

Industrial Property

Published monthly
Annual subscription:
180 Swiss francs
Each monthly issue:
23 Swiss francs

30th Year – No. 4
April 1991

Monthly Review of the
World Intellectual Property Organization

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INDUSTRIAL PROPERTY LAWS AND TREATIES (INSERT)

Editor's Note

AUSTRALIA

Patents Act 1990 (No. 83 of 1990, amended by the Industry, Technology and Commerce Legislation Amendment Bill 1991) (Sections 1 to 175) (*This text replaces the one previously published under the same code number*) Text 2-001

WIPO 1991

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Notifications Concerning Treaties

WIPO Convention

Accession

SAN MARINO

The Government of San Marino deposited, on March 26, 1991, its instrument of accession to the Convention Establishing the World Intellectual Property Organization, signed at Stockholm on July 14, 1967, and amended on October 2, 1979.

The said Convention, as amended on October 2, 1979, will enter into force, with respect to San Marino, on June 26, 1991.

WIPO Notification No. 152, of March 26, 1991.

Paris Convention

I. New Member of the Paris Union

CHILE

The Government of Chile deposited, on March 13, 1991, its instrument of accession to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Stockholm on July 14, 1967, and amended on October 2, 1979.

Chile has not heretofore been a member of the International Union for the Protection of Industrial Property ("Paris Union"), founded by the Paris Convention.

The Paris Convention, as revised at Stockholm on July 14, 1967, and amended on October 2, 1979, will enter into force, with respect to Chile, on June 14, 1991. On that date, Chile will become a member of the Paris Union.

Chile will belong to Class VII for the purpose of establishing its contribution towards the budget of the Paris Union.

Paris Notification No. 125, of March 14, 1991.

II. Accession to the Stockholm Act (1967)

SAN MARINO

The Government of San Marino deposited, on March 26, 1991, its instrument of accession to the Stockholm Act of July 14, 1967, of the Paris Convention for the Protection of Industrial Property of March 20, 1883.

San Marino will belong to Class VII for the purpose of establishing its contribution towards the budget of the Paris Union.

The Stockholm Act (1967), as amended on October 2, 1979, of the said Convention will enter into force, with respect to San Marino, on June 26, 1991.

Paris Notification No. 126, of March 26, 1991.

Madrid Agreement (Indications of Source)

Accession to the Additional Act of Stockholm (1967)

SAN MARINO

The Government of San Marino deposited, on March 26, 1991, its instrument of accession to the Additional Act of Stockholm of July 14, 1967, to the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of April 14, 1891.

The Additional Act of Stockholm (1967) to the said Agreement will enter into force, with respect to San Marino, on June 26, 1991.

Madrid (Indications of Source) Notification No. 23, of March 26, 1991.

Madrid Agreement (Marks)

Accession to the Stockholm Act (1967)

SAN MARINO

The Government of San Marino deposited, on March 26, 1991, its instrument of accession to the Stockholm Act of July 14, 1967, and amended on October 2, 1979, of the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891.

The Stockholm Act (1967), as amended on October 2, 1979, of the said Agreement will enter into force, with respect to San Marino, on June 26, 1991.

Madrid (Marks) Notification No. 46, of March 26, 1991.

Patent Cooperation Treaty (PCT)

New Member of the PCT Union

CZECHOSLOVAKIA

The Government of Czechoslovakia deposited, on March 20, 1991, its instrument of accession to the Patent Cooperation Treaty (PCT), done at Washington on June 19, 1970, as amended on October 2, 1979, and modified on February 3, 1984.

The said Treaty will enter into force, with respect to Czechoslovakia, on June 20, 1991.

PCT Notification No. 63, of March 21, 1991.

Budapest Treaty

Limitation of the Status of International Depository Authority

IN VITRO INTERNATIONAL, INC. (IVI)

(United States of America)

The following written communication dated March 4, 1991, addressed to the Director General of

WIPO by the Government of the United States of America relating to the status of In Vitro International, Inc. (IVI), as an international depository authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure was received on April 2, 1991:

The Patent and Trademark Office has recently been informed that In Vitro International, Inc. (IVI), of Linthicum, Maryland, an international depository authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, is seeking to terminate its status as such an authority. I am hereby notifying you that the United States has determined that it can no longer assure that IVI is able to continue to comply with the requirements of Article 6(2) of the Budapest Treaty with respect to any original deposits hereafter made with IVI pursuant to Rule 6.1 of the Regulations under the Treaty.

We are in the process of informing patent owners and patent applicants, who made deposits with IVI, of the determination by the United States and of the existence of other international depository authorities operating both inside and outside of the United States. We are also publishing notices of the determination in the *Official Gazette* and the *Federal Register*.

[End of text of the communication of the Government of the United States of America]

Pursuant to Article 8(2)(b) of the Budapest Treaty and of Rule 4.2(c) of the Regulations under that Treaty, the assurances in the declaration made by the United States of America (see Budapest Notification No. 34 of November 3, 1983) with respect to In Vitro International, Inc. (IVI) will not be applicable to any microorganism the original deposit of which is made, pursuant to Rule 6.1 of the Regulations under that Treaty, with In Vitro International, Inc. (IVI) after the expiration of three months from the date (March 4, 1991) of the said communication, that is, June 4, 1991. In Vitro International, Inc. (IVI) will continue to have the status of international depository authority under the Budapest Treaty in respect of the microorganisms deposited with it prior to June 4, 1991, or in respect of new deposits of the same microorganisms (see Article 4 of the Budapest Treaty and Rule 6.2 of the Regulations under that Treaty) made with it on or after that date.

Budapest Communication No. 69 (this communication is the subject of Budapest Notification No. 97, of April 8, 1991).

WIPO Meetings

Madrid Union

Working Group on the Application of the Madrid Protocol of 1989

Second Session
(Geneva, November 26 to 30, 1990)

NOTE*

Introduction

The Working Group on the Application of the Madrid Protocol of 1989 (hereinafter referred to as "the Working Group") held its second session in Geneva from November 26 to 30, 1990.

The following States members of the Working Group were represented: Algeria, Austria, Belgium, Bulgaria, China, Czechoslovakia, Democratic People's Republic of Korea, Denmark, Egypt, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Luxembourg, Mongolia, Morocco, Netherlands, Portugal, Romania, Senegal, Soviet Union, Spain, Sweden, Switzerland, United Kingdom, Viet Nam, Yugoslavia (30). In addition, the European Communities (EC) were also represented.

The following States, with observer status, were represented: Burundi, Norway, Republic of Korea, United States of America (4). A representative of one intergovernmental organization and representatives of 20 non-governmental organizations also participated in an observer capacity. The list of participants follows this Note.

The discussions of the second session of the Working Group were based on the following document prepared by the International Bureau of WIPO: "Draft Regulations Under the Madrid Agreement and the Madrid Protocol" (Rules 1 to 13) (document GT/PM/II/2); an information document with the heading "Results of an Inquiry Into Certain National Practices and the Estimated Amount of the Individual Fee" was also distributed at the beginning of the session (document GT/PM/II/INF/1).

In the present Note, all references to the "Agreement" are to the Madrid Agreement Concerning the International Registration of Marks, and all references to the Protocol are to the 1989 Madrid Protocol relating to that Agreement. Furthermore, any references to "the Draft Regulations," as well as to any given "draft Rule" and "draft paragraph" are references to the Draft Regulations, the given draft Rule or draft paragraph as proposed by the International Bureau in document GT/PM/II/2.

General Remarks

In the Working Group, the following general remarks were made in respect of document GT/PM/II/2:

"The International Bureau introduced document GT/PM/II/2 and pointed out that the draft Regulations were intended to cover three different situations in which either the Agreement alone, or the Agreement and the Protocol or the Protocol alone would be of application. In view of the fact that cases in which the Agreement and the Protocol would both be applicable were likely to occur for many years, it appeared to be warranted to adopt a single set of Regulations. It was also explained that, although the present member States of the Agreement did not wish the Regulations under the Agreement to be significantly amended, the International Bureau had endeavored to simplify the Regulations wherever it seemed necessary and, in particular, in order to facilitate application of both the Agreement and the Protocol at the same time. To conclude, it was said that two or three sessions of the Working Group would probably be needed before the Protocol entered into force, and it was pointed out

* Prepared by the International Bureau.

that the draft prepared by the Working Group would have to be adopted by the Madrid Union Assembly after entry into force of the Protocol.

The Delegation of the European Communities expressed the view that document GT/PM/II/2 was a good basis for discussion. It considered, however, that a final position on the draft Regulations could not be adopted until a text was available that covered all the Rules together. It declared itself pleased that so far the specific problems relating to the possible participation of intergovernmental organizations in the Protocol had been covered in an excellent way. Finally, it expressed the hope that the draft Rules that had yet to be produced would be written in the same spirit as those appearing in the present document had been.

The Delegation of the United States of America expressed its appreciation for being able to attend, in an observer capacity, this session of the Working Group. It pointed out that since the last session which was held in March of this year, the business and trademark communities in that country had begun to focus on the question of whether the United States of America should adhere to the Madrid Protocol. Members of the Delegation had spent considerable time in discussions with the Bar and other interested groups as to the contents of the Madrid Protocol and what adherence thereto would mean for the United States of America. It recalled that the USTA had adopted a resolution which, in principle, supported adherence to the Madrid Protocol and that a number of other groups had taken the first steps towards adopting similar resolutions, which showed how interest in the Madrid Protocol was growing within the United States of America. Whether the United States of America ultimately decided to adhere to the Madrid Protocol would depend, to a large extent, on the final shape the Regulations would take and on their compatibility with that country's laws. In 1989, a major change in the trademark law of the United States of America had been introduced, and the regulations implementing that change were geared to handling a large work load. Last year, the United States Patent and Trademark Office had received about 127,000 trademark applications, 12% of which had been filed by foreign entities, and it had issued over 65,000 registrations. Because of this recent change in the trademark law, any major changes in the near future were unlikely. However, the Delegation understood that adherence by the United States of America to the Madrid Protocol would necessitate some amendment of that country's trademark law and possibly major changes in its regulations.

The Delegation of the Soviet Union considered that document GT/PM/II/2, which took into

account most of the comments made at the first session of the Working Group, constituted a good basis for discussion. It noted with satisfaction that the draft Regulations followed, in general, the provisions of the Regulations under the Agreement.

The Delegation of Portugal wished that solutions be sought to enable the Madrid Union to be enlarged and was willing to work in that direction. It further emphasized that it had heard with satisfaction the statement made by the Delegation of the United States of America.

