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

Ninth Session
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**PROPOSALS FOR FURTHER HARMONIZATION OF FORMALITIES AND
PROCEDURES IN THE FIELD OF MARKS**

Document prepared by the Secretariat

INTRODUCTION

1. The revised Program and Budget for 2002 -2003 includes under Sub -Program 05.2, “Law of Trademarks, Industrial Designs and Geographical Indications”, the following activities (see document WO/PBC/4/2, page 53):

“Convening of four meetings of the SCT (and any Working Group set up by this Committee) to consider current issues, including:

- the revision of the *Trademark Law Treaty (TLT)* to address, *inter alia*, the creation of an Assembly, inclusion of provisions on electronic filing, and the incorporation of the Joint Recommendation on Trademark Licenses; [..];

2. At its eighth session (May 27 -31, 2002), the International Bureau submitted the document SCT/8/2 to the SCT. The document SCT/8/2 contained suggestions of draft articles for consideration in the perspective of further harmonization of formalities and procedures in the field of marks, which could lead to a revision of the TLT. It took into account the developments of techniques and the need to further simplify formalities. Moreover, this document tried to harmonize the TLT provisions with similar provisions of Patent Law Treaty (PLT) adopted by WIPO Member States in 2000. After an extended discussion, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) decided that the International Bureau should revise document SCT/8/2 on articles 8, 13bis and 13ter.

3. The present document contains a revised version of the draft articles 8, 13bis and 13ter and related rules of the draft revised Trademark Law Treaty (“TLT”), as contained in Document SCT/8/2. It also contains explanatory notes related to these articles.

4. Pursuant to the decision of the SCT, Article 8 (Communications) has been amended and introduced two alternatives in paragraph (1): Alternative A reproduces the text as proposed in Document SCT/8/2 and Alternative B proposes a draft of this paragraph in the affirmative. Amendments to paragraphs (3), (4) and (5) are self-explanatory. With regard to Articles 13bis and 13ter, the International Bureau proposes two alternatives: Alternative A reproduces the text of these Articles as contained in Document SCT/8/2, with various amendments, notably the addition of a new paragraph (6); Alternative B proposes that Articles 13bis and 13ter be combined in one single new Article 13bis. The document also contains amendments to other articles, as discussed and suggested by the SCT at its last session.

5. Differences between the text of the draft articles and rules submitted to the eighth session of the SCT (Document SCT/8/2) and the revised text of the draft articles, rules and notes as contained in the present document have been highlighted as follows:

(i) words which did not appear in document SCT/8/2 but appear in the present document are underlined and

(ii) words which appeared in document SCT/8/2 but which are omitted from the present document are shown as struck through.

6. The articles which were not discussed at the eighth session of the SCT and were already highlighted in Document SCT/8/2 are reproduced as such in the present document.

7. *The SCT is invited to consider and comment on the proposals as contained in the Annex to this document.*

[Annex follows]

ANNEX

TrademarkLawTreaty

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Article 1
Abbreviated Expressions

For the purposes of this Treaty, unless expressly stated otherwise:

- (i) “Office” means the agency entrusted by a Contracting Party with the registration of marks;
- (ii) “registration” means the registration of a mark by an Office;
- (iii) “application” means an application for registration;
- (iv) (iibis) “communication” means any application, or any request, declaration, document, correspondence or other information relating to an application or a mark, whether relating to a procedure under this Treaty or not, which is filed with the Office;
- (v) reference to a “person” shall be construed as references to both a natural person and a legal entity;
- (vi) “holder” means the person whom the register of marks shows as the holder of the registration;
- (vii) “register of marks” means the collection of data maintained by an Office, which includes the contents of all registrations and all data recorded in respect of all registrations, irrespective of the medium in which such data are stored;
- (viii) “Paris Convention” means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, as revised and amended;
- (ix) “Nice Classification” means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised and amended;
- (x) “Contracting Party” means any State or intergovernmental organization party to this Treaty;
- (xi) reference to an “instrument of ratification” shall be construed as including reference to instruments of acceptance and approval;
- (xii) (...) Trademark Licenses abbreviated expressions (Article 1 (vii) to (xi) of the Joint Recommendation Concerning Trademark Licenses);
- (xiii) “Organization” means the World Intellectual Property Organization;
- (xiv) “Director General” means the Director General of the Organization;
- (xv) “Regulations” means the Regulations under this Treaty that are referred to in Article 17.

Article 2
Marks to Which the Treaty Applies

(1) [*Nature of Marks*]

(a) This Treaty shall apply to marks consisting of visible signs, provided that only those Contracting Parties which accept for registration three-dimensional marks shall be obliged to apply this Treaty to such marks.

(b) This Treaty shall not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks.

(2) [*Kind of Marks*]

(a) This Treaty shall apply to marks relating to goods (trademarks) or services (service marks) or both goods and services.

(b) This Treaty shall not apply to collective marks, certification marks and guarantee marks.

Article 3
Application

(1) [*Indications or Elements Contained in or Accompanying an Application; Fee*]

(a) Any Contracting Party may require that an application contains some or all of the following indications or elements:

(i) a request for registration;

(ii) the name and address of the applicant;

(iii) the name of a State of which the applicant is a national if he is the national of any State, the name of a State in which the applicant has his domicile, if any, and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;

(iv) where the applicant is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(v) where the applicant has a representative, the name and address of that representative;

(vi) where an address for service is required under Article 4(2)(b), such address;

(vii) where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with indications and evidence in support of the declaration of priority that may be required pursuant to Article 4 of the Paris Convention;

(viii) where the applicant wishes to take advantage of any protection resulting from the display of goods and/or services in an exhibition, a declaration to that effect, together with indications in support of that declaration, as required by the law of the Contracting Party;

(ix) where the Office of the Contracting Party uses characters (letters and numbers) that it considers as being standard and where the applicant wishes that the mark be registered and published in standard characters, a statement to that effect;

(x) where the applicant wishes to claim color as a distinctive feature of the mark, a statement to that effect as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color;

(xi) where the mark is a three-dimensional mark, a statement to that effect;

(xii) one or more reproductions of the mark;

(xiii) a transliteration of the mark or of certain parts of the mark;

(xiv) a translation of the mark or of certain parts of the mark;

(xv) the names of the goods and/or services for which the registration is sought, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification;

(xvi) a declaration of intention to use the mark, as required by the law of the Contracting Party.

(b) The applicant may file, instead of or in addition to the declaration of intention to use the mark referred to in subparagraph (a)(xvi), a declaration of actual use of the mark and evidence to that effect, as required by the law of the Contracting Party.

(c) Any Contracting Party may require that, in respect of the application, fees be paid to the Office.

~~(2) [Presentation] As regards the requirements concerning the presentation of the application, no Contracting Party shall refuse the application, if it is presented, subject to paragraph (3) and to Article 8, on a form corresponding to the application Form provided for in the Regulations.~~

~~(23) [Single Application for Goods and/or Services in Several Classes] One and the same application may relate to several goods and/or services, irrespective of whether they belong to one class or to several classes of the Nice Classification.~~

~~(34) [Actual Use] Any Contracting Party may require that, where a declaration of intention to use has been filed under paragraph (1)(a)(xvi), the applicant furnish to the Office within a time limit fixed in its law, subject to a minimum time limit prescribed in the Regulations, evidence of the actual use of the mark, as required by the said law.~~

~~(45)~~ [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (3) ~~and (5)~~ and in Article 8(2) and (3) be complied with in respect of the application. In particular, the following may not be required in respect of the application throughout its pendency:

- (i) the furnishing of any certificate of, or extract from, a register of commerce;
- (ii) an indication of the applicant's carrying on of an industrial or commercial activity, as well as the furnishing of evidence to that effect;
- (iii) an indication of the applicant's carrying on of an activity corresponding to the goods and/or services listed in the application, as well as the furnishing of evidence to that effect;
- (iv) the furnishing of evidence to the effect that the mark has been registered in the register of marks of another Contracting Party or of a State party to the Paris Convention which is not a Contracting Party, except where the applicant claims the application of Article 6 *quinquies* of the Paris Convention.

~~(56)~~ [Evidence] Any Contracting Party may require that evidence be furnished to the Office in the course of the examination of the application where the Office may reasonably doubt the veracity of any indication or element contained in the application.

Article 4 *Representation; Address for Service*

(1) [Representatives Admitted to Practice] (a) Any Contracting Party may require that a representative appointed for the purposes of any procedure before the Office:

- (i) have the right, under the applicable law, to practice before the Office in respect of applications and trademarks;
- (ii) provide, as his address, an address on a territory prescribed by the Contracting Party.

(b) An act, with respect to any procedure before the Office, by or in relation to a representative who complies with the requirements applied by the Contracting Party under subparagraph (a), shall have the effect of an act by or in relation to the applicant, holder or other interested person who appointed that representative.

(2) [Mandatory Representation; Address for Service]

(a) Any Contracting Party may require that, an applicant, holder or other interested person appoint a representative for the purposes of any procedure before the Office, except that an applicant, holder or other interested person may act himself before the Office for the following procedures:

- (i) the filing of an application for the purposes of the filing date;
- (ii) the payment of a fee;

(iii) the issue of a receipt or notification by the Office in respect of any procedure referred to in items (i) and (ii).

(b) Notwithstanding sub-paragraph (a), any Contracting Party may require that, for the purposes of any procedure before the Office, any person who has neither a domicile nor a real and effective industrial or commercial establishment in its territory or has an address for service on that territory.

(3) [*Power of Attorney*]

(a) Whenever a Contracting Party allows or requires an applicant, a holder or any other interested person to be represented by a representative before the Office, it may require that the representative be appointed in a separate communication (hereinafter referred to as “power of attorney”) indicating the name of, and signed by, the applicant, the holder or the other person, as the case may be.

(b) The power of attorney may relate to one or more applications and/or registrations identified in the power of attorney or, subject to any exception indicated by the appointing person, to all existing and future applications and/or registrations of that person.

(c) The power of attorney may limit the powers of the representative to certain acts. Any Contracting Party may require that any power of attorney under which the representative has the right to withdraw an application or to surrender a registration contain an express indication to that effect.

