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INTRODUCTION TO TRADEMARKS
AND GEOGRAPHICAL INDICATIONS

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FOREWORD

The book “Introduction to Trademarks and Geographical Indications”, by the authors: Dr. Yves Reboul, Dr. Mirjana Polenak Akimovska and Dr. Goce Naumovski is published within the project titled “Regional Joint Degree Master of Intellectual Property Law ” financed by the European Commission through the Tempus program.

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This edition is actually an introductory textbook for the compulsory course on Trademarks and Geographical Indications, delivered at the master studies. The textbook is aimed at students who wish to acquire appropriate knowledge in one of the most interesting components of intellectual property.

Trademarks and Geographical Indications, as phenomena that one faces in everyday life, are of a core significance to a variety of individuals: consumers, legal practitioners, scientists, general audience. All of them are capable and eager to grasp more information on trademarks and geographical indications, due to their popularity, functions and significance.

The book is an attempt to outline the following typical issues of primary importance for trademarks and geographical indications: definitions and sources; registration, specific types; protection; infringement as well as certain recent developments. The book also contains an annex with some of the international treaties and conventions from the field, that would be useful for the readers.
The authors wish to thank the project consortium members and the referees for the suggestions during the preparation of the book. The authors also welcome the comments of the scientific, professional and general public concerning the approach of the book.

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I. INDIVIDUAL, COLLECTIVE AND CERTIFICATION TRADEMARK

1. Introduction

The trademark (marque) is one of the rights to industrial property and is part of the distinctive signs (signes distinctifs). The trademark (a registered goods or service mark) is a sign in the business traffic, intended for making a distinction of goods or services of the same or similar kind, while its protection is in accordance with the law.¹

Since ancient times, the mark is the most significant distinctive sign.² The cradle of the modern law regarding the mark is in France, especially with the first law that is exclusively devoted to the mark – the Manufacture and Goods Mark Act from 1857. The contemporary mark as part of the industrial property, which is an important segment of the intellectual property, has a very significant place in modern law, mainly because of the development of trade and industry.

Both in the twentieth century and today, publicity plays a big role in bringing the marks closer to the consumers, for example through the media and especially on the packaging or in promotional material. However, the development of the global market, accompanied by the transformation of trading methods of doing business, as well as the marketing where the marks plays an exceptionally important role, also reinforce the legal and economic meaning of the trademark in the Republic of Macedonia and all over the world.

² The beginnings of the industrial property first appeared in the field of marking the goods. In ancient times the goods were marked with drawings, pictures and names of authors. However, these signs did not have the function of the today’s protected mark, but rather served as a guarantee that the product was made by a certain handyman (H. Gaumont- Prat, Droit de la propriete industrielle, Lexis Nexsis, Lîtee, 131). Historically, the Venetian Statute from 1474 indicates the birth of ownership of non-material goods, while in the middle ages the use of the mark when the corporations had their own marks in order to guarantee the product quality.
2. The Concept of the Trademark

This is an intellectual good, which does not occur as a result of individual spiritual activities of an individual or a group, but rather a fruit or function of the business of a natural or legal person. Therefore, some theoreticians call the mark a “pseudo creation”. Its essence rests in the bond between the mark and what it signifies, and it is present in the consciousness of the participants in the traffic (С. Марковиќ, Право интелектуалне својине, 30, 2000)

The concept of trademark has several meanings. First, the trademark represents a sign which is used for marking goods and services. Second, the trademark is used for indicating a legal institute regulated by the legal norms of a certain legal order. Third, the trademark indicates the subjective right originating from the legal relationship that has occurred with the use of the trademark in the commodity and monetary exchange.

From legal standpoint, marks are one of the most sensitive rights to industrial property. In practice they are the most problematic ones and a significant number of court cases are initiated because of them.

3. Types of Trademarks According to the Holder

The basic theoretical formulations of the classification of trademarks, which has the trademark holder as a criterion, is analog to the classification of certain legal institutes in the cases when there is a “pluralism of the subjects”. Such is the case with the ownership and the collective ownership in the real law or the debentures with complex parties in debenture law.

In the field of intellectual property, we may find the following things interesting in this regard: co-authorship, but also the collective attainment of copyright and related rights, as well as co-inventing, collective and certification mark in the right to industrial property.

3.1. Individual Mark

The individual mark represents a mark in a narrower sense of the word, and it entails the “classical case” of a mark whose holder is a legal entity. Hence, the collective and certification mark are specific forms of the mark, i.e. marks for which the basic rules for individual mark apply, with certain specificities.
3.2. Collective Mark

According to the World Intellectual Property Organization (WIPO), the collective marks are usually defined as signs which distinguish the geographical origin, material, mode of manufacture or other common characteristics of goods or services of different enterprises using the collective mark. The owner may be either an association of which those enterprises are members or any other entity, including a public institution or a cooperative.3

In comparative law, several terms may be found for the collective mark: Association mark (The Paris Convention, Article 7 bis, Great Britain, Ireland); collective mark (EU); zajednički žig (Croatia); la marque collective (France); das Kollektivezeichen, die Kollektivmarke (Germany); коллективный знак (Russia) etc.

Unlike the individual mark which protects the rights of only one person, the collective mark protects the rights of more (mostly legal) persons, who have regulated the said right with the general act for the collective mark. Moreover, the members of the entity (association or similar) are obligated to use the collective mark only for designating goods or services which correspond to specified technical and other characteristics. As for the registration procedure, in most legislations, the application for the collective mar has to be accompanied by a copy of the rules determining the use of the collective mark.

Depending upon the organizational form of the collective mark owner, or the combination of the legal (or legal and natural) persons who have joined economically, organizationally or legally, in order to achieve a certain goal, the collective marks may appear in form of: collective marks of the concerns (Austrian, German and Italian SIEMENS); collective marks of the holding enterprises4, or associations that do not have their own trading or production plants, but may denounce (marks and give them to its members to use, provided that they sell or produce goods).5

There is also a different classification of the collective marks in theory, depending on the purpose for which the collectivity members use the mark. According to this criterion, collective marks may be:

- marks that are used by the collectivity in order to identify and differ goods or services from the members of the collectivity; and

4 М. Поленак-Акимовска, Ј. Дабовик- Анастасовска, В. Пепељугоски, В. Бучковски, Право на индустриска сопственост-Практикум, Ми-Ан, Скопје, 2005 година, стр. 315.
5 Ćizmić, Zlatović, Komentar zakona o žigu, 341 (Цитирано според М. Поленак-Акимовска, Ј. Дабовик- Анастасовска, В. Пепељугоски, В. Бучковски, Право на индустриска сопственост-Практикум, Ми-Ан, Скопје, 2005 година, стр. 315)
3.3. Certification Mark

Certification marks are usually given for compliance with defined standards, but are not confined to any membership. They may be used by anyone who can certify that the products involved meet certain established standards (for example, certification marks include WOOLMARK, which certifies that the goods on which it is used are made of 100% wool). The main difference between collective marks and certification marks is that the former may only be used by a specific group of enterprises, for example members of an association, while certification marks may be used by anybody who complies with the standards defined by the owner of the certification mark. The certification mark is also a collective mark, but the collective mark does not need to have a character of a certification mark, meaning that the latter is more open for access.

Among other examples for standards guaranteed by the certification mark are: ISO (standards of the International Standardization Organization), (norms of the national standardization), CEN – European Committee for Standardization, etc.

It is interesting that in comparative law there are cases when the administration of the certification marks is not done by state bodies, but by private organizations. This is the case with Germany, where this activity is under the competence of the so called RAL (RAL Deutsches Institut für Gütesicherung und Kennzeichnung e. V.), or the German Institute for Quality Assurance and Certification.  

4. Sources (comparative and Macedonian legislation)

The legal regime of the mark in all legal systems in the world and in the Republic of Macedonia is regulated by domestic, international and general legislation.

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8 Ibidem.
9 www.ral.de.
10 B. Schmidt, The Collective Trademark, (Presentation by Beate Schmidt, Head of Trademark Department, German Patent and Trademark Office, Munich).
sources. The Industrial Property Law (hereinafter: IPL) of the Republic of Macedonia from 2002/2004, together with the other reference legal literature, such as the Law on General Administrative Procedure, Law on Unfair Competition, Law on Consumers’ Protection and others represent the domestic legal framework of the trademark. There are numerous international sources that relate to the trademark, some are general and some are specific for the right to a mark. The Paris Convention for the Protection of Industrial Property from 1883 and the accession to the TRIPS Agreement in 1994 within the Uruguay Round of negotiations on the General Agreement on Tariffs and Trade – GATT, are multilateral conventions with general meaning. A distinctive source is the Nichan Agreement on International Classification of Goods and Services for Trade Mark Registration from 1957, as well as the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks.

The system of international registration of trademarks is organized by the Madrid Agreement Concerning the International Registration of Marks from 1891 and the Protocol Relating to the Madrid Agreement. General sources are considered a certain number of regulations which goal is to harmonize the European legislation of marks by adapting a standard, in order to create European Community mark. Based on the unique Trade mark Law of the European Union, rules have been established and the Office for Harmonization in the Internal Market, located in Alicante, Spain.

In this regard, it is significant to mention the Trade Mark Regulation of the European Union (1993), Articles 64 and 73, according to which “the Community trademark may be acquired for goods or services, as well as an individual or collective mark”.

The Directive 89/104 is also relevant, which provides for the EU Member States that they do not need to prescribe registration of certification or collective marks, but if they do so, they have to abide by the registration rules, especially the special conditions for the collective and certification mark.

5. Functions

The mark, as an industrial property right, is assigned many functions: distinctive function, competitive and guarantee function of the mark. The IPL of the Republic of Macedonia acknowledges also the advertising, but also the competitive function of the mark, because it has been standardized that the mark may be used to protect the packaging means, catalogues and other that usually serves for propaganda and marketing purposes.11

The competitive function of the mark is also comprised of the reinforcement of the consumer’s freedom of choice and it represents a significant economic and social category.\textsuperscript{12}

As for the \textit{specific functions of the collective mark} within the frames of WIPO, especially in the sphere of the affirmation activities for the meaning of the intellectual property for the business, the following functions are pointed out:\textsuperscript{13}

- compliance with certain standards (usually fixed in the regulations concerning the use of the collective mark) by its members;
- informing the public about certain particular features of the product for which the collective mark is used;
- promotion of products which are characteristic of a given region. The collective mark has not only helped to market such products domestically and occasionally internationally, but has also provided a framework for cooperation between local producers;
- development of certain standards and criteria and a common strategy. In this sense, collective marks may become powerful tools for local development;
- link to the historical, cultural, social conditions of the area through marketing of the said products, thus benefiting all producers;
- Associations of SMEs may, therefore, register collective marks in order to jointly market the products of a group of SMEs and enhance product recognition. Collective marks may be used together with the individual trademark of the producer of a given good. This allows companies to differentiate their own products from those of competitors, while at the same time benefiting from the confidence of the consumers in products or services offered under the collective mark;
- Collective may therefore represent useful instruments for SMEs assisting them to overcome some of the challenges associated with small size and isolation in the market place.

In practice, the most common cases of collective marks may be found in production. Such is the case with several producers associated for the purposes of a joint approach to the market with a collective brand Melinda-Val di Non from South Tyrol, Italy, which members are 16 cooperatives and over 5,000 farmers. They increased the production in a very short time, due to the advantages of the collective mark, i.e. today they represent 60\% of the regional apple production and cover 5\% of the European apple market.\textsuperscript{14}

\textsuperscript{13} http://www.wipo.int/sme/en/ip_business/collective_marks/collective_marks.htm (01.05.2006)
\textsuperscript{14} http://www.wipo.int/sme/en/case_studies/melinda.htm
A well-known example of a collective mark is INTERFLORA, which is used worldwide by a flower ordering service.\textsuperscript{15}

\textit{The functions of the certification mark} arise from its nature to guarantee certain products. It especially comes to attention when certification marks are used together with the individual trademark of the producer of a given good. The label used as a certification mark will be evidence that the company's products meet the specific standards required for the use of the certification mark.\textsuperscript{16}

Among the typical examples of successful certification marks are: MAX HAVELAAR, which is owned by the Max Havelaar Foundation. The Max Havelaar Foundation does not sell products itself. Each producer or importer of coffee, chocolate, tea, honey, bananas or oranges can be considered as a potential license holder. They have to comply with certain conditions of trade and be prepared to submit themselves to control.\textsuperscript{17} The situation is similar with the TOOTH FRIENDLY ACTION mark, which appears on the packaging of foodstuffs certifies that its ingredients do not produce cavities and thus are not bad for the teeth.\textsuperscript{18}

6. Subject to Protection

According to the Macedonian IPL, the trademark represents a sign which may be shown graphically and which is adequate for distinguishing the goods and services of one participant on the market from another. Those are the important elements of the definition of a trademark. Depending upon the purpose it serves, it can be a product or a service mark. Marque de produits, trademark, is a product mark. The Paris Convention for the Protection of Industrial Property (the Lisbon text from 1958) only protected the product mark. The protection of the service marks (marque de service) has a newer date. However, there are a large number of services that the consumers need to distinguish, both nationally and internationally, which is why the Macedonian legislation has standardized the product and service marks.

The product mark is a sign used in the commercial exchange in order to differentiate the goods of one subject from the same or similar types of goods of another subject. The said mark is protected in accordance with the legislative provisions. The product mark is a protected product sign that may be expressed

\textsuperscript{16} http://www.wipo.int/sme/en/ip_business/collective_marks/certification_marks.htm (01.05.2006)
\textsuperscript{17} The Value of Collective and Certification Marks for Small Players, WIPO Magazine, July/September 2002, p.6.
\textsuperscript{18} Ibidem.
verbally, figuratively or combined. This refers to one or more products, it is put on the goods, on the packaging and it thus marks the goods in relation to another of the same or similar kind. It should be noted, however, that the product mark is tied to bodily things.

A service mark is a sign used by a service providing company on the market, in order to make a distinction of its services from those of another company. The mark is protected in accordance with the law.

The IPL has standardized the signs that may be protected as marks (words, letters, numbers, pictures, drawings, combinations of colors, three dimensional forms …). Following the comparative practice and legislation, the Macedonian law also protects the three dimensional marks (marque plastique). An example of the three dimensional mark is the form of the Coca Cola bottle.

The recent laws on industrial property allow for protection of not only the three dimensional marks, but also of the acoustic mark, like in the Bulgarian law, as well as the acoustic and illuminant mark in the Hungarian law. The most recent legislation allows also for protection of the aromatic marks.

The exemplificative intonation of IPL provides a possibility for each sign that is not contrary to the legal norms to be protected with a mark, whereas it has been specifically prescribed that the tridimensional forms may be protected as marks, but also the packaging. The signs listed in IPL are not final, as the term “sign” is comprehended in its broadest sense. In many legal systems, one of which is ours as well, there is a limitation of the possibility to protect signs, whereas only the signs that can be represented graphically may be protected, mostly due to practical reasons – publication of the trademark in the official journal of the administration competent for the protection of industrial property. In the Republic of Macedonia, that is the State Office of Industrial Property (SOIP).

The TRIPS Agreement defines the minimum standards each World Trade Organization (WTO) member should provide, whereas the protectable subject matter of trademarks has been defined in Article 15, item 1, according to which: “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. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”

The IPL provides that words and letters may be written in any language and in any alphabet. Their transcriptions and transliterations are protected. The protection concerning translations of trademarks has been regulated in Article 6
Words (marque verbale), are the most common types of marks. Words from the live or classical languages, imaginary words and words from their combination may be protected. Words are individualized in a way they were written, visually and phonetically. The mark in words and letters has the broadest type of protection. The words may represent personal names, nicknames, made up names, real or imaginary signatures, combination of words, one word, as well as a slogan. The names of the trading companies and undertakings, provided that they fulfill the other protection and registration conditions, are considered as trademarks, and they are useful as source indicators, i.e. they indicate the origin of the goods or services. It has been accepted in comparative law that every day words may also be protected as trademarks, provided that they do not directly describe the goods they mark. Figurative marks (marque figurative) are all those signs that are not verbal.

IPL makes a clear distinction between the individual mark on one hand, but also the collective mark (which protects a sign intended for joint marking of products and services by an association or another group of legal or natural persons) and the certification mark (which protects a sign used by several trading companies under the supervision of the certification mark owner, and serves to protect the quality, origin, production method and other joint characteristics of the goods and services of the said companies).

7. Protection Conditions

There are two groups of conditions for protection of a sign with a trademark. The first group is consisted of the distinction of the sign and the possibility for its graphical representation.

IPL (and comparative law) separately define the distinctiveness of the signs as a condition for protection of a mark. This is contained in Article 6 quinquies b2 of the Paris Convention for the Protection of Industrial Property. The distinctiveness of the signs is the basic issue on which the protection of a trademark depends. A distinctive sign is the one which is convenient for making a difference among goods or services on the market, whereas special attention is paid for the sign to be new. The assessment of whether the sign is new or not is done in relation to the already protected marks of other entities for same or similar types of goods or services, i.e. an estimation is made whether the sign seeking protection is the same with a previously protected sign or with a sign of a previously filed trademark application. A sign may not be protected as a mark if it is similar to a previously protected sign of another entity for the same or similar type of goods or services. It should be noted that by using, the sign
becomes familiar or well known and may even become generic and the said sign may become distinctive or “diluted”. If a mark is not in use, it may make it non-distinctive and even lead to termination of the right to a mark. IPL, contains provisions for “acquired distinctiveness of the mark”, which has been taken from the Paris Convention for the Protection of Industrial Property (Article 6 quinquies C 1).

The determination of the distinctiveness of a sign is a difficult question and represents a problem during the assessment of whether the sign is adequate for distinguishing, since there are no exact measures for determining the degree of distinctiveness. The usage is always linked to certain goods and services and it is why the distinctiveness is assessed in relation to the goods and services indicated by the sign. A sign may be non-distinctive for marking certain goods, but on the other hand highly distinctive for marking other goods (Apple – for marking apple juice in the first case and computers in the second case). The degree of distinctiveness of the sign does not have a unique character; the made up signs, words or figurative elements have a high distinctive character, while the words used in the everyday speech have a low degree of distinctiveness. The generic signs only indicate the type of product or service and every subject producing or releasing such goods or services is interested in marking the said products with a generic sign, which is why these products should not be monopolized on the market (for ex. “furniture” or “liquor”).

Also, the sign should not be descriptive, as it can not be distinctive. An example for a descriptive sign would be the one indicating the attributes of the product or its quality, or any other characteristic of the goods.

The second group of conditions involves the conditions referring to the potential harmful effects of the trademark, provided that it has a deceitful or confusing character or is contrary to the public order or morale. There are two types of impediments, absolute and relative, the existence of which leads to rejection to protect the sign with a trademark.

It should be noted that IPL provides for three conditions for a sign to be protected as a mark: distinctiveness of the sign, connection of the sign to certain types of goods or services and the usage of the sign on the market.

The absolute reasons for rejecting the registration of a sign are in function of the protection of the public interest and refer to all signs, regardless of the goods and services they indicate. The institution in charge of the absolute reasons for rejections is the State Office of Industrial Property, by official duty. These reasons are absolute because they do not depend on the comparison of the concrete sign to any other previously filed or registered trademark or with any other right. The absolute reasons for rejection are contained in IPL and are equal by meaning, but it seems that the graphical representation of the sign needs to be set aside. The practice of the countries who have the same formulation regarding the graphical representation shows that both sound and smell signs are protected, whereas the first are graphically represented by formulas and the second by
tones. It has not been strictly indicated in IPL that the sound sign may be protected as a mark, but it is not a matter of an argument that if it can be represented graphically and if it is distinctive, it may be protected as a mark. Commonly, it is represented graphically and then descriptively. An example much quoted from comparative law is that a sound mark consisting of the roar of a lion would be represented graphically by writing down “the roar of a lion”. It may, however, be a discussion issue whether the roar of a lion differs from the roar of a tiger. Graphical representation of smell marks is even more problematic. The only smell mark in the USA protected as a trademark is represented upon a verbal description of the smell. Perfume and wine producers have appropriate methods for describing the smells that could be applied on trademarks. The smells could be described in form of a diagram based on chromatography of gas or liquid with high performances, although the application of such diagrams is not easy, especially in the case of comparison and search through the trademark register. A method for graphical representation of smell marks should be identified, which would enable the ordinary public to understand and differentiate the mark both on the market and when searching the registers. (Michael A, A Practical Guide to Trademark Law, London 1996).

IPL provides that the following signs may not be protected as a trademark: which publication or use is contrary to the law or morale; which can not be graphically represented; which is not distinctive; which only indicated the type of goods or services, their purpose, geographical origin, quality, price, quantity and weight that is common for marking goods or services (generic mark); which is consisted exclusively of a form originating from the type of goods or a form of goods necessary for achieving a particular technical result or a form that gives an essential value to the goods; which may lead to confusion on the market with its appearance, and especially lead the average customer to delusion in terms of the geographical origin, type, quality or other features of the goods or services; which contains a state or other public coat of arms, flag or emblem, name or abbreviation of a state or international organization, as well as their imitation (except with a permission); which contains or imitates a face or name of a person (except with a permission); which contains a seal or a stamp, official marks; which contains religious symbols or their imitations.

IPL also stipulates the relative reasons for disapproving the protection of a sign with a trademark. These reasons essentially differ from the absolute reasons for rejection, since the case here are not the reasons which may be removed in accordance with some authorized person, but reasons which may or may not lead to registration of such sign (Cornish, W.R Intellectual Property third edition, Sweet & Maxwell, London, 1996, 583). If we compare the absolute and relative reasons for rejecting a registration, it may be concluded that the relative rejection reasons are in function of protecting the private interests, they only refer to some trademarks and the competent administration does not handle them by official duty, but based on intervention by persons who have legal interest in
it. This means that the sign, by itself, is not unsuitable for registration, but it is only examined and compared to previously filed or protected signs.

IPL provides that a sign may not be registered as a trademark if it is identical (the same) as a previously filed or registered trademark of another person for the same type of goods and services. This is the case when the case when the sign represents exact reproduction and refers to the same type of goods and services covered by a previously filed or registered trademark.

There is a theory that one business undertaking may not have two identical registered signs. The only exception is when one of them is protected as a domestic trademark and the other as an international one. In this regard, a comparison should be done with Article 4 bis of the Madrid Agreement.

During the assessment of the distinctiveness, special account should be taken of whether the sign is new and the relative novelty of the design is estimated, but not in its absolute sense as is the case with the innovations. The novelty of the filed sign is estimated in reference to the already protected trademarks of other entities for the same or similar type of goods or service on the territory of the Republic of Macedonia.

IPL operates with an identical sign, but also with the determination of a similar type of goods or services, whereas it should be noted that the determination of similarity is a factual issue. In this regard, a starting point should be the consumers’ interests and disloyal competition. This is why IPL introduces the standard “deluding the average customer when making an estimation of which sign is identical or similar to a previously filed or registered trademark of another person for the same or similar type of goods or service”. The standard “average consumer” means a consumer of particular goods or a user of a particular service with a normal attentiveness (Бесариовиќ В Интелектуална права, индустриска својина и ауторско право, Београд, 99). This means that according to IPL, similarity is estimated on basis of the reaction of an average consumer, while comparative law points out that account should be taken for a wider circle of people, or the entire public.

Pursuant to IPL from 1993, the above mentioned reason for rejection was absolute, i.e. the competent administration took care of it by official duty. A novelty in IPL from 2002 is that the above mentioned rejection reasons are contained within the relative reasons for rejecting a registration. By that, the competencies have been transferred from the previous right holders. It should be pointed out that this novelty is very important. The intention of our legislator is to get closer to the other trademark systems in Europe, according to which the competent administration has a more reduced role and where the conflict of interests regarding the trademark has been left to the owners of the previous trademark.

Under the influence of comparative law, and in regard to the estimation of the similarity, apart from the criteria of deluding the average consumer, our IPL also accepts the sub-criteria of the possibility of associating with a
previously filed or registered trademark. The norm of the First EU Council Directive has been adopted, Article 4 paragraph 1 (b), according to which a trade mark shall not be registered or, if registered, shall be liable to be declared invalid because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

According to IPL, the sign seeking protection is compared to a previously filed or registered trademark, as follows:
- with trademarks that have right to priority according to the law
- previously internationally registered trademarks acting in our country
- well-known trademarks.

The well-known (renowned) trademarks represent novelty in the Macedonian trademark law. They are exception to the principle of specialty of the trademark. In accordance with the principle of specialty, a mark may be registered for another type of products of another business undertaking. This should not be the case with the well-known trademarks, as it would lead to confusion on the market. Well-known trademarks have such a reputation on the market, that they are given bigger protection than the other marks. This is the case with the right of the large companies who are owners of well-known trademarks and who do not allow their trademark to get “diluted”.

According to IPL, a well-known mark is the one that is famous for the public in the relevant sector, as well as trademarks that are well-known as a result of presentations, advertising and marketing to the broad public.

The well-known marks have the broadest protection within the framework of the trademark legislation, which prohibits using other people’s marks for marking products of the same kind. Dispute rises when a well-known mark is used for products of a different kind, because a commonly adopted standpoint of the international court practice is that a well-known mark may be recognized also based upon its advertising function, as standardized in IPL. This additional protection shelters the well-know marks from “diluting”. In court practice, the attempts to use the well-known trademarks for marking products of another kind is known as ‘parasite competition’, abuse of the rights, unjustified enrichment and digression from the good business practices, and contrary to the regulations regarding unfair competition (J. Чизмиќ, Златовиќ, Коментар закона о жигу, 65).

It is commonly known that the economic value of the well-known marks is very big and it is why their owners undertake measures to protect them. Sometimes, the well-known marks get generic meaning after the long use and lose the meaning of a mark (for example, the formerly well-known marks Vaseline, thermos, gramophone). Nevertheless, famous marks are a special type
of strong marks and are characterized by their degree of distinctiveness, which is usually a result of their originality or advertising.

Historically speaking, the protection of the well-known marks originates from the so called ‘Kodak doctrine’ from 1898. In our legislation, the well-known marks were protected with the latest legislation for the first time, while before that protection was enabled based on the regulations regarding the disloyal competition.

Apart from the trademarks that are well-known to the public in one or more countries, there are famous or renowned trademarks (marque de haute renomme). These are marks that are famous throughout the world or on a larger territory (for example, MERCEDES, SONY, COCA COLA).

8. Material Rights

The contents of the right to a mark are property and legal authorizations of the trademark owner to use it on the market for indicating his goods or services. This is a monopoly right, as it gives him an exclusive right to use. The right to a mark means a right to use it on packaging, catalogues, promotional materials, print items and letterheads. This means that the registered trademark gives its owner an exclusive right to use on products and services, as well as a right to legal protection from everyone impeding the trademark owner by using a similar goods or service mark for marking the same or similar kind of products or services. All these rights come from the principle of specialty, according to which the mark owner has an exclusive right to use it for marking goods and services listed in the application (Baumah Hermehl, Warenzeichengesetz, 12, Munchen, 1958) and to forbid its use on the market by third parties without his consent. So, a sign may not be used if it is identical or similar to the sign that has already been protected, but this also includes a prohibition for protection of a sign that associates to a sign already protected. The material rights of the trademark owner also incorporate the doctrine on the protection of the well-known marks, only because the trademark owner has the right to prohibit use of a sign on the market by third parties without his consent, if the sign is identical or similar to the trademark for different products or services, provided that the trademark is famous in the Republic of Macedonia and the use of the pertinent sign is considered unfair competition or harms the distinctive character or reputation of the trademark.

The contents of the right to a mark has also negative authorizations, such as a prohibition to place the sign on the products and their packaging, prohibition to provide services or release products with the particular sigh on the market, the sign for correspondence, advertising and marketing.
The content of the right to a mark does not have any personal legal authorizations for the subject of the protection. The reason is that the right to a trademark is not an expression of emanation of the person who is a trademark owner (С. Марковиќ, Право интелектуалне својине, 2000, 31).

One of the novelty is the tolerance of trademark use. This is a parallel existence of an earlier and later trademark, a legal and factual co-existence of two identical or similar trademarks, registered in favor of two different proprietors, which represents an exception to the rule of an unique trademark owner. The reasons of this legal safety require that the earlier trademark proprietor is limited in his right, provided that he consciously put up with the abuse for five consecutive years, unless the later trademark was protected unconscientiously. The passive behaviour of the trademark proprietor who has suffered use of the trademark by the proprietor of the later mark is contrary to the principle of consciousness and honesty and the general provision venire contra factum proprium, and therefore provisions were introduced for sanctioning the harmful consequences for the inactive trademark proprietor (Werwirung, Estopel, from the German or Anglo-Saxon law, in contemporary law it has been contained in the European Right to Trademark, with the First Council Directive in 1988, Article 9 paragraph 1, which approximates the regulations of the Member States. (89-104 EEC)

A novelty is also the institution called exhaustion of right, which limits the exclusive right of the trademark proprietor. It was introduced in accordance with the TRIPS Agreement. According to this institution, the trademark proprietor has no right to prohibit use of the trademark for goods and services he placed on the market himself or were placed with his agreement, unless the condition of the goods is changed or impaired after they have been put on the market. This is a case of limited consent for putting products with a trademark on the market. This legal institution is based upon the doctrine of exhaustion of rights according to which it is sufficient for exhaustion of the right to place goods with a trademark on the market, both domestic and international. This means that a proprietor of a domestic trademark recognized in some country may not prohibit third parties to import in that country a product marked with the said trademark, which the person bought abroad from the trademark proprietor or a person authorized by him.

This institution is applied in the European legislation and the international business practice (Council Directive from 1989 – 89 – 04 EEC). The application of the provisions for exhausting of rights means that the trademark proprietor or another person with his permission may place goods on the market of the European Economic Area and it is considered that this does not harm the use of the trademark connected to the goods. The proprietor may not recall his right to trademark in order to prevent future circulation of the goods under the “umbrella” of the pertinent mark.
This doctrine only seems to be confusing (Ć. Марковић, Право интелектуалне својине, 2000).

9. Acquisition Procedure in the Macedonian legislation

A trademark is acquired in a strictly formal administrative procedure conducted in the State Office of Industrial Property (SOIP). The trademark application procedure begins by submitting an application to SOIP. It is basically a one-sided procedure and participants are the applicant and SOIP. In the appeals procedure, the one-sided procedure becomes multi-sided, as it involves stakeholders, such as the appellant. The application contains a request for acknowledging the trademark and other essential elements prescribed by IPL. A separate application is filed for each sign that needs to be protected.

The priority right appears as national and international priority right (union and convention priority right, which are minimum rights).

The priority right has double meaning. First, the applicant has a priority right from the day of submitting the application in reference to all other subsequent applicants with the same or similar contents (identical or similar sign, identical or similar products or services); and second, the fulfilment of the conditions for acknowledging a right are assessed from the moment the priority right is acquired.

The national priority right occurs on the day of submitting an application to SOIP. Exceptions are the union and convention priority.

The content of the application has been developed in a special form, as per IPL and the Rulebook on the Trademark. The following are important elements of the application: a petition for acknowledging a trademark, information on the applicant, the appearance of the sign for which protection is sought, divided by classes in accordance with the International Classification and the Nice Classification of goods and services. It should be pointed out that the sign needs to be of good quality and done in a clear manner; additional deleting, striking through, gluing or colouring is forbidden.

Next, the submission date is established, which is a novelty in IPL. A submission date is considered the day of receiving a complete application upon which the applicant acted, in accordance with the notification, in terms of the application content pursuant to IPL. If date may not be established on the trademark application, SOIP will call the applicant to remove the deficiencies found. On the contrary, the application will be rejected with a conclusion. The trademark application, which application date has been established in accordance with IPL, is entered in the trademark applications register.

The formal inspection of the application is done after its entry in the applications register. The inspection is in terms of whether the application
contains the formal legal requirements in accordance with IPL (for example, whether it contains all elements necessary for assessing the right for which protection is sought, whether the prescribed tax has been paid, whether evidence for the payment has been attached, whether there is a valid power of attorney in case the application was filed by a proxy). If needed, SOIP calls the applicant to formally correct the application within 60 days (with a possibility for extending the deadline for additional 60 days) or on the contrary, the application is rejected with a conclusion.

The second phase of recognizing the right to a trademark involves a material and substantive inspection of the application. The existence of these conditions is inspected from the day of submitting the application, as a day from which the priority right begins. In this phase of the procedure, SOIP examines the absolute rejection reasons and if some of the rejection reasons are found, SOIP rejects the application with a decision. If absolute rejection reasons do not exist, if the trademark application is in order and the publication fees have been paid, the application data is published in SOIP’s official journal – Glasnik. The application is then published on SOIP’s website.

A significant novelty is also the legal remedy – complaint. This makes the procedure for recognizing the trademark right more objective, simpler and faster. The complaint was accepted as a modern solution in almost all trademark right related European laws. The complaint enables faster and more efficient protection of the owner and his violated rights in a special complaint procedure, during the trademark registration procedure.

SOPI does not pay attention to the relative rejection reasons by official duty, but the actively identified persons may also act upon them within 90 days of the publication of the application.

The complaint is a legal protection means which is filed against a trademark indicated in the published trademark application. It is a suspending legal mean, as it postpones the recognition of the trademark registration. It is a two-sided legal means, because the complaint is submitted to the complainant and the applicant, but it is also an autonomous legal means, as it is decided upon independently from the other trademark protection means. The complaint submission deadline is within 90 days from publishing the application in the official journal of the Office. The deadline is preclusive. It may not be extended. A separate complaint is filed for each application. Parties in the complaint procedure are the complainant and the applicant.

IPL pays special attention to the complaint and especially the procedural presumptions that need to be fulfilled in order for the trademark application complaint to be taken into meritorious consideration. This will happen if the complaint is allowed, timely and complete. The complaint is allowed if filed by an eligible person – identification document for filing according to IPL. The complaint is timely if filed within the deadline period. The complaint is complete if one can establish for which published trademark
application it refers to, as well as other documentation. If the previously mentioned conditions are not met, if the complaint is not suitable for meritorious decision making upon his grounding, SOIP rejects it with a conclusion.

The complaint upon the published trademark application is a two-sided legal means. If all conditions are fulfilled (allowed, timely and complete), SOIP notifies the applicant of the reasons listed in the complaint and invites him to give an explanation within 60 days.

If the applicant does not submit an explanation of the reasons listed in the complaint, it is considered that he has no objections to the complaint, in which case SOIP decides upon the items in the complaint. What is the final SOIP decision? If SOIP determines that the complaint is unfounded, it shall reject it with a decision. If SOIP determines that the complaint is founded, it shall reject the trademark application, for which it submits a decision both to the applicant and the complainant.

Pursuant to IPL, the trademark right is based on registration and is acquired by bringing a decision for recognizing the right (after all expenses are paid) and by recording the trademark in the trademark register kept in SOIP. The date of recording the trademark in the trademark register is identical to date of the decision for recognizing the trademark. The trademark right is valid for 10 years from the day of submitting a complete application, with a right to unlimited extension.

The right to trademark terminates with the expiration of the validity; negation of the right; close-down of the owner if it is a legal person; death of a natural person who did not leave heirs; and publishing a decision for invalid.

Apart from these provisions regarding the collective and certification mark, IPL also prescribes some additional registration requirements.

In terms of the collective mark, IPL sets forth that the collective mark protects a sign intended for joint labelling of products or services by an organization or any other association of legal or natural persons.

IPL defines any domestic organization or another association of legal and natural persons as an entity eligible for submitting a collective mark application, as well as a foreign legal person, as per the conditions set forth in IPL.

The General Act or the Collective Mark Agreement is rather specific, which is submitted together with the application, and which needs to contain the following elements:

- company name or name of the applicant, and name of the body or person authorized to represent the applicant;
- provisions on the appearance of the sign and the products or services to which the sign refers; provision on who has the rights to use the collective mark and under which conditions;
- provision on the rights and duties of the collective mark users in case of violation of the trademark;
- provisions on the measures and consequences in case of a trademark violation;
- provisions on the measures and consequences in case of defying the provisions set forth in the General Act or Agreement.

IPL defines the certification mark as a mark that protects a sign used by several companies under the supervision of the owner of the certification mark and it serves for protecting the quality, origin, way of production, and other joint characteristics of the goods or services of those companies.

When filing a certification mark application, the rules for using the certification mark are also enclosed, which contain provisions on the following: quality, features and other characteristics of the goods or services, control measures which the applicant for a certification mark will use and the sanctions that will apply.

Pursuant to IPL, trademark protection in the Republic of Macedonia may be sought through the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. The protection is reversible, from the country to the Madrid Union Members and vice versa. A condition according to the Madrid Agreement, but not according to the Protocol, is a previous national registration in the country where submitter of the international application has a headquarters or residence.

10. Instead of a Conclusion.

The legal regime of the trademark in the Republic of Macedonia has been determined in accordance with domestic and international regulations. It has been legally shaped to provide efficient and effective protection in accordance with the European and world standards. Bearing in mind the comparative experience, and especially taking into account the international regulations, the Macedonian legislator introduced a range of novelties in the new IPL from 2002/2004. Some of the more prominent ones are: publishing the application, determining the application date and complaint procedure within a special administrative procedure for recognizing a trademark right, as well as standardization of the certification mark and the well-known mark, which represents a step forward in the realization of the protection of the right to trademark as one of the most significant parts of the industrial property.
II. RELATIONS BETWEEN TRADEMARKS AND DESIGNS:

DESSINS OU MODELES ET MARQUES :

1. A LA RECHERCHE D’UNE CO-EXISTENCE

2. ENTRE DEUX DROITS DE PROPRIETE INTELLECTUELLE

Les dessins et les modèles sont des oeuvres de l’esprit qui se caractérisent par le fait qu’elles s’appliquent à des objets industriels. Les dessins et les modèles – créations esthétiques ou ornementales de l’art appliqué – ne doivent pas être confondus avec les modèles d’utilité que l’on rencontre dans les législations de différents pays tels que l’Allemagne en Europe, le Japon et la Chine en Asie par exemple, qui sont des créations industrielles techniques, c’est-à-dire des inventions susceptibles d’être protégées par un titre particulier, le modèle d’utilité.