The Delegation of Germany was ready to cooperate in drawing up Regulations that would apply both to the Agreement and to the Protocol. It considered that the solution consisting in a single set of Regulations covering three types of international application would be preferable in order to avoid the confusion that would result for applicants from the existence of three separate sets of Regulations. It approved the International Bureau's approach in improving the Regulations under the Agreement where that proved necessary. It held that the Protocol could apply, in the same way as the Agreement, to any type of system of registration for marks, with or without examination, and emphasized its satisfaction at the statement made by the Delegation of the United States of America.

The Delegation of Czechoslovakia considered that document GT/PM/II/2 constituted, in principle, a good basis for discussion with a view to the positive outcome of the Working Group's discussions. It approved the idea of the draft Regulations generally following the provisions of the Regulations under the Agreement, except where the Protocol demanded a differing provision or where the order of the provisions, or the wording, of the present Regulations under the Agreement was not altogether clear or logical. However, it felt that some of the amendments envisaged were perhaps not useful although, on the whole, the draft Regulations were acceptable.

The Delegation of Romania considered that document GT/PM/II/2 constituted a good basis for discussion. Whilst appreciating the present Regulations under the Agreement, it was in favor of the proposal by the International Bureau to establish a single set of Regulations applicable to both the Agreement and the Protocol and which would accommodate the various possible situations. It approved the fact that the draft Regulations should wherever possible follow the order and content of the current Regulations. The Delegation further pointed out that it remained attached to the system of international fees as laid down by the Agreement and that its country would not opt for the individual fee system. It finally reserved any additional remarks it would make on certain draft Rules.

The Representative of USTA said that since the last session of the Working Group, USTA had adopted a resolution supporting, in general, the Madrid Protocol and, specifically, supporting the United States of America's adherence thereto, subject to the successful conclusion of efforts to promulgate implementing regulations. This resolution represented the first time USTA had advocated participation by the United States of America in an international trademark application and registration system. Furthermore, it reflected USTA's belief that the Madrid Protocol offered significant opportunities for the future and a means for expanding the Madrid system. In order for the Protocol to be successful, USTA believed that the Regulations must achieve three key objectives. First, they must be sufficiently flexible to accommodate the various and different national trademark systems. In this respect, the Regulations must avoid the necessity of governments having to make substantive revisions of their national laws. Second, procedures under the Protocol must reflect an appreciation for the difficulties trademark owners already face in clearing new marks for adoption and use in national and international commerce. Trademark owners must be able to ascertain, as quickly and with as much certainty as possible, whether any potential conflicts and priority claims exist. Finally, trademark owners must have confidence that they will not be placed at a disadvantage as a result of their home country's adherence to the Protocol. This issue had several political and practical aspects. Nationals must not perceive or face the prospect that non-nationals would realize greater benefits than they did as a consequence of their country's adherence to the Protocol. This was true both as regards international applications filed by non-nationals with the trademark office of that country and as regards international applications filed by nationals in other countries. Furthermore, nationals must have the assurance that applications filed by non-nationals under the Protocol would not receive from the national office priority treatment over their own applications filed under the national law. USTA members, which were both large and small trademark owners drawn from over 75 countries, welcomed a system to facilitate the protection and maintenance of their trademark rights. USTA believed that the Protocol offered the prospect of providing such a system and appreciated the opportunity to participate in and support efforts that would lead to that outcome.

The Delegation of the United Kingdom appreciated the documents prepared by the International Bureau. It further stated that a White Paper had been published by its Government in September 1990 with regard to the amendments

that it was desirable to make to United Kingdom legislation on marks. That White Paper held in particular that the new legislation would have to contain provisions enabling the Protocol to be ratified. Finally, the Delegation confirmed its country's intention to ratify the Protocol."

Discussions on the Provisions of the Draft Regulations

Rule 1: Abbreviated Expressions¹

Rule 1 of the Draft Regulations as submitted by the International Bureau read as follows:

"For the purposes of these Regulations,

(i) 'Agreement' means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and amended on October 2, 1979;

(ii) 'Protocol' means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

(iii) 'Contracting Party' means any country party to the Agreement or any State or intergovernmental organization party to the Protocol;

(iv) 'Contracting State' means a Contracting Party that is a State;

(v) 'Contracting Organization' means a Contracting Party that is an intergovernmental organization;

(vi) 'designated Contracting Party' means a Contracting Party for which the extension of protection under Article 3ter of the Agreement or Article 3ter of the Protocol has been requested;

(vii) 'designation' means the request for (territorial) extension referred to in Article 3ter of the Agreement and Article 3ter of the Protocol or the recording of such extension, as the case may be;

(viii) 'Office' means the Office of a Contracting Party competent to effect registrations of marks, or the common Office referred to in Article 9quater of the Agreement and Article 9quater of the Protocol;

(ix) 'Office of origin' means the Office of the country of origin defined in Article 1(2) and (3) of the Agreement or the Office of origin defined in Article 2(2) of the Protocol or both Offices, as the case may be;

(x) 'international registration' means the registration of a mark effected under the Agreement, the Protocol or both;

¹ It was indicated in document GT/PM/II/2 that further abbreviated expressions would be included in Rule 1 as and when the text of the Rules not contained in the said document is drafted.

(xi) 'international application' means an application for international registration filed under the Agreement, the Protocol or both;

(xii) 'international application governed exclusively by the Agreement' means an international application whose Office of origin is the Office:

- of a State bound by the Agreement but not by the Protocol, or
- of a State bound by both the Agreement and the Protocol, where the application does not contain the designation of any State bound by the Protocol but not by the Agreement or of any Contracting Organization;

(xiii) 'international application governed exclusively by the Protocol' means an international application whose Office of origin is the Office:

- of a State bound by the Protocol but not by the Agreement, or
- of a Contracting Organization, or
- of a State bound by both the Agreement and the Protocol, where the international application does not contain the designation of any State bound by the Agreement;

(xiv) 'international application governed by both the Agreement and Protocol' means an international application whose Office of origin is the Office of a State bound by both the Agreement and the Protocol and which is based on a registration, where the international application contains the designations:

- of at least one State bound by the Agreement (whether or not that State is also bound by the Protocol), and
- of at least one State bound by the Protocol but not by the Agreement or of at least one Contracting Organization;

(xv) 'legal entity' includes also a group of natural persons or legal entities that may, under the national legislation under which such group exists, acquire rights and assume obligations, even though it does not possess a legal personality;

(xvi) 'applicant' means the natural person or legal entity in whose name the international application is filed;

(xvii) 'basic application' means the application for the registration of a mark that has been filed with the Office of a Contracting Party and that provides the basis for an international application for the registration of that mark;

(xviii) 'basic registration' means the registration of a mark by the Office of a Contracting Party that provides the basis for an international application for the registration of that mark;

(xix) 'International Register' means the official collection of data concerning international

registrations maintained by the International Bureau, which data the Agreement, the Protocol or the Regulations require or permit to be recorded, regardless of the medium in which such data are stored;

(xx) 'holder' means the natural person or legal entity whose name is recorded in the International Register as the holder of the international registration;

(xxi) 'Office of the holder' means the Office of the Contracting Party to which the holder's entitlement to own an international registration is attached;

(xxii) 'Director General' means the Director General of the World Intellectual Property Organization;

(xxiii) 'International Bureau' means the International Bureau of the World Intellectual Property Organization;

(xxiv) 'International Classification of Figurative Elements' means the Classification introduced by the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks of June 12, 1973;

(xxv) 'International Classification of Goods and Services' means the Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977."

The portion of the report of the Working Group concerning the discussions of Rule 1 reads as follows:

"Items (i) to (vii). These items were approved as proposed.

Item (viii). It was decided that the phrase 'Office of a Contracting Party competent to effect registrations of marks' would be replaced by 'Office of a Contracting Party in charge of the registration of marks,' the latter being the words of Article 2(3) of the Protocol.

Item (ix). It was decided that the phrase 'or both Offices, as the case may be' would be replaced with 'or both, as the case may be.'

Items (x) to (xiv). These items were approved as proposed.

Item (xv). It was decided that this item would be redrafted along the following lines: "legal entity" means a legal entity within the meaning of the law applicable to it; any group of natural persons or legal entities that may, under the legislation applicable to it, acquire rights, assume obligations, sue or be sued, even though it does not possess legal personality, shall also be treated as a legal entity."

Items (xvi) to (xxv). These items were approved as proposed.”

Rule 2: Representation Before the International Bureau

Rule 2 of the Draft Regulations as submitted by the International Bureau read as follows:

“(1) [Representative; Changes Relating to the Representative] (a) *The applicant or the holder may have a representative before the International Bureau, who shall be recorded in the International Register.*

(b) *The recording of the representative and of his name and address, or of any change relating thereto, shall be effected on the basis of a communication addressed to the International Bureau by the Office of origin or the Office of the holder, as the case may be. Unless that communication is contained in the international application, it shall be made separately from any other communication.*

(c) *The address of the representative shall be in a Contracting State or in the territory of a Contracting Organization, provided that the Office referred to in subparagraph (b) may require that the said address be in the Contracting State or in the territory of the Contracting Organization, as the case may be, whose Office is the said Office.*

(d) *The applicant or the holder may have one representative only. Where several representatives have been indicated in the communication referred to in subparagraph (b), only the one indicated first shall be considered to be a representative.*

(e) *Where a partnership or firm composed of attorneys or patent or trademark agents has been indicated as representative in the communication referred to in subparagraph (b), it shall be regarded as one representative.*

(f) *The recording of a representative shall be subject to the payment of the fee fixed in the Schedule of Fees, except where the communication referred to in subparagraph (c) is contained in the international application. The recording of any change concerning a representative who is already recorded shall be subject to the payment of the fee fixed in the Schedule of Fees.*

(2) [Communications to and by the Representative] (a) *The International Bureau shall [, subject to Rule ...]* address to the representative recorded under paragraph (1)(b) any invitation, notification or other communication which, in the absence of a representative, would have to be sent to the applicant or holder under these Regulations; any invitation, notification or other*

communication so addressed to the said representative shall have the same effect as if it had been addressed to the applicant or holder.

(b) *Any communication addressed to the International Bureau by the representative recorded under paragraph (1)(b) shall have the same effect as if it had been addressed to it by the applicant or holder.*

(3) [Cancellation of Recording] (a) *The recording of the representative shall be cancelled if requested in a communication made direct to the International Bureau either by the applicant or holder or by the representative, and signed by him; no fee is payable for the cancellation. The International Bureau shall inform the representative whose recording has been cancelled, the applicant or holder, and the Office which had addressed the communication referred to in paragraph (1)(c) to the International Bureau, of the cancellation.*

(b) *The recording of a representative shall entail the cancellation of the recording of any representative who had been recorded previously.*

(4) [Date of Recording or Cancellation] *The recording of a representative or of any change concerning the representative, or the cancellation of the recording of a representative, shall be effective as from the date of receipt by the International Bureau of the corresponding communication and the fee, if any, payable in respect of the communication. Such recordings and cancellations shall not be the subject of any notification to the Offices of the designated Contracting Parties or of any publication by the International Bureau.*

* It is proposed to continue the current practice whereby the International Bureau sends direct to the holder and the representative (if any) an unofficial notice of expiration of the international registration (presently provided for in Rule 24 of the Regulations under the Madrid Agreement). Accordingly, draft Rule 2(2)(a) would be subject to that practice.”

