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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Ninth Session
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FURTHER DEVELOPMENT OF INTERNATIONAL TRADE MARK LAW
AND CONVERGENCE OF TRADE MARK PRACTICES

Prepared by the Secretariat

INTRODUCTION

1. During the eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from May 27 to 31, 2002, the SCT asked the Secretariat to draft a questionnaire on substantive matters relating to trademark law on the basis of the views expressed by the Committee at its eighth session when discussing these principles contained in Document SCT/8/3.
2. Pursuant to the request of the Standing Committee, the Secretariat has prepared the attached questionnaire. The questionnaire will be presented to the SCT for discussion at the ninth session. It is not necessary to complete it at this stage. Based on the discussion to take place at the ninth session of the SCT, the questionnaire will be revised. Thereafter, it will be circulated to the WIPO Member States, intergovernmental and non-governmental organizations, for completion prior to the tenth session of the SCT.
3. The purpose of the questionnaire, is to collect information regarding the national practices of Member States of WIPO and to identify issues which require to be addressed at the international level concerning the further development of international trademark law and the convergence of national trademark practices. A similar approach was taken in 1985 in the context of preparatory work on a new treaty for the international registration of trademarks. This followed work conducted by WIPO in 1977 regarding Major Provisions of Trademark Legislation in Selected Countries, presented in the form of Summary Tables (WIPO Publication N° 113). Considering the norms and standards recently adopted at the international level in the field of trademark law, it may be useful to get at present a clear picture of the current national practices in the field of trademark law. This exercise should not, under any circumstances, be considered as interpreting the provisions of national legislation.
4. The questionnaires should assist in pursuing future work of the SCT aimed at further simplifying the work of national intellectual property offices and at providing a clear legal framework for trademark applicants and holders and their representatives, and for third parties and the general public (consumers) through a convergence of national laws or practices. By creating legal certainty through the adoption of common approaches, significant time and cost savings could be achieved for the users of the many different trademark systems that exist worldwide as well as for industrial property offices.
5. The basis for this work may be found in the revised Program and Budget for 2002-2003 which 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 desirability and feasibility of harmonizing substantive trademark law, including the protection for new trademarks (sound, smell, three-dimensional marks, etc.), the requirements for use of a mark prior to registration, substantive grounds for refusal, etc.; facilitation of discussion in the SCT to incorporate in this framework the Joint Recommendation concerning provisions on the protection of well-known marks, and the Joint Recommendation on the protection of marks and other industrial property rights in signs, on the Internet."

6. At the eighth Session (May 27 to 31, 2002) of the SCT, Member States initiated discussions on the further harmonization of substantive trademark law. The in-depth exchange of views which took place was based on document SCT/8/3, prepared by the Secretariat, providing preliminary indications of topics to be discussed regarding the substantive harmonization of trademark laws. Discussions illustrated the broad diversity of national systems, procedures and approaches in the field of marks. Various definitions of this term "mark", including non-traditional marks (olfactory or smell marks, sound marks, holograms and three-dimensional marks) were broadly discussed. Many SCT members noted the difficulties in the examination of such marks, particularly for small IPO Offices. The graphic representation of some sound marks or smell marks as well as the determination of the distinctive character of three-dimensional marks was pointed out particularly as being problematic.

7. The SCT also discussed the possibility of establishing an exhaustive list of absolute grounds for refusal, based on the list of Article 6 *quinquies* (B) of the Paris Convention. Relative grounds for refusal (conflicts with prior rights) were also thoroughly debated. National trademark laws vary considerably as to nature of the prior rights based on which the registration of a similar mark may be refused. The SCT also discussed the appropriate use of the commonly known symbols TM and ®. The use of these symbols is not currently regulated at the international level and it was felt that some clarification as to the use of these symbols would be useful, particularly because of the development of the Internet.

8. Issues such as the processing of applications for the registration of a mark (for example, maximum time limit for a first Office action or the possibility of fixing an opposition), the examination procedures (convergence of practices as to the examination of absolute grounds and/or relative grounds for refusal), what constitutes use of a mark for the purpose of determining acquisition or maintenance of a right in a mark and the relevant requirements of use of a mark, were not debated at the eighth session of the SCT, but are, however, included in the attached questionnaire.

