

# WIPO



SCT/11/7

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

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

### Eleventh Session Geneva, November 10 to 14, 2003

#### SUMMARY BY THE CHAIR

##### Agenda Item 1: Opening of the Session

1. Mr. Shozo Uemura, Deputy Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the delegates on behalf of the Director General of WIPO.

##### Agenda Item 2: Adoption of the Draft Agenda

2. The SCT adopted the Draft Agenda (document SCT/11/1 Prov.) without modifications.

##### Agenda Item 3: Adoption of the Draft Report of the Tenth Session

3. The SCT adopted the Draft Report (document SCT/10/9 Prov.2) with minor modifications.

##### Agenda Item 4: Revision of the Trademark Law Treaty

4. The Standing Committee discussed the documents concerning the Draft Revised Trademark Law Treaty (TLT) (document SCT/11/2), Draft Revised Regulations under the Draft Revised Trademark Law Treaty (document SCT/11/3) and Notes (document SCT/11/4) and agreed, as follows:

Draft Article 8

*Paragraph (1).* There was consensus on this provision.

*Paragraph (2), subparagraphs (a), (b) and (c).* There was consensus on this provision.

*Paragraph (3).* Following discussion, consensus was reached on this provision as redrafted.

*Paragraph (4), subparagraphs (a), (b) and (c).* There was consensus on this provision as modified in Informal Document 2 prepared by the International Bureau.

*Paragraph (5).* There was consensus on this provision as redrafted.

*Paragraph (6).* There was consensus on this provision.

*Paragraph (7).* There was consensus on this provision.

*Paragraph (8).* There was consensus on this provision as redrafted. However, the inclusion of a reference to paragraph (2) was referred to the International Bureau for further study.

Draft Article 13*bis*

*Paragraph (1).* There was consensus on this provision as redrafted. However, some parts were referred to the SCT for further discussion concerning time limits.

*Paragraph (2).* There was consensus on this provision.

*Paragraph (3).* There was consensus on this provision.

*Paragraph (4).* There was consensus on this provision as redrafted.

*Paragraph (5).* There was consensus on the deletion of this provision. However, the inclusion of a reference to Article 13*bis* in Article 14 was referred to the International Bureau for further study and to the SCT for further discussion.

Draft Rule 6

*Paragraph (1).* There was consensus on this provision.

*Paragraph (2).* There was consensus on this provision.

*Paragraph (3).* There was consensus on this provision.

*Paragraph (4).* There was consensus on this provision as redrafted. However, one delegation was not able to join the consensus at this stage of the discussion.

*Paragraph (5).* There was consensus on this provision.

*Paragraph (6).* There was consensus on this provision.

#### Draft Rule 7

*Paragraph (1).* There was consensus on this provision.

*Paragraph (2).* There was consensus on this provision.

*Paragraph (3).* There was consensus on this provision.

*Paragraph (4).* There was consensus on this provision.

*Paragraph (5)(a).* There was consensus on this provision.

*Paragraph (5)(b).* There was consensus on this provision as redrafted.

#### Draft Rule 10

*Paragraph (1).* There was consensus on this provision as redrafted.

*Paragraph (2).* There was consensus on this provision as redrafted.

*Paragraph (3).* There was consensus on this provision as redrafted.

*Paragraph (4).* There was consensus on this provision as redrafted. However, the inclusion of a time limit was referred to the International Bureau for further study.

*Paragraph (5).* There was consensus on this provision as redrafted. However, item (iii) was referred to the International Bureau for further study and to the SCT for further discussion.

The text reflecting the results of the deliberations on Articles 8 and 13*bis* and Rules 6, 7 and 10 is contained in the Annex.

#### Chapter II: Trademark Licenses

After a general exchange of views which showed a difference of opinions as to whether this chapter should be included in the revised TLT, the Committee decided to pursue the examination of the provisions contained in Articles 17 to 21 at the next meeting of the SCT.

#### Agenda Item 5: Internet Domain Names

5. With regard to the issues considered in paragraph 13 of document SCT/10/5 (“The Protection of Country Names in the Domain Name System”), the SCT decided to inform ICANN that no recommendation would be made to extend protection to names by which countries are familiarly or commonly known.

