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

======================================
--

^[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.]

Without Prejudice

geographical indications,] for goods or services that are related to those goods or services in respect of which the owner's trademark is registered, where such use would result in a likelihood of confusion. In the case of the use of an identical sign, [PE/MY/SG/CL/CA/MX/VN oppose: including a geographical indication,] for identical goods or services, a likelihood of confusion shall be presumed.

Article QQ.C.4:

Each Party may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interest of the owner of the trademark and of third parties.

Article QQ.C.5: {Well Known Trademarks}

- 1. No Party may require as a condition for determining that a trademark is well-known that the trademark has been registered in the Party or in another jurisdiction, included on a list of well-known trademarks, or given prior recognition as a well-known trademark.
- 2. Article 6bis of the Paris Convention for the Protection of Industrial Property (1967) shall apply, *mutatis mutandis*, to goods or services that are not identical or similar to those identified by a well-known trademark,[21] whether registered or not, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the trademark, and provided that the interests of the owner of the trademark are likely to be damaged by such use.
- 3. Each Party recognizes the importance of the *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (1999) asadopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO.
- 4. Each Party shall provide for appropriate measures to refuse the application or cancel the registration and prohibit the use of a trademark that is identical or similar to a well-known trademark,[22] for identical or similar goods or services, if the use of that trademark is likely to cause confusion with the prior well known trademark. A Party may also provide such measures *inter alia* in cases in which the subsequent trademark[23]:

====== e1	nd page	12=======
-----------	---------	-----------

^[21] Where a Party determines whether a mark is well-known in the Party, the Party need not require that the reputation of the trademark extend beyond the sector of the public that normally deals with the relevant goods or services.

^[22] It is understood that such a well-known trademark is one that was already well-known before the registration or use of the first-mentioned trademark.

^[23] Negotiator's note: AU opposes the last sentence of this chapeau, but is in discussions with NZ and US as to language that could resolve this.

Without Prejudice

- (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[24] 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}

	_
[24] For greater certainty, cancellation for purposes of this Section may be implemented through nullity or revocation proceedings.	
======= end page 13=========	

TPP Negotiations
IP Group
Intellectual Property [Rights] Chapter

Without Prejudice

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[25]; 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 profice 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

[25] Parties that rely on translations of the Nice Classification are required to follow updated versions of the Nice Classification	1
to the extent that official translations have been issued and published.	

====== end page 14==========

This Document Contains TPP CONFIDENTIAL Information MODIFIED HANDLING AUTHORIZED

TPP Negotiations IP Group Intellectual Property [Rights] Chapter

Without Prejudice

disputes	s expeditiously	and at lo	ow cost,	(ii) fai	r and	equitable,	(iii)	not (overly	burd	ensome,	and	(iv)
does not	t preclude resor	rt to cou	rt litigati	on; an	d								

(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.

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

====== end page 15========