(d) Where a communication is submitted to the Office by a person who refers to himself in the communication as a representative but where the Office is, at the time of the receipt of the communication, not in possession of the required power of attorney, the Contracting Party may require that the power of attorney be submitted to the Office within the time limit fixed by the Contracting Party, subject to the minimum time limit prescribed in the Regulations. Any Contracting Party may provide that, where the power of attorney has not been submitted to the Office within the time limit fixed by the Contracting Party, the communication by the said person shall have no effect.

~~(e) As regards the requirements concerning the presentation and contents of the power of attorney, no Contracting Party shall refuse the effects of the power of attorney presented on a form corresponding to the Power of Attorney provided for in the Regulations, signed by the applicant.~~

~~(4) [Language] Any Contracting Party may require that the power of attorney be in the language, or in one of the languages, admitted by the Office.~~

(45) [*Referenceto Power of Attorney*] Any Contracting Party may require that any communication made to the Office by a representative for the purposes of a procedure before the Office contain a reference to the power of attorney on the basis of which the representative acts.

(56) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraphs (3) to (45) and in Article 8(2) and (3) be complied with in respect of thematters dealt with in those paragraphs.

(67) [*Evidence*] Any Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraphs (2) to (5).

(78) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) and (2) are not complied with, the Office shall notify the applicant, holder or other interested person, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(89) [*Non-Compliance with Requirements*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) and (2) are not complied with within the time limit prescribed in the Regulations, the Contracting Party may apply such a sanction as is provided for in its law.

Article 5 *Filing Date*

(1) [*Permitted Requirements*]

(a) Subject to subparagraph (b) and paragraph (2), a Contracting Party shall accord as the filing date of an application the date on which the Office received the following indications and elements in the language required under Article ~~3(3)~~8(2) filed at the option of the applicant, on paper or as otherwise permitted by the Office for the purpose of the filing date:

- (i) an express or implicit indication that the registration of a mark is sought;
- (ii) indications allowing the identity of the applicant to be established;
- (iii) indications allowing the applicant or his representative, if any, to be contacted by the Office;
- (iv) a sufficiently clear reproduction of the mark whose registration is sought;
- (v) the list of the goods and/or services for which the registration is sought;
- (vi) where Article 3(1)(a)(xvii) or 3(1)(b) applies, the declaration referred to in Article 3(1)(a)(xvii) or the declaration and evidence referred to in Article 3(1)(b), respectively, as required by the law of the Contracting Party, those declarations being, if so required by the said law, signed by the applicant himself even if he has a representative.

(b) Any Contracting Party may accord as the filing date of the application the date on which the Office received only some, rather than all, of the indications and elements referred to in subparagraph (a) or received them in a language other than the language required under Article ~~3(3)~~8(2).

(2) [*Permitted Additional Requirement*]

(a) A Contracting Party may provide that no filing dates shall be accorded until the required fees are paid.

(b) A Contracting Party may apply the requirement referred to in subparagraph (a) only if it applies such requirement at the time of becoming party to this Treaty.

(3) [*Corrections and Time Limits*] The modalities of, and time limits for, corrections under paragraphs (1) and (2) shall be fixed in the Regulations.

(4) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) be complied with in respect of the filing date.

Article 6
Single Registration for Goods and/or Services in Several Classes

Where goods and/or services belonging to several classes of the Nice Classification have been included in one and the same application, such an application shall result in one and the same registration.

Article 7
Division of Application and Registration

(1) [*Division of Application*]

(a) Any application listing several goods and/or services (hereinafter referred to as “initial application”) may,

(i) at least until the decision by the Office on the registration of the mark,

(ii) during any opposition proceedings against the decision of the Office to register the mark,

(iii) during any appeal proceedings against the decision on the registration of the mark, be divided by the applicant or at his request into two or more applications (hereinafter referred to as “divisional applications”) by distributing among the latter the goods and/or services listed in the initial application. The divisional applications shall preserve the filing date of the initial application and the benefit of the right of priority, if any.

(b) Any Contracting Party shall, subject to subparagraph (a), be free to establish requirements for the division of an application, including the payment of fees.

(2) [*Division of Registration*] Paragraph (1) shall apply, *mutatis mutandis*, with respect to a division of a registration. Such a division shall be permitted

(i) during any proceedings in which the validity of the registration is challenged before the Office by a third party,

(ii) during any appeal proceedings against a decision taken by the Office during the former proceedings, provided that a Contracting Party may exclude the possibility of the division of registrations if its law allows third parties to oppose the registration of a mark before it is registered.

Article 8
Communications

(1) [*Form and Means of Transmittal of Communications*] (a) Except for the establishment of a filing date under Article 5(1), and subject to Article 3(1), the Regulations shall, subject to subparagraphs (b) to (d), set out the requirements which a Contracting Party shall be permitted to apply as regards the form and means of transmittal of communications.

[Alternative A]

(b) No Contracting Party shall be obliged to accept the filing of communications other than on paper.

(c) No Contracting Party shall be obliged to exclude the filing of communications on paper.

[End of Alternative A]

[Alternative B]

(b) Any Contracting Party may permit the filing of communications on paper

(c) Any Contracting Party may permit the filing of communications other than on paper.

[End of Alternative B]

(d) A Contracting Party ~~may~~ shall accept the filing of communications on paper for the purpose of complying with a time limit.

(2) [*Language of Communications*] Any Contracting Party may require that ~~the~~ any communication be in the language, or in one of the languages, admitted by the Office. Where the Office admits more than one language, the applicant, holder or other interested person may be required to comply with any other language requirement applicable with respect to the Office, provided that the communication may not be required to be in more than one language.

(3) [*Presentation of a Communication on Model International Forms*] Notwithstanding paragraph (1)(a), and subject to paragraph (1)(b) and Article 3(2), a Contracting Party shall accept the presentation ~~;~~ or the effects of ~~the contents of~~ a communication on a Form which corresponds to a Model International Form in respect of such a communication provided ~~ed~~ ed for in the Regulations, if any.

(4) [*Signature of Communications*] (a) Where a Contracting Party requires [a signature for the purposes of any communication] [a communication to be signed], that Contracting Party shall accept any signature that complies with the requirements prescribed in the Regulations.

(b) No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature, except if the law of the Contracting Party so provides, where the signature concerns the surrender of a registration and as prescribed in the Regulations.

(c) Subject to subparagraph (b), a Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the authenticity of any signature.

(5) [*Indications in Communications*] A Contracting Party may not require that a ~~ny~~ communication contain ~~one or more~~ indications other than those prescribed in the Regulations.

(6) [*Address for Correspondence, Address for Legal Service and Other Address*] A Contracting Party may, subject to any provisions prescribed in the Regulations, require that an applicant, holder or other interested person indicate in any communication:

- (i) an address for correspondence;
- (ii) an address for legal service;
- (iii) any other address provided for in the Regulations.

(7) [*Notification*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (6) are not complied with in respect of communications, the Office shall notify the applicant, holder or other interested person, giving the opportunity to comply with any such requirement, and to make observations, within the time limit prescribed in the Regulations.

(8) [*Non-Compliance with Requirements*] Where one or more of the requirements applied by the Contracting Party under paragraphs (1) to (6) are not complied with within the time limit prescribed in the Regulations, the Contracting Party may, subject to Article 5 and to any exceptions prescribed in the Regulations, apply such a sanction as is provided for in its law.

Article 9 *Classification of Goods and/or Services*

(1) [*Indications of Goods and/or Services*] Each registration and any publication effected by an Office which concerns an application or registration and which indicates goods and/or services shall indicate the goods and/or services by their names, grouped according to the classes of the Nice Classification, and each group shall be preceded by the number of the class of that Classification to which that group of goods or services belongs and shall be presented in the order of the classes of the said Classification.

(2) [*Goods or Services in the Same Class or in Different Classes*]

(a) Goods or services may not be considered as being similar to each other on the ground that, in any registration or publication by the Office, they appear in the same class of the Nice Classification.

(b) Goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication by the Office, they appear in different classes of the Nice Classification.

Article 10
Changes in Names or Addresses

(1) [*Changes in the Name or Address of the Holder*]

(a) Where there is no change in the person of the holder but there is a change in his name and/or address, each Contracting Party shall accept that a request for the recordal of the change by the Office in its register of marks be made in a communication signed by the holder or his representative and indicating the registration number of the registration concerned and the change to be recorded. ~~As regards the requirements concerning the presentation of the request, no Contracting Party shall refuse the request,~~

~~if it is presented, subject to subparagraph (c) and to Article 8, on a form corresponding to the request Form provided for in the Regulations.~~

(b) Any Contracting Party may require that the request indicate

- (i) the name and address of the holder;
- (ii) where the holder has a representative, the name and address of that representative;
- (iii) where the holder has an address for service, such address.

(c) Any Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(d) A single request shall be sufficient even where the change relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request.

(2) [*Change in the Name or Address of the Applicant*] Paragraph (1) shall apply, *mutatis mutandis*, where the change concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or his representative, the request otherwise identifies that application as prescribed in the Regulations.

(3) [*Change in the Name or Address of the Representative or in the Address for Service*] Paragraph (1) shall apply, *mutatis mutandis*, to any change in the name or address of the representative, if any, and to any change relating to the address for service, if any.

(4) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (3) ~~and in Article 8(2) and (3)~~ be complied with in respect of the request referred to in this Article. In particular, the furnishing of any certificate concerning the change may not be required.

(5) [*Evidence*] Any Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in the request.

Article 11 *Change in Ownership*

(1) [*Change in the Ownership of a Registration*]

(a) Where there is a change in the person of the holder, each Contracting Party shall accept that a request for the recordal of the change by the Office in its register of marks be made in a communication signed by the holder or his representative, or by the person who acquired the ownership (hereinafter referred to as “new owner”) or his representative, and indicating the registration number of the registration concerned and the change to be recorded. ~~As regards the requirements concerning the presentation of the request, no Contracting Party shall refuse the request,~~

~~if it is presented, subject to paragraph (2)(a) and to Article 8, on a form corresponding to the request Form provided for in the Regulations.~~

(b) Where the change in ownership results from a contract, any Contracting Party may require that the request indicate that fact and be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the contract, which copy may be required to be certified, by a notary public or any other competent public authority, as being in conformity with the original contract;

(ii) an extract of the contract showing the change in ownership, which extract may be required to be certified, by a notary public or any other competent public authority, as being a true extract of the contract;

(iii) an uncertified certificate of transfer drawn up in the form and with the content as prescribed in the Regulations and signed by both the holder and the new owner;

(iv) an uncertified transfer document drawn up in the form and with the content as prescribed in the Regulations and signed by both the holder and the new owner.