Constitue un dessin ou un modèle, toute figure ou forme donnée à un objet industriel et qui lui confère un effet esthétique, extérieur ou ornemental.

Les dessins et les modèles sont le fruit de l’activité intellectuelle de créateurs souvent appelés « designer », qui donnent aux objets industriels de toute sorte une configuration esthétique ou décorative particulière. Ainsi, les dessins et modèles reflètent la personnalité de leur créateur sur des produits industriels.

Les dessins et les modèles ont, donc, une fonction esthétique qui est distincte de la fonction utile de l’objet industriel ou encore de sa fonction technique.

Deux situations juridiques sont susceptibles de se présenter :

Selon un premier cas de figure, le créateur donne une apparence esthétique ou ornementale à un objet industriel qui a été inventé dans le passé, mais qui est dans le domaine public et, donc, peut être fabriqué librement ; dans

20 Article L511-1 § 1 du code de la propriété intellectuelle (cpi)
21 Article L511-1 § 2 du cpi :
ce cas, la forme esthétique de l’objet qui est indépendante de la fonction utile de celui-ci, laquelle est connue, est destinée à attirer la clientèle pour l’inciter à acheter ce produit de préférence à celui d’un concurrent.

Ainsi, le client choisira la lampe, la montre, les lunettes, le stylo, le fauteuil, etc… en raison de son aspect ornemental.

- Selon un deuxième cas de figure, l’objet industriel peut être protégé par un ou plusieurs brevets dans la mesure où il procède d’une ou plusieurs inventions qui produisent un effet technique ; deux droits de propriété industrielle ont, alors, vocation à s’appliquer :
  - le droit des brevets protégeant les inventions relatives à la fonction technique du produit ;
  - le droit des dessins et modèles, dans la mesure où le produit industriel qui incorpore la ou les inventions brevetées, présente un aspect esthétique propre, indépendant de l’effet technique destiné à attirer la clientèle et si possible à la retenir, lorsque les brevets ayant expiré, le produit sera livré à la concurrence.

Les dessins et les modèles bénéficient en France d’une protection spécifique, tant au plan interne qu’au plan communautaire.

Au plan interne, le créateur d’un dessin ou d’un modèle ou son ayant cause a la possibilité d’obtenir la protection de celui-ci par l’obtention d’un droit de dessin et modèle issu d’un enregistrement à l’INPI22.

Au plan de l’Union européenne, le créateur d’un dessin ou d’un modèle ou son ayant cause a, également, la possibilité d’obtenir une protection uniforme produisant des effets uniformes sur tout le territoire de la Communauté23.

L’enregistrement à l’INPI d’un dessin ou modèle national ou l’enregistrement d’un dessin ou modèle communautaire à l’Office de l’Harmonisation pour le Marché Intérieur (OHMI) accorde à son titulaire une protection pour une période de cinq ans, laquelle peut être prorogée pour plusieurs périodes de cinq ans jusqu’à un maximum de vingt-cinq ans24.


22 Article L et R 511.1 et suivants du cpi
Ainsi, selon le droit français, quel que soit le régime juridique applicable, un dessin ou modèle, c'est-à-dire la forme ornementale donnée à un objet industriel est d’abord une œuvre de l’esprit et notre Droit ne découplant pas entre l’Art pur et l’Art industriel, cette œuvre bénéficiant, dès sa création, de la protection de la propriété littéraire et artistique27.

La question se pose, alors, de savoir si cette même création d’ordre esthétique sur un objet industriel peut constituer un signe distinctif, une marque ?

L’article 96 du règlement sur les dessins et modèles communautaires prévoit expressément à son paragraphe 1 que celui-ci s’applique « sans préjudice des dispositions du droit communautaire ou de l’État membre concerné applicables … aux marques et autres signes distinctifs… ».

S’agissant des marques, le régime tant français que communautaire applicable à cette catégorie de signes distinctifs évoque les relations pouvant se nouer entre ces droits de propriété intellectuelle. Ainsi, selon le droit français, ne peut être adopté comme marque un signe portant atteinte à des droits antérieurs et notamment … aux droits d’auteurs, aux droits résultant d’un dessin ou modèle protégé28.

De même le règlement (CE) N° 40/94 du 20 décembre 1993 ci-après nommé « le règlement » instituant la marque communautaire29 prévoit-il, parmi les causes de nullité de celle-ci l’existence de droits antérieurs tels que un droit d’auteur ou un droit de propriété industrielle30. Ainsi, les œuvres littéraires et artistiques, y compris les œuvres musicales constituent des antériorités opposables à leur réservation comme signe susceptible de constituer une marque.

Toutefois, les mêmes textes normatifs en la matière énoncent que peuvent être choisis comme signes pouvant constituer une marque, entre autres : « les sons, phrases musicales, dessins, étiquettes, cachets, lisières, reliefs, hologrammes, logos, images de synthèse ; les formes notamment celles du produit ou de son conditionnement ou celles caractérisant un service ; les dispositions, combinaisons ou nuances de couleurs »31.

Ainsi, une œuvre d’art pur ou appliqué peut devenir un signe sonore ou figuratif exerçant une fonction de marque, sous réserve qu’il remplisse les conditions légales exigées pour l’obtention d’un tel titre, à savoir qu’il soit


28 Article L 711-4 e) et f) du cpi

29 Entré en vigueur le 15 mars 1994

30 Article 52-2, c) et d) du règlement

31 Article L 711-1, b) et c) du cpi ; article 4 du règlement (CE) N° 40/94 sur la marque communautaire.
susceptible de représentation graphique et qu’il serve à distinguer les produits ou les services d’une personne physique ou morale.

Si, s’agissant de la première condition d’accessibilité à la naissance d’un droit de marque, à savoir la représentation graphique du signe, aucune difficulté particulière ne surgit en raison de la nature même de celui-ci qui est figuratif, il en va différemment pour la seconde condition, l’aptitude à distinguer les produits ou les services d’une personne physique ou morale.

Classiquement, le droit français des marques reposait sur deux principes fondamentaux et exclusifs de toutes autres considérations : le droit de marque est un droit d’occupation, autrement dit tout objet entrant dans le domaine des signes qui n’a pas déjà été réservé pour une fonction de marque est apte à donner naissance à un droit de marque valable ; la fonction essentielle de la marque est de distinguer, c’est-à-dire d’individualiser les produits ou services considérés afin de permettre au consommateur de les reconnaître parmi les produits ou services identiques ou similaires, le lien avec l’entreprise qui met le produit sur le marché ou qui fournit le service, n’étant que la conséquence, l’effet induit du monopole attaché au droit de marque.

La publication de la directive (CE) N° 89/104 du 21 décembre 1988 rapprochant la législation des États membres sur les marques (abrogée par la directive CE N° 2008/95 du 22 octobre 2008), ci-après nommée « la directive »et surtout, les arrêts de la Cour de justice appelée à de nombreuses reprises à en interpréter le contenu, sont venus bouleverser l’ordre établi. Bien que la seule fonction juridique établie par les directives demeure – dans leurs dispositions normatives tout au moins – la fonction de « distinguer les produits d’une entreprise de ceux d’autres entreprises »

La Cour de Justice s’appuyant sur les considérants 10 puis 11 du préambule des directives successives, est venue attribuer de nouvelles fonctions à la marque, dont l’une est considérée comme la fonction essentielle : la fonction de garantie d’origine de la marque qui est d’indiquer la provenance des produits ou des services.


34 Articles 2 de la directive (CE) N° 89/104 et de la directive 2008/95.

35 Les considérants 10 et 11 des directives précitées déclarent : « la protection conférée par la marque enregistrée, dont le but est notamment de garantir la fonction d’origine de la marque… »

36 Sur l’évolution de la jurisprudence française et communautaire, v. notamment :

G. Bonet, chroniques de propriétés intellectuelles, Revue trim-dr-eu.
Aussi, est-ce désormais, à l’aune de cette fonction essentielle de la marque que la Cour de justice de Luxembourg examine la condition de distinctivité du signe choisi comme marque 37.

L’arbitraire entre le signe et le produit ou le service qu’il désigne, est nécessaire pour distinguer ces derniers, pour permettre au public de les reconnaître parmi les produits identiques ou similaires sur le marché ; encore faut-il que ce signe soit le « signifiant » de l’identité de l’entreprise titulaire de la marque afin que le consommateur soit, ainsi, en mesure d’établir un lien entre le produit marqué et celle-ci 38.

La « subjectivisation » de la fonction de la marque à laquelle on assiste n’est pas sans conséquences quant à l’examen de la distinctivité des signes pour lesquels une protection par un droit de marque est revendiquée, en particulier lorsque ceux-ci ont pour objet un dessin ou un modèle, tant les « voies / voix » de la Cour de justice en la matière semblent assez impénétrables ! Tenter de discerner un ordre logique, une cohérence dans les décisions rendues par la Cour suprême de l’Union européenne conduit à dissocier l’œuvre – le dessin ou le modèle – et le signe et à identifier leurs fonctions.

Il sera, alors, permis de constater que le passage de l’œuvre d’art appliqué au signe – du dessin et modèle – à la marque et, donc, leur coexistence, suppose la présence de leurs fonctions respectives, la première d’ordre esthétique (I), la seconde d’ordre distinctif (II).

I – CONDITIONS RELATIVES AU DESSIN OU MODELE : LA PRESENCE D’UNE FONCTION ESTHETIQUE

S’agissant de la condition de distinctivité du signe exigée pour l’obtention d’un droit de marque valable, on observe que – formellement tout au moins – le législateur français n’a pas transposé à la lettre la directive 39.

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37 Y. Basire : la fonction patrimoniale de la marque, Lexicom N°44 ; les fonctions juridiques de la marque, thèse à paraître 2011.
39 G. Bonet et A. Bouvel, distinctivité du signe, précité ; J. Azéma, Lamy commercial, Marques, précité.
O. Thrierr et L. Clavier : un an de jurisprudence sur les motifs absolus de refus de marques communautaires, revue propr. Ind. N°3 mars 2010, chron...3 ; J. Passa, droit de la propriété industrielle, précité, N°87 et s.

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Si, en effet, l’article L 711-1 du cpi reproduit globalement l’article 2 de la directive relatif aux signes susceptibles de constituer une marque, c’est-à-dire les signes propres à distinguer les produits ou les services « … d’une entreprise de ceux d’autres entreprises », il en va différemment de l’article 3 relatif aux motifs de refus ou de nullité : cet article prévoit expressément que sont « refusées à l’enregistrement ou susceptibles d’être annulées…les marques qui sont dépourvues de caractère distinctif » (article 3-1.b)) ; ces mêmes dispositions se retrouvent dans le règlement (CE) N° 40/94 sur la marque communautaire respectivement aux articles 4 et 7-b)40.

Il y aurait, donc, deux niveaux d’examen de la distinctivité : celle du signe qui doit permettre de distinguer les produits ou les services d’une entreprise et celle de la marque en tant que telle.

Pareille distinction laisse perplexe dans la mesure où le droit de marque étant un droit relatif entre un signe et un produit ou un service, soit le premier est apte à distinguer les seconds, soit il ne l’est pas, sauf à considérer que les articles 2 de la directive et 4 du règlement (CE) N° 40/94 visent uniquement le domaine des marques en énumérant une liste de signes pouvant les constituer.

L’article 3 de la directive et l’article 7 du règlement énumèrent les signes et les marques qui sont frappés de nullité :
- les signes qui sont hors le domaine des marques de l’article 2 (article 3§1-a) de la directive et article 7§1-a) du règlement).
- Des signes qui sont compris dans l’article 2 ou dans l’article 7, mais qui ne peuvent constituer des marques dans certaines circonstances (article 3-1, e) de la directive et article 7-e) du règlement).
- Les marques qui sont dépourvues de caractère distinctif. Les textes visent, ici, les marques en général et la sanction de la nullité en cas d’absence de caractère distinctif (article 3§1-b) et article 7§1-b)), ainsi que les cas d’espèces où les marques dans leur relation avec les produits ou les services qu’elles doivent désigner sont dépourvues de distinctivité (article 3§1-c) et d), article 7§1-c) et d)).

Les textes français de transposition de la directive sont plus simples en ce sens que l’article L 711-1 du cpi définit le domaine des marques, l’article L 711-2 pose la condition de distinctivité et l’article L 714-3 énumère les causes d’annulation de la marque, dont la non-conformité aux dispositions des articles L 711-1 et L 711-2 du cpi.

En tout état de cause, il apparaît que l’accessibilité d’un dessin ou modèle à la catégorie ou au statut de signe distinctif suppose que celui-ci soit ornemental autrement dit qu’il exerce une fonction esthétique ; Toutefois il est indiffèrent que la création d’art appliqué soit encore protégée ou non par les droits de dessin et modèle ou d’auteur : en effet, la fonction esthétique de la création demeure indépendamment de la durée de la protection patrimoniale et la


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loi ne pose aucune condition particulière quant à la superposition des droits, le droit de marque étant indépendant des droits de dessin et modèle ou d’auteur.

En revanche, les textes français et communautaire en la matière excluent de l’aptitude à devenir signes distinctifs, les dessins et modèles et, plus généralement, les formes qui par leur apparence ou leur structure sont dépourvues de toute qualité esthétique. Les dessins et les modèles dont la forme ne présente pas d’apparence esthétique ou ornementale particulière se trouvent être exemptés de cette qualité, soit parce que cette forme exerce une fonction technique, soit tout simplement parce que cette dernière est banale ou usuelle pour le produit considéré selon sa nature ; Aussi, convient-il de distinguer les exclusions selon qu’elles sont fondées sur la forme fonctionnelle (A) ou sur la nature (B) du produit en cause.

1. L’exclusion du dessin ou du modèle fondée sur la forme fonctionnelle.

La directive qui vise à l’article 2 la forme du produit comme signe susceptible de constituer une marque, exclut à l’article 3§1, e), ii) « les signes constitués exclusivement par la forme du produit nécessaire à l’obtention d’un résultat technique ».

L’article L 711§2, c) du cpi déclare que sont dépourvus de caractère distinctif « les signes constitués exclusivement par la forme imposée … par la fonction du produit… ».

L’article 7§1,e), ii) du règlement dispose que sont refusés à l’enregistrement « les signes constitués exclusivement par la forme du produit nécessaire à l’obtention d’un résultat technique ».

L’exclusion est, ici, fondée sur la non appartenance de la création à la catégorie des créations esthétiques et à sa qualification en création technique qui la rattache au domaine des inventions et qui rend impossible toute protection autre que celle du brevet41.

Le Tribunal de grande instance de Paris a jugé que la forme constituée par une bande en forme de croissant placée à la partie supérieure du talon de chaussures de sport ne pouvait constituer une marque, car elle avait pour fonction de protéger le talon d’Achille42 ; la chambre commerciale de la Cour de cassation a rejeté un pourvoi formé contre un arrêt de la Cour d’appel de Paris qui avait refusé la protection par un droit de marque, de la forme d’une brique de jeu de construction, jugée fonctionnelle, car produisant un effet technique et qui, par ailleurs, avait été couverte par un brevet43. La Cour d’appel de Versailles a jugé dans le même sens pour la forme de pièces de jeu meccano exclusivement

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41 Article L 511-8, 1er du cpi
fonctionnelle et dont l’assemblage permet de réaliser des constructions diverses 44.

Les juridictions communautaires, qu’il s’agisse des questions préjudicielles posées à la Cour de Justice en interprétation de la directive ou du contentieux sur la marque communautaire, refusent pareillement des marques constituées par la forme du produit qui est nécessaire à l’obtention d’un résultat technique.

Interrogée sur l’interprétation de l’article 3§1 e) de la directive et du paragraphe 3 du même article relatif à l’acquisition de la distinctivité par l’usage, la Cour de Justice est venue dans un arrêt devenu célèbre45 rappeler : « qu’un signe constitué exclusivement par la forme d’un produit n’est pas susceptible d’enregistrement en vertu de cette disposition (article 3 § 1 e) deuxième tiret) s’il est démontré que les caractéristiques fonctionnelles essentielles de cette forme sont attribuables uniquement au résultat technique ».

La Cour a, par ailleurs, apporté une précision importante quant au champ d’application du droit des dessins et modèles, à savoir que l’existence de formes différentes ou multiples équivalentes pour l’obtention du résultat technique n’entraînait pas la disqualification de la forme du produit – invention – en création ornementale, c’est-à-dire en dessin et modèle protégeable comme tel. La Cour de justice a, ainsi, ajouté : « la démonstration de l’existence d’autres formes permettant d’obtenir le même résultat technique n’est pas de nature à écarter le motif de refus ou de nullité d’enregistrement contenu dans ladite disposition ».

Dans un arrêt Linde en date du 8 avril 2003, la Cour de justice interrogée sur une question similaire s’est prononcée dans le même sens46.

Plus récemment, le Tribunal de première instance des communautés européennes (devenu Tribunal de première instance de l’Union européenne) a repris la solution retenue par la Cour de justice dans l’arrêt Philips et dans l’arrêt

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Linde à l’occasion d’une procédure d’annulation de la forme fonctionnelle de la brique du jeu de construction « Lego »47.

Les Tribunaux français ont également été saisis d’un litige opposant la société Philips à la société Remington et ont rendu des décisions conformes aux prescriptions des arrêts de la Cour de justice48.

Ainsi, les formes des produits qui sont exclusivement fonctionnelles ou encore les formes des produits qui sont nécessaires49 à l’obtention d’un résultat technique, ne peuvent constituer de dessin ou de modèle protégé comme tel ; elles ne peuvent davantage constituer des signes distinctifs ; en effet ces créations de forme sont des inventions et sont susceptibles d’être brevetées, conférant à leur titulaire une protection absolue pour 20 ans. Toutefois, la forme étant nécessaire à la fonction technique, les produits ne sont pas identifiables par leur forme, à partir du moment où les opérateurs qui mettent en œuvre l’invention offrent des produits identiques pour lesquels le consommateur n’est pas en mesure de reconnaître l’origine de l’entreprise qui les met sur le marché. Par ailleurs, ainsi qu’il a été relevé, le cumul des protections par brevet puis par marque ferait en quelque sorte « sauter » la protection limitée des inventions et la règle de la spécialité du droit des marques en prolongeant le monopole absolu du brevet limité à 20 ans par un second monopole d’une durée illimitée50 portant sur le même objet, c’est-à-dire l’invention, puisque, par hypothèse, le signe n’existe pas !

2. L’exclusion du dessin ou du modèle fondée sur la nature du produit

L’article 3 § 1, e), i) de la directive, l’article 7 § 1, e), i) du règlement disposent que sont refusés à l’enregistrement … les signes constitués exclusivement « par la forme imposée par la nature même du produit ». L’article L. 711 – 2, c) du cpr reprend pratiquement la même formule : « sont dépourvus du caractère distinctif … les signes constitués exclusivement par la forme imposée par la nature du produit ».

47 TPICE 12 novembre 2008, affaire Lego juris A/S, T-270/06
49 Dans l’arrêt du 12 novembre 2008 précité, le Tribunal de première instance de l’Union européenne est venu préciser la signification de l’expression « les caractéristiques fonctionnelles essentielles de la forme sont attribuables uniquement au résultat technique. Selon le tribunal cette expression combinée avec les mots « exclusivement » ou « nécessaire » signifie que « l’ajout de caractéristiques non essentielles n’ayant pas de fonction technique ne fait pas échapper une forme à ce motif absolu de refus si toutes les caractéristiques essentielles de ladite forme répondent à une telle fonction ».
50 V. G. Bonet et A. Bouvel, distinctivité du signe, précité N° 71 ; egal. J Passa, droit de la propriété industrielle T.1, précité, N° 107 et s.
La mise en œuvre de ces textes a développé un contentieux important, auprès des instances juridictionnelles communautaires pour les demandes d'enregistrement de marques communautaires et auprès des juridictions nationales pour les marques françaises. La complexité de la matière et la « lisibilité » des décisions rendues, conduisent à distinguer entre l'objet de l’exclusion (1°) et l’examen de l’exclusion par les instances juridictionnelles (2°).

1° : l’objet de l’exclusion

L’exclusion tient, ici, au fait que le produit considéré se présente sous une forme banale, usuelle, générique, celle qui est couramment utilisée par les opérateurs qui mettent le produit sur le marché. La « forme imposée par la nature du produit » insusceptible de distinguer le produit est, en matière de signes figuratifs à trois dimensions, en quelque sorte l’équivalent « des dénominations qui, dans le langage courant ou professionnel, sont exclusivement la désignation nécessaire, générique ou usuelle du produit », selon l’article L. 711 – 2 a) du cpi51 ou encore « les marques qui sont composées exclusivement de signes ou d’indications devenus usuels dans le langage courant ou dans les habitudes loyales et constantes du commerce », aux termes de l’article 3§1, c) de la directive et de l’article 7§1, d) du règlement.

D’une manière générale les décisions s’appuient sur le caractère descriptif de la forme du produit pour rejeter la distinctivité de celui-ci en raison de sa nature52.

Interprétant l’article 3§1 de la directive, la Cour de justice est venue préciser dans un arrêt Henkel du 12 février 2004, que pour les produits qui n’ont pas une forme déterminée, c’est l’emballage choisi qui donne sa forme au produit. Tel est le cas par exemple des produits liquides ou des produits fabriqués sous forme de granules ou de poudre53. Dans ces conditions, s’agissant


de la réservation du conditionnement des produits par un droit de marque, celui-ci est assimilé au produit lui-même\textsuperscript{54}.

Les décisions rendues en matière de conditionnement de produits objets de marque sont légion, tant de la part des juridictions françaises que communautaires.

Les Tribunaux distinguent entre la forme nécessaire, la forme usuelle ou couramment utilisée qui exclut la protection par un droit de marque, en raison de « la nature du produit » et, donc, de son conditionnement et les hypothèses où cette forme comprend des éléments non nécessaires\textsuperscript{55} ou celles où il existe d’autres conditionnements pour le même produit entrainant la distinctivité de la marque\textsuperscript{56}.

S’appuyant sur la forme imposée par la nature du produit, les tribunaux refusent la protection par un droit de marque, de conditionnements dépourvus de tout caractère arbitraire et de toute fantaisie\textsuperscript{57}, appartenant à un genre figuratif usuel et répandu, qui ne présentent aucun caractère distinctif\textsuperscript{58}, remplissant une fonction pratique\textsuperscript{59} ou une nécessité pratique\textsuperscript{60}.

Le Tribunal de première instance et la Cour de justice de l’Union européenne ont eu, également, à se prononcer à diverses reprises en matière de

\textsuperscript{54} Dans l’arrêt Henkel précité la Cour a notamment déclaré : »pour les marques tridimensionnelles constituées de l’emballage des produits qui sont emballés dans le commerce pour des raisons liées à la nature même du produit, l’emballage de celui-ci doit être assimilé à la forme du produit, de sorte que le dit emballage peut constituer la forme du produit au sens de l’article 3§1 sous e) de la première directive… ».


\textsuperscript{60} CA Versailles 6 janvier 1995, PIBD 1995 – 609 – III – p.223, à propos d’une boîte de conserve de forme rectangulaire dont la partie supérieure et inférieure comporte un bourrelet dépassant le couvercle de fermeture, lequel répond à une nécessité pratique, à savoir permettre son ouverture à l’aide d’un ouvre-boîte.
demandes d’enregistrement de marques communautaires. Ainsi sont refusées à l’enregistrement, les formes qui ne présentent pas de caractéristiques suffisamment différentes de celles susceptibles d’être communément utilisées pour ce produit, si elles n’ont pas d’aptitude concrète à indiquer une provenance commerciale déterminée et si elles se trouvent immédiatement perçues par l’acheteur potentiel, non comme l’indication de provenance, mais comme une représentation du produit lui-même.

Ainsi dans l’arrêt Henkel en date du 24 avril 2004 relatif à des tablettes de forme tridimensionnelle pour lave-linge ou lave-vaisselle, la Cour de justice a pu déclarer : « la forme tridimensionnelle dont l’enregistrement a été demandé […] compte parmi les formes géométriques de base et est une des formes venant naturellement à l’esprit pour un produit destiné au lave-linge ou au lave-vaisselle. »

Dans l’arrêt Procter et Gamble rendu le même jour, la Cour est venue préciser : « plus la forme dont l’enregistrement est demandé se rapproche de la forme la plus probable que prendra le produit en cause, plus il est vraisemblable que ladite forme est dépourvue de caractère distinctif au sens de l’article 7§1 sous b) du règlement… ».

De même dans l’arrêt Mag instrument inc. du 7 octobre 2004, relatif à des formes tridimensionnelles de lampe de poche, la Cour de justice a indiqué : « seule une marque qui, de manière significative diverge de la norme ou des habitudes du secteur et, de ce fait, est susceptible de remplir sa fonction essentielle d’origine n’est pas dépourvue de caractère distinctif au sens de ladite disposition (l’article 7§1 sous b) ».

Le même raisonnement s’applique pour les marques revendiquant le conditionnement d’un produit ou pour les marques figuratives bidimensionnelles.

63 CJCE 7 octobre 2004, aff. C – 136/02 P, consid. 31. Egalement, dans un arrêt du 22 juin 2006, pour une demande d’enregistrement de marque communautaire constituée par la forme tridimensionnelle d’un bonbon de couleur marron clair, la Cour a rappelé : « seule une marque qui de manière significative, diverge de la norme ou des habitudes du secteur et, de ce fait est susceptible de remplir sa fonction essentielle d’origine, n’est pas dépourvue de caractère distinctif au sens de l’article 7§1 sous b) du règlement… » ; aff. Storck C – 24/05 P, consid. 26. Plus récemment le TPI de l’Union européenne a jugé : « …il suffit de rappeler que, comme il ressort de la jurisprudence exposée…, dès lors que la marque demandée ne diverge pas de manière significative des formes communément utilisées dans le secteur en cause et, de ce fait, ne permet pas au consommateur d’en identifier l’origine commerciale ou industrielle, elle ne saurait être considérée comme présentant un caractère distinctif » (TPICE arrêt du 10 mars 2009, affaire G.M. Piccoli Srl T – 8/08, consid. 28).
64 CJCE 12 janvier 2006, aff. Deutsche Sisi-Werke GmbH C – 173/04 P.
65 CJCE 4 octobre 2007, aff. Henkel C – 144/06 P. L’espèce concernait une demande d’enregistrement de marque communautaire figurative constituée par la représentation d’une tablette rectangulaire rouge et blanche assortie d’un noyau ovale. La Cour a dit pour droit que la
Dans l’arrêt Deutsche Sisi-Werke Gmbh du 12 janvier 2006 relatif à une demande d’enregistrement de marque communautaire ayant pour objet des formes tridimensionnelles de sachets tenant debout pour boissons de fruits et jus de fruits, la Cour de justice confirmant l’arrêt du TPICE a repris mot pour mot la formule classique utilisée dans les décisions antérieures et a même ajouté : « le tribunal a légitimement pu se référer … à la « forme générique », à la « forme de base », à la « forme basique » ou à « l’apparence générique » des sachets tenant debout, formes et apparences qu’il a pu déterminer à partir des sachets tenant debout utilisés pour la commercialisation des liquides alimentaires sur le marché européen ».

2° l’examen de l’exclusion

On observera que les décisions rendues par le Tribunal de première instance et la Cour de justice de l’Union européenne en matière d’enregistrement de marques communautaires et plus exactement dans les espèces citées – de refus d’enregistrement – se placent sur le terrain de l’article 7§1, b) du règlement, c’est-à-dire celui de l’examen des « marques dépourvues de caractère distinctif » et non sur le terrain de l’article 7§1, e), i) qui vise « les signes constitués exclusivement par la forme par la nature même du produit ».

Pareil rattachement n’est pas sans conséquences juridiques dans la mesure où selon la qualification choisie, le déposant aura la possibilité ou non d’invoquer l’acquisition de la distinctivité par l’usage au moment de la demande d’enregistrement de la marque communautaire.

L’article 7§2 du règlement (l’article 3§3 de la directive et l’article L 711-2 infine du cpi) dispose que si cette faculté est offerte pour les signes ou les marques visés aux points b), c) et d) du paragraphe 1 de l’article 7, elle est en revanche refusée pour les signes visés aux points e) et suivants du même paragraphe.

On observera, également, que se plaçant uniquement sur le terrain de la distinctivité de la marque, la Cour de justice et le Tribunal de première instance de l’Union européenne se situent toujours dans la relation « signe - produit ou service » pour vérifier si le signe est apte à identifier et à signifier au consommateur ou au public pertinent l’origine commerciale de l’entreprise qui a mis sur le marché le produit ou le service marqué.

C’est ce mode de raisonnement qu’adopte la Cour de justice au fil des décisions successives rendues en la matière.

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jurisprudence développée au sujet des marques tridimensionnelles constituées par l’apparence du produit lui-même, vaut également lorsque, comme en l’espèce, la marque demandée est une marque figurative constituée par la représentation bidimensionnelle dudit produit (consid. 37).


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Dans l’arrêt Henkel du 29 avril 2004, la Cour indique déjà que pour apprécier si la combinaison de la forme et de l’agencement des couleurs de la tablette litigieuse peut être perçue par le public comme une indication d’origine, il y a lieu d’analyser l’impression d’ensemble produite par cette combinaison. 

Auparavant dans un arrêt du 6 mars 2003, le Tribunal de première instance avait pu déclarer à propos d’une demande d’enregistrement de marque communautaire figurative représentant une calandre de véhicule (calandre de Jeep) : « … ainsi il ne s’agit pas d’une des formes habituelles des produits du secteur concerné ou encore d’une simple variante de celles-ci, mais d’une forme ayant une apparence particulière, qui, compte tenu également du résultat esthétique d’ensemble, est de nature à retenir l’attention du public concerné et à permettre à ce dernier de distinguer les produits… ».

La spécificité en matière de marques figuratives bi ou tridimensionnelles est qu’il n’y a pas, à la différence des marques nominales, d’extériorité ou de séparabilité, apparente tout au moins, entre le signe – la dénomination – et le produit auquel il s’applique. Ici, le produit est à la fois le sujet et l’objet du signe, le signifiant et le signifié. Toutefois pour que la transmutation ou plus exactement la scissiparité « produit – signe » soit possible, pour que la forme devienne marque, il importe que la condition de distinctivité soit satisfaite. Se pose, alors, la question de l’appréciation du caractère distinctif d’une telle marque par la jurisprudence et des conséquences qui en découlent sur la qualification de la forme du produit objet d’un tel droit.

a) L’appréciation de la distinctivité de la forme du produit

Les instances juridictionnelles communautaires, de manière constante depuis les premières décisions rendues en la matière, rappellent la signification du caractère distinctif de la marque au sens de l’article 7§1, sous b) du règlement et au sens de l’article 3§1 sous b) de la directive tel qu’il a été interprété par la Cour de justice ; elles précisent, également, la méthode de l’appréciation du caractère distinctif.

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69 TPICE 6 mars 2003, affaire Daimler Chrysler Corporation T-128/01, consid. 42.
70 Dans les arrêts Procter et Gamble du 29 avril 2004 précités, la Cour de justice a ainsi déclaré : « le caractère distinctif d’une marque au sens de l’article 7§1, sous b) du règlement N°40/94 signifie que cette marque permet d’identifier le produit pour lequel l’enregistrement est demandé comme provenant d’une entreprise déterminée et donc de distinguer ce produit de ceux d’autres entreprises », Consid. 32.
71 [voir à propos de l’article 3§1, sous b) de la première directive 89/804/CEE du Conseil du 21 décembre 1988 rapprochant les législations des Etats membres sur la marque contient une disposition qui est identique à l’article 7§1, sous b) : pour l’interprétation de ce texte, v. CJCE arrêt du 8 avril 2003, Linde e.a., C-53/01 à C-55/01, rec. p.1 – 3161, consid. 40].
d’appréciation du caractère distinctif, qui est, relative, dans la mesure où cette
dernière s’effectue dans le cadre de la règle de la spécialité du droit de marque, à
savoir par rapport aux produits ou services pour lesquels l’enregistrement est
demandé et par rapport à la perception qu’en a le public pertinent72.

De la même manière, les instances juridictionnelles communautaires
indiquent pour chaque décision rendue, que « les critères d’appréciation du
caractère distinctif des marques tridimensionnelles constituées par la forme du
produit lui-même ne sont pas différents de ceux applicables aux autres catégories
de marques »73.

Les critères d’appréciation de la distinctivité de la marque sont donc
identiques quelle que soit la catégorie du signe choisi : marque nominale,
figurative à deux ou trois dimensions.

Les juges communautaires prennent, toutefois, soin de préciser que
l’application de ces critères est plus délicate, lorsqu’il s’agit d’apprécier la
relation entre la marque et le public pertinent pour vérifier si celle-ci est
distinctive, autrement dit si la forme du produit donne une identité à ce dernier,
de sorte que le public – le consommateur ou l’utilisateur final – puisse le
reconnaître comme provenant d’une entreprise déterminée74.

Aussi, trouve-t-on dans les arrêts de la Cour de justice comme du
Tribunal de première instance de l’Union européenne la formule suivante :

« Seule une marque qui, de manière significative, diverge de la norme
ou des habitudes du secteur et, de ce fait, remplit sa fonction d’origine n’est pas
dépourvue de caractère distinctif… »75.

L’appréciation de la distinctivité se fait en considération de l’impression
d’ensemble qu’elle produit, auprès du consommateur moyen ou de l’utilisateur

72 Arrêts Procter et Gamble précités, consid. 33, 34, 35.
73 Arrêts Procter et Gamble précités, consid. 36 ; v. également les autres décisions citées de la
CJCE qui reprennent la même formule et plus récemment l’arrêt du TPICE du 14 septembre 2009,
affaire Lange Uhren GmbH, consid. 68.
74 Dans les décisions Procter et Gamble précités, la Cour de justice reprenant les attendus du
TPICE à son compte a déclaré : « il a toutefois rappelé que, dans le cadre de l’application de ces
critères, la perception du public pertinent n’est pas nécessairement la même dans le cas d’une
marque tridimensionnelle, constituée par la forme et les couleurs du produit lui-même, que dans le
cas d’une marque verbale ou figurative, qui consiste en un signe indépendant de l’aspect des
produits qu’elle désigne. En effet, les consommateurs moyens n’ont pas pour habitude de présumer
l’origine des produits en se fondant sur leur forme ou celle de leur emballage, en l’absence de tout
élément graphique ou textuel, et il pourrait donc s’avérer plus difficile d’établir le caractère
distinctif s’agissant d’une telle marque tridimensionnelle que s’agissant d’une marque verbale ou
figurative … », consid. 36
75 Arrêts Procter et Gamble précités, consid. 36 ; également CJCE arrêt du 8 avril 2003, affaire Linde
et al. C-53/01 à C-55/01, consid. 48 et s. ; CJCE arrêt du 12 février 2004, affaire Henkel C-456/01 P
et C-457/01 P précité, consid. 38 ; CJCE 22 juin 2006, affaire Storck précitée, consid. 26 ; CJCE 7
qui la perçoit normalement comme un tout et ne se livre pas à un examen de ses différents détails 76.

Il ressort de l’analyse de la jurisprudence communautaire, notamment, que ce n’est pas le produit en tant que tel, mais la forme qu’il revêt et, donc, son apparence qui peut être l’objet d’un droit de marque, à partir du moment où cette forme n’est ni exclusivement fonctionnelle, ni imposée par la nature du produit. Seule une forme particulière qui est détachable du produit, indépendante du produit, intellectuellement tout au moins, dans sa fonction ou dans le genre auquel il appartient, peut ériger celui-ci en signe qui pourra exercer la fonction de marque, dès lors que la forme – signe a un caractère distinctif, c’est-à-dire est capable d’identifier le produit considéré en permettant au consommateur ou à l’utilisateur final de connaître l’origine de l’entreprise qui l’a mis sur le marché.

L’examen de la distinctivité de la marque s’effectue, donc, dans la relation entre le produit et sa forme 77 ; conformément à la jurisprudence établie de la Cour de justice et le Tribunal de première instance, cet examen n’est pas différent de celui qui est applicable aux autres catégories de marques, les marques nominales notamment 78.

b) La qualification de la forme du produit

Si la relation entre le produit et la forme qu’il épouse doit être arbitraire, originale pour que la condition de distinctivité soit satisfaite, alors cette forme doit avoir un caractère propre, une apparence particulière, indépendante du produit dans sa fonction technique ou simplement utilitaire. Autrement dit, le produit doit avoir une forme, une apparence esthétique ou ornementale qui

76 CJCE arrêt du 7 octobre 2004, affaire Mag instrument Inc. Précitée, consid. 20 ;
Dans l’arrêt du 30 juin 2005, affaire Eurocernex Sa précitée, la Cour de justice a jugé « pour apprécier si une marque complexe n’est pas dépourvue de caractère distinctif, il convient de se fonder sur la perception globale de cette marque par le consommateur moyen et non sur la présomption que des éléments dépourvus isolément de caractère distinctif ne peuvent une fois combinés, présenter un tel caractère (consid. 26) ; TPICE arrêt du 5 mai 2009, affaire Thomas Rotter, consid. 23 ; TPICE arrêt du 10 mars 2009, affaire G-P. Piccoli Srl T-8/08, consid. 27.

