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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

Twenty-Second Session
Geneva, November 23 to 26, 2009

REPORT*

adopted by the Standing Committee

* This report was adopted at the twenty-third session of the SCT.

INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”) held its twenty-second session, in Geneva, from November 23 to 26, 2009.

2. The following Member States of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Argentina, Australia, Austria, Azerbaijan, Belgium, Bosnia and Herzegovina, Brazil, Cambodia, Canada, Chile, China, Colombia, Costa Rica, Croatia, Cuba, Czech Republic, Denmark, Dominican Republic, Ecuador, El Salvador, Estonia, Finland, France, Germany, Guatemala, Hungary, Indonesia, Iran (Islamic Republic of), Ireland, Italy, Jamaica, Japan, Jordan, Kenya, Latvia, Lesotho, Libyan Arab Jamahiriya, Lithuania, Malaysia, Mexico, Morocco, Myanmar, Norway, Oman, Panama, Pakistan, Peru, Poland, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Serbia, Singapore, Spain, Sweden, Switzerland, Syrian Arab Republic, Thailand, the former Yugoslav Republic of Macedonia, Tonga, Turkey, United Kingdom, United States of America, Ukraine, Uruguay, Yemen, (69). The European Community was represented in its capacity as member of the SCT.

3. The following intergovernmental organization took part in the meeting in an observer capacity: Benelux Organisation for Intellectual Property (BOIP) (1).

4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), International Association for the Protection of Industrial Property (AIPPI), Centre for International Intellectual Property Studies (CEIPI), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), Intellectual Property Institute of Canada (IPIC), Inter-American Association of Industrial Property (ASIPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), Organization for an International Geographical Indications Network (oriGIn) (13).

5. The list of participants is contained in Annex II of this Report.

6. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions on the basis of all observations made.

Agenda Item 1: Opening of the Session

7. Mr. Francis Gurry, Director General, opened the twenty-second session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) and welcomed the participants.

8. Mr. Ernesto Rubio, Assistant Director General, reported on the work done by the International Bureau in preparation for the twenty-second session of the SCT in connection with each of the topics proposed for discussion.

9. Mr. Marcus Höpperger (WIPO) acted as Secretary to the SCT.

Agenda Item 2: Adoption of the Agenda

10. The SCT adopted the Draft Agenda (document SCT/22/1 Prov.) without modifications.

Agenda Item 3: Adoption of the Draft Report of the Twenty-First Session

11. The SCT adopted the Report of the Twenty-First Session based on document SCT/21/8 Prov., with modifications as requested by the Delegations of Canada, Jamaica, Spain, Sweden, the United States of America, Uruguay and by the Representative of CEIPI.

Agenda Item 4: Industrial Designs

Possible Areas of Convergence in Industrial Design Law and Practice

12. The discussion was based on document SCT/22/6.

Possible Area of Convergence on the Form of Reproduction of Industrial Designs

13. The Delegation of Canada declared that it could support the text of this possible area of convergence, subject to the insertion of the words “stippled lines” after “the use of dotted lines”.

14. The Delegations of El Salvador and Italy expressed support for the text as it stood.

15. The Delegation of Argentina, indicating that photographs were not accepted under national law, said that it would prefer that there was no possible area of convergence that would leave the choice of the form of reproduction to the applicant.

Possible Area of Convergence on the Views of Industrial Designs

16. The Delegation of the Russian Federation noted that the requirements concerning the views were dependent on the type of industrial design. It therefore suggested that the text of this possible area of convergence expressly indicate that offices should be free to require additional views, including specific types of views, at a later stage of the examination process.

17. The Delegation of Ukraine supported the statement by the Delegation of the Russian Federation.

Possible Area of Convergence on the Number of Copies of Each Reproduction

18. In reply to a request for clarification from the Delegation of El Salvador, the Secretariat recalled that several delegations which presently require more than three copies of each reproduction had indicated at previous sessions that they would not exclude bringing the number of copies down to three, or less, in the future.

Specimens

19. There were no comments on this topic.

Possible Area of Convergence on Other Contents of the Application Generally Required

20. There were no comments on this possible area of convergence.

Possible Area of Convergence on the Filing of the Application in the Name of the Creator

21. The Delegation of Japan pointed out that, while the name of the creator had to be indicated in an application, a statement of assignment was not required.

22. The Delegation of the United States of America suggested adding the words “if appropriate” before the second item set out in the text of this possible area of convergence, so as to take into account the case where the applicant was the creator or where an assignment had already taken place.

23. The Delegation of Canada supported the suggestion by the Delegation of the United States of America.

24. The Representative of CEIPI suggested adding the phrase “where it is required that the application be filed in the name of the creator”, with a view to making it clear that this possible area of convergence concerned only that situation.

Possible Area of Convergence on Unity of Design or Unity of Invention

25. There were no comments on this possible area of convergence.

Possible Area of Convergence on Multiple Applications

26. The Delegation of Canada, noting that Canadian legislation did not allow multiple applications, suggested adding the phrase “provided that the Office allows multiple applications”.

27. The Secretariat explained that this possible area of convergence aimed at enabling the division of application while keeping the original filing date in the applications resulting from the division, including where the reason for the division was that multiple applications were not allowed by the Office.

28. The Delegation of Canada, noting that division was available in Canada and that the original filing date was maintained in case of division, agreed to this possible area of convergence, subject to it being re-drafted in a clearer way.

29. The Delegation of Uruguay expressed support for this possible area of convergence.

Possible Area of Convergence on the Definition of Filing Date Requirements

30. The Delegation of Japan indicated that, in order to be accorded a filing date, an application had to be filed in Japanese and, where the applicant did not have a domicile or residence in Japan, through a representative domiciled or with residence in Japan.
31. The Delegation of Australia suggested replacing the first element in the text of this possible area of convergence by “an express or implicit indication to the effect that the elements are intended to be an application”.
32. The Representative of CEIPI, noting the success of the Geneva Act of the Hague Agreement for the International Registration of Industrial Designs, expressed the view that the list of filing-date requirements should not be larger than the list in that Act. The Representative considered that it would be preferable to come back to a more restricted list of filing-date requirements, and that those delegations which could not at this time adhere to such list would make reservations to the text of this possible area of convergence.
33. The Delegation of Cuba declared that it did not favor including a description and a claim as filing-date requirements.
34. The Delegation of Australia expressed the view that “the indication of the product” should be moved to the second sentence of the text, which listed possible filing-date requirements *in certain jurisdictions*.
35. The Delegation of the Czech Republic declared its support for the view expressed by the Delegation of Australia.

Possible Area of Convergence on Deferment of Publication and Secret Design

36. The Delegation of Turkey declared that it could support the text, but requested that the term “at least 6 months” be removed.
37. The Delegation of Japan, explaining that under the secret design system in Japan, an industrial design could be kept secret for a maximum of three years after registration, observed that the Japanese system was not reflected in this possible area of convergence.
38. The Delegation of Australia, noting that there were no express provisions for deferment of publication in Australia, indicated that it could nonetheless support the text of this possible area of convergence if the terms “filing date” were removed.
39. The Delegation of Brazil declared that it could support the text of this area of convergence, subject to the deletion of the words “priority date”.
40. The Delegation of Cuba stated that it had no problem with the text.
41. The Delegation of the Syrian Arab Republic said that Syrian legislation provided for a maximum period of deferment of publication of 12 months.
42. The Delegation of Uruguay observed that the second paragraph of this possible area of convergence addressed the situation in its country.

Possible Area of Convergence on Grace Period in the Event of Disclosure

43. The Delegation of Turkey, observing that national legislation provided for a 12-month grace period, suggested inserting the words “the date of priority” after “the date of filing”.
44. The Delegation of the United States of America suggested that the text of this possible area of convergence adopt a more precise language as regards the author of the disclosure and refer to a 12-month grace period.
45. The Delegation of Canada declared that it could support the text, but requested that the terms “as established in accordance with national legislation” be added after “a reasonable period”.
46. The Delegations of the Republic of Moldova and of Ukraine wondered what would be the criteria, and who would be the qualified authority, to determine what was a “reasonable period”.
47. The Delegation of Brazil said that the grace period in Brazil related to a disclosure made by the creator or by a third party without the consent of the creator, prior to the date of filing *or the date of priority*, and that such disclosure was without prejudice to the *novelty*, but not to the originality of the design.
48. The Delegation of Uruguay suggested specifying that the “reasonable period” should be not less than 6 months, that the “disclosure” in question should be the result of the creator or his/her successor in title, or of an authorized person, and that the effect of such disclosure should be limited to not affecting the novelty of the design.
49. The Delegation of Australia, pointing out that national legislation did not provide for a grace period in the event of disclosure, said that it could not support the text of this possible area of convergence.
50. The Delegation of the Russian Federation said that the text should also refer to the case of unauthorized disclosure by a third party who had obtained the information illegally, for instance in the case of espionage.
51. The Delegation of the Syrian Arab Republic, pointing out that national legislation did not provide for a grace period for industrial designs, suggested that the time limit given for the grace period be subject to national law.

