating that individual e-mail notifications as described in paragraph 24 of document SCT/17/5 could cause problems.

288. The Delegation of Croatia was in favor of the option for individual downloads of the relevant data from an FTP server.

289. The Delegation of Germany said that it agreed with the proposal to introduce electronic communications as a supplementary means of communication with States. The Delegation asked whether there were any differences between the format of the data available in the Article 6ter database and the data on the FTP server.

290. The Secretariat explained that the data available on the FTP server would be in XML (“eXtended Markup Language”) format. The server would not provide any software to visualize the data. This data would be received in XML format by the offices, which could incorporate it into their data systems.

291. The Delegation of the Russian Federation said that the national Office was in favor of receiving an e-mail alert for the update of the Article 6ter database. The Delegation also expressed support for the further option of an individual download of data from an FTP server.

292. The Delegation of the Republic of Korea underlined that the option of an individual download of data from an FTP server was the most advanced form of electronic communication. The Delegation sought a clarification of the expression “individual e-mail notification” in paragraph 24 of document SCT/17/5.

293. The Chair explained that the word “individual” in the context of paragraph 24 meant that an individual e-mail notification was sent every time a communication was requested. The word “individual” used in paragraph 25 regarding the individual download of the data did not have the same sense as in paragraph 24 since it referred to the individual offices.

294. The Representative of CEIPI, speaking also on behalf of ATRIP, asked whether it was the paper communication or the electronic communication which had legal effect under Article 6ter.

295. The Secretariat said that only the communication of a verbal note, on paper addressed to the Ministries of Foreign Affairs of the States party to the Paris Convention and the Members of the WTO had legal effect. There was currently no proposal to replace the communication on paper. The possibility of electronic communication would only be supplementary to the paper communication. The proposed electronic communication would be sent only to offices wishing to receive the data in the electronic form.

296. The Delegation of the Russian Federation raised a question as to whether the required number of copies of the attachments to the notification would be reduced when applying the electronic communication.

297. The Secretariat explained that at least two copies of the reproduction were sent to the States party to the Paris Convention and to the Members of the WTO, which were not party to the Paris Convention. In addition, the International Bureau maintained a stock of copies to be submitted to the States newly acceding to the Paris Convention. A number of administrations had also indicated that they wished to receive more than two copies. Consequently, the 600 copies of the reproduction would still be required in the future.

298. The SCT noted that the existing paper-based communication procedure should not be replaced by electronic means of communication. However, the Committee agreed to ask the Secretariat to implement the option outlined in paragraph 25 of document SCT/17/5 (i.e., individual download from FTP server), it being understood that this would allow Contracting Parties to the Paris Convention to download this information monthly.

Review of Existing Communications

299. The Delegation of the United States of America referred to a comment made by the Delegation of Sweden concerning the updating of the contact details and the revision of the existing communications. The Delegation noted that it might be worthwhile to consider a review of the existing communications at the national level and to “clean up” the Article 6*ter* database as well as the national databases.

300. The Delegation of Mexico shared the opinion expressed by the Delegation of the United States of America and noted that each State should itself review its communications.

301. The Delegation of Canada supported the proposal made by the Delegation of the United States of America. The Delegation observed that the review of the existing communications could be easily carried out on the basis of the information contained in the new database.

302. The Delegation of Uruguay said that the offices of some countries did not have the resources to carry out such a review.

303. The Delegation of Germany noted that the Office in Germany was not able to commit itself to such a review. However, the Delegation said that there was a legitimate interest to review the existing communications.

304. The Delegation of Sweden recalled that the relation with the WTO Members, which were not party to the Paris Convention, should be examined. The Delegation noted that in the Article 6*ter* database there were international intergovernmental organizations, which did not

exist anymore or others whose name or abbreviation had been changed. The Delegation inquired whether there were any statistics of the obsolete abbreviations or names of international intergovernmental organizations in the Article 6*ter* database.

305. In response to the statement of the Delegation of Sweden, the Secretariat explained that when a new communication was requested by an international intergovernmental organization, the International Bureau inquired whether the protection of the previously communicated signs was maintained. Consequently, the number of obsolete abbreviations and names of international intergovernmental organizations in the database would not appear to be significant.

306. The SCT recommended that each Member of the Paris Union undertake, when resources permit, a review of the signs communicated on behalf of that Member, in order to determine whether protection is still required or if any details needed to be updated.

Draft Requests

307. The Delegation of Austria suggested that a reference to the indication of goods and services in respect of which the official signs and hallmarks were used, be added in the field of enclosures of the draft request by a State.

308. The Delegation of Spain asked whether the goods and services would be indicated in the draft request by a State or in the annex to that request.

309. In reply to a question of the Delegation of Spain the Chair explained that the goods and services would not be indicated in the draft request by a State but in the annex to that request. However, a reference to the goods and services indicated in the annex would be inserted in the draft request.

310. The Delegation of the United States of America sought clarification as to whether the International Bureau accepted the category of the sign indicated in the request for communication or whether it questioned the eligibility of the sign.

311. The Secretariat indicated that, under the current administrative practice, the International Bureau required that the requesting party indicate the category of sign under Article 6*ter* for which protection was claimed. However, the International Bureau did not refuse to communicate a given sign on the basis of the category indicated for that sign, since that decision was ultimately within the responsibility of the States that received the communication.

312. In reply to a question raised by the Delegation of the Republic of Korea, the Chair explained that the annexes to the draft requests by international intergovernmental organizations and by institutions or programs established by an international intergovernmental organization or by a convention constituting an international treaty were identical.

313. The SCT expressed agreement with Annexes I to III of document SCT/17/5 with the following changes:

- The request for the communication of official signs and hallmarks indicating control and warranty should include a reference to the enclosed list of goods and services to which that official sign or hallmark pertains.
- The enclosure should contain contact details of the requesting party.

