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SINGAPORE TREATY ON THE LAW OF TRADEMARKS

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Mr. BIDEN, from the Committee on Foreign Relations, submitted the following

REPORT

[To accompany Treaty Doc. 110–2]

The Committee on Foreign Relations, to which was referred the Singapore Treaty on the Law of Trademarks, adopted in Singapore on March 27, 2006 and signed by the United States at Singapore on March 28, 2006 (the "Singapore Treaty" or "Treaty") (Treaty Doc. 110–2), having considered the same, reports favorably thereon with a condition as indicated in the resolution of advice and consent, and recommends that the Senate give its advice and consent to ratification thereof, as set forth in this report and the accompanying resolution of advice and consent.

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I. BACKGROUND

The Singapore Treaty was negotiated under the auspices of the World Intellectual Property Organization (WIPO), which was established by the WIPO Convention in 1967 and is composed of 184 Member States, including the United States. Negotiations were concluded and the text of the Treaty adopted by a diplomatic conference on March 27, 2006.

The Singapore Treaty is a revised and updated version of the 1994 Trademark Law Treaty, which the United States ratified on

May 12, 2000 (the "TLT") (Treaty Doc. 105–35; Exec. Rept. 105–17). The purpose of the TLT was to simplify and harmonize administrative procedures for national trademark applications and the protection of marks. Specifically, the TLT established a maximum list of formal requirements that a Contracting Party could impose on trademark applicants and holders. The Singapore Treaty contains virtually all of the provisions that are in the TLT, but includes additional provisions, which are intended to improve upon and update the framework established by the TLT.

II. Purpose

The purpose of the Singapore Treaty is to further harmonize and simplify the process of recording trademark licenses and applying for and maintaining trademark registrations in those countries or intergovernmental organizations that are a party to the Treaty. In particular, the Singapore Treaty improves upon the TLT by: (1) allowing national trademark offices to accept only electronic filings, if they so choose; (2) providing relief measures for failures to comply with certain time limits; (3) imposing limits on license recordal requirements and on penalties associated with a failure to record licenses; (4) creating an Assembly to deal with matters concerning the Treaty; (5) expanding the scope to include new types of marks; and (6) clarifying the role of WIPO's International Bureau in administering the Treaty.

III. Major Provisions

A detailed analysis of the Singapore Treaty may be found in the Letter of Submittal from the Secretary of State to the President, which is reprinted in full in Treaty Document 110–2. A summary of the key provisions of the Treaty that go beyond the TLT is set forth below.

1. Electronic Processing

The Singapore Treaty makes it possible for a national trademark office to rely exclusively on electronic processing, rather than paper processing. Specifically, Article 8 provides that any Party to the treaty may choose whether it accepts communications on paper, communications in electronic form, or any other form of communication. By contrast, several provisions of the 1994 TLT, which are not included in the Singapore Treaty, require domestic trademark offices (such as the U.S. Patent and Trademark Office (the "USPTO")) to accept trademark applications submitted in paper form.

The Singapore Treaty does not, however, mandate that Parties implement electronic filing systems or other automation systems. This is made clear in Section 3 of the Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks and the Regulations Thereunder (the "Supplementary Resolution"), the text of which is set forth at pages 42–43 of Treaty Document 110–2, and in Rule 6 of the Regulations.

In testimony before the committee regarding the USPTO's plans to move towards electronic filing, Ms. Boland explained that over 90 percent of trademark applications are currently filed electroni-

cally with the USPTO. At present the United States does not plan to mandate electronic filing but may revisit this question within the next decade.

2. Relief for Failure to Comply with Certain Time Limits

The Singapore Treaty provides relief under particular circumstances to applicants for their failure to comply with certain time limits. Specifically, Article 14 requires Parties to provide one or more specific relief measures for trademark applicants who apply for such relief after having failed to comply with certain time limits during the trademark application process. Relief measures can take the form of: (1) an extension of the time limit concerned for the period prescribed in the Regulations; (2) continued processing with respect to the application or registration; or (3) a reinstatement of the rights of the applicant, holder, or other interested person with respect to the application or registration if the trademark office finds that the failure to comply with the time limit concerned occurred in spite of due care having been taken or, at the option of the Contracting Party, that the failure was unintentional.

3. Limit on the Requirements for the Recording of a License and on Associated Penalties

Certain countries (not the United States) require that trademark licenses that are issued by trademark owners be recorded with their national Offices. Articles 17 and 18 of the Singapore Treaty impose limits on the types of requirements that a Contracting Party can impose with respect to recording a license, in an effort to minimize the formalities associated with this process, which can be costly, time-consuming, and complex. Articles 19 and 20 provide additional protection by prohibiting Contracting Parties from depriving trademark owners or licensees of certain legal rights simply because of a failure to record a license. For example, Article 19(1) provides that the lack of recording a license in a Party's national Office shall not affect the validity of the registration of the mark that is the subject of the license or the protection of that mark.