Possible Area of Convergence on Communications

52. The Delegation of Japan suggested including the possibility for an office of permitting, instead of a handwritten signature, the use of a seal on a communication.

Possible Area of Convergence on Relief Measures

53. The Delegation of Sweden said that it favored the option set out in the first paragraph, although it could accept paragraph two if the word “should” at the end of the second sentence was replaced by “could”.

54. The Delegation of Turkey indicated that Turkish legislation did not provide for relief measures.

55. The Delegation of Japan, noting that time limits established by legislation were not subject to any relief measure in Japan, suggested limiting the requirement to provide for relief measures to the case of failure to comply with a time limit *fixed by the Office*, in line with Article 11 of the Patent Law Treaty.

56. The Delegation of Canada stated that it could not support the option set out in the second paragraph.

57. The Delegation of Brazil pointed out that, under national legislation, relief measures were available only for patents, in case of *force majeure*, and in respect of time limits for the payment of fees.

58. In reply to a request for clarification from the Delegation of the United Kingdom, concerning the relationship between the first and second paragraphs, the Secretariat said that each paragraph was intended to present a separate option.

59. The Delegation of the Russian Federation suggested that a further issue for discussion by the Committee could relate to the matter that could not constitute an industrial design in the different jurisdictions.

60. The Representative of INTA recalled that, through this exercise, users aimed at achieving a simplification of formalities, in particular as regards the possibility to file a single set of representations in as many countries as possible.

61. The Delegation of the United Kingdom expressed the view that issues concerning the registration of transactions such as assignments and licenses could also form the basis of further developments in the future.

62. The Delegation of Hungary, observing that one of the leading principles of the work of Committee should be the interest of users, stated that the aim of such work should not only be to collect information on existing principles and practices, but also to identify areas in which there was a possibility of attaining convergence in the future.

63. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-second session of the SCT. The Secretariat was requested to provide a revised working document on possible areas for convergence on industrial design law and practice in SCT Members, to be considered by the SCT at its twenty-third session, highlighting the potential benefits that users and industrial design administrations could derive from convergence among Member States in industrial design law and practice. This document should take into account the proposals made at the twenty-second session and include comments made by delegations and observer representatives during that session. It should set out already identified possible areas of convergence, as well as indicate tendencies in the law and practice of SCT Members and areas where no concrete convergence could be established at this time.
64. The Delegations of Australia, Brazil, Canada, El Salvador, France, Hungary, Mexico, Morocco, Norway, Republic of Korea, Singapore, Spain, United Kingdom, United States of America and Uruguay expressed their support for the proposal made by the Chair.
65. The Delegation of Argentina expressed the view that the discussion should not result in a binding document for offices.

Digital Access Service for Priority Documents

66. The discussion was based on document SCT/22/7
67. The Delegation of China, pointing out that extension of the “Digital Access Service for Priority Documents” (“DAS”) would be beneficial for users as well as for offices, expressed support for the extension and the launching of discussions on language, translation and storage issues.
68. In reply to a question from the Delegation of El Salvador, concerning the possible cost of the extension, the Secretariat indicated that, while it was not in a position to guarantee what the situation would be in respect of trademarks and industrial designs, the International Bureau did not charge for the system in the field of patents because the marginal cost was close to zero.
69. The Delegation of the Republic of Moldova declared that it supported the extension of the DAS.
70. The Delegation of Cuba expressed the view that, although the idea of extending the DAS to trademarks and industrial designs was good, the Committee should first examine the requirements and practices relating to priority documents in the different jurisdictions, as well as the problems related to translations.
71. The Delegation of Brazil said that, while it supported the extension of the DAS, it required more time to reflect on issues relating to translations.
72. The Delegation of Japan, expressing support for the extension of the DAS, stated that implementation of such extension should properly take into account the features of industrial designs and trademarks, as well as the question of accessibility in different countries.

73. The Delegation of Mexico, expressing support for the extension of the DAS, indicated that Mexico intended to amend its legislation, so that priority documents would only be required in the case of conflict with another trademark. Observing that the aim of the DAS was to access the original version of a priority document, the Delegation considered that the issue of translations would have to be looked at separately.

74. The Secretariat, referring to the comments on translation, explained that the aim of the DAS was to make accessible a reliable copy of the original version of priority documents, and that States would continue to be able to request a translation of priority documents.

75. The Delegation of the Russian Federation, expressing support for the extension of the DAS, indicated that the Russian Federation expected to become a participating office in the near future, after overcoming some technical problems. The Delegation pointed out that particular consideration should be given to the technical requirements that might be needed when extending the DAS to non-traditional marks.

76. The Secretariat explained that the DAS had no impact on the way offices carried out their examination. However, participating countries should provide for the possibility for applicants of filing priority documents after the expiry of the applicable time limit, in case of failure of the system due to technical problems.

77. The Delegation of Australia, declaring that Australia would probably join the DAS on December 12, 2009, considered that the work to extend the service to industrial designs and trademarks should be undertaken as soon as possible.

78. The Chair concluded that the SCT had taken note of document SCT/22/7 and had requested the Secretariat to advance work on the establishment of a Digital Access Service for Priority Documents for industrial designs and for trademarks, in a way that would ensure the largest possible participation of interested offices in such a service.

Agenda Item 5: Trademarks

79. The discussion was based on document SCT/22/2.

Grounds for Refusal of all Types of Marks

80. The Secretariat noted that the numbering of the English version of document SCT/22/2 for the chapter "Grounds for Refusal" should read as capital roman II and that precision would be introduced in the next version of the document.

(a) Signs not constituting a trademark

81. The Delegation of Morocco asked SCT members to share their practice concerning the registration of non-visible signs. The Delegation acknowledged the examples of registered sound marks and olfactory marks that were included in the document, but noted that it would be useful to include examples of refused non-visible signs, as well as the grounds on which those marks were refused.

82. The Delegation of the United States of America, in response to the question raised by the Delegation of Morocco, pointed out that non-visible signs were considered in the same way as traditional marks. The Delegation declared that for registration of non-visible signs two different analyses were made: firstly as to the distinctiveness of the sign and secondly as to the functionality of the sign. The applicants were required to show that the marks were distinctive and not functional with regard to the goods or services for which the mark was applied. This could be shown by supporting evidence such as, affidavits, surveys, and proof of use in commerce.

83. The Delegation further explained that when applications for sound and scent marks were submitted electronically, there was a need to replace the drawing requirement. Accordingly, the Office requested a sound file where the application was filed for a sound mark and for the specimen of the scented product in the case of a scent mark. Audiocassettes or compact discs were accepted as specimens for sound marks. Additionally, if a sound mark was composed by music or words or a set of music, the musical score of the mark could also serve as specimen. For scent marks the scented product itself served as a specimen. The Office did not require the submission of drawings for marks comprised solely by sound or scent. Instead, the applicants were required to provide a written description of the mark. If an application for a sound mark was filed electronically, the musical score of the mark should be submitted in a .WAVE format. The applicant had to transmit that file after the application was submitted, indicating the relevant application number. When searching for confusingly similar marks, the examiner searched the description field in the USPTO trademark database for determining whether a particular sound or scent mark was confusingly similar with a previously registered mark. Such searches generated a list of any other sound or scent marks that might be similar with the mark applied for.

84. As to whether the scent or sound mark could be identified at the point of sale, the Delegation used the example of the sound of a series of five chirps similar to the chirping sound of a cricket, which was registered for computer software, in particular, for notifying weather information. When user turned on the computer and this type of software was installed, the user would hear this chirping sound that instantly acknowledged the user on that software application, so the sound identified this type of product. Another example would be the musical score of five notes which are played when a user turns a computer with a Microsoft operating system. In this case also the sound immediately identified the operator. In this manner the sound was capable of identifying the product and distinguishing it from other goods.

85. The Delegation of Italy said that according to national law, sound trademarks could be registered only when they were represented graphically, for example, by musical notation, a stave or a sonogram. Those signs must have distinguishing capacity and, in no case, a complete song could be registered, but only jingles.