(c) Where the change in ownership results from a merger, any Contracting Party may require that the request indicate that fact and be accompanied by a copy of a document, which document originates from the competent authority and evidences the merger, such as a copy of an extract from a register of commerce, and that that copy be certified by the authority which issued the document or by a notary public or any other competent public authority, as being in conformity with the original document.

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(d) Where there is a change in the person of one or more but not all of several co-holders and such change in ownership results from a contractor merger, any Contracting Party may require that any co-holder in respect of which there is no change in ownership give his express consent to the change in ownership in a document signed by him.

(e) Where the change in ownership does not result from a contractor merger but from another ground, for example, from operation of law or a court decision, any Contracting Party may require that the request indicate that fact and be accompanied by a copy of a document evidencing the change and that that copy be certified as being in conformity with the original document by the authority which issued the document or by a notary public or any other competent public authority.

(f) Any Contracting Party may require that the request indicate

(i) the name and address of the holder;

(ii) the name and address of the new owner;

(iii) the name of a State of which the new owner is a national if he is the national of any State, the name of a State in which the new owner has his domicile, if any, and the name of a State in which the new owner has a real and effective industrial or commercial establishment, if any;

(iv) where the new owner is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(v) where the holder has a representative, the name and address of that representative;

(vi) where the holder has an address for service, such address;

(vii) where the new owner has a representative, the name and address of that representative;

(viii) where the new owner is required to have an address for service under Article 4(2)(b), such address.

(g) Any Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(h) A single request shall be sufficient even where the change relates to more than one registration, provided that the holder and the new owner are the same for each registration and that the registration numbers of all registrations concerned are indicated in the request.

(i) Where the change of ownership does not affect all the goods and/or services listed in the holder's registration, and the applicable law allows the recording of such change, the Office shall create a separate registration referring to the goods and/or services in respect of which the ownership has changed. n

(2) [*Language; Translation*]

~~(a) Any Contracting Party may require that the request, the certificate of transfer or the transfer document referred to in paragraph (1) be in the language, or in one of the languages, admitted by the Office.~~

(b) Any Contracting Party may require that, if the documents referred to in paragraph (1)(b)(i) and (1)(b)(ii), (1)(c) and (1)(e) are not in the language, or in one of the languages, admitted by the Office, the request be accompanied by a translation or a certified translation of the required document in the language, or in one of the languages, admitted by the Office.

(3) [*Change in the Ownership of an Application*] Paragraphs (1) and (2) shall apply, *mutatis mutandis*, where the change in ownership concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or his representative, the request otherwise identifies that application as prescribed in the Regulations.

(4) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (3) and in Article 8(2) and (3) be complied with in respect of the request referred to in this Article. In particular, the following may not be required:

(i) subject to paragraph (1)(c), the furnishing of any certificate of, or extract from, a register of commerce;

(ii) an indication of the new owner's carrying on of an industrial or commercial activity, as well as the furnishing of evidence to that effect;

(iii) an indication of the new owner's carrying on of an activity corresponding to the goods and/or services affected by the change in ownership, as well as the furnishing of evidence to either effect;

(iv) an indication that the holder transferred, entirely or in part, his business or the relevant goodwill to the new owner, as well as the furnishing of evidence to either effect.

(5) [*Evidence*] Any Contracting Party may require that evidence, or further evidence where paragraph (1)(c) or (1)(e) applies, be furnished to the Office where that Office may reasonably doubt the veracity of any indication contained in the request or in any document referred to in the present Article.

Article 12
Correction of a Mistake

(1) [*Correction of a Mistake in Respect of a Registration*]

(a) Each Contracting Party shall accept that the request for the correction of a mistake which was made in the application or other request communicated to the Office and which mistake is reflected in its register of marks and/or any publication by the Office be made in a communication signed by the holder or his representative and indicating the registration number of

the registration concerned, the mistake to be corrected and the correction to be entered. ~~As regards the requirements concerning the presentation of the request, no Contracting Party shall refuse the request, if it is presented, subject to subparagraph (c) and to Article 8, on a form corresponding to the request Form provided for in the Regulations.~~

(b) Any Contracting Party may require that the request indicate

- (i) the name and address of the holder;
- (ii) where the holder has a representative, the name and address of that representative;
- (iii) where the holder has an address for service, such address.

~~(c) Any Contracting Party may require that the request be in the language, or in one of the languages, admitted by the Office.~~

~~(c)~~ Any Contracting Party may require that, in respect of the request, a fee be paid to the Office.

~~(d)~~ A single request shall be sufficient even where the correction relates to more than one registration of the same person, provided that the mistake and the requested correction are the same for each registration and that the registration numbers of all registrations concerned are indicated in the request.

(2) [*Correction of a Mistake in Respect of an Application*] Paragraph (1) shall apply, *mutatis mutandis*, where the mistake concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or his representative, the request otherwise identifies that application as prescribed in the Regulations.

(3) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) and in Article 8(2) and (3) be complied with in respect of the request referred to in this Article.

(4) [*Evidence*] Any Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt that the alleged mistake is in fact a mistake.

(5) [*Mistakes Made by the Office*] The Office of a Contracting Party shall correct its own mistakes, ex officio or upon request, for no fee.

(6) [*Uncorrectable Mistakes*] No Contracting Party shall be obliged to apply paragraphs (1), (2) and (5) to any mistake which cannot be corrected under its law.

Article 13
Duration and Renewal of Registration

(1) [Indications or Elements Contained in or Accompanying a Request for Renewal; Fee]

(a) Any Contracting Party may require that the renewal of a registration be subject to the filing of a request and that such request contains some or all of the following indications:

- (i) an indication that renewal is sought;
- (ii) the name and address of the holder;
- (iii) the registration number of the registration concerned;
- (iv) at the option of the Contracting Party, the filing date of the application which resulted in the registration concerned or the registration date of the registration concerned;
- (v) where the holder has a representative, the name and address of that representative;
- (vi) where the holder has an address for service, such address;
- (vii) where the Contracting Party allows the renewal of a registration to be made for some only of the goods and/or services which are recorded in the register of marks and such a renewal is requested, the names of the recorded goods and/or services for which the renewal is requested or the names of the recorded goods and/or services for which the renewal is not requested, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which the group of goods or services belongs and presented in the order of the classes of the said Classification;
- (viii) where a Contracting Party allows a request for renewal to be filed by a person other than the holder or his representative and the request is filed by such a person, the name and address of that person;
- (ix) a signature by the holder or his representative or, where item (viii) applies, a signature by the person referred to in that item.

(b) Any Contracting Party may require that, in respect of the request for renewal, a fee be paid to the Office. Once the fee has been paid in respect of the initial period of the registration or of any renewal period, no further payment may be required for the maintenance of the registration in respect of that period. Fees associated with the furnishing of a declaration and/or evidence of use shall not be regarded, for the purposes of this subparagraph, as payments required for the maintenance of the registration and shall not be affected by this subparagraph.

(c) Any Contracting Party may require that the request for renewal be presented, and the corresponding fee referred to in subparagraph (b) be paid, to the Office within the period fixed by the law of the Contracting Party, subject to the minimum periods prescribed in the Regulations.

~~(2) [Presentation] As regards the requirements concerning the presentation of the request for renewal, no Contracting Party shall refuse the request, if it is presented,~~

~~subject to paragraph (3) and to Article 8, on a form corresponding to the request Form provided for in the Regulations.~~

~~(3) [Language] Any Contracting Party may require that the request for renewal be in the language, or in one of the languages, admitted by the Office.~~

(24) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) ~~to (3) and Article 8(2) and (3)~~ be complied with in respect of the request for renewal. In particular, the following may not be required:

- (i) any reproduction or other identification of the mark;
- (ii) the furnishing of evidence to the effect that the mark has been registered, or that its registration has been renewed, in the register of marks of any other Contracting Party;
- (iii) the furnishing of a declaration and/or evidence concerning use of the mark.

(35) [*Evidence*] Any Contracting Party may require that evidence be furnished to the Office in the course of the examination of the request for renewal where the Office may reasonably doubt the veracity of any indication or element contained in the request for renewal.

(46) [*Prohibition of Substantive Examination*] No Office of a Contracting Party may, for the purposes of effecting the renewal, examine the registration as to substance.

(57) [*Duration*] The duration of the initial period of the registration, and the duration of each renewal period, shall be 10 years.

Articles 13 bis and 13 ter

[Alternative A]

Article 13 bis Relief in Respect of Time Limits

(1) [*Extension of Time Limits*] A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office in respect of an application or a registration of a mark, if a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party:

- (i) prior to the expiration of the time limit; or
- (ii) after the expiration of the time limit, and within the time limit prescribed in the Regulations.

(2) [*Continued Processing*] Where an applicant ~~or~~ holder or other interested person has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office in respect of an application or a registration of a trade mark, and that Contracting

Party does not provide for extension of a time limit under paragraph (1)(ii), the Contracting Party shall provide for continued processing with respect to the application or the registration of the trademark and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration of the trademark, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements in respect of which the time limit for the action concerned applied are complied with, within the time limit prescribed in the Regulations.

(3) [Exceptions] No Contracting Party shall be required to provide for the relief referred to in paragraph (1) or (2) with respect to the exceptions prescribed in the Regulations.

(4) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) or (2).

(5) [Prohibition of Other Requirements] No Contracting Party may require that requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the relief provided for under paragraph (1) or (2), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(6) [Opportunity to Make Observations in Case of Intended Refusal] A request under paragraph (1) or (2) may not be refused without the applicant or holder being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Article 13ter
Reinstatement of Rights After a Finding of Due Care
or Unintentionality by the Office

(1) [Request] A Contracting Party shall provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or registration mark, the Office shall reinstate the rights of the applicant or holder with respect to the application or the registration trademark concerned, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements in respect of which the time limit for the said action applied are complied with, within the time limit prescribed in the Regulations;

(iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(2) [Exceptions] No Contracting Party shall be required to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.