9. The SCT is invited to consider the proposal referred to in paragraph 2 above, and comment on the questionnaire as contained in the Annex to this Document.

[Annex follows]

ANNEX

QUESTIONNAIRE ON TRADEMARKS

I. DEFINITION

1. According to the applicable legislation, a mark is defined as:

- | | | | | |
|----|---|-----|----|-----|
| A. | Anysignorcombinationofsigns, capableofdistinguishingthegoodsorservices ofanundertakingfromthegoodsorservicesofanotherundertaking. | YES | NO | N/A |
| B. | Signsvisuallyperceptible | YES | NO | N/A |
| C. | Signscapableofbeingrepresentedgraphically | YES | NO | N/A |
| D. | Other | YES | NO | N/A |

If YES, please explain _____

2. Does the applicable legislation provide for any specific categories of signs to be excluded from registration as a mark

YES	NO	N/A
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Please explain: _____

II. TYPES OF MARKS REGISTERABLE

Can the following signs be registered as marks under the applicable legislation?:

- | | | | | |
|----|-----------------------------|-----|----|-----|
| A. | Denominations | | | |
| 1. | Words in foreign languages | YES | NO | N/A |
| 2. | Personal names/famous names | YES | NO | N/A |
| 3. | Letters | YES | NO | N/A |
| 4. | Numbers | YES | NO | N/A |

B. Non-traditional marks

- | | | | | |
|----|--|-----|----|-----|
| 1. | Colormarks | YES | NO | N/A |
| | i. Singlecolor | YES | NO | N/A |
| | ii. Combinationofcolors | YES | NO | N/A |
| | iii. Combinationofcolorsassociatedwithothersigns | YES | NO | N/A |

2. Soundmarks

- | | | | | |
|-----|---------------|-----|----|-----|
| i. | Musicalsounds | YES | NO | N/A |
| ii. | Othersounds | YES | NO | N/A |

If YES, please list them and explain how they can be represented graphically in the application _____

- | | | | | |
|----|-----------------|-----|----|-----|
| 3. | Olfactory marks | YES | NO | N/A |
|----|-----------------|-----|----|-----|

If YES, how are they represented graphically? _____

4. Three-dimensional marks

- | | | | | |
|-----|-------------------------------|-----|----|-----|
| i. | Product packaging/trade dress | YES | NO | N/A |
| ii. | Product shape | YES | NO | N/A |

- | | | | | |
|----|-----------|-----|----|-----|
| 5. | Holograms | YES | NO | N/A |
|----|-----------|-----|----|-----|

If YES, how are they represented graphically? _____

6.	Slogans	YES	NO	N/A
7.	Movie/BookTitles	YES	NO	N/A
8.	Motion/multimediasigns	YES	NO	N/A

How are they represented graphically? _____

9.	Others	YES	NO	N/A
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If YES, please list them and explain how they are represented graphically? _____

10.	Do the same examiner examine non-traditional and traditional marks?	YES	NO	N/A
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11. If NO, who examines non-traditional marks? _____

12.	Is there any special training given to those who examine marks?	YES	NO	N/A
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C.	ServiceMarks	YES	NO	N/A
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1.	Are marks for retail services protected?	YES	NO	N/A
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D. "Special" Types of Marks

1.	Defensive marks?	YES	NO	N/A
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2.	Associated marks?	YES	NO	N/A
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3.	A series of marks?	YES	NO	N/A
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4.	Collective marks?	YES	NO	N/A
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5.	Certification marks?	YES	NO	N/A
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III. BASIS FOR THE REGISTRATION OF A MARK

1. Can an application be based on use? YES NO N/A

2. Can an application be based on intent to use? YES NO N/A

3. Others: _____

4. Must evidence of use/intent to use be provided at the time of filing?
YES NO N/A

5. Is use required before registration? YES NO N/A

IV. APPLICATION PROCEDURE

1. Is there a maximum time limit for a first Office action on a trademark application?
YES NO N/A

2. Are procedures available to expedite the processing of an application?
YES NO N/A

If YES, is there an additional fee? YES NO N/A

3. Are multiple -class applications permitted?
YES NO N/A

4. Is electronic filing permitted? YES NO N/A

If YES, what are the problems you may have encountered?