314. Furthermore, the SCT requested the Secretariat to prepare a document for the eighteenth session of the SCT containing a status report on the implementation of the recommendations concerning Article 6ter agreed at the current session, including, where necessary, a proposal for decision by the Paris Union Assembly.

Agenda Item 6: Industrial Designs

Questionnaire Relating to Formalities of Industrial Design Registration

315. Discussion was based on document SCT/17/6.

316. The Chair suggested that the Standing Committee go through the questionnaire section by section, with the purpose of clarifying all areas covered or for including additional questions, where necessary. The overall aim was to finalize the questionnaire at the current session and request the Secretariat to circulate it thereafter, providing a deadline for delegations to reply by November 2, 2007. The Chair asked for comments of a general nature.

317. The Delegation of Denmark said that it was difficult to answer some of the questions simply with “yes” or “no” and therefore, it would appreciate having the possibility to include explanatory remarks to certain questions. That would facilitate getting more correct and accurate responses to the questionnaire.

318. The Secretariat clarified that, in general, the questionnaire was structured in a manner that would facilitate the evaluation of replies. This was based on the experience acquired from the Questionnaire on Trademark Law and Practice, where the Secretariat was faced with the difficult task of evaluating and summarizing written replies from several delegations on a single question. However, at the current session delegations would have an opportunity to correct any ambiguity that they would detect in the questionnaire.

319. The Chair noted that it should be clarified from the outset that, while the results of the questionnaire on design would be as useful as those of the questionnaire on trademark law and practice, they should not be considered a universal guideline on the law of design in the different jurisdictions. The analysis should serve to look at broad differences between types of systems rather than providing detailed information about every single jurisdiction.

320. The Representative of the European Community clarified that the European Community had submitted in writing a list of additional questions. The Representative said that these questions could be divided in three types: firstly, yes/no questions, secondly, questions that if

answered as “yes” percentages would be required and thirdly “free text” questions. In view of the discussion, the European Community would not insist on maintaining either the free text questions or the questions requiring information on percentages. The Representative added that he would appreciate it if the Secretariat could reproduce and distribute the written paper of the European Community among the members of the Standing Committee.

321. The Delegation of Germany said that it also had a written list of comments on the questionnaire. The list concerned only a number of points and therefore the Delegation wished to submit that written paper to the Secretariat, as it had been suggested by the Representative of the European Community, without expecting each individual issue to be discussed by the Committee. As a general point, the Delegation suggested to add a category “non-applicable” to the existing yes/no possible replies.

322. The Delegation of Spain said that while it agreed with the Secretariat that evaluating yes/no questions was easier, in some cases providing additional information would facilitate the evaluation.

323. The Delegation of the Russian Federation indicated that the draft questionnaire was a sound basis for further work. However, it had some proposals for additional questions. Firstly, it suggested adding a new section on the possibility of introducing changes to the industrial design, which would deal with the formulation and the submission of the industrial design. Secondly, questions dealing with the transmission of rights in an industrial design and the right to use and apply the design. Thirdly, the possibility of providing additional comments to some of the questions. This would allow that Delegation to provide details on particular aspects of national legislation, for example regarding the representation of the industrial design itself.

324. The Delegation of Japan said that it considered it meaningful for the questionnaire to recognize the differences among the design registration systems of members. If the questionnaire could provide information concerning each registration system, it would significantly contribute to a discussion of those differences. The Delegation announced that it would submit a concrete proposal for amending the draft questionnaire after the seventeenth session of the SCT and provided some key points of that proposal. Firstly, the Delegation explained that the history and legal meaning of design was different in several member countries. So was the procedure for obtaining design rights, particularly between countries which had a substantive examination system and others which did not. This should be an essential part of the survey. Finally, it would be useful to inquire on how to legally distinguish design and trademark rights.

325. The Chair noted that the issues raised by the Delegation of Japan concerned questions of substantive law, while the current content of the questionnaire concerned the formalities of industrial design registration and the borderlines between design and all types of marks. In view of the suggestions made by the Delegation of Japan, the Standing Committee would have to decide whether or not it wished to enhance the scope of the questionnaire to cover those issues.

326. The Delegation of Germany pointed out that, drawing from the experience of trademark law, it had proved to be successful dealing separately with formalities and issues of substantive law. In that light, it was probably preferable to keep the current draft as simple as possible and reserve substantive issues for a later stage.

327. The Delegation of the Republic of Korea said that if the Delegation of Japan could circulate its proposal at the current session, Delegations would be able to decide on whether or not to include these issues in the questionnaire.

328. The Delegation of Japan noted that, since this was the first time that an inquiry in the field of industrial design was circulated, it was important that it should have a very large scope. That was considered important for Japan and for all Member States.

329. The Delegation of Uruguay said that although the proposal made by the Delegation of Japan was interesting, it might not be appropriate at this stage, as it was pointed out by the Delegation of Germany. The draft questionnaire submitted to the current session of the Standing Committee covered only the official procedures for registration of industrial designs.

330. The Representative of CEIPI, speaking also on behalf of ATRIP, mentioned that there was perhaps an important point in the proposal made by the Delegation of Japan. In the opinion of the Representative, it was useful to know the basis of national legislation and practice. The replies to the questionnaire would be better understood if the background of the system was also known. Therefore, the question of timing was important and it would be regrettable to postpone this basic question for a long time. The Representative thought that the issues could be covered, perhaps through a separate questionnaire, but they should not be delayed for too much longer. He noted that there was a clear interest from all the stakeholders, and particularly the creators of designs.