77 Ainsi le TPICE, dans son arrêt du 14 septembre 2009, (affaire Lange Uhren Gmbh T-152/07) relatif à une demande de marque communautaire constituée par des champs géométriques sur le cadrant d’une montre, a pu déclarer :
« … les formes géométriques en cause s’inscrivent sur le cadrant d’une montre qui est le produit pour lequel l’enregistrement de la marque a été demandée et qu’elles constituent une partie intégrante de la forme et de la représentation figurative dudit produit.
Il y a lieu dès lors de considérer, d’une part, que c’est à bon droit que la chambre de recours a estimé que la marque demandée reproduisait les éléments de la forme du produit concerné et, d’autre part, que, pour le consommateur moyen, la marque demandée n’est pas constituée par un signe indépendant de l’apparence des produits qu’elle désigne » (consid. 76 et 77). A. Foliard-Monguiral, revue propr. Ind. N°11, novembre 2009, comm.64.

78 Voir la jurisprudence de la Cour de justice et du TPICE précité.
permettra de le distinguer des autres produits identiques ou similaires ... dans leur fonction technique ou utilitaire. Le produit doit, donc, appartenir à la catégorie des dessins et modèles.

La qualification du produit ou dessin et modèle ne signifie pas que seules les créations ornementales protégées par un droit de dessin et modèle sont susceptibles de constituer des signes aptes à donner naissance à un droit de marque. En effet, tant l’article 2 de la directive, l’article L 711-1, c) du code de l’industrie que l’article 4 du règlement relatif au domaine des marques, n’opèrent aucune distinction : toute forme du produit ou de son conditionnement a vocation à devenir un signe susceptible de constituer une marque79 ... sous réserve qu’elle ait un caractère distinctif.

L’existence d’une fonction esthétique ou d’un caractère propre de la forme du produit n’a à être prise en considération que pour l’appréciation de l’aptitude de la forme à devenir signe, à constituer une marque, c’est-à-dire lors de l’examen de la relation entre le produit en tant que tel et sa forme. Autrement dit, elle est une condition nécessaire, mais non suffisante de la distinctivité du signe. C’est, ainsi, semble-t-il, qu’il faut interpréter la jurisprudence communautaire, qui distingue entre la protection de la forme ornementale en tant que telle par droit de dessin et modèle ou par droit d’auteur le cas échéant80 et la forme envisagée en tant que signe, qui dans sa relation avec le produit lui-même doit présenter un caractère distinctif.

Ainsi sont exclues, « la forme générique, la forme de base, la forme de produits couramment utilisés dans le secteur considéré »81, « la marque constituée par une combinaison d’éléments de présentation venant naturellement à l’esprit et qui sont typiques des produits concernés »82, la marque qui « vue dans son ensemble » ... « ne se différencie pas substantiellement des formes de base du conditionnement des produits concernés, communément utilisés dans le commerce » ... mais qui « apparaît plutôt comme une variante de ces formes83.

79 Ainsi la Cour de justice a pu déclarer dans l’arrêt Philips/Remington précité : « en particulier, la directive n’exige nullement que la forme du produit en considération duquel le signe est enregistré doive comporter quelque addition arbitraire. Conformément à l’article 2 de la directive, la forme en question doit simplement être propre à distinguer le produit du titulaire de la marque de ceux d’autres entreprises et donc à remplir sa fonction essentielle, à savoir garantir l’origine du produit » (consid. 49).
80 TPICE arrêt du 21 octobre 2008, affaire T-73/06 à propos d’un modèle de sac (consid. 32) ; TPICE arrêt du 29 septembre 2009, affaire T-139/08 à propos d’une marque figurative représentant la moitié d’un sourire de smiley (consid. 30).
Inversement, lorsque la forme du produit revêtira un aspect esthétique, celui-ci sera pris en considération comme un des éléments permettant d’accueillir la distinctivité du signe. C’est dans ce sens que s’est prononcé le Tribunal de première instance de l’Union européenne à propos d’une marque figurative représentant la calandre de véhicule. Le juge a considéré que le signe en cause constituant le dessin d’une calandre inhabituelle ne visait pas des éléments communément utilisés pour représenter une calandre84.

Dans l’arrêt précité du 10 mars 2009 le Tribunal de première instance de l’Union européenne a indiqué à propos d’une demande de marque communautaire constituée par la forme d’une coquille : « Il convient de rappeler que selon la jurisprudence l’existence de traits particuliers ou originaux peut conférer le degré requis de caractère distinctif à une marque qui en serait autrement dépourvue85.

Toutefois, la constatation de l’apparence esthétique du produit, nécessaire pour ouvrir l’accès à la distinctivité de la marque, n’est pas suffisante. Ainsi dans l’arrêt du 21 octobre 2008, précité, relatif à une demande de marque communautaire représentant la forme d’un sac le Tribunal de première instance de l’Union européenne a précisé : « … s’il n’est pas exclu que la protection d’une forme par le droit d’auteur national soit prise en compte dans l’examen de son caractère distinctif, cette circonstance ne suffit cependant pas, à elle seule, à établir le caractère distinctif de la marque demandée86.

La forme du produit présentant un caractère propre ou esthétique ne pourra devenir un signe et, partant, donner naissance à un droit de marque que si elle remplit également la fonction de la marque, si elle exerce une fonction distinctive.

84 TPICE arrêt du 6 mars 2003, affaire Daimler Chrysler Corp. Précitée. Le Tribunal a notamment déclaré (consid. 42 à 50) :
« La requérante fait valoir que la marque demandée est manifestement différente des dessins de calandre de tout autre véhicule terrestre. L’OHMI rétorque que le signe en cause reste dans les limites de ce que le consommateur moyen est habitué à observer comme calandres de véhicules terrestres et ne présente donc aucun caractère original. A cet égard il y a lieu d’observer que le signe en cause est la représentation de la partie frontale d’une automobile ayant une forme irrégulière comprenant au centre de celle-ci sept larges ouvertures verticales et de chaque côté supérieur un cercle représentant les phares du véhicule. Cette figure au moment du dépôt constitue un dessin d’une calandre inhabituelle,… Pourtant le signe en cause ne peut être considéré comme l’image venant naturellement à l’esprit de la représentation typique d’une calandre contemporaine. Dès lors il n’est pas possible de retenir la constatation de l’OHMI selon laquelle le signe en cause vise des éléments communément utilisés pour représenter une calandre ».
III. CONDITIONS RELATIVES À LA MARQUE : L’EXISTENCE D’UNE FONCTION DISTINCTIVE

La forme esthétique d’un produit donne à celui-ci une apparence particulière, un aspect ornemental ; elle est le fait de l’imagination de son créateur ; elle est une œuvre qui a pu ou qui est encore protégée en tant que telle par un droit de dessin et modèle, voire, pour la France, par droit d’auteur également. Toutefois, quelle que soit la date de sa création, que sa protection ait été ou non reconnue, que le dessin ou modèle soit dans le domaine public ou non, la fonction esthétique demeure, elle est inhérente au produit lui-même. Pour que la forme exerce une nouvelle fonction, à savoir celle d’une marque, elle doit être capable de distinguer, c’est-à-dire, selon la définition désormais commune, elle doit permettre d’identifier le produit pour lequel l’enregistrement est demandé comme provenant d’une entreprise déterminée et donc de distinguer ce produit de ceux d’autres entreprises.

Lorsque cette condition de fonction distinctive autonome n’existe pas, lorsque la forme ne permet pas d’identifier le produit en indiquant au consommateur ou au destinataire final de celui-ci l’origine de l’entreprise qui l’a mis sur le marché, un droit de marque ne peut être valablement constitué.

Il en est, ainsi, lorsque la forme du produit, le dessin ou modèle qui le couvre, donne au produit sa valeur substantielle et rend impossible l’émergence d’un signe distinctif (A). La question se posera, alors, de savoir à quelles conditions la forme d’un produit qui ne donne pas à celui-ci sa valeur substantielle pourra s’en détacher pour se muer en signe doté d’une fonction distinctive (B).

L’exclusion de la forme qui donne une valeur substantielle au produit

L’article 3§1, c), iii) de la directive, l’article 7§1, e), iii) du règlement disposent que sont refusés à l’enregistrement ou déclarés nuls les signes constitués exclusivement « par la forme qui donne une valeur substantielle au produit », tandis que l’article L 711-2, e) du cpi indique que ceux-ci sont dépourvus de caractère distinctif.

Les différences que l’on peut constater entre les textes communautaires et la transposition en droit français n’ont pas d’incidence juridique dans la mesure où de tels « signes » ne peuvent acquérir la distinctivité par l’usage en
raison de l’inapplicabilité à leur égard de l’article 3§3 de la directive, de l’article 7§3 du règlement et de l’article L. 711-2, c) alinéa 2 du cpi.

La raison de cette exclusion est précisément que la forme de tels produits a exclusivement une fonction esthétique, elle est une œuvre d’art appliqué du produit lui-même protégée par un droit de dessin ou modèle. Si la forme donne la valeur « substantielle » du produit, elle n’est pas détachable de celui-ci, en ce sens qu’elle donne au produit un aspect ornemental, esthétique qui est protégé en tant que tel comme dessin et modèle et, donc, accorde au créateur ou à son ayant cause un droit exclusif de reproduction de ce dernier.

Elle ne peut, donc, pas devenir un signe indépendant du produit, car, ici, aucune relation arbitraire ne peut s’établir entre la forme et le produit : le consommateur identifie le produit uniquement par la valeur esthétique de sa forme et non par rapport à l’origine de l’entreprise qui l’a admis sur le marché.

Admettre la protection cumulative de la marque sur la protection du modèle conduirait en délibérative à octroyer à ce dernier une protection indéfinie par la voie d’un autre droit d’industrielle – le droit de marque – alors que l’objet de la protection est unique, à savoir la forme esthétique du produit et que celle-ci n’exerce pas, en parallèle, une fonction distinctive.

Interrogé sur la question de savoir si un tel signe pouvait acquérir la distinctivité par l’usage en application de l’article 3§3 de la directive, la Cour de justice a répondu par la négative en rappelant que dans son arrêt Philips elle avait indiqué que l’article 3§1, e) de la directive visait « certains signes qui ne sont pas de nature à constituer des marques » et qu’en conséquence, les signes ayant pour objet la forme qui donne une valeur substantielle au produit, comme ceux dont la forme est imposée par la nature est nécessaire à l’obtention d’un résultat technique, ne sont pas justiciables du paragraphe 3 de l’article 3.

L’admission de la fonction distinctive de la forme du produit

Un produit peut présenter une forme esthétique ou ornementale qui le caractérise sans pour autant constituer la valeur substantielle de celui-ci. On sait que l’existence d’une seule fonction décorative n’est pas suffisante pour imprimer une fonction distinctive à la forme du produit.

88 Ainsi dans l’arrêt Mag instrument du 7 octobre 2004 précité, la Cour de justice a déclaré : « …s’agissant de la reconnaissance dont, selon la requérante, le design des lampes de poche en cause jouirait sur le plan international, il convient de relever que la circonstance que les produits bénéficient d’un design de qualité n’implique pas nécessairement qu’une marque constituée de la forme tridimensionnelle de ces produits permet ab initio de distinguer lesdits produits de ceux d’autres entreprises, au sens de l’article 7§1, sous b), du règlement N°40/94 » (consid. 68).
La Cour de justice, dans l’arrêt du 4 octobre 2007 précité, reprenant les attendus du TPICE a jugé : « l’impression d’ensemble produite par le signe en cause se borne à celle d’une représentation d’un produit pour lave-vaisselle ou pour lave-linge sous la forme d’une tablette dans laquelle plusieurs agents chimiques sont regroupés de façon décorative et attrayante en deux couches colorées, rouge et blanche, et dont la couche rouge est assortie d’un noyau ovale bleu … » ; « … l’impression d’ensemble produite par le signe ne signalera pas au public ciblé que la présentation concrète du produit est révélatrice de son origine commerciale… » ; « … dès lors, la marque demandée ne permet pas au consommateur moyen desdits produits … de distinguer le produit concerné de ceux d’autres entreprises »

Plus récemment, le Tribunal de première instance de l’Union européenne, dans l’arrêt du 29 septembre 2009 précité a pu déclarer : « or, la marque en cause ne présente aucun aspect facilement et immédiatement mémorisable par le public pertinent … qui lui permettrait d’être appréhendé immédiatement comme une indication de l’origine commerciale des produits en cause. Comme l’a justement relevé la chambre de recours, elle sera exclusivement perçue comme un élément décoratif, qu’il s’agisse tant des produits relevant de la classe 14 que ceux relevant des classes 18 et 25. Partant, la marque en cause ne permettra d’individualiser aucun des produits en cause par rapport à des produits concurrents »

Si, donc, la forme banale, usuelle dépourvue de caractère esthétique ou décoratif ne peut constituer une marque et si la présence de ces caractères est nécessaire mais non suffisante, à quelles conditions, alors, la forme du produit pourra satisfaire à l’exigence du caractère distinctif ?

Il apparaît, à l’observation des décisions des juridictions communautaires que, conformément au droit commun des marques, la forme du produit ou de son conditionnement présentera un caractère distinctif, lorsque celle-ci sera nouvelle autrement dit disponible pour désigner le produit considéré (1er) et subsidiairement lorsque la distinctivité sera acquise par l’usage (2ème).

1er : la distinctivité fondée sur la disponibilité du dessin ou du modèle

Le caractère distinctif d’une marque ne suppose pas seulement une relation arbitraire ou originale entre le signe et le produit ; il suppose également la disponibilité du signe choisi pour la relation envisagée. Si en matière de marques nominales, il est aisé d’examiner la disponibilité d’une dénomination en recherchant si celle-ci n’a pas été auparavant réservée comme signe distinctif

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89 CJCE arrêt du 4 octobre 2007, affaire Henkel Kga A., C-144/06 P, précitée, consid. 43.
90 TPICE arrêt du 29 septembre 2009, affaire the Smiley company, consid. 31.
constituant un droit antérieur opposable, il en va différemment en matière de marques figuratives bi ou tridimensionnelles.

Ici, la forme décorative ou esthétique donnée au produit ou au dessin est permanente, en ce sens qu’elle n’est pas liée à la durée de la protection par droit de dessin et modèle ou d’auteur et qu’elle est absolue.

Autrement dit tous les produits mis sur le marché par différents opérateurs économiques peuvent avoir une forme esthétique ou décorative identique ou similaire, qu’ils peuvent utiliser librement si le dessin ou le modèle est dans le domaine public ou avoir acquis du créateur ou de son ayant cause cession ou licence du droit d’exploitation.

Dans ces conditions, la forme esthétique ou décorative étant communément utilisée dans des secteurs déterminés de l’industrie ou du commerce, celle-ci ne saurait exercer la fonction distinctive assignée à la marque, car elle est insusceptible d’indiquer l’origine de l’entreprise qui met le produit sur le marché : en effet, elle ne peut identifier le produit ou son conditionnement par sa forme esthétique ou décorative, puisque par hypothèse, de nombreux produits sur le marché en cause présentent une décoration ou une apparence esthétique identique ou similaire. C’est dire que la forme esthétique, appréhendée comme signe, est devenue banale, générique, voire descriptive pour les produits ou les conditionnements en cause.

C’est ainsi, semble-t-il, qu’il faut interpréter les décisions rendues par les juridictions communautaires lorsqu’elles déclarent :

« Seule une marque qui, de manière significative, diverge de la norme ou des habitudes du secteur et, de ce fait, est susceptible de remplir sa fonction essentielle d’origine n’est pas dépourvue de caractère distinctif … ». « Dès lors, le Tribunal a, à bon droit, pris en considération les formes et les couleurs de bonbons communément utilisés dans le commerce aux fins d’apprécier si la marque demandée est ou non dépourvue de caractère distinctif … » et « a constaté que la forme du bonbon en cause ne se différencie pas substantiellement de certaines formes de base des produits concernés, qui sont communément utilisés dans le commerce »91.

Plus récemment, le Tribunal de première instance de l’Union européenne dans l’arrêt du 21 octobre 2008 précité relatif à une demande d’enregistrement de marque communautaire constituée par la forme d’un sac, a pu déclarer : « En premier lieu, il peut être relevé que la forme représentée par le signe dont l’enregistrement est demandé, se rapproche des formes communes des sacs … En l’espèce le signe litigieux constitue un modèle évoquant l’image venant naturellement à l’esprit de la représentation typique d’un sac

contemporain et ne peut dès lors être considéré comme distinctif » 92 ; v. égal. :
TPICE arrêt du 10 mars 2009, précité, consid. 28 et 30.

Inversee, lorsque la forme esthétique ou décorative est nouvelle, lorsqu’elle n’a pas été utilisée comme telle dans le secteur d’activité en cause, elle est, alors, susceptible de remplir la fonction de marque c’est-à-dire de créer le lien entre le produit qu’elle a pour objet d’identifier et l’entreprise qui met ce produit sur le marché.

C’est ce qu’a jugé le Tribunal de première instance de l’Union européenne dans l’arrêt du 6 mars 2003 précité, relatif à la représentation d’une calandre de véhicule, en déclarant que le signe en cause ne pouvait pas être considéré comme l’image venant à l’esprit de la représentation typique d’une calandre contemporaine 93.

La nouveauté du dessin et du modèle et sa disponibilité pour exercer une fonction distinctive expliquent la solution retenue par le Tribunal de première instance de l’Union européenne dans l’arrêt du 10 octobre 2007 relatif à une demande de marque communautaire tridimensionnelle ayant pour objet la forme d’un haut-parleur 94.

Il a été jugé :

« Dès lors, il convient de constater que la marque demandée diverge, de manière significative, des habitudes du secteur. En effet, elle présente des caractéristiques suffisamment spécifiques et arbitraires susceptibles de retenir l’attention du consommateur moyen et de permettre à ce dernier d’être sensibilisé par la forme des produits de la requérante. Ainsi, il ne s’agit pas d’une des formes habituelles des produits du secteur concerné ou encore d’une simple variante de celles-ci, mais d’une forme ayant une apparence particulière, qui, compte tenu également du résultat esthétique d’ensemble, est de nature à retenir l’attention du public concerné et à permettre à ce dernier de distinguer les produits visés par la demande d’enregistrement de ceux ayant une autre origine commerciale » 95.

93 TPICE arrêt du 6 mars 2003 précité. Le Tribunal a notamment relevé : » à cet égard, il y a lieu d’observer que le signe en cause est la représentation frontale d’une automobile ayant une forme irrégulière comprenant au centre de celle-ci sept larges ouvertures verticales et de chaque côté supérieur un cercle représentant les phares du véhicule. Cette figure, au moment du dépôt de la demande, constitue le dessin d’une calandre inhabituelle qui offre l’image d’une calandre d’autrefois et une configuration simple qui ne peut pas être considérée comme tout à fait commune dans les circonstances existant à la date de dépôt de la demande » (consid. 46 et 48).
94 TPICE arrêt du 10 octobre 2007, affaire Bang and Olufsen T-460/05.
95 Arrêt du 10 octobre 2007 précité, consid.42.
2° : la distinctivité fondée sur l’usage du dessin ou du modèle à titre de marque

Dès lors que l’appréciation du caractère distinctif de la marque figurative bi ou tridimensionnelle relève des dispositions des articles 3§1, b) de la directive, L. 711-2 b) du cpi ou encore de l’article 7§1, b) du règlement, le signe considéré est susceptible d’acquérir la distinctivité par l’usage que prévoient l’article 3§3 de la directive, l’article L 711-2 c) in fine du cpi, l’article 7§3 du règlement.96

Un signe figuratif ou la forme esthétique d’un produit ou de son conditionnement n’acquerront la distinctivité que si la fonction d’indication de l’origine de l’entreprise du produit ou du service qu’ils identifient est réalisée.

Il en sera, ainsi, si, en premier lieu, le signe figuratif ou la forme esthétique du produit, qui sont connus comme dessins et modèles, protégés comme tels ou dont la durée de protection est expirée, sont utilisés à la manière d’une marque. Un long usage d’un signe figuratif uniquement comme décoration, d’une forme d’un produit uniquement dans sa fonction esthétique, c’est-à-dire comme modèle en tant que tel, ne seront pas de nature à créer la fonction distinctive : c’est l’usage à la manière d’une marque, c’est-à-dire comme signe permettant au consommateur d’établir un lien entre l’origine de l’entreprise et le produit, ainsi individualisé par rapport aux produits des entreprises concurrentes, qui réalisera l’acquisition de cette distinctivité. Ainsi l’usage d’un dessin comme décoration sur un produit ou sur un conditionnement, la commercialisation d’un produit ou d’un conditionnement présentant en soi une forme esthétique particulière ne seront pas suffisantes, s’ils n’apparaissent pas au consommateur comme des signes destinés à distinguer les produits, c’est-à-dire à lui indiquer – à lui désigner – l’origine de l’entreprise qui met ce produit sur le marché, mais seulement à attirer son attention par son aspect esthétique ou décoratif.

C’est ainsi, nous semble-t-il, qu’il faut interpréter la jurisprudence communautaire. Toutefois, il incombe au requérant de rapporter la preuve que le signe figuratif ou la forme du produit auront fait l’objet d’un usage à titre de marque.97

Dans l’arrêt du 22 juin 2006 précité, la Cour de justice a pu déclarer : « … Il y a lieu de rappeler que, en ce qui concerne l’acquisition d’un caractère distinctif par l’usage, l’identification par les milieux intéressés du produit ou du service comme provenant d’une entreprise déterminée doit être effectuée grâce à l’usage de la marque en tant que marque.98

97 CJCE arrêt du 7 octobre 2004 précité, affaire Mag instrument, consid. 53 à 55.
98 CJCE arrêt du 22 juin 2006 précité, affaire Storck consid. 61 ; égal. TPICE arrêt du 29 septembre 2009 précité, affaire the SMiley company, consid. 31

52
Récemment, dans un arrêt rendu le 30 septembre 2009, le Tribunal de première instance de l’Union européenne est venu préciser les éléments de fait pouvant permettre d’établir l’usage du signe figuratif ou de la forme à titre de marque.

Le Tribunal relève que l’acquisition d’un caractère distinctif par l’usage de la marque exige qu’au moins une fraction significative du public pertinent identifie grâce à la marque les produits ou les services concernés comme provenant d’une entreprise déterminée. Parmi les facteurs d’appréciation de l’acquisition d’un caractère distinctif le Tribunal retient la part de marché détenue par la marque, l’intensité, l’étendue géographique et la durée de l’usage de cette marque, l’importance des investissements faits par l’entreprise pour la promouvoir, la proportion des milieux intéressés qui identifie le produit comme provenant d’une entreprise déterminée grâce à la marque99.

En second lieu, le requérant devra démontrer que le caractère distinctif de la marque a été acquis par un usage antérieur à la date du dépôt de la demande d’enregistrement100.

En définitive, il apparaît que les relations complexes entre les dessins et modèles et les marques qui se partagent un même objet – un produit destiné au marché – se clarifient, lorsque sont mises en évidence les fonctions respectives qui leur sont attribuées : une fonction esthétique pour les uns, une fonction distinctive pour les autres. Force est de constater que la coexistence suppose un dédoublement de la création esthétique en signe qui ne saurait devenir distinctif que si celle-ci se « positionne » comme une marque … mais c’est là un tout autre débat.

IV. THE RELATIONSHIP BETWEEN TRADEMARKS AND DOMAIN NAMES

1. Introduction

Trademarks, which enable differentiation of the goods and services (especially in terms of the quality and value) by the consumer, may be an integral part of the domain’s name. For example, the well known Coca-Cola® trademark is an integral part of the coca-cola.com domain\textsuperscript{101}.

The domain differs from the trademark by several characteristics. First, the domain is present in the virtual space and territoriality does not apply as in the trademark. Second, the domain is unique and there can not be coexistence, as is the case with the trademarks of different categories of goods and services. The domain or IP address is unique, which means that two business entities may have the same mark, but can not have the same domain name. Hence, the domain is unique and unrepeatable.

It is obvious why a trademark is very valuable and significant as a domain name. With its registration, the trademark loses the characteristics of territoriality and specialty. The trademark transformed into a domain is present worldwide. The issue is a virtual monopoly right, bearing its own characteristics.

Businesses started to register the domains on the Internet at the beginning of the 1990s, in order to introduce their companies and to place and advertise their products. This, however, was done only by the visionaries who believed in the power of the Internet. Businesses interact through Internet with the consumers without any impediments (political, territorial, religious, moral, temporal, cultural, etc.). This seems much faster and more efficient than the “classical way” in “real-time relationships” among people. The number of domain names is growing by the day. According to an information from 2003, there are more than 15 million domain names.\textsuperscript{102}

\textsuperscript{101} www.coca-cola.com.
2. Abusive Registration of a Domain Name

(Domain Hijacking, Cybersquatting,)

Since the registered domains are fulfilled according to the priority principle, i.e. by accepting the application that was submitted first, there were many cases in the beginning when domains were registered that had nothing to do with the real producers or service providers to which the domain name indicated. For example, domains like McDonald’s, Hertz, Rolex and others were given to entities that were quite different from the apposite companies.

The persons who succeeded in registering these domains later demanded huge sums of money as compensation for relinquishing the domain to the company that has a trademark apposite to the domain name.

This phenomenon of malicious, deliberate registration of domains that correspond to trademarks or names of some entities in order to make profit is called “domain hijacking” or “cybersquatting”. The subject undertaking domain hijacking activities is known as “cybersquatter”. This subject acts in mala fides, contrary to the principles of consciousness and honesty, “occupying” an attractive domain, with the intention of later offering it to the carrier of the eponymous trademark and make profit.

A scholarly example is the court order in the USA in the cases between Dennis Toeppen and Panavision International and Intermatic. Namely, Toeppen had registered a large number of domains that were the same as or similar to famous marks, among which the marks of Panavision® and Air Canada®, as apposite domains: panavision.com and aircanada.com. Panavision® brought an action and the court applied the US traditional trademark right (under the US Federal Trademark Dilution Act). The court established existence of commercial use, because Toeppen had registered a large number of someone else’s trademarks as domain names.

The court ruled similarly in the Intermatic v Toeppen case, where the court found dilution of the Intermatic trademark and registration of a domain name by a person who does not have the right to the trademark.

Apart from the domain registration of apposite trademarks in their authentic form, it is possible for the registered domain to be a corrupt, diluted, or

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103 The formula “first come, first served” is the basis of the registration principle or the awarding of a domain name, and represents a “legal transplant” of the Roman principle “qui prior est tempore, potior est jure” (this is the theory of legal transplants, supported by Alan Watson, who believes that law is not developed as a result of evolution, but through borrowing or transplanting legal institutions from previous legislations into the contemporary legislation (see more in: А. Вотсон, Правни трансплантати, приступ упоредном праву, Београд, 2000).


105 For more information, please see: M. Killian (2000), Cybersquatting and Trademark Infringement, E- law, vol 7, N 3.
deformed shape of a trademark or name. As an example, we could use the .nikke.com\textsuperscript{106} domain, which is an on-line shopping web page, but with the average consumer it may arise association with the .nike.com domain, which belongs to the NIKE\textsuperscript{® 107} company. In the Macedonian practice, we are familiar with the google.com.mk, yahoo.com.mk domain cases.

Domain hijacking is different from the “honest competition use” of a domain. We could use the comparison of the mtv.com and mtv.com.mk domains as an example for this situation, even though both subjects come from the same line of business.

2.1. The Position of the Cybersquatter from Aspect of the Right to a Trademark

How can a trademark holder defend himself from the cybersquatter? First of all, the characteristics of the mark should be pointed out, and they are: territoriality and specialty. Typical for the mark is territoriality, simply because it is valid on the territory of one country or one region or a special union of countries.

The mark has a distinctive function, i.e. it differentiates goods and services of one participant in the commercial trade from another, for identical or similar goods and services. There may be more identical or similar marks for different goods and services at the same time. The exception for the widely known marks has already been mentioned.

On another level, the source of the problems in the constellation between the domain names and the marks, irrespective of whether it is about the actions of the cybersquatter or same marks that strive towards one domain name, is exactly in the previously mentioned registration priority principle. If the holder of a mark wishes to register a domain name, he would face serious difficulties if that had previously been done by the cybersquatter. The purpose of the cybersquatter, acting in bad faith, is to gain profits by registering someone else’s mark or “to dilute” a renown mark as a domain name, and to later offer the domain name to the mark holder. The domain registration, as well as its maintenance, does not require a lot of money compared to the extorted sum for transferring the domain name to the mark holder. In this way, the cybersquatter would groundlessly gain wealth, acting in bad faith (\textit{mala fides}).

\textsuperscript{106} www.nikke.com
\textsuperscript{107} www.nike.com
3. Procedure for Resolving Domain Disputes

Two parties appear in the disputes dealing with the domains: one of the parties is the person who is most often the trademark holder or a legal or physical person who believes that his/her interest is endangered by the domain (petitioner, appellant, complainant), while the other party is the person who registered the domain (domain holder, respondent).

Due to the sensitivity of the matter, but also from economical reasons, disputes regarding domains are most commonly subject to alternative dispute resolution.

The parties, however, may initiate a court procedure for the domain, even if a decision had already been made in the alternative dispute resolution procedure.

3.1 An Overview of Resolutions in Comparative Law

In most national legislations, there are several regimes for regulating cases involving domains, especially in terms of cybersquatting. In this regard, the practice of the USA and Australia is indicative. Yi Fen Lim gives the following facts.108

In the United States of America, the so called Anticybersquatting Protection Act (Truth in Domain Names Act) applies since 1999. This Act forbids behaviour of individuals, who have a bad faith intent to profit from someone else’s trademark, by registering or using domain names that are identical, confusingly similar or delusive of a trademark. The most interesting aspect of this piece of legislation is 15 USC s. 1125 (d) 2 C. Pursuant to this Article, the domain names are subject to an in rem action, in the judicial district where the domain name was registered. If, however, the cybersquatter is a legal person, then an in personam action is filed. Some familiar cases dealing with this issue are: Kremen vs. Stephen Michael Cohen, Network Solutions et al, who disputed over the sex.com domain.

In Australia, the purpose of the domain registration policy is to prevent cybersquatting. The domain allocation, however, is determined by the first come first serve rule. Only trading entities may get the .com.au domains. These trading entities may be registered in one of the following forms: companies (including foreign companies in Australia), registered names of companies, incorporated associations, statutory trading bodies, financial institutions, registered funds. The applicants may use the full name or an abbreviation for the domain name. There are three conditions that need to be fulfilled in case of an abbreviation: the

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abbreviation needs to derive from the full name; signs may be removed from the name, but sequences may not be changes; and new signs may not be introduced.

As per the European Union legislation, the cases of suspicious domain registrations and their abuse are settled in a court procedure or in an alternative dispute resolution procedure.

Regulation 874/2004 provides that a registered domain name may be subject to revocation where that name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, and where it:

(a) has been registered by its holder without rights or legitimate interest in the name; or
(b) has been registered or is being used in bad faith.

A legitimate interest of the holder may be demonstrated where:

(a) prior to any notice of an alternative dispute resolution (ADR) procedure, the holder of a domain name has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;
(b) the holder of a domain name, being an undertaking, organisation or natural person, has been commonly known by the domain name, even in the absence of a right recognised or established by national and/or Community law;
(c) the holder of a domain name is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name on which a right is recognised or established by national and/or Community law.

3.2. Alternative Dispute Resolution Regarding Domains

The purpose of the Alternative Dispute Resolution (ADR) in information technology law, as in any other legal branch, is to enable dispute resolution in an efficient, time and money saving manner for the parties. This is a rational alternative to the judicial process. In regard to the domains, this is even more evident, bearing in mind the distance of the parties in dispute of the domain.

In 1999, the Internet Corporation for Assigned Names and Numbers (ICANN) adopted the Uniform Domain Name Dispute Resolution Policy


110 Ibid.
(UDRP Policy), as well as the UDRP Rules that regulate the administrative procedure for resolving domain disputes.\textsuperscript{111}

Under the UDRP rules, the domain name dispute resolution procedure may take place before one of the following ICANN approved service providers:\textsuperscript{112} the Asian Domain Name Dispute Resolution Centre (ADNDRC)\textsuperscript{113}, with offices in Beijing, Hong Kong and Seoul; the National Arbitration Forum (NAF)\textsuperscript{114}; the WIPO Arbitration and Mediation Center\textsuperscript{115} and the Czech Arbitration Court (in regard to the .eu domain).

The list of providers may be amended, which essentially means that ICANN has the right to assign a new provider or to revoke the approval to some of the existing providers.\textsuperscript{116}

Each provider follows the UDRP Rules, as well as its own supplemental rules, in the dispute resolution procedure.

As for who would be “in charge” of some dispute, the selection is made by the submitter of the complaint, or the trademark holder, and is bound to put that in the complaint.

3.3. ICANN’s General UDRP Rules

The UDRP rules have double goals: to remove bad faith domain holder from the virtual space and to enable the complainant (mark holder) to get the domain to which he has a legitimate right. UDRP rules apply to dispute resolution regarding generic top-level domains (gTLD): .com, .net, .org, .biz, .name, .info, .pro, .coop, .aero, .museum, .job and .travel. UDRP is accepted only for some of the national domains (e.g., .nu, .tv, .ws).\textsuperscript{117}

The procedure begins by submission of a complaint by the trademark holder, in which he/she states the relevant facts. The entire procedure is shown on the picture below.

Under the UDRP Rules, it is quite probable that the domain holder would lose the right to the domain, in case when the trademark holder submits a complaint, which proves: 1) that the manner in which the domain name(s) is/are

\textsuperscript{112} http://icann.org/udrp/approved-providers.htm.
\textsuperscript{113} http://www.adndrc.org/adndrc/index.html.
\textsuperscript{114} http://www.adrforum.com.
\textsuperscript{115} http://www.wipo.int/amc/en/.
\textsuperscript{116} In the past, service providers were also the CPR Institute for Dispute Resolution [CPR] and eResolution (eRES). CPR acts only upon disputes initiated by January 2007, while eRes by November 2001 (http://www.icann.org/udrp/approved-providers.htm).
\textsuperscript{117} The maintenance of the national top-level domains (ccTLD) is under the authority of a separate Agency of the International Standardization Organization (ISO 3166 Maintenance agency (ISO 3166/MA)), in accordance with the IANA procedures (http://www.iana.org/domains/root/ccTLD/).
identical or confusingly similar to a trademark or service mark in which the Complainant has rights; 2) why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and 3) why the domain name(s) should be considered as having been registered and being used in bad faith (mala fides).

The Respondent (domain-name holder) has to submit a response within twenty (20) days of the date of commencement of the administrative proceeding. In the response, the domain-name holder attempts to prove his/her right and legitimate interest to use the domain. He/she proves that through the existence of one of the following circumstances: 1) before being notified of the proceeding, he/she used or was preparing to use the domain in good-faith (bona fide) to offer goods and services; 2) the domain-name holder is generally known for the domain, although he/she never acquired the right to a trademark; and 3) the domain-name holder uses the domain in good-faith and for non-commercial goals, without intent to make profit or mislead the average consumer or discredit the trademark at stake.

The dispute is decided by one or a panel of three mediators, selected from an international list of experts kept in one of the three organizations that may conduct the proceeding (ADNDRC, NAF or WIPO).

If found by the Panel to be present, the following is considered to be evidence of the registration and use of a domain name in bad faith:

1) circumstances indicating that the domain name has been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or

2) the domain name has been registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that there was an engagement in a pattern of such conduct; or

3) the domain name has primarily been registered for the purpose of disrupting the business of a competitor;

4) by using the domain name, there has been an intentional attempted to attract, for commercial gain, Internet users to the domain owner’s web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the web site or location or of a product or service on the web site or location.

Based on the evidence, the Panel may render one of the following decisions: 1) the registration of the domain to be revoked or deleted; 2) the domain to be transferred from the domain owner to the trademark holder; or 3)
to leave the domain to the domain owner, i.e. to reject the complaint of the trademark holder.

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**Organisational chart of the participants in the proceeding under UDRP (A. Christie).** ¹¹⁸

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**6.8.2.2. Asian Domain Name Dispute Resolution Centre (ADNDRC)**

ADNDRC was approved for dispute resolutions under the UDRP Rules in February 2002. ADNDRC is a joint undertaking of several bodies: the China International Economic and Trade Arbitration Commission (CIETAC)¹¹⁹; the Hong Kong International Arbitration Centre (HKIAC)¹²⁰ and the Korean Internet Address Dispute Resolution Committee (KIDRC)¹²¹.

The ADNDRC has four offices: Beijing, Hong Kong, Seoul and Kuala Lumpur. Each of these offices has supplemental rules to the UDRP ones, which mostly regulate technical and costs issues.

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¹¹⁹ http://www.cietac.org.cn/.


¹²¹ http://www.idrc.or.kr/
3.4. Proceedings before the National Arbitration Forum (NAF)

*NAF* was approved by ICANN for dispute resolutions under the UDRP Rules in 1999. Its headquarters is in Minneapolis, Minnesota, USA. It is considered one of the most effective organizations dealing with Alternative Dispute Resolution. So far, NAF has resolved over 10,000 domain-name disputes and in 2007 it presided over 1,805 domain-name disputes.\(^ {122}\)

3.5. WIPO Arbitration and Mediation Center

Globally, the WIPO Center is the most popular provider organization for domain-name dispute resolution, among other things because of the First and Second WIPO Internet Domain Name Processes, which result in adoption of final reports focusing on the conflict between domain-names and trademarks.

The Center has handled over 8,350 cases, with parties from 127 countries and covering some 16,000 domains since the UDRP went into effect.

Among the more popular cases administered by this Center are the ones involving the domains: bmw.org, nike.net, but also cases connected to celebrity names, like .madonna.com, resolved in favour of Madonna Ciccone.\(^ {123}\)

The WIPO press release from January 2006 (Press Release 435, http://www.wipo.int/edocs/prdocs/en/2006/wipo_pr_2006_435.html), points to a 20% increase in the number of cybersquatting cases filed in 2005, while some 1,500 cybersquatting cases were filed with WIPO’s Arbitration and Mediation Center. Most cases are filed by parties based in the United States of America or Europe (including, increasingly, in Eastern European countries).

