The Meeting dealt from Monday to Wednesday morning with trademarks and on Wednesday afternoon discussions on geographical indications started. I attended the meeting for the part dealing with trademarks.

The WIPO-SCT Secretariat had prepared two documents, one containing proposals for further harmonization of formalities and procedures in the field of trademarks in draft treaty language, based on the present text of the Trademark Law Treaty (TLT) (document SCT/8/2), and one containing suggestions for the further development of international trademark law (document SCT/8/3).

Harmonization of formalities and procedures

Since its establishment, the SCT finalized proposals for the protection of well-known marks, trademark licenses and the protection of marks on the Internet, all having been adopted as Joint Recommendations by the Assemblies of the Paris Convention and of WIPO. In view of some technical and other developments it was now felt by the WIPO Assemblies and by the members of the SCT that a further harmonization of formalities and procedures in the field of trademarks, possibly in the framework of a revision of the TLT, should be considered. The draft provisions, which were submitted to the meeting, took into account these developments, such as the possibility of electronic filing and certain provisions of the Patent Law Treaty, which was adopted in 2000. In that context it may be recalled that the Patent Law Treaty in its basic approach follows the TLT, however, being a more recent treaty, contains certain provisions, which were not considered when adopting the TLT and may be useful also in the field of trademarks. For future sessions it is also envisaged to discuss the inclusion of the provisions contained in the Recommendation on Trademark Licenses, and new administrative clauses, in particular providing for an Assembly of the TLT. In the following I will briefly discuss the three main proposals contained in document SCT/8/2.

Communications

Article 8, at present dealing with signatures, has been totally reworded, and a new Rule 5bis has been added to the Regulations, in order to deal more generally with communications (defined in a new clause (iii bis) of Article 1 as any application, or any
request, declaration, document, correspondence or other information relating to an application or a registration, whether relating to a procedure under the Treaty or not, which is filed with the Office). The proposed language follows largely the language of Article 8 of the Patent Law Treaty. Whilst basically the meeting agreed to include in the TLT a provision on communications, it was felt that it should be possible to propose the new provisions in a more comprehensive manner (the text of Article 8 and the corresponding Rule 8 of the Patent Law Treaty contains last minute changes made in the Diplomatic Conference and is not an example for clarity). Also, some reservations were expressed as concerns some of the proposals. However, since it was agreed that for the next meeting the Secretariat would propose a revised text, I will not go into details. May I only mention that it was agreed, whenever for a communication a signature is required, to retain the language of Article 8(4) of the TLT, which is its cornerstone, that no Contracting Party may require the certification of any signature, except in the case of a surrender (and it is added: *and as prescribed in the Regulations; in the Patent Law Treaty that text was changed into an exception for “any quasi-juridical procedure or as prescribed in the Regulations”).

The wording of the new Article 8 will allow for some deletions of text in a number of Articles, which were not discussed in details. However it was agreed that the text should be streamlined wherever possible. Since the new provisions will allow Contracting Parties, after a certain date, to exclude the filing of communications on paper, the meeting has also agreed that there should be two exceptions, where Offices must accept the filing on paper: The minimum requirements of indications to be filed for the purpose of the filing date (Article 5(1)(a)) and the filing of communications for the purpose of complying with a time limit (Article 8(1)(d)). Of course, these exceptions play no role for Offices, which generally continue to request or to allow communications to be submitted on paper (that this will be possible, is also expressly provided for).

Since all delegations agreed that the main purpose of the TLT, which is to reduce formalities to a minimum, should not be endangered, it was agreed that the proposed Subparagraph 5, providing that a Contracting Party may require that any communication contain one or more indications prescribed in the Regulations, be put in square bracket and it be examined whether such additional indications were really needed.

*Relief in respect of time limits*

The purpose of a new Article 13bis (together with a new Rule 9 in the Regulations) is to request that Offices grant relief, if a communication is not submitted within a certain time limit set by the Office (as opposed to time limits provided by law) and to harmonize Office practices as concerns possible extensions of time limits. The proposed provisions correspond to the provisions in Article 11 with Rule 12 of the Patent Law Treaty. There was general agreement that such provisions were useful, even if for certain aspects changes as compared to the approach taken in the Patent Law Treaty were proposed (for example there should be no need for Offices to issue a notification under Rule 9(4) in order to initiate the time limit for filing a request for “continued processing”). Again, I
propose to review the new provisions more in detail based on a revised text, to be prepared by the Secretariat.

Reinstatement of rights

The proposed article 13ter with Rule 10 corresponds to Article 12 with Rule 13 of the Patent Law Treaty. Whilst some delegations doubted the value of that article in the trademark field (e.g. fearing a prolongation of procedures), I supported its inclusion, since the cases where such reinstatement may be requested under the strict conditions provided are rare, but exactly in such cases the owner of the right would suffer a real loss if that relief were not provided for. It was agreed to retain the provisions in principle, but to adapt them to the needs for trademarks (Rule 10(2)(ii) provides for an additional time limit of 12 months where a request relates to non payment of a maintenance fee; such provision may be important for the annual fees to be paid for the maintenance of a patent, but would be much too long for trademarks, where such maintenance fees generally do not exist and the possibility of late payment for renewals is taken care of by the Paris Convention).

Further development of trademark law

Additionally to the further harmonization of formalities in a revision of the TLT, the WIPO revised program and budget for 2002-2003 provides also for a review by the SCT of the desirability and feasibility of harmonizing substantive trademark law. For that purpose the Secretariat provided in Document SCT/8/3 for a set of principles for discussion in order to see whether it was desired to draft specific provisions on such substantive matters. The list is quite comprehensive, providing for summary proposals on the following topics:

Definition of a mark, registrability of a mark, trademark administration, examination, absolute grounds for refusal, conflicts with prior rights, rights conferred by registration, cancellation, requirements of use, use of the mark, and enforcement.

The main topics were briefly discussed and there was general agreement that the SCT should discuss provisions on harmonization, based on proposals to be worked out by the Secretariat, relating to all the principles listed on the document. With respect to a number of these principles, some delegations proposed certain aspects to be considered, which are not mentioned in the document (such as the possibility for States to provided in their law for a positive right of the trademark owner to use his mark). Additionally there was agreement that provisions dealing with the use of signs such as the ® and “TM” or “SM”, should be proposed. Furthermore, it was proposed to discuss in a future meeting questions relating to the protection of unregistered marks.

There was no discussion at this stage as to the form of adoption of any provisions (also as concerns harmonization of formalities the document SCT/8/2 had not addressed that question and it was not discussed).