Singapore Sling: WIPO Passes the Buck on Meaningful Reform of International Trademark Law

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SINGAPORE SLING: WIPO PASSES THE BUCK ON MEANINGFUL REFORM OF INTERNATIONAL TRADEMARK LAW

I. INTRODUCTION

Trademarks today exist in a world where political borders mean less than they ever have. Teenagers crave Nikes and Nokias from Moscow to Muncie and from Shanghai to São Paulo. Exports and imports have become an ever-increasing part of the American economy. As part of this expansion of international trade, agreements such as the General Agreement on Tariffs and Trade (“GATT”) and the North American Free Trade Agreement (“NAFTA”) established general rules for the reduction of trade barriers.

As a part of the general trend towards promoting greater freedom of trade, the World Intellectual Property Organization (“WIPO”) has sought to harmonize national intellectual property laws, including the laws concerning trademarks. The part of the effort aimed at trademark law was initially meant to standardize both substantive and procedural matters, but due to the enormity of the task, the eventual diplomatic conference focused solely on the procedural aspects of trademark law.¹ This diplomatic conference, held at Geneva in 1994, produced the Trademark Law Treaty (hereinafter, “1994 Treaty”).² This treaty sets maximum limits on the procedures nations can impose on trademark holders and has become an accepted standard even for those nations which are not signatories.


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Other international agreements entered into around the same time dealt specifically with intellectual property law and included the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which accompanied the Uruguay Round of GATT, signed in 1994, as well as the Protocol Relating to the Madrid Agreement (Madrid Protocol), signed in 1996. As always, however, problems arose within the world of international trademark practice, and legislators across the world began to hear calls for changes and additions to the existing treaties.

In the spring of 2006, dignitaries from over one hundred WIPO Member Nations gathered in Singapore “to create a modern and dynamic international framework for the harmonization of administrative trademark registration procedures.” This was a departure from WIPO’s previous “soft law” approach of promulgating “suggested practices” that member nations could voluntarily choose to adopt, rather than a “hard law” approach of binding international agreements. The most likely impetus for this departure from the soft law emphasis was the adoption of the WIPO Development Agenda during the 2004 WIPO General Assembly meeting. This development agenda, sponsored primarily by nations from the developing world, advocated a much more active position for WIPO and a more aggressive stance on norm-setting by WIPO. The end goal of the development


agenda was to place WIPO in a position where it could sufficiently influence international IP law in ways which would further the development of poorer nations and prevent developed nations and multinational corporations from abusing IP law in ways which would hinder growth in the developing world.

The previous soft law emphasis did, as shown below, strongly influence the drafting of the eventual treaty. The Singapore Diplomatic Conference resulted in a treaty which made several major revisions and additions to the text of the 1994 Treaty. This was done to address concerns by trademark offices and trademark holders that major procedural aspects related to trademark law were left ungoverned by the 1994 Treaty. This lack of regulation, it was argued, led to unreasonable demands on trademark holders and to a greater unpredictability within those areas which were not covered by the old treaty.

This article continues in Part Two by discussing the reaction to the 1994 Treaty and the circumstances which led to the decision by WIPO to propose the adoption of a new treaty. Part Three explains how the newly re-written treaty, The Singapore Treaty on the Law of Trademarks (hereinafter “New Treaty” or “Singapore Treaty”), highlights the way in which it differs from the 1994 Treaty and provides reasons for each of the changes. Part Three also explores the potential implications of these changes from the 1994 Treaty. Part Four analyzes the effectiveness of these changes in implementing three different justifications for the harmonization of trademarks. Finally, the article concludes by presenting the argument that the Singapore Treaty makes mainly superficial changes and fails to seriously further the stated goals of International Harmonization advocates.

II. BACKGROUND

International agreements governing the protection of trademarks have existed since the Paris Convention in 1883. The Paris Convention established two basic principles: equal rights between nationals of a country and foreigners, as regards to protection of

marks, and international priority in the use of a mark. Since then, other treaties such as the Madrid Agreement (1892) have paved the way for international goods like Coca-Cola, BMW and Sony to become well-recognized and popular with consumers the world over. But despite this long history of international cooperation in trademark law, major conflicts, like that based on the requirement of actual use of a mark in common law countries, still exist.

The original Trademark Law Treaty ("1994 Treaty") was signed by the representatives of thirty-five nations, including the United States, China, Great Britain and Russia, in the same year as the GATT agreement which created the World Trade Organization (WTO). NAFTA went into effect in 1994 as well, and both GATT and NAFTA had the effect of unleashing an unforeseen period of globalization and increased international trade, which contributed to the economic boom of the late 1990s. The 1994 Treaty's main effect was to set forth measures allowing for the standardization of elements of procedure concerning trademarks, including the process of application, representation, the use of a single registration for multiple classes of marks, changes in names, addresses or ownership, providing for the correction of mistake and ensuring that service marks received the same treatment as trademarks. The 1994 Treaty set forth clear standards such as a ten-year registration period and trademark classification abiding by the Nice Agreement standards. By 1996, the agreement was hailed as a success "with far greater acceptance and standardization than had been hoped or expected". While many


12. Allan Greenberg, Trends in International Trademark Law, in 3 INTERNATIONAL INTELLECTUAL PROPERTY LAW & POLICY 32 (Hugh C. Hansen

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nations have not explicitly signed on to the treaty, most notably India, it has become the guideline for their procedures regarding trademarks. Because the 1994 Treaty had been modestly drafted to encourage widespread adoption, proponents of a stronger treaty which would ensure greater harmonization of trademark laws were encouraged by the progress of the original and hoped to continue that work. With the rise of globalization, the popularization of the internet, and other technical advances, some areas of the treaty, most notably communications and non-standard marks, became outdated.

The WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter, "Standing Committee") has monitored the state of international trademark law since 1998. As early as its first session, proposals for revision of the Trademark Law Treaty were already being discussed. By 2002, the Standing Committee concluded that revision of the 1994 Treaty was necessary and called for the convening of a diplomatic conference to do so. Work began within the Standing Committee to develop the elements of the new treaty, modeling some of the new aspects on the Patent Law Treaty of 2000. The Standing Committee considered amending the treaty to deal with substantive trademark issues (inclusion of dilution, etc.), but rejected the idea after consultation with parties to the treaty. The Standing Committee approved a final draft of

13. Id.
18. WIPO, Summary by the Chair, Standing Committee on the Law of
The proposed Treaty in April 2005. The Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty began on March 13, 2006 in Singapore and lasted for two weeks. The Conference produced the final version of the Singapore Treaty. The Standing Committee presented a fairly progressive draft treaty for consideration before the conference which significantly altered several aspects of the 1994 Treaty. Although many nations, from Iran to France, submitted proposals during the Conference, the Treaty in its final form strongly resembled the draft developed by the Standing Committee.

III. PROPOSED LEGISLATION – NEW ELEMENTS TO THE TREATY

There are five major ways in which the Singapore Treaty differs from the 1994 Treaty. All five of these changes were included in the proposed draft by the Standing Committee.

First, the scope of the treaty was expanded. While the 1994 Treaty only covered visible two-dimensional marks (and allowed for limited coverage of three-dimensional marks), the Singapore Treaty covers all forms of marks, including holograms, motion marks, and non-visible (audible and olfactory) marks. Second, the treaty revises the rules governing communications made by mark holders, applicants, or other interested persons (hereinafter, “interested persons”) to the trademark offices with which those interested persons must work. Most notably, the regulations governing electronic communications have been expanded and

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modernized. Third, the treaty now requires and specifies appropriate relief measures when an interested party fails to comply with certain time limits. Fourth, guidelines governing official recording (referred to in the treaty as “recordal”) of trademark licenses were included in the treaty. Lastly, the treaty created a Trademark Law Treaty Assembly (hereinafter “Trademark Assembly”) within WIPO to oversee future changes to the treaty and to issue new accompanying regulations or modify those already in place.

Because the treaty was modified in a way that dealt with completely separate issues of trademark procedure, each change stands on its own and needs to be analyzed as such. However, a common thread runs between most of the changes. A reading of the treaty in its entirety reveals that it seeks to simplify as much as possible any dealings interested persons will have with national trademark offices and prevent individual nations from finding loopholes to formal adherence to the terms of the treaty. Whether the New Treaty actually meets those lofty goals will be discussed in Part Four of this article.

Accompanying the treaty is a set of regulations (hereinafter, “Regulations”) which lay out the specifics of the procedural requirements implemented by the treaty. With the creation of the Trademark Assembly, the Regulations can also be more easily amended than the treaty itself. Because of this, the Regulations also incorporate many additional requirements which are more likely to need amendment given the fast-changing nature of intellectual property law. The drafters also created a set of model forms for all of the procedures referred to in the treaty, which are

22. Id. art. 8.
23. Id. art. 14.
24. Id. arts. 17-20.
25. Id. art. 23.
28. Forms include: Application for Registration, Request for Renewal,
meant to serve as templates for national trademark offices and can be substituted for a particular country’s procedural forms.

The Singapore Treaty, like the 1994 Treaty, limits itself to harmonization of the procedural aspects of the trademark laws of the signatories of the Treaty (hereinafter, “Contracting Parties”), as opposed to substantive elements, which are already loosely governed by the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”). In fact, substantive trademark law was specifically ruled out by the Standing Committee prior to the diplomatic conference which approved the Singapore Treaty. Members of the Treaty are wary of losing their independent control over substantive issues, while harmonization of procedure has little to no impact on policy and is less of a concern to legislatures and the public.

A. Expansion of the Scope of the Treaty

At its very outset, the 1994 Treaty was limited in its scope and did not govern all actions made by national trademark offices. Article Two, Paragraph One of the 1994 Treaty restricts the scope of the treaty to procedures and regulations governing “marks consisting of visible signs,” with the caveat that “only those Contracting Parties which accept for registration three-dimensional marks shall be obliged to apply this Treaty to such marks.” Part (b) of Paragraph One specifically excluded “hologram marks and .

Request for the Correction of Mistake, etc.

29. Due to the inclusion of the European Union as a signatory, alongside its member states (due to the nature of the Community Trade Marks Office), the term “nations” is not entirely appropriate for use here. The Treaty therefore uses the term “Contracting Parties” and that convention is followed in this article.


33. 1994 Treaty, supra note 2, art. 2, para. (1)(a) (emphasis added).
marks not consisting of visible signs, in particular, sound marks and olfactory marks.34 These exclusions were made to maintain uniformity as non-standard marks were rare and not recognized by many nations. Although the United States does recognize non-visual trademarks,35 the more standard marks covered by the 1994 treaty constituted approximately “ninety-nine percent of the marks filed in the United States Patent and Trademark Office” at the time the treaty was presented to the Senate for ratification in November 1997.36

As a result of advances in technology and free trade since 1994, the prevalence of non-visible and other excluded trademarks has increased.37 In 2002, WIPO recommended that the scope of the Treaty be widened to cover these marks as well.38 This was viewed by some members as a controversial move because acceptance of non-standard marks was considered a substantive issue beyond the scope of the Singapore Treaty, and the Standing Committee only moved forward after distributing a questionnaire on the subject to its member states and international organizations.39 Because of the lack of general acceptance of these non-traditional marks, the exception which previously allowed Contracting Parties to not recognize three-dimensional marks was expanded to cover all marks. This allows holders of non-traditional marks to receive the benefits of the treaty in those countries where their marks are valid.40 This can be done without imposing the requirement that any nation which chooses to not

34. Id. art. 2, para. (1)(b).
recognize such marks altogether be forced to accept them as a result of the Treaty.

The new Article 2(1)(a) simplifies the procedural rules by ensuring that the Treaty applies to every type of mark which a nation may choose to place under the protection of its trademark laws. Rather than enumerating which types of marks are included, excluded, or may be included under certain conditions, this rule covers all marks, without making distinction between them. This reduces any interference the Treaty may have with a participating nation/organization’s substantive trademark law. It also allows room for the emergence of new kinds of marks which may develop as a result of further technological innovation, without requiring a rewrite of the Treaty to ensure that fair treatment is accorded to holders of those new types of marks.