The portion of the report of the Working Group concerning the discussion of Rule 2 reads as follows:

“Paragraph (1)(a). This paragraph was approved as proposed.

Paragraph (1)(b). It was decided that, for the next meeting of the Working Group, the Secretariat would propose a text that left it to the Office of the holder of the international registration to require that appointments of representatives be effected through its intermediary or be in a communication addressed direct by the holder to the International Bureau. Furthermore, the new text should allow the inclusion of the appointment of a representative not only in the international

application but also in any request for recording a change in the person of the holder.

It was also decided that the subparagraph would provide that the recordal of any appointment of a representative, and of any change concerning representatives, should be notified to the holder of the international registration and to the Office of such holder and published in the Gazette of the International Bureau.

Paragraph (1)(c). It was decided that the words 'provided that ... the said Office' would be placed between square brackets in the next draft of the Regulations, as several of the participants were of the opinion that no Office should be allowed to require the address of the representative to be on the territory covered by that Office.

Paragraph (1)(d). It was decided to add the words 'and will be recorded.'

Paragraph (1)(e). This paragraph was approved as proposed.

Paragraph (1)(f). It was decided that the International Bureau would give further thought to the question whether the non-payment of a fee should not be extended to cover also the case where the recording is made in connection with an assignment.

Paragraph (2). This paragraph was approved as proposed.

Paragraph (3). It was noted that 'cancellation' covered both revocation and renunciation and that the reference to paragraph (1)(c) should be to paragraph (1)(b). It was decided that the International Bureau would consider whether subparagraph (b) should not precede the second sentence of subparagraph (a), as the latter applied to all cases of cancellation; furthermore, that any changes consequential to the changes in paragraph (1)(b) should be made in the paragraph under consideration."

Rule 3: Means of Communicating with the International Bureau

Rule 3 of the Draft Regulations as submitted by the International Bureau read as follows:

"(1) [Communications in Writing] Any communication addressed to the International Bureau shall be effected in writing; where the use of a printed form is prescribed, it shall be effected by filling in that form. It shall be signed, or it shall bear a reproduction of the signature or an official seal.

(2) [Facsimile] (a) Any communication addressed to the International Bureau may consist of the sending of a facsimile, provided that, where the use of a printed form is prescribed, what is

communicated by facsimile machine is the facsimile of the filled-in printed form.

(b) The communication by facsimile machine shall be deemed to be received by the International Bureau on the day on which the facsimile so transmitted reaches the International Bureau or, if that day is a day on which the International Bureau is not open to the public, the first subsequent day on which it is open to the public, provided that, within a period of 20 days from the day on which the communication by facsimile machine is deemed to have been received, the same communication, signed by the sender, reaches the International Bureau in the form prescribed in paragraph (1), failing which the communication by facsimile machine shall be deemed not to have been received by the International Bureau."

The portion of the report of the Working Group concerning the discussion of Rule 3 reads as follows:

"Paragraph (1). The International Bureau said that it will be in order if applicants prepare their own forms, provided that they are the same as those issued by the International Bureau; nevertheless, forms prepared by applicants may be *recto* only and may have slightly different spacing.

It was decided that the references to the reproduction of signatures and to seals would be omitted in this paragraph and that the Rule on definitions would define 'signature' and that such definition would cover the said reproduction of signatures and seals.

Otherwise, the paragraph was approved as proposed.

Paragraph (2). It was decided that this paragraph should be modified along the following lines:

(i) international applications may be filed in writing (on paper) or by facsimile (not by telex or telegram); the receipt of the facsimile by the International Bureau will be acknowledged by the International Bureau to the Office having sent the facsimile; the requirement of confirmation in writing will be maintained,

(ii) other communications may be in writing (on paper) or may be sent to the International Bureau by facsimile, telex or telegram; they need not be signed; as to the question whether they need to be confirmed in writing, two alternatives will be proposed for further consideration: the first will not provide for the need for confirmation; the second will provide for the need for confirmation where the communication affects the right of the applicant or the holder of the international registration. The receipt of the facsimile by the International Bureau will be acknowledged by

the International Bureau to the Office or person having sent the facsimile,

(iii) in all cases where confirmation in writing is required, the time limit will be one month, rather than 20 days."

Rule 4: Calculation of Time Limits

Rule 4 of the Draft Regulations as submitted by the International Bureau read as follows:

"(1) [Periods Expressed in Years] *Any period expressed in years shall expire, in the relevant subsequent year, in the month having the same name and on the day having the same number as the month and the day of the event from which the period starts to run, provided that, if the event occurred on February 29 and in the relevant subsequent year February ends with 28, the period shall expire on February 28.*

(2) [Periods Expressed in Months] *Any period expressed in months shall expire, in the relevant subsequent month, on the day which has the same number as the day of the event from which the period starts to run, provided that, if the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month.*

(3) [Periods Expressed in Days] *The calculation of any period expressed in days shall start with the day following that on which the relevant event occurred and shall expire accordingly.*

(4) [Expiration on a Day on Which the International Bureau is Not Open to the Public] *If a period expires on a Saturday, a Sunday or another day on which the International Bureau is not open to the public, the period shall, notwithstanding paragraphs (1) to (3), expire on the first subsequent day on which the International Bureau is open to the public.*

(5) [Indication of the Date of Expiration] *The International Bureau shall, in all cases in which it communicates a time limit, indicate the date of the expiration of the said time limit."*

The portion of the report of the Working Group concerning the discussion of Rule 4 reads as follows:

"This Rule was approved as proposed."

Rule 5: Languages

Rule 5 of the Draft Regulations as submitted by the International Bureau read as follows:

"(1) [International Applications Governed Exclusively by the Agreement; International

Registrations Thereon] *International applications governed exclusively by the Agreement and the international registrations effected pursuant to those applications, as well as all communications concerning such applications and registrations, shall be in French and only in French.*

(2) [International Applications Governed Exclusively by the Protocol or Governed by Both the Agreement and the Protocol; International Registrations Thereon] *Where the international application is governed exclusively by the Protocol or is governed by both the Agreement and the Protocol,*

(i) *the international application shall be in English or French according to what is prescribed by the Office of origin;*

(ii) *the international registration shall be in the language of the international application;*

(iii) *any communication addressed to the International Bureau by the applicant or the holder shall be, at the option of the applicant or the holder, in English or French;*

(iv) *any communication addressed to the International Bureau by an Office shall be, at the option of that Office, in English or in French;*

(v) *any communication by the International Bureau to an Office shall be, at the option of that Office, in English or French;*

(vi) *any communication by the International Bureau to the applicant or the holder shall be in the language of the international application, unless the applicant or the holder indicates that he wishes to receive such communications in English although the language of the international application is French, or in French although the language of the international application is English.*

(3) [Publications] (a) *All publications in the periodical gazette Les Marques internationales/International Marks concerning international registrations made pursuant to international applications governed exclusively by the Agreement shall be in French.*

(b) *All publications in the periodical gazette Les Marques internationales/International Marks concerning international registrations made pursuant to international applications governed exclusively by the Protocol or governed by both the Agreement and the Protocol shall be both in English and in French; in each case, the publication shall indicate the language in which the international application, or other communication on which the publication is based, was received by the International Bureau.*

(c) *Any translation from English into French or from French into English needed for the publications referred to in subparagraph (b) shall be*

prepared by the International Bureau, provided that the applicant or the holder may submit to the International Bureau a proposed translation of the indication of goods or services. If such proposed translation is not considered to be correct by the International Bureau, it may be corrected by the International Bureau, after giving the applicant an opportunity to make observations on the proposed corrections."

The portion of the report of the Working Group concerning the discussion of Rule 5 reads as follows:

"Paragraph (1). Most of the delegations that spoke voiced their approval of the text proposed by the International Bureau.

Paragraph (2). The Delegation of Algeria considered that the introduction of English as a working language for applications governed both by the Agreement and by the Protocol and for the corresponding international registrations (hereinafter referred to as 'mixed' applications and registrations) was at variance with the provisions of paragraph (1), and that this could give rise to controversy on the question of working languages.

It was answered that paragraph (1) concerned only applications governed exclusively by the Agreement so that it cannot be in contradiction with paragraph (2) which concerned mixed applications. In any event, French would be safeguarded, as all publications made by the International Bureau, in every case, would also be in French.

The Delegation of Spain made a general reservation concerning the solutions proposed in Rule 5. It considered that its country could only accept any alteration of the principle of a single working language if the inclusion of Spanish was contemplated. It pointed out in this connection that, as the Protocol was a text of universal vocation and therefore destined to apply to the countries of Latin America, a multilingual system including Spanish would have to be envisaged. If such a system could not be adopted, and if therefore the principle of universality did not find favor, then the principle of a single working language should be retained.

The Delegation of Portugal, while favoring the continued use of a single working language in principle, felt that, from a practical point of view and in order that the Madrid Union might extend its coverage by means of the Protocol, it could accept the introduction of English as a second working language in the cases provided for in paragraph (2). It added however that, if countries were to demand the introduction of a third working language, its country would also demand the introduction of Portuguese.

The Delegation of Germany said that, without the introduction of English as a working language in the cases provided for in paragraph (2), the system of the international registration of marks would never develop. It considered that, while a multilingual system might well prove interesting for users, it would nevertheless place an additional burden of work on the International Bureau and designated Offices. It wondered moreover what criteria would be used to determine the choice of languages in connection with a multilingual system. It considered that the system proposed in paragraph (2) was a reasonable solution as far as the working languages were concerned, as French and English would be on an equal footing. It concluded by expressing the view that a multilingual system could be considered in the future, when technological developments made it possible to do so at reasonable cost.

The Delegation of France considered that the question of working languages was above all a political one, even though it could have practical implications, and pointed out that, in any event, the final decision would fall to the Assembly of the Madrid Union. It felt that the introduction of English alongside French, as provided in paragraph (2), could be acceptable for applications and registrations governed exclusively by the Protocol, even though French as a single language would be preferable. As for mixed applications and registrations, on the other hand, it said that it wished to reserve its position.

The International Bureau made it clear that notifications of refusal from countries that had chosen English as their working language would be translated into French by the International Bureau and communicated by it, in that language, to the designated Offices that had chosen French as their working language. The same procedure would apply *mutatis mutandis* to notifications of refusal from countries that had chosen French as their working language.

