In the General Assemblies September/October 2004 it has been decided that a Diplomatic Conference on the revision of the Trademark Law Treaty (TLT) will be convened in spring 2006 and that two further meetings of the SCT should be dedicated to the preparation of that Conference, one in October 2004 and a further meeting in April 2005. As a consequence, discussion of the October 2004 meeting during the whole week, including the morning session and a part of the afternoon session of Friday, October 29, 2004, focused on the Draft Revised TLT (Document SCT/13/2), and the Draft Revised Regulations under the Draft Revised TLT (Document SCT/13/3), prepared by the Secretariat. Only in a couple of minutes on Friday afternoon, before the Draft Summary of the Chair was adopted, the two further items of the agenda: Questionnaire on Trademark Law and Practice, and Internet Domain Names and Geographical Indications, were briefly mentioned and a short discussion took place on the Provisional Summary of Replies to the Questionnaire (Document SCT/13/5). At the time of preparation, 69 States and 3 intergovernmental Organizations (Benelux, European Union and OAPI) had replied. In the meantime some more replies were received and it was agreed that they should be inserted in the Summary. Be it as it may, it is clear that discussions on provisions for the harmonization of substantive trademark law will start only after adoption of the revised TLT. This does not exclude that in the SCT meeting of autumn 2005 a discussion on the questionnaire and on possible topics to be included in a draft paper on harmonization of substantive law will take place.

The TLT 1994

Before reporting on the discussions on the revision of the TLT, may I briefly recall the importance of this Treaty, which has been adopted thanks to an initiative of AIPPI. Even if it has been ratified “only” by 37 States (recent members are Germany and Turkey), it has considerably influenced recent legislation in much more countries, including India and Brazil and also the European Community Trade Mark System, in an effort to simplify administrative procedures before Trademark Offices. Its cornerstone is the provision in Art. 8(4) that no certification of any signature may be requested, supplemented by the prohibition for Offices
to request from applicants additional documents such as extracts from the register of commerce. Furthermore, maximum lists of possible requirements for trademark applications, according a filing date, changes in ownership (including a provision allowing the parties to submit a simple uncertified certificate of transfer) etc. are provided. These are only some of the highlights of the Treaty, which contains some more important provision.

For political reasons, which have been solved in the meantime, the Treaty had to be concluded without creating a special Union, which means that there exists no Assembly that could change the Regulations under the Treaty. Also, the Treaty does not yet contain provisions on electronic filing and the time was not yet ripe to include provisions on filing formalities for trademark licenses (which in September 2000 have been adopted in form of a Joint Recommendation). Furthermore, is was deemed useful to take on board certain provisions about relief in case of failure to comply with time limits that had been included in the more recent Patent Law Treaty. For these reasons, after a relatively short period of time after its adoption, work on a revision of the TLT was started in the SCT in March 2001.

**Revision of the TLT**

The revised documents prepared by the Secretariat took into account the changes that were agreed upon in the twelfth meeting of the SCT in April 2004. In the following the main points of discussion are dealt with.

**Article 2 (Marks to which the Treaty applies)**

Article 2 does not any more provide that only those Contracting Parties which accept three-dimensional marks for registration, are obliged to apply the Treaty to these marks. Consequently, the revised draft obliges Contracting Parties to register three-dimensional marks. However hologram marks continue under the Draft to be excluded, despite the fact that these are visible signs (non-visible signs, in particular sound marks and olfactory marks, are also excluded from its application). The Swiss Delegation had submitted a written proposal to include hologram marks in the definition of marks to which the TLT applies and that proposal was in principle accepted. The Secretariat will have to prepare a new draft for Article 2, which will also make clear that Contracting Parties are not obliged to accept for registration marks that are not registrable und the applicable law. However, if an Office registers hologram marks it will be obliged to apply the provisions of the TLT, and it is of course recommended that Offices apply them also, at least to the extent possible, to other marks such as sound marks, olfactory marks or moving marks.

**Article 8 (Communications) with Rule 6 (Details Concerning Communications)**

There was consensus on the revised wording of Article 8.
The revised TLT provides for the freedom of the Contracting Parties to choose between communications on paper, the submission of paper communications by electronic means (mainly by fax, but also e.g. per email with an attached scanned document) and/or exclusively electronic communications. The respective provisions in Rule 6 were in principle accepted, however some redrafting will be necessary. The wording of Paragraph 4 on electronic communications of documents signed on paper will have to take into account that Offices not always print out such document, which means that the requested signature will not necessarily be reproduced on a printout.