B. Communications: Article 8

A second change implemented by the new treaty is the revision of standards for communications made to the trademark offices of the Contracting Parties. Due to the rapid growth in the use of electronic communications after 1994, including e-mail and online registration, the old principles governing, among other things, signatures and “telefacsimile communications,” became outdated. In the 1994 Treaty, provisions concerning the form of communications permitted were separately placed in almost every Article. The old Article 8 also set forth elaborate provisions regarding signatures on paper documents, but had only a cursory mention of electronic communications.

In the 1994 Treaty, Article 8 was titled “Signature,” reflecting the importance that paper documents and their accompanying authentication had in the pre-Internet world. Article 8 has now been renamed “Communications” and places far less of an

41. Singapore Treaty, supra note 7, art. 8.
42. Also known as “faxes.”
45. Id. art. 8, para. 3.
46. Id. art. 8.
emphasis on paper forms. The new Communications article, like Paragraph One of Article Two described above, takes all of the clauses concerning any communication about any aspect of a mark and merges them into one rule, eliminating the possibility that identical language could be interpreted differently for different communications. Under the 1994 Treaty, unscrupulous trademark officials could claim that the identical phrase, "[a]ny Contracting Party may require that the application be in the language, or in one of the languages, admitted by the Office," had a different meaning in Article 11 (Change in Ownership) as it did in Article 12 (Correction of a Mistake), due to the rule of surplusage, or any other convenient pretext. Now, each of the articles which previously had its own provisions regarding communications simply directs the reader to Article 8 instead.

Article 8 allows a Contracting Party to choose the form of communication it will accept. "Any Contracting Party may choose the means of transmittal of communications and whether it accepts communications on paper, . . . in electronic form or any other form of communication." This is a major step away from the 1994 Treaty, which required acceptance of signed writings on paper for most categories. With the new provision, offices are potentially free to switch to all-electronic operations. The requirement of acceptance of any application which conforms to the Model Forms provided with the New Treaty has been clarified and is now uniform for all of the Model Forms. The provisions dealing with the language of communications, which previously specified documents requiring translation, are now expanded to allow for translation of any communication. This has been tempered, however, as the New Treaty allows restrictions requiring translation into only one language and prohibitions on requiring certification of translations.

47. Singapore Treaty, supra note 7, art. 8.
48. See id. arts. 3, 5, 10-17.
49. Id. art. 8, para. 1.
50. Model Forms were also provided with the 1994 Treaty, but requirement of use was scattered through the Treaty, as with all other communications rules.
51. Singapore Treaty, supra note 7, art. 8, para. 5.
52. Id. art. 8, para. 2.
53. Id.
It . . . enables a Contracting Party to require that some indications or elements of the communication, such as the list of goods and services, be in a language admitted by the Office which does not necessarily have to be the official language of the Office, and that some other indications or elements of the communication be in the official language of the Office. 54

Signatures may still be required on paper communications, but the specifics have been moved out of the Treaty itself and into the more easily modified Regulations. 55 Rule Six of the Regulations now also specifies that receipt of communications can be considered to have occurred when the communication has been made to an official postal service or an authorized delivery service, along with direct delivery to an official branch of the trademark office. 56 This officially incorporates the traditional common law “mailbox rule” 57 rather than requiring the date of receipt to be the actual date on which a mailed or delivered communication arrives at its destination.

New rules on electronic methods of communications have replaced the vague and now-outdated rules on “telefacsimile” communications. 58 To simplify the process of adjusting to rapidly-changing technology, the requirements have been shifted to the Regulations, which currently allow for requirements of electronic authentication, as well as requirements that electronic submissions be accompanied by a paper copy, albeit with a one-month grace period. 59 These changes were made to mirror similar provisions in the Patent Law Treaty. While not specified in the Singapore Treaty itself, the supplementary Resolution by the Diplomatic Conference issued along with the Treaty emphasized that these provisions do

54. Treaty Notes, supra note 40, at 10.
55. Singapore Treaty, supra note 7, art. 8, para. 3.
56. Regulations Under the Singapore Treaty, supra note 27, Rule 6, para. 7.
57. An acceptance is transmitted the moment it leaves the sender's control (i.e. being placed in a mailbox). See RESTATEMENT (SECOND) OF CONTRACTS § 64 (2007).
58. Singapore Treaty, supra note 7, art. 8, para. 4.
not oblige any Contracting Party to implement “electronic filing systems or other automation systems.” This ensures that smaller and poorer countries, which do not yet possess the necessary technological resources, will not be forced to implement such systems.

The Treaty now explicitly prohibits any application of the requirements authorized by the Treaty towards “communication between an applicant, holder or other interested person and its representative.” Any requirements mandated by a Contracting Party must concern communications made to the Contracting Party itself. This procedural requirement may be self-evident to those who have become accustomed to the strong tradition of lawyer-client confidentiality in common law nations, especially the United States. The globalization of trademark law has made the provisions of the Treaty especially important in nations without such protections, particularly in the former communist bloc and the developing world (China being the most prominent example). This is again an example of the Treaty’s underlying purpose of reducing trademark agency interference with interested persons in general.

Lastly, the Treaty now explicitly prohibits any other outside rules regarding any communications for purposes of national trademark law. Article 8 is the outer bounds of what procedures can be required of interested persons when communicating with trademark offices. This catchall prevents any bad-faith attempts by Contracting Parties to place additional hurdles in the path of interested persons, allowing those parties to concentrate on the substantial portions of their applications, claims, or any other important communication with a trademark office, rather than being forced to waste valuable time and energy on purely procedural matters.