All the other delegations and also the representatives of non-governmental organizations that spoke supported draft paragraph (2). The representatives of non-governmental organizations laid stress on the fact that the paragraph in question proposed the only solution that was likely to ensure the success of the Protocol.

The Delegation of France reserved its position, and wondered what the additional cost of translation and publication in two languages would be for mixed applications and registrations. It mentioned among other things that countries party only to the Agreement should not have to bear any of the extra cost.

Subject to the above reservation, this paragraph was approved as proposed."

Rule 6: Communications with the International Bureau

Rule 6 of the Draft Regulations as submitted by the International Bureau read as follows:

“(1) [Addressing of Correspondence] Unless these Regulations provide otherwise, the applicant or the holder shall not communicate direct with the International Bureau, and all communications concerning a given international application or international registration shall be between the interested Office and the International Bureau.

(2) [Identification of Documents] If several documents are included in one envelope, they shall be accompanied by a list identifying each of them.”

The portion of the report of the Working Group concerning the discussion of Rule 6 reads as follows:

“Paragraph (1). Several participants expressed the view that it was unnecessary to send all communications through the Office of the applicant or the holder of the international registration as direct communication would be simpler and faster.

One delegation wondered why it was that all communications should in principle take place between the International Bureau and the Office concerned. It considered among other things that, when the international registration had become independent, its holder should be able to communicate with the International Bureau.

The International Bureau recalled that the provision was no more than a general principle, applicable in particular to the filing of the international application, but that the text of the draft Regulations, when it was complete, would specify the cases in which direct communication between the applicant or holder and the International Bureau was permissible. Once the draft was complete, one might consider whether the expression of a general principle was really necessary.

Subject to the understanding that the question would be re-examined once the draft of the Regulations is complete, paragraph (1) was approved as proposed.

Paragraph (2). This paragraph was approved as proposed.”

Rule 7: Several Applicants Under the Agreement, the Protocol or Both

Rule 7 of the Draft Regulations as submitted by the International Bureau read as follows:

“(1) [Two or More Applicants Applying Under the Agreement] Two or more natural

persons or legal entities may jointly file an international application under the Agreement if

(i) each of them qualifies for filing an international application under Article 1(2) or Article 2 of the Agreement and

(ii) the country of origin, as defined in Article 1(3) of the Agreement, is the same for all of them.

(2) [Two or More Applicants Applying Under the Protocol] Two or more natural persons or legal entities may jointly file an international application under the Protocol if

(i) each of them qualifies for filing an international application under Article 2(1) of the Protocol and

(ii) the Office of origin, as defined in Article 2(2) of the Protocol, is the same for all of them.

(3) [Two or More Applicants Applying Under Both the Agreement and the Protocol] Two or more natural persons or legal entities may jointly file an international application under both the Agreement and the Protocol if, for all the applicants, the country of origin as defined in Article 1(3) of the Agreement is the same as the State party to the Protocol whose Office is the Office of origin pursuant to Article 2(2) of the Protocol.”

The portion of the report of the Working Group concerning the discussion of Rule 7 reads as follows:

“This Rule was approved on the understanding that paragraph (3) would be drafted in the same manner as paragraphs (1) and (2) to make it quite clear that each of the applicants should be entitled to file an international application under the Agreement and under the Protocol.”

Rule 8: Transmission, Form, Fees and Contents of the International Application

Rule 8 of the Draft Regulations as submitted by the International Bureau read as follows:

“(1) [Transmission to the International Bureau] The international application shall be addressed to the International Bureau by the Office of origin.

(2) [Form and Signature] The international application shall be presented in one copy, dated and signed by the Office of origin, on a printed form supplied free of charge by the International Bureau. The printed form shall be completed legibly, preferably with the use of a typewriter or other machine. The international application shall contain a statement to the effect that it is filed at the request of the applicant.

(3) [Fees] The fees set out in the Schedule of Fees shall, subject to Article 8(7)(a)(i) of the

Protocol, be payable in respect of the international application.

(4) [Content of the International Application] Subject to paragraphs (5), (6) and (7), the international application shall contain or indicate

(i) the name of the applicant; where the applicant is a natural person, the name to be indicated is the family name and the given name(s), with the given name(s) preceding the family name; where the applicant is a legal entity, its full official designation shall be given;

(ii) the address of the applicant in such way as to satisfy the customary requirements for prompt postal delivery; in addition, a different address for correspondence may be indicated; where there are two or more applicants with different addresses, one address for correspondence shall be indicated; where no such address is indicated, the address for correspondence shall be the address of the applicant first named;

(iii) the name and address of the representative, if any;

(iv) where priority is claimed, a declaration claiming the priority of one or more earlier filings under the Paris Convention for the Protection of Industrial Property, together with an indication of the name of the Office where such filing or filings were made, and the date and serial number of that filing or the date and serial number of each of those filings;

(v) the reproduction of the mark; that reproduction shall appear in the square of 8 x 8 centimeters contained in the printed form; the distance between the two points of the mark farthest from each other may not be less than 15 millimeters; the reproduction shall be in black and white, or in color, depending on whether the reproduction of the mark is in black and white, or in color, in the basic application or in the basic registration;

(vi) where applicable, a statement to the effect that color, as a distinctive feature of the mark, is claimed, it being understood that, where the reproduction referred to in item (v), above, is in color, the international application shall be regarded as containing that statement;

(vii) the names of the colors claimed, where color is claimed as a distinctive feature of the mark and the reproduction is in black and white; where the reproduction is in color, the indication of the names of the colors is optional;

(viii) where the basic application or the basic registration is in respect of a three-dimensional mark, the indication "three-dimensional mark";

(ix) if the mark or part of the mark consists of or contains matter in script other than Latin script or numbers expressed in numerals other than Arabic or Roman numerals, a transliteration

of such matter in Latin script and Arabic numerals; the transliteration shall follow the rules of the language in which the international application is filed;

[(x) if the mark contains a word or words that have a dictionary meaning but are in a language other than the language in which the international application is filed, a translation of such word or words in the latter language;]*

(xi) where the basic application or the basic registration is in respect of a collective, certification or guarantee mark, the indication 'collective mark,' 'certification mark' or 'guarantee mark,' as the case may be;

(xii) the naming of the goods and services for which the international registration of the mark is sought, grouped in the appropriate classes of the International Classification of Goods and Services and presented in the order of the classes of that Classification; the goods and services shall be indicated in precise terms, preferably using the words appearing in the Alphabetical List of the said Classification; the international application may contain a limitation of the list of goods and services in respect of one or more designated Contracting Parties;

(xiii) the date on which the Office of origin has received the request of the applicant to file the international application;

(xiv) the amount of the fees referred to in Rule 8(3), the method of payment of the fees and the identification of the party paying those fees;

(xv) where appropriate, an indication that the applicant has submitted to the Office of origin evidence of his right to use certain elements in the mark, such as those referred to in Article 5bis of the Agreement or 5bis of the Protocol;

(xvi) a description of the mark by words, if the basic application or the basic registration contains such a description.

(5) [Additional Content of an International Application Governed Exclusively by the Agreement] In the case of an international application governed exclusively by the Agreement, such international application shall contain or indicate, in addition to the indications referred to in paragraph (4),

(i) the identification of the Contracting State of the Agreement in which the applicant has a real and effective industrial or commercial establishment; if there is no such Contracting State, the identification of the Contracting State of the

* As an alternative, one could consider the possibility of the furnishing of a translation continuing to be optional rather than being mandatory.

Agreement in which the applicant has his or its domicile; if there is no such Contracting State, the identification of the Contracting State of the Agreement of which the applicant is a national;

(ii) the date and the serial number of the basic registration and the date and the serial number of the filing for the said registration, together with a declaration by the Office of origin certifying that the particulars that appear in the international application correspond to the particulars appearing, at the time of the certification, in the basic registration, namely, that the mark is the same, that the colors claimed, if any, are the same, that any indication appearing in the international application under Rule 8(4)(viii) or (xi) also appears in the basic registration, that the applicant in the international application is the same natural person or legal entity as the holder of the basic registration, and that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic registration; an international application may be based on two or more basic registrations of the mark in the Office of origin, where all such basic registrations are owned by the applicant in the international application;

(iii) the identification of the designated Contracting Parties of the Agreement.

(6) [Additional Content of an International Application Governed Exclusively by the Protocol] *In the case of an international application governed exclusively by the Protocol, such international application shall contain or indicate, in addition to the indications referred to in paragraph (4),*

(i) *where the basic application has been filed with, or where the basic registration has been made by, the Office of a Contracting State of which the applicant is a national or in which he is domiciled or has a real and effective industrial or commercial establishment, the identification of that Contracting State;*

(ii) *where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the identification of that organization and the identification of the State member of that organization of which the applicant is a national or a statement that the applicant is domiciled or has a real and effective industrial or commercial establishment in the territory of the said organization;*

(iii) *the date and the serial number of the basic application, or the date and the serial number of the basic registration together with the date and the serial number of the filing from which that basic registration resulted, as the case*

may be, and a declaration by the Office of origin certifying that the particulars that appear in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or the basic registration, namely, that the mark is the same, that the colors claimed, if any, are the same, that any indication appearing in the international application under Rule 8(4)(viii) or (xi) also appears in the basic application or the basic registration, that the applicant in the international application is the same natural person or legal entity as the applicant in the basic application or the holder of the basic registration, and that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic application or the basic registration; an international application may be based on two or more basic applications and/or on two or more basic registrations of the mark in the Office of origin, where all such basic applications or basic registrations are owned by the applicant for the international application;

(iv) *the identification of the designated Contracting Parties of the Protocol, it being understood that, if the Office of origin is the Office of a State party to both the Agreement and the Protocol, no State party to both the Agreement and the Protocol may be designated under the Protocol.*

(7) [Additional Content of an Application Governed by Both the Agreement and the Protocol] *In the case of an international application governed by both the Agreement and the Protocol, such international application shall contain or indicate, in addition to the indications referred to in paragraph (4), all the indications referred to in paragraphs (5) and (6), it being understood that only a basic registration and not a basic application may be indicated under paragraph (6)(iii), and that that basic registration is the same as the basic registration referred to in paragraph (5)(ii)."*

The portion of the report of the Working Group concerning the discussion of Rule 8 reads as follows:

"Paragraph (1). This paragraph was approved.

Paragraph (2). This paragraph was approved once it had been made clear that the word 'preferably' meant that, if necessary, the international application could be submitted on a form completed by hand.

The International Bureau said that the next draft of the Regulations would contain a definition of the term 'signature' to the effect that it covered equally a handwritten signature, a printed

signature or a signature affixed by means of a stamp, as also the affixing of a seal.