331. The Chair suggested that, in view of the comments made, the SCT could ask the Secretariat to develop a second questionnaire covering the issues suggested by the Delegation of Japan. This separate questionnaire would be submitted to the eighteenth session of the Standing Committee in November 2007, and delegations would be asked to submit their replies shortly after that meeting, in order to allow consideration of the replies during the nineteenth session of the SCT in May 2008.

332. The Delegation of Spain held the view that although the proposal made by the Delegation of Japan was interesting, it might delay the proceedings in relation to the questionnaire as it had been presented to the meeting. The Delegation supported the suggestion made by the Chair to issue a separate questionnaire, which would be circulated to national offices at a later stage.

333. The Delegation of Australia said that while it did not support an in-depth inquiry with regard to substantive examination, it believed that two questions could be added to the questionnaire to achieve the objectives being discussed. Firstly, the questionnaire seemed to have been based on the assumption that substantive examination occurred prior to the actual registration of rights, while that was not the case in all jurisdictions. A question could be added as to whether substantive examination did or did not occur prior to registration and if substantive examination was provided for in national jurisdictions, whether it applied to all industrial designs. A second question could relate to the fact that in certain jurisdictions, it was possible that substantive examination take place post-registration, as an invalidation mechanism. The Delegation believed that these two questions, that would still relate to the procedure of design registration, might provide a context for any subsequent work to be done in relation to the substantive examination requirements.

334. The Delegation of the Ukraine supported the proposal by the Chair to separate the work in two stages. The Delegation declared that, from a study of the legislation in different countries, it was apparent that in many of them, there was either no substantive examination or examination of only some industrial designs. There was at times some confusion with regard to three-dimensional signs. The Delegation concluded that receiving the result of the questions presented by Japan in May 2008 did not seem like an unreasonable deadline.

335. The Delegation of Japan declared that it would submit a concrete proposal through the SCT Electronic Forum soon after the seventeenth session of the SCT for discussion at the next session of the Standing Committee.

336. The Chair said that, at its next session, the SCT would discuss the proposal to be submitted by the Delegation of Japan and decide how to proceed with it. The Chair also asked whether delegations wished to comment the suggestion made by the Delegation of Australia.

337. The Delegation of the Republic of Korea declared that recently the private sector in Korea had started to emphasize the importance of managing and protecting designs. The Korean Intellectual Property Office (KIPO) had broadened the scope of design protection to include typographic icons in a monitor. The terminology used in national legislation had been changed from “industrial design law” to “design protection law”. In this context, the Delegation wondered whether the Committee could consider changing “industrial design” for “design”. The Delegation suggested adding a question to the questionnaire on this very point. The Delegation noted that the summary of replies to the questionnaire would indicate how many countries had adopted examination systems. In this connection, it would also welcome the proposal announced by the Delegation of Japan.

338. The Chair said that perhaps some of the information mentioned by the Delegation of the Republic of Korea could be provided in the replies to the questions suggested by the Delegation of Australia and noted that there seemed to be no objection to include them in the questionnaire. The Chair then asked whether other delegations had general comments.

339. The Delegation of the Russian Federation said that, in its view, the ultimate purpose of the questionnaire was to prepare a document that would harmonize the formalities for design registration. The notion that such a document could be presented in the form of a recommendation had been discussed in previous sessions of the SCT. The Delegation noted, however, that formalities were linked to the type of examination system contemplated in national legislation. For example, in countries that had substantive examination, there were usually very stringent requirements for presenting the object for which protection was sought. Therefore, the Delegation believed that the questionnaire should take into account the questions suggested by the Delegation of Japan.

340. The Chair noted that if the Committee had accepted the questions proposed by the Delegation of Australia, it seemed that the answers to those questions would provide information about the nature of the design system, as requested by the Delegation of the Russian Federation.

341. The Representative of INTA referred to the comments made by the Delegations of Denmark, Germany, the Russian Federation, and by the Representative of the European Community in relation to the possibility of adding comments or replacing a “yes/no” question

by a comment. The Representative noted that it was not always easy or even possible to answer yes or no to a given question and it was necessary to qualify the answers. Nevertheless, the Representative acknowledged that it would be difficult to compile such answers and suggested a compromise solution. In his view, the possibility to add a comment should be provided for every question. However, the document to be prepared by the International Bureau would simply make a reference to the effect that a comment was made by one or more delegations. The actual comments would only appear in the answers to the questionnaire, which could be published on the SCT Electronic Forum Website. In that manner, there would be no additional compilation work, but the possibility of adding comments would be retained.

342. The Delegation of Sweden suggested that, rather than providing that comments could be added generally to every point of the questionnaire, the SCT could review each individual question and try to assess whether a third or fourth alternative should be added to the question or if there was any other solution.

343. The Delegation of Chile expressed the view that it should be up to each country to make a determination on whether it wishes to add a comment to the questionnaire. However, if countries were to include a position supplementing the yes/no answers, it would be up to the Secretariat to interpret those positions. The Delegation did not believe that was appropriate.

344. The Delegation of the United Kingdom supported the comment made by the Delegation of Chile and added that a balance needed to be drawn between the resources of the Secretariat and the usefulness of the questionnaire. The Delegation noted that the “at a glance” nature of the questionnaire was very useful and added a lot of value to an international comparison. However, where a delegation could not simply answer a question by yes or no, it would be useful to add a comment, but it was probably worth drawing from the INTA recommendation that the SCT should not expect the Secretariat to prepare an analysis of those exceptions, but to simply provide the information on the website.

345. The Chair said that it flowed from the discussion that SCT Members agreed it was important to retain the capacity to make additional comments to the questionnaire. However, those comments would not be included in the body of the questionnaire itself but at the end, or in the form of an attachment containing comments to specific questions. That information would not form part of the analysis by the International Bureau, but it would be made available as an additional submission on the SCT Electronic Forum or in some other way upon request.