(3) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraph (1).

(4) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.

[End of Alternative A]

[Alternative B]

Article 13b is
Relief in Respect of Time Limits - Reinstatement of Rights

(1) [Extension of Time Limits] A Contracting Party may provide for the extension, for the period prescribed in the Regulations, of a time limit fixed by the Office for an action in a procedure before the Office in respect of an application or a registration of a mark, if a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations, and the request is filed, at the option of the Contracting Party:

(i) prior to the expiration of the time limit; or

(ii) after the expiration of the time limit, and within the time limit prescribed in the Regulations.

(2) [Continued Processing] (a) Where an applicant or holder has failed to comply with a time limit fixed by the Office of a Contracting Party for an action in a procedure before the Office in respect of an application or a registration of a trade mark, and that Contracting Party does not provide for extension of a time limit under paragraph (1)(ii), the Contracting Party shall provide for continued processing with respect to the application or the registration of a trade mark and, if necessary, reinstatement of the rights of the applicant or holder with respect to that application or registration of the trade mark, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements in respect of which the time limit for the action concerned applied are complied with, within the time limit prescribed in the Regulations.

(b) [Reinstatement of Rights] Where the failure to comply with the time limit under paragraph 2 (a) has the direct consequence of causing a loss of rights with respect to an application or a registration of a mark, the Contracting Party shall provide that the Office shall reinstate the rights of the applicant or holder with respect to the application or the registration concerned, if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed, and all of the requirements in respect of which the time limit for the action concerned applied are complied with, within the time limit prescribed in the Regulations.

(iii) the request states the reasons for the failure to comply with the time limit; and

(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.

(3) *[Exceptions]* No Contracting Party shall be required to provide for the relief referred to in paragraph (1) or (2) (b) or for the reinstatement of rights under paragraph (2) (b) with respect to the exceptions prescribed in the Regulations.

(4) *[Fees]* A Contracting Party may require that a fee be paid in respect of a request under paragraph (1) or (2).

(5) *[Prohibition of Other Requirements]* No Contracting Party may require that requirements other than those referred to in paragraphs (1) to (4) be complied with in respect of the relief provided for under paragraph (1) or (2), except where otherwise provided for by this Treaty or prescribed in the Regulations.

(6) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (2) (b) (iii) be filed with the Office within a time limit fixed by the Office.

(7) [Opportunity to Make observations in Case of Intended Refusal] A request under paragraph (1) or (2) may not be refused without the applicant or holder being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Article 13ter
Reinstatement of Rights After a Finding of Due Care
or Unintentionality by the Office

(1) [Request] A Contracting Party shall provide that, where an applicant or holder has failed to comply with a time limit for an action in a procedure before the Office, and that failure has the direct consequence of causing a loss of rights with respect to an application or a mark, the Office shall reinstate the rights of the applicant or holder with respect to the application or trademark concerned, if:

~~(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;~~

~~(ii) the request is filed, and all of the requirements in respect of which the time limit for the said action applied are complied with, within the time limit prescribed in the Regulations;~~

~~(iii) the request states the reasons for the failure to comply with the time limit; and~~

~~(iv) the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that any delay was unintentional.~~

~~(2) [Exceptions] No Contracting Party shall be required to provide for the reinstatement of rights under paragraph (1) with respect to the exceptions prescribed in the Regulations.~~

~~(3) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraph (1).~~

~~(4) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph (1)(iii) be filed with the Office within a time limit fixed by the Office.~~

[End of Alternative B]

Article 13 quater
Correction or Addition of Priority Claim; Restoration of Priority Right

(1) [Correction or Addition of Priority Claim] Except where otherwise prescribed in the Regulations, a Contracting Party shall provide for the correction or addition of a priority claim with respect to an application (“the subsequent application”), if:

(i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;

(ii) the request is filed within the time limit prescribed in the Regulations; and

(iii) the filing date of the subsequent application is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(2) [Delayed Filing of the Subsequent Application] Taking into consideration Article 15, a Contracting Party shall provide that, where an application (“the subsequent application”) which claims or could have claimed the priority of an earlier application has a filing date which is later

than the date on which the priority period expired, but within the time limit prescribed in the Regulations, the Office shall restore the right of priority, if

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit prescribed in the Regulations;
- (iii) the request states the reasons for the failure to comply with the priority period; and
- (iv) the Office finds, that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, was unintentional.

(3) [Failure to File a Copy of Earlier Application] A Contracting Party shall provide that, where a copy of an earlier application required under Article 3 (a)(vii) is not filed with the Office within the time limit prescribed in the Regulations pursuant to Article 3, the Office shall restore the right of priority, if:

- (i) a request to that effect is made to the Office in accordance with the requirements prescribed in the Regulations;
- (ii) the request is filed within the time limit for filing the copy of the earlier application prescribed in the Regulations pursuant to Article 3 (a)(vii);
- (iii) the Office finds that the request for the copy to be provided had been filed with the Office with which the earlier application was filed, within the time limit prescribed in the Regulations.

(4) [Fees] A Contracting Party may require that a fee be paid in respect of a request under paragraphs (1) to (3).

(5) [Evidence] A Contracting Party may require that a declaration or other evidence in support of the reasons referred to in paragraph 2(iii) be filed with the Office within a time limit fixed by the Office.

(6) [Opportunity to Make Observations in Case of Intended Refusal] A request under paragraphs (1) to (3) may not be refused, totally or in part, without the requesting party being given the opportunity to make observations on the intended refusal within a reasonable time limit.

Article 14

Opportunity to Make Observations in Case of Intended Refusal

An application or a request under Articles 10 to 13 may not be refused totally or in part by an Office without giving the applicant or the requesting party, as the case may be, an opportunity to make observations on the intended refusal within a reasonable time limit.

Article 15
Obligation to Comply with the Paris Convention

Any Contracting Party shall comply with the provisions of the Paris Convention which concern marks.

Article 16
Service Marks

Any Contracting Party shall register service marks and apply to such marks the provisions of the Paris Convention which concern trademarks.

CHAPTER II
TRADEMARK LICENSES

[See Article 1 to 6 of the Joint Recommendation Concerning Trademark Licenses]

CHAPTER III
ADMINISTRATIVE AND FINAL CLAUSES

Article 17
Regulations

(1) [Content]

(a) The Regulations annexed to this Treaty provide rules concerning

(i) matters which this Treaty expressly provides to be “prescribed in the Regulations”;

(ii) any details useful in the implementation of the provisions of this Treaty;

(iii) any administrative requirements, matters or procedures.

(b) The Regulations also contain Model International Forms.

(2) [Conflict Between the Treaty and the Regulations] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 18
Revision; Protocols

- (1) *[Revision]* This Treaty may be revised by a diplomatic conference.
- (2) *[Protocols]* For the purposes of further developing the harmonization of law on marks, protocols may be adopted by a diplomatic conference insofar as those protocols do not contravene the provisions of this Treaty.

Articles 19 to 25
[Reserved]

REGULATIONS UNDER THE
TRADEMARK LAW TREATY

List of Rules

- Rule 1: Abbreviated Expressions
Rule 2: Manner of Indicating Names and Addresses
Rule 3: Details Concerning the Application
Rule 4: Details Concerning Representation
Rule 5: Details Concerning the Filing Date
Rule 5 *bis*: Filing of Communications under Article 8
Rule 6: Details Concerning the Signature
Rule 7: Manner of Identification of an Application Without Its Application Number
Rule 8: Details Concerning Duration and Renewal
Rule 9: Details Concerning Relief in Respect of Time Limits Under Article 13 *bis*
Rule 10: Details Concerning the Reinstatement of Rights After a Finding of Due Care and Unintentionality by the Office Under Article 13 *ter*

List of Model International Forms

- Form No. 1 Application for the Registration of a Mark
Form No. 2 Power of Attorney
Form No. 3 Request for the Recordal of Change(s) in Name(s) and/or Address(es)
Form No. 4 Request for the Recordal of a Change in Ownership in Respect of Registration(s) and/or Application(s) for Registration of Marks
Form No. 5 Certificate of Transfer in Respect of Registration(s) and/or Application(s) for Registration of Marks
Form No. 6 Transfer Document in Respect of Registration(s) and/or Application(s) for Registration of Marks
Form No. 7 Request for the Correction of Mistake(s) in Registration(s) and/or Application(s) for Registration of Marks
Form No. 8 Request for the Renewal of a Registration
Forms relating to Trademark Licenses

Rule 1
Abbreviated Expressions

(1) [“*Treaty*”; “*Article*”] (a) In these Regulations, the word “*Treaty*” means the Trademark Law Treaty.

(b) In these Regulations, the word “*Article*” refers to the specified Article of the Treaty.

(2) [*Abbreviated Expressions Defined in the Treaty*] The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of the Regulations.

Rule 2
Manner of Indicating Names and Addresses

(1) [*Names*] (a) Where the name of a person is to be indicated, any Contracting Party may require,

(i) where the person is a natural person, that the name to be indicated be the family or principal name and the given or secondary name or names of that person or that the name to be indicated be, at that person's option, the name or names customarily used by the said person;

(ii) where the person is a legal entity, that the name to be indicated be the full official designation of the legal entity.

(b) Where the name of a representative which is a firm or partnership is to be indicated, any Contracting Party shall accept as indication of the name the indication that the firm or partnership customarily uses.

(2) [*Addresses*] (a) Where the address of a person is to be indicated, any Contracting Party may require that the address be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and, in any case, consist of all the relevant administrative units up to, and including, the house or building number, if any.

(b) Where a communication to the Office of a Contracting Party is in the name of two or more persons with different addresses, that Contracting Party may require that such communication indicate a single address as the address for correspondence.

(c) The indication of an address may contain a telephone number and a telefacsimile number and, for the purposes of correspondence, an address different from the address indicated under subparagraph (a).

