



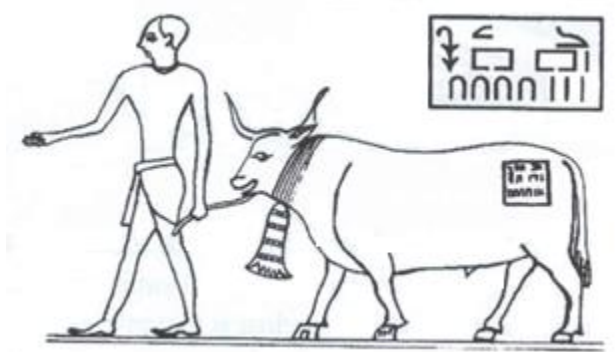
Trademark Law

WIPO-administered Treaties

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Sources of TM Law: the first marks

- used to mark goods
 - began as “**badges of origin**”
 - told customers who to return to if they wanted more / to complain
- Indication of **trade origin**: essential function



Sources of TM Law: the first marks

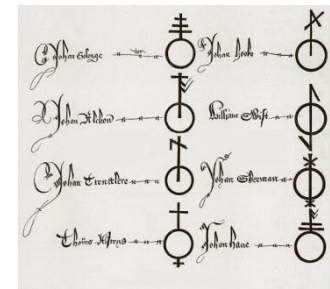
■ **India:** over 3,000 years ago



■ **China, Rome:** over 2,000 years ago



■ **Middle Ages:** cooper's Marks

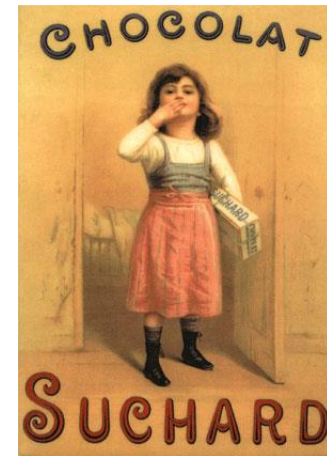
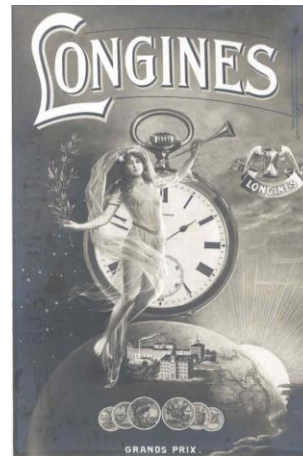


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Trademarks: growth

Industrial Revolution

- important role



- they became since a key factor in trade

Sources of TM Law: the first treaties

Paris Convention for the Protection of Industrial Property

- March 20, 1883
- Subsequently revised and amended
- 176 members



Paris Convention

Some important provisions

- National treatment
- Right of priority
- Territoriality principle
- Grounds of refusal for trademark registration
- Protection of well-known marks
- ...

Paris Convention

National Treatment

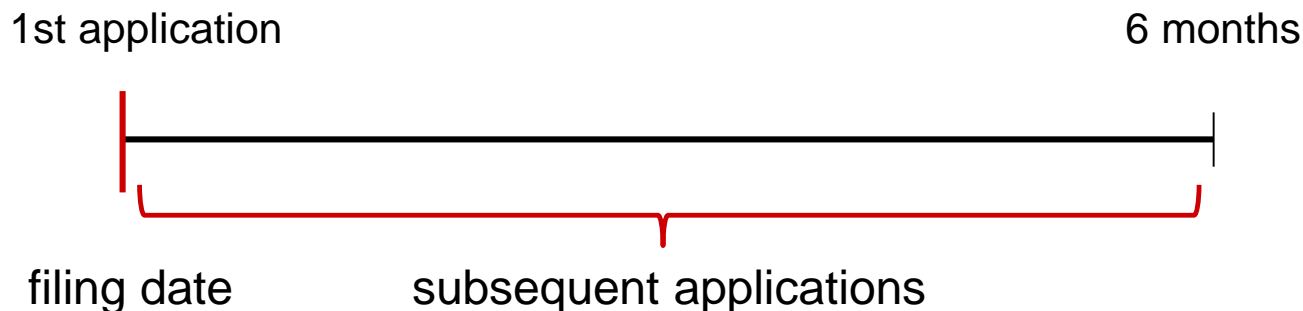
“Nationals of any country of the **Union** shall... enjoy in all the other countries of the Union the advantages that their respective laws now grant... to nationals...”