346. The Delegation of Ecuador supported the proposal made by the Delegation of Chile and said that it would be useful to set a short deadline for replies to be sent to the Secretariat, so that the summary document could be processed soon.

347. The Representative of the APAA declared that he wished to suggest a number of additional questions at a later stage. However, in one area, he wished to ascertain the feeling of the Committee as to whether those questions were appropriate for inclusion in the questionnaire. The questions concerned claims to being party to a Convention, typically the Paris Convention. In this connection, the Representative believed that it would be valuable to know how each industrial design office would process claims to priority as to form and

procedure. For example, where the basic application originated in a country with quite a different design law, there could be uncertainty in the case where one country allowed multiple designs and another country did not.

348. The Chair noted that there was no objection to the proposal made by the Representative of the APAA. Since there were no more general comments, the Chair suggested reviewing the questionnaire by groups of questions. He also recalled that the Delegations of Germany and Norway and the Representative of the European Community had submitted written comments to a number of questions and those comments would be taken up as part of the review.

Questions 1 to 3

349. The Representative of INTA suggested dividing the first item of question 1 in two items “black and white photographs” and “color photographs”, because in some jurisdictions, an authorization was required to supply the latter. The Representative noted that this could be an example of a reply where an additional comment could be provided.

350. The Representative of ECTA proposed to modify the last item of question 1 from a yes/no option to “other graphic representations, namely” and provide space for an enumeration.

351. The Chair noted that, on these questions, there were comments from the Delegation of Norway and the Representative of the European Community.

352. The Representative of CEIPI, speaking also on behalf of ATRIP, said that the suggestion made by the Delegation of Norway to add “a specimen” to the list of options in question 1 was not clear and wondered if the Delegation could provide an explanation.

353. The Delegation of Norway explained that its proposal for adding “specimen” to question 1, in fact meant a “three-dimensional model or reproduction of the design”. Thus if the latter wording could be included as another option, the Delegation would withdraw its original proposal on question 1.

354. The Delegation of Latvia said that the new proposal made by the Delegation of Norway was not equivalent to its original proposal, because a specimen was a sample of a product and not a model.

355. The Secretariat explained that, at least in the framework of The Hague Agreement Concerning the International Registration of Industrial Designs, a basic distinction was made between the reproduction of the design and the specimen. The former consisted of a two-dimensional reproduction, such as a graphic or photographic reproduction, a drawing or a picture, but in any event, something that could be published. The specimen might be filed with the application, but it was a sample of the design and the applicant would still need to provide a reproduction of the design for its publication in the Gazette. The Secretariat noted that, taking into account that under some systems and certainly under the Hague System, it was possible to file “in lieu” of a reproduction a specimen in two-dimensions or in three-dimensions, a separate “category (c)” was provided for in the questionnaire and thus it would not be advisable to deal with this question in Section I(a)(i), which concerned reproduction in general.

356. Following the discussion on this point, the Delegation of Norway withdrew its proposal on question 1.

Questions 4 to 9

357. The Delegation of Sweden suggested adding a second item to question 7 as follows: “detailed views of the industrial design are permitted, yes/no”. The Delegation explained that, according to design law experts in Sweden that would be a relevant question, at least for the European Community countries.

Questions 10 and 11

358. The Delegation of Sweden proposed adding a third option in question 11: “generally not permitted, yes/no”.

Questions 12 to 19

359. The Delegation of Spain suggested a change in terminology in the Spanish version, in the first line of question 15, to read “...*productos sobre los que se aplica o incorpora un diseño industrial*”.

360. The Delegation of Chile supported the views expressed by the Delegation of Spain and said that perhaps “*se aplica*” is closer to the other language versions.

361. The Delegation of Germany recalled its written comments on questions 12 and 13 regarding the term “design specimen”. The Delegation declared that it had problems with this formulation, because according to national law submissions of three-dimensional designs were not permitted. In certain cases two-dimensional designs could be submitted optionally, for example in the case of deferment of publication. The Delegation further noted that it would not be able to answer any of the questions dealing with specimens (i.e., questions 12, 13, 28 and 30), unless an explanation were added as to the meaning of specimen.

362. The Representative of CEIPI, speaking also on behalf of ATRIP, referred to the comments made by the Delegation of Spain and suggested to align the text of question 15 in the three languages with The Hague Agreement as follows: “an indication of the product or products which constitute the industrial design or in relation to which the industrial design is to be used”. He further suggested replacing the last word in the French text “*abrégé*” for “*abstrait*”, which would correspond better to the formulation of the English text “in the abstract”.

363. The Delegation of Australia, referring to the comment made by the Delegation of Germany in relation to question 12, suggested adding an extra entry “generally not permitted for three-dimensional designs”. The Delegation explained that “generally” would mean that the design office would not wish to be obliged to store the actual physical specimens of three-dimensional designs, which could be quite voluminous and it would therefore deter applicants from submitting them. While an office might generally wish to deny submission of designs, in some instances, only three-dimensional designs would not be permitted.

364. The Delegation of Sweden said that similarly to the Delegation of Germany, it had difficulties with question 13 and suggested adding a new option “other,” and then drawing a line to give the opportunity of including text.

365. The Delegation of Germany expressed support for the proposal put forward by the Delegation of Sweden but declared that it did not resolve its problem. The Delegation explained that according to German law, the specimen could only be submitted in the case of deferment of publication. Thus, the answer to the third dash of question 13 would be “yes”, but only for two-dimensional samples, for example a piece of cloth and not for three-dimensional samples, since it was not possible to submit them in any case.

366. The Secretariat explained that the idea in question 12 was simply to research whether it was possible to submit a design specimen instead of a reproduction of the design and then whether it was possible to submit two or three-dimensional designs. The Secretariat proposed to restructure the different items of the question to that effect and to ask whether there were limitations to submitting specimens or whether they were not permitted at all. It followed from the discussion that most offices did not wish to receive three-dimensional design specimens but it was worth researching that very point through the questionnaire.