61. Singapore Treaty, supra note 7, art. 8, para. 7.

62. Id. art. 8, para. 6.
C. Relief Measures for Failure to Comply with Time Limits: Article 14

Concerns about adverse actions taken against parties whose only fault is a failure to meet time requirements were raised as early as 2001.63 Efforts to include provisions dealing with relief for those parties have been present in all discussions of possible revisions of the Trademark Law Treaty. The new provisions added to the Singapore Treaty in Article 14 deal with two types of relief: requests for relief before the deadline in question has expired64 and those made after the expiration of the time limit.65 The Singapore Treaty appears to only allow relief measures for applications and registrations. Article 14 specifically mentions those two categories and does not mention changes in name or address, changes in ownership, correction of mistake, or licensing of marks.

In the case where an Interested Person has knowledge that they will not be able to meet a certain deadline and requests relief before the time limit passes, Article Fourteen, Paragraph One of the Treaty is non-intrusive. It allows Contracting Parties to provide for the filing of an extension of that time limit in any manner they see fit.66 Trademark Offices are also free not to provide such relief. This is not a major concern, as Interested Parties may wait until after the deadline expires and opt to seek some relief under the second clause of Article Fourteen.

Paragraph Two of Article Fourteen, which deals with relief measures after the deadline has passed, is much more involved. Paragraph Two requires that the office in question provide specific

64. Singapore Treaty, supra note 7, art. 14, para. 1.
65. Id. art. 14, para. 2.
66. Id. art. 14, para. 1.
listed relief measures. 67 The relief measures available under the New Treaty are: (1) extension of the time limit for no less than two months, (2) continuing the process of the application or registration, or (3) in the case of honest mistake, the reinstatement of the rights of the concerned person. 68

Of course, these remedies cannot be applied across the board, and several exceptions are listed in the Regulations 69 for which the remedies are not available. 70 These include:

(i) Missing a deadline which has already been expanded pursuant to Article 14(2) of the Treaty,

(ii) Filing a request for relief from failing to meet a deadline,

(iii) Failure to pay a renewal fee,

(iv) Actions before review bodies of the Office in question,

(v) Actions in inter partes proceedings,

(vi) Applications to take advantage of the priority of an earlier application or display of goods and/or services in an exhibition,

(vii) Filing a declaration to establish a new filing date for an application, and

(viii) Correction or addition of a priority claim. 71

The exclusion of many of these categories is self-evident, as granting relief for lateness would either undo the spirit of the category (e.g. filing for priority) or interfere unduly with national judicial or quasi-judicial proceedings. The intent is to make remedies available for honest mistakes, not to allow loopholes and

67. Id. art. 14, para. 2.
68. Id.
69. As opposed to the Treaty itself, for easier amendment.
70. Singapore Treaty, supra note 7, art. 14, para. 3.
71. Regulations Under the Singapore Treaty, supra note 27, Rule 9, para. 4.
more complexity to enter the system.

D. Licensing of Trademarks: Articles 17-20

The fourth change brought about by the New Treaty is the inclusion of Articles governing how trademark licenses may be officially recorded. Due to the nature of international trade, it is a common custom for parent corporations to license their easily-recognizable intellectual property, especially trademarks on popular brand names, to their foreign subsidiaries or partners. According to the August 1, 2004 International Trademark Association (INTA) Bulletin, failure to record a trademark license in countries that require official recordal of a trademark was the most common problem in foreign trademark infringement cases. Given the amount of licensing and its place in intellectual property law, proposals for rules governing the requirements for recording of licenses were brought up at Standing Committee Meetings as early as September 2000.

The new licensing Articles all deal with the rights of both the Contracting Parties and of the Interested Person who must register the trademark license in those countries which offer or require the recording of a license. Most importantly, rights granted to licensees by statute are preserved regardless of recordal or not. Article Seventeen is concerned solely with the process of having a license officially recorded by a Trademark Office. Only one request is sufficient, even when dealing with multiple marks/registrations, provided the holder and licensee are the same for all the transactions. This reflects the 1994 Treaty’s stance on initial trademark registrations, applications for transfer of ownership, and other similar transactions. Member Countries may

73. Trademark Problems to Avoid, INTA BULLETIN, August 1, 2004, at 4.
75. Singapore Treaty, supra note 7, arts. 17-20.
76. Id. art. 19, para. 2.
77. Id. art. 17.
78. Id. art. 17, para. 3.
only impose the recording requirements in the categories laid out in the Regulations. The Regulations also restrict which supporting documents must be submitted along with the request.

Article Seventeen prohibits countries from imposing three requirements in particular. No trademark office may require furnishing of the registration certificate of the mark, furnishing the licensing contract, or furnishing any “indication of the financial terms of the license contract.” The prohibition on these three requirements, however, only applies to the request itself. Contracting Parties are authorized to demand these documents for other inquiries concerning the licensing agreement. Article Eighteen specifies that only the same requirements applied to requests for recording in Article Seventeen may be applied to requests for amendment or cancellation of a license registration.

Article Nineteen strictly addresses the rights of Interested Parties as opposed to the practices of Trademark Offices. This Article outlines the rights that are retained by all parties even when the licensing of a trademark is not officially recorded. As the inclusion of guidelines for license recording could be seen as encouraging its requirement, Article Nineteen sets forth that failure to record a license is not sufficient cause to deny licensees or holders any rights they have in the marks in question. The Article does not address the issue of whether a licensee has the right to join proceedings involving a holder or vice-versa, but failure to record the license cannot be grounds to deny such a right when the right is given. The first section of Article Nineteen also prohibits countries and organizations from canceling the registration of a licensed mark if a license to use the mark has not been properly recorded. Article Twenty allows requiring an

79. Id. art. 17, para. 1.
80. Id.
81. Singapore Treaty, supra note 7, art. 17, para. 4(a)(iii). Other governmental offices may still require the parties to furnish these documents, for other valid purposes. See Treaty Notes, supra note 40, at 20 n.17.07.
82. Singapore Treaty, supra note 7, art. 17, para. 4.
83. Id. art. 18 para. 2.
84. Id. art. 19, para. 1.
85. Id. art. 19, para. 2.
86. See Treaty Notes, supra note 40, at 21 n.19.03.
87. Singapore Treaty, supra note 7, art. 17, para. 1.
indication that a mark is being used under a license, but separates any sanction for violation of that rule from the loss of rights prohibited in Article Nineteen. Article Twenty also ensures that failure to indicate licensing of a mark will not result in the loss of registration of the mark by its owner.

