



Council of the
European Union

Brussels, 15 November 2019
(OR. en)

14206/19

PI 148

NOTE

From: General Secretariat of the Council

To: Delegations

No. prev. doc.: 13170/1/19 REV1

Subject: 42nd Session of the WIPO Standing Committee on the Law of Trademarks,
Industrial Design and Geographical Indication (SCT)
(Geneva, 4-7 November 2019)
- Final EU/Member States statements

Delegations will find attached, for information, the EU/Member States statements as delivered at the above-mentioned WIPO meeting.

**42nd Session of the WIPO Standing Committee on the Law of Trademarks,
Industrial Designs and Geographical Indications (SCT)**

(Geneva, 4-7 November 2019)

Opening Statement

Agenda Item 1

Chair,

1. The EU and its Member States would like to wish you and your Vice-Chairs every success in guiding our work this week. We would also like to thank the Secretariat for its excellent preparatory work for this session.
2. With regard to participation in WIPO treaties, we are pleased to confirm that the EU has concluded its legislative procedure to become a contracting Party to the Geneva Act of the Lisbon Agreement. Therefore, we are happy to announce that the EU will be able to deposit its instrument of accession to the Geneva Act with WIPO in the forthcoming weeks.
3. Looking back to the previous SCT session, we recall with appreciation that we moved forward on all key topics and delegations maintained a constructive spirit. As to trade marks, we held intense discussions and made some progress in seeking a compromise solution on the topic of country names. As regards designs, we agreed on a more defined scope of future work concerning Graphical User Interface designs and embarked on exploring the topic of international exhibitions. We are hopeful that in the end, step-by-step progress on geographical indications can also lead to clear and tangible results within the SCT mandate and framework that have a positive impact on stakeholders. We would like to reiterate that the SCT should not aim to interpret or revise provisions of the Lisbon Agreement or the Geneva Act.

4. Looking at the agenda of this meeting, first as regards industrial designs, we refer to the discussions held in relation to the Design Law Treaty during the General Assembly this year. We were pleased to engage in informal discussions initiated by the circulation of the facilitator's proposal for a possible compromise solution on outstanding issues. Nevertheless, we have to note with regret that again this year, no positive decision to convene a diplomatic conference on the adoption of a Design Law Treaty could be achieved and that the matter remains on the agenda for the General Assembly in 2020.
5. In relation to Graphical User Interfaces (GUIs), following the launch of a Questionnaire finalised at SCT 40, we endorsed the extension of the deadline to submit additional responses by 31 July 2019. We would like to thank SCT members for further contributions and the Secretariat for compiling all responses received in document SCT/41/2, including replies with further information on the common practice developed by the European Union Intellectual Property Office. In all the up-to-date and detailed responses we see a wealth of information which will no doubt prove useful in further discussions and we can fully support the compilation to be used as reference for further work on selected pertinent issues for such designs.
6. Concerning future work on this topic, we note with much interest the proposal submitted by the delegations of Japan and the United States of America in document SCT/42/6. We welcome this new initiative and support the aim of adopting this joint recommendation as a practical way forward to achieve a more harmonised approach in relation to industrial design protection for GUI designs.
7. As regards the proposal submitted by Spain relating to "official or officially recognized international exhibitions", we supported the launch of the Questionnaire finalised at our last session. We would like to thank the Secretariat for preparing a compilation of responses to the Questionnaire in document SCT/42/2 Prov. The compilation reveals that there exist considerable divergences in practices on a number of pertinent questions. We support the continuation of discussions on this issue. We would like to propose the organisation of an information session on that matter to explore users' needs and national experiences, and to share best practices among offices.

8. On the topic of country names, we discussed a number of proposals at the last SCT session. As regards the proposal in document SCT/41/6, in general we remain supportive of the underlying rationale as explained on pages 1 to 3 of the document. At our last session, the proponents elaborated a revised version of the text in document SCT/41/6 which was subject to informal discussions. We reiterate our appreciation of the spirit of seeking consensus that is reflected in this joint proposal and we stand ready to participate in continued discussions to address certain technical issues in the context of the latest wording as proposed by co-sponsors.
9. Finally, turning to geographical indications, we welcome the decision to organise an information session at this meeting to discuss three topics submitted by each of the proponents of the lists of topics tabled at SCT 41. We look forward to engaging constructively on each of the selected topics in order to advance the international debate on geographical indications. We encourage the wider membership to table proposals for debate on GIs on subjects of concerns and we hope that we will be able to agree on some particular topics for further discussion to be conducted at SCT 43.
10. Chair, the EU and its Member States are hopeful to have a successful meeting under your guidance. We look forward to continuing work and contributing constructively in discussions in all three key areas of the SCT.

Thank you.

