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1 ARTICLE 15

1.1 Text of Article 15

Article 15

Protectable Subject Matter

1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).

3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.

4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.

5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

1.2 General, including title

1. The Appellate Body in *US – Section 211 Appropriations Act*, in rejecting an argument that Members must register trademarks that meet the requirements of Article 15.1, referred to the title of Article 15:

> "[S]upporting these distinctions is the fact that the title of this Article speaks of subject matter as 'protectable', and not of subject matter 'to be protected'. In this

> way, the title of Article 15 expresses the notion that the subject matter covered by the provision is subject matter that *qualifies* for, but is not necessarily *entitled to*, protection."[1]

2. The Panel in *Australia – Tobacco Plain Packaging*, in rejecting an argument that the conditions in Article 15.4 should apply not just to the registration as a trademark, but more generally to substantive protection of a trademark once it is registered, referred to the title of Article 15:

> "This interpretation is confirmed by the title of Article 15, 'Protectable Subject Matter', which can be contrasted with the scope of substantive protection afforded to a registered trademark, which is addressed separately under the heading of 'Rights Conferred' in Article 16."[2]

3. In *Australia – Tobacco Plain Packaging*, the Panel, in considering the meaning of "registration of the trademark" in Article 15.4, referred to the Appellate Body's clarification of the overall structure and operation of Article 15 in combination with Article 6(1) of the Paris Convention (1967)[3] which provides that each country of the Paris Union has the right to determine the conditions for filing and registration of trademarks in its domestic legislation.[4] The Panel explained:

> "The 'considerable discretion' provided by this general rule is limited in Article 15 of the TRIPS Agreement by setting out specific options and limitations regarding the conditions that Members may establish for the registration of trademarks in their national legislation."[5]

4. The Panel, after explaining in a general manner how the different provisions in Article 15, as well as Article 6*quinquies* of the Paris Convention (1967), as incorporated into the TRIPS Agreement, operate to limit Members' freedom to determine conditions for trademark registration,[6] concluded:

> "Taken together, these provisions thus define Members' obligations under the TRIPS Agreement with respect to the registration of trademarks."[7]

5. The Panel in *Australia – Tobacco Plain Packaging* also considered the relationship between the criteria set out in Article 15.1 and Members' obligations:

> "This view is further consistent with the approach widely reflected in the TRIPS Agreement and the Paris Convention (1967) that it is usually the responsibility of private parties, i.e. applicants or right holders in the context of the varying market conditions, to fulfil the criteria required for registration, protection and enforcement of IP rights. Outside the scope of express obligations set out in the TRIPS Agreement, the Agreement does not in our view oblige Members to ensure that private parties are in a position to fulfil such criteria, or to refrain from regulations otherwise not inconsistent with the covered agreements that may affect the market conditions that determine how easy or difficult it is for private parties to comply with the distinctiveness requirements as a condition for trademark registration."[8]

1.3 Article 15.1

6. In *US – Section 211 Appropriations Act*, the Appellate Body rejected an argument that Members must register trademarks that meet the requirements of Article 15.1:

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[1] Appellate Body Report, *US – Section 211 Appropriations Act*, para. 155.
[2] Panel Reports, *Australia – Tobacco Plain Packaging*, paras. 7.1904-7.1905.
[3] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1842.
[4] Appellate Body Report, *US – Section 211 Appropriations Act*, para. 132.
[5] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1843.
[6] Panel Reports, *Australia – Tobacco Plain Packaging*, paras. 7.1844-7.1851.
[7] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1852.
[8] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1897.

> "It follows that the wording of Article 15.1 allows WTO Members to set forth in their domestic legislation conditions for the registration of trademarks that do *not* address the definition of either 'protectable subject-matter' or of what constitutes a trademark.
>
> …
>
> In our view, Article 15.1 of the *TRIPS Agreement* limits the right of Members to determine the 'conditions' for filing and registration of trademarks under their domestic legislation pursuant to Article 6(1) [of the Paris Convention (1967) as incorporated in the TRIPS Agreement] *only* as it relates to the distinctiveness requirements enunciated in Article 15.1."[9]

1.3.1 "trademark"

7. In *Australia – Tobacco Plain Packaging*, the Panel, in considering the meaning of "trademark" in Article 15.4, observed:

> "The terms 'trademark' and 'registration as trademarks' are also used in subsequent paragraphs of Article 15, including Article 15.4, and, indeed, elsewhere in the TRIPS Agreement. These terms must logically be given, in these other provisions, and specifically in Article 15.4, the meaning established in the first and second sentences of Article 15.1 determining the protectable subject matter.
>
> The term 'trademark' must therefore be understood, in Article 15.4, as referring to those signs that are 'capable of constituting a trademark' within the meaning of Article 15.1. Specifically, as described by the Appellate Body, the definition, in Article 15.1, of the signs or combinations of signs that are 'capable of constituting a trademark' is based on their capacity to distinguish the relevant goods or services (or 'distinctiveness', in the words of the Appellate Body) either 'as such' or 'as acquired through use'."[10]