**E. Assembly of the Contracting Parties**

Finally, what first appears to be the most significant change brought about by the Singapore Treaty is the creation of an Assembly of the Contracting Parties. The Trademark Assembly, modeled after the Patent Law Treaty Assembly, is empowered to convene conferences for the revision of the Treaty, to amend the Regulations and determine the conditions for application of those amendments, as well as "perform such other functions as are appropriate to implementing the provisions of [the] Treaty." The Assembly will meet at the same time as the WIPO General Assembly, or at any other time upon the convocation of the Director-General of WIPO. During meetings of the Trademark Assembly, each nation will have one vote, while Intergovernmental Organizations representing their members (i.e. the EU) are given the option of casting as many votes as they have members who are party to the Treaty. The notes to the Treaty specify that this is an option, and the member states may vote individually, if they choose. The goals of the Assembly are to come to decisions by consensus, but for contentious issues, voting is preferred to non-action. Keeping with the spirit of consensus, a supermajority two-thirds vote is required for most votes, while an even more restrictive three-quarters vote is required to amend the Regulations.

The Director General and the International Bureau of WIPO will

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88. *Id.* art. 20.
89. *Id.*
90. *Id.* art. 23, para. 2.
91. *Id.* art. 23, para. 6.
92. *Id.* art. 23, para. 4(b).
93. *Treaty Notes, supra* note 40, at 2 n.2.01.
95. *Id.* art. 23, para. 5.
96. *Id.* art. 22, para. 2.
deal with administrative matters relating to the Treaty and the Assembly. 97 The Director-General shall, among other things, act as Secretary of the Assembly at meetings and revision conferences. 98 The International Bureau shall provide the Assembly with its Secretariat, and is responsible for preparatory work for any meeting as well as any other tasks assigned to it which relate to the Treaty. 99

IV. ANALYSIS

Many different rationales and goals have been used by various proponents of global harmonization of intellectual property law. Most of those rationales, while originally used to promote earlier endeavors, can be applied equally well to the Singapore Treaty. Professor Kenneth Port theorized that there are three basic agendas behind the push for the "harmonization" of trademark law in his critique of the 1994 Treaty. 100 The first group seeks to make all trademark law in the world uniform so that trademark owners, their lawyers, and other representatives, only have to understand one set of rules in order to know their rights worldwide. 101 A second group hopes to minimize conflict between different sets of rules without requiring them to be exactly the same, and a third group wishes to promote measures which "[imply] the creation of accord or consonance." 102 According to Port, these categories are primarily the desires of trademark holders, diplomats and patent officials, and academics, respectively. 103

While the Singapore Treaty certainly satisfies the third category of expectations, it is the most superficial and least substantive of the three categories. When using the other two categories as a means of examining the five major changes to the Treaty, the effectiveness of the Treaty falls short of the stated goals of its

97. Id. art. 24.
98. Id.
99. Id.
101. Id. at 34.
102. Id. at 34-35.
103. Id. at 35.
drafters either to unify trademark law completely or to minimize the gaps between different systems. Therefore, the Treaty fails to advance the cause of international trademark harmonization.

A. Development towards a Unitary System of Trademark Law

Describing it as an effort to develop a single system of laws which would apply to trademarks worldwide would be a radical simplification of the movement towards the unification of law. Predictability, particularly for those directly affected by the law in question, is the key consideration. Port defines the process:

[the process is merely an effort to] study similarities between systems (so that you are comparing comparables), categorize each system, and determine the common denominator of substantive treatment of any given legal issue. Through this process, theoretical as well as legislative lessons might be learned to determine what, if anything, other societies should change in their legal systems.

This implies a series of studies as to the comparative benefits of the current differences between the various procedures and rules of trademark law. This is an extension of the concept of individual states serving as “laboratories of democracy” to actually have concrete evidence of the success or failure of a particular way of doing things. WIPO’s previous focus on “soft law” initiatives and the use of the Standing Committee to review proposals are examples of WIPO’s work in this area. But in the end, a single standard must be chosen, and all local regulations must be made to correspond to that standard, or else the unitary system will never come into being. So the question must be asked – does the Singapore Treaty succeed as a means of providing Interested

105. Port, supra note 100, at 47 n.53.
Persons more predictability in their dealings with trademark offices worldwide?

Unfortunately, the answer is that while some further harmonization is achieved, trademark owners' lives will not be made easier as a result of the New Treaty. Examining the effects of the relevant changes shows that the Treaty sets a basic floor of generalized right, but leaves the various trademark regimes to their own devices in terms of how they wish to comply with the new provisions, as well as granting great latitude to grant greater protections than those granted by the Treaty. At the expense of predictability for Interested Persons, the Treaty preserves national sovereignty and does not significantly lead towards a unitary system of trademark law.

1. Expansion of Marks Covered by the Treaty

At first glance, the expansion of the number of types of marks covered by the Treaty would appear to be a definite step towards uniformity in all types of trademark law. But the new provision is crafted in such a way as to allow maximum flexibility in the treatment of non-standard marks by Contracting Parties, and current differences as to the registrability of three-dimensional, movement, sound, and other marks remain intact. WIPO maintains that the Treaty retains the power to "define relevant standards, once the treaty has entered into force and once there is agreement on the substance of such standards," but such statements are premised on WIPO's future ability to bring about some kind of agreement on non-traditional marks.