86. The Delegation of Azerbaijan commented that non-visible signs were not eligible for protection according to national law, which provided as a requirement that signs should be represented graphically. Furthermore, the sign should be capable of distinguishing the goods and services of one undertaking from those of another undertaking. The Delegation expressed concern about the likely subjective appreciation of such signs and, in particular, smell marks.

87. The Delegation of the United Kingdom sought a clarification regarding the comment made by the Delegation of the United States of America regarding the examples of marks provided for in the document, in particular if the applications needed to be accompanied by the sound file and the specimen of scent.

88. The Delegation of China stated that, according to national law, any distinctive and visually perceptible sign –if it was not prohibited by law– was eligible for registration as a mark. Protection was not extended to sound or olfactory marks, but there was a possibility that the law could be amended. The Delegation wondered whether the description of the olfactory mark “the scent of bubble gum” presented on page 3 of Annex I of the document would be accurate enough for consumers to distinguish the mark or in terms of its enforcement.

89. The Delegation of Serbia recalled that in the case of a traditional mark the graphical representation of the sign was the mark itself and the mark would appear in the market in the same form as it was registered. However, that was different for sound marks. Musical notation, which was the traditional way of representing a sound mark, would not be seen by consumers and those signs would be assessed in a different way. As a consequence, the sound and not the musical notation would function as a trademark.

(b) Lack of distinctiveness

90. The Delegation of Serbia expressed the view that the key question regarding distinctiveness was whether the average consumer could perceive a particular sign as a mark. The Delegation said that there were a number of factors to be taken into consideration when assessing whether a sign was seen as a trademark by the consumer and every particular case should be considered on its own merits.

91. The Representative of CEIPI asked for a precision referring to the translation of the words “in abstract”, in paragraph 13 of the French version of document SCT/22/2. The Representative expressed concern about the fact that a complete song or a whole film could be considered a sign.

92. The Delegation of the United Kingdom, in response to the Representative of CEIPI, explained that such complex and non-unitary items as a complete song or a whole film could not perform the essential function of a trademark. The Delegation specified that it was not aware of specific case law on such items, but considered that they would certainly pass the graphic representation test. The Delegation further noted that if the United Kingdom Registry felt that a particular “sign” was simply incapable of performing the function of a trademark under any circumstances, for any goods or services, as might be the case, for a complete song or a whole film, the Registry would be unlikely to accept that such complex media would have the required impact to function as a trademark.

93. The Delegation of Spain mentioned that in relation to color marks the practice of the national Office determined that a trademark consisting of a single color without a concrete shape could not be granted. In that case, the absolute ground of lack of distinctive character of the sign would apply, unless it is demonstrated that distinctiveness was acquired through use.

94. The Delegation of Norway clarified that the trademark “the color red” shown as an example in paragraph 18 of Annex I of document SCT/22/2 was registered in 2005, on the basis of evidence of distinctiveness acquired through use.

95. The Delegation of Italy stated that single colors were generally considered as lacking distinctiveness. Nevertheless, the Office recognized that in exceptional circumstances, a color *per se* could be registered as a trademark upon a showing of distinctiveness acquired through use. For example, “yellow” for AGFATM products or “red” for FerrariTM cars.

96. The Delegation of Azerbaijan referred to a national ruling concerning the use of a stripe of green for a chain of gas stations, which was later used by a similar business. In such a case the Court decided that use of the same color green for the same type of services for another person was misleading and constituted an act of unfair competition.

97. The Delegation of Ukraine stated that a color *per se* was generally not considered to be inherently distinctive. Evidence of acquired distinctiveness had to be lodged to overcome an objection based on such a ground and, generally, this was decided by the court. The Delegation further noted that this would also involve a consideration of whether the color was used for a long period of in the market place or the relevant trade.

98. The Delegation of Cuba noted that the content of paragraph 13 concerned signs which are not capable as such of distinguishing goods or services. In the doctrine this was referred to as inherent capacity to distinguish or lack thereof. In paragraph 16, the analysis on lack of distinctiveness was linked to descriptive or generic character, while it was possible to consider these elements separately. Such an analysis could give rise to subjectivity on the part of the examiner. The Delegation supported the views expressed by the Delegation of the Russian Federation and requested that the document include examples of scent marks which are not descriptive.

(c) Descriptiveness

99. The Delegation of Japan noted that the examples submitted by its Office and presented in the document in paragraphs 27, 28, 31 and 32 were hypothetical and did not correspond to any actual applications or registrations. The examples were meant to explain how those particular grounds for refusal would apply in Japan. The Delegation asked the Secretariat to clarify this point in the revised version of the document.

100. The Delegation of Morocco asked SCT members to share their practice concerning the examination and registration of combined marks that were comprised of a descriptive and a distinctive element.

101. The Delegation of the United States of America, in response to the Delegation of Morocco, pointed out that in the case of a combined mark the applicant would be asked to disclaim the non distinctive or descriptive element of the mark.

102. The Delegation of Uruguay indicated that, in cases in which a mark contained a non-distinctive element, the Office granted the mark applying a disclaimer for that element.

103. The Delegation of Switzerland declared that it was the overall impression created by the sign that determined whether or not that sign could be registered as a mark. The Delegation said that the Office did not apply the disclaimer system.

104. The Delegation of Singapore pointed out that national legislation did not provide for a practice of disclaimers. The Office examined composite trademarks as a whole, without dissecting the trademark into distinctive and non distinctive elements. If the overall impression of the mark was sufficiently distinctive, the registration was granted.

105. The Delegation of Mexico explained that, according to national legislation, trademarks which contained or consisted of descriptive and misleading terms relating to the geographical origin of goods and services could not be protected. The Delegation asked SCT members to share their practice concerning the examination and registration of marks that included terms relating to the geographical origin of goods and services, which were not misleading.

106. The Delegation of Italy considered it important to safeguard consumers from any possible deceptive activity of the trader with regard to the exact place of production and nature of goods or the place where services were rendered. Nevertheless, the Office accepted applications for collective marks that consisted of geographical indications, according to article 11 of the national Code of Intellectual Property. Such a collective mark had to be filed by the association of manufacturers, accompanied by the regulations containing all the requirements and standards to be applied to the goods.

107. The Delegation of China indicated that national law contained provisions regarding the registration of trademarks which contained or consisted of a geographical indication. In particular, names of cities, districts, countries, and foreign geographical names which were well-known by the general public in China would not be protectable. However, the protection of geographical indications as certification marks was provided in national law.

108. The Delegation of Spain indicated that national legislation established an absolute ground for refusal in relation to trademarks for wines and spirits that include a misleading geographical indication. Likewise, the law protects not only appellations of origin, but also any right relating to indications of the geographical source of wines and spirits, which are recognized by the country of origin, as long as there is a reputation attributable to the indication of geographical source.

109. The Delegation of Cuba declared that according to national law, the registration of a trademark which consisted exclusively of a geographical indication would be refused irrespective of whether or not it was deceptive in respect of the goods applied for. However, if the non-deceptive geographical term was accompanied by other distinctive elements, the trademark could be registered.

110. The Delegation of Hungary expressed the view that trademarks which consisted exclusively of geographical indications would be refused registration. The Office would examine *ex officio* this absolute ground for refusal, irrespective of whether it was a national or a foreign geographical indication. The Delegation indicated that according to national law, the registration of a trademark which contained a geographical indication might be refused with respect of goods not originating in the territory indicated, if use of that designation for the goods was likely to mislead the public as to their true place of origin.

111. The Delegation of Ukraine said that geographical indications were protected according to special laws, which were separate from trademark legislation. Furthermore, national law did not contemplate the protection of geographical indications through the system of collective trademarks.

112. The Delegation of Serbia stated that the test for determining whether a mark composed exclusively of a geographical term could be registered had two elements: (1) whether the average consumer would understand that the primary significance of the mark was a geographic location, and (2) whether the average consumer would associate the goods and/or services with the place identified in the mark. If the answer to both questions was affirmative, the trademark would be refused.

113. The Delegation of Azerbaijan explained that when examining marks composed of geographical names, a careful analysis would be made with regard to the primary significance of the mark and the link of the goods and/or services with the place identified in the mark. For example, if the mark identified a specific good with a particular quality, reputation or other characteristic and the goods did not originate in the place identified in the mark applied for, the application would be refused.