It was decided that the next draft of the Regulations should contain, as far as signatures are concerned, a possible solution according to which the international application must be signed by the applicant or his representative, and, as far as the certification of the identity of the data in the basic application or registration and the international application is concerned, it must be also signed by the Office of origin. Furthermore, it was decided that, either as an item in or an annex to the international application, a declaration of *bona fide* intention to use the mark should be presentable in respect of any country which, in the applicable circumstances, would, under its national law, require the presentation of such a declaration.

Paragraph (3). This paragraph was approved.

Paragraph (4)(i), (ii) and (iii). These items were approved.

Paragraph (4)(iv). This item was approved. Replying to a question by the Delegation of the European Communities as to whether a Community mark could serve as a basis for claiming priority, the International Bureau said that such was the case under Article 4(2) of the Protocol. The fact that, in draft Rule 8(4)(iv), reference was made to the Office of origin (rather than a country of origin) also showed that a Community mark could serve as a basis for a claim of priority.

Paragraph 4(v). This item was approved.

Paragraph (4)(vi). This item was approved subject to the decision recorded at the end of this paragraph. It was further decided that statements to the effect that color was claimed as a distinctive feature of a mark should, where appropriate, be included in the application whether the reproduction be black or white or in color. It had been noted that databases could not, as things stood, accept reproductions of marks in color and it was necessary, for searching purposes, to have information in all cases that color had been claimed as a distinctive element of a mark. Consequently, it was decided to delete the phrase beginning 'it being understood.'

Paragraph (4)(vii). This item was approved subject to deletion of the phrase 'where the reproduction is in color, the indication of the names of the colors is optional.' That meant that it would be mandatory to state the names of the claimed colors even where the reproduction of the mark given on the application was in color.

Paragraph (4)(viii). This item was approved. It was further decided that the International Bureau would examine whether applications should not comprise a statement to the effect that

a mark was a sound mark in those cases where such marks could be given a graphic representation (by notes of music) and be internationally registered.

Paragraph (4)(ix). This item was approved.

Paragraph (4)(x). This item was approved subject to modification of the text in the next draft of the Regulations to make the provision of a translation optional rather than mandatory.

Paragraph (4)(xi) and (xii). These items were approved.

Paragraph (4)(xiii). This item was approved. Replying to one of the delegations, the International Bureau said that the second sentence in Rule 8(2)(xiii) of the current Regulations was not included in draft Rule 8(4)(xiii) since it concerned solely the case of applications under the Madrid Agreement, whereas draft Rule 8(4)(xiii) concerned all types of international application, including those submitted in accordance with the Protocol. The International Bureau explained that the provision would be introduced in Rule 8(5) in the next draft of the Regulations.

Paragraph (4)(xiv). This item was approved on the understanding that the words 'the amount of the fees referred to in Rule 8(3)' would be replaced by 'the amount of the fees paid.'

The International Bureau said that the matter of method of payment of fees would be dealt with in a specific Rule to be included in the next draft.

Paragraph (4)(xv) and (xvi). These items were approved.

Paragraph (5). This paragraph was approved, subject to the phrase 'Contracting Parties of the Agreement' in item (iii) being replaced with 'States party to the Agreement,' and to the word 'mark' in the antepenultimate line of item (ii) being replaced with 'same mark.'

Paragraph (6). This paragraph was approved, subject, in view of the amendment to paragraph (5)(ii), to the word 'mark' being replaced with 'same mark' in the 17th line of item (iii).

Paragraph (7). This paragraph was approved, after one delegation had expressed the view that a special Rule should be written for each of the three types of application.

It was agreed that the International Bureau would have to study further the question raised by the representative of a non-governmental organization, who expressed the view that an applicant qualifying to make a mixed application could, in a first stage, rely for his international registration on a basic application designating only countries bound by the Protocol alone (which would constitute an international application governed exclusively by the Protocol) and then, in a second stage, once the basic application had been regis-

tered by the Office of origin, proceed to designate countries bound by the Agreement (which would result in an international registration governed both by the Agreement and by the Protocol)."

Rule 9: Additional Reproduction(s) Accompanying the International Application

Rule 9 of the Draft Regulations as submitted by the International Bureau read as follows:

"The international application shall be accompanied by one reproduction of the mark identical to the reproduction appearing in the international application pursuant to Rule 8(4)(v), and, where the reproduction appearing in the international application is in black and white but color is claimed as a distinctive feature of the mark, also by a reproduction of the mark in color."

The portion of the report of the Working Group concerning the discussion of Rule 9 reads as follows:

"This Rule was approved."

Rule 10: Irregularities Other Than Those Concerning the List of Goods and Services

Rule 10 of the Draft Regulations as submitted by the International Bureau read as follows:

"(1) [Procedure Following Identification of Irregularity] (a) Subject to Rules 11 and 12, if the International Bureau considers that an international application does not comply with the Agreement and/or the Protocol, as the case may be, or these Regulations, it shall defer registration and shall, subject to subparagraph (b), notify the Office of origin accordingly.

(b) Where the irregularity consists of the non-payment or the insufficiency of the fees, the International Bureau shall directly notify the applicant of the irregularity.

(2) [Time Allowed to Remedy Irregularity] (a) If the irregularity is not remedied within three months from the date of the notification referred to in paragraph (1), the International Bureau shall notify both the applicant and the Office of origin accordingly.

(b) If the irregularity is not remedied within a further period of three months from the date of notification under subparagraph (a), the international application shall be considered abandoned and any fees already paid shall be reimbursed."

The portion of the report of the Working Group concerning the discussion of Rule 10 reads as follows:

"The Delegation of the United States of America proposed that, in order to simplify and speed up procedures in all cases involving irregularities, including those concerning goods and services, which were dealt with in Rules 11 and 12, the same notification be sent by the International Bureau both to the Office of origin and to the applicant or holder, or his representative, at the same time, and that the time allowed for remedying the irregularity be three months but without a further period of three months.

The International Bureau said that, for the next meeting of the Working Group, there would be a draft Rule providing for the entry in the WIPO database, which would be available to the public for consultation, of the essential elements of the international application, which would be done within a short space of time (one to three days), with a mention, where appropriate, that a decision on the acceptability of the application had not yet been taken.

This Rule was approved, on the understanding that the next draft of the Regulations would incorporate the proposal by the Delegation of the United States of America and also the statements by the International Bureau reported in the previous two paragraphs, and that it would be provided that the remedying of an irregularity could be demanded both by the Office of origin and by the applicant, or his representative, in a communication filed direct with the International Bureau."

Rule 11: Irregularities With Respect to the Classification of Goods and Services

Rule 11 of the Draft Regulations as submitted by the International Bureau read as follows:

"(1) [Identification of Irregularity and Proposal for Classification] If the International Bureau considers that the requirements of Rule 8(4)(xii) are not complied with or that the classification of the goods and services contained in the international application is incorrect, or if there is no such classification contained therein, it shall submit its own proposal for the classification of the goods and services to the Office of origin.

(2) [Fees Payable in Case of Irregularity] (a) Where the International Bureau submits its own proposal for classification to the Office of origin in accordance with paragraph (1), the fee for classification set out in the Schedule of Fees shall be payable. Where the classification proposed by the International Bureau results in an increase in the amounts of the fees referred to in Rule 8(3), because goods and/or services are to be classified

in more classes than those indicated by the applicant and for which the said fees have been paid, the additional amounts shall be payable.

(b) The International Bureau shall notify the applicant of the fee for classification payable and the amount thereof as well as of any additional amounts referred to in subparagraph (a).

(c) The amounts referred to in subparagraph (b) shall be paid within a period of three months from the date of their notification by the International Bureau.

(d) If the amounts have not been paid within three months from the date of their notification by the International Bureau, the International Bureau shall allow a period of the same duration for their payment, and it shall notify the applicant accordingly. If the amounts are not paid within the latter period, the international application shall be considered abandoned and any amounts already paid shall be reimbursed.

(3) [Communication of Opinion Contrary to the Proposal for Classification] The Office of origin may, within a period of three months from the date of the proposal for classification of the International Bureau, communicate to the International Bureau an opinion contrary to that proposal.

(4) [Classification on Registration] Subject to the conformity of the international application with the Agreement or the Protocol, as the case may be, and these Regulations, the mark shall be registered with the classification proposed by the International Bureau and such modifications, if any, that the International Bureau considers should be made on the basis of any contrary opinion communicated to it."

The portion of the report of the Working Group concerning the discussion of Rule 11 reads as follows:

"This Rule was approved, on the understanding that the proposals adopted in connection with Rule 10 would be incorporated in paragraph (1) as far as the submission of the classification proposal also to the applicant was concerned, and in paragraph (2)(d) as far as the removal of the second period of three months was concerned."

Rule 12: Irregularities With Respect to the Indication of Goods and Services

Rule 12 of the Draft Regulations as submitted by the International Bureau read as follows:

"(1) [Communication of Irregularity by the International Bureau to the Office of Origin] If the International Bureau considers that any of the goods and services is indicated in the interna-

tional application by a term that is too vague for the purposes of classification or is incomprehensible or linguistically incorrect, it shall defer registration and notify the Office of origin accordingly. The International Bureau may suggest a substitution term, or the deletion of the term, to the Office of origin.

(2) [Time Allowed to Remedy Irregularity] (a) If the irregularity is not remedied within three months from the date of the notification referred to in paragraph (1), the International Bureau shall notify both the applicant and the Office of origin accordingly and shall invite correction of the irregularity within three months from the date of the notification.

(b) If the irregularity is not remedied within the period indicated in subparagraph (a), the International Bureau shall include in the international registration even the term or terms that it considers to be too vague for the purposes of classification or to be incomprehensible or linguistically incorrect, provided that the Office of origin has specified the class in which such term or terms should, in its opinion, be classified; the international registration shall contain an indication to the effect that, in the opinion of the International Bureau, the said term or terms are too vague for the purposes of classification or are incomprehensible or linguistically incorrect. Where no class has been specified by the Office of origin, the International Bureau shall delete the said term or terms ex officio and inform both the Office of origin and the applicant accordingly."

The portion of the report of the Working Group concerning the discussion of Rule 12 reads as follows:

"This Rule was approved, on the understanding that the proposals adopted in connection with Rule 10 would be incorporated in paragraph (1) as far as the notification of the applicant as well as the Office of origin was concerned, and in paragraph (2)(a) as far as the removal of the second period of three months was concerned."

Rule 13: Currency of Payment of Fees*

Rule 13 of the Draft Regulations as submitted by the International Bureau read as follows:

"(1) [Obligation to Use Swiss Currency] All fees payable under these Regulations shall be paid to the International Bureau in Swiss currency.

* Provisional numbering.

