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**National Interest Analysis [2008] ATNIA 1
with attachment on consultation**

**Singapore Treaty on the Law of Trademarks
adopted at Singapore on 27 March 2006
[2007] ATNIF 18**

NATIONAL INTEREST ANALYSIS: CATEGORY 1 TREATY

SUMMARY PAGE

Singapore Treaty on the Law of Trademarks adopted at Singapore on 27 March 2006 [2007] ATNIF 18

Nature and timing of proposed treaty action

1. The proposed treaty action is ratification of the *Singapore Treaty on the Law of Trademarks* (Singapore Treaty) by Australia, pursuant to Article 26(2).
2. The Singapore Treaty was adopted at Singapore on 27 March 2006, and Australia signed it on 26 March 2007. It will enter into force three months after ten States or intergovernmental organizations ratify or accede to it (Article 28(2)). Singapore, Switzerland and Bulgaria are the first States to ratify the Singapore Treaty. However, other countries are currently undergoing their domestic treaty processes.
3. Ratification is proposed to be undertaken by Australia as soon as practicable after the completion of domestic processes. The Singapore Treaty would enter into force for Australia on the later of the date on which it comes into force generally or three months after Australia deposits its instrument of ratification.

Overview and national interest summary

4. The Singapore Treaty revises and updates the *Trademark Law Treaty* [1998] ATS 3 (TLT). Whilst the TLT will continue in its own right, the Singapore Treaty will apply exclusively as between States that are party to both instruments (Article 27(1)). The Singapore Treaty applies to the procedural aspects of trade mark applications, and its provisions reflect 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 trade mark procedures. This treaty does not harmonise substantive requirements of national trade mark law, and therefore provides no substantive obligations regarding the protection of trade marks.
5. Australia's legislation, systems and practices are already in line with both the TLT and the Singapore Treaty.
6. A significant benefit of Australia's ratification of the Singapore Treaty is the positive example it would provide for Australia's trading partners. Accession to the Singapore Treaty by other countries and regional trade mark organisations will benefit Australians applying for trade mark protection overseas through a further simplified and harmonised application process. There would be more security in trade mark rights and lower application costs due to reduced requirements for supporting documentation.
7. Ratification of the Singapore Treaty will also enable Australia to influence further enhancement of the treaty through participation in the Assembly created under Article 23. It would also be consistent with Australia's history as a leading member of the intellectual property community regionally, and would serve to enhance Australia's reputation as maintaining a modern intellectual property system.

Reasons for Australia to take the proposed treaty action

8. Australia has been at the forefront of international negotiations aimed at harmonising and normalising the administration of intellectual property rights.
9. As noted Australia has been a Party to the TLT since 1998. 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 is set at ten years under the TLT. The TLT does not provide any substantive obligations relating to the protection of trade marks.
10. 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.
11. 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 at a Diplomatic Conference in Singapore in 2006. The Singapore Treaty does not completely supersede the TLT, which is still open for adoption by countries wishing to do so. However, the Singapore Treaty will apply exclusively as between States that are party to both instruments.
12. In addition to covering the provisions of the TLT, 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; and, the formation of an Assembly.
13. The greater degree of flexibility in the application process under the Singapore Treaty will benefit applicants as it will lead to more security in intellectual property 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.
14. Fifty-five countries have signed the Singapore Treaty, including the United Kingdom, Singapore, Spain, New Zealand, Italy, France and China. To date Singapore, Switzerland and Bulgaria are the only countries which have completed national treaty making processes and ratified this treaty. Ratification or accession is being considered by other countries and is currently before the governments of New Zealand and the USA.
15. Australia already provides a trade mark system that complies with both the TLT and 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.
16. Australian trade mark holders will benefit further in export markets which join the Singapore Treaty, because the application process will be more user-friendly and

consistent, particularly where electronic filing is introduced. They will also benefit from lower application costs due to reduced requirements for supporting documentation.

17. 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.

18. Significant in the new treaty is the creation of an Assembly of Contracting Parties (Article 23), 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. Changes to the Singapore Treaty itself will still require a Diplomatic Conference.

19. Accession to the Singapore Treaty will also enable Australia to influence further enhancement of the treaty through participation in the Assembly.

Obligations

20. The Singapore Treaty sets the maximum requirements that the trade marks office of a Contracting Party can insist on in a trade mark application (Article 3). The Treaty applies to all marks consisting of signs that can be registered in a given country (Article 2(1)), and therefore potentially applies to non-visible and other non-traditional marks (such as scents, sounds, colours, holograms, three-dimensional shapes and motions). However, the Treaty does not oblige Contracting Parties to protect these kinds of signs (this point was affirmed in a Resolution adopted by the Diplomatic Conference that adopted the Singapore Treaty). Australian trade mark law allows for marks consisting of a wide range of signs including scents, sounds, colours, holograms, three-dimensional shapes and movement marks.

21. In certain circumstances, Contracting Parties must provide relief measures where a deadline is missed (Article 14). 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. The procedures applied by IP Australia (the Australian agency responsible for registering trade marks) already have appropriate extension of time provisions.

22. Contracting Parties are to accept requests for correction of mistakes made in applications, or in any other requests, sent to the trade mark office and reflected in the Register or other publication (Article 12). Evidence can be required where the office reasonably doubts that the alleged mistake is in fact a mistake. However an office is not obliged to correct any mistake that cannot be corrected under its law.

23. 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 (Article 8). Under the TLT, 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.

24. Maximum administrative standards a trade mark office can require for recording, amendment and cancellation of licence interests in a trade mark are included in the Singapore Treaty (Articles 17–18). This is particularly relevant for applicants filing in countries where failure to record a licence with the relevant trade mark office can currently result in invalidation of the trade mark registration. Australian trade mark legislation does not require the recording 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. Part 11 complies with the Singapore Treaty.

