

Sent: Thursday, February 03, 2005 4:38 PM  
To: Department of Foreign Affairs and Trade  
Subject: Submission Request - Australia-ASEAN-New Zealand Free Trade Agreement (FTA)

February 3, 2005

The Asia Trade Task Force  
Department of Foreign Affairs and Trade  
RG Casey Building  
John McEwen Crescent  
BARTON ACT 0221

Dear Sirs:

The International Trademark Association respectfully submits the attached Model Free Trade Agreement (FTA) in response to the December 3rd request on issues relevant to the potential Australia-ASEAN-New Zealand Free Trade Agreement (FTA).

The International Trademark Association (INTA) is a not-for-profit membership association of more than 4,600 trademark owners and professionals, from more than 180 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. Additionally, INTA has submitted comments on the trademark-related provisions of free trade agreements since 1996, with the commencement of the negotiations between the 34 nations of the Free Trade Area of the Americas.

INTA's Model FTA was created as a framework by which INTA can evaluate and comment on new bilateral or multilateral trade agreements. This document draws upon existing bilateral treaties, multilateral trademark and trade treaties, prior INTA policy statements and the expertise of INTA members. We hope this Model will assist you in the consideration of the Australia-ASEAN-New Zealand Free Trade Agreement, and welcome any opportunity to assist further in the negotiation of this Agreement.

If you have any questions, please contact Caren Fitzgerald at [cfitzgerald@inta.org](mailto:cfitzgerald@inta.org).

Sincerely,

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INTA -- Representing the Trademark Community since 1878.



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Submitted February 3, 2005

## **Model Free Trade Agreement Proposals**

### **Intellectual Property Rights: Trademark Law**

**International Trademark Association  
January 2005**

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### **Disclaimer**

This document is limited to issues relating to the treatment of trademark rights. No recommendation is made or intended with respect to other forms of intellectual property, such as industrial designs, copyrights and patents. Although certain proposals herein may reference texts that incorporate treatment of intellectual property rights other than trademark rights, INTA makes no recommendation with respect to other such references.

## **I Introduction**

The International Trademark Association (INTA) is a not-for-profit membership association of more than 4,500 trademark owners and professionals, from more than 180 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce.

In fulfillment of the Association's mission to foster effective trademark laws and policies worldwide and harmonize their implementation, INTA has assigned members to serve on committees designated to evaluate public policy and offer assistance to national and international officials in the practice of trademark protection and enforcement. Among these committees is the Treaty Analysis Committee, which has provided insight and comments related to the negotiation of the Intellectual Property sections of free trade agreements since 1996, beginning with the Free Trade Area of the Americas.

In order to have a minimum set of baseline proposals by which INTA can evaluate and comment on new bilateral or multilateral trade agreements, the Treaty Analysis Committee has developed the following *Model Free Trade Agreement proposals*. This project has drawn on existing bilateral treaties, multilateral trademark and trade treaties, prior INTA policy statements and legislation and the expertise of INTA committees.

Specifically, the following documents were reviewed, which have been incorporated as bases for the Model Free Trade Agreement Proposals:

- The Agreement on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods 1993 (TRIPs).
- Joint Resolution Concerning Provisions on the Protection of Well-Known Marks Endorsed by WIPO (1999).
- The Trademark Law Treaty of 1994 (TLT).
- World Customs Organization's "Model Provisions For National Legislation To Implement Fair And Effective Border Measures Consistent With The Agreement On Trade-Related Aspects Of Intellectual Property Rights" (May 19, 2004).

The INTA Model Free Trade Agreement Proposals will continue to be supplemented periodically to reflect new positions taken by INTA in furthering standards for the international protection of trademarks. In addition, INTA is prepared to provide detailed rationales and specific language for each recommendation upon request.

### **Proposal No. 1: General Provisions**

Parties to the FTA should ratify or accede to the following treaties and conventions, if they have not already done so:

- (a) The Trade-Related Aspects of Intellectual Property Agreement (TRIPS);
- (b) The Trademark Law Treaty (TLT) (1994); and
- (c) *The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* (1989).