114. The Delegation of Peru declared that in the case of applications containing geographical names, the Office looked at the type of sign and tried to establish whether the sign was fanciful in relation to the goods or if the national consumer could see a connection between the goods and the geographical name. “*Sorrento*” for chocolate or “*Florida*” for canned fish were examples of trademarks which were granted by the national office. The Delegation noted that if the trademark consisted of an indication of source, the sign could be considered descriptive. It would be considered misleading if a false or deceptive indication of source was used. Under national law, if the sign consisted of a geographical indication, it would be refused under absolute grounds and there was a special protection for geographical indications concerning wines and spirits.

(d) Public order and morality

115. The Delegation of Spain declared that national law contained strong provisions preventing the registration of trademarks which contained racial and religious disparagement or were contrary to the rights of children.

(e) Deceptiveness

116. The Delegation of Hungary referred to the example for a refusal provided by the Delegation of Norway on page 17 of Annex I and said that it corresponded to the current national legislation. The Delegation explained the national experience in relation to signs which are geographically deceptive and, in particular, the criteria used for to make that determination, namely, the list of goods and services, the residence and the seat of the applicant. The Delegation indicated that with regard to the assignment of registered marks, the Office had the burden to examine if the assignments mislead the public, as deception can arise in relation to the geographical origin of the goods or services because of a change of ownership.

117. The Delegation of Peru stated that the national Office did not take into account the nationality of the applicant in the analysis of deceptive character.

118. The Delegation of Azerbaijan supported the statement made by the Delegation of Hungary and pointed out that its Office also encountered difficulties when examining the assignment of registered marks which might become deceptive as to the geographical origin of the goods and services as a result of the assignment. The Delegation mentioned an example of a trademark that contained a geographical name and was registered by a company

from the Russian Federation for spirits, which was subsequently assigned to a company from the Netherlands. In that case, the Office did not accept the assignment as the change of ownership of the trademark would mislead the consumer. The Delegation concluded that in this type of applications, it would be useful to include information indicating whether the sign made reference to a particular geographical place, the goods and services claimed in the application and information regarding the domicile of the applicant.

119. The Delegation of the United Kingdom disagreed with the views expressed by the Delegation of Azerbaijan that the residence of the applicant was a key factor when assessing the deceptiveness of a mark. The Delegation said that the most important aspect was the overall impression and the impact of the mark, or the message that the mark would convey to the consumer. If the mark “*Holland House*”, which was mentioned on page 17 of Annex I of the document, were applied in the United Kingdom, the examiner would look at the mark as a whole and analyze if the goods and services had a reputation in association with Holland. Such a trademark would be refused for “flowers”, for example, and might be registered for “car washing services”. Therefore, the crucial element was not the seat of the applicant, but the message that the sign sends to the consumer.

120. The Delegation of Croatia supported the views expressed by the Delegation of the United Kingdom and stated that a deceptiveness objection in Croatia would be raised if, due to some connotation or sign contained in the mark, the use of the trademark in relation to the goods or services claimed in the application would be likely to deceive the public. The link between the geographical origin of the goods or services and the perception of the consumer was particularly important.

121. The Delegation of Switzerland stated that the national Office used the criteria of the company headquarters as relevant to determine if a mark was misleading for services. In the case of a geographical term which was known by the public, the determination of whether the trademark was misleading for services would be answered by looking at the headquarters of the trademark holder.

122. The Delegation of Hungary supported the statement made by the Delegation of Switzerland. The Delegation indicated that when applications contained certain geographical terms, the applicant was required to limit the list of goods to those produced in line with specific indications. For instance, in case of a mark containing a reference to the Russian Federation applied for vodka, the applicant had to limit the list of goods to “vodka made in the Russian Federation”.

(f) Article 6*ter* of the Paris Convention for the Protection of Industrial Property

123. The Delegation of Italy stated that, generally, trademarks that contained armorial bearings, flags and other State emblems were refused registration. Nevertheless, a significant number of decisions on refusal were appealed to the Board of Appeals of the Italian Patent Office and the decisions of the examiners might be overturned on the basis of the provisions contained in Article 6*ter*(1)(c).

(g) Shapes

124. The Delegation of Italy stated that the Office received many applications for trademarks consisting exclusively of shapes that were in fact disguised utility or ornamental models. The Delegation considered that applicants preferred the possibility to renew trademarks

indefinitely, as compared to the limited 25-years protection of models and designs. The refusals of those trademarks were based firstly on the grounds that the shape was necessary to obtain a technical result, and secondly, that the shapes were giving a substantial value to the product itself.

(h) Bad faith

125. The Delegation of Azerbaijan mentioned the case of a national trademark “*Smootch*”, which was registered as a word mark for biscuits. The use of that mark on the market was considered to be in bad faith because the mark was written in the same way as the letters of a famous mark “*Snickers*TM”; the same colors were used and the product had the same packaging. In this case, the Office decided that the way in which the mark was used and marketed was misleading. Following this decision, the Office proposed amendments to the legislation. The provision stated that if bad faith was established in the use of a registered mark, the Office was entitled to consider the invalidation of that mark. Another example concerned a registered mark “Bingo” for products in class 03. An application for the mark “B BingoTM” was filed for the same products, and the logo was very similar to the earlier registered mark “Bingo”. The Office decided that the second mark was filed in bad faith and the mark was refused during the examination proceedings.

126. The Representative of INTA drew the attention of the Committee to the Resolution adopted by the Board of the Directors of INTA, in September 2009, on the issue of bad faith. This Resolution aimed at preventing clear cases of misappropriation of trademarks that were identical or substantially identical to those of trademarks owners. The Representative said that according to the Resolution, bad faith should be narrowly construed to capture only conduct which was clearly inconsistent with norms of honest and fair commercial behavior. In order to apply that concept, INTA recommended a number of requirements to be imposed for a finding of bad faith application or registration.

127. The Representative said that the first requirement was that the applicant or registrant knew of the third party rights or legitimate interest in a mark identical or substantially identical to the mark applied for or registered, where such knowledge was actual or might be inferred from the surrounding circumstances. Also, that the conduct of the applicant or registrant in applying for the mark was inconsistent with norms of reasonable honest and fair commercial behavior. The Resolution recommended a non-exhaustive list of factors which were to be considered when determining whether the conduct of the applicant or registrant was inconsistent with norms of reasonable, honest and fair commercial behavior.

128. The Delegation of the Russian Federation indicated that in the year 2003, provisions referring to bad faith registrations were introduced into the national legislation, and accordingly, if it was proven that an applicant was responsible for acts of unfair competition connected with a trademark for which registration was sought, the registration was refused. Moreover, a special body, namely the antimonopoly service, was in charge of determining acts of unfair competition. Based on the decision of the antimonopoly service, the interested party could request the Office to cancel a particular trademark registration.

129. The Delegation of Serbia noted that bad faith was a complicated issue and said that the Office was authorized to examine the trademark but was not in position to appreciate whether the applicant acted in good or bad faith. Bad faith was not listed as a ground for refusal in the Trademark Law of Serbia. The Office only had the capacity to stop the proceedings in cases where an action regarding the bad faith of the applicant had been decided by the Court.

130. The Delegation of China agreed with the description of bad faith provided in paragraphs 54, 55 and 56 of document SCT/22/2. The Delegation stated that in national practice bad faith was rarely used as a ground for refusal of registration in examination proceedings. However, this was a ground for opposition and if the bad faith of the applicant was proved, the trademark would be refused.

(i) Prior trademark rights

131. The Delegation of Brazil asked SCT members whether their laws provided any specific protection for highly renowned marks and, in particular, whether protection would cover goods and services different than those covered by the mark.

132. The Delegation of Mexico pointed out that national legislation provided for the possibility of refusing a trademark which could lead to confusion with regard to a well-known or famous trademark. The legislation of Mexico distinguished between a well-known and a famous trademark. The protection for well-known marks was recognized only for the goods and services for which the mark was registered. The protection of a famous brand would be recognized for any other products.

133. The Delegation of Uruguay pointed out that national legislation provided for protection of well-known and famous marks under relative grounds for refusal. Signs or words which constituted a reproduction, imitation or translation, total or partial, of any well-known trademark would be refused registration. In the case of marks which were well-known in a specific market only, the protection would be the same as indicated by the Delegation of Mexico.

134. The Delegation of Portugal said that national legislation distinguished between well-known and famous trademarks in the same way as it was described by the Delegations of Mexico and Uruguay.

135. The Delegation of Syrian Arab Republic stated that the Office refused to register trademarks that were similar or that were a translation of a famous trademark for all kinds of goods and services, even if the famous trademark was not registered in Syria.