Notification and observations (Rule 6(7) and Article 22).

Rule 6 on communications provides in its paragraph 7 that the Office must notify the interested person where certain requirements under the TLT are not complied with in a communication, giving the opportunity to comply with such requirement within a reasonable time limit. The SCT decided that the contents of Rule 6(7) should be transferred to Article 22 which provides that in case of intended refusal of an application or of a request (relating to registration of a change of ownership, renewal etc.) the Office must give the requesting party an opportunity to make observations within a reasonable time limit.

Art. 14 (Measures in Case of Failure to Comply with Time Limits) and Rule 9 (Requirements Relating to such Measures).

The text of Article 14 provides that, as agreed in the last meeting, every Contracting Party must at least provide one of the following types of relief:

- an extension of a time limit for an action after the expiry of the time limit;
- continued processing;
- reinstatement of rights.

The meeting agreed that the text of the present draft was acceptable in substance, even if a number of interventions proposed different wording in an effort to simplify the provision. It was left to the Secretariat to reflect on an improved wording to be represented at the next meeting. Should the new draft not meet the consensus of the Committee, the text as agreed would remain.

The details of the three different types of relief are regulated in Rule 9 paragraphs 1 to 3. As concerns continued processing and reinstatement of rights, it was agreed that Contracting Parties should not only have the possibility to require the omitted act to be completed within the time period given for filing the request (two months from the date of expiry in the case of continued processing, reasonable time from the date of the removal of the cause of failure to comply with the time limit in case of reinstatement) but also that the omitted act be completed together with the request. Furthermore it was agreed that in
case of reinstatement of rights Contracting Parties may provide for a maximum time limit of not less than 6 months from the date of expiry of the time limit concerned (the draft had provided for 12 months).

Art. 17 (Request for Recording of a License) and Art. 18 (Request for Amendment of Cancellation), with Rule 10 (Contents of Recording).

Paragraph 4 of Art. 17 provides that no other requirements than those referred to in the Regulations (and in Art. 8 on communications) may be demanded by the Office. Note 17.06 to Art. 17 clarifies that of course other authorities such as tax authorities or authorities establishing statistics may require parties to a license contract to furnish information. It was agreed that the substance of this note be included in Article 17. As concerns evidence (paragraph 5) it was agreed that a Contracting Party should also be allowed to require evidence where it may reasonably doubt the veracity of any document (in addition to indications) submitted with the request.

Rule 10 regulates in its paragraph 2 which documents a Contracting Party may require to be joined, at the option of the requesting party, to the request for recording of a license. Whilst the majority agreed that it should be sufficient, as provided in Paragraph 2(ii) that an uncertified statement of license, signed by both parties, be submitted, several delegations proposed certain changes of the Rule. In that context it was agreed that in case of a co-ownership of the mark Offices should be able to request a declaration of consent of the co-holder of the registration where only one co-holder requests the registration. In the case of a request for registration of the license by the holder a number of delegates was of the opinion that the signature of the request by the holder should be sufficient. It was agreed that the Secretariat should propose a revised text for further discussion.

Similar considerations were made in the context of Rule 10, paragraph 3, which is dealing with supporting documents for amendment or cancellation (supplementing Article 18).

Art. 20 (Use of a Mark on Behalf of the Holder)

Following the discussions in the last meeting the Secretariat had redrafted that provision which in the Joint Recommendation provides that use of a mark by a person other than the holder is deemed to constitute use by the holder if such use is made with his consent (European standard). In view of the fact that many countries, such as the United States, require control of the holder, the Secretariat had restricted the rule to use of a mark by the licensee to be deemed to constitute use by the holder even where the license is not recorded with the Office. In the discussion, this principle was finally confirmed, however it was agreed that the text needs redrafting. For users, particularly in Europe, it is regrettable that the principle as now contained in the Joint Recommendation
could not be safeguarded, however this was a compromise to be made if one wishes to have the provisions on the registration of licenses integrated into the TLT.

Administrative provisions

For the first time also the provisions relating to the assembly, the tasks of the International Bureau, revisions and amendments etc. were discussed. It appeared that most of these provisions are not problematic, since they correspond to similar provisions in other treaties, administered by WIPO. As concerns the establishing and modifying Model International Forms, listed as task of the Assembly in Art. 24(2)(ii), the question was raised, whether this task may be covered by Art. 24(2)(iii) providing for amendments of the Regulations. Furthermore, Art. 28 on the relationship between the application of the TLT 1994 and the new Treaty was left open to further discussion.

November 8, 2004