8. In *Australia – Tobacco Plain Packaging*, the Panel rejected an argument that the definition of what must be capable of constituting a trademark should include signs that have not yet acquired distinctiveness through use but have the "capacity" to do so in the future:

> "We note – as the Dominican Republic does – that the term 'capable' means 'able to take in, receive, contain, or hold; having room or capacity for'. In the context of Article 15.1, as discussed above, the definition contained in the first sentence refers to signs that, at that particular moment, are capable of distinguishing goods and services and that are, therefore, considered as capable of constituting a trademark. Pursuant to the second sentence, Members are obliged to consider such signs as eligible for registration as trademarks. This obligation does not, in our view, cover signs that only have *the potential to develop this capacity* in the future. Rather, as the Appellate Body's description of the 'distinctiveness criteria' highlights, the existence of a capacity to distinguish goods or services at the time of assessment is the very basis for the definition of the signs that must be eligible for registration. This capacity may exist either because the signs or combinations of signs at issue have 'as such' the capacity to distinguish the relevant goods or services or it may have been 'acquired through use'."[11]

1.3.2 "registration as trademarks"

9. In *Australia – Tobacco Plain Packaging*, the Panel, in considering the meaning of "registration of the trademark" in Article 15.4, explained:

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[9] Appellate Body Report, *US – Section 211 Appropriations Act*, paras. 156 and 165.
[10] Panel Reports, *Australia – Tobacco Plain Packaging*, paras. 7.1829-7.1830.
[11] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1864. See also the considerations of the Panel summarized under Article 6*quinquies* of the Paris Convention (1967).

> "In the same way as for the term 'trademark', we consider that the meaning of the term 'registration of the trademark' in Article 15.4 must be established with reference to the same terms as used in other paragraphs of Article 15 that also refer to the registration of trademarks.
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> …
>
> This distinction between constituting a trademark and thus eligibility for registration, on one hand, and actual registration as a trademark to become a *registered* trademark[12], on the other, is confirmed by other provisions, which further define the obligations of Members in respect of the conditions for eligibility for registration as a trademark, beyond the 'distinctiveness' requirements of Article 15.1.
>
> …
>
> Regarding the functional context of registration of the trademark, we further note that Article 16.1, entitled 'Rights Conferred', obliges Members to provide the rights described therein to the owners of *registered* trademarks. This means that the *registration* of the trademark, as governed by Article 15 in the manner described above, is a precondition for the availability of those minimum rights conferred on a trademark owner, the scope and content of which are governed by Article 16.1."[13]

1.3.3 Article 15.1, third sentence

10. In *Australia – Tobacco Plain Packaging*, the Panel clarified that Article 15.1, third sentence, provides an option to Members:

> "Article 15.1, third sentence, in contrast, provides Members with an *option* to make the registrability of signs that are not *inherently* distinctive, depend on distinctiveness acquired through use."[14]

11. In *Australia – Tobacco Plain Packaging*, the Panel rejected an argument that a Member that exercised the option in Article 15.1, third sentence, to make the registrability of non-inherently distinctive signs depend on distinctiveness acquired through use, would violate Article 15.4 if, at the same time, it restricted the possibility to use the sign on a particular good in order to acquire distinctiveness, solely because of the nature of the good:

> "We find no support in the text of Article 15.1 for the complainants' assertion that exercising the option of Article 15.1, third sentence, would modify the scope of the definition of 'trademark' and thus extend the scope of the prohibition in Article 15.4, for the relevant Member, so as to include signs that are not inherently distinctive and which have not yet acquired distinctiveness through use. …
>
> By permitting Members to make registrability dependent on distinctiveness *acquired by use*, the text of Article 15.1, third sentence, does not indicate a modification to the concept of *distinctiveness* itself, but merely points out *a particular manner* in which the condition for constituting a trademark, namely complying with the distinctiveness criterion defined in the first sentence of Article 15.1, may be fulfilled. …
>
> A plain reading of the text therefore indicates that Members may make registrability depend on distinctiveness that *has been acquired*, or *obtained* through use prior to registration. This formulation does not provide support for an interpretation that would include signs that are only 'capable of acquiring distinctiveness through use' in the future."[15]

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[12] (*footnote original*) We note that the rights conferred in Article 16.1 are only available to the owners of *registered* trademarks.

[13] Panel Reports, *Australia – Tobacco Plain Packaging*, paras. 7.1835, 7.1840, and 7.1853.

[14] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1884.