The language of the FTA should provide for a specific date by which ratification or accession must occur, instead of a “best efforts” clause. INTA supports The Trademark Law Treaty and the Madrid Protocol because as globalization increases, it creates an imperative for harmonized international trademark laws and procedures, and greater uniformity of the law will reduce costs, expedite registration and help ease administrative burdens on trademark owners. INTA supports the Hague Convention because the convention would abolish legalization requirements contained in the TLT, which are unduly expensive and time consuming.

### **Proposal No. 2: Protectable Subject Matter**

The term “trademark” should be broadly defined. INTA supports the definition set out in Article 15.1 of TRIPs:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks.

In addition, INTA supports express provisions relating to the registration of the following:

1. Three-dimensional shapes that serve as trademarks (which include service marks, certification marks and/or collective marks), protection of which will enhance international marketing and product identification.
2. Sound marks. In the debate over sound marks, several issues have been raised, which INTA believes can be resolved. INTA can provide guidelines to issues such as the manner in which the mark needs to be used in association with goods or services, and in particular the principles of “connection” and “affixation,” articulation of the mark for registration, distinctiveness including functionality and consistency in use and assessment of confusion.

3. Single Colors. INTA supports the registrability of single colors under appropriate circumstances and notes that the arguments against registration of single colors, namely color depletion, functionality and shade confusion, are not persuasive. INTA can provide an analysis of such issues upon request.

### **Proposal No. 3: Exhaustion of Rights**

The parties to a bilateral FTA should agree to national exhaustion of intellectual property rights.

### **Proposal No. 4: Well-Known Marks**

#### *Well-Known Marks*

Each party to the FTA should protect well-known marks pursuant to Article 6bis of the Paris Convention for the protection of Industrial Property and Article 16.2 and 16.3 of the TRIPS agreement. Each party should also recognize the importance of the *Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks* (1999) endorsed by WIPO and be guided by the principles contained in this Recommendation.

### **Proposal 5: Term of Protection**

The initial registration, and each renewal of registration, of a trademark shall be for a term of no less than 10 years.

### **Proposal 6: Licensing and Assignment**

INTA supports the following:

1. Recordation of licenses should not be required and non-recordal of a license should not affect the validity of the registration of the mark that is the subject of the license, or the protection of that mark;
2. Licenses may be exclusive or non-exclusive;
3. Sublicensing should be permitted;
4. Use of a trademark with the holder's consent should inure to the benefit of the holder;

5. Failure to record an assignment should not result in loss of ownership rights in a trademark. If recordation is required under local law in order to enforce rights in a trademark, recordal before or after knowledge of an infringement should be permitted for purposes of enforcement of the assigned trademark(s) against infringers.

#### **Proposal 7: Domain Names on the Internet**

Each party should maintain provisions that:

1. Prohibit and provide sanctions against cybersquatting;
2. Clear remedies for trademark holders, including the availability of injunctive and other appropriate relief;
3. To the extent that they are recognized in relevant jurisdictions, protection of the public interest, including the legitimate uses of domain names that meet fair use/freedom of expression standards; and
4. Regarding each party's Network Information Centers (NICs), its affiliated organizations and the parties operating under contract with them should make available to the public complete lists of the domain names in a database format that is accessible through existing commercial or private computer search techniques.

#### **Proposal 8: Geographical Indications ("GIs")**

The principle of "first in time, first in right" priority should be applied when resolving conflicts between geographical indications and trademarks. Geographical Indications should not be permitted to preclude pre-existing trademark rights.

#### **Proposal 9: Counterfeiting**

Each party should adopt anticounterfeiting laws that go beyond the minimum requirements of TRIPS Part III to strengthen the protection of trademarks and enhance the legitimate trade between nations.

#### **Proposal 10: Special Requirements Related to Border Measures**

Further to TRIPS Part III, the FTA should incorporate explicit provisions to implement such requirements. The World Customs Organization (WCO) has created model legislation for

individual nations to use for guidance in implementing its own protection measures. INTA supports the inclusion in negotiations of the WCO model legislation.