(d) Subparagraphs (a) and (c) shall apply, *mutatis mutandis*, to addresses for service.

(3) [*Script to Be Used*] Any Contracting Party may require that any indication referred to in paragraphs (1) and (2) be in the script used by the Office.

Rule 3
Details Concerning the Application

(1) [*Standard Characters*] Where, pursuant to Article 3(1)(a)(ix), the application contains a statement to the effect that the applicant wishes that the mark be registered and published in the standard characters used by the Office of the Contracting Party, the Office shall register and publish that mark in such standard characters.

(2) [*Number of Reproductions*] (a) Where the application does not contain a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than

(i) five reproductions of the mark in black and white where the application may not, under the law of that Contracting Party, or does not contain a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of the said Contracting Party;

(ii) one reproduction of the mark in black and white where the application contains a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of that Contracting Party.

(b) Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than five reproductions of the mark in black and white and five reproductions of the mark in color.

(3) [*Reproduction of a Three-Dimensional Mark*] (a) Where, pursuant to Article 3(1)(a)(xi), the application contains a statement to the effect that the mark is a three-dimensional mark, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction.

(b) The reproduction furnished under subparagraph (a) may, at the option of the applicant, consist of one single view of the mark or of several different views of the mark.

(c) Where the Office considers that the reproduction of the mark furnished by the applicant under subparagraph (a) does not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, up to six different views of the mark and/or a description by words of that mark.

(d) Where the Office considers that the different views and/or the description of the mark referred to in subparagraph (c) still do not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, a specimen of the mark.

(e) Paragraph (2)(a)(i) and 2 (b) shall apply *mutatis mutandis*.

(4) [*Transliteration of the Mark*] For the purposes of Article 3(1)(a)(xiii), where the mark consists of or contains matter in script other than the script used by the Office or numbers expressed in numerals other than numerals used by the Office, a transliteration of such matter in the script and numerals used by the Office may be required.

(5) [*Translation of the Mark*] For the purposes of Article 3(1)(a)(xiv), where the mark consists of or contains a word or words in a language other than the language, or one of the languages, admitted by the Office, a translation of that word or those words into that language or one of those languages may be required.

(6) [*Time Limit for Furnishing Evidence of Actual Use of the Mark*] The time limit referred to in Article 3(6) shall not be shorter than six months counted from the date of allowance of the application by the Office of the Contracting Party where that application was filed. The applicant or holder shall have the right to an extension of that time limit, subject to the conditions provided for by the law of that Contracting Party, by periods of at least six months each, up to a total extension of at least two years and a half.

Rule 4 *Details Concerning Representation*

(1) [*Time Limits Under Article 4(3)(d)*] The time limit referred to in Article 4(3)(d) shall be counted from the date of receipt of the communication referred to in that Article by the Office of the Contracting Party concerned and shall not be less than one month where the address of the person on whose behalf the communication is made is on the territory of that Contracting Party and not less than two months where such an address is outside the territory of that Contracting Party.

(2) [*Time Limits Under Article 4(7) and (8)*] Subject to paragraph (3), the time limits referred to in Article 4(7) and (8) shall be not less than two months from the date of the notification referred to in Article 4(7).

(3) [*Exception to Time Limit Under Article 4(8)*] Where a notification referred to in Article 4(7) has not been made because indications allowing the applicant, holder or other interested person to be contacted by the Office have not been filed, the time limit referred to in Article 4(8) shall be not less than three months from the date on which the procedure referred to in Article 4(7) was commenced.

Rule 5 *Details Concerning the Filing Date*

(1) [*Procedure in Case of Non-Compliance with Requirements*] If the application does not, at the time of its receipt by the Office, comply with any of the applicable requirements of Article 5(1)(a) or 5(2)(a), the Office shall promptly invite the applicant to comply with such requirements within a time limit indicated in the invitation, which time limit shall be at least one month from the date of the invitation where the applicant's address is on the territory of the Contracting Party concerned and at least two months where the applicant's address is outside the territory of the Contracting Party concerned. Compliance with the invitation may be subject to the payment of a special fee. Even if the Office fails to send the said invitation, the said requirements remain unaffected.

(2) [*Filing Date in Case of Correction*] If, within the time limit indicated in the invitation, the applicant complies with the invitation referred to in paragraph (1) and pays any required special fee, the filing date shall be the date on which all the required indications and elements referred to in Article 5(1)(a) have been received by the Office and, where applicable, the required fee referred to in Article 5(2)(a) has been paid to the Office. Otherwise, the applications shall be treated as if they had not been filed.

(3) [*Date of Receipt*] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document or the payment of a fee shall be deemed to constitute receipt by or payment to the Office in cases in which the document was actually received by or payment was actually made to

- (i) a branch or sub-office of the Office,
- (ii) a national Office on behalf of the Office of the Contracting Party, where the Contracting Party is an intergovernmental organization referred to in Article 19(1)(ii),
- (iii) an official postal service,
- (iv) a delivery service, other than an official postal service, specified by the Contracting Party.

~~(4) [*Use of Telefacsimile*] Where a Contracting Party allows the filing of an application by telefacsimile and the application is filed by telefacsimile, the date of receipt of the telefacsimile by the Office of that Contracting Party shall constitute the date of receipt of the application, provided that the said Contracting Party may require that the original of such application reach the Office within a time limit which shall be at least one month from the day on which the telefacsimile was received by the said Office.~~

Rule 5bis
Filing of Communications Under Article (8)

(1) [*Communications Filed on Paper*] ~~(a)~~ After [month][day], [year], any Contracting Party may, subject to Articles 5(1) and 8(1) (d), exclude the filing of communications on paper or may continue to permit the filing of communications on paper. Until that date, all Contracting Parties shall permit the filing of communications on paper.

~~(b) Subject to Article 8(3), a Contracting Party may prescribe the requirements relating to the form of communications on paper.~~

(2) [*Communications Filed in Electronic Form or by Electronic Means of Transmittal*] ~~(a)~~ Any Wherea Contracting Party may permit the filing of communications in electronic form or by electronic means of transmittal with its Office in a particular language, including the filing of communications by telegraph, teleprinter, telefacsimile or other like means of transmittal -

~~(b) Where, under subparagraph (a), a Contracting Party permits the filing of communications by telegraph, teleprinter, telefacsimile or other like means of transmittal, it may require that the original of any document which was transmitted by such means of transmittal, accompanied by a~~

letter identifying that earlier transmission, be filed on paper with the Office within a time limit which shall be not less than one month from the date of the transmission.

(3) [Details Concerning Indications Under Article 8(5)] (a) A Contracting Party may require that any communication:

- (i) indicate the name and address of the applicant, holder or other interested person;
- (ii) indicate the number of the application or registration of the mark to which it relates;
- (iii) contain, where the applicant, holder or other interested person is registered with the Office, the number or other indication under which he is registered.

(b) A Contracting Party may require that any communication by a representative for the purposes of a procedure before the Office contain:

- (i) the name and address of the representative;
- (ii) a reference to the power of attorney, or other communication in which the appointment of that representative is or was effected, on the basis of which the said representative acts;
- (iii) where the representative is registered with the Office, the number or other indication under which he is registered.

(4) [Address for Correspondence and Address for Legal Service] (a) A Contracting Party may require that the address for correspondence referred to in Article 8(6)(i) and the address for legal service referred to in Article 8(6)(ii) be on a territory prescribed by that Contracting Party.

(b) Where no representative is appointed and an applicant, owner or other interested person has provided, as his address, an address on a territory prescribed by the Contracting Party under paragraph (2) (a), that Contracting Party shall consider that address to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, holder or other interested person expressly indicates another such address under Article 8(6).

(c) Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for correspondence referred to in Article 8(6)(i) or the address for legal service referred to in Article 8(6)(ii), as required by the Contracting Party, unless that applicant, owner or other interested person expressly indicates another such address under Article 8(6).

(5) [Time Limits Under Article 8(7) and (8)] (a) Subject to paragraph (b), the time limits referred to in Article 8(7) and (8) shall be not less than [two] months from the date of the notification referred to in Article 8(7).

(b) Where an notification under Article 8(7) has not been made because indications allowing the applicant, holder or other interested person to be contacted by the Office have not been filed, the time limit referred to in Article 8(8) shall be not less than [three] months from the date on which the communication referred to in Article 8(7) was received by the Office.

(6) [Sanctions for Non -Compliance with Requirements Under Article 8(8)] No Contracting Party may provide for the refusal of an application for failure to comply with any requirement to file a registration number or other indication under paragraph (3) (a)(iii) and (b)(iii).

Rule 6
Details Concerning the Signature

(1) ~~[Legal Entities - Indications Accompanying Signature] Where a communication is signed on behalf of a legal entity, a~~ Any Contracting Party may require that the signature ~~, or the seal,~~ of the natural person who signs ~~or whose seal is used~~ be accompanied by:

(i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person;

(ii) an indication of the capacity in which that person is signed, where such capacity is not obvious from reading the communication.

~~(2) [Communication by Telefacsimile] The period referred to in Article 8(2)(b) shall not be less than one month from the date of the receipt of a transmittal by telefacsimile.~~

(2) [Date of Signing] Any Contracting Party may require that a signature ~~or seal~~ be accompanied by an indication of the date on which the signing ~~or sealing~~ was effected. Where that indication is required but is not supplied, the date on which the signing ~~or sealing~~ is deemed to have been effected shall be the date on which the communication bearing the signature ~~or seal~~ was received by the Office or, if the Contracting Party so allows, a date earlier than the latter date.

(3) [Signature of Communications on Paper] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party:

(i) shall, subject to item (iii), accept a handwrittensignature;

(ii) ~~shall be free to allow~~ may permit, instead of a handwrit tensignature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal ~~or of a bar~~ coded label ;

(iii) may, where the natural person who signs the communication is ~~its a~~ national of the Contracting Party and such person's address is on its territory, ~~or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment on its territory,~~ require that a seal be used instead of a handwrittensignature.

(iv) may, where a seal is used, require that the seal be accompanied by an indication in letters of the name of the natural person whose seal is used.