25. The Singapore Treaty also obliges parties to comply with the provisions of the *Paris Convention for the Protection of Industrial Property* [1972] ATS 12 (Paris Convention) that relate to marks (Article 15), and to extend to service marks the provisions from the Paris Convention that apply only to trademarks (Article 16). Australia is already a party to the Paris Convention, and to the *Agreement on Trade-Related Aspects of Intellectual Property Rights* (Annex 1C to the *Marrakesh Agreement Establishing the World Trade Organisation* [1995] ATS 8) which applies equivalent obligations to those in the Paris Convention to service marks. As such, Articles 15 and 16 create no new obligations for Australia.

26. There are also Regulations annexed to the Treaty, which set out matters expressly delegated by the text of the Treaty to the Regulations, details useful for the implementation of the Treaty and administrative matters (Article 22). As there is no statement to the contrary, the Regulations will be binding on Contracting Parties to the same extent as the Treaty. However, the Regulations are clearly subsidiary, with the Treaty expressly providing that the Treaty prevails in case of any conflict (Article 22(4)).

27. IP Australia's legislation, practices and systems are already compliant with the Singapore Treaty.

Implementation

28. No Commonwealth or State and Territory action is required to implement the Singapore Treaty. Implementation will not affect the existing roles of the Commonwealth and States and Territories.

Costs

29. Ratification of the Singapore Treaty would result in no costs to the Australian Commonwealth or State Governments.

30. There are no contributions payable by Australia under the Singapore Treaty. Increases in Australia's contribution to the World Intellectual Property Organisation (WIPO) are not anticipated as Australia's contribution is not based on the number of treaties Australia joins.

31. IP Australia operates on a full cost recovery basis, and its activities are revenue neutral to Government. Attendance by IP Australia officials at any working group meetings will be met from within IP Australia's existing budget.

32. The Singapore Treaty does not increase costs to industry and can potentially reduce costs for Australians doing business overseas and wanting to protect their trade marks in those countries.

Regulation Impact Statement

33. IP Australia has assessed the implementation of the Singapore Treaty against criteria in The Best Practice Regulation Handbook. This regulatory option has no impact on business and individuals or on the economy and a Regulation Impact Statement or Business Cost Calculator report is not required.

Future treaty action

34. Pursuant to Article 25, the Singapore Treaty may only be revised or amended by a diplomatic conference, the convocation of which will be decided by the Assembly. Any amendment of the Singapore Treaty will be subject to the Australian treaty process.

35. The Regulations, including the Model Forms contained within them, may be amended by the Assembly by a three-fourths majority (Article 22). However, a provision of the Regulations may provide that it can only be amended by unanimity. As there is no provision in the Treaty to the contrary, amendments to the Regulations adopted by the Assembly will come into effect immediately. Amendments to the Regulations will therefore automatically bind Australia once adopted. Although amendments to the Regulations will come into effect immediately, any such amendments will be notified as part of the Australian treaty process.

Withdrawal or Denunciation

36. Article 30 of the Singapore Treaty provides that any Contracting Party can denounce the Treaty by notification to the Director General of WIPO. The denunciation takes effect one year from the date on which the Director General is notified. Any termination on the part of Australia will be subject to the Australian treaty process.

Contact Details

International Policy

Business Development and Strategy

IP Australia (Department of Innovation, Industry, Science and Research).

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Consultation

1. IP Australia consults regularly with industry and professional organisations. Consultation includes meetings with groups such as the Inventors Associations, the Australian Manufacturers' Patents, Industrial Designs, Copyright and Trade Mark Association (AMPICTA), the Institute of Patent and Trade Mark Attorneys of Australia (IPTA), the Advisory Council on Intellectual Property and the Law Council. Such meetings include opportunities for exchanging information on IP Australia's activities. In particular these treaty actions regarding the Singapore Treaty on the Law of Trademarks, Patent Law Treaty and formal acceptance of the administrative amendments to several WIPO treaties were items on the agenda for meetings with AMPICTA, IPTA, the Minister's Advisory Committee on IP (ACIP) and the trade marks Combined Interest Group (CIG). CIG includes representatives from IPTA, AMPICTA and the Law Council of Australia. Favourable and supportive comments were received from these meetings.
2. IP Australia placed on its website a Public Consultation Notice regarding Australia's consideration of the Singapore Treaty, Patent Law Treaty and formal acceptance of the administrative amendments to several WIPO treaties in May 2007. The Public Consultation Notice provided a general overview of these actions, advised the dates of free Information Sessions to be held in each mainland capital city and called for comments on the proposed treaty actions. A Public Consultation Paper with more detailed information on the Singapore Treaty was also provided with the Public Consultation Notice.
3. In May 2007, approximately 1200 people on IP Australia's "What's New" email list were notified by email of the potential treaty action and their attention was directed to the Public Consultation Notice and the Consultation papers. They included intellectual property professionals, academics, intellectual property owners and potential applicants as well as staff of State and federal government departments and agencies.
4. These consultations were also listed on the www.business.gov.au website in May 2007. This Business Consultation website allows the Australian Government to easily consult with business owners, associations and people interested in business.
5. Public Information Seminars were held around Australia in June. IP Australia officials presented on each of the treaty actions. Attendees at these seminars were in favour of Australia joining the Singapore Treaty particularly in view of the benefits to Australians seeking IP protection in other countries which also join the Singapore Treaty.

6. The treaty has also been included on the twice yearly schedules of the Commonwealth-State/Territory Standing Committee on Treaties (SCOT) since February 2006. The schedules allow the States and Territories to seek further information at the twice yearly meetings; however no State or Territory has sought further information from this committee.