4. The Assembly

The Singapore Treaty establishes an Assembly of the Parties, which is expected to help facilitate the development and implementation of the treaty regime. Specifically, Article 23 establishes an Assembly to amend the Regulations under the Treaty, including the Model Forms, and determine the conditions for the effective date of such amendments; address matters concerning the development of the Treaty; and perform other appropriate functions related to treaty implementation.

5. Scope

The Singapore Treaty expands the scope of marks covered by the Treaty beyond those covered by the TLT. Specifically, the scope provision in Article 2 of the Singapore Treaty goes beyond visible signs to non-visible signs such as sound, taste, scent, or feel, in addition to non-traditional marks, such as three-dimensional marks and holograms. These marks are being increasingly protected in jurisdictions around the world, such that it is useful to have them

covered by the Treaty. Further, Section 3 of the Supplementary Resolution makes it clear that the Treaty does not impose an obligation on Contracting Parties to register new types of marks.

6. WIPO's International Bureau

Article 24 of the Singapore Treaty clarifies the administrative tasks to be performed by WIPO's International Bureau in relation to the Treaty. Among other tasks, the International Bureau is responsible for preparing and staffing meetings of the Assembly and other committees or working groups established by the Assembly, as well as revision conferences.

IV. Entry Into Force

In accordance with Article 28, the Treaty will enter into force three months after ten States or intergovernmental organizations referred to in Article 26(1)(ii) of the Treaty have deposited their instruments of ratification or accession. If the United States is among those initial States that deposited their instruments of ratification, the Treaty will enter into force for the United States three months after the tenth instrument of ratification or accession is deposited. If not, the Treaty will enter into force for the United States three months after the date on which it deposits its instrument of ratification.

V. Implementing Legislation

No further implementing legislation is required for the Treaty. Current law suffices to implement the Treaty.

VI.Committee Action

The committee held a public hearing on the Treaty on July 17, 2007 (a hearing print of this session will be forthcoming). Testimony was received by Ms. Lois E. Boland, Director of the Office of International Relations, U.S. Patent and Trademark Office. On September 11, 2007, the committee considered the Treaty, and ordered it favorably reported by voice vote, with a quorum present and without objection.

VII. Committee Recommendation and Comments

The Committee on Foreign Relations believes that the Treaty is an important tool to further promote and protect the rights of U.S. Trademark owners on a worldwide basis. The committee therefore urges the Senate to act promptly to give advice and consent to ratification of the Singapore Treaty, as set forth in this report and the accompanying resolution of advice and consent.

TACIT AMENDMENTS

Articles 22 and 23 of the Singapore Treaty make clear that the Regulations can be amended by a super-majority vote of the Assembly and such amendments will take effect for all even absent the explicit consent of all Contracting Parties, unless the particular amendment requires unanimity in accordance with Article 22(3).

The committee recognizes that such a tacit amendment procedure for amending regulations annexed to a treaty is fairly common in multilateral intellectual property treaties negotiated under the auspices of WIPO, many of which have been ratified by the United States. Allowing the Assembly to amend the Regulations in this manner makes it possible for the technical implementation of the treaty to evolve without going through the more formalized and standard amendment process, which involves a revision conference and frequently takes years to effect. Amendments effected through this mechanism may not, as a matter of law, rise to the level of those that require the advice and consent of the Senate. The executive branch has assured the committee that there is an inherent limitation on any amendments to the Regulations the Assembly can consider, because the Regulations cannot exceed and can only implement the Singapore Treaty's provisions. An amendment to the Regulations so limited should not, in the normal course, require advice and consent. If there is any question, however, as to whether an amendment to the Regulations goes beyond the implementation of specific provisions in the Singapore Treaty, the committee expects the executive branch to consult with the committee in a timely manner in order to determine whether Senate advice and consent is necessary.

The committee has included a condition in the resolution of advice and consent to ratification, which requires the Secretary of State to transmit to this committee, and to the Committee on the Judiciary, the text of an amendment to the Regulations no later than 60 days after the Assembly has agreed to the amendment. This reporting requirement is not intended to be a substitute for consultation regarding the character of an amendment, as described above.

VIII. Resolution of Advice and Consent to Ratification

Resolved (two-thirds of the Senators present concurring therein),

SECTION 1. SENATE ADVICE AND CONSENT SUBJECT TO A CONDITION

The Senate advises and consents to the ratification of the Singapore Treaty on the Law of Trademarks adopted in Singapore on March 27, 2006 and signed by the United States at Singapore on March 28, 2006 (Treaty Doc. 110–2), subject to the condition of section 2.

SECTION 2. CONDITION

The advice and consent of the Senate under section 1 is subject to the following condition:

> Report on Amendments to the Regulations. Not later than 60 days after the Assembly has agreed to an amendment to the Regulations pursuant to Article 22 and Article 23 of the Treaty, the Secretary of State shall transmit the text of the amendment to the Committee on Foreign Relations and the Committee on the Judiciary of the Senate.

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