367. The Delegation of Chile suggested dividing question 12 in two sub-items that would deal separately with two and three-dimensional designs. The Delegation explained that the law in Chile did not consider two-dimensional designs, thus the two categories should be set aside. The Delegation also noted that it would help to add a clarification as to whether one is referring to a physical specimen or to the representation thereof.

368. The Secretariat noted that question 12 could be further clarified if it were broken down into two points: firstly to ask whether the submission of a design specimen was possible yes/no and then, if it was possible to ask a further question as to whether it is possible to provide two-dimensional designs only or two-dimensional and also three-dimensional designs.

369. The Delegation of the Russian Federation proposed to indicate the nature of the specimen in question 12. According to the Delegation, the specimen was an ideal or theoretical object, thus, in fact, one could only speak about the reproduction or the representation as such of that specimen, because the specimen was not an object *per se*.

370. The Secretariat clarified that the mere idea of a specimen or a sample of the design was different from the reproduction, which was normally in two dimensions and consisted in either a photograph or an image, on paper or in electronic form that was filed with the office for the purposes of examination and publication. The Secretariat noted that many offices did not receive samples or specimens of the design, although others did, and therefore the question was included to cover all possible situations. However, it seemed clear that the two things were different and were thus treated in different items of the questionnaire.

371. The Delegation of Germany suggested adding a fourth dash in question 14 for “other”, because national legislation contemplated a consequence different than those listed in that question.

372. The Delegation of Spain said that “heading (e)” which appeared before question 17 in the Spanish version, should read “*solicitud de registro múltiple*”, and that correction should also be reflected in the index.

373. The Delegation of Germany sought clarification as to whether question 13 would be further redrafted.

374. The Chair suggested that the Delegation of Germany discuss with the Secretariat any further changes to the formulation of this question.

Questions 20 to 27

375. The Delegation of Australia suggested to preface questions 21 and 22 with a requirement that the answer to question 20 was “yes”. Otherwise, the way in which those questions were answered might in fact obscure the analysis.

376. The Delegation of Switzerland declared that national legislation in Switzerland did not provide for the possibility of “claims”. The Delegation believed that this could also be the case for the legislation of other countries. Therefore, it suggested rewording question 20 to indicate at the beginning “in the case that the national legislation has the concept of claims” or some other similar formulation.

377. The Chair noted that there could be a number of cases in which this type of formulation should be inserted and wondered whether a general instruction could be provided at the beginning of the questionnaire to the effect that where the question was not relevant or applicable according to national law, the responding office should leave it blank. If offices were to provide negative answers where the question did not concern them, this would distort the analysis.

378. The Delegation of Switzerland agreed with the proposal made by the Chair and noted that the questionnaire should be easy to read and yield the most results possible. Thus, if a clear instruction were included at the beginning of the questionnaire indicating that delegations need not answer questions with which they were not concerned, it would not be necessary to spell that out for each question.

379. The Delegation of the Russian Federation supported the comment made by the Delegation of Switzerland in relation to question 20 and noted that the concept of “claim” was not contemplated in the legislation of the Russian Federation.

380. The Chair recalled that with regard to this question too, a general instruction at the beginning of the questionnaire would clarify that if the Delegation did not answer this particular question, it meant that it was not relevant or applicable according to national law.

381. The Delegation of Chile suggested adding another dash in question 23 for “other requirements”, to perhaps complement with other requirements as provided by national legislation.

382. The Delegation of Australia supported the proposal made by the Delegation of Chile. The Delegation noted that questions 23 to 27 had a strong emphasis on the “creator” of the design, while at least in Australia, there were several other requirements relating to the “owner” of the right. The Delegation suggested to include questions relating to the actual owner of the design right.

Questions 26 and 27

383. The Delegation of Germany asked whether on its written proposal dealing with the creator of the design, it should provide a written text or whether it would be sufficient to discuss bilaterally with the International Bureau.

384. The Chair suggested that the Delegation of Germany provide a specific text to the Secretariat where necessary, or that it simply agree with the latter the nature of the change to be proposed, leaving the formulation of the actual wording for a later stage.

Questions 28 and 29

385. The Delegation of Spain suggested the following changes in the Spanish version of question 28: the end of the second bullet should read “... *mandatario, en su caso*”, the sixth bullet should read “...*productos sobre los que se aplica o incorpora el diseño*” and the ninth bullet should read “...*representante, en su caso*”.

386. The Delegation of Austria sought clarification as to whether question 29 referred to the indications and elements required for a filing date.

387. The Chair confirmed that this was the sense of the question and proposed adding the phrase “, in order to secure the filing date,” at the end of the sentence.

Question 30

388. The Delegation of the Russian Federation said that in relation to questions 28 and 30, it wished to include as a mandatory reply whether the application contains a request for the legal protection of the industrial design. The Delegation noted that a similar requirement existed in the law of several countries. The Delegation also noted that in question 30, bullets 8 and 9 seemed to be identical to bullets 17 and 18. These indications should either be deleted or a footnote should be included to indicate the difference.

389. The Chair explained that indeed bullets 17 and 18 seemed to duplicate the information already requested under bullets 8 and 9 and should therefore be deleted.

390. The Delegation of Singapore proposed including another bullet in question 30 as to whether a local address for service could be required. The Delegation clarified that this was a requirement under the law of Singapore.

391. The Delegation of Spain suggested to consider numbering the bullets, especially in questions that have a large number of options. The Delegation explained that this could facilitate referencing the replies. The Delegation also suggested to change the wording of bullet 11 in the Spanish version to read “...*productos sobre los que se aplica o incorpora el diseño industrial*” and bullet 13 to read “...*las solicitudes múltiples*”.

