



Council of the
European Union

Brussels, 12 May 2016
(OR. en)

8854/16

PI 55

NOTE

From: General Secretariat of the Council
To: Delegations

No. prev. doc.: 8211/16 PI 43

Subject: 35th Session of the WIPO Standing Committee on the Law of Trademarks,
Industrial Designs and Geographical Indications
(Geneva, 25-27 April 2016)
-Final EU Statements

Delegations will find attached, for information, the EU/Member States' statements made at the above mentioned WIPO meeting.

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical

Indications

35th Session

(WIPO, Geneva, 25 – 27 April 2016)

Opening Statement

Chairman,

The EU and its Member States would like to congratulate you and your vice chairs on your election. We express our full support for your efforts to guide us through this weeks' agenda, as you have done during preceding SCT sessions. We wish to thank the WIPO Secretariat for its excellent preparatory work for this meeting.

During the previous SCT we focused our discussions in relation to the Design Law Treaty on the two remaining issues, as mandated by the General Assembly. In the next 3 days we should use this opportunity with a view to reaching a common understanding on these 2 issues, which would enable us to move forward to the Diplomatic Conference and the preparatory committee scheduled for this coming Thursday and Friday.

In relation to the other two agenda items, namely country names and GI's, we look forward to constructive discussions on both items. We would like to note our interest in conducting a study on GI and the Domain Name System, which would fall within the scope of the decision by the General Assembly to examine the different systems for protection of geographical indications, within its current mandate and covering all aspects.

Thank you Chairman.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical
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35th Session**

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Industrial Design Law and Practice – draft articles (SCT/35/2)

Industrial Design Law and Practice – draft regulations (SCT/35/3)

Chair,

The main body of the Draft Design Law Treaty is stabilized, and has been for some time. The EU and its Member States welcome the opportunity to discuss the two remaining issues, as mandated by the General Assembly. Resolving these outstanding issues is an essential step that allows us to move to the Preparatory Committee later this week.

(Technical Assistance)

In relation to technical assistance, the EU and its Member States remain flexible on the options on the table. We support the effective delivery of technical assistance in implementing the Design Law Treaty. Whichever form is agreed should be geared to the requirements of end users.

(Disclosure requirement)

The purpose of the Design Law Treaty is the alignment and simplification of design registration. On the basis of our discussions so far and the many discussions at SCT 34, we remain unconvinced that the proposal on disclosure requirement as included in article 3 of the Design Law Treaty is relevant for industrial design, which protects the appearance of a product.

Disclosure requirement is however linked to the patent system. This year we resumed the IGC process. The question of disclosure requirement was addressed in the first meeting held in February 2016 which focused on genetic resources.. We believe fruitful and open substantive discussions were held, in order to gain understanding of the different issues on the table. We are looking forward to continuing the discussions at the next session of the IGC in May.

To recall, the EU and its Member States have contributed constructively and made a significant proposal on a patent disclosure requirement for genetic resources, and pending further discussions, possibly traditional knowledge associated with genetic resources.

To sum up, we believe the IGC is the appropriate forum to discuss the underlying substantive issues in relation to disclosure requirement. .

Thank you chair.

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Proposal by the US (SCT/34/5)

Proposals by the Delegation of the United States (SCT/30/7 and SCT/31/7)

**Proposal by the Delegations of the Czech Republic, France, Germany, Hungary, Italy,
Republic of Moldova, Portugal, Spain and Switzerland (SCT/31/8 Rev.4)**

Chair,

The EU and its Member States would like to address the broad range of issues in relation to Geographical Indications.

Our work on GIs is guided by the 2016 General Assembly decision to direct the SCT to examine the different systems for protection of geographical indications, within its current mandate and covering all aspects.

Taking this decision into account, the EU and its MS believe that work on GIs should be focused on the Domain Name System, which is a very relevant and topical subject. We therefore call for a study on GI and the Domain Name System or GIs and the Internet names as earlier proposed in SCT/31/8 Rev 5, and previously supported by the EU and its Member States. The study should investigate:

- whether the need of users for the protection of geographical indications in the DNS has changed,
- whether the measures available today for holders of geographical indications against infringing domain names are effective enough and
- how the existing legal and procedural framework could be improved.

In relation to the other proposals on the table, we would like to note that work done by the SCT should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act. For institutional and legal reasons, it cannot be given such a mandate. Any future revision of the Lisbon Agreement or the Geneva Act is the exclusive prerogative of Parties to these agreements.

As a consequence, the examination of the different systems for protection for geographical indications, within its current mandate and covering all aspects, cannot be based upon documents SCT/30/7, SCT/31/7, SCT/34/5, since these documents mainly relate to the Lisbon agreement.

During previous sessions we discussed the proposal from the US to conduct a study. We still believe that such a study would add little new, and would in essence only reiterate the obvious fact that there are some countries which protect GIs through the trade mark system, and others, including the EU and its Member States, through *sui generis* systems.

However, in the interest of consensus we are prepared to initiate a dialogue on national and regional regimes in the matter of GI protection at SCT 36.

Thank you Chair.

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**Protection of Country Names against Registration and Use as Trademarks, Practices,
Approaches and Possible Areas of Convergence (SCT/35/4) and Revised proposal by the
Delegation of Jamaica (SCT/32/2)**

Chair,

My statement is on document SCT/35/4, not on the proposal just made by the delegation of Jamaica.

The EU and its Member States would like to thank the WIPO secretariat for the document on the Protection of Country Names against Registration and Use as Trademarks, Practices, Approaches and Possible Areas of Convergence, contained in document SCT/35/4.

We take note that the paper confirms, as the Study already did, that there are several opportunities available to third parties, before, during and after the trademark registration process where the protection of country names may be invoked.

In this regard, our preferred way forward therefore would focus on awareness raising activities on the available mechanisms for the refusal or invalidation of trademarks containing country names. Several grounds exist to refuse or invalidate trademarks, namely for lack of any distinctiveness, for being descriptive, for being contrary to public policy or for being misleading, deceptive or false. We are also still interested in the proposal by the WIPO secretariat in SCT/34/2 that the protection of country names could be addressed in trademark examination manuals, in order to raise awareness of the already widely existing possibilities to refuse or invalidate the registration as a trademark of signs consisting of or containing a country name.

With respect to the possible areas suggested in the paper where convergence may be found among the laws and practices of different members, we are not opposed to continue work in those areas which are related to practice.

We believe that areas which are of a substantive nature, such as areas 3 and 4, should be outside the scope of the work as we believe progress here would be difficult.

The European Union and its Member States look forward to participating constructively in future discussions on this topic and are ready to engage.

Thank you Chair.

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Proposal by the delegations of the United States of America and Japan (SCT/35/6)

The EU and its Member States would like to thank the delegations of the United States of America, Japan and Israel for their proposal on Industrial Design and Emerging Technologies.

We look forward to discussing it at the next session of the SCT.

Thank you Chair.

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Closing statement

Thank you very much Chair.

I'm aware that you don't like thanks, but please indulge me whilst I thank you on behalf of the EU and its Member States for your tireless and ceaseless efforts. Yours has been a bravura performance and I'm only sorry that it wasn't crowned with success at the end of the day because what we were aiming for was something that would have benefitted all designers around the world. We all had a vested interest in achieving success today. Regrettably we were unable to. The European Union and its Member States could, in a spirit of compromise, have accepted your last proposal as a pathway to consensus. We will continue, of course, our endeavours to see whether the possibility exists for an agreement at a later stage, but again, many thanks indeed for having done what you've done, and many thanks to all those delegations that showed flexibility throughout these 3 days.