Until that agreement is reached, the expansion of the treaty to cover all marks is severely restricted by the caveat that no particular mark must be protected by a jurisdiction. That is not to say that there is no benefit to trademark holders. Where Contracting Parties were only prevented from imposing onerous restrictions on two-dimensional visual marks, now procedures for all marks will be standardized. This would be most useful to applicants seeking to register multiple marks, some traditional and some not, as the procedures to register both would be held to the

same requirements. This does bring a certain level of added predictability to Interested Parties, but this predictability is strictly on a national level—it evens out varied procedures within the same regime. This is a national issue, which could have been solved at the national level, rather than through a treaty, which should be focused on international issues. Where the Treaty fails to produce increased predictability is when moving from one regime to another. Even in closely-bound international trade groups, like NAFTA, there is no predictability. In NAFTA, the United States allows olfactory marks, while Mexico, its third-largest trading partner, does not.

Following Professor Port’s logic, if no attempt is made to promote a single standard then harmonization has not occurred. In this way, the Singapore Treaty is a step back from the 1994 Treaty. In the 1994 Treaty, a standard was set—only visual, stationary trademarks were to be protected, and all others were excluded. This did provide predictability to parties seeking to register non-traditional marks, namely that they would not receive the protection of the 1994 Treaty. Under the Singapore Treaty, those same parties would have to conduct a country-by-country search in order to determine if they could rely on the Treaty, based on whether that country accepted that type of mark, rather than on any international standard.

Instead of simplifying the process, the Treaty has replaced one potential stumbling block—the disparate treatment of different types of marks by trademark offices—with a different form of complexity—the interjection of a third party (WIPO) into the proceedings. The Treaty does not accomplish harmonization in the form of setting forth a single or even simplified standard. From the point of view of the trademark holder, the various national systems must still be approached individually, without improvement in terms of unifying principles or standards.

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108. Historically, Mexico has been the United States' second-largest trading partner, but was surpassed by China in October 2006. See U.S. Census Bureau, Foreign Trade Statistics, October 2006, http://www.census.gov/foreign-trade/statistics/highlights/top/top0610.html (last visited Nov. 1, 2007).
109. Martin, Michaus R., An IP Overview after 12 Years of NAFTA and TRIPs in Mexico, Global Competition Review.
2. Communications

The revision of Article Eight of the New Treaty, which deals with Communications, had two major thrusts. First, the article consolidated all of the separate rules governing different communications (e.g. applications, registrations, etc.) from the individual articles dealing with each communication into one article. Second, the new article is modernized, in order to deal with advances in technology. It addresses those changes which have already come into place since the signing of the 1994 Treaty, as well as providing for any future changes in the way trademark offices do business.

The consolidation of all of the rules regarding communications into Article Eight and having all other clauses refer back to that Article is a prime example of rewriting the treaty with the intent of minimizing any potential differences between systems and promulgating a single, unified standard for all parties to follow.\textsuperscript{110} The language of the 1994 Treaty was superfluous in several sections. Such sloppy drafting is a temptation for unscrupulous trademark officials looking to circumvent the Treaty’s mandates.\textsuperscript{111} With consolidation, a more even application of the rules governing communications is not merely possible, but required.

The manner in which the new Article Eight is written, although a sincere attempt at providing greater predictability for Interested Persons, is not a true solution. It remains riddled with the same caveats and exceptions from the 1994 Treaty which allow such a degree of independence to the Contracting Parties that any single standard is impossible to discern. While the rules have been consolidated, they still only mandate certain boundaries of behavior beyond which national trademark laws may not go. For example, in Paragraph Three of Article Eight, the Treaty prevents a Contracting party from requiring “attestation, notarization, authentication, legalization or other certification of any signature”\textsuperscript{112} in sub-clause (b), but then in sub-clause (c) allows contracting parties to “require that evidence. . .where the Office

\begin{footnotesize}
\begin{itemize}
\item[110.] Singapore Treaty, supra note 7, art. 8.
\item[111.] See Frost, supra note 37.
\item[112.] Singapore Treaty, supra note 7, art. 8, para. 3(b).
\end{itemize}
\end{footnotesize}
may reasonably doubt the authenticity of any signature."\(^{113}\)

As a means of keeping national systems harmonized despite any technological advances, the treaty also refrains from setting out a single standard and instead leaves the various trademark offices free to accept or reject new ways of submitting correspondence, such as via e-mail or web-based forms. The Singapore Treaty meets trademark holders' expectations by at least acknowledging the rapid advances in telecommunications since 1994.\(^{114}\) However, the new treaty provisions simply provide for use of future technologies by trademark offices as they wish, rather than provide a broad rule covering how these new technologies may or may not be used. Additionally, the statement in the supplementary Resolution clarifying that no nation will be forced to adopt new technologies\(^{115}\) could presage wild differences in the processing of applications, with developed countries going completely on-line while developing nations still use paper and ink.

This can be seen by the manner in which Article Eight is written. Each paragraph, with the exception of Paragraphs Five and Six, specifies how a Contracting Party may impose requirements on communications regarding trademarks. In terms of modernization, the key paragraph, Paragraph One, states "Any Contracting Party may choose the means of transmittal of communications and whether it accepts... paper... electronic... or any other form of communication."\(^{116}\)

Paragraph Six is the main operative clause of Article Eight, and now mandates that no other requirements beyond those mentioned in Article Eight may be imposed by any Contracting Party.\(^{117}\) This language was not included in the 1994 treaty. Article Eight now operates as a ceiling for behavior rather than a floor. But within the outer boundary provided by Paragraph Six, predictability remains elusive. There is just too much room for local choice for

\(^{113}\) Id. art. 8, para. 3(c).

\(^{114}\) Advances in telecommunications being one of the prime sources in the boom in globalized trade which necessitated a revision of the Trademark Law Treaty in the first place. See The New Singapore Treaty on the Law of Trademarks: What Does it Change?, supra note 14.

\(^{115}\) See Diplomatic Resolution, supra note 60.

\(^{116}\) Singapore Treaty, supra note 7, art. 8, para. 1.

\(^{117}\) Id. art. 8, para. 6.
Paragraph Five is the best example of a unified rule. It provides that the model forms attached to the Treaty shall be accepted by any Contracting Party, creating a universally acceptable method of communications. But Paragraph Five existed in virtually the same form in the 1994 treaty, and therefore cannot be regarded as a move forward by the Singapore Treaty.