According to WIPO’s data from 27 March 2007\(^ {123}\), the number of domain-name disputes in 2007 was constantly increasing, representing an 18% increase over 2006. The graphical chart of the increase of cases is given below.

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\(^ {122}\) http://domains.adrforum.com/newsroom.aspx?itemID=1363

As for the types of domains, .com domains remained the solid leader in terms of the number of domain names included by complainants in cases filed with WIPO, followed by .net, .info, .org, .mobi, .biz, .cat, etc. This tendency is represented in the chart below.

Number of WIPO Domain Name Cases in the period 1999 – 2007
(Source: WIPO)

gTLDs in WIPO Domain Name Cases (Source: WIPO)
The dominating sectors were Biotechnology and Pharmaceuticals, Banking and Finance, and IT.

The graphical representation of disputes as per this criterion is given in the chart below.

Areas of WIPO Domain Name Complainant Activity (Source: WIPO)

3.6. Proceedings before the Czech Arbitration Court

The Czech Arbitration Court was authorized as UDRP service provider in January 2008. This Arbitration Court is based in Prague and is attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic. The Czech Arbitration Court administers ADR Proceedings according to ADR Rules and in line with the Public Policy Rules for .eu domain of the European Commission (EC Regulation 874/2004), as well as its own Supplemental Rules.¹²⁴

¹²⁴ Supplemental ADR Rules of the Arbitration Court attached to the Economic Chamber of the Czech Republic and Agricultural Chamber of the Czech Republic (www.adr.eu).
The following may be conditions for initiating a procedure: existence of a suspicious registration of a domain-name or its abuse; or rendering a decision by the Registrar contrary to Regulation 733/2002.125

Following the receipt of the Complaint, the Arbitration Court notifies the Registry (EURid), in order to identify the domain name that is subject to the dispute. The Registry postpones all actions regarding the domain name (cancellation, transfer, etc.) until a final decision is rendered.

The decision is rendered by a single or 3-member Panel, bearing in mind the effective rules of the Union. The Panel may that the disputed domain name be revoked or in some cases be transferred to another holder, terminated or changed. The decisions are binding for both parties.126

126 Ibid.
V. EXAMPLE FROM THE PRACTICE (L’OREAL)

L’ARRÊT DE LA COUR DE JUSTICE DU 18 JUIN 2009
L’ORÉAL-BELLURE : COMMENT RÉSISTER À LA RANÇON DE LA GLOIRE !

L’encre était à peine sèche, que l’arrêt de la Cour de Justice du 18 juin 2009 (affaire c-487/07) qui opposait des sociétés du groupe français L’Oréal (L’Oréal SA, Lancôme parfums et beauté, Laboratoire Garnier) à des sociétés au Royaume-Uni (Bellure NV, Investiments ltd et Starion International ltd) faisait l’objet de nombreux commentaires, en raison de l’attente que suscitait auprès des spécialistes du droit des marques, la réponse des juges appelés à se prononcer sur l’interprétation de deux directives appelées à se croiser dans la vie des affaires : la directive « marques » et la directive « publicité trompeuse et publicité comparative ».

Les faits de l’espèce étaient les suivants :
La société L’ORÉAL et d’autres sociétés du même groupe (L’Oréal e.a.) sont titulaires au Royaume-Uni de différentes marques renommées, enregistrées pour des parfums et autres produits parfumés.
Certaines marques se rapportant au parfum Trésor :
La marque verbale Trésor
La marque verbale et figurative constituée d’une représentation du flacon de parfum Trésor
La marque verbale et figurative constituée d’une représentation de l’emballage dans lequel ce flacon est commercialisé

D’autres marques se rapportant au parfum Miracle :
La marque verbale Miracle
La marque verbale et figurative constituée d’une représentation du flacon de parfum Miracle
La marque verbale et figurative constituée d’une représentation de l’emballage dans lequel le flacon de parfum Miracle est commercialisé
La marque verbale Anaïs-Anaïs, ainsi que les marques verbales et figuratives constituées du mot « Noa ».

Au Royaume-Uni la société Bellure produit des imitations de parfums fins qui sont commercialisés par Malaika et Starion sous différentes gammes de produits « création Lamis », « Dorail ».

La gamme « création Lamis » comprend, notamment, le parfum La Valeur qui est une imitation du parfum Trésor dont le flacon et l’emballage présentent une ressemblance générale avec ce parfum ; elle comprend, également, le parfum Pink Wonder qui est une imitation du parfum Miracle et dont l’emballage et le flacon présentent une ressemblance générale avec celui-ci.

Il est observé que dans les deux cas la ressemblance entre les flacons et les emballages en cause n’est pas de nature à tromper les professionnels ou le public.

La gamme « Dorail » comprend, pour ce qui la concerne, le parfum coffret d’or qui est une imitation du parfum Trésor, dont le flacon et l’emballage présentent une légère ressemblance avec ceux de ce dernier.

Malaika et Starion, pour commercialiser leurs produits, utilisent des listes comparatives communiquées aux détaillants et qui indiquent la marque verbale du parfum fin (Trésor, Miracle) dont le parfum commercialisé est l’imitation.

L’Oréal e.a. introduisent une action en contrefaçon à l’encontre de Bellure, de Malaika et de Starion (ci-après Bellure e.a.), pour atteinte à leurs droits de marques verbales Trésor et Miracle et pour atteinte à leurs marques verbales et figuratives, flacons et emballages.

La High Court of Justice accueille l’action en contrefaçon fondée sur l’utilisation des listes comparatives nommant les marques verbales Trésor, Miracle, etc. en application de l’article 10§1 de la loi de 1994 sur les marques. En revanche, la High Court a rejeté les prétentions de L’Oréal e.a. selon lesquelles l’imitation des flacons et des emballages de leurs produits portait atteinte à leurs droits sur les marques verbales Trésor et Miracle et sur leurs marques verbales et figuratives Flacon de Trésor, emballage de Trésor, etc. en application de l’article 10§3 de la loi sur les marques.

Bellure e.a. ainsi que L’Oréal e.a., ont formé un recours devant la Court of Appeal.

La Court of Appeal sursoit à statuer et pose à la Cour de Justice cinq questions qui, de fait, peuvent s’ordonner autour des deux volets que suggère la problématique des relations entre le titulaire d’une marque et les tiers, selon qu’il revendique les prérogatives que lui confère le droit de propriété incorporelle sur
le signe ainsi protégé ou qu’il invoque les « opportunités » et, plus exactement, les moyens juridiques supplémentaires qui peuvent lui être offerts lorsque la marque en cause est notoirement connue.

En l’espèce, le litige avait pour théâtre d’opérations l’usage de la marque d’autrui dans la vie des affaires, dans un contexte de publicité pouvant être qualifié de comparative et dont l’acteur principal mis en cause n’était autre que le numéro 1 mondial des produits cosmétiques de parfums, titulaire de marques de renommée planétaire.

Ainsi, s’agissant d’analyser l’arrêt de la Cour de Justice rendu dans cette affaire, convient-il de distinguer entre, d’une part l’usage de la marque d’autrui à des fins de publicité susceptible de porter atteinte au droit exclusif de son titulaire (I) et, d’autre part l’usage de la marque renommée à des fins de publicité, lorsqu’il est de nature à mettre en œuvre le droit national (II).

1. L’usage de la marque d’autrui à des fins de publicité : atteinte au droit exclusif de son titulaire


« la marque enregistrée confère à son titulaire un droit exclusif. Le titulaire est habilité à interdire à tout tiers, en l’absence de son consentement, de faire usage dans la vie des affaires :

a) d’un signe identique à la marque pour des produits ou des services identiques à ceux pour lesquels celle-ci est enregistrée ;

b) d’un signe pour lequel, en raison de son identité ou de sa similitude avec la marque et en raison de l’identité ou de la similitude des produits ou des services couverts par la marque et le signe, il existe, dans l’esprit du public, un risque de confusion qui comprend le risque d’association entre le signe et la marque ».

L’article 6 de la directive vient introduire une limitation aux effets de la marque en déclarant en son paragraphe 1 : « le droit conféré par la marque ne permet pas à son titulaire d’interdire à un tiers l’usage, dans la vie des affaires...

   c) d’indications relatives à l’espèce, à la qualité, à la quantité, à la destination, à la valeur, à la provenance géographique, à l’époque de la production du produit ou de la prestation du service ou à d’autres
caractéristiques de ceux-ci. Ces dispositions légalisent la publicité comparative qui autorise les tiers, dans la vie des affaires, de faire usage de la marque d’autrui pour comparer leurs propres produits ou services avec ceux couverts par ladite marque et sans l’autorisation de son titulaire.

Les quatre premières questions posées à la Cour de Justice portaient sur l’articulation entre le droit exclusif de marque – objet spécifique du droit de propriété incorporelle sur le signe - et la vie des affaires qui, au nom du principe de la libre concurrence, justifie cette limite à l’exercice de ce droit privatif que constitue la publicité comparative.

En l’espèce, les sociétés Bellure, Malaika et Starion en établissant les listes comparatives où figuraient, d’une part leurs marques de produits de parfums et, d’autre part, les marques renommées de produits de parfums de la société L’Oréal e.a. en mentionnant que les premiers avaient « l’odeur » des seconds, ont-elles effectué des actes de publicité comparative et sont-elles justiciables de l’article 5 paragraphe 1 a) ou b) de la directive ?

En répondant par l’affirmative, la Cour de Justice a manifesté la recherche d’un équilibre entre des contraintes qui s’opposent, par une interprétation large de la publicité comparative (A) et une application stricte des droits conférés par la marque (B).

2. Une interprétation large de la publicité comparative

La directive 84/450/CEE du Conseil du 10 septembre 1984, devenue la directive 2006/114 du Parlement européen et du Conseil en matière de publicité trompeuse et de publicité comparative définit la « publicité » comme « toute forme de communication faite dans le cadre d’une activité commerciale, industrielle… dans le but de promouvoir la fourniture de biens ou de services… » (article 2-a) et « la publicité comparative » comme « toute publicité qui, explicitement ou implicitement identifie un concurrent ou des biens ou services offerts par un concurrent » (article 2-c).

Le préambule de la directive, après avoir indiqué que la publicité comparative, quand elle compare des caractéristiques essentielles, pertinentes, véritables et représentatives et qu’elle n’est pas trompeuse, qu’elle peut être un moyen légitime d’informer les consommateurs de leur intérêt, vient préciser qu’il peut être indispensable afin de rendre la publicité comparative effective, d’identifier les produits ou les services d’un concurrent en faisant référence à une marque dont ce dernier est titulaire (considérant 14).

Le considérant 15 de la directive vient, alors, ajouter « une telle utilisation de la marque… ou d’autres signes distinctifs d’autrui n’enfreint pas
ce droit exclusif dans les cas où elle est faite dans le respect des conditions établies par la présente directive, le but visé étant uniquement de les distinguer et, donc, de mettre les différences objectivement en relief ».

On pouvait se demander si les pratiques des sociétés Bellure, Malaika et Starion, consistant à comparer les odeurs de leurs produits de parfum avec celles des produits de parfum de la société L'Oréal e.a pour indiquer qu'ils sont identiques, pouvaient s'analyser comme une publicité comparative, indépendamment de la question de savoir si cette « publicité » était trompeuse ou licite.

La pratique des tableaux dits « de concordance » est ancienne et elle a été sanctionnée à différentes reprises par les tribunaux français, au motif qu’ils constituent « per se » une contrefaçon par reproduction et par l’usage, dès lors qu’ils ont pour objet, pour leurs auteurs, de reproduire la marque d’autrui pour nommer leurs propres produits qui n’ont pas droit à cette marque, puis d’utiliser cette dernière pour commercialiser leurs produits sous leur marque, un numéro par exemple128.

Le législateur français n’a pas repris, formellement, les dispositions de l’article 6-1-b) de la directive 89/104 de 1988 lors de la transposition de celle-ci en droit interne.

L’article L. 713-6 du Code de la propriété intellectuelle relatif aux limites au droit exclusif de marque au profit de son titulaire cite la « référence nécessaire pour indiquer la destination d’un produit ou d’un service… » ; il ne vise pas expressément les autres usages que mentionne l’article 6-1-b) de la directive, tels que les « indications relatives à l’espèce, à la qualité », etc..

Dans ces conditions, la référence par les sociétés Bellure e.a. aux marques de la société L’Oréal e.a. pour indiquer que leurs produits de parfum auraient une odeur identique à celle des produits vendus par cette dernière sous les marques Trésor, etc. ne ferait pas partie du domaine de la publicité comparative et, partant, ne serait pas soumise à l’examen de sa licéité ou de son illicéité, mais relèverait exclusivement des dispositions de l’article L 713-2 du CPI relatif aux droits conférés par l’enregistrement, lequel interdit au paragraphe a) « la reproduction, l’usage… même avec l’adjonction de mots tels que : « formule, façon, système, imitation, genre, méthode », ainsi que l’usage d’une marque reproduite… » sauf à admettre que cet usage de la marque d’autrui n’aurait lieu qu’à titre d’information129 ou pour décrire les caractéristiques du

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produit\textsuperscript{130}, sous réserve que les conditions d’application de ces limites au droit exclusif soient satisfaites\textsuperscript{131}.

Telle n’a pas été l’analyse retenue par la Cour de Justice sollicitée notamment sur l’interprétation de l’article 6-1-b) de la directive sur les marques et par ricochet sur celle de l’article 3-bis de la directive en matière de publicité trompeuse et de publicité comparative (article 4 de la directive 2006) et par voie de conséquence sur l’applicabilité de l’article 5-1 de la directive sur les marques.

Répondant à la première question qui lui était posée, la Cour va considérer que les listes comparatives telles qu’elles ont été formulées par les sociétés Bellure e.a., pouvaient être qualifiées de publicité comparative au sens de l’article 2 point 1 de la directive 84/450 (article 2-a de la directive 2006), dès lors que, conformément à l’article 2-2bis (article 2-c de la directive 2006) constitue une publicité comparative « toute publicité qui explicitement ou implicitement identifie un concurrent » ; et la Cour de citer différents arrêts qu’elle a rendus, consacrant une définition large de la publicité comparative (considérant 52). Par ailleurs, l’utilisation par l’annonceur d’un signe identique ou similaire à la marque d’un concurrent pour identifier les produits ou services de ce dernier s’analyse comme un usage pour les produits ou les services de l’annonceur lui-même (considérant 53).

L’utilisation par un tiers de la marque d’autrui dans la publicité comparative étant analysée comme un usage de celle-ci dans la vie des affaires : cet usage sera légitimé lorsque la publicité comparative sera licite ; inversement, si les conditions de licéité de la publicité comparative ne sont pas réunies, l’usage entrera dans les prévisions de l’article 5 « droits conférés par la marque » de la directive 89/104 (article 5 de la directive « marques » 2008) et il sera justiciable des dispositions du paragraphe 1 – selon le cas le point a) ou le point b) – et, s’il y a lieu, du paragraphe 2 si la marque en cause est une marque renommée.

En l’espèce, la Cour de Justice relève que Malaika et Starion ont utilisé, dans les listes comparatives de parfums les marques verbales Trésor, Miracle, Anaïs-Anaïs, etc. telles qu’enregistrées par L’Oréal e.a. et non des signes seulement similaires à ces marques et pour désigner des produits identiques à ceux pour lesquels lesdites marques ont été enregistrées, à savoir des parfums.

La Cour en tire la conclusion logique :

« un tel usage entre dans le champ d’application de l’article 5§1, sous a) de la directive 89/104 et non dans celui du même article, paragraphe 1 sous b) ».


A contrario, il est permis de considérer que si les marques en cause ne sont pas reproduites à l’identique par le tiers, mais sont similaires en raison de l’existence d’un risque de confusion, pour désigner des produits ou services qui sont identiques, voire similaires, avec ceux visés par le tiers, sous sa propre marque, dans sa liste comparative, le fait de publicité comparative illicite, sera justiciable de l’article 5 paragraphe 1, sous b).

La deuxième question posée à la Cour de Justice avait trait à l’hypothèse où l’on est en présence d’une marque renommée, utilisée dans des listes comparatives, notamment, pour désigner une caractéristique des produits en cause (en particulier l’odeur), alors qu’il n’existe aucun risque de confusion dans l’esprit du consommateur, ni de préjudice d’aucune sorte établi par le titulaire de la marque renommée.

La Cour répondra de la même manière que l’utilisation de la marque renommée dans une publicité comparative jugée illicite, par un tiers, sera éligible de l’article 5 de la directive 89/104 (l’article 5 de la directive 2008) en particulier le paragraphe 1 sous a), lorsque les marques et les produits en cause sont identiques.

Quels enseignements la Cour de Justice délivre-t-elle de l’interprétation de ce texte, dans cette situation juridique où sont en balance, d’une part le droit exclusif de marque et les prérogatives qui y sont attachées au profit de leur titulaire et, d’autre part la libre concurrence qui autorise la publicité comparative dans la vie des affaires ?

3. Une application stricte des droits conférés par la marque

La Cour de Justice était appelée, en définitive, à se prononcer sur les règles de coexistence de deux exigences contradictoires sur la scène de la vie des affaires, à savoir, d’une part le respect d’un monopole –le droit exclusif d’utiliser un signe réservé par un droit de marque- et, d’autre part, la possibilité pour les concurrents d’accéder à l’usage de ce signe pour assurer l’effectivité de la concurrence. Il est rassurant de constater que la Cour de Justice, en posant la séparation de l’examen des conditions de licéité de la publicité comparative et des conditions d’application de l’article 5 de la directive « marques » a fait une application stricte des droits conférés par la marque ; celle-ci a affirmé tout à la fois l’indépendance de la publicité comparative au regard de l’article 5 de la directive « marques » (1er) et l’indifférence des atteintes aux fonctions de la marque (2ème).
3.1, Indépendance de la publicité comparative et de l’article 5 de la directive « marques »

Les troisième et quatrième questions posées à la Cour de Justice avaient précisément pour objet l’interprétation de l’article 3 bis de la directive 84/450 en matière de publicité trompeuse et de publicité comparative (l’article 4 de la directive 2006/114/CE du 12 décembre 2006 codifiée).

Après avoir justifié l’utilité de la publicité comparative, la nécessité de faire référence à une marque d’autrui pour identifier les produits ou services d’un concurrent et indiqué qu’une telle utilisation de la marque n’enfreint pas ce droit exclusif, la directive 84/450 pose à l’article 3 bis, paragraphe 1 (l’article 4 de la directive 2006) les conditions de la licéité de la publicité comparative, lesquelles sont cumulatives (considérant n° 11 de la directive 2006).

Parmi ces conditions, plusieurs d’entre elles concernent les marques en particulier celles figurant aux alinéas g) et h) de l’article 3 bis paragraphe 1 : les alinéas j) et g) de l’article 4 de la directive 2006.

La première condition examinée par la Cour de Justice est celle visée à l’article 3 bis paragraphe 1 sous h) de la directive 84/450 (l’article 4-g) de la directive 2006 « publicité trompeuse et publicité comparative ») qui déclare :

« ... la publicité comparative est licite dès lors que les conditions suivantes sont remplies :

... 

  g) elle ne présente pas un bien ou un service comme une imitation ou une reproduction d’un bien ou d’un service portant une marque ou un nom commercial protégé ». 

La Cour vient préciser que cette condition s’applique « non seulement aux produits de contrefaçon, mais également à toute imitation et reproduction ». Autrement dit, il importe peu que le produit objet de la comparaison soit ou non protégé par un droit de propriété industrielle – brevet ou dessin et modèle – la référence à tout produit, par le truchement de la marque qui identifie ce produit, de la part du tiers, pour comparer ses propres produits avec ceux du titulaire de la marque protégée, est visée par le texte.

Ainsi, la Cour de Justice dissocie, dans la publicité comparative, l’objet de celle-ci à savoir la possibilité, pour un opérateur économique, de promouvoir les produits qu’il offre sur le marché en les comparant par leur identité ou leur similitude avec les produits des concurrents et les instruments juridiques qui permettent la réalisation de cette comparaison, à savoir les signes distinctifs, en particulier les marques qui identifient les produits en cause et, partant, indiquent l’origine de l’entreprise qui met ces produits sur le marché.

132 V. le préambule de la directive 84/450 et les considérants 14 et 15 de la directive 2006.
S’agissant de s’interroger sur la licéité de la publicité comparative, il n’y a pas lieu de vérifier si la comparaison qui est faite des produits eux-mêmes et entre eux, est ou non susceptible d’induire en erreur les personnes auxquelles elle s’adresse, autrement dit si elle est trompeuse ou non. Dans l’affirmative, si la comparaison est susceptible d’affecter le comportement des consommateurs, si elle porte préjudice ou est susceptible de porter préjudice à un concurrent (article 2-b) de la directive 2006), elle constituera un acte de concurrence déloyale sanctionné conformément aux articles 5 et suivants de la directive 2006.

Il en va différemment lorsque la considération porte sur l’utilisation du signe distinctif –la marque d’autrui en l’occurrence- qui rend possible la publicité comparative, puisque le recours au signe permet d’identifier le produit qui sert de référent au concurrent, pour « informer » le consommateur que son produit est « l’imitation » ou la « reproduction » du bien nommé par la marque d’autrui.

C’est, ainsi, qu’il faut « lire » le considérant 74 de l’arrêt du 18 juin 2009 :

« ... il résulte d’une interprétation systématique de l’article 3 bis, paragraphe 1 sous h) de la directive 84/450 que celui-ci ne présuppose ni l’existence d’un caractère trompeur de la publicité comparative, ni celle d’un risque de confusion. En effet, l’absence de tels caractère et risque constitue des conditions indépendantes de licéité de la publicité comparative, énoncée au dit article 3 bis, paragraphe 1, sous a) et d) ».

Ainsi, la règle est clairement établie : c’est la seule présence, dans une publicité comparative de la mention visée à l’article 3 bis, paragraphe 1, sous h) de la directive 84/450 (l’article 4-g) de la directive 2006 « publicité trompeuse et publicité comparative »), à savoir la présentation d’un bien ou d’un service « comme une imitation ou une reproduction d’un bien ou d’un service portant une marque », qui déclenche l’illicéité de la publicité comparative, indépendamment de toute autre considération, rendant de ce fait cette publicité justiciable de l’article 5 de la directive marques.

Le même raisonnement s’applique lorsque la marque utilisée dans la publicité comparative est une marque notoirement connue.

L’article 3 bis sous g) de la directive 84/450 (l’article 4-f) de la directive 2006 « publicité trompeuse et publicité comparative ») dispose que pour être licite, la publicité comparative ne doit pas tirer « indûment profit de la notoriété attachée à une marque… ».

Il était, également, demandé à la Cour de Justice (troisième question) de se prononcer sur le sens de l’expression « tire... indûment profit de », en particulier lorsqu’un commerçant, dans une liste comparative, compare son
produit avec un produit commercialisé sous une marque notoirement connue : dans ce cas tire-t-il indûment profit de la notoriété attachée à cette marque133 ?

La Cour va constater que la notion de « profit indûment tiré » de la notoriété de la marque qui entraîne l’illégalité de la publicité comparative est celle qui figure à l’article 5 paragraphe 2 de la directive « marques » et qu’elle doit, en conséquence, recevoir la même interprétation. C’est, donc, dans le cadre de l’article 5 paragraphe 2 de la directive « marques » rendu applicable en raison de l’illégalité de la publicité comparative, que ce fait sera établi.

La Cour va, d’ailleurs, très opportunément préciser la concordance des agissements répréhensibles, lorsque la publicité comparative est illicite, notamment en raison du non-respect des dispositions de l’article 3 bis paragraphe 1 sous h) et sous g) de la directive 84/450 (article 4-g) et f) de la directive 2006 « publicité trompeuse et publicité comparative ») en déclarant au considérant 79 de l’arrêt : « … une publicité comparative qui présente les produits de l’annonceur comme une imitation d’un produit portant une marque est qualifiée par la directive 84/450 de contraire à une concurrence loyale et donc d’illicite, le profit réalisé par l’annonceur grâce une telle publicité est le fruit d’une concurrence déloyale et doit, par conséquent, être considéré comme indûment tiré de la notoriété attachée à cette marque ». La publicité comparative étant déclarée illicite se pose, alors la question de la mise en œuvre de l’article 5 de la directive « marques » ?

3.2. L’indifférence des atteintes aux fonctions de la marque

Le considérant 13 de la directive 2006 « publicité trompeuse et publicité comparative » vise expressément l’article 5 de la directive 84/104 « marques » (l’article 5 de la directive 2008) pour rappeler les droits exclusifs que confère la marque enregistrée à son titulaire, le considérant 14 prévoit l’exception de publicité comparative, tandis que le considérant 15 vient préciser les limites à cette exception en déclarant : « une telle utilisation de la marque… n’enfreint pas ce droit exclusif dans les cas où elle est faite dans le respect des conditions établies par la présente directive… ». Autrement dit, dès lors que l’exception ne joue plus, c’est l’article 5 qui s’applique dans toute sa rigueur et à l’aune des seules dispositions qu’il édicte pour « instrumentaliser » le droit exclusif du titulaire de la marque, dès lors que l’usage de sa marque par un tiers, a lieu dans la vie des affaires et sans son consentement.

133 Sur cette question et la notion de profit « tiré indûment de la notoriété attachée à une marque : v. infra, 2ème partie.
Aussi, le retour au droit commun en la matière, du fait de l’illicéité de la publicité comparative et, donc, de l’exclusion de l’exception, conduit à vérifier, selon le cas d’espèce, quelles sont les dispositions de l’article 5 qui sont applicables.

En premier lieu, la Cour de Justice constate que l’usage des marques dont est titulaire la société L’Oréal e.a. par les sociétés Bellure e.a., a lieu dans la vie des affaires et que l’exception de publicité comparative étant écartée, cet usage n’entre pas dans les prévisions de l’article 6-b) de la directive 2008 « marques » relatif aux limitations des effets de la marque. En effet, les sociétés Bellure e.a. n’utilisent pas les marques de la société L’Oréal e.a. à des fins purement descriptives, mais publicitaires et qui le demeurent, quand bien même l’exception de publicité comparative se trouverait écartée pour illicéité (considérants 61 et 62 de l’arrêt).

En second lieu, la Cour de Justice constate que les sociétés Bellure e.a. ont reproduit et utilisé les marques Trésor, Miracle, etc. de la société L’Oréal e.a. à l’identique et pour désigner des produits identiques : des parfums ; elle en conclut que l’article 5 paragraphe 1, sous a) de la directive 89/104 est applicable (considérant 65 de l’Arrêt).

Pour motiver sa décision, la Cour relève que la protection conférée à l’article 5 paragraphe 1, sous a) de la directive est plus étendue que celle prévue au même article 5 paragraphe 1, sous b) dont la mise en œuvre exige l’existence d’un risque de confusion, dès lors que les signes en présence et/ou les produits ne sont pas identiques, mais similaires.

La Cour vient, alors, préciser (considérant 58 de l’Arrêt) que « le droit exclusif prévu à l’article 5, paragraphe 1, sous a) de la directive a été octroyé afin de permettre au titulaire de la marque de protéger ses intérêts spécifiques en tant que titulaire de cette marque, c’est-à-dire d’assurer que cette dernière puisse remplir ses fonctions propres et que, dès lors, l’exercice de ce droit doit être réservé aux cas dans lesquels l’usage du signe par un tiers porte atteinte ou est susceptible de porter atteinte aux fonctions de la marque…. Parmi ces fonctions figurent non seulement la fonction essentielle de la marque qui est de garantir aux consommateurs la provenance du produit ou du service, mais également les autres fonctions de celle-ci, comme notamment celle consistant à garantir la qualité de ce produit ou de ce service, ou celles de communication, d’investissement ou de publicité ».

Et la Cour de conclure, considérant 65 de l’Arrêt :
« … il convient de répondre… que l’article 5, paragraphe 1, sous a)… doit être interprété en ce sens que le titulaire d’une marque enregistrée est habilité à faire interdire l’usage par un tiers, dans une publicité comparative qui ne satisfait pas à toutes les conditions de licéité…. d’un signe identique à cette marque pour des produits ou des services identiques à ceux pour lesquels ladite marque a été enregistrée, même lorsque cet usage n’est pas susceptible de porter atteinte à la fonction essentielle de la marque, qui est d’indiquer la
provenance des produits ou services, à condition que ledit usage porte atteinte ou soit susceptible de porter atteinte à l’une des autres fonctions de la marque ».

On ne peut qu’approuver sans réserve la décision rendue consistant à appliquer de manière stricte les dispositions de l’article 5, paragraphe 1, sous a) de la directive 89/104, dès lors que, l’exception de publicité comparative ayant été écartée pour illicéité, l’atteinte au droit exclusif de marque ne pouvait être appréhendée qu’à partir des seules prescriptions que ce texte édicté.

Toutefois, la distinction opérée par les juges entre la fonction essentielle de la marque –indiquer la provenance des produits ou services– et d’autres fonctions de la marque, telles que garantir la qualité du produit ou du service, la garantie de communication, d’investissement ou de publicité, laisse la place à une certaine perplexité… vient, en effet, à l’esprit l’adage « ubi lex non distinguit nec nos distinguere debemus ».

Il nous semble, en effet, que ces nouvelles fonctions assignées à la marque, qui conduisent à assimiler les fonctions commerciales de celle-ci à sa fonction juridique, conduisent à introduire un élément d’incertitude, voire de flou juridique dans la mise en œuvre de l’article 5, paragraphe 1 de la directive en raison précisément de la distinction opérée par la « lex » -en l’occurrence la directive- entre l’alinéa a) et l’alinéa b).

La fonction juridique de la marque, telle qu’elle est précisée à l’article 2 de la directive et à l’article L 711-1 du CPI demeure de « distinguer les produits ou les services d’une entreprise de ceux d’autres entreprises134. Cette fonction, lorsqu’elle existe, a pour corollaire, selon la formule devenue célèbre du considérant 14 de la directive 2008 « notamment de garantir la fonction d’origine de la marque ». La fonction de garantie d’origine de la marque signifie que le consommateur ou l’utilisateur du produit marqué bénéficie de la sécurité juridique selon laquelle c’est bien l’entreprise titulaire de la marque qui a mis le produit sur le marché ou un tiers avec son consentement.

La directive distingue ensuite l’hypothèse où il y a identité entre marque et signe et entre produits ou services, de celle où il y a seulement similitude et dans ce dernier cas la protection conférée par la marque enregistrée supposera l’existence d’un risque de confusion.

Cette distinction est reprise par l’article 5, paragraphe 1, sous a) et sous b) de la directive.

Autrement dit, s’agissant d’appliquer l’article 5, paragraphe 1, sous a), la protection de la marque étant absolue, il n’y a pas lieu de s’interroger sur l’existence ou non d’un risque de confusion dans l’esprit du consommateur sur la provenance des produits. L’article 5, paragraphe 1, sous a) de la directive ne fait référence ni explicitement, ni implicitement à un quelconque risque de confusion.

Par conséquent, ce texte s’applique, dès lors que les conditions de sa mise en œuvre sont réunies, à savoir l’usage dans la vie des affaires, en l’absence du consentement du titulaire de celle-ci, d’un signe identique à la marque d’autrui pour des produits ou services identiques à ceux pour lesquels celle-ci est enregistrée. Tel était le cas dans cette espèce où les sociétés Bellure e.a. ont utilisé les marques de la société L’Oréal e.a. à l’identique, pour désigner des produits identiques et, ici, la circonstance selon laquelle le consommateur n’est pas victime d’un risque de confusion, car il sait que les produits de parfum mis en cause, n’ont pas pour origine ou provenance la même entreprise, est indifférente : en effet, l’article 5§1 sous a) de la directive « marques » a vocation à s’appliquer pour sanctionner toute atteinte au droit de marque en cas d’identité des signes et des produits et/ou services, précisément lorsque le risque de confusion n’existe pas dans l’esprit du consommateur en raison notamment de la renommée de la marque.

Dans le contraire, on aboutirait à une situation absurde où le titulaire d’une marque renommée ou notoire serait moins bien protégé que le titulaire d’une marque ordinaire, car précisément en raison même de la notoriété de la marque, le public sait que le produit mis sur le marché par un tiers qui fait référence à celle-ci pour désigner des produits ou services identiques, n’a pas la même origine.

L’article 5, paragraphe 1, sous a) étant applicable du fait de l’exclusion de l’exception de publicité comparative, la fonction d’indication de provenance des produits de parfum n’étant pas remise en cause, la mise en évidence par la Cour de Justice, d’autres fonctions de la marque, pour vérifier s’il leur a été porté atteinte, nous semble superfétatoire.

En revanche, il en irait différemment pour l’application de l’article 5, paragraphe 1, sous b) de la directive où l’atteinte au droit de marques suppose l’existence d’un risque de confusion. Ici, les fonctions commerciales de la marque (communication, investissement, publicité) y compris la fonction de garantie de qualité qui, en tout état de cause, ne saurait être une garantie juridique – cette dernière n’étant pas inhérente au droit de marque – seront des instruments précieux pour le titulaire de la marque en charge de rapporter la preuve d’un risque de confusion et, donc, la similitude entre les signes en cause et, s’il y a lieu, entre les produits ou les services qu’ils désignent.

3.3 L’usage de la marque de renommée à des fins de publicité en l’absence de risque de confusion

Une cinquième question était posée à la Cour de Justice qui concernait l’interprétation de l’article 5, paragraphe 2 de la directive 89/104 (article 5, paragraphe 2 de la directive 2008).
L’hypothèse envisagée est celle où un commerçant fait usage d’un signe similaire à une marque enregistrée qui jouit d’une renommée et que ce signe ne ressemble pas à la marque au point de provoquer une confusion, alors que la fonction essentielle de la marque enregistrée n’est pas altérée ni menacée, qu’il n’y a pas ternissement ni de confusion concernant la marque enregistrée ou sa renommée, que cela n’affecte pas les ventes du titulaire de la marque, enfin que ce dernier n’est privé d’aucuns des bénéfices tirés à la promotion ou au développement de sa marque. Toutefois, le commerçant tire un avantage commercial de l’usage de son signe en raison de sa similitude avec la marque enregistrée.

La question posée est, alors, de savoir si un tel usage revient à tirer « indûment profit » de la notoriété attachée à la marque enregistrée au sens de l’article 5, paragraphe 2 de la directive ?

La question de portée générale visait, également, le litige opposant la société L’Oréal et al. aux sociétés Bellure et al. dans la mesure où ces dernières utilisaient, également, pour commercialiser leurs gammes de produits, en même temps que leurs listes comparatives telles que décrites, des flacons et des emballages présentant une ressemblance générale avec ceux du parfum Trésor de la société L’Oréal et al. .

Il convient de rappeler que l’article 5 paragraphe 2 de la directive renvoie au législateur national pour sanctionner les atteintes susceptibles d’être portées aux marques renommées, commises à l’extérieur de la sphère de protection qu’elle édicte à l’article 5, paragraphe 1 et qui se situent au-delà des droits conférés par les marques, lesquels demeurent soumis à la règle de la spécialité.

Ainsi, la directive invite-t-elle les États membres à légiférer, selon leur droit interne, pour interdire à tout tiers, en l’absence du consentement du titulaire de la marque, « de faire usage dans la vie des affaires d’un signe identique ou comparable à la marque, pour des produits ou des services qui ne sont pas comparables à ceux pour lesquels la marque est enregistrée, lorsque celle-ci jouit d’une renommée dans l’État membre ».

Le législateur français, lors de la transposition de la directive 89/104 a choisi d’utiliser l’option offerte par l’article 5, paragraphe 2 de la directive, en introduisant un régime particulier de responsabilité civile qui figure désormais à l’article L. 713-5 du CPI.

L’article 5, paragraphe 2 de la directive « encadre l’intervention du droit national dans deux paramètres :
- L’usage du signe par le tiers doit être sans juste motif,
- le tiers qui fait usage du signe doit tirer indûment profit du caractère distinctif ou de la renommée de la marque ou leur porter préjudice (voir le considérant 34 de l’arrêt et la jurisprudence citée).

Bien que le texte de l’article 5, paragraphe 2 ne vise que l’usage de la marque renommée par un tiers, pour désigner des produits différents, la Cour de
Justice eu l’occasion de préciser que ce texte pouvait parallèlement s’appliquer à l’hypothèse où, les produits ou services en cause étant identiques ou similaires, le signe litigieux et la marque renommée n’étaient pas similaires en raison de l’absence de risque de confusion, mais suffisamment proches pour qu’un lien, une association se réalise, dans l’esprit du consommateur, entre le premier et la seconde (voir considérant 35, la jurisprudence citée).

S’agissant du litige opposant la société L’Oréal e.a. aux sociétés Bellure e.a., la Cour de Justice est venue préciser les règles d’application de l’article 5, paragraphe 2.

La Cour constate l’existence d’un lien entre certains conditionnements utilisés par les sociétés Bellure e.a. et certaines marques se rapportant à des emballages et des flacons dont sont titulaires L’Oréal e.a. ; ce lien constitue un avantage commercial pour les sociétés Malika et Starion qui ont délibérément recherché la similitude entre les marques dont est titulaire la société L’Oréal et les produits commercialisés par ces dernières, afin de créer une association dans l’esprit du public entre les parfums fins et leurs imitations.

En l’absence de préjudice révélé, soit sur le caractère distinctif des marques de la société L’Oréal, soit sur leur renommée, la question était, alors, de savoir si la seule constatation d’un profit indûment tiré du caractère distinctif ou de la renommée de la marque était suffisante pour déclencher la mise en œuvre de l’article 5, paragraphe 2 de la directive.