6. In respect of the question of sovereign immunity of States, referred to in paragraph 18 of document SCT/10/5, the SCT decided to inform ICANN that no recommendation would be made to establish a special appeal mechanism by way of *de novo* arbitration.

7. With regard to the issue of domain names and geographical indications, further discussion was requested.

#### Agenda Item 6: Geographical Indications

8. With regard to the issue of geographical indications, further discussion was requested.

#### Agenda Item 7: Other Matters

9. The Committee was reminded that replies to the Questionnaire on Trademark Law and Practice (document SCT/11/6) should be sent to the International Bureau before the end of the year.

10. It was suggested that the registration of well-known marks in national registries deserves consideration by the Committee.

11. It was suggested that the protection provided under Article 6*ter* of the Paris Convention deserves consideration by the Committee.

#### Agenda Item 8: Future Work

12. The SCT decided that priority should be given to the revision of the TLT. The SCT further agreed that its twelfth session would last five full working days and that the agenda of that session would devote at least four full days to work on the TLT, leaving the last day flexible for consideration of other issues including the WIPO Questionnaire on Trademark Law and Practice, Geographical Indications, Domain Names and Geographical Indications, Article 6*ter* of the Paris Convention and the registration of well-known marks.

13. The provisional date of the twelfth session of the SCT will be April 26 to 30, 2004.

[Annex follows]

ANNEX

*Article 8*  
*Communications*

(1) [*Means of Transmittal of Communications*] Any Contracting Party may choose the means of transmittal of communications.

(2) [*Language of Communications*]

(a) Any Contracting Party may require that any communication be in a language 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 no indication or element of the communication may be required to be in more than one language.

(b) No Contracting Party may require the attestation, notarization, authentication, legalization or any other certification of any translation of a communication other than as provided under this Treaty.

(c) Where an Office does not require a communication to be in a language admitted by the Office, it may require that a translation of that communication by an official translator or a representative, into a language admitted by the Office, be supplied within a reasonable time limit.

(3) [*Presentation of a Communication*] Subject to paragraph (2), any Contracting Party shall accept the presentation of a communication, the content of which corresponds to the relevant Model International Form, if any, provided for in the Regulations.

(4) [*Signature of Communications*]

(a) Where a Contracting Party requires 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,

(i) where the law of the Contracting Party so provides, if the signature concerns the surrender of a registration, or,

(ii) in the case of a signature in electronic form, as prescribed in the Regulations.

(c) Notwithstanding 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) [*Prohibition of Other Requirements*] No Contracting Party may require that a communication comply with requirements other than those prescribed in this Article or in the Regulations.

(6) [*Address for Correspondence, Address for Legal Service*] Any Contracting Party may, subject to any provision prescribed in the Regulations, require that an applicant, holder or other interested person indicate in any communication an address for correspondence and/or an address for legal service.

(7) [*Original of a Communication Filed in Electronic Form or by Electronic Means of Transmittal*] Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal, it may require that the original of any such communication, accompanied by a letter identifying that earlier transmission, be filed on paper with the Office within a reasonable time limit.

(8) [*Notification*] Where one or more of the requirements under paragraphs [(2), and (4) to (7)][(4) to (7)] are not complied with in respect of a communication [in a language admitted by the Office], 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 a reasonable time limit.

*Article 13bis*  
*Measures in Case of Failure to Comply with Time Limits*

(1) [*Measures*] A Contracting Party shall provide for at least one of the following procedures, in accordance with the requirements prescribed in the Regulations, for the case where an applicant, holder or other interested person fails [,or is about to fail,] to comply with a time limit for an action in a procedure before the Office in respect of an application or a registration, and that time limit is [less than][not more than][six months][three months]:

- (i) an extension of the time limit for a reasonable period of time,
- (ii) continued processing with respect to the application or registration, or
- (iii) reinstatement of the rights of the applicant or holder with respect to the application or registration, 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, that the failure was unintentional.

(2) [*Exceptions*] No Contracting Party shall be required to provide for any of the procedures referred to in paragraph (1) with respect to exceptions prescribed in the Regulations.

