



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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July 23, 2007

The Honorable Joseph R. Biden, Jr.
Chairman
Committee on Foreign Relations
United States Senate
Dirksen Senate Office Building
Washington, DC 20510-6225

Dear Mr. Chairman:

The American Intellectual Property Law Association (AIPLA) is pleased to present its views on the Singapore Treaty on the Law of Trademarks adopted on March 28, 2006 in Singapore, the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs adopted on July 2, 1999 in Geneva, and the Patent Law Treaty and Regulations Under the Patent Law Treaty adopted on June 1, 2000 in Geneva.

AIPLA is a national bar association of more than 16,000 members engaged in private and corporate practice, in government service, and in the academic community. AIPLA represents a diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

The treaties captioned above concern three discrete aspects of intellectual property law: trademarks, industrial designs, and patents. All three treaties, however, recognize the need to streamline the protection of intellectual property rights and to remove legal complexity and procedural difficulty in obtaining and maintaining such rights. To the extent those goals may be accomplished should the United States adhere to these treaties, all rights holders, and in particular small entities in the United States, will be better able to participate in the growing global economy with sound, cost effective intellectual property protection.

We note that, while all three of the above referenced treaties have been referred to the Senate for its advice and consent, no implementing legislation has been published. In the case of the Singapore Treaty, we believe that the United States currently complies with the treaty provisions and that no implementing legislation would be required to implement it. Regarding the two Geneva treaties, however, implementing legislation would be required and, while we are able to offer our general views on these treaties, we must reserve final judgment until we are able to review the specific proposed implementing legislation.

Singapore Treaty on the Law of Trademarks:

The Singapore Treaty on the Law of Trademarks (the Singapore Treaty) was adopted in Singapore on March 28, 2006, and forwarded to the Senate for its advice and consent on May 3, 2007. Ratification and implementation of this treaty will significantly benefit United States trademark owners conducting business globally. We therefore urge the Committee to support ratification of the Singapore Treaty.

The Singapore Treaty builds upon and updates the Trademark Law Treaty of 1994, to which the United States is a party. The 1994 treaty harmonized formalities and simplified procedures in applying, registering, and renewing trademarks, by establishing maximum requirements that Contracting Parties can impose on trademark applicants and holders. The Singapore Treaty maintains this focus, but has a wider scope of application and addresses new developments in the field of communication technology.

The Singapore Treaty applies to all types of marks registrable under the law of a given Contracting Party. The Treaty allows Contracting Parties the freedom to choose the means of communication with their trademark offices, and introduces relief measures for missed time limits and errors in recording trademark licenses. Other provisions of the Singapore Treaty closely follow the Trademark Law Treaty. Such common procedural standards would create a level playing field for all parties that invest in branded goods. Moreover, the Singapore Treaty creates a dynamic regulatory framework for brand rights and, unlike the Trademark Law Treaty, establishes an Assembly of the Contracting Parties that can review administrative details, a feature of great practical importance for brand owners.

The Singapore Treaty addresses the burdensome license recordal requirements in some countries that make it difficult for trademark licensors and licensees to enforce trademark rights. In many cases, failure to record a license results in invalidation of the trademark registration. The Singapore Treaty's license recordal provisions reduce the formalities that trademark owners are subject to when doing business with a Contracting Party that requires recordal, and mitigate the damaging effects that can result from failure to record a license in those jurisdictions.

Unlike the Trademark Law Treaty, the Singapore Treaty allows Contracting Parties the freedom to choose the form and means of transmittal of communications, i.e., whether they accept communications on paper, communications in electronic form, or any other mode of communication. This allows national and regional trademark offices to move to electronic systems for receiving and processing trademark applications, permitting such Offices to take advantage of electronic communication systems as an efficient and cost saving alternative to paper communications. The Singapore Treaty also maintains a very important provision of the Trademark Law Treaty, namely that the authentication, certification, or attestation of any signature on paper communications cannot be required. Contracting Parties remain free to determine whether and how they wish to implement a system of authentication of electronic communications.

The Treaty protects applicants from failures to comply with time limits by requiring Contracting Parties to provide at least one of the following forms of relief: an extension of time to comply, the opportunity to continue processing, or a reinstatement of rights. Such mandatory relief would mitigate drastic penalties resulting from mere failure to meet a specific time limit.