5. Can applications be assigned? YES NO N/A

V. EXAMINATION PROCEDURE

1. Does the IP office *ex officio* examine applications for marks with regard to:

A. Formal requirements? YES NO N/A

B.	Absolute grounds/inherent registrability?	YES	NO	N/A
C.	Relative grounds for refusal (prior rights)?	YES	NO	N/A
D.	Grounds for refusal as a whole (with no distinction as to Band C)?	YES	NO	N/A
E.	Others: _____			

2. Does the examination occur:

A.	prior to the publication of the application?	YES	NO	N/A
B.	after publication?	YES	NO	N/A

3. Absolute grounds for refusal

If the application is examined to determine whether it meets statutory requirements, what are, according to your legislation, the absolute grounds for refusal?

A.	Signs which do not satisfy the requirement of the definition of a mark (e.g., not capable of being graphically represented,...)	YES	NO	N/A
B.	Signs devoid of any distinctive character	YES	NO	N/A
C.	Signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production (descriptive signs).	YES	NO	N/A
D.	Signs which have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed (generic terms).	YES	NO	N/A
E.	Signs contrary to morality or public order	YES	NO	N/A
F.	Signs of such a nature as to deceive the public	YES	NO	N/A
G.	Signs contrary to Article 6 ^{ter} of the Paris Convention	YES	NO	N/A
H.	Signs benefiting protection from other international conventions (Red Cross, Olympics symbols...)	YES	NO	N/A
I.	Signs protected by national law			
	i. Royal emblems	YES	NO	N/A

ii.	Indigenoussigns	YES	NO	N/A
iii.	Others	YES	NO	N/A
J.	Well-knownmarks/famousmarks/markshavingareputation	YES	NO	N/A
K.	Appellationsoforigin	YES	NO	N/A
L.	Businessnames	YES	NO	N/A
M.	Namesoffamouspersons	YES	NO	N/A
N.	Foreignwordsoexpressions	YES	NO	N/A
O.	Others: _____			

4.	Musttheexaminerfollowprecedents?	YES	NO	N/A
	i) Decisionsofjudicialoradministrativetribunals	YES	NO	N/A
	ii) Decisionsofothere xaminers	YES	NO	N/A
5.	Lengthoftimegiventooapplicanttorespondto <i>ex parte</i> objections: _____			

6.	Areextensionsoftimegrantedtorespondto <i>ex parte</i> objections?	YES	NO	N/A
7.	Relativegrounds(pri orrights)			
	Iftheapplicationisexamined <i>ex officio</i> todeterminewhetherthetrademarkapplication isinconflictwithpriorrights,whatare,accordingtotheapplicablelegislation, consideredaspriorrights?			
A.	Anidenticalmarkregisteredorapplied forbyanotherpersoninrespectof identicalgoodsorservices	YES	NO	N/A
B.	Anidenticalmarkregisteredorappliedforbyanotherpersoninrespectof similargoodsorservices	YES	NO	N/A
C.	Asimilarmarkregisteredorappliedforbyanotherpersoninrespectofidentical goodsorservices	YES	NO	N/A

D.	Asimilar mark registered or applied for by another person in respect of similar goods or services	YES	NO	N/A
E.	A well-known mark	YES	NO	N/A
F.	Indigenous signs	YES	NO	N/A
G.	Business names	YES	NO	N/A
H.	Appellation of origin/ Geographical indications	YES	NO	N/A
I.	Industrial designs	YES	NO	N/A
J.	Copyrights	YES	NO	N/A
K.	Personal names	YES	NO	N/A
L.	Collective or certification marks	YES	NO	N/A
M.	Unregistered trademarks	YES	NO	N/A
N.	Others	YES	NO	N/A

