



STANDARD ST. 64

RECOMMENDED SEARCH FILES FOR TRADEMARK SEARCH

*Recommendation adopted by the PCIP Executive Coordination Committee
at its eighteenth session on May 24, 1996*

INTRODUCTION

1. The purpose of this recommendation is to give guidance to any industrial property office which wishes to start undertaking trademark search or reviewing a collection of search files that it is currently using.
2. This recommendation provides a list of search files desirable for trademark search, bearing in mind the recent globalization of trade of goods and services, with a view to improving access to trademark information and thereby leading to a level of search results high in quality and efficiency.
3. This recommendation is not intended to suggest amendments or harmonization of relevant provisions of existing trademark laws but is so elaborated as to accommodate most of the different requirements for the registrability of trademarks set forth in the trademark laws currently in force in many countries. This recommendation, however, assumes that the country, the industrial property office of which is referred to in paragraph 1, above, is party to the Paris Convention for the Protection of Industrial Property.

DEFINITION

4. For the purposes of this Standard, the expression:
 - (i) "trademark" should be understood to include both trademarks and service marks, as well as collective marks, certification marks and guarantee marks;
 - (ii) "Trademark Gazette" means an official publication with respect to trademarks issued in accordance with requirements under national or regional industrial property legislations or international industrial property conventions;
 - (iii) "geographical indications" should be understood to include appellations of origin.

RECOMMENDATION

5. It is recommended that an industrial property office should have and keep updated the following files for trademark search:
 - (a) Files of trademarks registered by the industrial property office, if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to a trademark whose registration date precedes the filing date or, where applicable, the priority date of the later trademark and which is for goods or services identical or similar to those of the earlier trademark;
 - (b) Files of trademark applications which were filed with the industrial property office, if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to a trademark whose filing date or, where applicable, the priority date precedes the filing date or, where applicable, the priority date of the later trademark and which is for goods or services identical or similar to those of the earlier trademark;
 - (c) Files of trademark applications or trademarks registered under a regional agreement if the country is a party to the said agreement and to the extent that registrations and filings under the regional agreement are to be taken into account according to the applicable legislation;
 - (d) Files of international registrations of marks under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement Concerning the International Registrations of Marks, if an extension of protection has been made to the country;



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- (e) List of signs protected under Article 6*ter* of the Paris Convention;
 - (f) List of armorial bearings, flags, emblems, other than those protected under Article 6*ter* of the Paris Convention, which is prepared by the competent authority, if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which includes such signs;
 - (g) List of geographical indications which are protected under a bilateral or regional agreement in respect of the protection of geographical indications, if the country is party to the said agreement, or the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to such indications;
 - (h) List of appellations of origin registered under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, if the country is party to the said Agreement, or the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to such indications;
 - (i) List of International Nonproprietary Names (INN) for Pharmaceutical Substances issued by the World Health Organization (WHO), if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to such names;
 - (j) List of Common Names for Pesticides and Other Agrochemicals issued by the International Organization for Standardization (ISO), if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to such names;
 - (k) List of names of plant varieties registered in the country, if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to a name of a plant variety registered by the competent authority of the country;
 - (l) List of names of persons, companies and institutions issued by competent authorities or organizations of the country (e.g., commercial register and telephone directory), if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which, without consent, refers to a name or surname of a particular individual, company or institution;
 - (m) General references (encyclopedia, dictionary, technical handbooks, journals and other publications of this kind), if the applicable legislation provides for the refusal or invalidation of the registration of a trademark which is identical or similar to a common name, a name of geographic location or the like.
6. Where, in accordance with Article 6*bis* of the Paris Convention, a country acts *ex-officio* under its national legislation, it is recommended that, for the protection of well-known marks, an industrial property office should have and keep updated all search files referred to in paragraph 5(d), above, even if the proviso in the said paragraph does not apply to the country.

7. It is recommended that, for an efficient search, an industrial property office should have and keep up to date the above-mentioned search files in an automated system or on a machine-readable carrier to the extent possible.

NOTES

8. It is noted that, in order to facilitate searching, online access to some commercial databases and/or local access to commercial CD-ROM products would be useful. (A list of certain databases of trademark information is given in Part 6.4 of the WIPO Handbook on Industrial Property Information and Documentation.)
9. It is noted that the International Bureau issues ROMARIN discs (Read-Only-memory of Madrid Actualized Registry I/nformation) which contain information referred to in paragraphs 5(d) and (h) together with the Nice and Vienna Classifications, and Article 6*ter* (Paris Convention) discs which contain information referred to in paragraph 5(e).



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10. For orders and further details on the publications referred to in paragraph 5(i), it is advisable to address inquiries to the following:

World Health Organization (WHO)
20 avenue Appia
1211 Geneva, Switzerland (Tel: + 41 22 791.21.11; Fax: + 41 22 791.07.46)

11. For orders and further details on the publications referred to in paragraph 5(j), it is advisable to address inquiries to the following:

Secretariat of ISO/TC 81
BSI, Mr. M.R. Bell
2 Park Street
London W1A 2BS, United Kingdom (Tel: + 44 171.629.90.00; Fax: + 44 171 629.05.06)

12. For orders and further details on the publications referred to in paragraph 9, it is advisable to address inquiries to the following:

World Intellectual Property Organization
34, chemin des Colombettes,
1211 Geneva 20, Switzerland (Tel: + 41 22 730.91.44; Fax: + 41 22 734.14.46)

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