



## Singapore Treaty on the Law of Trademarks

**November 8, 2006**

**Sponsoring Committee:** Treaty Analysis Committee

### **Resolution**

**WHEREAS**, the International Trademark Association has supported the adoption of and adherence to the Trademark Law Treaty of 1994;

**WHEREAS**, a revised and updated Trademark Law Treaty, known as the Singapore Treaty on the Law of Trademarks, was adopted by a diplomatic conference of World Intellectual Property Organization member states on March 27, 2006;

**WHEREAS**, the Singapore Treaty on the Law of Trademarks expands on the Trademark Law Treaty of 1994 by further harmonizing the administrative procedures of trademark offices in line with developments in technology and trademark practice;

**BE IT RESOLVED**, that the International Trademark Association endorses the adherence to the Singapore Treaty on the Law of Trademarks.

### **Background**

On October 27, 1994, the Trademark Law Treaty (TLT 1994) was adopted by World Intellectual Property Organization (WIPO) member states as part of an international effort to harmonize the administrative procedures of trademark offices worldwide. INTA, as a non-governmental observer to WIPO, was an active participant in this effort and on March 7, 1994 passed a Board Resolution supporting the adoption of the TLT 1994.

As of April 15, 2006, 34 WIPO member states have joined the TLT 1994. However, over the years, the rise in electronic filing and other technological advancements, changes in the scope of trademark protection, and the resolution of voting rights of intergovernmental organizations in WIPO treaties led to the need to update the TLT 1994 in response to these developments.

WIPO's aim in this regard was to make several technical and substantive changes to the treaty, while retaining the key provisions such as use of the Nice System for International classification,

requirements to provide for multi-class applications and registrations, and restrictions on notarization, legalization and other certification requirements. After three years of negotiations at the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), in which INTA participated regularly as an observer, a revised treaty – the Singapore Treaty on the Law of Trademarks (Singapore Treaty”) – was adopted on March 27, 2006 by a diplomatic conference of WIPO member states in Singapore.

For the Singapore Treaty to take effect, ratification or accession by 10 member states and intergovernmental organizations is required. As of September 26, 2006, 45 countries have signed the Singapore Treaty. The Singapore Treaty does not replace the TLT 1994, but INTA would encourage states and intergovernmental organizations – including current members of the TLT 1994 – to accede to the Singapore Treaty and abide by its standards.

### **Key Changes from the TLT 1994**

The Singapore Treaty contains the following key changes from the TLT 1994:

#### **1. Creation of an Assembly**

An Assembly of Contracting Parties (i.e. states and intergovernmental organizations that have joined the treaty) has been created with the power to deal with matters concerning the development of the treaty; amend the treaty regulations, including the Model International Forms; and perform other functions as appropriate to implement the provisions of the treaty. The main treaty can be revised or amended only through a diplomatic conference.

The TLT 1994 did not include an Assembly due to a lack of consensus at that time over the voting rights of intergovernmental organizations. The voting rights issue was subsequently resolved in other WIPO-administered treaties, thus setting the stage for the TLT to have an Assembly, like other WIPO treaties.

#### **2. Trademark License Recordal Provisions**

Provisions relating to trademark license recordal, based on the 2000 WIPO Joint Recommendation on Trademark Licenses, establish maximum requirements for the requests for recordal, amendment or cancellation of the recordal of a license. 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.

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

Three possible types of relief measures are provided for cases in which a time limit has been

missed for an action in a procedure relating to an application or registration. These are: (i) extension of the time limit; (ii) continued processing; and (iii) reinstatement of rights if the trademark office found that the failure to meet the time limit occurred despite due care taken, or if the failure was unintentional.

Applicants, holders and interested persons may be required to file requests for time limit extensions and continued processing within a time limit of no less than two months from the date of expiry of the time limit concerned. Requests for reinstatement of rights shall be filed within a “reasonable time limit”, which may be set at a maximum of no less than six months from the date of expiry of the time limit concerned.

#### **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 accept paper, electronic, or other forms of communications. There are also provisions governing the procedures for electronic communications, including paper communications transmitted electronically. As is stated in the TLT 1994, no attestation, notarization, authentication, legalization or other certification of signatures may be required, except in cases where the signature concerns the surrender of a registration. Contracting Parties are nevertheless free to determine if and how they wish to authenticate electronic communications.

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

The TLT 1994 covers only visible signs, but non-visible signs such as sounds and smells, in addition to nontraditional marks such as three-dimensional marks and holograms, are increasingly being protected in jurisdictions around the world. In keeping with this trend, the Singapore Treaty may be generally applied to all signs registrable under the national law of any Contracting Party. Specific application requirements are laid out in the treaty for three-dimensional marks, non-visible signs and “new types of marks” such as hologram marks, motion marks, color marks and position marks.

#### **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. The resolution also endorses the provision of technical assistance to developing countries, primarily the least developed countries (LDCs), so as to enable them to fully benefit from the treaty. INTA Committee Deliberations Based on INTA’s prior participation in the WIPO SCT meetings on the revision of the Trademark Law Treaty and in the diplomatic conference to adopt the revised treaty, as well as a comparative analysis of the Singapore Treaty against the TLT 1994, the Treaty Analysis Committee respectfully requests that the INTA Board of Directors approve this resolution. Upon Board approval, it is the intention of the Treaty Analysis Committee that the relevant INTA committees,

working with staff, will use this Resolution as a basis to encourage WIPO members to accede to or ratify the Singapore Treat