3. Relief Measures and Licensing of Trademarks

As regards movement towards a unified standard trademark law, the New Treaty’s addition of rules regarding ‘Relief Measures for Failure to Comply with Time Limits’ and those governing the ‘Licensing of Trademarks’ operate in similar ways. Unfortunately, they both act to set basic floors for behavior, but offer free rein for nations to offer more protections than those set by the Treaty. Because these new measures simply act as a floor, allowing for wide variation from system to system, the Singapore Treaty does not move towards a greater harmonization from the unification of laws standpoint.

In the case of time limit relief measures, predictability is provided by the fact that some form of relief must be provided to parties who miss a deadline. However, the form of that relief can vary widely from jurisdiction to jurisdiction. For the first form of relief—relief granted before the time limit has passed—trademark offices are given almost free rein to determine whether extensions can be granted and how long those extensions may last. There is no guidance whatsoever from the New Treaty. The Treaty does mandate that Contracting Parties must offer one of three forms of relief to parties who have already exceeded a time limit, but offers no guidance as to which of the choices should be given. While this reduces the potential consequences down to a manageable level, it can hardly be seen as a single unitary standard. Additionally, the first optional time limit extension only sets a minimum of two months for the extension, but trademark offices are free to offer an extension of any length over that as they

118. Id. art. 8, para. 5.
119. 1994 Treaty, supra note 2, art. 3, para. 2(i).
The Treaty offers guidance, but for Interested Persons, determining what the rule is still requires a case-by-case analysis.

Likewise, the acknowledgment of trademark licensing as a key part of international trademark law creates an incentive for the unification of the rules governing licensing. However, the new rules set out by the Singapore Treaty do not lead to a single standard which would govern trademark licensing, and more particularly, the official recording of those licenses. The treaty simply sets out a floor for what procedures various offices may require, and in Article Seventeen, explicitly bans certain requirements.\footnote{See Singapore Treaty, supra note 7, arts. 17-20.} Beyond that, the New Treaty simply lays out a floor above which Contracting Parties are free to set whatever rules and regulations they please.

Article Nineteen takes some steps towards real standardization by laying out that the rights of licensees are preserved regardless of recordal, without exception.\footnote{Id. art. 19.} This is an excellent example of how the Singapore Conference could have set out clear universal rules to be applied by all member countries, without any leeway or “may” clauses. But other than this key element, the remaining rules regarding both relief from failure to meet deadlines and recordal of licenses are set up loosely, outlining the basic principles that Contracting Parties should abide by, but without setting a single standard.

4. Trademark Treaty Assembly

The Trademark Assembly may produce a more unified set of rules in the future with revisions to the Treaty and Regulations which remove the existing exceptions and loopholes or address substantive trademark law. When analyzing the effects of the Singapore Treaty, however, any movement the Assembly may make once it is established is far too speculative to really qualify as concrete assurance that a greater unification of international trademark laws will be achieved. Additionally, the fact that consensus is the preferred route for decisions by the Assembly, with a minimum of a two-thirds vote required for any action, makes any progress on heavily-contested issues very difficult to
envision. With such strict requirements for action, it is likely that nations are more likely to independently adopt new standards and then formalize them through use of the Assembly, rather than the Assembly being the catalyst for any new substantive rules in international trademark law.

B. Bridging the Gaps Between Different Trademark Regimes

If we assume that the rationale for the Singapore Treaty is not to create a single standard for worldwide trademark law, but instead to minimize the differences between existing trademark regimes, then a different method of analysis is needed. Proponents of bridging-the-gaps methods of harmonization like Professor Arthur Rosett argue that universal rules often have the perverse effect of causing more confusion in international business matters, and separating international law from similar domestic regulation.123 When a matter is purely domestic, the governing authority usually has full control over what methods of regulation to use, but when matters are partly domestic and partly international, that same governing body is subject to international standards. This can create a disconnect in the way trademark offices treat local and international applicants. When bridging the gaps, rather than finding the best method or most effective rule, the harmonizing authority (here, the Singapore Conference) leaves discretion to individual nations and seeks to minimize potential conflict between the systems those nations have set up. The main goals in this system are to harmonize outcomes and to encourage parties to make the choices which are already the most beneficial.124

The most relevant example for the Singapore Treaty is the European Union’s Community Trade Mark System.125 When the EU Council issued its first directive concerning trademark harmonization, it did so by setting forth basic guidelines outlining the rights (both floors and ceilings) of trademark holders and

124. Id. at 696.
ordering its member nations to amend their individual laws to match these guidelines. The new trademark office, the Office of Harmonization in the Internal Market (OHIM), functions as a supplement to protections granted by national trademark offices. Interested Parties may now rely on both national standards as well as OHIM.126

Professor Port cited Stephen Zamora’s analysis of harmonization in NAFTA127 as a key example of this theory of harmonization.128 “Harmonization,” according to Professor Zamora, “does not entail the adoption of a single, model set of rules, but instead implies a wide range of ways in which differences in legal concepts... are accommodated.”129

The Singapore Treaty is certainly very careful to leave room for individual variation; thus, it would make sense that the treaty would attempt foremost to bridge the gaps between different systems.

1. Expansion of the Treaty

The most significant way in which the New Treaty attempts to minimize the differences between the rules of its various signatories is the expansion of the treaty to cover any form of trademark recognized by a particular nation.

This change bridged gaps by ensuring that whatever a particular country’s policy towards recognizing non-standard marks (three-dimensional, sound, olfactory, motion, hologram, etc.,) the rules of the Treaty apply to all of its trademarking rules and regulations. This enables a person familiar with one form of mark in one jurisdiction to travel to another jurisdiction and encounter a system based on those same rules. The old system resulted in many nations having one base set of procedures for visual, two-

128. Port, supra note 100, at 34.
129. Zamora, supra note 127, at 403.
dimensional marks and a completely separate way of operating for the small number of non-traditional marks, as Professor Rosett predicted would come of excessive focus on the unification of laws. Under the new regime, one basic set of standards now governs the breadth and depth of marks and any new forms of marks which future advances in technology may make possible.