(2) [Establishment of the Amount of Individual Fees in Swiss Currency] (a) *Where a Contracting Party makes a declaration under Article 8(7)(a) of the Protocol that it wants to receive an individual fee, and the amount of the individual fee is indicated in the declaration in a currency other than Swiss currency, the Director General shall, after consultation with the Office of that Contracting Party, establish the amount of the individual fee in Swiss currency on the basis of the official exchange rate of the United Nations.*

(b) *Where, for more than 30 consecutive days, the official exchange rate of the United Nations between Swiss currency and any other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 5% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Office of that Contracting Party may ask the Director General to establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the request is made. The Director General shall proceed accordingly. The new amount shall become applicable as from a date which shall be fixed by the Director General, provided that such date shall be within a period of one to two months after the date of the publication of the said amount in the periodical gazette Les Marques internationales/International Marks.*

(c) *Where, for more than 30 consecutive days, the official exchange rate of the United Nations between Swiss currency and any other currency in which the amount of an individual fee has been indicated by a Contracting Party is higher or lower by at least 10% than the last exchange rate applied to establish the amount of the individual fee in Swiss currency, the Director General shall, after consultation with the Office of that Contracting Party, establish a new amount of the individual fee in Swiss currency according to the official exchange rate of the United Nations prevailing on the day preceding the day on which the consultation is initiated by the Director General. The new amount shall become applicable as from a date which shall be fixed by the Director General, provided that such date shall be within a period of one to two months after the date of the publication of the said amount in the periodical gazette Les Marques internationales/International Marks.*"

The portion of the report of the Working Group concerning the discussion of Rule 13 reads as follows:

"This Rule was approved after it had been explained, in reply to a question raised by a delegation, that, where the amount of the individual fee had been changed between the time of the Office of origin receiving the application from the applicant and the time at which the International Bureau received the application, the amount payable would be that applicable at the time when the Office of origin received the application from the applicant.

The International Bureau further explained that it would be impractical to provide for a change in fees at predetermined intervals (every year or every six months, for instance) owing to the fact that considerable exchange-rate fluctuations could occur during periods of such length, and that the very principle of the individual fee was that it should bear a relation to the fee charged for an application filed by the national route."

Schedule of Fees²

The portion of the report of the Working Group concerning the discussion of the schedule of fees reads as follows:

"The schedule was approved.

A number of non-governmental organizations representing users wished to stress the fact that the term of 10 years provided for mixed registrations met with their entire satisfaction, with regard both to the savings achieved thereby and to the simplicity of administration that it made possible, and that the necessity of paying the basic fee twice for mixed registrations should be ruled out."

Forms³

The portion of the report of the Working Group concerning the discussion of the forms reads as follows:

"The draft forms were approved, on the understanding that the form in Annex I would be brought into line with the other forms."

² The schedule of fees is not reproduced in the present Note. It constitutes a part of document GT/PM/II/2 (pages 38 and 39), which can be obtained from the International Bureau.

³ The forms are not reproduced in the present Note. They constitute a part of document GT/PM/II/2 (Annexes I, II and III), which can be obtained from the International Bureau. It should be noted that the form in Annex I was directed to an international registration under the Agreement, the form in Annex II was directed to an international registration under the Protocol and the form in Annex III was directed to an international registration under both the Agreement and the Protocol.

LIST OF PARTICIPANTS**

I. Members

Algeria: M. Redjald; H. Yahia-Cherif. **Austria:** M. Stangl. **Belgium:** W.J.S. Peeters. **Bulgaria:** T. Petkova. **China:** Ou Wan Xiong; Pei Xiao Ling. **Czechoslovakia:** V. Zamrzla; P. Vrba. **Democratic People's Republic of Korea:** Hyon Chun Hwa; Hwang Myong Hi; Yu Song Nam. **Denmark:** J.E. Carstad; B. Kromann. **Egypt:** M.M. Saad; A.G.M. Fouad. **Finland:** S.-L. Lahtinen. **France:** B. Vidaud. **Germany:** A. von Mühlendahl; M. Bühring. **Greece:** P. Geroulakos. **Hungary:** G. Vékás; L. Tattay; M. Koslik. **Ireland:** H.A. Hayden. **Italy:** M.G. Fortini; P. Iannantuono; I. Nicotra; S. Paparo. **Luxembourg:** E.L. Simon. **Mongolia:** D. Zolboot. **Morocco:** P. Baroudi. **Netherlands:** H.R. Furstner; D. Verschure. **Portugal:** J. Mota Maia; R.A. Costa de Morais Serrão; J. Pereira da Cruz; A.Q. Ferreira. **Romania:** S. Romulus; V. Burzo. **Senegal:** D. Sagna. **Soviet Union:** E.G. Koutakova. **Spain:** A. Casado Cerviño; M.T. Yeste Lopez. **Sweden:** K. Sundström. **Switzerland:** D.R. Pedinelli. **United Kingdom:** A. Sugden; M. Todd. **Viet Nam:** Tran Viet Hung; Nguyen Thanh Long. **Yugoslavia:** T. Lisavac. **European Communities (EC):** P. Iannantuono; E.C. Nooteboom; G. Heil.

II. Observer States

Burundi: A. Negamiye. **Norway:** E.S. Helgesen. **Republic of Korea:** J.-K. Kim. **United States of America:** J.M. Samuels; R.G. Bowie.

III. Intergovernmental Organization

Benelux Trademark Office (BBM): E.L. Simon.

IV. Non-Governmental Organizations

Benelux Association of Trademark and Design Agents (BMM): F. Gevers. **Center for the International Study of**

Industrial Property (CEIPI): B. de Passemar. **Chambre des spécialistes en marques et modèles, France (CSMM):** J.-C. Magnin. **Chartered Institute of Patent Agents, United Kingdom (CIPA):** A.C. Serjeant. **Committee of National Institutes of Patent Agents (CNIPA):** A. Hansmann. **European Association of Industries of Branded Products (AIM):** G.F. Kunze. **European Communities Trade Mark Practitioners' Association (ECTA):** F. Gevers. **Federal Chamber of Patent Attorneys, Germany (FCPA):** A. Hansmann. **Federation of German Industry (BDI):** D. Füllkrug. **French Association of Practitioners in Trademark and Design Law, France (APRAM):** R. Baudin. **International Association for the Protection of Industrial Property (AIPPI):** G.F. Kunze. **International Federation of Industrial Property Attorneys (FICPI):** A.L. de Sampaio; A. Hansmann. **International League for Competition Law (LIDC):** J. Guyet. **Institute of Trade Mark Agents, United Kingdom (ITMA):** A. Porteous. **Trade Marks, Patents and Designs Federation, United Kingdom (TMPDF):** D.H. Tatham. **The United States Trademark Association (USTA):** R. Rolfe; Y. Chicoine. **Union des fabricants pour la protection internationale de la propriété industrielle et artistique, France (UNIFAB):** M. Deroulers. **Union of European Practitioners in Industrial Property (UEPIP):** C. Kik. **Union of Industrial and Employers' Confederations of Europe (UNICE):** D.H. Tatham. **World Federation of Advertisers (WFA):** E. Van Ginkel.

V. Bureau

Chairman: J. Mota Maia (Portugal). *Vice-Chairmen:* S.-L. Lahtinen (Finland); V. Zamrzla (Czechoslovakia). *Secretary:* P. Mangué (WIPO).

VI. International Bureau of WIPO

A. Bogsch (*Director General*); A. Schäfers (*Deputy Director General*); L. Baeumer (*Director, Industrial Property Division*); P. Mangué (*Senior Counsellor, Industrial Property (Special Projects) Division*); S. Di Palma (*Head, International Trademark and Industrial Design Registries*); H. Lom (*Senior Legal Officer, Developing Countries (Industrial Property) Division*); B. Ibois (*Legal Officer, Industrial Property (Special Projects) Division*).

** A list containing the titles and functions of the participants may be obtained from the International Bureau.

Studies

The Trademark Law Revision Act of 1988— New Law Modernizes United States Trademark System

R.A. ROLFE*

The Trademark Law Revision Act of 1988¹ was enacted on November 16, 1988, and implemented on November 16, 1989. It represented the first comprehensive revision of United States trademark law since the Trademark Act of 1946² (the Lanham Act). While the new law has been in effect a little more than a year, it is too soon to assess the full impact and significance of its changes. No doubt, judicial interpretation over the next few years will begin to bring about this kind of understanding. Nevertheless, it is not premature to appreciate the general importance of the Revision Act.

The Trademark Law Revision Act is exceptional for several reasons. First, it grew out of a study initiated by the United States Trademark Association (USTA), which chartered a special committee of 29 experienced trademark practitioners to broadly examine the United States trademark system. Starting with a directive to objectively evaluate both statutory and common trademark law, the Trademark Review Commission, as the committee was called, was not created to propose amendments to the Lanham Act. After a two-year study, which included extensive consultation with the United States Government, interested organizations and individual experts, the Commission published its report.³ It concluded that the principles underlying United States law were sound and appropriate. However, it made numerous recommendations to address specific problems and to generally modernize the Lanham Act in keeping with marketing realities and expressing the current state of the law, as developed through four decades.

The Commission's recommendations were endorsed not only by the USTA Board of Directors

but also by the United States Patent and Trademark Office (USPTO) and a large number of trade, business and professional organizations.⁴ Only a few individual critics could find fault. Such broad support for trademark law reform is itself noteworthy. The result was that the entire legislative process took only one year and all but a few of the recommendations were enacted.

Another unusual aspect of the Trademark Law Revision Act is that it significantly alters United States trademark law but is neither a wholesale overhaul of the law nor a radical revision of the Lanham Act. In essence, the Trademark Law Revision Act represents a 42-year tune up of the Lanham Act to ensure its continuing vitality and to keep it working as well as when it was new—and better.

This approach, which might be characterized as "renovation without revolution," is perhaps best exemplified by the Trademark Law Revision Act's new standards for filing an application for federal trademark registration. On the one hand, it carefully preserves the basis of United States trademark law, while on the other hand it addresses the practical business problems of marketing products. At the same time, it moves the United States trademark system closer to the regimes of the rest of the world.

Federal trademark protection in the United States of America arises under the Constitution. Unlike patents and copyrights, which are expressly granted protection, federal trademark rights derive from the Commerce Clause (Article 1, Section 3, Clause 3). Therefore, a valid and substantial relationship to interstate or foreign commerce is required as a

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¹ Public Law 100-667 (1988).

² Public Law 79-489, Chapter 510; Stat 427; 15 USC Sec. 1051-1127. For the Lanham Act, as amended, see *Industrial Property Laws and Treaties*, UNITED STATES OF AMERICA—Text 3-001.

³ 77 *Trademark Reporter* (Tm Rep.) 375-463 (1987).