La Cour rappelle qu’un seul des trois types d’atteintes suffit pour que l’article 5, paragraphe 2 soit applicable (voir le considérant 42 et la référence à l’arrêt Intel corporation, C-252/07).

Pour constater l’existence d’un profit indûment tiré du caractère distinctif ou de la marque, il faut tenir compte du fait que l’usage des emballages et des flacons similaires à ceux des parfums imités a pour but de profiter, à des fins publicitaires, du caractère distinctif et de la renommée des marques sous lesquelles ces parfums sont commercialisés (considérant 48 de l’arrêt).

Et la Cour de conclure que l’article 5, paragraphe 2 doit être interprété en ce sens que l’existence d’un profit indûment tiré du caractère distinctif ou de la renommée de la marque, ne présuppose ni l’existence d’un risque de confusion, ni celle d’un risque de préjudice porté à ces caractères distinctif ou renommée ou, plus généralement, au titulaire de celle-ci.

Le profit, pour un tiers, résultant de l’usage d’un signe similaire à une marque renommée, est tiré indûment par celui-ci desdits caractères distinctif ou renommée, lorsque cet usage est destiné à lui permettre de bénéficier du pouvoir d’attraction, de la réputation et du prestige de cette dernière et d’exploiter, sans compensation financière, l’effort commercial déployé par le titulaire de la marque pour créer et entretenir l’image de celle-ci (considérant 50 de l’Arrêt).

C’est bien de parasitisme qu’il s’agit, tel qu’il est visé par l’article 3 bis, paragraphe 1, sous g de la directive 84/450 (l’article 4-f) de la directive 2006 « publicité trompeuse et publicité comparative ») entrainant l’illicéité de la
publicité comparative au sein de laquelle il se développe et, par voie de conséquence, la mise en œuvre de l’article 5, paragraphe 2 de la directive 2008 « marques », selon les dispositions prévues par le droit national, en France la responsabilité civile, telle qu’elle a été introduite à l’article L. 713-5 du CPI.
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VI. GEOGRAPHICAL INDICATIONS IN COMPARATIVE
AND MACEDONIAN LEGISLATION

1. Introduction

1.1 Concept and Meaning

The geographical indications are a special type of right to industrial property. The protection of the geographical indications is done in order to mark specific products which originate from a specific geographical area, and special conditions have been foreseen for their acquisition and usage. The regulatory rules have been foreseen in both domestic and international sources.

The geographical indications have not only legal meaning as a special type of right to industrial property, which differs from the other rights to industrial property, but they also have a huge economic meaning. It remains a fact that the market may be conquered with quality of the products and the perseverance of the said quality. The protection of the geographical indications has a role of pointing out to the consumer that the products marked by certain geographical indications have special characteristics and quality. This makes the geographical indications a guarantee for quality, which means that they have a supplementary guarantee function.

The use of the protected geographical indications for marking the products that originate from a certain area also propagate and advertise the product, point to the special attributes of the product, as a result of the natural conditions and the traditional knowledge of the producers in that area.

The transition countries, one of which is also the Republic of Macedonia, hold a special interest in the geographical indications. This is because the specific products that our country has in abundance, as a result of the natural conditions and the traditional knowledge of the people, marked with protected geographical indications may become competitive not only on the domestic, but also on the foreign markets.

Also, a procedure is being specified for acquiring the protected geographical indications, which goes along with the legal safety and the rule of law, as fundamental principles towards which the Republic of Macedonia is striving.
1.2 Historical Development

The historical data witness about the marking of the products that were recognized due to their place of origin, which means the natural conditions of the place they originate from, by emphasizing the country of origin, the specific geographical area, region, town or village.

The wines of Corinth, the honey from Sicily, the marbles of Paros and Carrara have been known since ancient times. Since the products from these areas also bear a function of quality, there was a danger even then to be usurped, imitated and falsified. In order to distinguish these products that came from specific areas, and which were particularly famous for the traditional knowledge of the people from that region, craftsmen and producers created signs which guaranteed that the product originated from a specific area and thus had apposite quality.

Among other examples for protection in France, passing a separate law on the agricultural products in 1905 is quite distinctive, as well as the organization of the wine areas in 1911\(^{135}\). The further advancement of the protection in this country entailed defining of the authorities in 1919, as well as passing a law on marking cow cheese in 1925\(^{136}\).

1.3 International Sources and Terminology Regarding the Geographical Indications

The protection of products for which the origin represents a special guarantee for quality is done by international and domestic sources, and they are characterized by constant changes.

The oldest international source for industrial property, the Paris Convention from 1883, equals the marking of the products with the brands. Later, under the influence of the French national legislation, where the reinforced wine production ascended, it came to separation of the product marks and the brands: indication of source (indication de provenance) and appellation of origin (appellations d’origine).

As a result of this activity, at the conference in Hague in 1925, the first article of the Paris Convention was amended by supplementing the words “…indication of source or appellation of origin”, which implies that the two terms

\(^{135}\text{Л. Варга, Компаративен приказ на заштитата на географските називи на производите во поедини земји и нивни искуства, Семинар: Защитата на географските називи на производите со ознаки на потеклото на производите како право од индустриска сопственост, Стопанска комора на Македонија, Завод за заштита на индустриска сопственост, Скопје, 1 март, 1995 година, стр. 27-39.}\)

\(^{136}\text{Ibid.}\)
are synonymous, although they are not. In the third paragraph of the aforementioned article, an explanation is given for processing agricultural products, such as wines, grain, tobacco, leaf, cattle, minerals, mineral waters, beers, flowers, flour, etc.

The historical course of the legal regulation of the geographical indications notes that the two terms “indication of source” and “appellation of origin” are used as synonyms, which is why at the Lisbon Conference in 1958 a proposal was given to substitute “or” with “and”, but this proposal was not adopted.

It is not disputable that there are no direct provisions in the Paris Convention regarding the protection of the geographical indications, except for the indirect implication of Article 10(1), in reference to Article 9, about the protection from direct or indirect use of false indication of the source of the goods. Nevertheless, the principle of assimilation, the unionist treatment and the principle of minimum protection also relate to the geographical indications.

A broader protection of the geographical indications is given in the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods from 1891 and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration from 1958. The Republic of Macedonia has not ratified these two agreements, but with the accession to the WTO and the TRIPS Agreement, its ratification should be considered. Anyhow, the TRIPS Agreement norms the basic principles which the countries should abide by, in order to avoid false use of the geographical indications. The TRIPS Agreement provides directions in terms of the conflict between the geographical indication and the trademark, leaving however, to the national legislations to regulate the protection of the geographical indications. Articles 22, 23 and 24 are among the most significant provisions of TRIPS.

Some authors (Sappa) give a graphical representation of the relationship of the international sources, relevant for the geographical indications. (Chart 1)137

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137 C. Sappa, Geographical Indications: Strategic Use and Economic Value in the Wines and Spirits Sector, Strategic Use of IPRs for Economic and Social Development, Ohrid, May 21st 2007.
The fact remains that there is no generally adopted terminology for the geographical indications in the comparative law of industrial property. The reason for this lies both in the specificity of the evolution of this law in national legislations\textsuperscript{138} and the different terminology in the international instruments.

In literature today, there is domination of the above mentioned terms:\textsuperscript{139} ‘Indication of Source’ – an indication that the product comes from a specific geographical region; ‘Appellation of Origin’ – a certification that the product originates from a certain geographical region, only when the specific product quality is due to the geographical area, including the natural and human factors; and “Geographical Indication” – which involves both concepts\textsuperscript{140}.

Lately, at the Secretariat of the World Intellectual Property Organization (WIPO) the term "indications of geographical origin" is in use, in order to encompass all the different expressions used by the members of the World Trade Organization\textsuperscript{141}.

\textsuperscript{138} M. Blakeney, Geographical Indications and Trade, Queen Mary Intellectual Property Research Institute, Queen Mary and Westfield College, University of London, London.


\textsuperscript{140} M. Blakeney, Geographical Indications and Trade, Queen Mary Intellectual Property Research Institute, Queen Mary and Westfield College, University of London, London.

\textsuperscript{141} Note by the WTO Secretariat IP/C/W/253, dated April 2001, on “Review under Article 24.2 of the
Despite the terminological differences, the observation remains that the presence of the protected geographical names depends upon the country where there are regions with popular products.

France is pointed out as a positive example, where due to the wine and dairy production, and especially cheese, but also agricultural products in general, a special institute has been established within the Ministry of Agriculture and Fisheries, known as “National Institute for Origin and Quality” (L’Institut national de l’origine et de la qualité-INAO).142

2. Goal and Function of the Geographical Indications

As a method for marking the origin of the goods and services, the indication of the product’s origin and the geographical indication enable promotion of specific products with special characteristics and quality in commerce, through informing the consumer. Furthermore, they could be perceived as industrial property rights that enable linking of culture and production. The indication of the product’s origin and the geographical indication represent a strong instrument for promotion of traditional products, such as food, wine, handicrafts, etc.

From the aspect of the consumers’ behaviour, it is believed that geographical indications have double manifestation: they represent a reflection of the consumers’ interest for a particular “regional” product, but also an affiliation with the quality of the product. From macroeconomic aspect, however, geographic indications are often viewed as a tool for facilitating the development of rural areas. There are multiple experiences in this field in the agricultural and wine tourism.

Apart from the economic function, geographical indications also have a cultural function, which is linked to the provision from Article 4 (4) of the UNESCO Convention on the Protection and Promotion of the Diversity of Cultural Expressions. According to the Convention, “… cultural activities, goods and services refers to those activities, goods and services which at the time they are considered as a specific attribute, use or purpose, embody or convey cultural expressions, irrespective of the commercial value they may have. Cultural activities may be an end in themselves, or they may contribute to the production of cultural goods and services.”143

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There are widely known examples of geographical indications throughout the world, such as: Champagne, Cognac, Roquefort, Parmigiano, Porto, Havana, Tequila, etc.

In recent years, the interest for this category of rights to industrial property also results in concrete steps in the field of organized approach of the producers through promotion of the protection in practice. This is the case, for example, with the organization “OriGi n”, established in 2003, which represents an umbrella organization for over 80 associations of producers, with over 2 million protected geographical indications.  

3. Geographical indications in the EU Legislation

Under the influence of the French legislation and practice, the protection of the geographical indications in the European Union is performed on the basis of special products.

In the European legislation, the following Regulations are relevant for the geographical indications: 1576/89 on the general rules on the definition, description and presentation of spirit drinks; 2392/89 on the general rules for the description and presentation of wines and grape musts; 2081/92 on the protection of Geographical indications and designations of origin for agricultural products and foodstuffs; 510/2006 on agricultural products and foodstuffs. These regulations norm the extent of the protection, as well as the procedure thereof.

The last regulation, which is entirely compatible with the World Trade Organization, covers four groups of products: agricultural, foodstuffs and other agricultural products. (Table 1)

The practice of the European Court of Justice (ECJ) is also significant, especially in regard to the following cases: Prosciutto di Parma, Gorgonzola, Feta Cheese, Tokaj/Tocai, Parmigiano, Budweiser and others.

144 E. Olivas, Perspectives for Geographical Indications, WIPO International Symposium on GIs, Beijing, China, June 2007.
146 R. Serra : Geographical Indications: A Success Story of European Agriculture, International Symposium on Geographical Indications, Beijing, 2007
148 European Court reports 1999 Page I-01301, Case C-87/97.
149 R. Serra: Geographical Indications: A Success Story of European Agriculture, International Symposium on Geographical Indications, Beijing, 2007
150 Official Journal of the European Union 2006/C; 86/01.
Type of products:

<table>
<thead>
<tr>
<th>Agricultural products</th>
<th>Foodstuffs</th>
</tr>
</thead>
<tbody>
<tr>
<td>Hay</td>
<td>Beer</td>
</tr>
<tr>
<td>Essential oils</td>
<td>Beverages from plant extracts</td>
</tr>
<tr>
<td>Cork</td>
<td>Bread, pastry, cakes, confectionery and other baker’s wares</td>
</tr>
<tr>
<td>“Cochineal” (raw product of animal origin)</td>
<td>Mustard paste</td>
</tr>
<tr>
<td>Flowers and ornamental plants</td>
<td>Pasta</td>
</tr>
<tr>
<td>Wool</td>
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</tr>
<tr>
<td>Wicker</td>
<td></td>
</tr>
<tr>
<td>Scutched flex</td>
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</tr>
</tbody>
</table>

Table 1. Products covered by Regulation 510/2006

The European normative framework for geographical indications is a result of their broad application in practice. This particularly refers to France, Portugal and Italy, where we may notice the highest presence degree of the indication of origin and the geographical indication. (Chart 2).

The economic effect in these three countries is mostly visible in terms of the use of geographical indications. For example, in 2003, 85% of the wines exported from France had geographical indications, and geographical indications mean life for as many as 138,000 farms in France and over 300,000 employees in Italy.153

The new Union members have also started using the registration system, in accordance with the Regulation. So, the following have already been registered as European geographic indications: Bulgarian Yogurt and Han Krum Traminer wine.154

154 M. Blakeney, Geographical Indications After Doha, 2006.
In terms of the distribution of geographical indications by products, it is noticeable that the largest number goes to the Protected Designation of Origin (PDO) for cheeses and olive oil, while from the Geographical Indication (GI) to fruit and meat (Chart 3).\textsuperscript{155}

\begin{table}[h]
\centering
\begin{tabular}{|c|c|c|c|c|c|c|c|}
\hline
 & Meat & Meat products & Cheeses & Olives & Fruit & Other & Total \\
\hline
PDO & 22 & 25 & 144 & 89 & 75 & 74 & 429 \\
PGI & 81 & 61 & 12 & 14 & 95 & 36 & 317 \\
\hline
\end{tabular}
\caption{Distribution of PDOs and GIs in the EU, until May 2007 (Source: European Commission)}
\end{table}

\textsuperscript{155} R. Serra: Geographical Indications: A Success Story of European Agriculture, \textit{International Symposium on Geographical Indications, Beijing, 2007.}
4. Provisions for the "Geographical Names" (Appellations of Origin and the Geographical Indications) in the Macedonian Legislation

Currently, the Macedonian legislation uses the term "geographical names", that enhances the 1) appellations of origin and 2) the geographical indications. Their function is to protect the products produced by physical or legal persons in a certain region (IPL, Article 183).

In the Industrial Property Law from 1993\textsuperscript{156}, the Macedonian legislaton stipulated the appellation of origin, which is considered as a higher type of protection.

In the Industrial Property Law (hereinafter: IPL)\textsuperscript{157} from 2002, apart from the appellation of origin, a new, so called "lower protection" has also been introduced through a new instituted– geographical indication, adopted under the influence of the legal terminology of the European Union.

4.1. Conditions for Protection of "Geographical Names"

A broad range of products from a certain country, region or place may be designated with the "geographical names". They may be natural products (marble, granite, jewels), agricultural (grapes, coffee, beans, lentils, olives, rice, fresh meat); industrial (wine, beer, cheese, meat products); artisanship (water jugs, baking dishes); handicrafts (embroideries, lace), etc. Furthermore, the traditional names may be protected with the "geographical names", i.e. appellation of origin or geographical indication (for example, Kochani rice).

In accordance with IPL (Article 190), an appellation of origin or a geographical indication may not be used to protect a "geographical name" that has become generic over the long time in use, or commonly known for designating a certain type of product (for ex.: fayans, ceramic, Persian carpet). As exceptions from the protection of "geographical names", IPL also lists the names of places: which lead to confusion about the origin, quality, the way of production or other product qualities; which is equal to the name of a plant or animal kind, if leads to confusion regarding the origin; and which is identical to a trademark, when there is a probability for delusion (Article 189). In reference to the homonyms, according to IPL (Article 191), all homonyms are protected by the principle of: equality of the producers on the market; accurate information of the consumers and under the condition that the public is not lead into delusion regarding the true origin.

\textsuperscript{156} Official Gazette of RM, no. 42/93
4.2. Appellation of Origin

Pursuant to IPL, the product marked with an appellation of origin needs to fulfil several conditions: to originate from the particular region; the quality and the necessary characteristics to be exclusively or predominantly conditioned by the geographical area, including the human factor; the production, processing and preparation to take place in a particular geographical area. 

As per the raw materials, they may come from another area, but only if the region for production of raw materials is limited and if there are special conditions for production of the raw materials.

Hence, in the case of the appelation of origin, apart from the geographical, the traditional way of production and the human factor are also decisive for the quality and the special characteristics of the product.

This definition regarding the appellation of origin in IPL is entirely compatible with the EU regulations, as well as with the Lisbon Agreement, except that there is no special emphasis in IPL that the use of the name of the country is possible in exceptional cases, and not as a rule.158

4.3. Geographical Indication

A product may be marked with a geographical indication only if: the quality, reputation or other characteristics may essentially be ascribed to the geographical origin, or if the production and/or the processing and/or the preparation take place in a specific geographical area.

As the geographical indication in the Macedonian legislation is considered as a relatively lower form of a designation, the "geographical names" that do not fulfill the conditions for an appellation of origin may be protected as geographical indication.

4.3.1. Geographical Indication in the Wine Industry in the Republic of Macedonia

A relevant source regarding the geographical indication of wines in the Republic of Macedonia is the Law on Wine159, or more precisely the provisions in Chapter VI (Wines marked with Geographical Indication), i.e. Articles 28,

159 Official Gazette of RM, no. 69/2004
29, 30, 31 and 32. Pursuant to these articles, the classification of wines in Macedonia entails regional, high quality and superb wines. Practically, this represents a link with TRIPS, and with Article 4, Annex 2 of the Additional Protocol to the Stabilisation and Association Agreement between the European Communities and their Member States and the Republic of Macedonia.

Among the more significant provisions of the Law is the one prescribing that for more effective protection of the geographical origin of the wine, the wine regions are classified as follows: Povardarie, Pchinja – Osogovo and Pelagonia – Polog regions. As per the geographical indication, the provision stipulating that the name of a certain geographical area may not be used for the wines not produced in that particular area is considered as quite important.

4.4. Procedures for Protection of the Appellation of Origin and the Geographical Indication According to IPL

According to IPL (Article 193), the procedure for the protection of the appellation of origin and the geographical indication begins with submitting applications by: natural or legal persons – producers; associations of producers; state body; local government unit; or a chamber.

It is precisely defined what the application needs to contain (Article 197). In the case of the appellation of origin, it is the following elements: an Application – a prescribed form and an Elaboration prepared by an authorized institution.

In the case the geographical indication, one would need an Application – a prescribed form, as well as a Specification prepared by the applicant.

The acquisition of the right of an appellation of origin or geographical indication transpires by passing a decision on the protection of the indication and enlistment in the registry (Article 200).

It is quite distinctive in terms of the other industrial property rights that the protection is unlimited, while the right is collective, meaning that it may be used by all producers in the particular region, who fulfil the conditions for marking with the respective indication.

The application for the right to use needs to contain the following: an Application – a prescribed form; a proof for doing business – needs to be connected to the production of the product to which the protection applies; as well as a proof for an inspection undertaken (for the appellation of origin) and in the case of the geographical indication – only for wines and spirits. If another type of geographical indication is at stake, instead of a proof for inspection undertaken, a statement by the applicant is submitted. (Article 203)

The right is acquired by passing a decision and enlistment in the registry, it lasts 5 years from the day of passing the decision and it may be
extended unlimited number of times, provided that all prerequisites are met.
(Article 201)

The beneficiary of the appellation of origin or the geographical indication has the following rights: to use it for marking only the protected product; to also use it for packaging means; business materials; propaganda (Article 212).

The right to use may not be transferred, deviated or pawned (Article 213). The beneficiary may ask for an injunction for the following: direct or indirect unauthorized use; use for a product from another region; using it in a way that is harmful for the reputation or abuses the same; using untruthful information that lead to delusion regarding the origin (Article 214).

The decision for acknowledging the right to use may be revoked if the conditions for acknowledging the right to use have ceased to exist (Article 217).

5. The Relationship of the Geographical Indications and the Trademark

There are undisputable similarities between the geographical indications and the trademark, which manifest in the field of the economic function. The function of the trademark is to enable distinction of the product or service of one entity from the competitors’ products or services. Similar to the trademark, the geographical indications also highlight certain specifics of the product, as a result of their particular regional origin.

The same as trademarks, geographical indications also produce values, simply because the consumers are ready to pay a higher price, which derives from the association of the product with a particular geographical location.160

However, unlike trademarks, which are tied to an individual producer, geographical indications have a broader circle of carriers. Thus, the names Bordeaux and Champagne may be used by all wine producers in the regions of Bordeaux and Champagne.

Also, unlike the trademark, which is a creation of the producer, the geographical indication, as a toponymy, is self-imposed, i.e. it already exists as a category.

The difference may somewhat be relative in view of the collective and certification marks, especially since there are examples in history when geographical indications have been protected by a certification mark.161

160 P. Kole, Geographical Indications: Creating Value through Connecting Products with Geographical Origin, WIPO International Symposium on GIs, June 2007, Beijing, China.
161 This is the case with Australia, in the period up to the negotiations of Australia with the EU regarding the wine trade (Л. Варга, Компаративен приказ на защитата на географските називи на производите во поедини земји и нивни искуства, Семинар: Защитата на географските називи на производите со ознаки на потеклото на производите како право од

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However, there are fundamental differences between the collective and certification marks and the geographical indications in terms of the protection source. In contrast to the geographical indications, which are available to all producers who meet the legally prescribed conditions, the acquisition of the right to a collective or certification mark derives from the joint act of the producers, i.e. a separate act.

Bearing in mind these moments, Sylvander’s table showing the differences and similarities between trademarks and appellations of origin or geographical indications, according to different criteria, is quite acceptable: (Table 2)\textsuperscript{162}

<table>
<thead>
<tr>
<th>Characteristics</th>
<th>Trademark</th>
<th>Appellation of origin / Geographical indication</th>
</tr>
</thead>
<tbody>
<tr>
<td>Distinctive sign</td>
<td>Creation: fancy/new name. TM is distinctive</td>
<td>Determined by the already existing geographical and human know-how</td>
</tr>
<tr>
<td>Quality</td>
<td>No necessary link to quality, unless search of reputation</td>
<td>Identifier guaranteed by the State, quality linked with origin</td>
</tr>
<tr>
<td>Ownership</td>
<td>Owner (individual or collective in the Certification TM case) Transfer is possible (in certain limits for Certification TM)</td>
<td>Public ownership Unalienable Cannot become generic</td>
</tr>
<tr>
<td>Registration</td>
<td>First in time, first in rights (Qui prior est tempore potior est iure )</td>
<td>Procedures, claims, oppositions, register</td>
</tr>
<tr>
<td>Use</td>
<td>Mostly private (unless collective TM and Certification TM)</td>
<td>Mostly collective</td>
</tr>
<tr>
<td>Conditions of use</td>
<td>Free, but not deceptive Rules for Certification TM and collective TM Closed (TM and collective TM) Open (Certification TM)</td>
<td>Comply with the conditions stated in the Codes of practices</td>
</tr>
<tr>
<td>Duration of use</td>
<td>Limited in time (10 to 20 years) Must be renewed</td>
<td>Permanent</td>
</tr>
<tr>
<td>Protection</td>
<td>Private Passing off (the plaintiff has the proof burden)</td>
<td>Public Ex officio protection</td>
</tr>
</tbody>
</table>

\textit{Table 2: Differences between trademarks and appellation of origin or geographical indications (Sylvander)}

\textsuperscript{162} B. Sylvander, Protecting GIs: an international comparison of schemes and systems, conference “food quality certification – adding value to farm products, Brussels, February 2007.
Potential controversies between the trademark and geographical indications arise from the cases of collision between the registered trademarks similar to the geographical indications, which would lead to delusion of the consumers, especially when the trademark is registered before the protection of the geographical indication. There are some considerations in the EU about granting a right to the trademark holder to prevent its use as a geographical indication, in cases when that would lead to delusion of the consumer.\textsuperscript{163}

6. Instead of a Conclusion

Based on the attitudes presented regarding geographical indications, it could be ascertained that their strategic role contains several dimensions.

First, the appellation of origin and the geographical indication enable differentiation of the products on the market, due to their attractiveness and quality. This practically provides certain “exterritoriality” in terms of promoting on the wider market rather than the national one, which is an advantage in regard to the other rights from industrial property.

Second, from economic viewpoint, the appellation of origin of the product and the geographical indication create values, because the consumers are ready to pay a higher price due to the connection of the production to a particular geographical area.

Third, they attribute to the preservation of the biodiversity, local skills and natural resources and positively influence tourism.

It could be noted that geographical indications play a significant role in the Macedonian economy, especially in the wine and alimentary industry.

Hence, alongside with the economic measures, it is necessary to work on the stimulation and achievement of the protection of geographical indications. Permanent education of the organizations, business communities and the other factors is an important tool in the set of measures, not only as a form of awareness raising about this issue, but also as a mode to acquire knowledge that would be disseminated to every individual producer.

\textsuperscript{163} M. Blakeney, Controversial Aspects of GIs, Queen Mary Intellectual Property Research Institute, 2006.
MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

of April 14, 1891,
as revised
at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague
on November 6, 1925, at London on June 2, 1934,
at Nice on June 15, 1957,
and at Stockholm on July 14, 1967,
and as amended on September 28,1979

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Article 1

[Establishment of a Special Union. Filing of Marks at International Bureau. Definition of Country of Origin]

(1) The countries to which this Agreement applies constitute a Special Union for the International registration of marks.

(2) Nationals of any of the contracting countries may, in all the other countries party to this Agreement, secure protection for their marks applicable to goods or services, registered in the country of origin, by filing the said marks at the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization"), through the intermediary of the Office of the said country of origin.

(3) Shall be considered the country of origin the country of the Special Union where the applicant has a real and effective industrial or commercial establishment; if he has no such establishment in a country of the Special Union, the country of the Special Union where he has his domicile; if he has no domicile within the Special Union but is a national of a country of the Special Union, the country of which he is a national.

Article 2

[Reference to Article 3 of Paris Convention (Same Treatment for Certain Categories of Persons as for Nationals of Countries of the Union)]

Nationals of countries not having acceded to this Agreement who, within the territory of the Special Union constituted by the said Agreement, satisfy the conditions specified in Article 3 of the Paris Convention for the Protection of Industrial Property shall be treated in the same manner as nationals of the contracting countries.

Article 3

[Contents of Application for International Registration]

(1) Every application for international registration must be presented on the form prescribed by the Regulations; the Office of the country of origin of the mark shall certify that the particulars appearing in such application correspond to the particulars in the national register, and shall mention the dates and numbers of the filing and registration of the mark in the country of origin and also the date of the application for international registration.
(2) The applicant must indicate the goods or services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods or services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the national Office. In the event of disagreement between the national Office and the International Bureau, the opinion of the latter shall prevail.

(3) If the applicant claims color as a distinctive feature of his mark, he shall be required:

1. to state the fact, and to file with his application a notice specifying the color or the combination of colors claimed;
2. to append to his application copies in color of the said mark, which shall be attached to the notification given by the International Bureau.
3. The number of such copies shall be fixed by the Regulations.

(4) The International Bureau shall register immediately the marks filed in accordance with Article 1. The registration shall bear the date of the application for international registration in the country of origin, provided that the application has been received by the International Bureau within a period of two months from that date. If the application has not been received within that period, the International Bureau shall record it as at the date on which it received the said application. The International Bureau shall notify such registration without delay to the Offices concerned. Registered marks shall be published in a periodical journal issued by the International Bureau, on the basis of the particulars contained in the application for registration. In the case of marks comprising a figurative element or a special form of writing, the Regulations shall determine whether a printing block must be supplied by the applicant.

(5) With a view to the publicity to be given in the contracting countries to registered marks, each Office shall receive from the International Bureau a number of copies of the said publication free of charge and a number of copies at a reduced price, in proportion to the number of units mentioned in Article 16(4)(a) of the Paris Convention for the Protection of Industrial Property, under the conditions fixed by the Regulations. Such publicity shall be deemed in all the contracting countries to be sufficient, and no other publicity may be required of the applicant.
Article 3bis
["Territorial Limitation"]

(1) Any contracting country may, at any time, notify the Director General of the Organization (hereinafter designated as "the Director General") in writing that the protection resulting from the international registration shall extend to that country only at the express request of the proprietor of the mark.

(2) Such notification shall not take effect until six months after the date of the communication thereof by the Director General to the other contracting countries.

Article 3ter
[Request for "Territorial Extension"]

(1) Any request for extension of the protection resulting from the international registration to a country which has availed itself of the right provided for in Article 3bis must be specially mentioned in the application referred to in Article 3(1).

(2) Any request for territorial extension made subsequently to the international registration must be presented through the intermediary of the Office of the country of origin on a form prescribed by the Regulations. It shall be immediately registered by the International Bureau, which shall notify it without delay to the Office or Offices concerned. It shall be published in the periodical journal issued by the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiration of the international registration of the mark to which it relates.

Article 4
[Effects of International Registration]

(1) From the date of the registration so effected at the International Bureau in accordance with the provisions of Articles 3 and 3ter, the protection of the mark in each of the contracting countries concerned shall be the same as if the mark had been filed therein direct. The indication of classes of goods or services provided for in Article 3 shall not bind the contracting countries with regard to the determination of the scope of the protection of the mark.

(2) Every mark which has been the subject of an international registration shall enjoy the right of priority provided for by Article 4 of the Paris
Convention for the Protection of Industrial Property, without requiring compliance with the formalities prescribed in Section D of that Article.

Article 4bis
[Substitution of International Registration for Earlier National Registrations]

(1) When a mark already filed in one or more of the contracting countries is later registered by the International Bureau in the name of the same proprietor or his successor in title, the international registration shall be deemed to have replaced the earlier national registrations, without prejudice to any rights acquired by reason of such earlier registrations.

(2) The national Office shall, upon request, be required to take note in its registers of the international registration.

Article 5
[Refusal by National Offices]

(1) In countries where the legislation so authorizes, Offices notified by the International Bureau of the registration of a mark or of a request for extension of protection made in accordance with Article 3ter shall have the right to declare that protection cannot be granted to such mark in their territory. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark filed for national registration. However, protection may not be refused, even partially, by reason only that national legislation would not permit registration except in a limited number of classes or for a limited number of goods or services.

(2) Offices wishing to exercise such right must give notice of their refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by their domestic law and, at the latest, before the expiration of one year from the date of the international registration of the mark or of the request for extension of protection made in accordance with Article 3ter.

(3) The International Bureau shall, without delay, transmit to the Office of the country of origin and to the proprietor of the mark, or to his agent if an agent has been mentioned to the Bureau by the said Office, one of the copies of the declaration of refusal so notified. The interested party shall have the same remedies as if the mark had been filed by him direct in the country where protection is refused.

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(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Offices which, within the aforesaid maximum period of one year, have not communicated to the International Bureau any provisional or final decision of refusal with regard to the registration of a mark or a request for extension of protection shall lose the benefit of the right provided for in paragraph (1) of this Article with respect to the mark in question.

(6) Invalidation of an international mark may not be pronounced by the competent authorities without the proprietor of the mark having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

Article 5bis
[Documentary Evidence of Legitimacy of Use of Certain Elements of Mark]

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the contracting countries shall be exempt from any legalization or certification other than that of the Office of the country of origin.

Article 5ter
[Copies of Entries in International Register. Searches for Anticipation. Extracts from International Register]

(1) The International Bureau shall issue to any person applying therefor, subject to a fee fixed by the Regulations, a copy of the entries in the Register relating to a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipation among international marks.

(3) Extracts from the International Register requested with a view to their production in one of the contracting countries shall be exempt from all legalization.
Article 6
[Period of Validity of International Registration. Independence of International Registration. Termination of Protection in Country of Origin]

(1) Registration of a mark at the International Bureau is effected for twenty years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiration of a period of five years from the date of the international registration, such registration shall become independent of the national mark registered earlier in the country of origin, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked, in whole or in part, if, within five years from the date of the international registration, the national mark, registered earlier in the country of origin in accordance with Article 1, no longer enjoys, in whole or in part, legal protection in that country. This provision shall also apply when legal protection has later ceased as the result of an action begun before the expiration of the period of five years.

(4) In the case of voluntary or ex officio cancellation, the Office of the country of origin shall request the cancellation of the mark at the International Bureau, and the latter shall effect the cancellation. In the case of judicial action, the said Office shall send to the International Bureau, ex officio or at the request of the plaintiff, a copy of the complaint or any other documentary evidence that an action has begun, and also of the final decision of the court; the Bureau shall enter notice thereof in the International Register.

Article 7
[Renewal of International Registration]

(1) Any registration may be renewed for a period of twenty years from the expiration of the preceding period, by payment only of the basic fee and, where necessary, of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not include any change in relation to the previous registration in its latest form.

(3) The first renewal effected under the provisions of the Nice Act of June 15, 1957, or of this Act, shall include an indication of the classes of the International Classification to which the registration relates.

(4) Six months before the expiration of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the proprietor of the mark and his agent of the exact date of expiration.
Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be granted for renewal of the international registration.

Article 8

[National Fee. International Fee. Division of Excess Receipts, Supplementary Fees, and Complementary Fees]

(1) The Office of the country of origin may fix, at its own discretion, and collect, for its own benefit, a national fee which it may require from the proprietor of the mark in respect of which international registration or renewal is applied for.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall include:

(a) a basic fee;
(b) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;
(c) a complementary fee for any request for extension of protection under Article 3ter.

(3) However, the supplementary fee specified in paragraph (2)(b) may, without prejudice to the date of registration, be paid within a period fixed by the Regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiration of the said period, the supplementary fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the application for international registration shall be deemed to have been abandoned.

(4) The annual returns from the various receipts from international registration, with the exception of those provided for under (b) and (c) of paragraph (2), shall be divided equally among the countries party to this Act by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of the said Act. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the excess receipts calculated on the basis of that earlier Act which is applicable to it.

(5) The amounts derived from the supplementary fees provided for in paragraph (2)(b) shall be divided at the expiration of each year among the countries party to this Act or to the Nice Act of June 15, 1957, in proportion to the number of marks for which protection has been applied for in each of them.
during that year, this number being multiplied, in the case of countries which make a preliminary examination, by a coefficient which shall be determined by the Regulations. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the amounts calculated on the basis of the Nice Act.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(c) shall be divided according to the requirements of paragraph (5) among the countries availing themselves of the right provided for in Article 3bis. If, at the time this Act enters into force, a country has not yet ratified or acceded to the said Act, it shall be entitled, until the date on which its ratification or accession becomes effective, to a share of the amounts calculated on the basis of the Nice Act.

Article 8bis
[Renunciation in Respect of One or More Countries]

The person in whose name the international registration stands may at any time renounce protection in one or more of the contracting countries by means of a declaration filed with the Office of his own country, for communication to the International Bureau, which shall notify accordingly the countries in respect of which renunciation has been made. Renunciation shall not be subject to any fee.

Article 9
[Changes in National Registers also Affecting International Registration. Reduction of List of Goods and Services Mentioned in International Registration. Additions to that List. Substitutions in that List]

(1) The Office of the country of the person in whose name the international registration stands shall likewise notify the International Bureau of all annulments, cancellations, renunciations, transfers, and other changes made in the entry of the mark in the national register, if such changes also affect the international registration.

(2) The Bureau shall record those changes in the International Register, shall notify them in turn to the Offices of the contracting countries, and shall publish them in its journal.

(3) A similar procedure shall be followed when the person in whose name the international registration stands requests a reduction of the list of goods or services to which the registration applies.
(4) Such transactions may be subject to a fee, which shall be fixed by the Regulations.
(5) The subsequent addition of new goods or services to the said list can be obtained only by filing a new application as prescribed in Article 3.
(6) The substitution of one of the goods or services for another shall be treated as an addition.

Article 9bis
[Transfer of International Mark Entailing Change in Country of Proprietor]

(1) When a mark registered in the International Register is transferred to a person established in a contracting country other than the country of the person in whose name the international registration stands, the transfer shall be notified to the International Bureau by the Office of the latter country. The International Bureau shall record the transfer, shall notify the other Offices thereof, and shall publish it in its journal. If the transfer has been effected before the expiration of a period of five years from the international registration, the International Bureau shall seek the consent of the Office of the country of the new proprietor, and shall publish, if possible, the date and registration number of the mark in the country of the new proprietor.
(2) No transfer of a mark registered in the International Register for the benefit of a person who is not entitled to file an international mark shall be recorded.
(3) When it has not been possible to record a transfer in the International Register, either because the country of the new proprietor has refused its consent or because the said transfer has been made for the benefit of a person who is not entitled to apply for international registration, the Office of the country of the former proprietor shall have the right to demand that the International Bureau cancel the mark in its Register.

Article 9ter
[Assignment of International Mark for Part Only of Registered Goods or Services or for Certain Contracting Countries. Reference to Article 6quater of Paris Convention (Assignment of Mark)]

(1) If the assignment of an international mark for part only of the registered goods or services is notified to the International Bureau, the Bureau shall record it in its Register. Each of the contracting countries shall have the right to refuse to recognize the validity of such assignment if the goods or
services included in the part so assigned are similar to those in respect of which the mark remains registered for the benefit of the assignor.

(2) The International Bureau shall likewise record the assignment of an international mark in respect of one or several of the contracting countries only.

(3) If, in the above cases, a change occurs in the country of the proprietor, the Office of the country to which the new proprietor belongs shall, if the international mark has been transferred before the expiration of a period of five years from the international registration, give its consent as required by Article 9bis.

(4) The provisions of the foregoing paragraphs shall apply subject to Article 6quater of the Paris Convention for the Protection of Industrial Property.