Industrial Designs

(SCT/41/2, SCT/42/2 Prov. and SCT/42/6)

Agenda Item 4

Chair,

1. As to the topic of Graphical User Interface (GUI), icon and type face/type font designs at recent SCT sessions, most delegations including the EU and its Member States have been in favour of further work, in particular on the tie between the product and the design and on how that affects the scope of protection, as well as on representation of animated GUIs. We shared common understanding that currently existing divergences should be directly addressed and further work on these issues can pave the way for a more harmonised approach.
2. At our last session, following the launch of a Questionnaire, we welcomed document SCT/41/2 Prov. setting out responses in a clear, coherent and appropriately detailed manner. We also endorsed the extension of the deadline to submit additional responses by 31 July 2019. We would like to thank SCT members for further contributions and the Secretariat for compiling all responses received in document SCT/41/2, including replies with further information on the common practice developed by the European Union Intellectual Property Office.
3. We reiterate our view that while this is not the first such survey, it is certainly the most up-to-date and detailed. This new survey explores, by means of specified and additional questions, issues such as, in particular, the link of these types of designs to the product indication; the use and effect of disclaimers; prior art searches; and viewing requirements including animated designs. In all the responses we see a wealth of information which will no doubt prove useful in further debates on GUIs, icons and typefaces in the committee. Therefore, we can fully support the compilation to be used as reference for further work on selected pertinent issues for such designs.

4. As regards future work on this topic, with particular reference to the invitation by the SCT Chair to present proposals on this matter, we note with much interest the proposal submitted by the delegations of Japan and the United States of America in document SCT/42/6. We welcome this new initiative and support the aim of adopting this joint recommendation as a practical way forward to achieve a more harmonised approach in relation to industrial design protection for GUI designs. We fully endorse the rationale to provide for at least a base line standard of protection for GUIs and we look forward to discussing this proposal with other delegations. We wish to make more detailed suggestions on the text of the draft recommendations in a later stage.
5. Although we acknowledge that issues concerning novel technological designs are interesting and relevant, we wish to reiterate our view that we should first focus on solving already-existing problems in the field of currently known forms of graphical user interface and icon designs. We continue to believe that we should have a phased approach and first channel discussions around existing and well perceptible differences that can, and should be, immediately addressed. However, we also remain interested in hearing more about other novel technological designs from user associations.
6. As regards the proposal submitted by Spain on the protection provided for by Article 11 of the Paris Convention, how it is implemented and how the term “official or officially recognized international exhibitions” is interpreted, we supported the launch of the Questionnaire finalised at our last session. We would like to thank the Secretariat for preparing a compilation of responses to the Questionnaire in document SCT/42/2 Prov. The compilation reveals that there exist considerable divergences in practices on a number of pertinent questions, and most importantly, on the criteria established to determine what qualifies as an “official or officially recognised international exhibition”. We support the continuation of discussions on this issue. We would like to propose the organisation of an information session on that matter to explore users’ needs and national experiences, and to share best practices among offices.

Thank you.

Protection of Country Names against Registration and Use as Trademarks

(SCT/32/2, SCT/39/8 Rev.3, SCT/41/6 and SCT/42/4)

Agenda item 5

Chair,

1. On the topic of country names, we discussed a number of proposals at the last session of the SCT. As regards the joint proposal contained in document SCT/41/6, the EU and its Member States would like to thank the delegation of Switzerland and other proponents for preparing a non-paper for the informal discussions at SCT 41.
2. As we commented before, we welcome the separation of two distinct policy objectives that were both covered in the previously discussed proposal in SCT/39/8 Rev. 2. The policy objective of protecting country names and geographical names of national significance against their delegation as top-level domain names in the DNS is addressed by the proposal in document SCT/41/6. In our opinion, by means of this clear divide the original Joint Proposal has been further improved in the right direction.
3. As regards the proposal in document SCT/41/6, in general we remain supportive of the underlying rationale as explained on pages 1 to 3, of the document. We can associate ourselves with the principles endorsed in the Report of the Second Special Session, supported by the SCT in 2002, as contained in document SCT/S2/8.
4. At our previous SCT session, the proponents elaborated a revised version of the text in document SCT/41/6 which was subject to informal discussions. We reiterate our appreciation of the spirit of seeking consensus that is reflected in this joint proposal and we stand ready to participate in continued discussions to address certain technical issues in the context of the latest wording as proposed by co-sponsors.

5. Turning to the proposal in document SCT/39/8 Rev. 3 addressing the policy objective of protecting country names and geographical names of national significance against their registration as distinctive signs such as trademarks, we continue to have concerns about a general prohibition of the registration of country names and geographical names of national significance as distinctive signs such as trademarks if the sign consists exclusively of such a name or if it would amount to the monopolisation of such a name.
6. In respect of both of the joint proposals discussed, we appreciate that these proposals would not imply any legislative exercise, nor do they envisage any disruption of existing practices on descriptiveness and distinctiveness. We remain of the opinion that the creation of a new “norm setting” instrument may not be the most appropriate way to address this issue.
7. Chair, we note that Peru has submitted a new proposal in document SCT/42/4 concerning a survey among Member States to determine how they treat, develop and protect nation brands both inside and outside of their respective jurisdictions. The EU and its Member States recall that in the context of a previous proposal by Peru concerning the recognition and protection of nation brands, we voiced a number of concerns at SCT 40. We reiterate our view that the concept of “nation brands” covers not only signs consisting of country names but could include, for example, any figurative elements, in any combination therewith. Therefore, it appears that the concept would significantly extend the scope of aspects to be taken into account when protecting symbols of sovereignty in the strict sense. For that reason, we remain unconvinced that further work in that direction would benefit the success of ongoing discussions on this topic. In our view, the SCT should rather focus its efforts on proposals already on the table and try to seek consensual solutions on that basis.