If YES, please list them: _____

8. Effective Date of Registration

1.	Filing Date of application?	YES	NO	N/A
2.	Date of issuance of certificate of registration?	YES	NO	N/A

3. Others: _____

9. Proof of Acquired Distinctiveness

1.	Are certain marks registrable only with proof of acquired distinctiveness?	YES	NO	N/A
----	--	-----	----	-----

If YES, please list them: _____

- | | | | | |
|----|--|-----|----|-----|
| 2. | In the case of composite trademarks with non -distinctive words or elements, may the applicant be asked to disclaim such words or elements of his trademark? | YES | NO | N/A |
|----|--|-----|----|-----|

VI. OPPOSITION PROCEDINGS

- | | | | | |
|----|---|-----|----|-----|
| 1. | Does the applicable registration system allow for opposition? | YES | NO | N/A |
|----|---|-----|----|-----|

- | | | | | |
|------|---|-----|----|-----|
| A. | Pre-registration (opposition to an application) | | | |
| i. | Before any examination | YES | NO | N/A |
| ii. | During examination | YES | NO | N/A |
| iii. | After the examination of formal requirements | YES | NO | N/A |
| iv. | After examination of absolute grounds for refusal | YES | NO | N/A |
| v. | After examination of relative grounds for refusal | YES | NO | N/A |
| vi. | Are applications published for opposition? | YES | NO | N/A |

- | | | | | |
|----|--|-----|----|-----|
| B. | Post-registration (opposition to a registration) | YES | NO | N/A |
|----|--|-----|----|-----|

- | | | | | |
|----|--|-----|----|-----|
| 2. | What is the length of the opposition period? | | | |
| A. | 2 months | YES | NO | N/A |
| B. | 3 months | YES | NO | N/A |
| C. | More than 3 months | YES | NO | N/A |

If YES, please specify: _____

- | | | | | |
|----|---------------------------|-----|----|-----|
| D. | Are extensions available? | YES | NO | N/A |
|----|---------------------------|-----|----|-----|

Please explain under what conditions: _____

3. Publication

Where is the application/registration published for opposition?

A. In a gazette	YES	NO	N/A
B. On the IP office website	YES	NO	N/A
C. Both (A and B)	YES	NO	N/A
D. Other	YES	NO	N/A

Please describe what is the frequency of the publication: _____

Indicate which publication is "official" (i.e. has legal effect?) _____

4. When is the starting date of the opposition period?

A. The publication of the application for registration	YES	NO	N/A
B. The publication of the registration	YES	NO	N/A

C. Others: _____

5. Whom may invoke an opposition?

A. Any person	YES	NO	N/A
B. Anyone showing a legitimate interest	YES	NO	N/A

C. Any competent authorities YES NO N/A

D. Other: _____

6. Are opposition proceedings available:

A. Before the registry/IP Office? YES NO N/A

B. Before a judicial body? YES NO N/A

C. Other? YES NO N/A

Please explain: _____

7. Is there a procedure for appeals? YES NO N/A

A. Before the registry/IP Office? YES NO N/A

B. Before an administrative body? YES NO N/A

C. Before a Court? YES NO N/A

8. Within which period of time, appeal is possible?

A. 2 months after the registration YES NO N/A

B. 3 months after the registration YES NO N/A

C. More than 3 months after the registration YES NO N/A

Please explain: _____

9. What are the possible grounds for opposition?

A. Likelihood of confusion with prior registered mark.
YES NO N/A

B. Likelihood of confusion with prior unregistered mark.
YES NO N/A

C. Likelihood of confusion with a pending application.

	YES	NO	N/A
D. Appellation of origin	YES	NO	N/A
E. Geographic significance	YES	NO	N/A
F. Surname	YES	NO	N/A
G. Descriptiveness	YES	NO	N/A
H. Genericness	YES	NO	N/A
I. Other: _____ _____ _____			
10. In opposition proceedings, what factors are considered in determining likelihood of confusion?	YES	NO	N/A
Please explain: _____ _____ _____			
11. Is it possible to reach settlement agreements in opposition proceedings?	YES	NO	N/A
12. Is each party held responsible for his/her costs?	YES	NO	N/A \
13. Does the losing party bear the entire cost of the opposition proceeding?	YES	NO	N/A
14. What is the average time it takes to issue a decision after an opposition proceeding is finished (meaning no further submission will be accepted)? _____ _____ _____			