➤ **Advantages** = non-discrimination

Paris Convention

Priority right

- **first** application duly filed in one country of the Union
=> right of **priority** within **6 months**
- application for the **same object**
- subsequent applications keep the **same filing date**



Paris Convention

Principles

- Principle of **territoriality**:
 - Conditions for filing and registration determined by domestic legislation
 - Protection granted within a territory



Apple Computer,
USA



Apple Corps.,
UK

- Principle of **independence**: marks not affected by decisions in other countries

Specialty Principle

- Use in relation to **goods** and/or **services**
- application must contain a **list** of G/S, grouped in **classes** (International Classification of Goods and Services for the Purposes of Registration)



France (fruit juices)



Cuba (shows, restaurants)

Aptitude of a sign to become a TM

- Sign must be capable of **distinguishing**:
 - the goods/services
 - a particular commercial origin attributable to these G/S

- Distinctiveness may be inherent or **acquired through use**

Paris Convention

Absolute Grounds for Refusal

not distinctive

descriptive

**customary in
trade**

**contrary to
morality or public
order**

deceptive

Examples of refused marks

- Descriptive:

WODKA

- Customary in trade: **“TELEKOM”**

- Contrary to public policy or accepted principles of morality (depend on the country):

“DALAILAMA”, “URBI ET ORBI”

- Deceptive as to the origin or the characteristics of the goods if they do not correspond:

PATAYA

(goods are not from Thailand)

(not for coffee)

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Paris Convention

Relative Grounds for Refusal

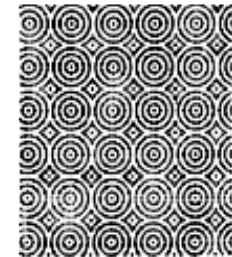
- When signs infringe **third parties rights** in the same country or area

Examples of conflicting third-party rights

- Prior marks



- Other industrial property rights



- Copyright



Well-known nickname



- Personality Rights

МЕДВЕДЕВ
MEDVEDEV

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Paris Convention



Well-known marks

- Protection against registration and use
- of an identical or similar mark
- liable to create confusion
- with an already “well-known” trademark
- belonging to another person
- for identical or similar goods

The Trademark Law Treaty and the Singapore Treaty on the Law of Trademarks

The Trademark Law Treaty

Background: TM registration formalities

- Variety of requirements in different countries
- Excessive complexity for filing in several countries
- Need for certainty