[15] Panel Reports, *Australia – Tobacco Plain Packaging*, paras. 7.1885–7.1887. See also the explanations on Article 15.1 above.

1.4 Article 15.2

12. In *US – Section 211 Appropriations Act,* the Appellate Body found that paragraph 2 of Article 15 permits Members to deny trademark registration on grounds other than those expressly provided for in the TRIPS Agreement and the Paris Convention (1967):

> "The specific reference to Article 15.1 in Article 15.2 makes it clear that the 'other grounds' for denial of registration to which Article 15.2 refers are different from those mentioned in Article 15.1. …
>
> …
>
> [A] condition need not be expressly mentioned in the Paris Convention (1967) in order not to 'derogate' from it. Denial of registration on 'other grounds' would derogate from the Paris Convention (1967) only if the denial were on grounds that are inconsistent with the provisions of that Convention.
>
> [We] conclude also that 'other grounds' for the denial of registration within the meaning of Article 15.2 of the *TRIPS Agreement* are not limited to grounds expressly provided for in the exceptions contained in the Paris Convention (1967) or the *TRIPS Agreement*."[16]

1.5 Article 15.4

1.5.1 General, including object and purpose

13. In *Australia – Tobacco Plain Packaging*, the Panel, in assessing the object and purpose of Article 15.4, concluded that:

> "In light of our earlier findings, it is clear to us that the object and purpose of Article 15.4, read in the context of Article 15.1, is to regulate Members' obligations regarding the registration of distinctive signs as trademarks. It is not within the object and purpose of Article 15.4 to regulate the *use* of signs that do not already have the capability of distinguishing goods or services in the sense of Article 15.1. In our view, therefore, interpreting Article 15.4 as obliging Members to permit use of non-distinctive signs to allow them to acquire distinctiveness irrespective of the products or services to which they are to be applied is not compatible with the language of Article 15.4, nor with its object and purpose, as read in the context of Article 15.1."[17]

14. The Panel, in considering an argument that the conditions in Article 15.4 should apply not just to the registration as a trademark, but more generally to the substantive protection of a trademark once it is registered, concluded:

> "In light of the above, and recalling our earlier findings, we find that Article 15.4 limits the grounds for refusal of the step of registering a trademark, which Members are, as a rule, required to make available for eligible signs under Article 15.1, second sentence. Article 15.4 does not, however, stipulate an obligation that the scope and content of trademark protection that flows from such registration has to be the same notwithstanding the nature of the goods or services to which trademarks are or may be applied."[18]

15. The Panel confirmed its interpretation by reviewing the negotiating history of Article 7 of the Paris Convention (1967), on which Article 15.4 is based.[19]

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[16] Appellate Body Report, *US – Section 211 Appropriations Act*, paras. 171, 177-178.
[17] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1894.
[18] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1908.
[19] Panel Reports, *Australia – Tobacco Plain Packaging*, paras. 7.1909-7.1911.

1.5.2 "trademark" and "registration of the trademark"

16. In *Australia – Tobacco Plain Packaging*, the Panel, in interpreting the meaning of the terms "trademark" and "registration of a trademark" in Article 15.4, concluded that:

> "We recall our finding that the scope of the prohibition in Article 15.4 is defined by the meaning of the terms 'trademark' and 'registration of a trademark', which must be read in accordance with the definitions in Article 15.1. We have established in the previous section that Members' obligation under Article 15.1 of what to consider as 'capable of constituting a trademark' does not include signs that are not inherently distinctive and that have not yet acquired distinctiveness through use, and that therefore the prohibition in Article 15.4 does not extend to such signs."[20]

1.5.3 "obstacle"

17. In *Australia – Tobacco Plain Packaging*, the Panel discussed arguments implying that obstacles to "achieving distinctiveness through use" should be covered by the prohibition on obstacles to the "registration of the trademark", established in Article 15.4:

> "This would require an interpretation of the term 'obstacle' to include not only hindrances and impediments to the act of registration of the trademark itself, but also hindrances or impediments that stand in the way of non-distinctive signs – signs that are not required to be eligible for registration as trademarks – acquiring distinctiveness through use to fulfil the criteria or other preconditions for being capable of constituting a trademark and thus subsequently becoming eligible for trademark registration.
>
> In assessing this question, we recall the grammatical structure of Article 15.4, namely that the object of the preposition 'to' in 'obstacle to' is 'registration of the trademark'. We note first that interpreting the term 'obstacle' to refer, not only to the 'registration of the trademark', but also to the use of non-distinctive signs would undermine the precise meaning of the terms and the grammatical structure used in framing the object of the prohibition in Article 15.4."[21]

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[20] Panel Reports, *Australia – Tobacco Plain Packaging*, para. 7.1883.
[21] Panel Reports, *Australia – Tobacco Plain Packaging*, paras. 7.1891-7.1892.