136. The Delegation of Ukraine explained that national legislation covered the protection of well-known marks, without making any distinction as the level of notoriety. A well-known mark could be recognized as such only by the Office or by the Court, based on criteria that were developed in the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks. The protection of a well-known mark covered all types of goods and services and not only those for which the mark was recognized to be well-known.

137. The Delegation of Italy said that the Office did not examine relative grounds for refusal, so conflicts arising from the protection of well-known trademarks were considered by the court. National law did not provide for opposition procedures and in some cases the Office contacted organizations of trademarks owners to inform them about applied trademarks, but usually the trademark holders were themselves in charge of checking all new filings.

138. The Delegation of Azerbaijan declared that according to national legislation the Office examined and recognized well-known marks. Once recognized, the well-known mark was included in a special register and the information was published in the official publication in order to give third parties a possibility to file objections. Well-known mark protection covered all types of goods and services and not only those for which the mark was registered.

139. The Delegation of Australia stated that national trademark law did not specifically incorporate a definition of well-known marks and did not provide for a register of well-known marks. However, it was possible to obtain protection proactively for what the applicant would consider to be a well-known mark through a defensive trademark system. For a defensive trademark to be registered, the applicant must already have a registration for the same mark. The registered trademark must be used to such an extent for the goods or services for which it is registered that consumers are likely to assume a connection between those goods or services and the goods or services of the defensive trademark. It was not a requirement that the defensive trademark must be used on all the goods or services for which it is registered and the mark cannot be removed on the basis of non-use.

140. The Representative of the European Community said that in the Community trademark system it was possible, either in opposition or in invalidity proceedings for a registered mark with reputation to pose an obstacle to the registration of an identical or confusingly similar mark in respect of dissimilar goods or services, subject to certain conditions, namely where the mark has a reputation and where the use without due cause of the trade mark applied for or registered would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Those conditions must be complied for the holder of a mark with reputation to be able to attack or defend itself against an application or registration for dissimilar goods and services. The legal provisions were found in Article 8 paragraph (5) of the Council Regulation (EC) No 207/2009 of February 26, 2009 on the Community trade mark (codified version), in respect of opposition, and Article 53 paragraph (1) in relation to invalidity.

141. The Delegation of Peru noted that Andean Community legislation did not distinguish between well-known and famous marks. Nevertheless, different levels of protection could be inferred. A well-known mark was protected against the risk of confusion and was recognized as well-known only in a specific sector of the public and protected against the risk of confusion with goods and services related to that sector. However, a trademark recognized to be famous could be protected against marks applied for dissimilar good and services.

142. The Delegation of Switzerland expressed the view that whether or not a mark was well-known had to be determined by the country where protection was sought and the perception of the consumer in that particular country was the decisive factor. The fact that a mark was well-known in one country did not mean that the same mark could be well-known in another country.

143. The Representative of INTA considered that the question of well-known marks registers was very much debated among users. INTA had never endorsed or recommended establishing well-known mark registers, but to the extent that such registers might be established in certain jurisdictions, INTA would like to ensure that their implementation contributed to legal certainty as to the protection of well-known marks in those jurisdictions.

The Representative believed that the right of a trademark owner to establish that the trademark was well-known in litigation or other proceedings should not be adversely impacted by the fact that the trademark was not included in a well-known marks register. The Representative said that registration in a well-known marks register should not be a condition for establishing the well-known character of a mark in case of litigation.

(j) Personality rights

144. The Delegation of the United States of America inquired how the Offices of other SCT members treated applications to register trademarks which consisted of or included the name of a head of State or names of famous persons. The Delegation noted that the national Office had found that countries around the world treated those issues in opposition or cancellation proceedings, which might be difficult for heads of State to deal with due to legal representation and legal standing issues.

145. The Delegation indicated that under national trademark law there were several absolute grounds for refusal which might be used to reject such applications, including false suggestions or connection, disparagement, and use of the name of a living individual without his/her consent. The Office considered that a refusal based on the name of the living individual without its consent was the most effective, because the examiner was not required to prove that the consumer would be misled by the use of the mark or that the consumer would believe that there was any affiliation between the source of the goods or services and a head of State. However, most national offices did not contemplate this type of refusal.

146. The Delegation of Spain declared that its legislation provided for the refusal of registration of the pseudonym, the patronymic or any other name of public figures without their authorization.

147. The Delegation of Malaysia said that the Office requested a letter of consent for any of the above mentioned types of applications. In cases where the person was deceased, the consent was required from a legal representative; otherwise the applications were refused.

148. The Delegation of the Republic of Moldova explained that national legislation allowed third parties to protect their rights in cases where someone applied for registration of a mark that included their names. Moreover, specific provisions referred to refusal of a mark when it contained the name of a famous person.

149. The Delegation of Brazil declared that national legislation stated that names or signatures of persons, family names or patronymic and images were not eligible to be registered as trademarks, except with the consent of the owner, his heirs or his successors.

150. The Delegation of Mexico stated that it was not possible to register names, pseudonyms, signatures and portraits of living persons without their authorization or the authorization of the successors of deceased persons. The Delegation considered that the definition of a name could include anything that identified the person.

151. The Delegation of the Russian Federation explained that national legislation contained provisions aimed at prohibiting the registration as trademarks of names or pseudonyms of famous people without their consent. Nevertheless, this particular ground for refusal was not checked *ex officio* during the examination of an application, but would rather be invoked during cancellation proceedings. The Delegation said that amendments to national legislation were needed so that the Office could check this ground for refusal during registration procedures.

152. The Delegation of Cuba stated that a conflict between a trademark and personality rights might constitute a relative ground for refusal according to national legislation. The registration of a trademark might be refused if the mark affected the rights of the third party, including personality rights. The definition of personality rights was broad and referred the name, signature, nickname, pseudonym, image, or portrait of a given person, who was different from the person seeking registration. However, registration might be granted if the person whose rights were concerned or his successors in right agreed to the registration of the mark.

153. The Delegation of Turkey said that two marks containing the name of the President of the United States of America had been filed with the Office. According to national legislation personality rights were not stated as an absolute ground for refusal; however, the applications were refused on the basis of objections submitted by the Embassy of the United States of America.

154. The Delegation of Uruguay highlighted that national legislation considered the existence of personality rights as a relative ground for refusal. The notion of personality rights referred to the name, signature, nickname, pseudonym and title that identify the person. The person whose rights were concerned or his legal successors should consent to the registration of the marks. The Delegation said that the marks “*Pele*” and “*Prince Charles*” were refused registration on the basis of this ground.

155. The Delegation of Kenya shared its experience concerning refusals of trademark registration on the ground of personality rights. National legislation stated that personal names, family names or the patronymic of third parties were not eligible to be registered as trademarks, except with the consent of the owner or its successors.

156. The Chair concluded that the work of the SCT on grounds for refusal of all types of marks was of great interest for IP Offices of SCT members. All comments by delegations would be recorded in the report of the twenty second session of the SCT. The Secretariat was requested to revise document SCT/22/2, taking into consideration all comments made by delegations at the twenty-second session. Furthermore, delegations will be given the opportunity to present comments in writing for inclusion into the revised working document. Such comments should reach the Secretariat by the end of January 2010. The revised working document should take the form of a SCT reference document on grounds for refusal of all types of marks. This reference document would be presented to the twenty-third session of the SCT for final review and should be published thereafter.

Technical and Procedural Aspects Relating to the Registration of Certification and Collective Marks

157. Discussion was based on document SCT/22/3.

158. The Delegation of Hungary indicated that national law dealt with certification or collective marks in the same manner as other kinds of trademarks and did not provide for any limitation of their representation, as it was indicated in paragraph 31 of document SCT/22/3. In addition, it specified that it was not possible to register a collective mark which consisted exclusively of the name of a geographical area or a city, such sign being exclusively protected by means of geographical indications.

159. The Delegation of Sweden explained that misleading collective and certification marks would be refused in Sweden in accordance with general rules applying to all kinds of marks. The Delegation therefore proposed that paragraph 23 of the document be reworded as follows: “additional grounds for refusal may apply to collective and certification marks, which are not applicable to individual trademark applications. The former application may for example ...”. Furthermore, the Delegation pointed out that its registration Office did not inquire as to the authority of the applicant to control the use of a geographical term, and thus suggested replacing, in the eighth line of paragraph 28 the words “the office will inquire ...” by “the office may inquire...”.