392. The Delegation of Sweden supported the suggestion made by the Delegation of the Russian Federation regarding questions 28 and 30.

Question 31

393. The Chair recalled that in relation to question 31, there was a request from the Delegation of the European Community to include two optional replies, as reflected in its written submission.

394. The Delegation of Switzerland suggested to split the last bullet of question 31 in two different items, one dealing with conflicts with Article 6ter of the Paris Convention and another dealing with conflicts with other international conventions according to national law.

395. The Delegation of the Republic of Korea said that in relation to question 31, it was necessary to clarify the meaning of bullet 3 “original” and bullet 4 “differs significantly from known designs” or to add another bullet after line 4 to read “cannot be easily created by combining two or more known designs”. The Delegation clarified that this question might relate more significantly to States that have a pre-registration examination system. However, the issue might also relate to the opposition procedure, for example in question 39. The Delegation explained that in the past, the Korean Patent Office did not examine whether a design could have easily been created by combining two or more preexisting designs. This was a strikingly different feature of Korean design examination practice from patent or utility model examination practice where the satisfaction of “non-obviousness” or “inventive step” criteria was usually decided by combining two or more pre-existing inventions. The Delegation noted that the Design Protection Law of Korea was amended in 2004 and examiners currently considered that where a design could be easily created by combining two or more pre-existing designs, it could not be registered. The Delegation wondered whether this situation existed in the practice of other Member States.

Question 32

396. The Chair drew the attention of the Standing Committee to the written comment presented by the Delegation of Norway, to add in question 32 a phrase similar to that stated in question 33 to read “as to novelty or originality”.

Question 34

397. The Chair noted that the proposal contained in the written submission by the Delegation of the European Community was accepted.

Questions 35 to 42

398. The Delegation of Germany suggested that the title of heading (b) be changed to read “Opposition Procedures Before the Office”.

399. The Chair noted that, in its written submission, the Delegation of the European Community had suggested adding optional replies to question 39 and a new question to this section. The Chair also recalled that, following the intervention by the Delegation of the Republic of Korea, a fourth bullet should be added in question 39 to read “can be easily created by combining two or more known designs”.

400. The Delegation of Sweden said, in relation to question 41, that in Sweden oppositions are examined both by a legal officer and an examiner and therefore it would like to have a fourth bullet in that question to read legal officer and examiner or to put “other,”.

401. The Chair said that perhaps “other,” was a preferable solution, as there seemed to be a number of other variations when it came to examination.

Questions 43 to 47

402. The Delegation of Australia suggested adding two possible replies to question 43 as to whether the design was published at filing or at registration. The Delegation explained that in several jurisdictions different elements of the industrial design were published at different points in time. For example, at filing, applicants might simply file the bibliographic information of the design but not the representations themselves and those representations, for instance, were provided at a later point in time, either following examination or at the point of registration.

403. The Delegation of Switzerland suggested adding another bullet in question 45 to read “X times per month”. Even though the reply would be close to that of the second bullet, there could be a difference in the periodicity of the publications.

Questions 48 to 52

404. The Delegation of Switzerland suggested adding a new question after question 52, to read “If the period of grace is not observed, does a procedure exist to restore the industrial design which may have meanwhile lapsed? yes/no”. The Delegation noted that national law in Switzerland provided for this possibility to resume the procedure, even if the period of grace had lapsed. There was in fact a dual period of grace.

Questions 53 to 56

405. The Delegation of Switzerland suggested adding a new question after question 53 to read “The effect of the recordal of a license is: bullet 1 declaratory, yes/no and bullet 2 constitutive, yes/no”.

Questions 57 to 61

406. The Delegation of Sweden suggested adding two new possible replies in questions 57 and 59, to read: “the number of classes claimed” and “the filing of a specimen”.

407. The Delegation of Germany suggested adding the following phrase at the beginning of question 58 “If the applicable law provides for opposition procedures,”. This structure would be similar to that in question 61.

Questions 68 to 69

408. The Delegation of the United Kingdom asked for clarification from the Secretariat as to the context in which question 69 was posed. The Delegation explained that its preliminary reading of this question was that it referred to cumulative rights (first patents and then designs). However, it did not seem entirely clear whether it referred to a coexisting application.

409. The Secretariat explained that the intention of question 69 was to cover only industrial design regimes as such and restrict this question to design patents, registered industrial design and *sui generis* unregistered industrial design regimes. At the start, there was no information as to whether these regimes could be cumulative, since in most cases, where there was a design patent system, there would not be a registered design system and vice versa. The Secretariat suggested clarifying the heading of question 69 to state “the protection of an industrial design as such...” and by changing the last bullet to read “...unregistered *sui generis* industrial designs.”

410. The Representative of CEIPI, speaking also on behalf of ATRIP, wondered whether in light of the explanations provided by the Secretariat, it would be necessary to move question 69 to a different section of the questionnaire, since Chapter VI dealt with borderlines with trademarks. The Representative noted that the points covered by the question seemed well justified but keeping them in the current place might lead to misinterpretations.

411. The Chair suggested leaving it up to the Secretariat to find the appropriate place for question 69.

412. The Delegation of the United Kingdom declared that it would submit drafting comments to the Secretariat on question 69.

Questions 70 to 73

413. The Delegation of Mexico suggested redrafting question 70 in the Spanish language. As currently drafted, the heading of this question already stated that subject matter that is dictated essentially by technical or functional considerations “cannot” enjoy protection, and it would not seem appropriate to then ask yes or no.

414. The Chair noted that the sense of that question in English also seemed to be in the negative although the intent of the question seemed to be clear. The Chair suggested asking the Secretariat to harmonize the drafting in the three working languages.

