

*Without Prejudice*

**{Section C: Trademarks}**

**Article QQ.C.1: {Types of Signs Registrable as Trademarks}**

No Party may require, as a condition of registration, that a sign be visually perceptible,[15] nor may a Party deny registration of a trademark solely on the ground that the sign of which it is composed is a sound [VN/BN//CA/JP/ oppose: or a scent]. A Party may require a concise and accurate description, or graphical representation, or both, as applicable, of the trademark.

**Article QQ.C.2: {Collective and Certification Marks}**

1. Each Party shall provide that trademarks shall include collective marks and certification marks. A Party is not obligated to treat certification marks as a separate category in its domestic law, provided that such marks are protected. Each Party shall also provide that signs that may serve as geographical indications are capable of protection under its trademark system.[16]

[US/PE/MX[17]/SG propose; AU/NZ/VN/BN/MY/CA oppose: 2. Pursuant to Article 20 of the TRIPS Agreement, each Party shall ensure that its measures mandating the use of the term customary in common language as the common name for a good or service (“common name”) including, inter alia, requirements concerning the relative size, placement or style of use of the trademark in relation to the common name, do not impair the use or effectiveness of trademarks used in relation to such good or service.[18]][19][20]

**Article QQ.C.3: {Use of Identical or Similar Signs}**

Each Party shall provide that the owner of a registered trademark shall have the exclusive right to prevent third parties not having the owner’s consent from using in the course of trade identical or similar signs, [PE/MY/VN/CA/MX oppose: including subsequent

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[15] Negotiators’ note: VN can accept the protection of sound but only if it is given an adequate transitional period.

[16] For purposes of this Chapter, **geographical indication** means indications that identify a good as originating in the territory of a party, or a region or locality in that territory, where a given quality, reputation, or other characteristic of the good is essentially attributable to its geographical origin. Consistent with this definition, any sign or combination of signs shall be eligible for protection under one or more of the legal means for protecting GIs, or a combination of such means. {Chair’s note: address placement in legal scrub.}

[17] Negotiators’ Notes: PE/MX/SG will go with consensus on this paragraph.

[18] [PE/US propose: For greater certainty, the existence of such measures does not per se, amount to impairment.]

[19] Negotiators’ Note: JP is considering this provision.

[20] [SG propose: This provision is not intended to affect the use of common names of pharmaceutical products in prescribing medicine.]



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- (a) is likely to deceive [UNREADABLE] or risk associating the trademark with the owner of the well-known trademark, or
- (b) constitutes unfair exploitation of the reputation of the well-known trademark.]

**Article QQ.C.6: {Examination, Opposition and Cancellation / Procedural Aspects}**

Each Party shall provide a system for the examination and registration of trademarks which shall include, *inter alia*:

- (a) providing to the applicant a communication in writing, which may be electronic, of the reasons for any refusal to register a trademark;
- (b) providing the opportunity for the applicant to respond to communications from the competent authorities, to contest an initial refusal, and to appeal judicially any final refusal to register a trademark;
- (c) providing an opportunity to oppose the registration of a trademark or to seek cancellation<sup>[24]</sup> of a trademark; and
- (d) requiring that administrative decisions in opposition and cancellation proceedings be reasoned and in writing. Written decisions may be provided electronically.

**Article QQ.C.7: {Electronic Trademarks System}**

Each Party shall provide:

- (a) a system for the electronic application for, and maintenance of, trademarks; and
- (b) a publicly available electronic information system, including an online database, of trademark applications and of registered trademarks.

**Article QQ.C.8: {Classification of Goods and Services}**

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[24] For greater certainty, cancellation for purposes of this Section may be implemented through nullity or revocation proceedings.

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Each Party shall adopt or maintain a trademark classification system that is consistent with the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks* (Nice Classification) of June 15, 1957, as revised and amended. Each Party shall provide that:

[CA oppose: (a) registrations and the publications of applications indicate the goods and services by their names, grouped according to the classes established by the Nice Classification<sup>[25]</sup>; and]

(b) goods or services may not be considered as being similar to each other on the ground that, in any registration or publication, they are classified in the same class of the Nice Classification. Conversely, each Party shall provide that goods or services may not be considered as being dissimilar from each other on the ground that, in any registration or publication, they are classified in different classes of the Nice Classification.

**Article QQ.C.9: {Term of Protection for Trademarks}**

Each Party shall provide that initial registration and each renewal of registration of a trademark shall be for a term of no less than 10 years.

**Article QQ.C.10:**

No Party may require recordal of trademark licenses: to establish the validity of the license; [VN/MX oppose: [CL/BN/MY oppose: as a condition for any right that a licensee may have under that Party's law to join infringement proceedings initiated by the holder, or to obtain by way of civil infringement proceedings damages resulting from an infringement of the trademark which is subject to the license]; or as a condition for use of a trademark by a licensee, to be deemed to constitute use by the holder in proceedings relating to the acquisition, maintenance and enforcement of trademarks].

**Article QQ.C.12: {Domain Name Cybersquatting}**

1. In connection with each Party's system for the management of its country-code top-level domain (ccTLD) domain names, the following shall be available:

(a) an appropriate procedure for the settlement of disputes, based on, or modelled along the same lines as, the principles established in the Uniform Domain-Name Dispute-Resolution Policy, or that is: (i) designed to resolve

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[25] Parties that rely on translations of the Nice Classification are required to follow updated versions of the Nice Classification to the extent that official translations have been issued and published.

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disputes expeditiously and at low cost, (ii) fair and equitable, (iii) not overly burdensome, and (iv) does not preclude resort to court litigation; and

(b) online public access to a reliable and accurate database of contact information concerning domain-name registrants;

in accordance with each Party's laws and, where applicable, relevant administrator policies regarding protection of privacy and personal data.

2. In connection with each Party's system for the management of ccTLD domain names, appropriate remedies,[26] shall be available, at least in cases where a person registers or holds, with a bad faith intent to profit, a domain name that is identical or confusingly similar to a trademark.

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[26] It is understood that such remedies may but need not include, for example, revocation, cancellation, transfer, damages, or injunctive relief.