The Singapore Treaty, in contrast to the Trademark Law Treaty, applies generally to marks that can be registered under the law of a Contracting Party. Never before have non-traditional marks been explicitly recognized in an international instrument dealing with trademark law. The Treaty is applicable to all types of marks, including non-traditional visible marks such as holograms, three-dimensional marks, color, position, and movement marks, and non-visible marks such as sound, olfactory, or taste and feel marks. The Regulations provide for the mode of representation of these marks in applications, which may include non-graphic or photographic reproductions.

The Singapore Treaty creates an Assembly of the Contracting Parties, introducing a degree of flexibility in the definition and refinement of administrative procedures to be implemented by national trademark offices. We anticipate that future developments in trademark registration procedures and practice will warrant amendment of those details. The Assembly is endowed with powers to modify the Regulations and the Model International Forms, where necessary, and it can also deal—at a preliminary level—with questions relating to future development of the Treaty.

As outlined above, ratification of this Treaty by the United States and other nations will significantly benefit U.S. trademark owners conducting business globally. Ratification will simplify

procedures for both national and regional Offices and for applicants, reducing transaction costs and minimizing inadvertent loss of valuable rights.

AIPLA supports ratification by the United States of the Singapore Treaty on the Law of Trademarks.

Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs

The Geneva Act of the Hague Agreement (the Agreement) was adopted in Geneva on July 2, 1999, and forwarded to the Senate for its advice and consent on November 13, 2006. Ratification and implementation of this Agreement would provide industrial designers in the United States with access to an international legal framework through which they may obtain protection for their designs in multiple countries by filing a single application. We therefore urge the Committee to support ratification of the Agreement.

The Hague Agreement for the International Protection of Industrial Designs (the "Hague Agreement") includes three international treaties: the London Act (1934), the Hague Act (1960), and the Geneva Act (1999). A Contracting Party may ratify any or all of the three treaties. The most recent of these, the Geneva Act, became operational on April 4, 2004. This Agreement contains provisions that meet the needs of countries, like the United States, that undertake novelty examinations of industrial designs. Many of the provisions of the Agreement were specifically negotiated to accommodate these needs, as were the Regulations and Administrative Instructions.

The primary benefit of the Agreement would be that U.S. designers could obtain multi-national industrial design protection with a single application, instead of filing individual applications in each country of interest. Consequently, the Agreement is cost effective and efficient; creating opportunities that would not otherwise exist for an enterprise with a limited budget for legal protection. The Agreement, therefore, affords right holders great flexibility in targeting national, regional, or global markets for particular goods.

U.S. design owners would be able to file for design registration in any number of the Contracting Parties with a single standardized application in English. The application could be filed at either the United States Patent and Trademark Office (USPTO) or the International Bureau of the World Intellectual Property Organization (WIPO). In a similar manner, renewal of the design registration in each Contracting Party could be made by filing a single request, along with payment of the appropriate fees, with the International Bureau. The filing date of the international design application would be the date the application was received by either the International Bureau or the USPTO.

The International Bureau would normally publish the international registration within six months of the registration date. The international registration would have the same effect in the USPTO as a regularly filed national application under U.S. law. The international registration would be effective for a period of five years from the date of the registration, and could be renewed for additional five-year terms.

The Agreement contemplates that Contracting Parties may make declarations with respect to a variety of Agreement articles. The Department of State has recommended to the Senate that United States ratification be accompanied by nine such declarations. As a whole, we believe that the advantages of the agreement are such that they far outweigh any concerns that we have about any particular proposed declaration. We do note, however, that the eighth declaration, authorized by rule 13(4) of the agreement, allows the USPTO to notify the WIPO Director General that the law of the United States requires a security clearance and that the prescribed one-month period during which the patent office of a Contracting Party is required to forward an application to the International Bureau shall be replaced by a period of six-months to provide time for a security review of the application. While we appreciate that a design application may occasionally give rise to a need for such a security

review, we believe that such instances are rare and that a six-month delay in providing the application to the International Bureau is excessive. We would prefer that the eighth declaration be withdrawn, or that the proposed six-month delay be shortened.

As a whole, however, we believe that designers in the United States should have access to an international legal framework through which they may obtain protection for their industrial designs in multiple countries by filing a single application, and that the Agreement provides such a framework.

