

**STATEMENT BY ALAN C. DREWSSEN  
EXECUTIVE DIRECTOR, INTERNATIONAL TRADEMARK ASSOCIATION**

**SUBMITTED FOR THE RECORD FOR THE SENATE FOREIGN RELATIONS  
COMMITTEE HEARING (JULY 17, 2007) ON THE SINGAPORE TREATY ON  
THE LAW OF TRADEMARKS**

Mr. Chairman: The International Trademark Association (INTA) appreciates this opportunity to express its views on the Singapore Treaty on the Law of Trademarks which replaces the Trademark Law Treaty of 1994 to which the United States is a signatory. On behalf of our members, we respectfully ask the Committee to give this revision of the World Intellectual Property Organization Trademark Law Treaty of 1994 its favorable consideration.

The International Trademark Association is a not-for-profit membership association of more than 5,000 trademark owners and professionals dedicated to the support and advancement of trademarks and related intellectual property (“IP”) as elements of fair and effective national and international commerce. INTA works closely with government and judicial authorities around the world to promote the development and application of trademark law.

The Singapore Treaty is the product of worldwide growth in e-commerce and provides consistent rules for electronic filing of trademark applications, as well as further simplification and streamlining of administrative procedures. The modernization of the 1994 treaty reflects developments in technology and trademark practice.

INTA wishes to draw the Committee’s attention to the following key changes all of which constitute improvement over the 1994 treaty:

*1. Creation of an Assembly:*

An assembly of Contracting Parties has been created with the power to deal with matters concerning the development of the treaty. This consists of amending the treaty regulations, including the Model International Forms and performing other functions as appropriate to implement the provisions of the treaty.

*2. Trademark License Recordal Provisions:*

Provisions relating to trademark license recordal establish maximum requirements for the requests for recordal, amendment or cancellation. Importantly, non-recordal of a license shall not affect the validity of the registration of the mark which is the subject of the license or the protection of that mark. Recordal of a license may not be required as a condition for the use of a mark by a licensee to be deemed to constitute use by the holder in proceedings relating to the acquisition, maintenance and enforcement of marks. Recordal of a license may also not be required as a condition for a licensee to join infringement proceedings initiated by the holder or to obtain infringement damages

through such proceedings, although any state or intergovernmental organization may still declare through a reservation that it requires license recordal as a condition in this regard.

These provisions will simplify and reduce costs in many countries where the formalities of the recordal process are obstacles to cost-effective trademark protection. On the other hand, the treaty addresses the situation where failure to record licenses poses unacceptable risk for US trademark owners.

### *3. Relief Measures when Time Limits are Missed:*

Three possible types of relief measures are provided in cases in which a time limit has been missed for an action in a procedure relating to an application or registration. These include: (i) extension of the time limit; (ii) continued processing; and (iii) reinstatement of rights if the trademark office finds that the failure to meet the time limit occurred despite due care taken, or if the failure was unintentional.

### *4. Electronic Communications:*

In response to the increasing automation and adoption of electronic filing systems by trademark offices since 1994, the Singapore Treaty allows Contracting Parties to choose the means of transmittal of communications and to determine if they will accept paper, electronic, or other forms of communications. This is an especially important matter for the US Patent and Trademark Office (PTO), which has expanded its automation capacity during the filing process.

### *5. Expanded Scope of Marks Covered:*

The Singapore Treaty may be generally applied to all signs registrable under the national law of any Contracting Party, including non-visible signs such as sounds and smells, in addition to nontraditional marks such as three-dimensional marks and holograms.

### *6. Supplementary Resolution to the Singapore Treaty*

In addition to the main text and regulations to the Singapore Treaty, the diplomatic conference also adopted a supplementary resolution that states that Contracting Parties are not obliged to register the “new types of marks” mentioned in the regulations to the treaty, or implement electronic filing or other automated systems.

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Mr. Chairman, ratification of the Singapore Treaty will improve the ability of US trademark owners to protect their intellectual property throughout the world. Upon entry into force, this will simplify formal procedures and reduce associated costs for trademark applicants and governments. We urge the committee to report the Singapore Treaty favorably.