(2) ~~[Communication by Telefacsimile]~~

~~(a) Where a Contracting Party allows the transmittal of communication to the Office by telefacsimile, it shall consider the communication signed if, on the printout produced by the telefacsimile, there is the reproduction of the signature, or the reproduction of the seal together with, where required under paragraph (1)(iv), the indication in letters of the name of the natural person whose seal is used, appears.~~

~~(b) The Contracting Party referred to in subparagraph (a) may require that the paper whose reproduction was transmitted by telefacsimile be filed with the Office within a certain period, subject to the minimum period prescribed in the Regulations.~~

(3) ~~[Communication by Electronic Means]~~ Where a Contracting Party allows the transmittal of communication to the Office by electronic means, it shall consider the communication signed if the latter identifies the sender of the communication by electronic means as prescribed by the Contracting Party.

(4) ~~[Prohibition of Requirement of Certification]~~ No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature or other means of self-identification referred to in the preceding paragraphs, except, if the law of the Contracting Party so provides, where the signature concerns the surrender of a registration.

(4) [Signature of Communications Filed in Electronic Form or by Electronic Means of Transmittal Resulting in Graphic Representation] Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal, it shall consider such a communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on that communication as received by the Office of that Contracting Party.

(5) [Signature of Communications Filed in Electronic Form Not Resulting in Graphic Representation of Signature] Where a Contracting Party permits the filing of communications in electronic form, and a graphic representation of a signature accepted by that Contracting Party under paragraph (3) does not appear on such a communication as received by the Office of that Contracting Party, the Contracting Party may require that the communication be signed using a signature in electronic form as prescribed by that Contracting Party.

(6) [Exception to Certification of Signature Under Article 8(4)(b)] A Contracting Party may require that any signature referred to in paragraph (5) be confirmed by a process for certifying signatures in electronic forms specified by that Contracting Party.

Rule 7
Manner of Identification of an Application
Without Its Application Number

(1) [*Manner of Identification*] Where it is required that an application be identified by its application number but where such a number has not yet been issued or is not known to the applicant or his representative, that applications shall be considered identified if the following is supplied:

(i) the provisional application number, if any, given by the Office, or

(ii) a copy of the application, or

(iii) a reproduction of the mark, accompanied by an indication of the date on which, to the best knowledge of the applicant or their representative, the application was received by the Office and an identification number given to the application by the applicant or their representative.

(2) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in paragraph (1) be complied with in order for an application to be identified where its application number has not yet been issued or is not known to the applicant or his representative.

Rule 8
Details Concerning Duration and Renewal

For the purposes of Article 13(1)(c), the period during which the request for renewal may be presented and the renewal fee may be paid shall start at least six months before the date on which the renewal is due and shall end at the earliest six months after that date. If the request for renewal is presented and/or the renewal fees are paid after the date on which the renewal is due, any Contracting Party may subject the renewal to the payment of a surcharge.

[Alternative A]

Rule 9
Details Concerning Relief in Respect of
Time Limits Under Article 13bis

(1) [*Requirements Under Article 13bis(1)*] (a) A Contracting Party may require that a request referred to in Article 13bis(1):

(i) be signed by the applicant or holder;

(ii) contain an indication to the effect that extension of a time limit is requested, and an identification of the time limit in question.

(b) Where a request for extension of a time limit is filed after the expiration of the time limit, a Contracting Party may require that all of the requirements in respect of which the time limit for the action concerned applied be complied with at the same time as the request is filed.

(2) [*Period and Time Limit Under Article 13bis(1)*](a) The period of extension of a time limit referred to in Article 13bis(1) shall be not less than two months from the date of the expiration of the unextended time limit.

(b) The time limit referred to in Article 13bis(1)(ii) shall expire not earlier than two months from the date of the expiration of the unextended time limit.

(3) [*Requirements Under Article 13bis(2)(i)*] A Contracting Party may require that a request referred to in Article 13bis(2):

(i) be signed by the applicant or holder;

(ii) contain an indication to the effect that relief in respect of non-compliance with a time limit is requested, and an identification of the time limit in question.

(4) [*Time Limit for Filing a Request Under Article 13bis(2)(ii)*] The time limit referred to in Article 13bis(2)(ii) shall expire ~~not earlier than~~ two months after ~~a~~ the notification by the Office that the applicant or holder did not comply with the time limit fixed by the Office.

(5) [*Exceptions Under Article 13bis(3)*] (a) No Contracting Party shall be required under Article 13bis(1) or (2) to grant:

(i) a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 13bis(1) or (2);

(ii) relief for filing a request for relief under Article 13bis(1) or (2) or a request for reinstatement under Article 13ter(1);

(iii) relief in respect of a time limit for the payment of maintenance-renewal fees;

(iv) ~~(iii)~~ relief in respect of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;

(v) relief in respect of a time limit for an action in *inter partes* proceedings.

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements of a procedure before the Office shall be required under Article 13bis(1) or (2) to grant relief in respect of a time limit for an action in that procedure in respect of any of those requirements beyond that maximum time limit.

(1) [*Requirements Under Article 13ter(1)(i)*] A Contracting Party may require that a request referred to in Article 13ter(1)(i) be signed by the applicant or holder.

(2) [*Time Limit Under Article 13ter(1)(ii)*] The time limit for making a request, and for complying with the requirements, under Article 13ter(1)(ii), shall be the earliest to expire of the following:

(i) not less than two months from the date of the removal of the cause of failure to comply with the time limit for the action in question;

(ii) not less than [+2] months from the date of expiration of the time limit for the action in question, or , where a request relates to non-payment of a renewal/maintenance fee, not less than [+2] months from the date of expiration of the period of grace provided under Article 5 *bis* of the Paris Convention.

(3) [*Exceptions Under Article 13ter(2)*] The exceptions referred to in Article 13 *bis*(2) are failure to comply with that time limit:

(i) for an action before a board of appeal or other review body constituted in the framework of the Office;

(ii) for making a request for relief under Article 13 *bis*(1) or (2) or a request for reinstatement under Article 13 *bis*(1);

(iii) for an action in *inter partes* proceedings.

[End of Alternative A]

[Alternative B]

Rule 9
Details Concerning Relief in Respect of
Time Limits and Reinstatement of Rights
*After a Finding of Due Care or Unintentionality by the Office Under Article 13 *bis**

(1) [*Requirements Under Article 13bis(1)*] (a) A Contracting Party may require that a request referred to in Article 13 *bis*(1):

(i) be signed by the applicant or holder;

(ii) contain an indication to the effect that extension of a time limit is requested, and an identification of the time limit in question.

(b) Where a request for extension of a time limit is filed after the expiration of the time limit, a Contracting Party may require that all of the requirements in respect of which the time limit for the action concerned applied be complied with at the same time as the request is filed.

(2) [*Period and Time Limit Under Article 13bis(1)*](a) The period of extension of a time limit referred to in Article 13bis(1) shall be not less than two months from the date of the expiration of the unextended time limit.

(b) The time limit referred to in Article 13bis(1)(ii) shall expire not earlier than two months from the date of the expiration of the unextended time limit.

(3) [*Requirements Under Article 13bis(2)(a)*](i) A Contracting Party may require that a request referred to in Article 13bis(2):

(i) be signed by the applicant or holder;

(ii) contain an indication to the effect that relief in respect of non-compliance with a time limit is requested, and an identification of the time limit in question.

(4) [*Time Limit for Filing a Request Under Article 13bis(2)(a)*](ii) The time limit referred to in Article 13bis(2)(ii) shall expire ~~not earlier than~~ two months after ~~a~~ the notification by the Office that the applicant or holder did not comply with the time limit fixed by the Office.

(5) [Time Limit for Making a request Under Article 13bis(2)(b)] The time limit for making a request for complying with the requirements under Article 13bis(2)(b), shall be not less than two months from the date of removal of the cause of failure to comply with, or from the date of expiration of, the time limit for the action in question, whichever time expires the earlier.

~~(6)~~ [*Exceptions Under Article 13bis(3)*] (a) No Contracting Party shall be required under Article 13bis(1) or (2) to grant:

(i) a second, or any subsequent, relief in respect of a time limit for which relief has already been granted under Article 13bis(1) or (2);

(ii) relief for filing a request for relief under Article 13bis(1) or (2) ~~(a)~~ or a request for reinstatement under Article 13~~ter~~bis(2)(b);

(iii) relief in respect of a time limit for the payment of ~~renewal~~ renewal ~~maintenance~~ fees;

(iv) relief in respect of a time limit for an action before a board of appeal or other review body constituted in the framework of the Office;

(v) relief in respect of a time limit for an action in *inter partes* proceedings.

(b) No Contracting Party which provides a maximum time limit for compliance with all of the requirements of a procedure before the Office shall be required under Article 13bis(1) or (2) ~~(a)~~ to grant relief in respect of a time limit for an action in that procedure in respect of any of those requirements beyond that maximum time limit.

[End of Alternative B]

EXPLANATORY NOTES

Article 8 (Communications)

8.01. As to the term “communication”, reference is made to Article 1(iii) *bis*).

8.02. Along the lines with the agreed Statement adopted at the Diplomatic Conference regarding the Patent Law Treaty (PLT) and with a view to facilitating the implementation of Rule 8(1)(a), it could be envisaged to provide the developing and least developed countries and countries in transition, on request and on mutually agreed terms and conditions, technical and financial cooperation.

8.03. *Paragraph (1)(a)* The requirements that a Contracting Party is permitted to apply under this provision are prescribed in Rule 5 *bis*. The exception in respect of the filing date under Article 5(1) is needed because that Article provides for a filing date to be accorded where the prescribed elements of an application are filed, at the option of the applicant, on paper or as otherwise permitted by the Office for the purposes of the filing date. The effect of the reference to Article 3(1) is that, in the case of an application, the requirements in respect of the form or contents of an application under that Article prevail over the provisions under this paragraph.