VII. RIGHTS GRANTED TO UNREGISTERED MARKS

1. Are unregistered marks protected under national law? <i>(If reply is NO, please skip to VIII. Use of a mark)</i>	YES	NO	N/A
2. Are unregistered marks protected against infringement?	YES	NO	N/A
3. Are unregistered marks protected against dilution?	YES	NO	N/A

- | | | | | |
|----|--|-----|----|-----|
| 4. | Doestheownerofapriorunregisteredmarkhaveanyrecourseagainsta subsequent user? | YES | NO | N/A |
| 5. | Doestheownerof apriorunregisteredmarkhaveanyrecourseagainsta subsequentapplicant/registrant? | YES | NO | N/A |
| 6. | SubjectMatterProtected: | | | |
| | A. UnregisteredWordmarks | YES | NO | N/A |
| | B. Unregisteredlogoandothernon -wordmarks | YES | NO | N/A |
| | C. Packaging | YES | NO | N/A |
| | D. Tradedress | YES | NO | N/A |
| | E. Companynames | YES | NO | N/A |
| 7. | CriteriaforProtectionofUnregisteredM arks | | | |
| | A. Isaleveloffame/priorrecognitionrequired? | YES | NO | N/A |
| | B. Isdistinctivenessrequired? | YES | NO | N/A |
| | C. Other: _____

_____ | | | |
| 8. | InfringementStandards | | | |
| | A. Isactualconfusionrequired? | YES | NO | N/A |
| | B. Islikelihoodofconfusionrequired? | YES | NO | N/A |
| | C. Others: _____

_____ | | | |
| 9. | Whatarethepenalties/damagesprovisionsforinfringementofunregisteredmarks? | | | |
| | A. Sameasregisteredmarks | YES | NO | N/A |
| | B. Others: _____

_____ | | | |

VIII. USE OF A MARK

- | | | | | |
|----|---|-----------|----|-----|
| 1. | Does the applicable legislation provide for a use requirement? | YES | NO | N/A |
| 2. | If use is required to maintain a registration what uninterrupted period of non-use is considered? | ... years | | |
| 3. | Must use be substantiated during the registration period (for example prior to renewal) | YES | NO | N/A |
| 4. | Does the legislation define what use is required (e.g., use in advertisements, on product, etc.) | YES | NO | N/A |

If YES, please give definition: _____

- | | | | | |
|----|--|-----|----|-----|
| 5. | According to your legislation, do the following acts constitute use: | | | |
| A. | Use in commercials or advertising | YES | NO | N/A |
| B. | Use of a registered mark in a different form, the elements of which do not alter the distinctive character of the mark as registered | YES | NO | N/A |
| C. | Affixation of a mark to goods or to the packaging thereof in your country solely for export purposes | YES | NO | N/A |
| D. | Use of a mark by a person other than the holder, if such use is made with the holder's content | YES | NO | N/A |
| E. | Use of a mark as a business name or a business symbol, and not in relation to the goods or services for which the mark is protected | YES | NO | N/A |
| F. | Use for the purpose of a mark of a test of goods or service | YES | NO | N/A |

6. What other types of use fulfil the use requirement?
 Please explain: _____

- | | | | | |
|----|--|-----|----|-----|
| 7. | Periods of use/non-use after registration | | | |
| A. | Is the uninterrupted period of non-use computed from the date of registration? | YES | NO | N/A |

- B. Is the uninterrupted period of non-use computed at any time during the registration? YES NO N/A
- C. Can the period of non-use be reset by subsequent use? YES NO N/A
- D. By other means? YES NO N/A

If Yes, please explain: _____

- E. What kind of valid reasons shown by the holder of the mark will excuse non-use? YES NO N/A