160. The Delegation of the Russian Federation, referring to paragraph 54 of document SCT/22/3, said that licensing of collective marks was not allowed due to potential misuse and asked whether any research had been undertaken with regard to abuse in the jurisdictions where licensing of such marks was allowed. In addition, it stated that national legislation provided for the possibility of transforming a collective mark into an individual mark or vice-versa, and suggested reflecting that option in the document.

161. The Delegation of Serbia indicated, with regard to paragraph 55 of document SCT/22/3, that assignment of registration was not allowed according to the trademark law of Serbia. It however noted that the document referred to both the possibility and prohibition of assignment in Member States, without clearly determining which was the rule and which was the exception. The Delegation expressed the view that the general rule consisted on the prohibition of assignment of collective marks and proposed amending the document accordingly.

162. The Delegation of Italy noted that the Office received a large number of applications for collective trademarks since Italian products, such as manufactured leather or typical foodstuffs, were based on traditional know-how and had a reputation worldwide. However, the Office paid particular attention to collective trademarks which could be in conflict with previously registered geographical indications or appellations of origin.

163. The Delegation of Cuba pointed out that its legislation provided for collective marks only. Referring to paragraph 34 of the document, that stated the need for use regulations to be clear and accessible to anyone seeking to use the mark, the Delegation believed that confidential information should not be accessible to persons outside the association. The Delegation further explained, in relation to paragraph 39, that according to national legislation producers or associations of producers authorized to use the mark should be situated or have their domicile in the geographical area specified in the use regulations, in order to avoid any

misleading information for consumers. Regarding control over the use of the mark, the Delegation requested that the Spanish version of paragraph 49 of the document be clarified, since the term “applicant” could refer to the trademark applicant, the holder or the person seeking to use the mark.

164. The Delegation of Sweden, commenting on the statement made by the Delegation of Serbia, observed that assignment of certification and collective marks to new holders was allowed in Sweden and expressed the view that the text of paragraphs 55 and 57 should remain unchanged.

165. The Delegation of China said that both certification and collective marks could be transferred, provided that the new holder complied with certain requirements. As regards collective marks, only members of the association were allowed to use the mark.

166. The Chair requested delegations to express their views on the continuation of the work. He suggested either to make the document available on the WIPO website including the statements made at the twenty-second session of the SCT, or to request the Secretariat to review the document in line with those comments before publication after the next session.

167. The Delegations of Azerbaijan, Cuba, Hungary, Malaysia, Peru, Russian Federation, Spain, Ukraine, United States of America, Uruguay, and the Representative of the European Communities supported the second alternative put forward by the Chair.

168. The Delegation of Cuba pointed out that so-called “State” marks used for certification purposes had been communicated by Cuba under Article 6*ter* of the Paris Convention, and asked whether in other jurisdictions there was a relation between such marks and certification marks.

169. The Delegation of Azerbaijan requested that issues relating to licensing of certification marks be included in the revised document. The Delegation held the view that when a national emblem was used as part of a certification mark, it would be difficult to license that mark, as it indicated a connection with a specific country.

170. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-second session of the SCT. The Secretariat was requested to prepare a revised working document on technical and procedural aspects relating to the registration of certification and collective marks, taking into consideration the comments made by delegations during the twenty-second session. Furthermore, delegations will be given the opportunity to present comments in writing for inclusion into the revised version of the working document. Such comments should reach the Secretariat by the end of January 2010. After reconsideration of the document by the twenty-third session of the SCT, the document will be published for reference purposes.

Article 6ter of the Paris Convention

171. Discussion was based on document SCT/22/4.

172. The Delegation of Jamaica sought clarification with regard to the distinction between “registration” and “use” of trademarks. The Delegation presented a proposal for the amendment of the draft questionnaire concerning the protection of official names of States against registration or use as trademarks. With regard to the issue of non-commercial uses of official names of States, the Delegation suggested including the following questions in the questionnaire: “Under the applicable legislation, official names of States are protected against registration as trademarks for non-commercial purposes” and “Under the applicable legislation, official names of States are protected against use as trademarks for non-commercial purposes”.

173. Regarding exceptions to protection, the Delegation suggested two additional questions focusing on the registration and use of trademarks: “Under the applicable legislation, are there any exceptions regarding the protection of official names of States against registration as trademarks?” and “Under the applicable legislation, are there any exceptions regarding the protection of official names of States against use as trademarks?”.

174. The Delegation asked SCT Member States to share their practice on the use of adjectives and transliterations, and suggested adding questions that would read: “Under the applicable legislation, are adjectives and/or transliterations of official names of States protected against registration as trademarks?” and “Under the applicable legislation, are adjectives and/or transliterations of official names of States protected against use as trademarks?”.

175. Recalling the text of Article 6ter(1)(a) of the Paris Convention on the requirement of authorization by the competent authorities, the Delegation suggested including the following questions: “Under the applicable legislation, the registration of trademarks which include official names of States requires proof of authorization” and “Under the applicable legislation, the use of trademarks which include official names of States requires proof of authorization”. With regard to the issue of non-commercial use, the Delegation proposed including the following question: “Where a possible conflict between a trademark for non-commercial entities and an official name of a state constitutes a ground for refusing the registration of the trademark, this ground”, and then include the same sub-items as in questions 5 and 6 of the draft questionnaire.

176. Moreover, the Delegation requested that references to goods and services contained in questions 7 and 8 of the draft questionnaire be replaced either by “goods and/or services” or “goods or services”, or alternatively that the reference to goods and services be separated for goods and for services as in the example given for question 7: “In determining whether there is a conflict between a trademark for which registration is sought for goods and an official name of a State, consideration must be given to the potential deception of consumers as to the origin of the goods on which the trademark is proposed”, and “In determining whether there is a conflict between a trademark for which registration is sought for services and an official name of a State, consideration must be given to the potential deception of consumers as to the origin of the services on which the trademark is proposed”.

177. The Delegation of Switzerland supported the proposal made by the Delegation of Jamaica concerning the introduction of a question on adjectives and transliterations of State names. The Delegation also agreed on the suggested separation of goods and services in questions 7 and 8.

178. The Delegation of El Salvador declared that it did not support the proposed change in the formulation of questions 7 and 8.

179. The Delegation of Austria considered that the questions of the draft questionnaire were not precise enough, as some could be answered positively and in the negative at the same time, depending on circumstances, which might need to be explained. The Delegation observed that the answers could only be properly interpreted by introducing footnotes.

180. The Delegation suggested dividing questions 1 and 3 into two subquestions respectively, as follows: “Under the applicable legislation, official names of States are in any case/*per se* protected against registration as trademarks for goods”; “Under the applicable legislation, official names of States are protected against registration as trademarks for goods in the case that the overall impression of the trademark could be considered descriptive (for example it could be seen as an indication of geographical origin) or lacks distinctive character in relation to the goods in question”; “Under the applicable legislation, official names of States are protected in any case/*per se* against use as trademarks for goods”; “Under the applicable legislation, official names of States are protected against use as trademarks for goods if the use could be seen as misleading (for example in respect of the geographical origin) of the goods”.

181. The Delegation of Cuba supported the proposal made by the Delegation of Jamaica, with the exception of the separation of goods and services in questions 7 and 8. With regard to question 5, the Delegation sought clarification on the requirements for third parties in raising objections against registration, and proposed to reconsider the requirement of potential deception of consumers in question 7. Finally, the Delegation suggested that the revised questionnaire also deal with the question of homonymous names.

182. The Delegation of Peru proposed adding the option of invalidation procedures in the last sub-item of questions 5 and 6, and explained that national legislation made a difference between cancellation and invalidation procedures.

183. The Delegation of France wondered whether the draft questionnaire could be useful in determining the current state of protection granted to official names of States in national legislation. In fact, it seemed that the draft questionnaire would not allow to reflect the legislation of a number of States, which without providing for a specific regime for names of States, protected them in the same manner as other geographical indications. The Delegation explained that the national Office refused the registration of names of States as trademarks if they are likely to mislead the public or were considered descriptive of any other particular quality of the products on the basis of which the geographical place has acquired reputation.

184. The Delegation of Brazil supported the proposal made by the Delegation of Jamaica and the statements made by other delegations, and suggested that countries be allowed to make comments on each question of the draft questionnaire in their replies.

185. The Delegation of the United Kingdom supported the interventions made by the Delegations of Austria, Brazil and France concerning the possibility of inserting footnotes and explanatory notes for each question. The Delegation expressed the view that the expression “applicable legislation” might be vague and wondered if it also referred to the practices of Member States.