8.04. The “form” of communication refers to the physical form of the medium which contains the information, for example, papers, sheets, a floppy disk, or an electronically transmitted document. It also encompasses physical requirements, and the presentation or arrangement of the information or data in a communication, for example, a format which uses standard data identifier tags to facilitate converting data from paper to electronic form. In addition, it also includes the notion of “electronic document formats”, such as pdf, XML, SGML, TIFF. The “means of transmittal” refers to the means, for example, the physical or electronic means, used to transmit the communication to the Office. For example, an application on paper mailed to the Office is a communication in paper form transmitted by physical means, while a floppy disk mailed to the Office is a communication in electronic form transmitted by physical means. A telex facsimile transmission resulting in a paper copy is a communication in paper form transmitted by electronic means, while a telex facsimile transmission to a computer terminal is a communication in electronic form transmitted by electronic means. In addition, an electronic transmission from computer to computer is a communication in electronic form transmitted by electronic means. The term “filing of communications” refers to transmission of a communication to the Office. A Contracting Party is not required to accept the filing of communications in any and all electronic forms, or by any and all electronic means of transmittal, simply because that Contracting Party permits the filing of communications in electronic form or by electronic means.

ALTERNATIVE A

8.05. *Paragraphs 1(b) and (c)*. These provisions ensure that no Contracting Party is obliged, against its wishes, to accept the filing of communications in electronic form or by electronic means of transmittal, or to exclude the filing of communications on paper. The Office of any Contracting Party may choose to accept filings on paper only, or both on paper and electronic filing. This will continue to be the case after the deadline to be defined in Rule 5 *bis*, even though after that date any

Contracting Party will be permitted under Rule 5bis(1)(a), to exclude the filing of communications on paper, except as provided under Article 8(1) (d) and Article 5(1).

ALTERNATIVE B

8.05. *Paragraphs 1(b) and (c)* As suggested at the eighth session of the SCT (see document SCT/8/7, paragraphs 47, 53 and 58) the paragraphs (b) and (c) have been redrafted in an affirmative form. Paragraph (a) ensures that a Contracting Party may continue to accept the filing of communications on paper and is not obliged to exclude the filing of communication on paper. However, for those Contracting Parties which so wish, paragraph (b) ensures the possibility of introducing the filing of communications on other means than on paper. The date, after which, any Contracting Party may, subject to Articles 5(1) and 8(1) (d), exclude the filing of communications on paper or may continue to permit the filing of communications on paper, should be defined in Rule 5bis(1)(a). After that date, any Contracting Party will be permitted, but not required, to exclude the filing of communications on paper, except for the purposes of a filing date under Article 5(1) and for meeting a time limit under Article 8(1)(d).

8.06. *Paragraph 1(d)*. Some delegations in the SCT suggested the deletion of paragraph (d) (see document SCT/8/7 paragraphs 49, 52 and 54). Other delegations noted that Article 8(1) (d) of the PLT reads “shall” and suggested to maintain Article 8(1)(d) in the TLT and change “may” to “shall” (see document SCT/8/7, paragraphs 54, 60 and 61). Under the revised provision, a Contracting Party is obliged to continue to accept the filing of communications on paper for the purpose of complying with a time limit, even where, after the date fixed in Rule 5bis(1), a Contracting Party excludes the filing of communications on paper. This provision has no effect on the countries which do not accept other applications than paper applications (see document SCT/8/7, paragraphs 40 and 41). The phrase “on paper” refers to paper forms transmitted by physical means (see Note 8.04). Where, for the purposes of complying with a time limit, an applicant files a communication on paper with an Office that requires the filing of communications on electronic form or by electronic means of transmittal, that Office will be permitted to treat the filing on paper as a formal defect, and to require, under paragraph (7), that the communication be re-filed in an electronic form or by electronic means of transmittal complying with the requirements applied by that Contracting Party under Rule 5bis(1).

8.07. *Paragraph (2)*. This paragraph provides, generally, that a Contracting Party may require that any communication be in a language admitted by the Office. However, Article 5(1)(b) expressly provides that, for the purposes of the filing date, the indications and elements referred to in Article 5(1)(a) may be received in a language other than the language required by the Office under the present paragraph. Paragraph (2) does not only cover the filing of application but applies to all the subsequent procedures of a mark in an Office. Therefore the repetition of this provision in other Articles would be superfluous (see document SCT/8/7 paragraphs 72, 73 and 74). The expression “a language admitted by the Office” refers to a verbal language and not, for example, to a computer language. What constitutes “a language admitted by the Office” remains a matter for the applicable law of the Contracting Party concerned.

8.08. The second sentence of Article 8(2) enables multilingual countries which allow the filing in different languages, to require the applicant, holder or the interested person, to comply with any other language requirements applicable with respect to their Offices, provided that the communication may not be required to be more than one language.

8.09. *Paragraph(3)*. This paragraph obliges a Contracting Party to accept communications filed on a Model International Form provided for in the Regulations. The effect of the phrase “subject to paragraph(1) (b)” is that a Contracting Party that does not accept the filing of communications other than on paper is not obliged to accept the filing of a communication on a Model International Form that applies, for example, to communications filed in electronic form or by electronic means of transmittal.

8.10. As suggested in the eighth session of the SCT the wording “presentation of the contents of a communication” in paragraph(3) is clarified and reads now “presentation of a communication” (see document SCT/8/7 paragraph 79). Since it is a generic provision for communication, similar provision in other Articles should be deleted.

8.11. Since Article 8(3) is a generic provision which covers all types of communications with an Office, the expression “the effects of a communication” has been added in order to cover the communication of a power of attorney. Article 4(3)(e) of the TLT currently states that “[...] no Contracting Party shall refuse the effects of the power of attorney [...] if it is presented, [...] on a form corresponding to the Power of attorney Form provided for in the Regulations.”

8.12. *Paragraph(4)*. The term “signature” means any means of self-identification. It is implicit that the “signature” of a communication must be that of a person who is authorized to sign the communication concerned. Accordingly, the Office may reject the signature of a person who is not so authorized. Certain forms of signature that a Contracting Party shall accept, or may require, are expressly referred to under Rule 6(3) and (4), namely a hand-written, printed or stamped signature, a seal, a bar-coded label, or a signature filed in electronic form or by electronic means of transmittal. Since discussions on electronic signature are still underway at the international level, this provision is conceived in broad terms and makes an express reference to the Regulations where details may be fixed.

8.13. *Paragraph 4(a)*. Regulations concerning the signature of communications filed on paper, in electronic form or by electronic means of transmittal are prescribed in Rule 6(4), (5) and (6).

8.14. *Paragraph 4(b)*. Unless its law provides for the contrary, this provision obliges a Contracting Party to accept a signature of the person concerned as sufficient authentication when the communication concerns the surrender of a registration without the need for further authentication by way of, for example, attestation or notarization of that signature, thereby reducing the burden on applicants and holders.

8.15. *Paragraph 4(c)*. In case of reasonable doubt as to the authenticity of the signature, the Office may require the applicant, holder or other interested person filing the communication to file evidence of authenticity. Such evidence may, at the option of the applicant, holder or other interested person, be in the form of certification. The Office is may be obliged to inform the applicant of the reason for its doubt.

8.16. *Paragraph 5*. The indication that a Contracting Party may require under this paragraph should be prescribed in a new rule. This provision is rewritten in the negative as requested in the SCT (see document SCT/8/7 paragraphs 90 and 91).

8.17. *Paragraph 6(i) and (ii)*. What constitutes an address for correspondence or an address for legal service under these items is a matter for the applicable law of the Contracting Party concerned. It is also a matter for the applicable law of the Contracting Party concerned as to

whether, and in what circumstances, the Office requires an address for correspondence or an address for legal service, or both, and in what communications such address(es) shall be indicated.

8.18. *Paragraph 6(iii)*. This item is intended to provide for any future developments which necessitate a Contracting Party requiring an address other than those under items (i) and (ii), for example, an e-mail address or other electronic location. At present, no provision for such other address is included in the Regulations.

8.19. *Paragraph 7*. It is to be noted that, under this paragraph, the Office is required to notify either the applicant, owner or other interested person who filed the communication, not later than three. The time limit provided for in this paragraph is not yet provided for in the Regulations.

8.20. *Paragraph 8*. The effect of the reference to Article 5 is that, where an application complies with the requirements under that Article for according a filing date, a Contracting Party is obliged to accord that filing date and cannot revoke the filing date for failure to comply with requirements applied under paragraphs (1) to (6), even where the application is subsequently refused or considered withdrawn under this paragraph. The time limit under this provision is not yet included in the Regulations.

Articles 13bis and 13ter

ALTERNATIVE A

Article 13bis (Relief in respect of time limits)

13bis.01. This Article obliges a Contracting Party to provide relief in respect of time limits. Such relief may be in the form of an extension of a time limit under paragraph (1) and/or continued processing under paragraph (2). Such relief is subject only to the filing of a request in accordance with the requirements of paragraph (1) and (2) and Rule 9, and the payment of any fee required under the paragraph (4). Accordingly, the applicant or holder cannot be required to state the grounds on which the request is based. In addition, in contrast to the reinstatement of rights under Article 13ter, a Contracting Party is not permitted to make the grant of relief under Article 13bis conditional on a finding of due care or unintentionality by the Office.

13bis.02. The relief that a Contracting Party is obliged to provide under paragraphs (1) and (2) is restricted to time limits "fixed by the Office for an action in a procedure before the Office". It is further subject to certain exceptions under paragraph (3) and Rule 9(5). It is for each Contracting Party to decide which time limits, if any, are fixed by the Office. An example of a time limit that is fixed by some Offices is the time limit for response to an examiner's substantive examination report. It follows that Article 13bis does not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation. It also does not apply to time limits for actions that are not before the Office, for example, actions before a court. Accordingly, although a Contracting Party is free to apply the same requirements in respect of such other time limits, it is also free to apply other requirements, or to make no provision for relief (other than reinstatement or rights under Article 13ter), in respect of those other time limits.

13bis.03. *Paragraph (1)*. This paragraph provides for relief in the form of the extension of a time limit fixed by the Office. Under item (i) Contracting Party may require that the request for extension be filed before the expiration of that time limit. Under item (ii), a Contracting Party may require that the request be filed after that expiration and within the time limit prescribed in

Rule 9(2). A Contracting Party may, of course, provide for both types of relief under items (i) and (ii). There are requirements in respect of the request, the period of extension, and the time limit for filing a request referred to in item (ii) are prescribed in Rule 9(1) and (2). In particular, a Contracting Party may, under Rule 9(1) (b), require that all of the requirements in respect of which the time limit to be extended applied be complied with at the same time as the request under item (ii) is filed.