Questions 74 to 76

415. The Delegation of Slovenia suggested adding questions concerning appeal procedures against the decision by the competent authority. The Delegation suggested looking into the corresponding section of the Questionnaire on Trademark Law and Practice (document WIPO/Strad/Inf.1).

416. The Chair requested the Delegation of Slovenia to provide its drafting suggestions to the International Bureau in writing.

417. The Delegation of Austria sought clarification as to the background of questions 74 to 76.

418. The Secretariat recalled that at the sixteenth session of the Standing Committee, the Secretariat was asked to draft a questionnaire only on procedural aspects of design registration, but as the meeting went on it was decided to add questions to further explore the borderlines between all types of marks and industrial designs (as stated in paragraph 27 of document SCT/16/8). However, it seemed that in particular questions 74 to 76 looked at the question of overlapping protection from the point of view of applying or enforcing the law in the courts rather than from the point of view of registration procedures. The Secretariat considered that the wording of these questions could be further clarified in the final version of the questionnaire, by also including language to be proposed by the delegations. Another option would be to remove the whole of Chapter VI and place it in the second questionnaire that would cover some questions of substance.

419. The Delegation of the Russian Federation thanked the Secretariat for the explanations given. The Delegation noted, however, that questions 75 and 76 seemed extremely complex and suggested that examples be given to clarify their intent.

420. The Chair noted that there was a suggestion to move these questions to the second questionnaire. This would allow the Secretariat to improve the text, which would be considered by the Standing Committee at the next session, so that the intent of the questions was clear.

421. The Delegation of Germany said that after having listened to previous speakers it had a preference to defer this set of questions for inclusion in the second questionnaire.

422. The Representative of OAPI said that in the legislation of a number of African countries and namely among members of OAPI, there was a principle of design being much closer to copyright law, thus protection was virtually automatic. The Representative noted that in most of these countries, there could be coexisting protection under design and copyright law. Therefore, it would be useful to include questions regarding the possibility of that coexisting protection.

423. The Delegation of Chile considered that the section starting with question 68 should be in a separate questionnaire. The Delegation supported the views expressed by the Representative of OAPI and said that the question of coexisting protection between design and copyright deserved to be treated in greater depth.

424. The Secretariat noted that in relation to the issues raised by the Delegation of Chile and the Representative of OAPI, work had already been undertaken by WIPO in document SCT/9/6, which looked at the relationship between industrial designs, three dimensional marks and works of applied art. At the sixteenth session of the Standing Committee, it was decided to update and expand that document, also on the basis of the replies to the questionnaire on design and to present the revised document to the eighteenth session of the SCT. The Secretariat said that as it was noted by the Representative of OAPI, questions should be added in the questionnaire to cover the relation between design and copyright. The Secretariat invited delegations to provide those questions so that they could be compiled and submitted to the Standing Committee at its next session. On that basis, the Secretariat could work to update document SCT/9/6.

425. The Chair recalled that at the sixteenth session of the Standing Committee, several delegations expressed the view that document SCT/9/6 was out of date because the law had changed in their country. The end of April 2007 was set as a deadline to send submissions to the Secretariat indicating any changes to be made in that document.

426. The Chair said that before closing discussion on the questionnaire, he wished to ask delegations to make any general comments or indicate any other points which they would like to see included in the questionnaire.

427. The Delegation of Paraguay said that in dealing with the borderlines between design and copyright, it would be important to look at the term of protection in each of those fields, as well as in trademarks. In the legislation of Paraguay, industrial design was protected for a maximum of 15 years, which were made up of three periods of five years each, while trademarks and copyright had significantly longer protection periods.

428. The Delegation of the Russian Federation suggested including questions that would deal with certain accessories, for example furniture, applications on furniture, drawings on porcelain or on dishes. The Delegation also suggested including elements which were not apparent, as they were found inside other objects.

429. The Chair said that the Secretariat had taken note of the suggestion made by the Delegation of the Russian Federation and would endeavor to include questions on that issue. However, it would be helpful if that Delegation or any other interested Delegation would provide input on these rather substantive issues for inclusion in the second questionnaire.

430. The SCT agreed to request the Secretariat to modify the questionnaire according to the proposals made by Members of the Committee.

431. The SCT agreed that the revised questionnaire would be distributed to Members as soon as possible. Replies to the questionnaire should be provided to the Secretariat by November 2, 2007. The Secretariat would present a document based on these replies to the nineteenth session of the SCT in May 2008.

432. The SCT further agreed that Members would provide additional questions to the Secretariat for inclusion in a second questionnaire dealing with substantive issues such as those suggested by the Delegations of Japan and Slovenia, and the issues relating to the borderline between industrial designs and other intellectual property rights, in particular copyright. Questions should be provided to the Secretariat by the end of June. The Secretariat would present the second questionnaire to the eighteenth session of the SCT with a view to having the results of both questionnaires available at the nineteenth session.

Agenda Item 7: Geographical Indications

433. The Chair noted that there were no working documents or proposals for discussion at this meeting.

Eighteenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/18)

434. The Chair announced as tentative dates for SCT/18, November 12 to 16, 2007.

[Annexes follow]

ANNEX I

WIPO



SCT/17/7

ORIGINAL: English

DATE: May 11, 2007

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

**Seventeenth Session
Geneva, May 7 to 11, 2007**

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. Mr. Ernesto Rubio, Assistant Director General, opened the session and welcomed the participants on behalf of the Director General of WIPO.
2. Mr. Marcus Höpferger (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 2: Election of a Chair and two Vice-Chairs

3. Mr. Michael Arblaster (Australia) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) for the year 2007. Mr. Maximiliano Santa Cruz (Chile) and Mr. Louis Chan (Singapore) were elected as Vice-Chairs for the same period.

