

Public Consultation Paper

Singapore Treaty on the Law of Trademarks

Background

The [Trademark Law Treaty 1994](#) (TLT) was adopted on 27 October 1994 and came into force on 1 August 1996. The 33 member countries of Trademark Law Treaty are obliged to comply with the relevant trade mark provisions of the [Paris Convention for the Protection of Industrial Property](#) (Paris Convention) and are required to use the [Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks](#) (Nice Classification).

The TLT simplifies and harmonises administrative requirements relating to trade mark registration by setting maximum requirements members can require in relation to trade mark applications, supporting documentation for changes of name or ownership of trade marks and the renewal of registration. The term of registration and each subsequent renewal at ten years is set under the TLT. Whilst marks consisting of visible signs including colour are covered by the TLT, non-visible signs such as sounds and scents are not. The TLT does not provide for the technology changes that have occurred in the last ten years.

Given these developments, it became necessary to review and update the TLT. This revised TLT, known as the [Singapore Treaty on the Law of Trademarks](#) (Singapore Treaty) was formally adopted on 27 March 2006. The Singapore Treaty does not supersede the TLT which is still open for adoption by countries wishing to do so.

Objectives of the Singapore Treaty

The Singapore Treaty reflects the worldwide growth in e-commerce, providing consistent rules for electronic lodgement of trade mark applications and associated communications. It also further simplifies and streamlines administrative procedures such as recordal of licences where that is required.

In addition to covering the provisions of TLT, the Singapore Treaty also provides for:

- **relief measures in case of failure to comply with time limits** (see Article 14)
In certain circumstances, Contracting Parties must provide relief measures where a deadline is missed. A Contracting Party may provide the relief in the form of an extension of the time limit, continued processing or reinstatement or restoration of the rights.
- **correction of errors in some circumstances** (see Article 12)
Contracting Parties shall accept requests for correction of mistakes made in applications or other requests sent to the Office and reflected in the Register or other publication. Evidence can be required where the Office reasonably doubts that the alleged mistake is in fact a mistake. An Office is not obliged to correct any mistake which cannot be corrected under its law.
- **e-filing of all application forms and communications** (see Article 8)
Contracting Parties can choose how they receive communications and whether they accept correspondence, including trade mark applications, by electronic means only, in paper only or by either electronic or paper filing. Under the Trademark Law Treaty, members have to allow paper filing of correspondence. IP Australia allows electronic or paper filing of trade mark applications and paper filing of other correspondence.

- **recording, amendment and cancellation of licence interests** (see Articles 17-20)
Maximum administrative standards a trade mark office can require for recording, amendment and cancellation of licence interests are included in the Singapore Treaty. This is particularly relevant for applicants filing in countries where failure to record a licence with the relevant Trade Mark Office can result in invalidation of the trade mark registration. Australian trade mark legislation does not require the recordal of licences, however a claim to an interest in, or right in respect of a trade mark may be recorded under Part 11 of the *Trade Marks Act 1995*. Such claims are often based on a licence arrangement.
- **trade marks which are on non-visible or non-traditional signs** (see Rule 3)
The Singapore Treaty does not require a country to amend its laws to allow registration of these kinds of signs. Where a country allows them, it sets the maximum requirements a Contracting Party may require for applications with hologram marks, motion marks, colour marks, position marks and marks consisting of non visible signs.
- **formation of an Assembly** (see Article 23)
Significant in the new treaty is the creation of an Assembly of Contracting Parties which will enable the Regulations under the Singapore Treaty to be updated as required. In contrast, the TLT can only be amended by a Diplomatic Conference which involves considerable preparatory work, time and expense.

Impact on Australian Domestic Law

The *Trade Marks Act 1995* is consistent with the requirements of the Singapore Treaty.

Impact on ATMOSS and the Trade Marks Office database

No changes are anticipated to the trade marks public computer systems.

Benefits

[Fifty two countries](#) have signed the Singapore Treaty, including UK, Singapore, Spain, New Zealand, Italy, France and China. To date Singapore is the only country which has completed its national treaty making processes and ratified this treaty. Ratification is being considered by other countries and is currently before the governments of New Zealand and the USA.

Trade mark applicants and owners already benefit within Australia because our legislation, systems and practices are in line with both the TLT and the Singapore Treaty.

Australian trade mark holders will benefit further in export markets which join the Singapore Treaty, because:

- the application process will be consistent internationally;
- the application process will be more user-friendly and consistent particularly where electronic filing is introduced;
- a greater degree of flexibility in the application process will lead to more security in IP rights. Measures to rectify errors and extend missed deadlines which would otherwise unduly impact on the trade mark rights of applicants will achieve this result; and
- lower application costs due to reduced requirements for supporting documentation.

The treaty will result in further harmonisation and will facilitate trade and foreign investment and lower transaction costs.

Should Australia ratify the Singapore Agreement?

Australia is now undergoing domestic treaty processes to assist the Government in deciding whether it should ratify the Singapore Treaty.

Australia already provides a trade mark system that complies with the Singapore Treaty and therefore provides significant benefits to local and foreign applicants in this country. However accession to the Singapore Treaty by other countries and regional trade mark organisations, including Australia's major trading partners will be a significant benefit to Australians applying for trade mark protection overseas.

Consequently, a significant benefit of Australia's ratification of the Singapore Treaty is the positive example it would provide for Australia's trading partners. Australian trade mark holders who also trade overseas will reap the benefits of greater consistency, flexibility and security as other countries join the Singapore Treaty.

Accession to the Singapore Treaty will also enable Australia to influence further enhancement of the treaty through participation in the Assembly created under Article 23 of this treaty.

In conclusion, membership of the Singapore Treaty generally provides advantages for trade mark applicants, IP professionals, Trade Mark Offices and Contracting Parties by harmonising and simplifying requirements for trade mark administrative procedures. Australian law and practice is consistent with the Singapore Treaty and Australians will also benefit when Australia's trading partners join the Singapore Treaty.

[Further information](http://www.wipo.int/treaties/en/) on the Singapore Treaty including the full text, can be found on the WIPO website at: **<http://www.wipo.int/treaties/en/>**