From the perspective of one interested in minimizing the gaps between different systems, this helps remove pockets of trademark law where the gaps between various systems have allegedly grown larger—non-standard marks. Now the similarities between the rules remain the same, whether a mark is of the sort generally accepted worldwide or is a newer, less traditional mark. This is done without mandating a single, universal standard as to the validity of non-standard marks, but ensures that the procedural differences between systems are minimized. For example, the requirements established governing multiple registrations now can be used by an applicant seeking to register both two- and three-dimensional forms of the same logo.

2. Procedural Issues

The Singapore Treaty also bridges the gaps in the more procedural areas, including the major changes in “Communications,” “Relief Measures in Case of Failure to Comply with Time Limits” and “Licensing of Trademarks,” but to a lesser degree.

All of the reforms in each of the procedural areas set certain minimum requirements on how trademark offices may deal with those procedural issues, but this new floor can hardly be considered a way to minimize the differences between systems. For example, when Interested Parties fail to meet a deadline, some relief must be allowed. But it is left to the respective Contracting Parties to determine the particular form of relief. When an extension of the deadline is granted as relief, the Contracting Parties are free to choose any length beyond two months that they feel is appropriate.130 At the same time, the Contracting Party may or may not simply continue the proceedings without the need for a

formal extension, and the rights of the holder may or may not be reinstated, depending on which of the provided methods of relief that particular nation's government has decided to be the best option.  

Likewise, a trademark licensee now only has to file a single request for recordal of multiple licenses, a basic guarantee which Interested Persons can rely on in any of the Contracting Parties. But this is hardly an example of common ground as the exact procedural requirements can vary widely from nation to nation, and applicants must meet certain requirements to qualify for the single application. While the new requirement certainly makes life easier for applicants, it does nothing to regularize the worldwide trademark system and to bridge gaps for those moving from one system to another. A far more effective reform would have been to add guidelines as to the procedural restrictions Contracting Parties can impose on those license recordal applications, or even to go as far as to include trademark licensing within the Madrid System. The restrictions in Article Seventeen which prevent a Contracting Party from requiring that licensing parties provide copies of the mark registration, licensing agreements or any similar documents provides a basic floor for behavior, but once again, this cannot be considered an accommodation of separate rules within a single system, but simply a low level of constraint on the current hodgepodge of trademark rules. These reforms are certainly good starting points which reflect international consensus, but to call this an effective gap-bridging measure would set the bar for gap-bridging so low that almost any measure which regulates trademark law could be considered an effective way of bridging gaps between trademark systems.

3. Trademark Assembly

The Trademark Assembly seems more geared toward proposing new regulations rather than minimizing the differences between the trademark regimes already in place. Additionally, the effects of the Assembly are far too speculative at this time to represent any

132. Id. art. 17, para. 3.
133. Id. art. 17, para. 4; see also supra text accompanying notes 77-83.
real achievement in gap-bridging.

C. Creating the Impression of Accord

Professor Port’s third category of harmonization is not a definition used by proponents of international harmonization, but instead by those who see it as a futile, or even counterproductive, effort. Professor Martin Boodman best articulated this point of view when he said that harmonization "is either redundant because it already exists, or meaningless because it describes any and every comparative legal analysis."[^134] Should the nations behind the new WIPO Development Agenda be able to turn WIPO into a more dynamic organization, the Assembly certainly has the potential to become a major force for serious discussion and reform of the major issues within trademark law.

In terms of the appearance of international accord, the various provisions of the Singapore Treaty all act in similar ways. Each of the new sections deals with a gap left uncovered by the 1994 Treaty. The 1994 Treaty specifically excluded coverage of non-standard marks, was silent on the issues of licensing and relief for failure to meet a time limit, and was simply outdated when dealing with communications. The Singapore Treaty provides broader regulation to cover each of these gaps, therefore creating the impression of accord over them. Now, proponents of the treaty, when asked about the discrepancies in various national treatment of issues such as the licensing of trademarks can point to the Singapore Treaty as an example of agreement between all of the Contracting Parties on those issues. The elimination of red tape and the "modernization" of the treaty to accommodate new technologies are the primary foci of enthusiastic press releases which use the Treaty as an example of WIPO’s commitment to harmonizing trademark law.[^135] Likewise, expansion of the Treaty’s scope to cover these areas is the easiest way of showing

If the Treaty had instead chosen to deal with substantive issues such as actual use requirements, proof of progress by WIPO would not be as clear. While the Singapore Treaty stands out by delving into the previously uncovered areas of licensing, relief measures, non-standard marks, and electronic communications, its changes are not as significant as they would be had it addressed more substantive issues.

Although less objective than the other two categories, Professor Port’s third category of harmonization – actions which create the impression of accord or agreement between parties – seems to be the most fitting for the Singapore Treaty. Unfortunately, the Treaty is just that. It acts more to create the illusion of progress and standardization of trademark law than any actual progress or standardization. Even when using the more lenient “bridging the gaps” theory, the Singapore Treaty still falls short of meaningful change, and the main result is the appearance of further international cooperation.

V. CONCLUSION

The Singapore Treaty sets out to “improve” the state of international trademark law, but does so in an extremely haphazard fashion. Instead of setting out a concrete goal and working to best achieve that goal, the framers of the Treaty seem to have entered into the treaty with the best of intentions, but with no clear outline of what the end result of the Treaty was supposed to resemble. The resulting treaty reflects this. Rather than making clear rules, or even addressing real problems of moving between various systems, the Singapore Treaty establishes broad outlines of behavior, which may or may not improve the lives of Interested Parties or trademark officials. This cannot be characterized as “harmonization” in any way. Instead, the New Treaty is comprised of superficial changes made to create the impression of progress. This “fluff” in the place of real harmonization is the reason countries like Brazil and Argentina have been pushing the new Agenda for WIPO. If the Singapore Treaty is any guide, however, that agenda may just be another piece of window

dressing while WIPO continues to neglect the harmonization of trademark law.

_Samay Gheewala_