Please explain: _____

- F. Does your legislation provide for a "grace" period between the end of the uninterrupted period of non-use and the introduction of an action for cancellation/revocation of the mark for non-use? YES NO N/A

- G. In such case, does your legislation provide for a specific period during which commencement or resumption of use is not taken into account when the holder of the mark was aware [or could not have been unaware] that an action for cancellation/revocation may be introduced? YES NO N/A

- H. Are there sanctions for unjustified non-use of a registered mark? YES NO N/A

IX. MARKING REQUIREMENTS (™, ®, *marquedéposée*, *marcaregistrada*) ON THE REFERENC TO THE MARK (NOT ON THE PRODUCT ITSELF)

1. Are markings allowed to indicate registration? YES NO N/A
2. Are markings allowed to indicate use (when mark is unregistered)? YES NO N/A
3. Are there optional marking provisions? YES NO N/A
4. Are there benefits from using optional markings? YES NO N/A
5. Which law applies for cases of false or deceptive usage of markings symbols

Please identify: _____

6. Are there penalties for non-use of marking symbols when it is required by law?
YES NO N/A

X. CANCELLATION OR/AND INVALIDATION PROCEEDINGS

1. Does failure of required use lead to *ex officio* cancellation of the registered mark?
YES NO N/A

2. Are proceedings available to remove a mark from the register at an administrative level in the Trademark Office?
YES NO N/A

i. If Yes, what are the standing requirements? _____

ii. By any interested person? YES NO N/A

3. Are appeal procedures available? YES NO N/A

4. Cancellation/Invalidation proceedings can start when within a continuous period of 5 years, the mark has not been put to genuine use in connection with the goods or services in respect of which it is registered.
YES NO N/A

If Yes, when does the 5 year period start ? _____

5. Are proceedings available to remove a mark from the register by a Court?
YES NO N/A

What are the standing requirements? _____

6. Are appeal procedures available? YES NO N/A

Please explain: _____

7. Are there restrictions in respect of the time period during which such proceedings may be brought? YES NO N/A

If Yes, give time period restriction: _____

8. Can some registrations become “incontestable?” YES NO N/A

If Yes, please explain how: _____

9. Possible Grounds for Removal:

A. Likelihood of confusion with prior registered mark YES NO N/A

B. Likelihood of confusion with prior unregistered mark YES NO N/A

C. Likelihood of confusion with pending application YES NO N/A

D. Appellation of origin YES NO N/A

E. Geographic significance YES NO N/A

F. Surname YES NO N/A

G. Descriptiveness YES NO N/A

H. Genericness YES NO N/A

I. Others: _____

10. Is there a period of time during which a third party or the owner of the removed mark may not apply to register the mark again? YES NO N/A

If Yes, please explain: _____

XI. RENEWAL OF REGISTRATION

1. Duration of Registration: _____
2. Window (period) for filing renewal applications: _____
3. Payment of renewal fee only required? YES NO N/A
4. How long is the period after expiration of registration during which renewal can still be made?

Please specify: _____

5. Does the IP Office contact the owner of the mark to inform him/her when his/her registration is due for renewal? YES NO N/A

6. Restoration

- A. Are there provisions to restore lapsed registration? YES NO N/A

If Yes, please explain _____

- B. Can restoration affect the rights of intervening users? YES NO N/A

If Yes, please explain: _____

- C. Can restoration affect the rights of intervening registrants of identical/similar marks? YES NO N/A

If Yes, please explain: _____

7.	Is there a period of time after non-renewal during which third parties are prevented from applying to register the same mark?	YES	NO	N/A
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If Yes, please explain: _____

8.	Are unlimited renewals available?	YES	NO	N/A
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9.	Must marks be used before they can be renewed?	YES	NO	N/A
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10.	Is evidence of use required upon renewal?	YES	NO	N/A
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If Yes, please explain: _____

11.	Duration of renewal:	_____		
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12.	Is a new number assigned each time a registration is renewed?	YES	NO	N/A
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13.	What other formalities must be observed upon renewal?	_____		

