

Singapore Treaty on the Law of Trademarks

Introduction

- 3.1 The Singapore Treaty on the Law of Trademarks (the Singapore Treaty)¹ is designed to establish consistent procedures for registering trademarks. It was adopted in Singapore on 27 March 2006 and signed by Australia a year later on 26 March 2007.

Background

- 3.2 The Singapore Treaty revises and updates the Trademark Law Treaty, which was finalised in 1994 and signed by Australia in 1998.² The Singapore Treaty does not completely supersede the Trademark Law Treaty and the Trademark Law Treaty remains open for adoption by countries wishing to do so.³ However, the Singapore Treaty will apply exclusively between States that are party to both instruments.⁴ The Committee was informed that there are key differences between the two treaties.

1 Full title: *Singapore Treaty on the Law of Trademarks, adopted at Singapore on 27 March 2006* [2007] ATNIF 18

2 National Interest Analysis (NIA), para. 2.

3 NIA, para. 11.

4 NIA, para. 11.

Whilst marks consisting of visible signs, including colour, are covered by Trademark Law Treaty, non-visible signs such as sounds and scents are not. The Trademark Law Treaty also does not provide for the technology changes that have occurred in the last 10 years. The treaty has been revised and a new treaty, the Singapore Treaty on the Law of Trademarks, was adopted...⁵

The Singapore Treaty

- 3.3 The Singapore Treaty sets the maximum requirements that the trade marks office of a Contracting Party can insist on in a trade mark application.⁶

So if an office has word marks, like every office has, you can only request a certain number of copies with the application. If an office or a country has scent marks – for example, the UK has a registration for rose-scented tyres – it stops someone asking for an enormous amount of supporting evidence at the filing stage.⁷

- 3.4 The Singapore Treaty applies to all marks consisting of signs that can be registered in a given country and therefore potentially applies to non-visible and other non-traditional marks, such as holograms, three-dimensional marks, colour, or taste and feel marks.⁸ IP Australia provided the Committee with examples of non-traditional marks.

We do not have any smell registrations in Australia, although there have been quite a number applied for. There have been three successful cases before the office, but they were probably only used as test cases, and they did not pay the registration fee. One of them, for instance, was the smell of beer on darts. Another was the smell of fresh-cut grass on tennis balls. Again, these are things which are designed to indicate that you could go into a shop and say, 'I want the tennis balls that smell like fresh-cut grass,' or, 'I want the darts that smell like beer.' But, as I said, none of them have

5 Mrs Fatima Beattie, *Transcript of Evidence*, 17 September 2007, p. 8.

6 Article 3 of the Singapore Treaty; NIA, para. 20.

7 Mrs Joanne Rush, *Transcript of Evidence*, 17 September 2007, pp 10-11.

8 Article 2(1) of the Singapore Treaty; NIA, para. 20.

yet been registered. The bulk of non-traditional signs registered in Australia are shape trademarks.⁹

3.5 However the Singapore Treaty does not oblige parties to protect these kinds of signs.¹⁰

3.6 The Singapore Treaty also provides for:

- relief measures in case of failure to comply with time limits;
- correction of errors in some circumstances, e-filing of all application forms and communications;
- recording, amendment and cancellation of licence interests;
- procedures relating to trade marks that are non-visible or non-traditional signs;
- regulations to be annexed to the Singapore Treaty which set out matters expressly delegated by the Treaty text, administrative matters and details useful for implementation; and
- the establishment of an Assembly of the Contracting Parties which is able to modify the regulations.

3.7 The Committee was informed that the benefits of the Singapore Treaty and the Trademark Law Treaty are that:

They lower costs for applicants; they give greater certainty for applicants; they ensure, again, as with the comment on the Patent Law Treaty, that applicants and owners do not lose rights because of relatively trivial formality issues; and, in relation to trademark licences, the Singapore law treaty guarantees that failure to record a licence does not invalidate the trademark.¹¹

Implementation and costs

3.8 Australia already provides a trademark system that complies with the Singapore treaty. In particular, Australian trade mark law allows for marks consisting of a wide range of signs including scents, sounds,

9 Mr Michael Arblaster, *Transcript of Evidence*, 17 September 2007, p. 10.

10 NIA, para. 20. The NIA states that this point was affirmed in a resolution adopted by the Diplomatic Conference that adopted the Singapore Treaty.

11 Mr Michael Arblaster, *Transcript of Evidence*, 17 September 2007, p. 11.

colours, holograms, three-dimensional shapes and movement marks. No action is required to implement the Singapore Treaty.¹²

- 3.9 The NIA states that ratification of the Singapore Treaty would not result in any costs to the Commonwealth or the State and Territory governments.¹³

Entry into Force

- 3.10 The Singapore Treaty will enter into force three months after ten States or intergovernmental organisations ratify or accede to it.¹⁴ It will enter into force for Australia either on the date on which it comes into force generally or three months after Australia deposits its instrument of ratification, whichever is later.¹⁵

Consultation

- 3.11 The NIA states that IP Australia consults regularly with industry and professional organisations.¹⁶ In relation to the Singapore Treaty, IP Australia placed a Public Consultation Notice on its website which provided a general overview of the treaty, the dates of free information sessions to be held in each mainland capital city and called for comments.¹⁷ Also, 1200 people were notified by email of the potential treaty action and were directed to the website. The NIA states that any feedback IP Australia received was supportive of the Singapore Treaty.¹⁸
- 3.12 The Committee commends IP Australia on its thorough consultation in relation to the Singapore Treaty.¹⁹

12 NIA, para. 28.

13 NIA, para. 29.

14 Article 28(2); NIA, para. 2.

15 NIA, para. 3.

16 NIA, 'Consultation', para. 1.

17 NIA, 'Consultation', para. 1.

18 NIA, 'Consultation', para. 5.

19 The same consultation process was observed for the Patent Law Treaty, in Chapter 2.

Conclusion and recommendation

- 3.13 The Committee supports measures which simplify the procedures for trademark applications.

Recommendation 2

The Committee supports the *Singapore Treaty on the Law of Trademarks* and recommends that binding treaty action be taken.