⁴ See generally, legislative history of Trademark Law Revision Act of 1988, including Hearing Before the Subcommittee on Patents, Copyrights and Trademarks of the Judiciary, U.S. Senate, S. 1883, March 15, 1988, 100th Cong., 2d Sess. (1988); Hearing Serial No. J100-56 Before the Subcommittee on Courts, Civil Liberties, and Administration of the Committee on the Judiciary, House of Representatives, 124-36, H.R. 4156, September 8, 1988, 100th Cong., 2d Sess. (1988); both reprinted at 4 J. Gilson, *Trademark Protection and Practice*, VI 153-VI 532 (1990).

prerequisite to federal trademark protection. This relationship occurs by use of the trademark in such commerce.

While some would like to minimize the modern relevance of this Constitutional threshold, it has remained a legal, political and practical issue. Historically, the problem, and consequent sensitivity, date back to the first United States trademark statute, the Act of 1870, which was declared unconstitutional by the United States Supreme Court because it did not require use or intended use in commerce.⁵ The absence of the necessary nexus to the commerce clause resulted in a finding that the statute was not sufficiently grounded in the Constitution to invoke federal jurisdiction. Thereafter, numerous attempts at intent-to-use legislation were viewed as controversial and were not enacted into law.

By the 1970s, the debate over the use standard was transferred to the Trademark Registration Treaty (TRT) with its registration and subsequent use provision. Ultimately, the United States of America signed but never ratified the TRT.⁶

Interest in intent-to-use was again revived in 1984 after the Trademark Trial and Appeal Board (TTAB) of the USPTO held that United States obligations under international treaties did not require foreign applicants filing under such international agreements to allege trademark use anywhere.⁷ The perception, if not the reality, was that United States applicants were being unfairly held to a higher standard for the filing of an application for registration.

The use requirement also posed another problem. Given the risks of using a trademark without the benefit of registration, a peculiar practice had evolved and been accepted, albeit reluctantly, by the courts. Without a word of change to the Lanham Act, the use in commerce requirement was interpreted to permit "token use" to support a trademark application. Thus, a single interstate shipment of goods labeled exclusively for the purpose of the trademark application could constitute use.⁸ Although the practice made many judges and practitioners uncomfortable, it was understood as necessary and realistic. It was simply unreasonable to expect that business would enter the commercial marketplace without the assurance of the trademark examination process and the comfort of a federal registration.

The resolution of the Trademark Law Revision Act is to maintain the principles of United States trademark law but to make the law more practical. The result is a two-option system under which applications for trademark registration can be filed on the basis of "use in commerce" or on the basis of a "bona fide intention to use the mark in commerce."⁹ The troublesome token use doctrine was effectively abolished by redefining "use in commerce" as the "bona fide use of a mark in the ordinary course of trade and not made merely to reserve a right in a mark."¹⁰ This definition has even greater importance because it applies not only to trademark applications but to registration renewals¹¹ and the declarations of use that must be filed between the fifth and sixth anniversaries of the registration.¹² The result is that fictitious use will not be tolerated at any time during federal protection.

The new intent-to-use provision remains faithful to the use standard by allowing an application for registration to be filed based on a "bona fide intention to use the mark in commerce" but withholds issuance of the registration until after there has been bona fide use in commerce.¹³ Thus, the constitutional use in commerce requirement is appropriately observed. Also, under the Revision Act foreign applicants will have to assert a bona fide intention to use, thereby significantly diminishing, although not entirely eliminating, the advantage to them.

While the ability to file an intent-based application certainly goes a long way to appreciate the marketing concerns, the Trademark Law Revision Act provides a further enhancement to the law. Now, the filing of an application confers a nationwide priority against all competing claims except those by prior users, prior applicants and foreign treaty applicants with an earlier priority filing date.¹⁴ This new feature is called "constructive use" because the rights of the trademark registrant are as if the owner used its mark throughout the United States of America on the date the application is filed.

The application and examination process remain unchanged with respect to use-based applications. When an application is filed based on use in commerce, a drawing of the mark together with specimens showing such use are required for examination.¹⁵ Upon completion of the examination, the mark is published for opposition and, if there is none, the registration is issued.

⁵ Trade-Mark Cases, 100 US 82, 96-97, 25 LEd 550 (1879).

⁶ Opposition in the United States to TRT was not restricted to the intent-to-use provisions. See 77 Tm Rep. 375 *supra* at 389.

⁷ *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984).

⁸ *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 390 F2d 1015, 1017, 157 USPQ 55, 56-57 (CCPA 1968), *cert. denied* 393 US 831, 159 USPQ 799 (1968).

⁹ 15 USC Sec. 1051.

¹⁰ 15 USC Sec. 1127.

¹¹ 15 USC Sec. 1059.

¹² 15 USC Sec. 1058(a).

¹³ 15 USC Sec. 1051(b).

¹⁴ 15 USC Sec. 1057(c).

¹⁵ 15 USC Sec. 1051(a).

The Revision Act necessarily creates a different scenario for Trademark Office examination of intent-based applications. Under the new system an intent-based application is filed with a drawing of the mark but without specimens. After the application is examined, the mark is published for opposition. If it survives the opposition period and any opposition proceedings, a Notice of Allowance will be issued.¹⁶ Within six months, the applicant must then commence use of the mark in commerce and file a statement of such use together with specimens demonstrating use of the mark.¹⁷ The declaration is subject to examination, which considers the declaration and specimens. There also is a limited reexamination of the application to consider any matters that could not have been addressed before the Notice of Allowance was issued and use initiated. The initial six-month period for filing the statement of use will be extended for an additional six months upon the filing of an affidavit stating the applicant's continued bona fide intention to use the mark, and payment of the applicable fee. Subsequent six-month extensions for a total of an additional 24 months may be issued for good cause—and payment of a fee. Thus, an applicant may have up to three years after the Notice of Allowance to use the mark.

In its short existence, the Trademark Law Revision Act seems to have provided new motivation for federal trademark registration. (Another reasonable explanation could be that the extensive publicity that the new law has been given has simply resulted in a higher level of awareness. Could it now be considered fashionable to have a registered trademark?) Regardless of the reason, the first year of the Trademark Law Revision Act yielded a bumper crop of trademark applications—more than 127,000.¹⁸ This represented more than a 50% rise in the number of applications over the same period a year earlier (83,000 applications were filed in 1989). Of the total number of post Revision Act applications (127,000+), approximately 45% (57,000) were filed under the new intent-to-use provision.

So far there is no indication that those intent-to-use applications are not maturing to registration based on timely, non-dilatory bona fide use in commerce. More than 1,300 intent-to-use applications were amended to use-based applications during the examination process. The first Notices of Allowance were issued on June 12, 1990, and as of December 31, 1990, more than 600 statements of use were filed (approximately 80% encountered no action upon reexamination). Although 179 extensions of time to file statements of use were filed, this

figure is not particularly informative since the first statements of use were not even due until December 12, 1990.

Clearly, it will take several more years for the effects of the new trademark application system to be known but the changes seem to have had an unplanned and unanticipated additional impact on United States trademark owners and practitioners. While it may be purely coincidental or attributable to other significant developments, the fact that United States trademark law now looks considerably more like other national trademark laws seems to have provoked new international sensitivities. For the first time since the TRT, there appears to be a general interest in exploring opportunities for greater international trademark cooperation (I intentionally do not use the term "harmonization"). USTA's support in principle for United States adherence to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks and its strong recommendation that the USPTO actively participate in the meetings to develop implementing regulations are the first visible evidence of this mood change. But, there are other non-specific indications that the United States trademark community feels less distant and more optimistic than in the past.

The Trademark Law Revision Act includes another significant provision that brought United States law more in line with the rest of the world. This is the reduction in the registration term from 20 years to 10 years.¹⁹ The incentive for this change came from a determination to keep the trademark register clear of marks that are no longer being used in commerce. According to the Report and Recommendations of the Trademark Review Commission:

"The volume of abandoned or inactive marks ('deadwood') on the PTO register poses a serious problem for the business community. These marks impair the utility of the register by needlessly discouraging the use of marks which are actually and legally available. To the extent that this occurs, the registration system cannot foster a healthy economy and stimulate commercial progress."²⁰

In addition to requiring renewal every 10 years, the trademark law now specifically requires registrants to state that the mark is in use in commerce on or in connection with *all* the goods and services for which the mark is registered and to submit evidence of that use.²¹ Furthermore, United States law continues to require the filing of a declaration of use between the fifth and sixth years of a registration, but here too the Revision Act requires a recitation of all the goods and services on which the registered mark is in use. The effective result is that twice during the first 10 years registrants must attest to the

¹⁶ 15 USC Sec. 1063(b).

¹⁷ 15 USC Sec. 1051(d).

¹⁸ Preliminary unofficial figures have been provided by the U.S. Patent and Trademark Office.

¹⁹ 15 USC Sec. 1058(a).

²⁰ 77 Tm Rep. *supra* at 407.

²¹ 15 USC Sec. 1059(a).

"bona fide use of [their] marks in the ordinary course of trade, and not made merely to reserve a right in [the] mark...."

At the same time as the law has become more demanding, it also is broader to address a number of practical issues. For example, while token or sham trademark uses and contrived limited volume or single product shipments are excluded, "bona fide use... in the ordinary course of trade" is defined with sufficient flexibility to permit genuine commercial use peculiar to a particular industry. Therefore, uses such as those made in test marketing, clinical shipments of a new drug product as well as limited use on large, expensive or seasonal goods and services are now indeed "use in commerce."²²

Similarly, the Revision Act makes clear that the bona fide use of a mark in commerce can be by a licensee as well as by the owner of the mark. The operative language is,

"If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be."²³

Another example of the pragmatic approach taken by the new statute is seen in the section that permits the Trademark Trial and Appeal Board (TTAB) to modify the description of goods or services in opposition and cancellation cases.²⁴ Based on evidence relating to the actual goods and services, the TTAB may narrow the goods or services in an application or registration in order to avoid confusion on the register. Thus, the TTAB is authorized to amend the identification of either applicant's or registrant's goods, for example, "silver jewelry" to "antique silver jewelry, namely bracelets, sold through nostalgia trade channels," if such a description is accurate and would avoid confusion.

The Lanham Act is more than just trademark registration and the Trademark Law Revision Act also addresses the complete statute. Thus, the provisions concerning trademark infringement and unfair competition clarify existing statutory language, eliminate inconsistencies, codify judicial interpretation of the law and update the law to reflect current commercial realities.

Among the amendments made by the Trademark Law Revision Act is the addition of equitable defenses (laches, acquiescence, estoppel) to the list of "defenses or defects" available to a defendant charged with the infringement of an incontestable registration.²⁵ This eliminates a considerable conflict among the courts as to the availability of

these defenses.²⁶ In addition, this amendment underscores the inherently equitable nature of trademark litigation and emphasizes the need for prompt legal action against infringements. In other words, a trademark owner (even one with an incontestable registration) cannot delay taking action while a potential infringer expands its business under an arguably similar trademark.