186. The Delegation of Kenya supported the proposal made by the Delegation of Jamaica. It also expressed support for continued deliberations of the SCT on that topic and requested the Secretariat to insert in the questionnaire questions concerning cases where national legislation did not prohibit the registration of trademarks including country names or abbreviations thereof, as well as the requirements for those registrations.

187. The Delegation of the Republic of Moldova wondered whether the first question referred to marks consisting exclusively of the name of a State or marks simply containing a country name. The Delegation sought clarification on the purpose of the questionnaire and asked whether it was intended to analyze the protection of the full official name of a State or parts of the name and the two letter code abbreviation of the country name.

188. The Delegation of Singapore proposed amending questions 5, 6 and 7 respectively as follows: “Where the inclusion of an official name of a State in a trade mark constitutes a ground for refusing the registration of that trade mark in respect of goods, that ground...”; “Where the inclusion of an official name of a State in a trade mark constitutes a ground for refusing the registration of that trade mark in respect of services, that ground...”; “In determining whether the inclusion of an official name of a State in a trademark would be a ground for refusing registration of that trademark, consideration must be given to the potential deception of consumers as to the origin of the goods or services on which that trademark is used or proposed to be used”.

189. The Delegation of Turkey expressed the view that before envisaging an amendment to the Questionnaire, an explanation was needed as to what is the official name of a country and asked whether that expression included variations of the name.

190. The Delegation of Azerbaijan considered the proposal made by the Delegation of Jamaica to be constructive and believed that there was a need for further discussion on the basis of the questionnaire. The Delegation supported the proposal of inserting footnotes or explanatory notes after each question.

191. The Delegation of Ukraine observed that the revised version of the questionnaire should take into account the concerns raised by delegations. The Delegation welcomed the suggestion made to insert questions regarding the translation, abbreviation and other derivatives of official names of States.

192. The Delegation of Azerbaijan supported to the views expressed by the Delegations of the Republic of Moldova and Ukraine.

193. The Chair concluded that the Secretariat was requested to revise the draft questionnaire concerning the protection of official names of States against registration or use as trademarks contained in the Annex to document SCT/22/4, taking into account all comments made by delegations at the twenty-second session. Furthermore, the Secretariat will publish an intermediary version of the revised draft questionnaire on the SCT Electronic Forum for further comments. A revised version of the draft questionnaire, taking into account the comments from the twenty-second session as well as the comments on the intermediary version published on the SCT Electronic Forum will be presented to the twenty-third session of the SCT for adoption and subsequent circulation.

Replies to the Questionnaire on Letters of Consent

194. Discussion was based on document SCT/22/5 Prov.

195. The Delegation of Portugal stated that their affirmative answer to Question 1(c) depended on the decision by a judge to accept or refuse letters of consent to overcome invalidation. Regarding Question 2, it explained that the answer would depend on whether a power of attorney was submitted.

196. The Delegation of Finland, referring to Question 2, sought clarification on the words “filed by” and wondered whether they could be understood as equivalent to “signed by”, in which case their answer would have to be in the negative.

197. The Delegation of Azerbaijan requested that its positive answer to Question 6 be amended, considering that the meaning of the question was broader. Referring to procedures under the Madrid System, the Delegation indicated that a letter of consent might be submitted at any time by the prior right holder, in writing, even when no contradiction has been raised during the examination procedure. In addition, the Delegation requested that the answer to Question 7 be amended in the negative.

198. The Delegation of Austria requested that the comments submitted with its replies to the questionnaire should be included in the revised document.

199. The Delegation of the Czech Republic noted that with regard to Question 5(a) concerning the mandatory content of a letter of consent, its answer should be in the negative.

200. The Delegation of Australia said that some of the information contained in the document with respect to Australia’s practice could be further clarified. Its reply to Question 2 would be that a letter of consent was not necessarily acceptable when filed by an applicant that is a legal person belonging to the same group of enterprises as the holder, unless it existed an appropriate commercial relationship between them. The Delegation suggested dividing Question 2 into sub-questions depending on the nature of the relationship between the applicant and the party providing a letter of consent.

201. The Delegation of the United States of America requested that its answer to Question 5(a) be corrected to indicate that there is no provision for a letter of consent to have a mandatory content.

202. The Delegation of Brazil asked that its negative answer to Question 4 be corrected in the affirmative.

203. The Delegation of China requested that its answer to Question 1(b) be recorded in the negative.

204. The Secretariat clarified that Question 2 referred to cases where the applicant and the holder of the opposing right belonged to the same group of enterprises. The question inquired as to whether that situation could disqualify the letter of consent. The question did not imply that a letter of consent could emanate from the applicant itself, but rather be submitted by it.

205. The Delegation of Mexico indicated that national legislation contemplated amendments which would allow for the presentation of letters of consent and pointed out the importance of understanding the practice of other offices, particularly in cases where conflicts could be solved through letters of consent. In analyzing the replies to the questionnaire, the Delegation considered that letters of consent had a limited scope if they were allowed for granting a registration but not for transferring it. The Delegation was interested in learning the experience of other offices in cases where electronic systems had to be adapted to take into account letters of consent. Where a letter of consent was required from all related right holders in order to grant a second or third registration, this would have to be recorded in the electronic system.

206. The Delegation of Serbia noted that a letter of consent was one of the factors that the examiner had to consider to determine whether there was a likelihood of confusion. The Delegation further noted that when the owner of the earlier mark decided at a later stage to withdraw the consent and asked for the cancellation of the mark, the Office would refuse the cancellation, since the withdrawal of consent was a new fact that did not exist at the time of granting the protection. A trademark could only be cancelled when the legal conditions for protection were not fulfilled at the time of registration. The Delegation indicated that it would submit a written statement containing those comments for inclusion in the revised document.

207. The Delegation of Uruguay said that, according to national law, letters of consent were not used to overcome an *ex officio* refusal of a trademark registration on the basis on an earlier registered trademark. However, in the case of a particular opposition without any *ex officio* refusal by the Office, a letter of consent would be accepted if it is filed by a holder that is a legal entity belonging to the same group of enterprises as the holder of the prior registered trademark. The Delegation explained that it was unable to respond to Questions 4, 5, 6, 7, 8 and 9, because of the public service nature of trademark registrations in Uruguay.

208. The Delegation of Cuba pointed out that when a letter of consent was provided, it would be taken into consideration during the examination procedure. However, as long as there was a possibility of confusion, the trademark would always be refused, in order to protect the collective interests of consumers. When there was more than one holder, the Delegation believed that instead of letters of consent use licenses would be relevant.

209. The Delegation of the Russian Federation raised the issue of cases where the Office could not register a given trademark even if a letter of consent was provided because such registration was contrary to the public interest or could be deceptive to consumers. The Delegation wondered whether offices should publish the information on letters of consent, as

this could be useful for third parties. The Delegation asked whether a copy of the letter of consent could be provided to interested third parties upon request. The Delegation asked the Secretariat to include the comments submitted by countries in the revised version of the questionnaire.

210. The Delegation of Croatia observed that the Trademark Act of Croatia did not include provisions on letters of consent. Earlier rights were not examined by the Office but the holder of earlier rights could raise an opposition after the publication of the application. The Delegation explained that its answers to the questionnaire contained footnotes, indicating that in its understanding the withdrawal of an opposition was not equivalent to a letter of consent.

211. The Delegation of Spain noted that when agreement was reached in opposition procedures, it was only necessary that the opponent withdraw its opposition. The Office in Spain did not examine prior rights *ex officio*, but if necessary it would send a communication to the potential opponent.

212. The Delegation of Azerbaijan indicated that following amendments to national legislation on May 17, 2009, letters of consent from the previous right holder could be submitted by applicants and always resulted in a positive conclusion if they were timely. The legislation specified that the trademarks could be similar and relate to similar goods, but would be rejected if they were identical. The Delegation noted that letters of consent could also be presented for international registrations. The national Office never experienced a situation where the previous right holder gave letters of consent to different applicants for similar trademarks, since in that case, the prior right holder would be in competition with the new right holders and would not be able to verify the quality of the goods. In response to the issue raised by the Delegation of the Russian Federation, the Delegation noted that the Office did not publish information on letters of consent, but would provide the information upon request by a third party.