**Article 9quater**

[Common Office for Several Contracting Countries. Request by Several Contracting Countries to be Treated as a Single Country]

(1) If several countries of the Special Union agree to effect the unification of their domestic legislations on marks, they may notify the Director General:
   (a) that a common Office shall be substituted for the national Office of each of them, and
   (b) that the whole of their respective territories shall be deemed to be a single country for the purposes of the application of all or part of the provisions preceding this Article.

(2) Such notification shall not take effect until six months after the date of the communication thereof by the Director General to the other contracting countries.

**Article 10**

[Assembly of the Special Union]

(1) (a) The Special Union shall have an Assembly consisting of those countries which have ratified or acceded to this Act.
   (b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
   (c) The expenses of each delegation shall be borne by the Government which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each member country, which shall be paid from the funds of the Special Union.
(2) (a) The Assembly shall:
(i) deal with all matters concerning the maintenance and development of the Special Union and the implementation of this Agreement;
(ii) give directions to the International Bureau concerning the preparation for conferences of revision, due account being taken of any comments made by those countries of the Special Union which have not ratified or acceded to this Act;
(iii) modify the Regulations, including the fixation of the amounts of the fees referred to in Article 8(2) and other fees relating to international registration;
(iv) review and approve the reports and activities of the Director General concerning the Special Union, and give him all necessary instructions concerning matters within the competence of the Special Union;
(v) determine the program and adopt the biennial budget of the Special Union, and approve its final accounts;
(vi) adopt the financial regulations of the Special Union;
(vii) establish such committees of experts and working groups as it may deem necessary to achieve the objectives of the Special Union;
(viii) determine which countries not members of the Special Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;
(ix) adopt amendments to Articles 10 to 13;
(x) take any other appropriate action designed to further the objectives of the Special Union;
(xi) perform such other functions as are appropriate under this Agreement.

(2) (b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) (a) Each country member of the Assembly shall have one vote.
(b) One-half of the countries members of the Assembly shall constitute a quorum.
(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one-half but equal to or more than one third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect onl if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their
vote or abstention attains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.
(e) Abstentions shall not be considered as votes.
(f) A delegate may represent, and vote in the name of, one country only.

(g) Countries of the Special Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(4) (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the countries members of the Assembly.

(c) The agenda of each session shall be prepared by the Director General.

(5) The Assembly shall adopt its own rules of procedure.

**Article 11**

[International Bureau]

(1) (a) International registration and related duties, as well as all other administrative tasks concerning the Special Union, shall be performed by the International Bureau.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may have been established by the Assembly.

(c) The Director General shall be the chief executive of the Special Union and shall represent the Special Union.

(2) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly and of such committees of experts or working groups as may have been established by the Assembly. The Director General, or a staff member designated by him, shall be ex officio secretary of those bodies.

(3) (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of the provisions of the Agreement other than Articles 10 to 13.
(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for conferences of revision.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at those conferences.

(4) The International Bureau shall carry out any other tasks assigned to it.

**Article 12**

[Finances]

(1) (a) The Special Union shall have a budget.

(b) The budget of the Special Union shall include the income and expenses proper to the Special Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.

(c) Expenses not attributable exclusively to the Special Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Special Union in such common expenses shall be in proportion to the interest the Special Union has in them.

(2) The budget of the Special Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Special Union shall be financed from the following sources:

(i) international registration fees and other fees and charges due for other services rendered by the International Bureau in relation to the Special Union;

(ii) sale of, or royalties on, the publications of the International Bureau concerning the Special Union;

(iii) gifts, bequests, and subventions;

(iv) rents, interests, and other miscellaneous income.

(4) (a) The amounts of the fees referred to in Article 8(2) and other fees relating to international registration shall be fixed by the Assembly on the proposal of the Director General.

(b) The amounts of such fees shall be so fixed that the revenues of the Special Union from fees, other than the supplementary and complementary fees referred to in Article 8(2)(b) and (c), and other sources shall be at least sufficient to cover the expenses of the International Bureau concerning the Special Union.
(c) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(5) Subject to the provisions of paragraph (4)(a), the amount of fees and charges due for other services rendered by the International Bureau in relation to the Special Union shall be established, and shall be reported to the Assembly, by the Director General.

(6) (a) The Special Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Special Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country as a member of the Paris Union for the Protection of Industrial Property to the budget of the said Union for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(d) As long as the Assembly authorizes the use of the reserve fund of the Special Union as a working capital fund, the Assembly may suspend the application of the provisions of subparagraphs (a), (b), and (c).

(7) (a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of those advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(8) The auditing of the accounts shall be effected by one or more of the countries of the Special Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

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**Article 13**

[Amendment of Articles 10 to 13]

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any country member of the Assembly, or by the
Director General. Such proposals shall be communicated by the Director General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date.

**Article 14**

[Ratification and Accession. Entry into Force. Accession to Earlier Acts. Reference to Article 24 of Paris Convention (Territories)]

(1) Any country of the Special Union which has signed this Act may ratify it, and, if it has not signed it, may accede to it.

(2) (a) Any country outside the Special Union which is party to the Paris Convention for the Protection of Industrial Property may accede to this Act and thereby become a member of the Special Union.

(b) As soon as the International Bureau is informed that such a country has acceded to this Act, it shall address to the Office of that country, in accordance with Article 3, a collective notification of the marks which, at that time, enjoy international protection.

(c) Such notification shall, of itself, ensure to the said marks the benefits of the foregoing provisions in the territory of the said country, and shall mark the commencement of the period of one year during which the Office concerned may make the declaration provided for in Article 5.

(d) However, any such country may, in acceding to this Act, declare that, except in the case of international marks which have already been the subject in that country of an earlier identical national registration still in force, and which shall be immediately recognized upon the request of the interested parties, application of this Act shall be limited to marks registered from the date on which its accession enters into force.

(e) Such declaration shall dispense the International Bureau from making the collective notification referred to above. The International Bureau
shall notify only those marks in respect of which it receives, within a period of one year from the accession of the new country, a request, with the necessary particulars, to take advantage of the exception provided for in subparagraph (d).

(f) The International Bureau shall not make the collective notification to such countries as declare, in acceding to this Act, that they are availing themselves of the right provided for in Article 3bis. The said countries may also declare at the same time that the application of this Act shall be limited to marks registered from the day on which their accessions enter into force; however, such limitation shall not affect international marks which have already been the subject of an earlier identical national registration in those countries, and which could give rise to requests for extension of protection made and notified in accordance with Articles 3ter and 8(2)(c).

(g) Registrations of marks which have been the subject of one of the notifications provided for in this paragraph shall be regarded as replacing registrations effected direct in the new contracting country before the date of entry into force of its accession.

(3) Instruments of ratification and accession shall be deposited with the Director General.

(4) (a) With respect to the first five countries which have deposited their instruments of ratification or accession, this Act shall enter into force three months after the deposit of the fifth such instrument.

(b) With respect to any other country, this Act shall enter into force three months after the date on which its ratification or accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of ratification or accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(5) Ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act.

(6) After the entry into force of this Act, a country may accede to the Nice Act of June 15, 1957, only in conjunction with ratification of, or accession to, this Act. Accession to Acts earlier than the Nice Act shall not be permitted, not even in conjunction with ratification of, or accession to, this Act.

(7) The provisions of Article 24 of the Paris Convention for the Protection of Industrial Property shall apply to this Agreement.

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**Article 15**

[Denunciation]

(1) This Agreement shall remain in force without limitation as to time.

(2) Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of all
earlier Acts and shall affect only the country making it, the Agreement remaining in full force and effect as regards the other countries of the Special Union.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Special Union.

(5) International marks registered up to the date on which denunciation becomes effective, and not refused within the period of one year provided for in Article 5, shall continue, throughout the period of international protection, to enjoy the same protection as if they had been filed direct in the denouncing country.

Article 16
[Application of Earlier Acts]

(1) (a) This Act shall, as regards the relations between the countries of the Special Union by which it has been ratified or acceded to, replace, as from the day on which it enters into force with respect to them, the Madrid Agreement of 1891, in its texts earlier than this Act.

(b) However, any country of the Special Union which has ratified or acceded to this Act shall remain bound by the earlier texts which it has not previously denounced by virtue of Article 12(4) of the Nice Act of June 15, 1957, as regards its relations with countries which have not ratified or acceded to this Act.

(2) Countries outside the Special Union which become party to this Act shall apply it to international registrations effected at the International Bureau through the intermediary of the national Office of any country of the Special Union not party to this Act, provided that such registrations satisfy, with respect to the said countries, the requirements of this Act. With regard to international registrations effected at the International Bureau through the intermediary of the national Offices of the said countries outside the Special Union which become party to this Act, such countries recognize that the aforesaid country of the Special Union may demand compliance with the requirements of the most recent Act to which it is party.
Article 17
[Signature, Languages, Depositary Functions]

(1) (a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) This Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Act to the Governments of all countries of the Special Union and, on request, to the Government of any other country.

(4) The Director General shall register this Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Special Union of signatures, deposits of instruments of ratification or accession and any declarations included in such instruments, entry into force of any provisions of this Act, notifications of denunciation, and notifications pursuant to Articles 3bis, 9quater, 13, 14(7), and 15(2).

Article 18
[Transitional Provisions]

(1) Until the first Director General assumes office, references in this Act to the International Bureau of the Organization or to the Director General shall be construed as references to the Bureau of the Union established by the Paris Convention for the Protection of Industrial Property or its Director, respectively.

(2) Countries of the Special Union not having ratified or acceded to this Act may, until five years after the entry into force of the Convention establishing the Organization, exercise, if they so desire, the rights provided for under Articles 10 to 13 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period.
PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Adopted at Madrid on June 27, 1989, as amended on October 3, 2006, and on November 12, 2007

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Article 1
Membership in the Madrid Union

The States party to this Protocol (hereinafter referred to as "the Contracting States"), even where they are not party to the Madrid Agreement Concerning the International Registration of Marks as revised at Stockholm in 1967 and as amended in 1979 (hereinafter referred to as "the Madrid (Stockholm) Agreement"), and the organizations referred to in Article 14(1)(b) which are party to this Protocol (hereinafter referred to as "the Contracting Organizations") shall be members of the same Union of which countries party to the Madrid (Stockholm) Agreement are members. Any reference in this Protocol to "Contracting Parties" shall be construed as a reference to both Contracting States and Contracting Organizations.

Article 2
Securing Protection through International Registration

(1) Where an application for the registration of a mark has been filed with the Office of a Contracting Party, or where a mark has been registered in the register of the Office of a Contracting Party, the person in whose name that application (hereinafter referred to as "the basic application") or that registration (hereinafter referred to as "the basic registration") stands may, subject to the provisions of this Protocol, secure protection for his mark in the territory of the Contracting Parties, by obtaining the registration of that mark in the register of the International Bureau of the World Intellectual Property Organization (hereinafter referred to as "the international registration," "the International Register," "the International Bureau" and "the Organization," respectively), provided that,

(i) where the basic application has been filed with the Office of a Contracting State or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of that Contracting State, or is domiciled, or has a real and effective industrial or commercial establishment, in the said Contracting State,

(ii) where the basic application has been filed with the Office of a Contracting Organization or where the basic registration has been made by such an Office, the person in whose name that application or registration stands is a national of a State member of that Contracting Organization, or is domiciled, or has a real and effective industrial or commercial establishment, in the territory of the said Contracting Organization.

(2) The application for international registration (hereinafter referred to as "the international application") shall be filed with the International Bureau
through the intermediary of the Office with which the basic application was filed or by which the basic registration was made (hereinafter referred to as "the Office of origin"), as the case may be.

(3) Any reference in this Protocol to an "Office" or an "Office of a Contracting Party" shall be construed as a reference to the office that is in charge, on behalf of a Contracting Party, of the registration of marks, and any reference in this Protocol to "marks" shall be construed as a reference to trademarks and service marks.

(4) For the purposes of this Protocol, "territory of a Contracting Party" means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies.

Article 3
International Application

(1) Every international application under this Protocol shall be presented on the form prescribed by the Regulations. The Office of origin shall certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the basic application or basic registration, as the case may be. Furthermore, the said Office shall indicate,

(i) in the case of a basic application, the date and number of that application,

(ii) in the case of a basic registration, the date and number of that registration as well as the date and number of the application from which the basic registration resulted.

The Office of origin shall also indicate the date of the international application.

(2) The applicant must indicate the goods and services in respect of which protection of the mark is claimed and also, if possible, the corresponding class or classes according to the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. If the applicant does not give such indication, the International Bureau shall classify the goods and services in the appropriate classes of the said classification. The indication of classes given by the applicant shall be subject to control by the International Bureau, which shall exercise the said control in association with the Office of origin. In the event of disagreement between the said Office and the International Bureau, the opinion of the latter shall prevail.
(3) If the applicant claims color as a distinctive feature of his mark, he shall be required

(i) to state the fact, and to file with his international application a notice specifying the color or the combination of colors claimed;

(ii) to append to his international application copies in color of the said mark, which shall be attached to the notifications given by the International Bureau; the number of such copies shall be fixed by the Regulations.

(4) The International Bureau shall register immediately the marks filed in accordance with Article 2. The international registration shall bear the date on which the international application was received in the Office of origin, provided that the international application has been received by the International Bureau within a period of two months from that date. If the international application has not been received within that period, the international registration shall bear the date on which the said international application was received by the International Bureau. The International Bureau shall notify the international registration without delay to the Offices concerned. Marks registered in the International Register shall be published in a periodical gazette issued by the International Bureau, on the basis of the particulars contained in the international application.

(5) With a view to the publicity to be given to marks registered in the International Register, each Office shall receive from the International Bureau a number of copies of the said gazette free of charge and a number of copies at a reduced price, under the conditions fixed by the Assembly referred to in Article 10 (hereinafter referred to as "the Assembly"). Such publicity shall be deemed to be sufficient for the purposes of all the Contracting Parties, and no other publicity may be required of the holder of the international registration.

Article 3bis
Territorial Effect

The protection resulting from the international registration shall extend to any Contracting Party only at the request of the person who files the international application or who is the holder of the international registration. However, no such request can be made with respect to the Contracting Party whose Office is the Office of origin.
Article 3ter
Request for "Territorial Extension"

(1) Any request for extension of the protection resulting from the international registration to any Contracting Party shall be specially mentioned in the international application.

(2) A request for territorial extension may also be made subsequently to the international registration. Any such request shall be presented on the form prescribed by the Regulations. It shall be immediately recorded by the International Bureau, which shall notify such recordal without delay to the Office or Offices concerned. Such recordal shall be published in the periodical gazette of the International Bureau. Such territorial extension shall be effective from the date on which it has been recorded in the International Register; it shall cease to be valid on the expiry of the international registration to which it relates.

Article 4
Effects of International Registration

(1) (a) From the date of the registration or recordal effected in accordance with the provisions of Articles 3 and 3ter, the protection of the mark in each of the Contracting Parties concerned shall be the same as if the mark had been deposited direct with the Office of that Contracting Party. If no refusal has been notified to the International Bureau in accordance with Article 5(1) and (2) or if a refusal notified in accordance with the said Article has been withdrawn subsequently, the protection of the mark in the Contracting Party concerned shall, as from the said date, be the same as if the mark had been registered by the Office of that Contracting Party.

(b) The indication of classes of goods and services provided for in Article 3 shall not bind the Contracting Parties with regard to the determination of the scope of the protection of the mark.

(2) Every international registration shall enjoy the right of priority provided for by Article 4 of the Paris Convention for the Protection of Industrial Property, without it being necessary to comply with the formalities prescribed in Section D of that Article.
Article 4bis
Replacement of a National or Regional Registration by an International Registration

(1) Where a mark that is the subject of a national or regional registration in the Office of a Contracting Party is also the subject of an international registration and both registrations stand in the name of the same person, the international registration is deemed to replace the national or regional registration, without prejudice to any rights acquired by virtue of the latter, provided that

(i) the protection resulting from the international registration extends to the said Contracting Party under Article 3ter(1) or (2),
(ii) all the goods and services listed in the national or regional registration are also listed in the international registration in respect of the said Contracting Party,
(iii) such extension takes effect after the date of the national or regional registration.

(2) The Office referred to in paragraph (1) shall, upon request, be required to take note in its register of the international registration.

Article 5
Refusal and Invalidation of Effects of International Registration in Respect of Certain Contracting Parties

(1) Where the applicable legislation so authorizes, any Office of a Contracting Party which has been notified by the International Bureau of an extension to that Contracting Party, under Article 3ter(1) or (2), of the protection resulting from the international registration shall have the right to declare in a notification of refusal that protection cannot be granted in the said Contracting Party to the mark which is the subject of such extension. Any such refusal can be based only on the grounds which would apply, under the Paris Convention for the Protection of Industrial Property, in the case of a mark deposited direct with the Office which notifies the refusal. However, protection may not be refused, even partially, by reason only that the applicable legislation would permit registration only in a limited number of classes or for a limited number of goods or services.

(2) (a) Any Office wishing to exercise such right shall notify its refusal to the International Bureau, together with a statement of all grounds, within the period prescribed by the law applicable to that Office and at the latest, subject to subparagraphs (b) and (c), before the expiry of one year from the date...
on which the notification of the extension referred to in paragraph (1) has been sent to that Office by the International Bureau.

(b) Notwithstanding subparagraph (a), any Contracting Party may declare that, for international registrations made under this Protocol, the time limit of one year referred to in subparagraph (a) is replaced by 18 months.

(c) Such declaration may also specify that, when a refusal of protection may result from an opposition to the granting of protection, such refusal may be notified by the Office of the said Contracting Party to the International Bureau after the expiry of the 18-month time limit. Such an Office may, with respect to any given international registration, notify a refusal of protection after the expiry of the 18-month time limit, but only if

(i) it has, before the expiry of the 18-month time limit, informed the International Bureau of the possibility that oppositions may be filed after the expiry of the 18-month time limit, and

(ii) the notification of the refusal based on an opposition is made within a time limit of one month from the expiry of the opposition period and, in any case, not later than seven months from the date on which the opposition period begins.

(d) Any declaration under subparagraphs (b) or (c) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General of the Organization (hereinafter referred to as "the Director General"), or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

(e) Upon the expiry of a period of ten years from the entry into force of this Protocol, the Assembly shall examine the operation of the system established by subparagraphs (a) to (d). Thereafter, the provisions of the said subparagraphs may be modified by a unanimous decision of the Assembly*.

(3) The International Bureau shall, without delay, transmit one of the copies of the notification of refusal to the holder of the international registration. The said holder shall have the same remedies as if the mark had been deposited by him direct with the Office which has notified its refusal. Where the International Bureau has received information under paragraph (2)(c)(i), it shall, without delay, transmit the said information to the holder of the international registration.

(4) The grounds for refusing a mark shall be communicated by the International Bureau to any interested party who may so request.

(5) Any Office which has not notified, with respect to a given international registration, any provisional or final refusal to the International
Bureau in accordance with paragraphs (1) and (2) shall, with respect to that international registration, lose the benefit of the right provided for in paragraph (1).

(6) Invalidation, by the competent authorities of a Contracting Party, of the effects, in the territory of that Contracting Party, of an international registration may not be pronounced without the holder of such international registration having, in good time, been afforded the opportunity of defending his rights. Invalidation shall be notified to the International Bureau.

**Article 5bis**

**Documentary Evidence of Legitimacy of Use of Certain Elements of the Mark**

Documentary evidence of the legitimacy of the use of certain elements incorporated in a mark, such as armorial bearings, escutcheons, portraits, honorary distinctions, titles, trade names, names of persons other than the name of the applicant, or other like inscriptions, which might be required by the Offices of the Contracting Parties shall be exempt from any legalization as well as from any certification other than that of the Office of origin.

Interpretative statement adopted by the Assembly of the Madrid Union: "Article 5(2)(e) of the Protocol is understood as allowing the Assembly to keep under review the operation of the system established by subparagraphs (a) to (d), it being also understood that any modification of those provisions shall require a unanimous decision of the Assembly."

**Article 5ter**

**Copies of Entries in International Register; Searches for Anticipations; Extracts from International Register**

(1) The International Bureau shall issue to any person applying therefor, upon the payment of a fee fixed by the Regulations, a copy of the entries in the International Register concerning a specific mark.

(2) The International Bureau may also, upon payment, undertake searches for anticipations among marks that are the subject of international registrations.

(3) Extracts from the International Register requested with a view to their production in one of the Contracting Parties shall be exempt from any legalization.
Article 6
Period of Validity of International Registration; Dependence and Independence of International Registration

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

(i) an appeal against a decision refusing the effects of the basic application,

(ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or

(iii) an opposition to the basic application results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in item (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.
Article 7

Renewal of International Registration

(1) Any international registration may be renewed for a period often years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

(4) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration.

Article 8

Fees for International Application and Registration

(1) The Office of origin may fix, at its own discretion, and collect, for its own benefit, a fee which it may require from the applicant for international registration or from the holder of the international registration in connection with the filing of the international application or the renewal of the international registration.

(2) Registration of a mark at the International Bureau shall be subject to the advance payment of an international fee which shall, subject to the provisions of paragraph (7)(a), include,

(i) a basic fee;

(ii) a supplementary fee for each class of the International Classification, beyond three, into which the goods or services to which the mark is applied will fall;

(iii) a complementary fee for any request for extension of protection under Article 3ter.

(3) However, the supplementary fee specified in paragraph (2)(ii) may, without prejudice to the date of the international registration, be paid within the period fixed by the Regulations if the number of classes of goods or services has been fixed or disputed by the International Bureau. If, upon expiry of the said period, the supplementary fee has not been paid or the list of goods or services has not been reduced to the required extent by the applicant, the international application shall be deemed to have been abandoned.
(4) The annual product of the various receipts from international registration, with the exception of the receipts derived from the fees mentioned in paragraph (2)(ii) and (iii), shall be divided equally among the Contracting Parties by the International Bureau, after deduction of the expenses and charges necessitated by the implementation of this Protocol.

(5) The amounts derived from the supplementary fees provided for in paragraph (2)(ii) shall be divided, at the expiry of each year, among the interested Contracting Parties in proportion to the number of marks for which protection has been applied for in each of them during that year, this number being multiplied, in the case of Contracting Parties which make an examination, by a coefficient which shall be determined by the Regulations.

(6) The amounts derived from the complementary fees provided for in paragraph (2)(iii) shall be divided according to the same rules as those provided for in paragraph (5).

(7) (a) Any Contracting Party may declare that, in connection with each international registration in which it is mentioned under Article 3ter, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as "the individual fee") whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said Contracting Party's Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable,

(i) no supplementary fees referred to in paragraph (2)(ii) shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3ter, and

(ii) no complementary fee referred to in paragraph (2)(iii) shall be payable in respect of any Contracting Party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.
Article 9
Recordal of Change in the Ownership of an International Registration

At the request of the person in whose name the international registration stands, or at the request of an interested Office made ex officio or at the request of an interested person, the International Bureau shall record in the International Register any change in the ownership of that registration, in respect of all or some of the Contracting Parties in whose territories the said registration has effect and in respect of all or some of the goods and services listed in the registration, provided that the new holder is a person who, under Article 2(1), is entitled to file international applications.

Article 9bis
Recordal of Certain Matters Concerning an International Registration

The International Bureau shall record in the International Register
(i) any change in the name or address of the holder of the international registration,
(ii) the appointment of a representative of the holder of the international registration and any other relevant fact concerning such representative,
(iii) any limitation, in respect of all or some of the Contracting Parties, of the goods and services listed in the international registration,
(iv) any renunciation, cancellation or invalidation of the international registration in respect of all or some of the Contracting Parties,
(v) any other relevant fact, identified in the Regulations, concerning the rights in a mark that is the subject of an international registration.

Article 9ter
Fees for Certain Recordals

Any recordal under Article 9 or under Article 9bis may be subject to the payment of a fee.

Article 9quater
Common Office of Several Contracting States

(1) If several Contracting States agree to effect the unification of their domestic legislations on marks, they may notify the Director General
(i) that a common Office shall be substituted for the national Office of each of them, and
(ii) that the whole of their respective territories shall be deemed to be a single State for the purposes of the application of all or part of the provisions preceding this Article as well as the provisions of Articles 9quinquies and 9sexies.

(2) Such notification shall not take effect until three months after the date of the communication thereof by the Director General to the other Contracting Parties.

Article 9quinquies
Transformation of an International Registration into National or Regional Applications

Where, in the event that the international registration is cancelled at the request of the Office of origin under Article 6(4), in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that
(i) such application is filed within three months from the date on which the international registration was cancelled,
(ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the Contracting Party concerned, and
(iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

Article 9sexies
Relations Between States Party to both this Protocol and the Madrid (Stockholm) Agreement

(1) (a) This Protocol alone shall be applicable as regards the mutual relations of States party to both this Protocol and the Madrid (Stockholm) Agreement.
(b) Notwithstanding subparagraph (a), a declaration made under Article 5(2)(b), Article 5(2)(c) or Article 8(7) of this Protocol, by a State party to both this Protocol and the Madrid (Stockholm) Agreement, shall have no effect in the relations with another State party to both this Protocol and the Madrid (Stockholm) Agreement.

(2) The Assembly shall, after the expiry of a period of three years from September 1, 2008, review the application of paragraph (1)(b) and may, at any time thereafter, either repeal it or restrict its scope, by a three-fourths majority. In the vote of the Assembly, only those States which are party to both the Madrid (Stockholm) Agreement and this Protocol shall have the right to participate.

**Article 10**

**Assembly**

(1) (a) The Contracting Parties shall be members of the same Assembly as the countries party to the Madrid (Stockholm) Agreement.

(b) Each Contracting Party shall be represented in that Assembly by one delegate, who may be assisted by alternate delegates, advisors, and experts.

(c) The expenses of each delegation shall be borne by the Contracting Party which has appointed it, except for the travel expenses and the subsistence allowance of one delegate for each Contracting Party, which shall be paid from the funds of the Union.

(2) The Assembly shall, in addition to the functions which it has under the Madrid (Stockholm) Agreement, also

(i) deal with all matters concerning the implementation of this Protocol;

(ii) give directions to the International Bureau concerning the preparation for conferences of revision of this Protocol, due account being taken of any comments made by those countries of the Union which are not party to this Protocol;

(iii) adopt and modify the provisions of the Regulations concerning the implementation of this Protocol;

(iv) perform such other functions as are appropriate under this Protocol.

(3) (a) Each Contracting Party shall have one vote in the Assembly. On matters concerning only countries that are party to the Madrid (Stockholm) Agreement, Contracting Parties that are not party to the said Agreement shall not have the right to vote, whereas, on matters concerning only Contracting Parties, only the latter shall have the right to vote.

(b) One-half of the members of the Assembly which have the right to vote on a given matter shall constitute the quorum for the purposes of the vote on that matter.
(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of the members of the Assembly having the right to vote on a given matter which are represented is less than one-half but equal to or more than one-third of the members of the Assembly having the right to vote on that matter, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly having the right to vote on the said matter which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiry of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Articles 5(2)(e), 9sexies(2), 12 and 13(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one member of the Assembly only.

(4) In addition to meeting in ordinary sessions and extraordinary sessions as provided for by the Madrid (Stockholm) Agreement, the Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the members of the Assembly having the right to vote on the matters proposed to be included in the agenda of the session. The agenda of such an extraordinary session shall be prepared by the Director General.

**Article 11**

**International Bureau**

(1) International registration and related duties, as well as all other administrative tasks, under or concerning this Protocol, shall be performed by the International Bureau.

(2) (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences of revision of this Protocol.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for such conferences of revision.
(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at such conferences of revision.

(3) The International Bureau shall carry out any other tasks assigned to it in relation to this Protocol.

**Article 12**

**Finances**

As far as Contracting Parties are concerned, the finances of the Union shall be governed by the same provisions as those contained in Article 12 of the Madrid (Stockholm) Agreement, provided that any reference to Article 8 of the said Agreement shall be deemed to be a reference to Article 8 of this Protocol. Furthermore, for the purposes of Article 12(6)(b) of the said Agreement, Contracting Organizations shall, subject to a unanimous decision to the contrary by the Assembly, be considered to belong to contribution class I (one) under the Paris Convention for the Protection of Industrial Property.

**Article 13**

**Amendment of Certain Articles of the Protocol**

(1) Proposals for the amendment of Articles 10, 11, 12, and the present Article, may be initiated by any Contracting Party, or by the Director General. Such proposals shall be communicated by the Director General to the Contracting Parties at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 10, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of those States and intergovernmental organizations which, at the time the amendment was adopted, were members of the Assembly and had the right to vote on the amendment. Any amendment to the said Articles thus accepted shall bind all the States and intergovernmental organizations which are Contracting Parties at the time the amendment enters into force, or which become Contracting Parties at a subsequent date.
Article 14
Becoming Party to the Protocol; Entry into Force

(1) (a) Any State that is a party to the Paris Convention for the Protection of Industrial Property may become party to this Protocol.

(b) Furthermore, any intergovernmental organization may also become party to this Protocol where the following conditions are fulfilled:

(i) at least one of the member States of that organization is a party to the Paris Convention for the Protection of Industrial Property;

(ii) that organization has a regional Office for the purposes of registering marks with effect in the territory of the organization, provided that such Office is not the subject of a notification under Article 9quater.

(2) Any State or organization referred to in paragraph (1) may sign this Protocol. Any such State or organization may, if it has signed this Protocol, deposit an instrument of ratification, acceptance or approval of this Protocol or, if it has not signed this Protocol, deposit an instrument of accession to this Protocol.

(3) The instruments referred to in paragraph (2) shall be deposited with the Director General.

(4) (a) This Protocol shall enter into force three months after four instruments of ratification, acceptance, approval or accession have been deposited, provided that at least one of those instruments has been deposited by a country party to the Madrid (Stockholm) Agreement and at least one other of those instruments has been deposited by a State not party to the Madrid (Stockholm) Agreement or by any of the organizations referred to in paragraph (1)(b).

(b) With respect to any other State or organization referred to in paragraph (1), this Protocol shall enter into force three months after the date on which its ratification, acceptance, approval or accession has been notified by the Director General.

(5) Any State or organization referred to in paragraph (1) may, when depositing its instrument of ratification, acceptance or approval of, or accession to, this Protocol, declare that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

Article 15
Denunciation

(1) This Protocol shall remain in force without limitation as to time.

(2) Any Contracting Party may denounce this Protocol by notification addressed to the Director General.
(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any Contracting Party before the expiry of five years from the date upon which this Protocol entered into force with respect to that Contracting Party.

(5) (a) Where a mark is the subject of an international registration having effect in the denouncing State or intergovernmental organization at the date on which the denunciation becomes effective, the holder of such registration may file an application for the registration of the same mark with the Office of the denouncing State or intergovernmental organization, which shall be treated as if it had been filed on the date of the international registration according to Article 3(4) or on the date of recordal of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, enjoy the same priority, provided that

(i) such application is filed within two years from the date on which the denunciation became effective,

(ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international registration in respect of the denouncing State or intergovernmental organization, and

(iii) such application complies with all the requirements of the applicable law, including the requirements concerning fees.

(b) The provisions of subparagraph (a) shall also apply in respect of any mark that is the subject of an international registration having effect in Contracting Parties other than the denouncing State or intergovernmental organization at the date on which denunciation becomes effective and whose holder, because of the denunciation, is no longer entitled to file international applications under Article 2(1).

Article 16
Signature; Languages; Depository Functions

(1) (a) This Protocol shall be signed in a single copy in the English, French and Spanish languages, and shall be deposited with the Director General when it ceases to be open for signature at Madrid. The texts in the three languages shall be equally authentic.

(b) Official texts of this Protocol shall be established by the Director General, after consultation with the interested governments and organizations, in the Arabic, Chinese, German, Italian, Japanese, Portuguese and Russian languages, and in such other languages as the Assembly may designate.
(2) This Protocol shall remain open for signature at Madrid until December 31, 1989. 

(3) The Director General shall transmit two copies, certified by the Government of Spain, of the signed texts of this Protocol to all States and intergovernmental organizations that may become party to this Protocol.

(4) The Director General shall register this Protocol with the Secretariat of the United Nations.

(5) The Director General shall notify all States and international organizations that may become or are party to this Protocol of signatures, deposits of instruments of ratification, acceptance, approval or accession, the entry into force of this Protocol and any amendment thereto, any notification of denunciation and any declaration provided for in this Protocol.
SINGAPORE TREATY ON THE LAW OF TRADEMARKS

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Article 1
Abbreviated Expressions

For the purposes of this Treaty, unless expressly stated otherwise:
(i) "Office" means the agency entrusted by a Contracting Party with the registration of marks;
(ii) "registration" means the registration of a mark by an Office; (iii) "application" means an application for registration;
(iv) "communication" means any application, or any request, declaration, correspondence or other information relating to an application or a registration, which is filed with the Office;
(v) references to a "person" shall be construed as references to both a natural person and a legal entity;
(vi) "holder" means the person whom the register of marks shows as the holder of the registration;
(vii) "register of marks" means the collection of data maintained by an Office, which includes the contents of all registrations and all data recorded in respect of all registrations, irrespective of the medium in which such data are stored;
(viii) "procedure before the Office" means any procedure in proceedings before the Office with respect to an application or a registration;
(ix) "Paris Convention" means the Paris Convention for the Protection of Industrial Property, signed at Paris on March 20, 1883, as revised and amended;
(x) "Nice Classification" means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, signed at Nice on June 15, 1957, as revised and amended;
(xi) "license" means a license for the use of a mark under the law of a Contracting Party;
(xii) "licensee" means the person to whom a license has been granted;
(xiii) "Contracting Party" means any State or intergovernmental organization party to this Treaty;
(xiv) "Diplomatic Conference" means the convocation of Contracting Parties for the purpose of revising or amending the Treaty;
(xv) "Assembly" means the Assembly referred to in Article 23;
(xvi) references to an "instrument of ratification" shall be construed as including references to instruments of acceptance and approval;
(xvii) "Organization" means the World Intellectual Property Organization;
(xviii) "International Bureau" means the International Bureau of the Organization;
"Director General" means the Director General of the Organization;
"Regulations" means the Regulations under this Treaty that are referred to in Article 22;
references to an "Article" or to a "paragraph", "subparagraph" or "item" of an Article shall be construed as including references to the corresponding rule(s) under the Regulations;

Article 2
Marks to Which the Treaty Applies
[Nature of Marks]

(1) Any Contracting Party shall apply this Treaty to marks consisting of signs that can be registered as marks under its law.
(2) [Kinds of Marks]
(a) This Treaty shall apply to marks relating to goods (trademarks) or services (service marks) or both goods and services.
(b) This Treaty shall not apply to collective marks, certification marks and guarantee marks.

Article 3
Application

(1) [Indications or Elements Contained in or Accompanying an Application; Fee]
(a) Any Contracting Party may require that an application contain some or all of the following indications or elements:
(i) a request for registration; (ii) the name and address of the applicant;
(iii) the name of a State of which the applicant is a national if he/she is the national of any State, the name of a State in which the applicant has his/her domicile, if any, and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any;
(iv) where the applicant is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;
(v) where the applicant has a representative, the name and address of that representative;
(vi) where an address for service is required under Article 4(2)(b), such address;

(vii) where the applicant wishes to take advantage of the priority of an earlier application, a declaration claiming the priority of that earlier application, together with indications and evidence in support of the declaration of priority that may be required pursuant to Article 4 of the Paris Convention;

(viii) where the applicant wishes to take advantage of any protection resulting from the display of goods and/or services in an exhibition, a declaration to that effect, together with indications in support of that declaration, as required by the law of the Contracting Party;

(ix) at least one representation of the mark, as prescribed in the Regulations;

(x) where applicable, a statement, as prescribed in the Regulations, indicating the type of mark as well as any specific requirements applicable to that type of mark;

(xi) where applicable, a statement, as prescribed in the Regulations, indicating that the applicant wishes that the mark be registered and published in the standard characters used by the Office;

(xii) where applicable, a statement, as prescribed in the Regulations, indicating that the applicant wishes to claim color as a distinctive feature of the mark;

(xiii) a transliteration of the mark or of certain parts of the mark;

(xiv) a translation of the mark or of certain parts of the mark;

(xv) the names of the goods and/or services for which the registration is sought, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification;

(xvi) a declaration of intention to use the mark, as required by the law of the Contracting Party.

(b) The applicant may file, instead of or in addition to the declaration of intention to use the mark referred to in subparagraph (a)(xvi), a declaration of actual use of the mark and evidence to that effect, as required by the law of the Contracting Party.

(c) Any Contracting Party may require that, in respect of the application, fees be paid to the Office.

(2) [Single Application for Goods and/or Services in Several Classes]
One and the same application may relate to several goods and/or services, irrespective of whether they belong to one class or to several classes of the Nice Classification.

(3) [Actual Use] Any Contracting Party may require that, where a declaration of intention to use has been filed under paragraph (1)(a)(xvi), the
applicant furnish to the Office within a time limit fixed in its law, subject to the minimum time limit prescribed in the Regulations, evidence of the actual use of the mark, as required by the said law.

(4) [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (3) and in Article 8 be complied with in respect of the application. In particular, the following may not be required in respect of the application throughout its pendency:

(i) the furnishing of any certificate of, or extract from, a register of commerce;
(ii) an indication of the applicant's carrying on of an industrial or commercial activity, as well as the furnishing of evidence to that effect;
(iii) an indication of the applicant's carrying on of an activity corresponding to the goods and/or services listed in the application, as well as the furnishing of evidence to that effect;
(iv) the furnishing of evidence to the effect that the mark has been registered in the register of marks of another Contracting Party or of a State party to the Paris Convention which is not a Contracting Party, except where the applicant claims the application of Article 6quinquies of the Paris Convention.

(5) [Evidence] Any Contracting Party may require that evidence be furnished to the Office in the course of the examination of the application where the Office may reasonably doubt the veracity of any indication or element contained in the application.