Agenda Item 3: Adoption of the Agenda

4. The SCT adopted the Draft Agenda (document SCT/17/1 Prov.) without modifications.

Agenda Item 4: Adoption of the Draft Report of the Sixteenth Session

5. The SCT adopted the Draft Report of the Sixteenth Session (document SCT/16/9 Prov.2) with modifications as requested by the Delegations of Brazil, France, Italy, the Russian Federation, Sweden and the Representative of the African Intellectual Property Organization (OAPI).

Agenda Item 5: Trademarks

Methods of Representation and Description of New Types of Marks

6. The Chair concluded that the SCT had considered certain portions of document SCT/17/2 namely those relating to three-dimensional marks, color marks, and sound marks. The SCT noted that nothing in the document or the subsequent discussion implied an obligation on any Member to protect any type of mark.

7. The SCT requested the Secretariat to prepare a working document for consideration at its eighteenth session, taking into account the deliberations of the present session and presenting key learnings for Member States in relation to the representation of those types of marks that the SCT had considered during the seventeenth session. As regards the portions of document SCT/17/2 that could not be dealt with during the present session, the SCT would resume work at the eighteenth session.

8. The Committee further agreed to invite delegations that had not yet done so to make submissions on those subjects by the end of June 2007, at the latest.

Relation of Established Trademark Principles to New Types of Marks

9. The Chair concluded that the discussion of document SCT/17/3 was postponed to the eighteenth session of the SCT.

Trademark Opposition Procedures

10. Discussion was based on document SCT/17/4.

11. The Committee noted that document SCT/17/4 was designed as a basis for discussion and provided a broad overview of the key features of the different types of opposition procedures. To the extent that the document identified the approach in specific jurisdictions, it was purely illustrative and was not intended to serve as a comprehensive or authoritative guide.

12. The Committee noted that the additional information provided during the meeting would be reflected in the report, and accordingly decided not to revise the document.

13. The SCT requested the Secretariat to draft a new document for the next meeting setting out key learnings in this field. The first draft of this document would be drawn from:

- submissions already received;
- the report of the current session;
- and any further submissions from SCT Members specifically addressing the issue of key learnings.

14. The SCT further requested the Secretariat to provide a draft of the document which would be posted on the SCT Electronic Forum by August 11, 2007, seeking comments from Member States to be used for the final version of that document.

Article 6ter of the Paris Convention

15. Discussion was based on document SCT/17/5.

Relevant Contact Details Concerning the Requesting Party

16. The SCT recommended that contact details be provided as part of the communication under Article 6ter(3)(a) and (b) in order to enable offices and third parties to contact the beneficiary of protection.

17. With regard to existing communications, the SCT requested the Secretariat to invite States and International Intergovernmental Organizations (“IGOs”) to provide contact details for the sake of completeness.

Information Concerning the Constituting Charter or Agreement of International Intergovernmental Organizations

18. The SCT recommended that the communications from IGOs should contain a reference to a website where the constituting agreement or charter of a given IGO could be accessed. This information could also be obtained by requesting it from the International Bureau which would provide it, for example, in paper form or PDF format.

Information on the Nature of Goods and Services on Which Official Signs and Hallmarks are Used

19. The SCT recommended that an indication of the goods and services should be a standard requirement for communications in relation to official signs and hallmarks indicating control and warranty.

Electronic Communication

20. The SCT noted that the existing paper-based communication procedure should not be replaced by electronic means of communication. However, the Committee agreed to ask the Secretariat to implement the option outlined in paragraph 25 of document SCT/17/5 (i.e., individual download from FTP server), it being understood that this would allow Contracting Parties to the Paris Convention to download this information monthly.

Review of Existing Communications

21. The SCT recommended that each Member of the Paris Union undertake, when resources permit, a review of the signs communicated on behalf of that Member, in order to determine whether protection is still required or if any details needed to be updated.

Draft Requests

22. The SCT expressed agreement with Annexes I to III of document SCT/17/5 with the following changes:

- The request for the communication of official signs and hallmarks indicating control and warranty should include a reference to the enclosed list of goods and services to which that official sign or hallmark pertains.

- The enclosure should contain contact details of the requesting party.

23. Furthermore, the SCT requested the Secretariat to prepare a document for the eighteenth session of the SCT containing a status report on the implementation of the recommendations concerning Article 6ter agreed at the current session, including, where necessary, a proposal for decision by the Paris Union Assembly.

Agenda Item 6: Industrial Designs

Questionnaire Relating to Formalities of Industrial Design Registration

24. Discussion was based on document SCT/17/6.

25. Following an extended exchange of views, the SCT requested the Secretariat to modify the questionnaire according to the proposals made by Members of the Committee.

26. The SCT agreed that the revised questionnaire would be distributed to Members as soon as possible. Replies to the questionnaire should be provided to the Secretariat by November 2, 2007. The Secretariat would present a document based on these replies to the nineteenth session of the SCT in May 2008.

27. The SCT further agreed that Members would provide additional questions to the Secretariat for inclusion in a second questionnaire dealing with substantive issues such as those suggested by the Delegations of Japan and Slovenia, and the issues relating to the borderline between industrial designs and other intellectual property rights, in particular copyright. Questions should be provided to the Secretariat by the end of June. The Secretariat would present the second questionnaire to the eighteenth session of the SCT with a view to having the results of both questionnaires available at the nineteenth session.

Agenda Item 7: Geographical Indications

28. The Chair noted that there were no working documents or proposals for discussion at this meeting.

Eighteenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/18)

29. The Chair announced as tentative dates for SCT/18, November 12 to 16, 2007.

[Annex II follows]

ANNEX II

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. MEMBRES/MEMBERS

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

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* Based on a decision of the Standing Committee, the European Communities were accorded member status without a right to vote.

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[End of Annex II and of document]