213. The Representative of INTA observed that about one fifth of the countries that replied to the Questionnaire would not accept a letter of consent in opposition procedures or a cancellation action. A number of those jurisdictions would nevertheless accept letters of consent in *ex parte* procedures. The Representative wondered whether this meant that in any of those jurisdictions, opposition or cancellation action would not be extinguished as a result of settlement between the parties and possibly withdrawal by the opponent or the applicant in a cancellation action. The Representative also wondered whether in such cases, the Office would nevertheless wish to decide on the likelihood of confusion.

214. The Chair concluded that the Secretariat was requested to finalize the Summary of replies contained in document SCT/22/5 Prov., in line with the comments made by delegations on specific answers contained in the table and on the comments section of the document, with a view to publishing the final version of this document for future reference.

215. The Representative of the European Community stated his understanding that the work of the SCT consisted also of exchanging information among participating delegations on major policy and legislative developments in different jurisdictions. Against that background, the Representative informed the SCT that an important project had been recently launched by the European Commission, which consisted of a comprehensive study of the overall functioning of the trademark system in Europe. The objective of the study was to identify potential areas for improvement, streamlining and further development of the system.

216. The Representative explained that since the Trademark Community System was closely related to the national trademark laws of the Member States, the study would not only analyze the need for reform in respect of the Community Trademark Regulation establishing the Community Trademark System, but would also examine the Trademark Directive, which was the legal instrument harmonizing national laws of Member States in the area of trademarks. Given that these two legal instruments had existed for some time, it was believed that a thorough analysis and assessment of their relevance and added value was necessary.

217. The Representative said that the results of the study might reveal the need for a review of the European statutory framework, including further harmonization and the establishment of enhanced cooperation between the Office for Harmonization in the Internal Market and the national offices of Member States. The Representative indicated that a contract had been signed with the Max Planck Institute (MPI) for Intellectual Property in Munich to carry out the study. The MPI had a long-standing research tradition in the area of Community and International Trademark Law. The survey was expected to last twelve months, with interim results available by the end of February 2010. The Representative pointed out that further information on this project was available on the website of the European Commission, where the full text of the relevant terms of reference were posted, together with the background of the study and the questions that it was expected to address.

Agenda Item 6: Geographical Indications

218. The Chair noted that there were no working documents or proposals for discussion at this meeting. The Chair concluded that this item will remain on the agenda for the next session of the SCT, at which moment delegations would have an opportunity to express their opinions whether they wished to pursue work under that agenda item on the basis of a specific working document.

Twenty-Third Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/23)

219. The Chair announced the week from April 19 to 23, 2010, as tentative dates for SCT/23 and the session of the Working Group for reviewing possible amendments to the Regulations under the Singapore Treaty on the Law of Trademarks, which will meet back-to-back with the twenty-third session of the SCT.

Agenda Item 7: Summary by the Chair

220. The SCT approved the Summary by the Chair as contained in the present document.

Agenda Item 8: Closing of the session

221. The Chair closed the session on November 26, 2009.

[Annexes follow]

WIPO



SCT/22/8

ORIGINAL: English

DATE: November 26, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Twenty-Second Session
Geneva, November 23 to 26, 2009

SUMMARY BY THE CHAIR

approved by the Standing Committee

Agenda Item 1: Opening of the Session

1. Mr. Francis Gurry, Director General, opened the twenty-second session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) and welcomed the participants.
2. Mr. Ernesto Rubio, Assistant Director General, reported on the work done by the International Bureau in preparation for the twenty-second session of the SCT in connection with each of the topics proposed for discussion.
3. Mr. Marcus Höpferger (WIPO) acted as Secretary to the SCT.

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Agenda Item 2: Adoption of the Agenda

4. The SCT adopted the Draft Agenda (document SCT/22/1 Prov.) without modifications.

Agenda Item 3: Adoption of the Draft Report of the Twenty-First Session

5. The SCT adopted the Report of the Twenty-First Session based on document SCT/21/8 Prov., with modifications as requested by the Delegations of Canada, Jamaica, Spain, Sweden, the United States of America, Uruguay and by the Representative of CEIPI.

Agenda Item 4: Industrial Designs

Possible Areas of Convergence in Industrial Design Law and Practice

6. Discussion was based on document SCT/22/6.
7. The SCT considered document SCT/22/6 in detail. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-second session of the SCT. The Secretariat was requested to provide a revised working document on possible areas for convergence on industrial design law and practice in SCT Members, to be considered by the SCT at its twenty-third session, highlighting the potential benefits that users and industrial design administrations could derive from convergence among Member States in industrial design law and practice. This document should take into account the proposals made at the twenty-second session and include comments made by delegations and observer representatives during that session. It should set out already identified possible areas of convergence, as well as indicate tendencies in the law and practice of SCT Members and areas where no concrete convergence could be established at this time.

Digital Access Service for Priority Documents

8. Discussion was based on document SCT/22/7.
9. The Chair concluded that the SCT had taken note of document SCT/22/7 and had requested the Secretariat to advance work on the establishment of a Digital Access Service for Priority Documents for industrial designs and for trademarks, in a way that would ensure the largest possible participation of interested offices in such a service.

Agenda Item 5: Trademarks

Grounds for Refusal of all Types of Marks

10. Discussion was based on document SCT/22/2.
11. The SCT considered document SCT/22/2 in detail. The Chair concluded that the work of the SCT on grounds for refusal of all types of marks was of great interest for IP Offices of SCT Members. All comments by delegations would be recorded in the report of the twenty-second session of the SCT. The Secretariat was requested to revise document SCT/22/2, taking into consideration all comments made by delegations at the twenty-second session.

Furthermore, delegations will be given the opportunity to present comments in writing for inclusion into the revised working document. Such comments should reach the Secretariat by the end of January 2010. The revised working document should take the form of a SCT reference document on grounds for refusal of all types of marks. This reference document would be presented to the twenty-third session of the SCT for final review and should be published thereafter.

Technical and Procedural Aspects Relating to the Registration of Certification and Collective Marks

12. Discussion was based on document SCT/22/3.

13. The SCT considered document SCT/22/3 in detail. The Chair concluded that all comments by delegations would be recorded in the report of the twenty-second session of the SCT. The Secretariat was requested to prepare a revised working document on technical and procedural aspects relating to the registration of certification and collective marks, taking into consideration the comments made by delegations during the twenty-second session. Furthermore, delegations will be given the opportunity to present comments in writing for inclusion into the revised version of the working document. Such comments should reach the Secretariat by the end of January 2010. After reconsideration of the document by the twenty-third session of the SCT, the document will be published for reference purposes.

Article 6ter of the Paris Convention

14. The SCT considered document SCT/22/4. The Chair concluded that the Secretariat was requested to revise the draft questionnaire concerning the protection of official names of States against registration or use as trademarks contained in the Annex to document SCT/22/4, taking into account all comments made by delegations at the twenty-second session. Furthermore, the Secretariat will publish an intermediary version of the revised draft questionnaire on the SCT Electronic Forum for further comments. A revised version of the draft questionnaire, taking into account the comments from the twenty-second session as well as the comments on the intermediary version published on the SCT Electronic Forum will be presented to the twenty-third session of the SCT for adoption and subsequent circulation.

Replies to the Questionnaire on Letters of Consent

15. Discussion was based on document SCT/22/5 Prov.

16. The Chair concluded that the Secretariat was requested to finalize the Summary of replies contained in document SCT/22/5 Prov., in line with the comments made by delegations on specific answers contained in the table and on the comments section of the document, with a view to publishing the final version of this document for future reference.

Agenda Item 6: Geographical Indications

17. The Chair noted that there were no working documents or proposals for discussion at this meeting. The Chair concluded that this item will remain on the agenda for the next session of the SCT, at which moment delegations would have an opportunity to express their opinions whether they wished to pursue work under that agenda item on the basis of a specific working document.

Twenty-Third Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/23)

18. The Chair announced the week from April 19 to 23, 2010, as tentative dates for SCT/23 and the session of the Working Group for reviewing possible amendments to the Regulations under the Singapore Treaty on the Law of Trademarks, which will meet back-to-back with the twenty-third session of the SCT.

Agenda Item 7: Summary by the Chair

19. The SCT approved the Summary by the Chair as contained in the present document.

Agenda Item 8: Closing of the session

20. The Chair closed the session on November 26, 2009.

[Annex II follows]

ANNEX II

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

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(dans l'ordre alphabétique des noms français des États)
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Association communautaire du droit des marques (ECTA)/European Communities Trade Mark
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* Sur une décision du Comité permanent, les Communautés européennes ont obtenu le statut de membre sans droit de vote.

* Based on a decision of the Standing Committee, the European Communities were accorded member status without a right to vote.

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