13bis.04. Paragraph 1 does not oblige a Contracting Party to provide for the extension of a time limit fixed by the Office under either item (i) or (ii). However, a Contracting Party that does not provide for extension after expiration of the time limit under item (ii) must provide for continued processing under paragraph (2).

13bis.05. Paragraph (2). This paragraph obliges a Contracting Party to provide for relief in the form of continued processing, after the applicant or holder has failed to comply with a time limit fixed by the Office, where that Contracting Party does not provide for the extension of time limits under paragraph (1)(ii). The effect of such continued processing is that the Office continues with the procedure concerned as if the time limit had been complied with. Also, the Office must, if necessary, reinstate the rights of the applicant or holder with respect to the application or registration concerned. The requirements in respect of the request referred to in item (i) are prescribed in Rule 9(3). The time limit for filing a request, and complying with all the requirements in respect of which the time limit concerned applied, referred to in item (ii), is prescribed in Rule 9(4).

13bis.06. Paragraph (3). The exceptions under this paragraph are prescribed in Rule 9(5).

13bis.07. Paragraph (4). Although a Contracting Party is permitted to charge a fee under this paragraph, it is not obliged to do so.

13bis.08. Paragraph (5). This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1) to (4). In particular, the applicant or holder concerned cannot be required to state the grounds on which the request is based or to file evidence with the Office. The requirements referred to in this paragraph which are "otherwise provided for by this Treaty or prescribed in the Regulations" are, in particular, those under Articles 4 and 8 and Rules 4, 5 bis and 6.

13bis.09. Paragraph (6). This paragraph only gives the requesting party the right to make observations on the intended refusal of a request under paragraph (1) to (2), for example, to assert that a fee required under paragraph (4) had in fact been paid. The term "intended refusal" does not imply that a Contracting Party would have to notify an applicant prior to refusal, giving him the opportunity to show the cause why a request should be denied. This paragraph does not provide an additional time limit to comply with any requirement under Article 13bis or Rule 9 that was not complied with in making the request. This paragraph does not regulate the form of observations which an applicant or holder must be given an opportunity to make. The term "refusal" is meant also to cover sanctions which are of equivalent effect to refusal of the request under paragraph (1), such as the request being treated as abandoned or withdrawn.

Article 13ter (Reinstatement of Rights After a Finding of Due Care Or Unintentionality by the Office)

13ter.01. This Article obliges a Contracting Party to provide for the reinstatement of rights with respect to an application or a registration following a failure to comply with a time limit for an action in a procedure before the Office. In contrast to Article 13bis, such reinstatement is subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or, at the option of the Contracting Party, was unintentional. Also in contrast to Article 13bis, Article 13ter is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (2) and Rule 10(2).

13ter.02. *Paragraph (1), introductory words.* The phrase “that failure has the direct consequence of causing a loss of rights with respect to an application or a procedure concerning a mark” is intended to cover the situations where a failure to comply with a time limit causes a loss of rights with respect to the ability to obtain or maintain a registration.

13ter.03. *Item (i).* The Regulations under this item are prescribed in Rule 10.

13ter.04. *Item (ii).* The time limit under this item is prescribed in Rule 10(2)

13ter.05. *Item (iii).* The applicant or holder may be required under paragraph (4) to file a declaration or other evidence in support of the reasons referred to in this item.

13ter.06. *Item (iv).* This item restricts reinstatement of rights under paragraph (1) to cases where the Office finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances, or, at the option of the Contracting Party, was unintentional, for example, where there had been a loss in the mail or an interruption in e-mail service. In making that finding, the Office may allow interested third parties to oppose to the request for reinstatement of rights.

13ter.07. *Paragraph (2).* The exceptions under this paragraph are prescribed in Rule 10(3).

13ter.08. *Paragraph (3).* Reference is made to the explanations given under Article 13bis.07.

13ter.09. *Intervening Rights.* The Treaty and Regulations do not regulate the rights, if any, acquired by a third party for any acts which were restarted, or for which effective and serious preparations were restarted, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated. These remain a matter for the applicable law of the Contracting Party concerned.

ALTERNATIVE B

Article 13bis (Relief in Respect of Time Limits - Reinstatement of Rights)

13bis.01. This Article obliges a Contracting Party to provide relief in respect of time limits. Such relief may be in the form of an extension of a time limit under paragraph (1) and/or continued processing and reinstatement of rights under paragraph (2). Such relief is subject only to the filing of a request in accordance with the requirements of paragraph (1) and (2) and Rule 9, and the payment of any fee required under the paragraph (4). Accordingly, the applicant or holder cannot

be required to state the grounds on which the request is based. In addition, in contrast to the reinstatement of rights under paragraph (2) (b), a Contracting Party is not permitted to make the grant of relief under paragraphs (1) and 2 (a) conditional on a finding of due care or unintentionality by the Office. The word “mark” in Article 13bis is replaced by “registration of a mark” in order to comply with the definition in Article 1(ii) (see document SCT/8/7 paragraph 124)

13bis.02. The relief that a Contracting Party is obliged to provide under paragraphs (1) and (2) is restricted to time limits “fixed by the Office for an action in a procedure before the Office”. It is further subject to certain exceptions under paragraph (3) and Rule 9(6). It is for each Contracting Party to decide which time limits, if any, are fixed by the Office. An example of a time limit that is fixed by some Offices is the time limit for response to an examiner’s substantive examination report. It follows that Article 13bis does not apply to time limits that are not fixed by the Office, in particular, time limits established by national legislation. It also does not apply to time limits for actions that are not before the Office, for example, actions before a court. Accordingly, although a Contracting Party is free to apply the same requirements in respect of such other time limits, it is also free to apply other requirements, or to make no provision for relief (other than reinstatement of rights under paragraph 2 (b)), in respect of those other time limits.

13bis.03. *Paragraph (1)*. This paragraph provides for relief in the form of the extension of a time limit fixed by the Office. Under item (i) a Contracting Party may require that the request for extension be filed before the expiration of that time limit. Under item (ii), a Contracting Party may require that the request be filed after that expiration and within the time limit prescribed in Rule 9(2). A Contracting Party may, of course, provide for both types of relief under items (i) and (ii). The requirements in respect of the request, the period of extension, and the time limit for filing a request referred to in item (ii) are prescribed in Rule 9(1) and (2). In particular, a Contracting Party may, under Rule 9(1)(b), require that all of the requirements in respect of which the time limit to be extended applied be complied with at the same time as the request under item (ii) is filed.

13bis.04. Paragraph (1) does not oblige a Contracting Party to provide for the extension of a time limit fixed by the Office under either item (i) or (ii). However, a Contracting Party that does not provide for extension after expiration of the time limit under item (ii) must provide for continued processing under paragraph (2) (a).

13bis.05. *Paragraph (2)(a)*. This paragraph obliges a Contracting Party to provide for relief in the form of continued processing, after the applicant or holder has failed to comply with a time limit fixed by the Office, where that Contracting Party does not provide for the extension of time limits under paragraph (1)(ii). The effect of such continued processing is that the Office continues with the procedure concerned as if the time limit had been complied with. Also, the Office must, if necessary, reinstate the rights of the applicant or holder with respect to the application or registration concerned. The requirements in respect of the request referred to in item (i) are prescribed in Rule 9(3). The time limit for filing a request, and complying with all the requirements in respect of which the time limit concerned applied, referred to in item (ii), is prescribed in Rule 9(4).

13bis.06. The paragraph 2(b) obliges a Contracting Party to provide for the reinstatement of rights with respect to an application or a registration following failure to comply with a time limit for an action in a procedure before the Office. In contrast to paragraphs (1) and (2) (a) such reinstatement is subject to a finding by the Office that the failure occurred in spite of due care required by the circumstances or, at the option of the Contracting Party, was unintentional. Also in

contrast to paragraphs (1) and 2 (a) paragraph 2 (b) is not restricted to time limits fixed by the Office, although it is subject to certain exceptions under paragraph (3) and Rule 9(5).

13bis.07. *Paragraph(2)(b)* The phrase “that failure has the direct consequence of causing a loss of rights with respect to an application or a procedure concerning a mark” is intended to cover the situations where a failure to comply with a time limit causes a loss of rights with respect to the ability to obtain or maintain a registration.

13bis.08. *Paragraph(3)*. The exceptions under this paragraph are prescribed in Rule 9(6).

13bis.09. *Paragraph(4)*. Although a Contracting Party is permitted to charge a fee under this paragraph, it is not obliged to do so.

13bis.10. *Paragraph(5)*. This provision prohibits a Contracting Party from imposing requirements additional to those provided under paragraphs (1) to (4). In particular, the applicant or holder concerned cannot be required to state the grounds on which the request is based or to file evidence with the Office. The requirements referred to in this paragraph which are “otherwise provided for by this Treaty or prescribed in the Regulations” are, in particular, those under Articles 4 and 8 and Rules 4, 5 bis and 6.

13bis.11. *Paragraph(7)*. This paragraph only gives the requesting party the right to make observations on the intended refusal of a request under paragraph (1) to (2), for example, to assert that a fee required under paragraph (4) had in fact been paid. The term “intended refusal” does not imply that a Contracting Party would have to notify an applicant prior to refusal, giving him the opportunity to show the cause why a request should be denied. This paragraph does not provide an additional time limit to comply with any requirement under Article 13bis or Rule 9 that was not complied with in making the request. This paragraph does not regulate the form of observations which an applicant or holder must be given an opportunity to make. The term “refusal” is meant also to cover sanctions which are of equivalent effect to refusal of the request under paragraph (1), such as the request being treated as abandoned or withdrawn.

13bis.12. *Intervening Rights*. The Treaty and Regulations do not regulate the rights, if any, acquired by a third party for any acts which were restarted, or for which effective and serious preparations were restarted, in good faith, during the period between the loss of rights resulting from the failure to comply with the time limit concerned and the date on which those rights are reinstated. These remain a matter for the applicable law of the Contracting Party concerned.

[End of Annex and of document]