The provision of the Lanham Act covering acts of unfair competition, Section 43(a), 15 USC Section 1125(a), is substantially revised to reflect its considerable development. This section, as interpreted by the courts, has become very important over the years. As revised, a defendant that

"uses in commerce any word, name, symbol, or device, or any combination thereof,"

which is likely to cause confusion, will be liable even where the plaintiff does not own a registration. The statutory language is intended to cover a wide variety of trademarks, service marks and trade dress that infringe unregistered marks or trade dress.

The language dealing with false advertising also is rewritten to make it clear that a business cannot make false or misleading representations with respect to *its own* products or services. The amendment to the false advertising provision, however, goes beyond merely codifying the existing law. It extends the law to prohibit false or misleading statements of fact about *another's* (e.g., a competitor's) products or services.

The amended Section 43(a) goes even further than statements about goods and services. It also applies to false or misleading descriptions or representations of fact pertaining to "commercial activities." Whether this language will be interpreted, as many think it should, to include general trade libel and business defamation is not clear; however, if the first appellate court decision on the subject, *U.S. Healthcare Inc., v. Blue Cross of Greater Philadelphia*, 14 USPQ2d 1257 (3d Cir. 1990), is any indication, courts will recognize this extended scope but will carefully scrutinize each case to make sure that activities considered "speech" by the First Amendment to the Constitution are protected.

The Trademark Law Revision Act also codifies the holdings of a number of courts that all infringement remedies available to registered trademarks are available to unfair competition claimants under Section 43(a) (e.g., owners of unregistered trademarks). These include injunctive relief, monetary compensation for defendant's profits, plaintiff's damages costs, treble profits or damages and attorney's fees in extenuating circumstances, and destruction of infringing material.²⁷

²² See J. Gilson, *supra* at 3-41 (1990).

²³ 15 USC Sec. 1055.

²⁴ 15 USC Sec. 1068.

²⁵ 15 USC Sec. 1115(b)(6).

²⁶ 77 Tm Rep. *supra* at 416 n. 57.

²⁷ 15 USC Sec. 1116-1118.

In conclusion, the Trademark Law Revision Act of 1988 is a broad and far-reaching modernization of United States trademark law. The changes it effected are pervasive but not invasive. The Revision Act brings statutory United States trademark law into conformity with present-day commercial realities and prevailing case law, and closer to other national trademark systems without undermining Constitutional principles. But the real value of the Trademark Law Revision Act is yet unknown. Perhaps, like the Lanham Act, its impact will be measured by the test of time—and, like the Lanham Act, it will be most appreciated after 40 years of effective operation.

Addendum

Other Noteworthy Provisions of the Trademark Law Revision Act

Concurrent Use Applications—Corrects an anomaly in the Lanham Act with respect to concurrent use registrations by including the following wording:

“Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant.”

15 USC Sec. 1052(d).

Registration—Revises the requirements for proving that a mark has become distinctive of an applicant's goods or services through use of the mark by allowing applicant to benefit from the use of the mark during the period its trademark application is being examined. Previously, the Act read,

“... for the five years next preceding the date of the filing of the application for the registration.”

15 USC Sec. 1052(f).

Collective and Certification Marks—Clarifies the difference between certification and collective marks by making clear that owners of collective marks may produce the goods or services on which the mark is used. Also permits the filing of both collective and certification mark applications on the basis of intent-to-use. 15 USC Sec. 1054.

Use by Related Companies—Provides that first use by a licensee will inure to the benefit of the applicant or registrant by adding the following language:

“If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.”

Assignment—Limits the assignment of intent-to-use applications to successor businesses in order to avoid trafficking in marks. 15 USC Sec. 1060.

Cancellation—Clarifies provisions with respect to the cancellation and incontestability of marks that have become generic terms for all or a portion of the goods and services registered. 15 USC Sec. 1064(3).

TTAB Decisions—Precludes the entry of final judgment in favor of intent-to-use applicants in Trademark Trial and Appeal Board proceedings (where the applicant cannot prevail without establishing constructive use) until registration issues to the applicant. 15 USC Sec. 1068.

Supplemental Registration—Eliminates the one-year use requirement for applications to register marks on the supplemental register and the requirement that petitions to cancel registrations on the supplemental register must be verified. Also provides that registration on the supplemental register does not constitute an admission that the mark has not acquired distinctiveness. 15 USC Sec. 1091.

Classification—Permits the Commissioner to eliminate multi-class applications if they become unmanageable under the intent-to-use system. 15 USC Sec. 1112.

Remedies—Expressly provides that the defenses in cases involving incontestable marks are available in cases involving marks which are not incontestable. 15 USC Sec. 1115(a).

Incontestable Registrations—Stipulates that owners of incontestable registrations are not relieved from the burden of proving infringement. 15 USC Sec. 1115(b).

Innocent Infringement—Adds language to protect television and radio broadcasters and others communicating through electronic media, as innocent infringers of trademarks, from the burden of damages resulting from airing advertisements that infringe another's mark(s). Previously, the Lanham Act specifically protected only printers and publishers. 15 USC Sec. 1114.

Definitions—Modernizes the definitions of the following words or phrases to conform to current interpretations: related company, trade name, trademark, service mark, certification mark, collective mark, mark, use in commerce, and abandonment of mark. 15 USC Sec. 1127.

New Items

AUSTRIA

*President,
Austrian Patent Office*

We have been informed that Hofrat Dipl.-Ing. Dr. Otmar Rafeiner has been appointed President of the Austrian Patent Office.

ECUADOR

National Director of Industrial Property

We have been informed that Mr. Leonardo Hidalgo C. has been appointed National Director of Industrial Property.

Calendar of Meetings

WIPO Meetings

(Not all WIPO meetings are listed. Dates are subject to possible change.)

1991

May 21 to 27 (Madrid)

Working Group on the Application of the Madrid Protocol of 1989 (Third Session)

The Working Group will continue to study Regulations for the implementation of the Madrid Protocol.

Invitations: States members of the Madrid Union, States having signed or acceded to the Protocol, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations.

June 3 to 28 (The Hague)

Diplomatic Conference for the Conclusion of a Treaty Supplementing the Paris Convention as Far as Patents Are Concerned

The Diplomatic Conference will negotiate and adopt a treaty supplementing the Paris Convention as far as patents are concerned (patent law treaty).

Invitations: States members of the Paris Union, the European Patent Organisation and the Organisation africaine de la propriété intellectuelle and, as observers, States members of WIPO not members of the Paris Union and certain organizations.

June 19 to 21 (Paris)

Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations: Intergovernmental Committee (Ordinary Session) (convened jointly with ILO and Unesco)

The Committee will review the status of the international protection of neighboring rights under the Rome Convention.

Invitations: States members of the Intergovernmental Committee and, as observers, other States members of the United Nations and certain organizations.

July 1 to 4 (Geneva)

WIPO Permanent Committee for Development Cooperation Related to Industrial Property (Fourteenth Session)

The Committee will review and evaluate the activities undertaken under the WIPO Permanent Program for Development Cooperation Related to Industrial Property since the Committee's last session (May/June 1989) and make recommendations on the future orientation of the said Program.

Invitations: States members of the Committee and, as observers, States members of the United Nations not members of the Committee and certain organizations.

July 8 to 12 (Geneva)

PCT Assembly (Extraordinary Session)

The Assembly will hold an extraordinary session to adopt amendments to the Regulations under the Patent Cooperation Treaty.

Invitations: States members of the PCT Union and, as observers, States members of the Paris Union not members of the PCT Union and certain organizations.

September 2 to 6 (Geneva)

Committee of Experts on the Settlement of Intellectual Property Disputes Between States (Third Session)

The Committee will continue the preparations for a possible multilateral treaty.

Invitations: States members of the Paris Union, the Berne Union or WIPO or party to the Nairobi Treaty and, as observers, certain organizations.

September 23 to October 2 (Geneva)

Governing Bodies of WIPO and the Unions Administered by WIPO (Twenty-Second Series of Meetings)

All the Governing Bodies of WIPO and the Unions administered by WIPO meet in ordinary session every two years in odd-numbered years. In the 1991 sessions, the Governing Bodies will, *inter alia*, review and evaluate activities undertaken since July 1990, and consider and adopt the draft program and budget for the 1992-93 biennium.

Invitations: As members or observers (depending on the body), States members of WIPO or the Unions and, as observers, other States members of the United Nations and certain organizations.

November 4 to 8 (Geneva)

Committee of Experts on a Possible Protocol to the Berne Convention (First Session)

The Committee will examine whether the preparation of a protocol to the Berne Convention for the Protection of Literary and Artistic Works should start, and—if so—with what content.

Invitations: States members of the Berne Union and, as observers, States members of WIPO not members of the Berne Union and certain organizations.

November 11 to 18 (Geneva)

Working Group on the Application of the Madrid Protocol of 1989 (Fourth Session)

The Working Group will continue to study Regulations for the implementation of the Madrid Protocol.

Invitations: States members of the Madrid Union, States having signed or acceded to the Protocol, the European Communities and, as observers, other States members of the Paris Union expressing their interest in participating in the Working Group in such capacity and certain non-governmental organizations.

December 2 to 5 (Geneva)

Committee of Experts on the International Protection of Geographical Indications (Second Session)

The Committee will examine a preliminary draft of a treaty on the international protection of indications of source and appellations of origin.

Invitations: States members of the Paris Union and, as observers, certain organizations.

UPOV Meetings

(Not all UPOV meetings are listed. Dates are subject to possible change.)

1991

October 21 and 22 (Geneva)

Administrative and Legal Committee

Invitations: Member States of UPOV and, as observers, certain non-member States and inter-governmental organizations.

October 23 (Geneva)

Consultative Committee (Forty-Fourth Session)

The Committee will prepare the twenty-fifth ordinary session of the Council.

Invitations: Member States of UPOV.

October 24 and 25 (Geneva)

Council (Twenty-Fifth Ordinary Session)

The Council will examine the reports on the activities of UPOV in 1990 and the first part of 1991 and approve the program and budget for the 1992-93 biennium.

Invitations: Member States of UPOV and, as observers, certain non-member States and inter-governmental organizations.

Other Meetings Concerned with Industrial Property

1991

May 29 (Paris)

Compagnie Nationale des Conseils en Brevets d'Invention: Conference (organized within the framework of the celebrations to mark the bicentenary of the French patent) on the theme: "La propriété industrielle dans le marché unique européen – Brevet et marque communautaires"

September 15 to 20 (Lucerne)

International Association for the Protection of Industrial Property (AIPPI): Council of Presidents

September 30 to October 4 (Harrogate)

International Federation of Industrial Property Attorneys (FICPI): Congress

October 21 and 22 (New York)

International League of Competition Law (LIDC): Study Days

1992

October 7 to 10 (Amsterdam)

International League of Competition Law (LIDC): Congress