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

(4) [*Prohibition of Other Requirements*] No Contracting Party may demand that requirements other than those referred to in this Treaty or in the Regulations be complied with in respect of the procedures provided for under paragraph (1).

*Article 14*  
*Opportunity to Make Observations in Case of Intended Refusal*

An application or a request under Articles 10 to 13[*bis*] 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.

*Rule 6*  
*Details Concerning the Signature Under Article 8(4)*

(1) [*Indications Accompanying Signature*] Any Contracting Party may require that the signature of the natural person who signs 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 signed, where such capacity is not obvious from reading the communication.

(2) [*Date of Signing*] Any Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature 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 handwritten signature;

(ii) may permit, instead of a handwritten signature, 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 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 handwritten signature.

(4) [*Signature of Communications Filed in Electronic Form or by Electronic Means of Transmittal Resulting in Graphic Representation*] Where a Contracting Party allows the transmittal of communications in electronic form or by electronic means of transmittal, it may 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 allows the transmittal 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)*] Any Contracting Party may require that any signature referred to in paragraph (5) be confirmed by a process for certifying signatures in electronic form specified by that Contracting Party.

#### *Rule 7*

##### *Details Concerning Indications Under Article 8(5), (6) and (8)*

(1) [*Details Concerning Indications Under Article 8(5)*]

- (a) Any 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 so registered.
- (b) Any 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 so registered.



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

(3) [*Address Where No Representative Is Appointed*] Where no representative is appointed and an applicant, holder or other interested person has provided, as his address, an address on a territory prescribed by the Contracting Party under paragraph (2), that Contracting Party shall consider that address to be the address for correspondence or the address for legal service, referred to in Article 8(6), as required by the Contracting Party.

(4) [*Address Where a Representative Is Appointed*] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for correspondence or the address for legal service, referred to in Article 8(6), as required by the Contracting Party.

(5) [*Sanctions for Non-Compliance with Requirements*]

(a) No Contracting Party may provide for the refusal of an application on grounds of failure to comply with any requirement to file a registration number or other indication under paragraphs (1)(a)(iii) and (b)(iii).

(b) Where a notification has not been made because indications allowing the applicant, holder or other interested person to be contacted by the Office have not been filed, a reasonable time limit shall be granted before the Contracting Party applies such sanctions as is provided for in its law.

#### *Rule 10*

##### *Requirements Relating to Measures in Case of Failure to Comply with Time Limits*

(1) [*Request for an Extension of a Time Limit*] Where a Contracting Party provides for an extension of a time limit, it may require that the request

(i) be filed with the Office prior to the expiration of that time limit,

(ii) be signed by the applicant or holder or the representative of the applicant or holder,

(iii) contain an identification of the time limit in question.

(2) [*Request for Continued Processing*] Where a Contracting Party provides for continued processing it may require that the request

(i) be filed with the Office prior or after the expiration of that time limit,

(ii) be signed by the applicant or holder or the representative of the applicant or holder,

(iii) contain an identification of the time limit in question,

and that the omitted act be completed.

(3) [*Request for Reinstatement of Rights*] Where a Contracting Party provides for the reinstatement of the rights of the applicant or holder, it may require that the request

(i) be filed with the Office,

(ii) be signed by the applicant or holder or the representative of the applicant or holder,

(iii) contain an identification of the time limit in question,

(iv) set out the facts and evidence in support of the reasons for the failure to comply with the time limit,

and that the omitted act be completed.

(4) [*Time Limit for Filing a Request for Reinstatement of Rights Under Paragraph (3)*] A request for reinstatement of rights shall be filed within a reasonable time limit from the date of the removal of the cause of failure to comply with the time limit in question or, not less than [ ] months from the date of expiration of the time limit in question, whichever is the earlier.

(5) [*Exceptions Under Article 13bis(2)*] The exceptions referred to in Article 13bis(2) are the cases of failure to comply with a time limit:

(i) for which relief has already been granted under Article 13bis(1)(i) or (ii);

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

[(iii) for payment of a renewal fee];

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

(v) for an action in *inter partes* proceedings;

(vi) for the correction or addition of a priority claim;

(vii) for filing the declaration referred to in Article 3(1)(a)(vii).

[End of Annex and of document]