AIPLA supports ratification by the United States of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

Patent Law Treaty and Regulations under the Patent Law Treaty

The Patent Law Treaty (the PLT) was adopted in Geneva on June 1, 2000, entered into force on April 28, 2005, and was forwarded to the Senate for its advice and consent on September 5, 2006. The PLT harmonizes and streamlines formal procedures in respect of national and regional patent applications and patents, reducing or eliminating formalities and potential loss of rights. Such procedural simplification can only benefit U.S. inventors. We therefore urge the Committee to support ratification of the Patent Law Treaty.

The PLT sets forth the maximum procedural requirements that a Contracting Party may impose on patent applicants, and dictates standardized requirements for obtaining a filing date. The grant of a filing date is essential for establishing priority for the grant of a patent and for the prior art applicable for determining the patentability of an invention. It is also relevant to claiming a right of priority under the Paris Convention as well as to the calculation of the term of patent protection. The PLT sets up requirements for obtaining a filing date and procedures to avoid loss of the filing date because of a failure to comply with formal requirements. In principle, the patent office of any Contracting Party is required to accord a filing date to an application on the basis of three elements: (i) an indication that what was filed is intended to be a patent application; (ii) indications that identify the applicant and allow the applicant to be contacted; and (iii) a part that appears to be a description of the invention. No additional elements may be required to receive a filing date.

The PLT establishes a single internationally standardized set of formal requirements for national and regional applications. To avoid having international "double standards," the formal requirements in respect of international applications under the PCT are incorporated into the PLT, wherever appropriate. The PLT provides for the establishment of several Model International Forms that have to be accepted by the patent offices of all Contracting Parties. Using the Model International Forms assures applicants and other parties that no patent office may refuse the communication because of non-compliance with a formal requirement.

To reduce any unnecessary burden on applicants, the PLT provides that evidence in support of the formal contents of an application, declarations of priority, or authentication of translations may only be required where a patent office has a reasonable doubt as to the veracity of the indications or the accuracy of the translation submitted by the applicant. A Contracting Party may not require a copy or a certified copy of an earlier application if it was filed with the patent office of that Contracting Party or if it could obtain the copy or the certification from other patent offices through a digital library that is accepted for that purpose. Multinational projects are now underway to expand such digital libraries that, in combination with this Treaty provision, would largely eliminate the burdensome exchange of paper certified copies of prior applications.

The PLT provides three types of relief from failure to comply with certain formal requirements. The first is an extension of procedural time limits where an applicant or owner requests the extension prior to the expiration of the time limit; the second is an extension of such time limits where an applicant or owner requests the extension after the expiration of the unobserved time limit; and the third is continued processing. A Contracting Party is not obliged to provide the first type of extension; however, it must provide either the second type of extension or continued processing. Relief under

these provisions is limited to non-compliance with a time limit fixed by a patent office, not to time limits fixed by legislation. The PLT also provides safeguard provisions for situations where an applicant or owner might lose rights with respect to an application or patent for failure to meet a time limit. Reinstatement of such rights is applicable to all time limits, including time limits set by legislation. The PLT also provides for the correction and addition of priority claims and restoration of priority rights where an application is filed after the expiration of the 12-month priority period, and where an applicant cannot submit a copy of an earlier application within 16 months from the priority date because of a delay in the patent office with which the earlier application was filed.

The PLT would facilitate implementation of electronic filing of applications and other communications, to the advantage of both patent offices and their users, while ensuring the co-existence of both paper and electronic communications. Applicants would be allowed to file applications and communications on paper, at least for the purposes of acquiring a filing date and complying with a time limit.

The Department of State Letter of Submittal noted that United States law does not contain a "unity of invention" requirement, and that the USPTO advises that it considers this a substantive patent law matter that it does not recommend changing. Accordingly, the Department of State recommended that the following reservation be included in the U.S. instrument of ratification: "Pursuant to Article 23, the United States declares that Article 6(1) shall not apply to any requirement relating to unity of invention applicable under the Patent Cooperation Treaty to an international application." AIPLA strongly opposes this reservation and favors acceptance by the USPTO of the unity of invention standard as a "best practice" for all purposes, including those implicated in international applications. Ratification of the Patent Law Treaty, however, even with the proposed reservation regarding unity of invention, will streamline and harmonize formal procedures in respect of national and regional patent applications and patents.

AIPLA supports ratification by the United States of the Patent Law Treaty and Regulations under the Patent Law Treaty.

Thank you for your consideration of our views on these important treaties.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael Kirk". The signature is fluid and cursive, with the first name "Michael" and last name "Kirk" clearly distinguishable.

Michael Kirk
Executive Director
AIPLA

cc: Senator Richard G. Lugar