Article 4
Representation; Address for Service

(1) [Representatives Admitted to Practice]

(a) Any Contracting Party may require that a representative appointed for the purposes of any procedure before the Office
(i) have the right, under the applicable law, to practice before the Office in respect of applications and registrations and, where applicable, be admitted to practice before the Office;
(ii) provide, as its address, an address on a territory prescribed by the Contracting Party.

(b) An act, with respect to any procedure before the Office, by or in relation to a representative who complies with the requirements applied by the Contracting Party under subparagraph (a), shall have the effect of an act by or in relation to the applicant, holder or other interested person who appointed that representative.

(2) [Mandatory Representation; Address for Service]
(a) Any Contracting Party may require that, for the purposes of any procedure before the Office, an applicant, holder or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment on its territory be represented by a representative.

(b) Any Contracting Party may, to the extent that it does not require representation in accordance with subparagraph (a), require that, for the purposes of any procedure before the Office, an applicant, holder or other interested person who has neither a domicile nor a real and effective industrial or commercial establishment on its territory have an address for service on that territory.

(3) \[Power of Attorney\]

(a) Whenever a Contracting Party allows or requires an applicant, a holder or any other interested person to be represented by a representative before the Office, it may require that the representative be appointed in a separate communication (hereinafter referred to as "power of attorney") indicating the name of the applicant, the holder or the other person, as the case may be.

(b) The power of attorney may relate to one or more applications and/or registrations identified in the power of attorney or, subject to any exception indicated by the appointing person, to all existing and future applications and/or registrations of that person.

(c) The power of attorney may limit the powers of the representative to certain acts. Any Contracting Party may require that any power of attorney under which the representative has the right to withdraw an application or to surrender a registration contain an express indication to that effect.

(d) Where a communication is submitted to the Office by a person who refers to itself in the communication as a representative but where the Office is, at the time of the receipt of the communication, not in possession of the required power of attorney, the Contracting Party may require that the power of attorney be submitted to the Office within the time limit fixed by the Contracting Party, subject to the minimum time limit prescribed in the Regulations. Any Contracting Party may provide that, where the power of attorney has not been submitted to the Office within the time limit fixed by the Contracting Party, the communication by the said person shall have no effect.

(4) \[Reference to Power of Attorney\] Any Contracting Party may require that any communication made to the Office by a representative for the purposes of a procedure before the Office contain a reference to the power of attorney on the basis of which the representative acts.

(5) \[Prohibition of Other Requirements\] No Contracting Party may demand that requirements other than those referred to in paragraphs (3) and (4) and in Article 8 be complied with in respect of the matters dealt with in those paragraphs.
Any Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in any communication referred to in paragraphs (3) and (4).

**Article 5**

**Filing Date**

(1) **[Permitted Requirements]**

(a) Subject to subparagraph (b) and paragraph (2), a Contracting Party shall accord as the filing date of an application the date on which the Office received the following indications and elements in the language required under Article 8(2):

(i) an express or implicit indication that the registration of a mark is sought;

(ii) indications allowing the identity of the applicant to be established;

(iii) indications allowing the applicant or its representative, if any, to be contacted by the Office;

(iv) a sufficiently clear representation of the mark whose registration is sought;

(v) the list of the goods and/or services for which the registration is sought;

(vi) where Article 3(1)(a)(xvi) or (b) applies, the declaration referred to in Article 3(1)(a)(xvi) or the declaration and evidence referred to in Article 3(1)(b), respectively, as required by the law of the Contracting Party.

(b) Any Contracting Party may accord as the filing date of the application the date on which the Office received only some, rather than all, of the indications and elements referred to in subparagraph (a) or received them in a language other than the language required under Article 8(2).

(2) **[Permitted Additional Requirement]**

(a) A Contracting Party may provide that no filing date shall be accorded until the required fees are paid.

(b) A Contracting Party may apply the requirement referred to in subparagraph (a) only if it applied such requirement at the time of becoming party to this Treaty.

(3) **[Corrections and Time Limits]** The modalities of, and time limits for, corrections under paragraphs (1) and (2) shall be fixed in the Regulations.

(4) **[Prohibition of Other Requirements]** No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) be complied with in respect of the filing date.
Article 6
Single Registration for Goods and/or Services in Several Classes

Where goods and/or services belonging to several classes of the Nice Classification have been included in one and the same application, such an application shall result in one and the same registration.

Article 7
Division of Application and Registration

(1) [Division of Application]
(a) Any application listing several goods and/or services (hereinafter referred to as "initial application") may,
   (i) at least until the decision by the Office on the registration of the mark,
   (ii) during any opposition proceedings against the decision of the Office to register the mark,
   (iii) during any appeal proceedings against the decision on the registration of the mark, be divided by the applicant or at its request into two or more applications (hereinafter referred to as "divisional applications") by distributing among the latter the goods and/or services listed in the initial application. The divisional applications shall preserve the filing date of the initial application and the benefit of the right of priority, if any.

(b) Any Contracting Party shall, subject to subparagraph (a), be free to establish requirements for the division of an application, including the payment of fees.

(2) [Division of Registration] Paragraph (1) shall apply, mutatis mutandis, with respect to a division of a registration. Such a division shall be permitted
   (i) during any proceedings in which the validity of the registration is challenged before the Office by a third party,
   (ii) during any appeal proceedings against a decision taken by the Office during the former proceedings, provided that a Contracting Party may exclude the possibility of the division of registrations if its law allows third parties to oppose the registration of a mark before the mark is registered.
Article 8
Communications

(1) [Means of Transmittal and Form of Communications] Any Contracting Party may choose the means of transmittal of communications and whether it accepts communications on paper, communications in electronic form or any other form of communication.

(2) [Language of Communications]
   (a) Any Contracting Party may require that any communication be in a language admitted by the Office. Where the Office admits more than one language, the applicant, holder or other interested person may be required to comply with any other language requirement applicable with respect to the Office, provided that no indication or element of the communication may be required to be in more than one language.
   
   (b) No Contracting Party may require the attestation, notarization, authentication, legalization or any other certification of any translation of a communication other than as provided under this Treaty.
   
   (c) Where a Contracting Party does not require a communication to be in a language admitted by its Office, the Office may require that a translation of that communication by an official translator or a representative, into a language admitted by the Office, be supplied within a reasonable time limit.

(3) [Signature of Communications on Paper]
   (a) Any Contracting Party may require that a communication on paper be signed by the applicant, holder or other interested person. Where a Contracting Party requires a communication on paper to be signed, that Contracting Party shall accept any signature that complies with the requirements prescribed in the Regulations.
   
   (b) No Contracting Party may require the attestation, notarization, authentication, legalization or other certification of any signature except, where the law of the Contracting Party so provides, if the signature concerns the surrender of a registration.
   
   (c) Notwithstanding subparagraph (b), a Contracting Party may require that evidence be filed with the Office where the Office may reasonably doubt the authenticity of any signature of a communication on paper.

(4) [Communications Filed in Electronic Form or by Electronic Means of Transmittal] Where a Contracting Party permits the filing of communications in electronic form or by electronic means of transmittal, it may require that any such communications comply with the requirements prescribed in the Regulations.

(5) [Presentation of a Communication] Any Contracting Party shall accept the presentation of a communication the content of which corresponds to the relevant Model International Form, if any, provided for in the Regulations.

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(6) **[Prohibition of Other Requirements]** No Contracting Party may demand that, in respect of paragraphs (1) to (5), requirements other than those referred to in this Article be complied with.

(7) **[Means of Communication with Representative]** Nothing in this Article regulates the means of communication between an applicant, holder or other interested person and its representative.

**Article 9**

**Classification of Goods and/or Services**

(1) **[Indications of Goods and/or Services]** Each registration and any publication effected by an Office which concerns an application or registration and which indicates goods and/or services shall indicate the goods and/or services by their names, grouped according to the classes of the Nice Classification, and each group shall be preceded by the number of the class of that Classification to which that group of goods or services belongs and shall be presented in the order of the classes of the said Classification.

(2) **[Goods or Services in the Same Class or in Different Classes]**

(a) Goods or services may not be considered as being similar to each other on the ground that, in any registration or publication by the Office, they appear in the same class of the Nice Classification.

(b) Goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication by the Office, they appear in different classes of the Nice Classification.

**Article 10**

**Changes in Names or Addresses**

(1) **[Changes in the Name or Address of the Holder]**

(a) Where there is no change in the person of the holder but there is a change in its name and/or address, each Contracting Party shall accept that a request for the recordal of the change by the Office in its register of marks be made by the holder in a communication indicating the registration number of the registration concerned and the change to be recorded.

(b) Any Contracting Party may require that the request indicate

(i) the name and address of the holder;

(ii) where the holder has a representative, the name and address of that representative;

(iii) where the holder has an address for service, such address.
(c) Any Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(d) A single request shall be sufficient even where the change relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request.

(2) [Change in the Name or Address of the Applicant] Paragraph (1) shall apply, mutatis mutandis, where the change concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or its representative, the request otherwise identifies that application as prescribed in the Regulations.

(3) [Change in the Name or Address of the Representative or in the Address for Service] Paragraph (1) shall apply, mutatis mutandis, to any change in the name or address of the representative, if any, and to any change relating to the address for service, if any.

(4) [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (3) and in Article 8 be complied with in respect of the request referred to in this Article. In particular, the furnishing of any certificate concerning the change may not be required.

(5) [Evidence] Any Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in the request.

**Article 11**

**Change in Ownership**

(1) [Change in the Ownership of a Registration]

(a) Where there is a change in the person of the holder, each Contracting Party shall accept that a request for the recordal of the change by the Office in its register of marks be made by the holder or by the person who acquired the ownership (hereinafter referred to as "new owner") in a communication indicating the registration number of the registration concerned and the change to be recorded.

(b) Where the change in ownership results from a contract, any Contracting Party may require that the request indicate that fact and be accompanied, at the option of the requesting party, by one of the following:

(i) a copy of the contract, which copy may be required to be certified, by a notary public or any other competent public authority, as being in conformity with the original contract;
(ii) an extract of the contract showing the change in ownership, which extract may be required to be certified, by a notary public or any other competent public authority, as being a true extract of the contract;

(iii) an uncertified certificate of transfer drawn up in the form and with the content as prescribed in the Regulations and signed by both the holder and the new owner;

(iv) an uncertified transfer document drawn up in the form and with the content as prescribed in the Regulations and signed by both the holder and the new owner.

(c) Where the change in ownership results from a merger, any Contracting Party may require that the request indicate that fact and be accompanied by a copy of a document, which document originates from the competent authority and evidences the merger, such as a copy of an extract from a register of commerce, and that that copy be certified by the authority which issued the document or by a notary public or any other competent public authority, as being in conformity with the original document.

(d) Where there is a change in the person of one or more but not all of several co-holders and such change in ownership results from a contract or a merger, any Contracting Party may require that any co-holder in respect of which there is no change in ownership give its express consent to the change in ownership in a document signed by it.

(e) Where the change in ownership does not result from a contract or a merger but from another ground, for example, from operation of law or a court decision, any Contracting Party may require that the request indicate that fact and be accompanied by a copy of a document evidencing the change and that that copy be certified as being in conformity with the original document by the authority which issued the document or by a notary public or any other competent public authority.

(f) Any Contracting Party may require that the request indicate

(i) the name and address of the holder;

(ii) the name and address of the new owner;

(iii) the name of a State of which the new owner is a national if he/she is the national of any State, the name of a State in which the new owner has his/her domicile, if any, and the name of a State in which the new owner has a real and effective industrial or commercial establishment, if any;

(iv) where the new owner is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(v) where the holder has a representative, the name and address of that representative;

(vi) where the holder has an address for service, such address;
(vii) where the new owner has a representative, the name and address of that representative;

(viii) where the new owner is required to have an address for service under Article 4(2)(b), such address.

(g) Any Contracting Party may require that, in respect of the request, a fee be paid to the Office.

(h) A single request shall be sufficient even where the change relates to more than one registration, provided that the holder and the new owner are the same for each registration and that the registration numbers of all registrations concerned are indicated in the request.

(i) Where the change of ownership does not affect all the goods and/or services listed in the holder's registration, and the applicable law allows the recording of such change, the Office shall create a separate registration referring to the goods and/or services in respect of which the ownership has changed.

(2) [Change in the Ownership of an Application] Paragraph (1) shall apply, mutatis mutandis, where the change in ownership concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or its representative, the request otherwise identifies that application as prescribed in the Regulations.

(3) [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) and in Article 8 be complied with in respect of the request referred to in this Article. In particular, the following may not be required:

(i) subject to paragraph (1)(c), the furnishing of any certificate of, or extract from, a register of commerce;

(ii) an indication of the new owner's carrying on of an industrial or commercial activity, as well as the furnishing of evidence to that effect;

(iii) an indication of the new owner's carrying on of an activity corresponding to the goods and/or services affected by the change in ownership, as well as the furnishing of evidence to either effect;

(iv) an indication that the holder transferred, entirely or in part, its business or the relevant goodwill to the new owner, as well as the furnishing of evidence to either effect.

(4) [Evidence] Any Contracting Party may require that evidence, or further evidence where paragraph (1)(c) or (e) applies, be furnished to the Office where that Office may reasonably doubt the veracity of any indication contained in the request or in any document referred to in the present Article.
Article 12  
Correction of a Mistake

(1)  [Correction of a Mistake in Respect of a Registration]  
(a) Each Contracting Party shall accept that the request for the correction of a mistake which was made in the application or other request communicated to the Office and which mistake is reflected in its register of marks and/or any publication by the Office be made by the holder in a communication indicating the registration number of the registration concerned, the mistake to be corrected and the correction to be entered.  
(b) Any Contracting Party may require that the request indicate  
(i) the name and address of the holder;  
(ii) where the holder has a representative, the name and address of that representative;  
(iii) where the holder has an address for service, such address.  
(c) Any Contracting Party may require that, in respect of the request, a fee be paid to the Office.  
(d) A single request shall be sufficient even where the correction relates to more than one registration of the same person, provided that the mistake and the requested correction are the same for each registration and that the registration numbers of all registrations concerned are indicated in the request.

(2)  [Correction of a Mistake in Respect of an Application] Paragraph (1) shall apply, mutatis mutandis, where the mistake concerns an application or applications, or both an application or applications and a registration or registrations, provided that, where the application number of any application concerned has not yet been issued or is not known to the applicant or its representative, the request otherwise identifies that application as prescribed in the Regulations.

(3)  [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraphs (1) and (2) and in Article 8 be complied with in respect of the request referred to in this Article.

(4)  [Evidence] Any Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt that the alleged mistake is in fact a mistake.

(5)  [Mistakes Made by the Office] The Office of a Contracting Party shall correct its own mistakes, ex officio or upon request, for no fee.

(6)  [Uncorrectable Mistakes] No Contracting Party shall be obliged to apply paragraphs (1), (2) and (5) to any mistake which cannot be corrected under its law.
Article 13

Duration and Renewal of Registration

(1) [Indications or Elements Contained in or Accompanying a Request for Renewal; Fee]

(a) Any Contracting Party may require that the renewal of a registration be subject to the filing of a request and that such request contain some or all of the following indications:

(i) an indication that renewal is sought; (ii) the name and address of the holder; (iii) the registration number of the registration concerned;
(iv) at the option of the Contracting Party, the filing date of the application which resulted in the registration concerned or the registration date of the registration concerned;
(v) where the holder has a representative, the name and address of that representative;
(vi) where the holder has an address for service, such address;
(vii) where the Contracting Party allows the renewal of a registration to be made for some only of the goods and/or services which are recorded in the register of marks and such a renewal is requested, the names of the recorded goods and/or services for which the renewal is requested or the names of the recorded goods and/or services for which the renewal is not requested, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification;
(viii) where a Contracting Party allows a request for renewal to be filed by a person other than the holder or its representative and the request is filed by such a person, the name and address of that person.

(b) Any Contracting Party may require that, in respect of the request for renewal, a fee be paid to the Office. Once the fee has been paid in respect of the initial period of the registration or of any renewal period, no further payment may be required for the maintenance of the registration in respect of that period. Fees associated with the furnishing of a declaration and/or evidence of use shall not be regarded, for the purposes of this subparagraph, as payments required for the maintenance of the registration and shall not be affected by this subparagraph.

(c) Any Contracting Party may require that the request for renewal be presented, and the corresponding fee referred to in subparagraph (b) be paid, to the Office within the period fixed by the law of the Contracting Party, subject to the minimum periods prescribed in the Regulations.

(2) [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraph (1) and in
Article 8 be complied with in respect of the request for renewal. In particular, the following may not be required:

(i) any representation or other identification of the mark;
(ii) the furnishing of evidence to the effect that the mark has been registered, or that its registration has been renewed, in any other register of marks;
(iii) the furnishing of a declaration and/or evidence concerning use of the mark.

(3) [Evidence] Any Contracting Party may require that evidence be furnished to the Office in the course of the examination of the request for renewal where the Office may reasonably doubt the veracity of any indication or element contained in the request for renewal.

(4) [Prohibition of Substantive Examination] No Office of a Contracting Party may, for the purposes of effecting the renewal, examine the registration as to substance.

(5) [Duration] The duration of the initial period of the registration, and the duration of each renewal period, shall be 10 years.

Article 14

Relief Measures in Case of Failure to Comply with Time Limits

(1) [Relief Measure Before the Expiry of a Time Limit] A Contracting Party may provide for the extension of a time limit for an action in a procedure before the Office in respect of an application or a registration, if a request to that effect is filed with the Office prior to the expiry of the time limit.

(2) [Relief Measures After the Expiry of a Time Limit] Where an applicant, holder or other interested person has failed to comply with a time limit ("the time limit concerned") for an action in a procedure before the Office of a Contracting Party in respect of an application or a registration, the Contracting Party shall provide for one or more of the following relief measures, in accordance with the requirements prescribed in the Regulations, if a request to that effect is filed with the Office:

(i) extension of the time limit concerned for the period prescribed in the Regulations;
(ii) continued processing with respect to the application or registration;
(iii) reinstatement of the rights of the applicant, holder or other interested person with respect to the application or registration if the Office finds that the failure to comply with the time limit concerned occurred in spite of due care required by the circumstances having been taken or, at the option of the Contracting Party, that the failure was unintentional.

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(3) [Exceptions] No Contracting Party shall be required to provide for any of the relief measures referred to in paragraph (2) with respect to the exceptions prescribed in the Regulations.

(4) [Fee] Any Contracting Party may require that a fee be paid in respect of any of the relief measures referred to in paragraphs (1) and (2).

(5) [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in this Article and in Article 8 be complied with in respect of any of the relief measures referred to in paragraph (2).

Article 15
Obligation to Comply with the Paris Convention

Any Contracting Party shall comply with the provisions of the Paris Convention which concern marks.

Article 16
Service Marks

Any Contracting Party shall register service marks and apply to such marks the provisions of the Paris Convention which concern trademarks.

Article 17
Request for Recordal of a License

(1) [Requirements Concerning the Request for Recordal] Where the law of a Contracting Party provides for the recordal of a license with its Office, that Contracting Party may require that the request for recordal

(i) be filed in accordance with the requirements prescribed in the Regulations, and

(ii) be accompanied by the supporting documents prescribed in the Regulations.

(2) [Fee] Any Contracting Party may require that, in respect of the recordal of a license, a fee be paid to the Office.

(3) [Single Request Relating to Several Registrations] A single request shall be sufficient even where the license relates to more than one registration, provided that the registration numbers of all registrations concerned are indicated in the request, the holder and the licensee are the same for all registrations, and the request indicates the scope of the license in accordance with the Regulations with respect to all registrations.
(4) **[Prohibition of Other Requirements]**

(a) No Contracting Party may demand that requirements other than those referred to in paragraphs (1) to (3) and in Article 8 be complied with in respect of the recordal of a license with its Office. In particular, the following may not be required:

(i) the furnishing of the registration certificate of the mark which is the subject of the license;
(ii) the furnishing of the license contract or a translation of it;
(iii) an indication of the financial terms of the license contract.

(b) Subparagraph (a) is without prejudice to any obligations existing under the law of a Contracting Party concerning the disclosure of information for purposes other than the recording of the license in the register of marks.

(5) **[Evidence]** Any Contracting Party may require that evidence be furnished to the Office where the Office may reasonably doubt the veracity of any indication contained in the request or in any document referred to in the Regulations.

(6) **[Requests Relating to Applications]** Paragraphs (1) to (5) shall apply, _mutatis mutandis_, to requests for recordal of a license for an application, where the law of a Contracting Party provides for such recordal.

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**Article 18**

**Request for Amendment or Cancellation of the Recordal of a License**

(1) **[Requirements Concerning the Request]** Where the law of a Contracting Party provides for the recordal of a license with its Office, that Contracting Party may require that the request for amendment or cancellation of the recordal of a license

(i) be filed in accordance with the requirements prescribed in the Regulations, and

(ii) be accompanied by the supporting documents prescribed in the Regulations.

(2) **[Other Requirements]** Article 17(2) to (6) shall apply, _mutatis mutandis_, to requests for amendment or cancellation of the recordal of a license.

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**Article 19**

**Effects of the Non-Recordal of a License**

(1) **[Validity of the Registration and Protection of the Mark]** The non-recordal of a license with the Office or with any other authority of the
Contracting Party shall not affect the validity of the registration of the mark which is the subject of the license or the protection of that mark.

(2) [Certain Rights of the Licensee] A Contracting Party may not require the recordal of a license as a condition for any right that the licensee may have under the law of the Contracting Party to join infringement proceedings initiated by the holder or to obtain, by way of such proceedings, damages resulting from an infringement of the mark which is the subject of the license.

(3) [Use of a Mark Where License Is Not Recorded] A Contracting Party may not require the recordal of a license 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.

Article 20
Indication of the License

Where the law of a Contracting Party requires an indication that the mark is used under a license, full or partial non-compliance with that requirement shall not affect the validity of the registration of the mark which is the subject of the license or the protection of that mark, and shall not affect the application of Article 19(3).

Article 21
Observations in Case of Intended Refusal

An application under Article 3 or a request under Articles 7, 10 to 14, 17 and 18 may not be refused totally or in part by an Office without giving the applicant or the requesting party, as the case may be, an opportunity to make observations on the intended refusal within a reasonable time limit. In respect of Article 14, no Office shall be required to give an opportunity to make observations where the person requesting the relief measure has already had an opportunity to present an observation on the facts on which the decision is to be based.

Article 22
Regulations

(1) [Content]
(a) The Regulations annexed to this Treaty provide rules concerning
(i) matters which this Treaty expressly provides to be "prescribed in the Regulations";

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(ii) any details useful in the implementation of the provisions of this Treaty;  
(iii) any administrative requirements, matters or procedures.

(b) The Regulations also contain Model International Forms.

(2) [Amending the Regulations] Subject to paragraph (3), any amendment of the Regulations shall require three-fourths of the votes cast.

(3) [Requirement of Unanimity]  
(a) The Regulations may specify provisions of the Regulations which may be amended only by unanimity.
(b) Any amendment of the Regulations resulting in the addition of provisions to, or the deletion of provisions from, the provisions specified in the Regulations pursuant to subparagraph (a) shall require unanimity.
(c) In determining whether unanimity is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(4) [Conflict Between the Treaty and the Regulations] In the case of conflict between the provisions of this Treaty and those of the Regulations, the former shall prevail.

Article 23
Assembly

(1) [Composition]  
(a) The Contracting Parties shall have an Assembly.
(b) Each Contracting Party shall be represented in the Assembly by one delegate, who may be assisted by alternate delegates, advisors and experts. Each delegate may represent only one Contracting Party.

(2) [Tasks] The Assembly shall  
(i) deal with matters concerning the development of this Treaty; (ii) amend the Regulations, including the Model International Forms;  
(iii) determine the conditions for the date of application of each amendment referred to in item (ii);  
(iv) perform such other functions as are appropriate to implementing the provisions of this Treaty.

(3) [Quorum]  
(a) One-half of the members of the Assembly which are States shall constitute a quorum.
(b) Notwithstanding subparagraph (a), if, in any session, the number of the members of the Assembly which are States and are represented is less than one-half but equal to or more than one-third of the members of the Assembly which are States, the Assembly may make decisions but, with the
exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the members of the Assembly which are States and were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of such members having thus expressed their vote or abstention attains the number of the members which was lacking for attaining the quorum in the session itself, such decisions shall take effect, provided that at the same time the required majority still obtains.

(4) [Taking Decisions in the Assembly]
   (a) The Assembly shall endeavor to take its decisions by consensus.
   (b) Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such a case,
      (i) each Contracting Party that is a State shall have one vote and shall vote only in its own name; and
      (ii) any Contracting Party that is an intergovernmental organization may participate in the vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Treaty. No such intergovernmental organization shall participate in the vote if any one of its Member States exercises its right to vote and vice versa. In addition, no such intergovernmental organization may participate in the vote if any one of its Member States party to this Treaty is a Member State of another such intergovernmental organization and that other intergovernmental organization participates in that vote.

(5) [Majorities]
   (a) Subject to Articles 22(2) and (3), the decisions of the Assembly shall require two thirds of the votes cast.
   (b) In determining whether the required majority is attained, only votes actually cast shall be taken into consideration. Abstentions shall not be considered as votes.

(6) [Sessions] The Assembly shall meet upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(7) [Rules of Procedure] The Assembly shall establish its own rules of procedure, including rules for the convocation of extraordinary sessions.
Article 24  
International Bureau

(1) [Administrative Tasks]  
(a) The International Bureau shall perform the administrative tasks concerning this Treaty.  
(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may be established by the Assembly.

(2) [Meetings Other than Sessions of the Assembly] The Director General shall convene any committee and working group established by the Assembly.

(3) [Role of the International Bureau in the Assembly and Other Meetings]  
(a) The Director General and persons designated by the Director General shall participate, without the right to vote, in all meetings of the Assembly, the committees and working groups established by the Assembly.  
(b) The Director General or a staff member designated by the Director General shall be ex officio secretary of the Assembly, and of the committees and working groups referred to in subparagraph (a).

(4) [Conferences]  
(a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for any revision conferences.  
(b) The International Bureau may consult with Member States of the Organization, intergovernmental organizations and international and national non-governmental organizations concerning the said preparations.  
(c) The Director General and persons designated by the Director General shall take part, without the right to vote, in the discussions at revision conferences.

(5) [Other Tasks] The International Bureau shall carry out any other tasks assigned to it in relation to this Treaty.

Article 25  
Revision or Amendment

This Treaty may only be revised or amended by a diplomatic conference. The convocation of any diplomatic conference shall be decided by the Assembly.
Article 26
Becoming Party to the Treaty

(1) [Eligibility] The following entities may sign and, subject to paragraphs (2) and (3) and Article 28(1) and (3), become party to this Treaty:

(i) any State member of the Organization in respect of which marks may be registered with its own Office;

(ii) any intergovernmental organization which maintains an Office in which marks may be registered with effect in the territory in which the constituting treaty of the intergovernmental organization applies, in all its Member States or in those of its Member States which are designated for such purpose in the relevant application, provided that all the Member States of the intergovernmental organization are members of the Organization;

(iii) any State member of the Organization in respect of which marks may be registered only through the Office of another specified State that is a member of the Organization;

(iv) any State member of the Organization in respect of which marks may be registered only through the Office maintained by an intergovernmental organization of which that State is a member;

(v) any State member of the Organization in respect of which marks may be registered only through an Office common to a group of States members of the Organization.

(2) [Ratification or Accession] Any entity referred to in paragraph (1) may deposit

(i) an instrument of ratification, if it has signed this Treaty,

(ii) an instrument of accession, if it has not signed this Treaty.

(3) [Effective Date of Deposit] The effective date of the deposit of an instrument of ratification or accession shall be,

(i) in the case of a State referred to in paragraph (1)(i), the date on which the instrument of that State is deposited;

(ii) in the case of an intergovernmental organization, the date on which the instrument of that intergovernmental organization is deposited;

(iii) in the case of a State referred to in paragraph (1)(iii), the date on which the following condition is fulfilled: the instrument of that State has been deposited and the instrument of the other, specified State has been deposited;

(iv) in the case of a State referred to in paragraph (1)(iv), the date applicable under item (ii), above;

(v) in the case of a State member of a group of States referred to in paragraph (1)(v), the date on which the instruments of all the States members of the group have been deposited.
Article 27
Application of the TLT 1994 and This Treaty

(1) [Relations Between Contracting Parties to Both This Treaty and the TLT 1994] This Treaty alone shall be applicable as regards the mutual relations of Contracting Parties to both this Treaty and the TLT 1994.

(2) [Relations Between Contracting Parties to This Treaty and Contracting Parties to the TLT 1994 That Are Not Party to This Treaty] Any Contracting Party to both this Treaty and the TLT 1994 shall continue to apply the TLT 1994 in its relations with Contracting Parties to the TLT 1994 that are not party to this Treaty.

Article 28
Entry into Force;
Effective Date of Ratifications and Accessions

(1) [Instruments to Be Taken into Consideration] For the purposes of this Article, only instruments of ratification or accession that are deposited by entities referred to in Article 26(1) and that have an effective date according to Article 26(3) shall be taken into consideration.

(2) [Entry into Force of the Treaty] This Treaty shall enter into force three months after ten States or intergovernmental organizations referred to in Article 26(1)(ii) have deposited their instruments of ratification or accession.

(3) [Entry into Force of Ratifications and Accessions Subsequent to the Entry into Force of the Treaty] Any entity not covered by paragraph (2) shall become bound by this Treaty three months after the date on which it has deposited its instrument of ratification or accession.

Article 29
Reservations

(1) [Special Kinds of Marks] Any State or intergovernmental organization may declare through a reservation that, notwithstanding Article 2(1) and (2)(a), any of the provisions of Articles 3(1), 5, 7, 8(5), 11 and 13 shall not apply to associated marks, defensive marks or derivative marks. Such reservation shall specify those of the aforementioned provisions to which the reservation relates.

(2) [Multiple-class Registration] Any State or intergovernmental organization, whose legislation at the date of adoption of this Treaty provides for a multiple-class registration for goods and for a multiple-class registration for
services may, when acceding to this Treaty, declare through a reservation that the provisions of Article 6 shall not apply.

(3) [Substantive Examination on the Occasion of Renewal] Any State or intergovernmental organization may declare through a reservation that, notwithstanding Article 13(4), the Office may, on the occasion of the first renewal of a registration covering services, examine such registration as to substance, provided that such examination shall be limited to the elimination of multiple registrations based on applications filed during a period of six months following the entry into force of the law of such State or organization that introduced, before the entry into force of this Treaty, the possibility of registering service marks.

(4) [Certain Rights of the Licensee] Any State or intergovernmental organization may declare through a reservation that, notwithstanding Article 19(2), it requires the recordal of a license as a condition for any right that the licensee may have under the law of that State or intergovernmental organization to join infringement proceedings initiated by the holder or to obtain, by way of such proceedings, damages resulting from an infringement of the mark which is the subject of the license.

(5) [Modalities] Any reservation under paragraphs (1), (2), (3) or (4) shall be made in a declaration accompanying the instrument of ratification of, or accession to, this Treaty of the State or intergovernmental organization making the reservation.

(6) [Withdrawal] Any reservation under paragraphs (1), (2), (3) or (4) may be withdrawn at any time.

(7) [Prohibition of Other Reservations] No reservation to this Treaty other than the reservations allowed under paragraphs (1), (2), (3) and (4) shall be permitted.

Article 30
Denunciation of the Treaty

(1) [Notification] Any Contracting Party may denounce this Treaty by notification addressed to the Director General.

(2) [Effective Date] Denunciation shall take effect one year from the date on which the Director General has received the notification. It shall not affect the application of this Treaty to any application pending or any mark registered in respect of the denouncing Contracting Party at the time of the expiration of the said one-year period, provided that the denouncing Contracting Party may, after the expiration of the said one-year period, discontinue applying this Treaty to any registration as from the date on which that registration is due for renewal.
Article 31
Languages of the Treaty; Signature

(1) [Original Texts; Official Texts]
(a) This Treaty shall be signed in a single original in the English, Arabic, Chinese, French, Russian and Spanish languages, all texts being equally authentic.
(b) An official text in a language not referred to in subparagraph (a) that is an official language of a Contracting Party shall be established by the Director General after consultation with the said Contracting Party and any other interested Contracting Party.

(2) [Time Limit for Signature] This Treaty shall remain open for signature at the headquarters of the Organization for one year after its adoption.

Article 32
Depositary

The Director General shall be the depositary of this Treat
REGULATIONS UNDER THE SINGAPORE TREATY ON THE LAW OF TRADEMARKS

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Form No. 9  Request for Recordal of License

Form No. 10  Statement of License

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Rule 1
Abbreviated Expressions

(1) [Abbreviated Expressions Defined in the Regulations] For the purposes of these Regulations, unless expressly stated otherwise:
   (i) "Treaty" means the Singapore Treaty on the Law of Trademarks;
   (ii) "Article" refers to the specified Article of the Treaty;
   (iii) "exclusive license" means a license which is only granted to one licensee and which excludes the holder from using the mark and from granting licenses to any other person;
   (iv) "sole license" means a license which is only granted to one licensee and which excludes the holder from using the mark but does not exclude the holder from granting licenses to any other person;
   (v) "non-exclusive license" means a license which does not exclude the holder from using the mark or from granting licenses to any other person.

(2) [Abbreviated Expressions Defined in the Treaty] The abbreviated expressions defined in Article 1 for the purposes of the Treaty shall have the same meaning for the purposes of these Regulations.

Rule 2
Manner of Indicating Names and Addresses

(1) [Names]
   (a) Where the name of a person is to be indicated, any Contracting Party may require,
      (i) where the person is a natural person, that the name to be indicated be the family or principal name and the given or secondary name or names of that person or that the name to be indicated be, at that person's option, the name or names customarily used by the said person;
      (ii) where the person is a legal entity, that the name to be indicated be the full official designation of the legal entity.
   (b) Where the name of a representative which is a firm or partnership is to be indicated, any Contracting Party shall accept as indication of the name the indication that the firm or partnership customarily uses.

(2) [Addresses]
   (a) Where the address of a person is to be indicated, any Contracting Party may require that the address be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address and,
in any case, consist of all the relevant administrative units up to, and including, the house or building number, if any.

(b) Where a communication to the Office of a Contracting Party is in the name of two or more persons with different addresses, that Contracting Partymay require that such communication indicate a single address as the address for correspondence.

(c) The indication of an address may contain a telephone number, a telefacsimile number and an e-mail address and, for the purposes of correspondence, an address different from the address indicated under subparagraph (a).

(d) Subparagraphs (a) and (c) shall apply, mutatis mutandis, to addresses for service.

(3) [Other Means of Identification] Any Contracting Party may require that a communication to the Office indicate the number or other means of identification, if any, with which the applicant, holder, representative or interested person is registered with its Office. No Contracting Party may refuse a communication on grounds of failure to comply with any such requirement, except for applications filed in electronic form.

(4) [Script to Be Used] Any Contracting Party may require that any indication referred to in paragraphs (1) to (3) be in the script used by the Office.

**Rule 3**

*Details Concerning the Application*

(1) [Standard Characters] Where the Office of a Contracting Party uses characters (letters and numbers) that it considers as being standard, and where the application contains a statement to the effect that the applicant wishes that the mark be registered and published in the standard characters used by the Office, the Office shall register and publish that mark in such standard characters.

(2) [Mark Claiming Color] Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, the Office may require that the application indicate the name or code of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color.

(3) [Number of Reproductions]

(a) Where the application does not contain a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than
(i) five reproductions of the mark in black and white where the application may not, under the law of that Contracting Party, or does not contain a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of the said Contracting Party;

(ii) one reproduction of the mark in black and white where the application contains a statement to the effect that the applicant wishes the mark to be registered and published in the standard characters used by the Office of that Contracting Party.

(b) Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than five reproductions of the mark in black and white and five reproductions of the mark in color.

(4) [Three-Dimensional Mark]

(a) Where the application contains a statement to the effect that the mark is a three-dimensional mark, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction.

(b) The reproduction furnished under subparagraph (a) may, at the option of the applicant, consist of one single view of the mark or of several different views of the mark.

(c) Where the Office considers that the reproduction of the mark furnished by the applicant under subparagraph (a) does not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, up to six different views of the mark and/or a description by words of that mark.

(d) Where the Office considers that the different views and/or the description of the mark referred to in subparagraph (c) still do not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, a specimen of the mark.

(e) Paragraph (3)(a)(i) and (b) shall apply mutatis mutandis.

(5) [Hologram Mark, Motion Mark, Color Mark, Position Mark] Where the application contains a statement to the effect that the mark is a hologram mark, a motion mark, a color mark or a position mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark, as prescribed by the law of that Contracting Party.

(6) [Mark Consisting of a Non-Visible Sign] Where the application contains a statement to the effect that the mark consists of a non-visible sign, a Contracting Party may require one or more representations of the mark, an
indication of the type of mark and details concerning the mark, as prescribed by the law of that Contracting Party.

(7) [Transliteration of the Mark] For the purposes of Article 3(1)(a)(xiii), where the mark consists of or contains matter in script other than the script used by the Office or numbers expressed in numerals other than numerals used by the Office, a transliteration of such matter in the script and numerals used by the Office may be required.

(8) [Translation of the Mark] For the purposes of Article 3(1)(a)(xiv), where the mark consists of or contains a word or words in a language other than the language, or one of the languages, admitted by the Office, a translation of that word or those words into that language or one of those languages may be required.

(9) [Time Limit for Furnishing Evidence of Actual Use of the Mark] The time limit referred to in Article 3(3) shall not be shorter than six months counted from the date of allowance of the application by the Office of the Contracting Party where that application was filed. The applicant or holder shall have the right to an extension of that time limit, subject to the conditions provided for by the law of that Contracting Party, by periods of at least six months each, up to a total extension of at least two years and a half.