The TLT

Purpose: harmonization

- **Maximum** requirements for formalities
- Term of registration

Adoption

- Geneva, 1994 – in force on August 1, 1996
- 54 Members



The TLT

Objective

- Update the TLT
 - enhance the scope

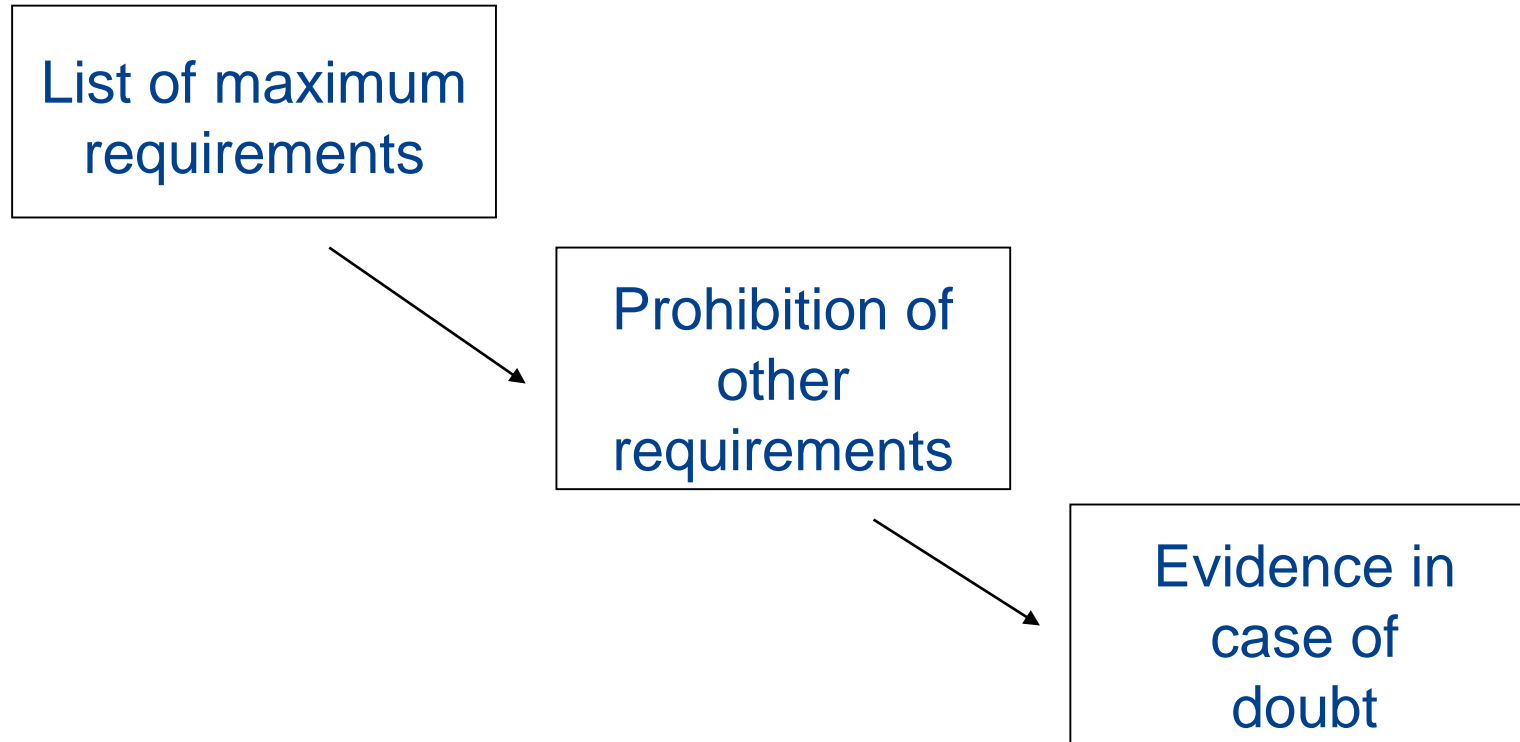


Adoption

- Singapore, 2006 – in force on March 16, 2009
- 45 Members

TLT and STLT

General structure of the provisions



The Trademark Law Treaty

Application of the Treaty to:

- Only **visible signs**
- 3D marks: only if contracting parties accept their registration
- Exclusion:
 - Holograms
 - Non-visible signs (sound, olfactory...)

The Singapore Treaty

Application of the Treaty to:

- Signs accepted under **national law**
- ⇒ Regulations: provisions on reproduction of non-traditional marks (if accepted in the contracting party)

Examples of non-traditional marks

Slogans

“Because you’re worth it”

“Just do it”

3-dimensional marks



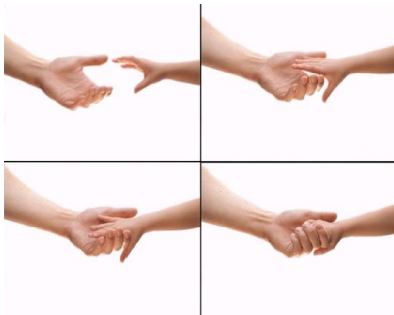
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Examples of non-traditional marks

Colors



Movement marks, position marks



Examples of non-traditional marks

Sounds – musical / not musical



Examples of non-traditional marks

Scent, taste marks



The TLT and STLT

Harmonization

- Definition of maximum requirements for
 - applications
 - requests for
 - changes of names or addresses
 - changes of ownership
 - corrections of mistakes
 - renewal
- Term of registration

The TLT and STLT

Simplification

- Filing date requirements
- Applications in several categories of goods and/or services in one single request
- Use of the International Classification for goods and services
- No legalization or certification of signatures
- Prohibition of requirements going beyond the texts of the treaties

The TLT and STLT

Prohibition of other requirements

- ❌ Certificate or extract from the register of commerce
- ❌ Indication that the applicant's activity corresponds to the goods and services applied for
- ❌ New reproduction of the mark on the occasion of renewal of protection
- ❌ ...

The Singapore Treaty



Relief measures in case of failure to comply with time limits

- Extension of the time limit
 - Continued processing
 - Reinstatement of rights
- At least one chosen by the contracting party

Other non-binding instruments

Joint Recommendations

- Adopted by the WIPO Assembly and the Paris Convention Assembly:
 - Well-known marks
 - Trademark licenses
 - Trademarks on the Internet
- More flexible, can be used as guidelines

WIPO work on trademarks



The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

- Established in 1998 – meets twice a year
- Member State body + observers
- Discussions on progressive development of international intellectual property law
- Submits recommendations to the WIPO General Assembly for approval

For further information

- Paris Convention:

<http://www.wipo.int/treaties/en/ip/paris/>

- TLT: <http://www.wipo.int/treaties/en/ip/tlt/>

- STLT:

<http://www.wipo.int/treaties/en/ip/singapore/>

- SCT: <http://www.wipo.int/policy/en/sct/>