8. As to European trade mark practice relating to country names, we would like to inform the SCT that the EUIPO has further developed its practice in respect of geographical names, with special regard to some judgments of the Court of Justice of the European Union. In respect of country names in particular, it will be assumed that the name of a country is, in principle, associated with the relevant goods and/or services and that the public will accordingly perceive a country name as an indication of the geographical origin of the goods and/or services.

Thank you.

Additional statement on Item 5 (Trade marks) delivered in SCT plenary

Peruvian proposal (SCT/42/4)

Chair,

1. We thank Peru for its presentation to introduce the proposal.
2. Previously, we voiced concerns and were not ready to support the proposal to conduct a survey. After having heard interventions in the plenary, we recognise that the majority of delegations are supportive.
3. In the spirit of compromise and cooperation, we stand ready to give our support to the Chair's proposal to move forward. We can endorse the preparation of a Questionnaire to be prepared by Peru which will be discussed at the next session, giving the opportunity to SCT members to participate in drafting the Questionnaire.

Thank you.

Korean proposal (SCT/42/5)

Chair,

1. We thank Korea for the proposal.
2. We can support a fact-finding exercise but without the expectations of norm-setting (limited to Phase 2 of Action plan, page 5 of document SCT/42/5).

Thank you.

Geographical Indications

(SCT/40/5, SCT/40/6)

Agenda item 6

Chair,

3. The EU and its Member States express their thanks and congratulations to the Secretariat for having completed the compilation of the replies to the two Questionnaires on geographical indications and preparation of the on-line database.
4. We consider this process has been a valuable and constructive exercise in advancing the international debate on geographical indications. We also look forward to the exercise to be continued with topics to be addressed in information sessions.
5. On the issue of protecting geographical indications in the DNS, in our opinion GIs, which are a universally recognised form of IPR, should not be mixed with the issue of protection of country names and geographical names of national significance.
6. The EU believes that the treatment of geographical indications as intellectual property rights on the internet is an area where there are significant lacuna, unjustified divergences from treatment of other form of IPR, and of global significance. We look forward to further explore this matter under the information session tomorrow.
7. We consider information sessions should be advanced, in particular to address the relevance of geographical indications for developing countries' economies and for empowering women farmers. For future sessions we appeal through the Chair for topics to be proposed by the wider membership. We have transmitted proposals for further topics to the Secretariat.

Thank you.

Closing statement

Chair,

1. The EU and its Member States would like to congratulate you for guiding us through our agenda successfully this week.
2. On the topic of designs, we welcome the decision that both the Questionnaire on Graphical User Interface, Icon and Typeface/Type Font Designs and the Questionnaire on temporary protection provided to industrial designs at certain international exhibitions under Article 11 of the Paris Convention should remain open for members to submit additional responses to the to further expand the volume of information available. We appreciate that the proposal submitted by Japan and the USA will remain on the table at the next session and we thank the proponents for their flexibility and readiness to take on board comments made. We are happy that we reached consensus on organising an information session on the topic of international exhibitions at the next session and. We look forward to further work on both issues.
3. As regards trade marks, on the discussion of country names, we would like to thank all delegations and the proponents for their continued efforts to facilitate reaching consensus. We remain open to continue discussions on this issue, in particular as regards the joint proposal in document SCT/41/6. We look forward to the preparation and discussion of Questionnaires on both the topics of nation brands and the protection of well-known marks at our next session.
4. On the topic of Geographical Indications, the EU and its Member States offer their thanks and congratulations to the Secretariat for the finalisation of the database reproducing all returns to Questionnaire I on the National and Regional Systems that can provide a certain protection to Geographical Indications, and to Questionnaire II on the Use and Misuse of Geographical Indications, Country Names and Geographical Terms on the Internet and in the DNS.

5. We were very satisfied with the GI Information Session that allowed us to hear from three expert panels on important aspects of GIs: evaluation of genericness; GIs as intellectual property titles in the operation of DNS and in the dispute resolution policies; and Notions of identity, similarity and imitation between GIs and trademarks in the context of registration and commercial uses. We consider these sessions are meeting an important need to exchange experiences and advance the global conversation on GIs in a constructive and business-like manner.
6. As regards the future information session, the Delegation welcomes the decision to organize the information session at the next SCT to discuss two topics, submitted by US together with CH and by the EU. We are looking forward to engage constructively on each of the selected topics, and welcome with satisfaction further proposals tabled from the wider membership. We support forward planning to also discuss at SCT43 Brazil's proposal and other proposals for SCT44.
7. Finally, we are pleased to announce that the EU is planning to deposit its instrument of accession to the Geneva Act with WIPO on 26 November 2019.
8. Chair, we are hopeful that this Committee will continue to have fruitful discussions on all three key areas at our next meeting.

Thank you.