Rule 4
Details Concerning Representation and Address for Service

(1) [Address Where a Representative Is Appointed] Where a representative is appointed, a Contracting Party shall consider the address of that representative to be the address for service.

(2) [Address Where No Representative Is Appointed] Where no representative is appointed and an applicant, holder or other interested person has provided as its address an address on the territory of the Contracting Party, that Contracting Party shall consider that address to be the address for service.

(3) [Time Limit] The time limit referred to in Article 4(3)(d) shall be counted from the date of receipt of the communication referred to in that Article by the Office of the Contracting Party concerned and shall not be less than one month where the address of the person on whose behalf the communication is made is on the territory of that Contracting Party and not less than two months where such an address is outside the territory of that Contracting Party.
Rule 5
Details Concerning the Filing Date

(1) [Procedure in Case of Non-Compliance with Requirements] If the application does not, at the time of its receipt by the Office, comply with any of the applicable requirements of Article 5(1)(a) or (2)(a), the Office shall promptly invite the applicant to comply with such requirements within a time limit indicated in the invitation, which time limit shall be at least one month from the date of the invitation where the applicant's address is on the territory of the Contracting Party concerned and at least two months where the applicant's address is outside the territory of the Contracting Party concerned. Compliance with the invitation may be subject to the payment of a special fee. Even if the Office fails to send the said invitation, the said requirements remain unaffected.

(2) [Filing Date in Case of Correction] If, within the time limit indicated in the invitation, the applicant complies with the invitation referred to in paragraph (1) and pays any required special fee, the filing date shall be the date on which all the required indications and elements referred to in Article 5(1)(a) have been received by the Office and, where applicable, the required fees referred to in Article 5(2)(a) have been paid to the Office. Otherwise, the application shall be treated as if it had not been filed.

Rule 6
Details Concerning Communications

(1) [Indications Accompanying Signature of Communications on Paper] Any Contracting Party may require that the signature of the natural person who signs be accompanied by
   (i) an indication in letters of the family or principal name and the given or secondary name or names of that person or, at the option of that person, of the name or names customarily used by the said person;
   (ii) an indication of the capacity in which that person signed, where such capacity is not obvious from reading the communication.

(2) [Date of Signing] Any Contracting Party may require that a signature be accompanied by an indication of the date on which the signing was effected. Where that indication is required but is not supplied, the date on which the signing is deemed to have been effected shall be the date on which the communication bearing the signature was received by the Office or, if the Contracting Party so allows, a date earlier than the latter date.
(3) [Signature of Communications on Paper] Where a communication to the Office of a Contracting Party is on paper and a signature is required, that Contracting Party
   (i) shall, subject to item (iii), accept a handwritten signature;
   (ii) may permit, instead of a handwritten signature, the use of other forms of signature, such as a printed or stamped signature, or the use of a seal or of a bar-coded label;
   (iii) may, where the natural person who signs the communication is a national of the Contracting Party and such person's address is on its territory, or where the legal entity on behalf of which the communication is signed is organized under its law and has either a domicile or a real and effective industrial or commercial establishment on its territory, require that a seal be used instead of a handwritten signature.

(4) [Signature of Communications on Paper Filed by Electronic Means of Transmittal] A Contracting Party that provides for communications on paper to be filed by electronic means of transmittal shall consider any such communication signed if a graphic representation of a signature accepted by that Contracting Party under paragraph (3) appears on the communication as received.

(5) [Original of a Communication on Paper Filed by Electronic Means of Transmittal] A Contracting Party that provides for communications on paper to be filed by electronic means of transmittal may require that the original of any such communication be filed
   (i) with the Office accompanied by a letter identifying that earlier transmission and
   (ii) within a time limit which shall be at least one month from the date on which the Office received the communication by electronic means of transmittal.

(6) [Authentication of Communications in Electronic Form] A Contracting Party that permits the filing of communications in electronic form may require that any such communication be authenticated through a system of electronic authentication as prescribed by that Contracting Party.

(7) [Date of Receipt] Each Contracting Party shall be free to determine the circumstances in which the receipt of a document or the payment of a fee shall be deemed to constitute receipt by or payment to the Office in cases in which the document was actually received by or payment was actually made to
   (i) a branch or sub-office of the Office,
(ii) a national Office on behalf of the Office of the Contracting Party, where the Contracting Party is an intergovernmental organization referred to in Article 26(1)(ii),

(iii) an official postal service,

(iv) a delivery service, or an agency, specified by the Contracting Party,

(v) an address other than the nominated addresses of the Office.

(8) [Electronic Filing] Subject to paragraph (7), where a Contracting Party provides for the filing of a communication in electronic form or by electronic means of transmittal and the communication is so filed, the date on which the Office of that Contracting Party receives the communication in such form or by such means shall constitute the date of receipt of the communication.

Rule 7
Manner of Identification of an Application
Without Its Application Number

(1) [Manner of Identification] Where it is required that an application be identified by its application number but where such a number has not yet been issued or is not known to the applicant or its representative, that application shall be considered identified if the following is supplied:

(i) the provisional application number, if any, given by the Office, or

(ii) a copy of the application, or

(iii) a representation of the mark, accompanied by an indication of the date on which, to the best knowledge of the applicant or the representative, the application was received by the Office and an identification number given to the application by the applicant or the representative.

(2) [Prohibition of Other Requirements] No Contracting Party may demand that requirements other than those referred to in paragraph (1) be complied with in order for an application to be identified where its application number has not yet been issued or is not known to the applicant or its representative.

Rule 8
Details Concerning Duration and Renewal

For the purposes of Article 13(1)(c), the period during which the request for renewal may be presented and the renewal fee may be paid shall start at least
six months before the date on which the renewal is due and shall end at the earliest six months after that date. If the request for renewal is presented and/or the renewal fees are paid after the date on which the renewal is due, any Contracting Party may subject the acceptance of the request for renewal to the payment of a surcharge.

Rule 9
Relief Measures in Case of Failure to Comply with Time Limits

(1) [Requirements Concerning Extension of Time Limits Under Article 14(2)(i)]
A Contracting Party that provides for the extension of a time limit under Article 14(2)(i) shall extend the time limit for a reasonable period of time from the date of filing the request for extension and may require that the request
(i) contain an identification of the requesting party, the relevant application or registration number and the time limit concerned, and
(ii) be filed within a time limit which shall not be less than two months from the date of expiry of the time limit concerned.

(2) [Requirements Concerning Continued Processing Under Article 14(2)(ii)] A Contracting Party may require that the request for continued processing under Article 14(2)(ii)
(i) contain an identification of the requesting party, the relevant application or registration number and the time limit concerned, and
(ii) be filed within a time limit which shall not be less than two months from the date of expiry of the time limit concerned. The omitted act shall be completed within the same period or, where the Contracting Party so provides, together with the request.

(3) [Requirements Concerning Reinstatement of Rights Under Article 14(2)(iii)]
(a) A Contracting Party may require that the request for reinstatement of rights under Article 14(2)(iii)
(i) contain an identification of the requesting party, the relevant application or registration number and the time limit concerned, and
(ii) set out the facts and evidence in support of the reasons for the failure to comply with the time limit concerned.
(b) The request for reinstatement of rights shall be filed with the Office within a reasonable time limit, the duration of which shall be determined by the Contracting Party from the date of the removal of the cause of failure to
comply with the time limit concerned. The omitted act shall be completed within the same period or, where the Contracting Party so provides, together with the request.

(c) A Contracting Party may provide for a maximum time limit for complying with the requirements under subparagraphs (a) and (b) of not less than six months from the date of expiry of the time limit concerned.

(4) [Exceptions Under Article 14(3)] The exceptions referred to in Article 14(3) are the cases of failure to comply with a time limit

(i) for which a relief measure has already been granted under Article 14(2),

(ii) for filing a request for a relief measure under Article 14, (iii) for payment of a renewal fee,

(iv) for an action before a board of appeal or other review body constituted in the framework of the Office,

(v) for an action in inter partes proceedings,

(vi) for filing the declaration referred to in Article 3(1)(a)(vii) or the declaration referred to in Article 3(1)(a)(viii),

(vii) for filing a declaration which, under the law of the Contracting Party, may establish a new filing date for a pending application, and

(viii) for the correction or addition of a priority claim.

**Rule 10**

*Requirements Concerning the Request for Recordal of a License or for Amendment or Cancellation of the Recordal of a License*

(1) [Content of Request]

(a) A Contracting Party may require that the request for recordal of a license under Article 17(1) contain some or all of the following indications or elements:

(i) the name and address of the holder;

(ii) where the holder has a representative, the name and address of that representative;

(iii) where the holder has an address for service, such address;

(iv) the name and address of the licensee;

(v) where the licensee has a representative, the name and address of that representative;

(vi) where the licensee has an address for service, such address;

(vii) the name of a State of which the licensee is a national if he/she is a national of any State, the name of a State in which the licensee has his/her
(viii) the holder or the licensee is a legal entity, the legal nature of that legal entity and the State, and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized;

(ix) the registration number of the mark which is the subject of the license;

(x) the names of the goods and/or services for which the license is granted, grouped according to the classes of the Nice Classification, each group preceded by the number of the class of that Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification;

(xi) whether the license is an exclusive license, a non-exclusive license or a sole license;

(xii) where applicable, that the license concerns only a part of the territory covered by the registration, together with an explicit indication of that part of the territory;

(xiii) the duration of the license.

(b) A Contracting Party may require that the request for amendment or cancellation of the recordal of a license under Article 18(1) contain some or all of the following indications or elements:

(i) the indications specified in items (i) to (ix) of subparagraph (a);

(ii) where the amendment or cancellation concerns any of the indications or elements specified under subparagraph (a), the nature and scope of the amendment or cancellation to be recorded.

(2) [Supporting Documents for Recordal of a License]

(a) A Contracting Party may require that the request for recordal of a license be accompanied, at the option of the requesting party, by one of the following:

(i) an extract of the license contract indicating the parties and the rights being licensed, certified by a notary public or any other competent public authority as being a true extract of the contract; or

(ii) an uncertified statement of license, the content of which corresponds to the statement of license Form provided for in the Regulations, and signed by both the holder and the licensee.

(b) Any Contracting Party may require that any co-holder who is not a party to the license contract give its express consent to the license in a document signed by it.

(3) [Supporting Documents for Amendment of Recordal of a License]
(a) A Contracting Party may require that the request for amendment of the recordal of a license be accompanied, at the option of the requesting party, by one of the following:

(i) documents substantiating the requested amendment of the recordal of the license; or

(ii) an uncertified statement of amendment of license, the content of which corresponds to the statement of amendment of license Form provided for in these Regulations, and signed by both the holder and the licensee.

(b) Any Contracting Party may require that any co-holder who is not a party to the license contract give its express consent to the amendment of the license in a document signed by it.

(4) [Supporting Documents for Cancellation of Recordal of a License]
A Contracting Party may require that the request for cancellation of the recordal of a license be accompanied, at the option of the requesting party, by one of the following:

(i) documents substantiating the requested cancellation of the recordal of the license; or

(ii) an uncertified statement of cancellation of license, the content of which corresponds to the statement of cancellation of license Form provided for in these Regulations, and signed by both the holder and the licensee.
RESOLUTION BY THE DIPLOMATIC CONFERENCE
SUPPLEMENTARY TO THE SINGAPORE TREATY ON
THE LAW OF TRADEMARKS AND THE REGULATIONS
THEREUNDER

1. The Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty, held in Singapore in March 2006, agreed that the Treaty adopted by the Conference would be named "Singapore Treaty on the Law of Trademarks" (hereinafter referred to as "the Treaty").

2. When adopting the Treaty, the Diplomatic Conference agreed that the words "procedure before the Office" in Article l(viii) would not cover judicial procedures under the Contracting Parties' legislation.

3. Acknowledging the fact that the Treaty provides for effective and efficient trademark formality procedures for Contracting Parties, the Diplomatic Conference understood that Articles 2 and 8, respectively, did not impose any obligations on Contracting Parties to:
   (i) register new types of marks, as referred to in Rule 3, paragraphs (4), (5) and (6) of the Regulations; or
   (ii) implement electronic filing systems or other automation systems.

   Each Contracting Party shall have the option to decide whether and when to provide for the registration of new types of marks, as referred to above.

4. With a view to facilitating the implementation of the Treaty in Developing and Least Developed Countries (LDCs), the Diplomatic Conference requested the World Intellectual Property Organization (WIPO) and the Contracting Parties to provide additional and adequate technical assistance comprising technological, legal and other forms of support to strengthen the institutional capacity of those countries to implement the Treaty and enable those countries to take full advantage of the provisions of the Treaty.

5. Such assistance should take into account the level of technological and economic development of beneficiary countries. Technological support would help improve the information and communication technology infrastructure of those countries, thus contributing to narrowing the technological gap between Contracting Parties. The Diplomatic Conference noted that some countries underlined the importance of the Digital Solidarity Fund (DSF) as being relevant to narrowing the digital divide.

6. Furthermore, upon entry into force of the Treaty, Contracting Parties will undertake to exchange and share, on a multilateral basis, information and experience on legal, technical and institutional aspects regarding the
implementation of the Treaty and how to take full advantage of opportunities and benefits resulting therefrom.

7. The Diplomatic Conference, acknowledging the special situation and needs of LDCs, agreed that LDCs shall be accorded special and differential treatment for the implementation of the Treaty, as follows:

(a) LDCs shall be the primary and main beneficiaries of technical assistance by the Contracting Parties and the World Intellectual Property Organization (WIPO);

(b) such technical assistance includes the following:

(i) assistance in establishing the legal framework for the implementation of the Treaty,

(ii) information, education and awareness raising as regards the impact of acceding to the Treaty,

(iii) assistance in revising administrative practices and procedures of national trademark registration authorities,

(iv) assistance in building up the necessary trained manpower and facilities of the IP Offices, including information and communication technology capacity to effectively implement the Treaty and its Regulations.

8. The Diplomatic Conference requested the Assembly to monitor and evaluate, at every ordinary session, the progress of the assistance related to implementation efforts and the benefits resulting from such implementation.

9. The Diplomatic Conference agreed that any dispute that may arise between two or more Contracting Parties with respect to the interpretation or the application of this Treaty should be settled amicably through consultation and mediation under the auspices of the Director General.
Lisbon Agreement
for the Protection of Appellations of Origin
and their International Registration

of October 31, 1958,
as revised at Stockholm on July 14, 1967,
and as amended on September 28, 1979

Article 1
[Establishment of a Special Union; Protection of Appellations of Origin
Registered at the International Bureau]164

(1) The countries to which this Agreement applies constitute a Special
Union within the framework of the Union for the Protection of Industrial
Property.

(2) They undertake to protect on their territories, in accordance with
the terms of this Agreement, the appellations of origin of products of the other
countries of the Special Union, recognized and protected as such in the country
of origin and registered at the International Bureau of Intellectual Property
(hereinafter designated as “the International Bureau” or “the Bureau”) referred to
in the Convention establishing the World Intellectual Property Organization
(hereinafter designated as “the Organization”).

Article 2
[Definition of Notions of Appellation of Origin
and Country of Origin]

(1) In this Agreement, “appellation of origin” means the geographical
denomination of a country, region, or locality, which serves to designate a
product originating therein, the quality or characteristics of which are due
exclusively or essentially to the geographical environment, including natural and
human factors.

164 Articles have been given titles to facilitate their identification. There are no titles in the signed
French text.
(2) The country of origin is the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation.

Article 3
[Content of Protection]

Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind,” “type,” “make,” “imitation”, or the like.

Article 4
[Protection by virtue of Other Texts]

The provisions of this Agreement shall in no way exclude the protection already granted to appellations of origin in each of the countries of the Special Union by virtue of other international instruments, such as the Paris Convention of March 20, 1883, for the Protection of Industrial Property and its subsequent revisions, and the Madrid Agreement of April 14, 1891, for the Repression of False or Deceptive Indications of Source on Goods and its subsequent revisions, or by virtue of national legislation or court decisions.

Article 5
[International Registration; Refusal and Opposition to Refusal; Notifications; Use Tolerated for a Fixed Period]

(1) The registration of appellations of origin shall be effected with the International Bureau, at the request of the Authorities of the countries of the Special Union, in the name of any natural persons or legal entities, public or private, having, according to their national legislation, the right to use such appellations.

(2) The International Bureau shall, without delay, notify the Authorities of the various countries of the Special Union of such registrations, and shall publish them in a periodical.

(3) The Authority of any country may declare that it cannot ensure the protection of an appellation of origin whose registration has been notified to it, but only in so far as its declaration is notified to the International Bureau, together with an indication of the grounds therefor, within a period of one year.
from the receipt of the notification of registration, and provided that such declaration is not detrimental, in the country concerned, to the other forms of protection of the appellation which the owner thereof may be entitled to claim under Article 4, above.

(4) Such declaration may not be opposed by the Authorities of the countries of the Union after the expiration of the period of one year provided for in the foregoing paragraph.

(5) The International Bureau shall, as soon as possible, notify the Authority of the country of origin of any declaration made under the terms of paragraph (3) by the Authority of another country. The interested party, when informed by his national Authority of the declaration made by another country, may resort, in that other country, to all the judicial and administrative remedies open to the nationals of that country.

(6) If an appellation which has been granted protection in a given country pursuant to notification of its international registration has already been used by third parties in that country from a date prior to such notification, the competent Authority of the said country shall have the right to grant to such third parties a period not exceeding two years to terminate such use, on condition that it advise the International Bureau accordingly during the three months following the expiration of the period of one year provided for in paragraph (3), above.

**Article 6**

[Generic Appellations]

An appellation which has been granted protection in one of the countries of the Special Union pursuant to the procedure under Article 5 cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.

**Article 7**

[Period of Validity of Registration; Fee]

(1) Registration effected with the International Bureau in conformity with Article 5 shall ensure, without renewal, protection for the whole of the period referred to in the foregoing Article.

(2) A single fee shall be paid for the registration of each appellation of origin.
Article 8
[Legal Proceedings]

Legal action required for ensuring the protection of appellations of origin may be taken in each of the countries of the Special Union under the provisions of the national legislation:
1. at the instance of the competent Authority or at the request of the public prosecutor;
2. by any interested party, whether a natural person or a legal entity, whether public or private.

Article 9
[Assembly of the Special Union]

(1) (a) The Special Union shall have an Assembly consisting of those countries which have ratified or acceded to this Act.
(b) The Government of each country shall be represented by one delegate, who may be assisted by alternate delegates, advisors, and experts.
(c) The expenses of each delegation shall be borne by the Government which has appointed it.
(2) (a) The Assembly shall:
(i) deal with all matters concerning the maintenance and development of the Special Union and the implementation of this Agreement;
(ii) give directions to the International Bureau concerning the preparation for revision conferences, due account being taken of any comments made by those countries of the Special Union which have not ratified or acceded to this Act;
(iii) modify the Regulations, including the fixation of the amount of the fee referred to in Article 7(2) and other fees relating to international registration;
(iv) review and approve the reports and activities of the Director General of the Organization (hereinafter designated as “the Director General”) concerning the Special Union, and give him all necessary instructions concerning matters within the competence of the Special Union;
(v) determine the program and adopt the biennial budget of the Special Union, and approve its final accounts;
(vi) adopt the financial regulations of the Special Union;
(vii) establish such committees of experts and working groups as it may deem necessary to achieve the objectives of the Special Union;
(viii) determine which countries not members of the Special Union and which intergovernmental and international non-governmental organizations shall be admitted to its meetings as observers;

(ix) adopt amendments to Articles 9 to 12;

(x) take any other appropriate action designed to further the objectives of the Special Union;

(xi) perform such other functions as are appropriate under this Agreement.

(b) With respect to matters which are of interest also to other Unions administered by the Organization, the Assembly shall make its decisions after having heard the advice of the Coordination Committee of the Organization.

(3) (a) Each country member of the Assembly shall have one vote.

(b) One-half of the countries members of the Assembly shall constitute a quorum.

(c) Notwithstanding the provisions of subparagraph (b), if, in any session, the number of countries represented is less than one half but equal to or more than one-third of the countries members of the Assembly, the Assembly may make decisions but, with the exception of decisions concerning its own procedure, all such decisions shall take effect only if the conditions set forth hereinafter are fulfilled. The International Bureau shall communicate the said decisions to the countries members of the Assembly which were not represented and shall invite them to express in writing their vote or abstention within a period of three months from the date of the communication. If, at the expiration of this period, the number of countries having thus expressed their vote or abstentionattains the number of countries which was lacking for attaining the quorum in the session itself, such decisions shall take effect provided that at the same time the required majority still obtains.

(d) Subject to the provisions of Article 12(2), the decisions of the Assembly shall require two-thirds of the votes cast.

(e) Abstentions shall not be considered as votes.

(f) A delegate may represent, and vote in the name of, one country only.

(g) Countries of the Special Union not members of the Assembly shall be admitted to the meetings of the latter as observers.

(4) (a) The Assembly shall meet once in every second calendar year in ordinary session upon convocation by the Director General and, in the absence of exceptional circumstances, during the same period and at the same place as the General Assembly of the Organization.

(b) The Assembly shall meet in extraordinary session upon convocation by the Director General, at the request of one-fourth of the countries members of the Assembly.
(c) The agenda of each session shall be prepared by the Director General.

(5) The Assembly shall adopt its own rules of procedure.

**Article 10**
[International Bureau]

(1) (a) International registration and related duties, as well as all other administrative tasks concerning the Special Union, shall be performed by the International Bureau.

(b) In particular, the International Bureau shall prepare the meetings and provide the secretariat of the Assembly and of such committees of experts and working groups as may have been established by the Assembly.

(c) The Director General shall be the chief executive of the Special Union and shall represent the Special Union.

(2) The Director General and any staff member designated by him shall participate, without the right to vote, in all meetings of the Assembly and of such committees of experts or working groups as may have been established by the Assembly. The Director General, or a staff member designated by him, shall be *ex officio* secretary of those bodies.

(3) (a) The International Bureau shall, in accordance with the directions of the Assembly, make the preparations for the conferences to revise the provisions of the Agreement other than Articles 9 to 12.

(b) The International Bureau may consult with intergovernmental and international non-governmental organizations concerning preparations for revision conferences.

(c) The Director General and persons designated by him shall take part, without the right to vote, in the discussions at those conferences.

(4) The International Bureau shall carry out any other tasks assigned to it.

**Article 11**
[Finances]

(1) (a) The Special Union shall have a budget.

(b) The budget of the Special Union shall include the income and expenses specific to the Special Union, its contribution to the budget of expenses common to the Unions, and, where applicable, the sum made available to the budget of the Conference of the Organization.
(c) Expenses not attributable exclusively to the Special Union but also to one or more other Unions administered by the Organization shall be considered as expenses common to the Unions. The share of the Special Union in such common expenses shall be in proportion to the interest the Special Union has in them.

(2) The budget of the Special Union shall be established with due regard to the requirements of coordination with the budgets of the other Unions administered by the Organization.

(3) The budget of the Special Union shall be financed from the following sources:

(i) international registration fees collected under Article 7(2) and fees and charges due for other services rendered by the International Bureau in relation to the Special Union;

(ii) proceeds from the sale of, or royalties on, the publications of the International Bureau concerning the Special Union;

(iii) gifts, bequests, and subventions;

(iv) rents, interest, and other miscellaneous income;

(v) contributions of the countries of the Special Union, if and to the extent to which receipts from the sources indicated in items (i) to (iv) do not suffice to cover the expenses of the Special Union.

(4) (a) The amount of the fee referred to in Article 7(2) shall be fixed by the Assembly on the proposal of the Director General.

(b) The amount of the said fee shall be so fixed that the revenue of the Special Union should, under normal circumstances, be sufficient to cover the expenses of the International Bureau for maintaining the international registration service, without requiring payment of the contributions referred to in paragraph (3)(v), above.

(5) (a) For the purpose of establishing its contribution referred to in paragraph (3)(v), each country of the Special Union shall belong to the same class as it belongs to in the Paris Union for the Protection of Industrial Property, and shall pay its annual contributions on the basis of the same number of units as is fixed for that class in that Union.

(b) The annual contribution of each country of the Special Union shall be an amount in the same proportion to the total sum to be contributed to the annual budget of the Special Union by all countries as the number of the units of the class to which it belongs is to the total of the units of all contributing countries.

(c) The date on which contributions are to be paid shall be fixed by the Assembly.

(d) A country which is in arrears in the payment of its contributions may not exercise its right to vote in any of the organs of the Special Union if the amount of its arrears equals or exceeds the amount of the contributions due from
it for the preceding two full years. However, such a country may be allowed to continue to exercise its right to vote in that organ if, and as long as, the latter is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(e) If the budget is not adopted before the beginning of a new financial period, it shall be at the same level as the budget of the previous year, as provided in the financial regulations.

(6) Subject to the provisions of paragraph (4)(a), the amount of fees and charges due for other services rendered by the International Bureau in relation to the Special Union shall be established, and shall be reported to the Assembly, by the Director General.

(7) (a) The Special Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Special Union. If the fund becomes insufficient, the Assembly shall decide to increase it.

(b) The amount of the initial payment of each country to the said fund or of its participation in the increase thereof shall be a proportion of the contribution of that country as a member of the Paris Union for the Protection of Industrial Property to the budget of the said Union for the year in which the fund is established or the decision to increase it is made.

(c) The proportion and the terms of payment shall be fixed by the Assembly on the proposal of the Director General and after it has heard the advice of the Coordination Committee of the Organization.

(8) (a) In the headquarters agreement concluded with the country on the territory of which the Organization has its headquarters, it shall be provided that, whenever the working capital fund is insufficient, such country shall grant advances. The amount of those advances and the conditions on which they are granted shall be the subject of separate agreements, in each case, between such country and the Organization.

(b) The country referred to in subparagraph (a) and the Organization shall each have the right to denounce the obligation to grant advances, by written notification. Denunciation shall take effect three years after the end of the year in which it has been notified.

(9) The auditing of the accounts shall be effected by one or more of the countries of the Special Union or by external auditors, as provided in the financial regulations. They shall be designated, with their agreement, by the Assembly.

**Article 12**

[Amendment of Articles 9 to 12]

(1) Proposals for the amendment of Articles 9, 10, 11, and the present Article, may be initiated by any country member of the Assembly, or by the Director General. Such proposals shall be communicated by the Director
General to the member countries of the Assembly at least six months in advance of their consideration by the Assembly.

(2) Amendments to the Articles referred to in paragraph (1) shall be adopted by the Assembly. Adoption shall require three-fourths of the votes cast, provided that any amendment to Article 9, and to the present paragraph, shall require four-fifths of the votes cast.

(3) Any amendment to the Articles referred to in paragraph (1) shall enter into force one month after written notifications of acceptance, effected in accordance with their respective constitutional processes, have been received by the Director General from three-fourths of the countries members of the Assembly at the time it adopted the amendment. Any amendment to the said Articles thus accepted shall bind all the countries which are members of the Assembly at the time the amendment enters into force, or which become members thereof at a subsequent date, provided that any amendment increasing the financial obligations of countries of the Special Union shall bind only those countries which have notified their acceptance of such amendment.

Article 13
[Regulations; Revision]

(1) The details for carrying out this Agreement are fixed in the Regulations.

(2) This Agreement may be revised by conferences held between the delegates of the countries of the Special Union.

Article 14
[Ratification and Accession; Entry into Force; Reference to Article 24 of Paris Convention (Territories); Accession to the Act of 1958]

(1) Any country of the Special Union which has signed this Act may ratify it, and, if it has not signed it, may accede to it.

(2) (a) Any country outside the Special Union, which is party to the Paris Convention for the Protection of Industrial Property, may accede to this Act and thereby become a member of the Special Union.

(b) Notification of accession shall, of itself, ensure, in the territory of the acceding country, the benefits of the foregoing provisions to appellations of origin which, at the time of accession, are the subject of international registration.
(c) However, any country acceding to this Agreement may, within a period of one year, declare in regard to which appellations of origin, already registered at the International Bureau, it wishes to exercise the right provided for in Article 5(3).

(3) Instruments of ratification and accession shall be deposited with the Director General.

(4) The provisions of Article 24 of the Paris Convention for the Protection of Industrial Property shall apply to this Agreement.

(5) (a) With respect to the first five countries which have deposited their instruments of ratification or accession, this Act shall enter into force three months after the deposit of the fifth such instrument.

(b) With respect to any other country, this Act shall enter into force three months after the date on which its ratification or accession has been notified by the Director General, unless a subsequent date has been indicated in the instrument of ratification or accession. In the latter case, this Act shall enter into force with respect to that country on the date thus indicated.

(6) Ratification or accession shall automatically entail acceptance of all the clauses and admission to all the advantages of this Act.

(7) After the entry into force of this Act, a country may accede to the original Act of October 31, 1958, of this Agreement only in conjunction with ratification of, or accession to, this Act.

**Article 15**

[Duration of the Agreement; Denunciation]

(1) This Agreement shall remain in force as long as five countries at least are party to it.

(2) Any country may denounce this Act by notification addressed to the Director General. Such denunciation shall constitute also denunciation of the original Act of October 31, 1958, of this Agreement and shall affect only the country making it, the Agreement remaining in full force and effect as regards the other countries of the Special Union.

(3) Denunciation shall take effect one year after the day on which the Director General has received the notification.

(4) The right of denunciation provided for by this Article shall not be exercised by any country before the expiration of five years from the date upon which it becomes a member of the Special Union.
Article 16
[Applicable Acts]

(1) (a) This Act shall, as regards the relations between the countries of the Special Union by which it has been ratified or acceded to, replace the original Act of October 31, 1958.
(b) However, any country of the Special Union which has ratified or acceded to this Act shall be bound by the original Act of October 31, 1958, as regards its relations with countries of the Special Union which have not ratified or acceded to this Act.

(2) Countries outside the Special Union which become party to this Act shall apply it to international registrations of appellations of origin effected at the International Bureau at the request of the Authority of any country of the Special Union not party to this Act, provided that such registrations satisfy, with respect to the said countries, the requirements of this Act. With regard to international registrations effected at the International Bureau at the request of the Authorities of the said countries outside the Special Union which become party to this Act, such countries recognize that the aforesaid country of the Special Union may demand compliance with the requirements of the original Act of October 31, 1958.

Article 17
[Signature, Languages, Depository Functions]

(1) (a) This Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.
(b) Official texts shall be established by the Director General, after consultation with the interested Governments, in such other languages as the Assembly may designate.

(2) This Act shall remain open for signature at Stockholm until January 13, 1968.

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Act to the Governments of all countries of the Special Union and, on request, to the Government of any other country.

(4) The Director General shall register this Act with the Secretariat of the United Nations.

(5) The Director General shall notify the Governments of all countries of the Special Union of signatures, deposits of instruments of ratification or accession, entry into force of any provisions of this Act, denunciations, and declarations pursuant to Article 14(2)(c) and (4).
Article 18
[Transitional Provisions]

(1) Until the first Director General assumes office, references in this Act to the International Bureau of the Organization or to the Director General shall be construed as references to the Bureau of the Union established by the Paris Convention for the Protection of Industrial Property or its Director, respectively.

(2) Countries of the Special Union not having ratified or acceded to this Act may, until five years after the entry into force of the Convention establishing the Organization, exercise, if they so desire, the rights provided for under Articles 9 to 12 of this Act as if they were bound by those Articles. Any country desiring to exercise such rights shall give written notification to that effect to the Director General; such notification shall be effective from the date of its receipt. Such countries shall be deemed to be members of the Assembly until the expiration of the said period.
Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of April 14, 1891

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Article 1

(1) All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.

(2) Seizure shall also be effected in the country where the false or deceptive indication of source has been applied, or into which the goods bearing the false or deceptive indication have been imported.

(3) If the laws of a country do not permit seizure upon importation, such seizure shall be replaced by prohibition of importation.

(4) If the laws of a country permit neither seizure upon importation nor prohibition of importation nor seizure within the country, then, until such time as the laws are modified accordingly, those measures shall be replaced by the actions and remedies available in such cases to nationals under the laws of such country.

(5) In the absence of any special sanctions ensuring the repression of false or deceptive indications of source, the sanctions provided by the corresponding provisions of the laws relating to marks or trade names shall be applicable.
Article 2

(1) Seizure shall take place at the instance of the customs authorities, who shall immediately inform the interested party, whether an individual person or a legal entity, in order that such party may, if he so desires, take appropriate steps in connection with the seizure effected as a conservatory measure. However, the public prosecutor or any other competent authority may demand seizure either at the request of the injured party or ex officio; the procedure shall then follow its normal course.

(2) The authorities shall not be bound to effect seizure in the case of transit.

Article 3

These provisions shall not prevent the vendor from indicating his name or address upon goods coming from a country other than that in which the sale takes place; but in such case the address or the name must be accompanied by an exact indication in clear characters of the country or place of manufacture or production, or by some other indication sufficient to avoid any error as to the true source of the wares.

Article 3bis

The countries to which this Agreement applies also undertake to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communication.

Article 4

The courts of each country shall decide what appellations, on account of their generic character, do not fall within the provisions of this Agreement, regional appellations concerning the source of products of the vine being, however, excluded from the reservation specified by this Article.
Article 5

(1) Countries of the Union for the Protection of Industrial Property which have not acceded to this Agreement may accede at their request in the manner prescribed by Article 16 of the General Convention.

(2) The provisions of Articles 16bis and 11bis of the General Convention shall apply to this Agreement.

Article 6

(1) This Act shall be ratified and the instruments of ratification deposited at Berne not later than May 1, 1963. It shall come into force, between the countries in whose names it has been ratified, one month after that date. However, if before that date it has been ratified in the name of at least six countries, it shall come into force, between those countries, one month after the deposit of the sixth ratification has been notified to them by the Government of the Swiss Confederation, and, in the countries in whose names it has been ratified at a later date, one month after the notification of each of such ratifications.

(2) Countries in whose names the instrument of ratification has not been deposited within the period provided for in the preceding paragraph may accede under the terms of Article 16 of the General Convention.

(3) This Act shall, as regards the relations between the countries to which it applies, replace the Agreement concluded at Madrid on April 14, 1891, and the Acts resulting from subsequent revisions.

(4) As regards countries to which this Act does not apply, but to which the Madrid Agreement revised at London in 1934 applies, the latter shall remain in force.

(5) Similarly, as regards countries to which neither this Act nor the Madrid Agreement revised at London applies, the Madrid Agreement revised at The Hague in 1925 shall remain in force.

(6) Similarly, as regards countries to which neither this Act nor the Madrid Agreement revised at London nor the Madrid Agreement revised at The Hague applies, the Madrid Agreement revised at Washington in 1911 shall remain in force.
II
Additional Act of Stockholm of July 14, 1967

Article 1
[Transfer of Depositary Functions in Respect of the Madrid Agreement]

Instruments of accession to the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, of April 14, 1891 (hereinafter designated as "the Madrid Agreement"), as revised at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, and at Lisbon on October 31, 1958 (hereinafter designated as "the Lisbon Act") shall be deposited with the Director General of the World Intellectual Property Organization (hereinafter designated as "the Director General"), who shall notify such deposits to the countries party to the Agreement.

Article 2
[Adaptation of References in the Madrid Agreement to Certain Provisions of the Paris Convention]

References in Articles 5 and 6 (2) of the Lisbon Act to Articles 16, 16bis, and 11 bis, of the General Convention shall be construed as references to those provisions of the Stockholm Act of the Paris Convention for the Protection of Industrial Property which correspond to the said Articles.

Article 3
[Signature and Ratification of, and Accession to, the Additional Act]

(1) This Additional Act may be signed by any country party to the Madrid Agreement and may be ratified or acceded to by any country which has ratified or acceded to the Lisbon Act.

(2) Instruments of ratification or accession shall be deposited with the Director General.
Article 4
[Automatic Acceptance of Articles 1 and 2 by Countries
Acceding to the Lisbon Act]

Any country which has not ratified or acceded to the Lisbon Act shall become bound also by Articles 1 and 2 of this Additional Act from the date on which its accession to the Lisbon Act enters into force, provided however that, if on the said date this Additional Act has not yet entered into force pursuant to Article 5 (1), then, such country shall become bound by Articles 1 and 2 of this Additional Act only from the date of entry into force of this Additional Act pursuant to Article 5 (1).

Article 5
[Entry Into Force of the Additional Act]

(1) This Additional Act shall enter into force on the date on which the Stockholm Convention of July 14, 1967, establishing the World Intellectual Property Organization has entered into force, provided however that, if by that date at least two ratifications or accessions to this Additional Act have not been deposited, then, this Additional Act shall enter into force on the date on which two ratifications or accessions to this Additional Act have been deposited.

(2) With respect to any country which deposits its instrument of ratification or accession after the date on which this Additional Act has entered into force pursuant to the foregoing paragraph, this Additional Act shall enter into force three months after the date on which its ratification or accession has been notified by the Director General.

Article 6
[Signature, etc., of the Additional Act]

(1) This Additional Act shall be signed in a single copy in the French language and shall be deposited with the Government of Sweden.

(2) This Additional Act shall remain open for signature at Stockholm until the date of its entry into force pursuant to Article 5(1).

(3) The Director General shall transmit two copies, certified by the Government of Sweden, of the signed text of this Additional Act to the Governments of all countries party to the Madrid Agreement and, on request, to the Government of any other country.

(4) The Director General shall register this Additional Act with the Secretariat of the United Nations.
(5) The Director General shall notify the Governments of all countries party to the Madrid Agreement of signatures, deposits of instruments of ratification or accession, entry into force, and other relevant notifications.

**Article 7**

[Transitional Provision]

Until the first Director General assumes office, references in this Additional Act to him shall be construed as references to the Director of the United International Bureaux for the Protection of Intellectual Property.