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Subject:	36 th Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (Geneva, 17- 19 October 2016) - Final EU/Member States statements

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

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical
Indications
36th Session
(WIPO, Geneva, 17- 19 October 2016)
Opening Statement**

Chairman,

The EU and its Member States would like to thank you for your continuous efforts and dedication to the work of this important committee.

The EU and its Member States profoundly regret that the General Assembly was unable to reach agreement on finalization of discussions on the Design Law Treaty. Against the experience of the failed negotiations at the GA, we believe that this committee should turn to other relevant topics, and not spend more of its valuable time on the DLT.

During our previous session, most of our time was dedicated to finalizing agreement on the DLT. It was therefore decided that country names would remain on the Agenda and that the SCT would revert to it at its next session. We are looking forward to a constructive and substantive discussion on this issue this week.

Over the years a number of documents have been tabled on the broader aspects of geographical indications. We look forward to continue with the discussion on these matters at SCT 36. We would like to make it clear however that the work of the SCT should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act, and that any future revision of the Geneva Act is the exclusive prerogative of the members of the Lisbon Union.

The EU and its Member States believe that conducting a study on GI and the Domain Name System 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 therefore would support such a study by the secretariat.

Thank you Chairman.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical
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(WIPO, Geneva, 17 – 19 October 2016)

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

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

Chair,

Once again the EU and its Member States would like to express our disappointment that the General Assembly was unable to reach agreement in relation to the Design Law Treaty.

The text of the DLT has been stabilized since 2014. Acknowledging the mandate of the 2015 GA, we have discussed extensively solutions to accommodate the need for policy space in order to comply with national or regional requirements, and the matter of technical assistance.

The EU has demonstrated great deal of flexibility and understanding during these discussions and did so again most recently at the General Assembly. The discussions at the General Assembly have shown that we have reached a deadlock of a political nature, and therefore there is no need for further discussions of matters of substance relating to the DLT in the framework of the SCT.

Thank you chair.

Statement 2 (in response to African Group comments)

To be clear, we held very extensive consultations on DLT during the 56th session of the General Assembly and the provisions relating to African group concerns. The EU showed a great deal of flexibility in addressing the concerns, and this was done in a transparent manner. For the record, we have gone as far as we could in the framework of informal consultations, now it is time for a political decision.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical
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36th Session**

(WIPO, Geneva, 17 – 19 October 2016)

Graphical User Interface, Icon and Typeface/Type font Designs (SCT/36/2)

Chair,

The EU and its Member States would like to thank the WIPO secretariat for the compilation of the replies to the questionnaire on graphical user interface (GUI), icon, and typeface / typefont designs contained in document SCT/36/2.

The questionnaire highlights that most jurisdictions protect graphical user interface, icon and typeface/typefont as designs but also under copyright law and as trade marks.

We would like to note that the legal regime applicable in the European single market for designs contains a broad notion of possible subject matter of designs, and allows for design protection of graphical symbols and logos. The regime includes the protection for animated GUI and icons, as set out also in the recent convergence programme of the IP offices of the European Trademark and Designs Network on the graphic representations of designs, which is set out on page 32 of SCT/36/2.

In relation to typefaces, we note that these can be registered with the product indication “typographic typeface” when the formal requirements as stipulated by Art. 4 Community Design implementing Regulation ('Representation of the design') are adhered to.

Thank you chair

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical
Indications
36th Session
(WIPO, Geneva, 17 – 19 October 2016)
Digital Access Service (DAS) for Priority Documents (SCT/36/3)**

Chair,

The EU and its Member States would like to thank the WIPO secretariat for the presentation and the information provided on the Digital Access Service for Priority Documents contained in document SCT/36/3.

The Digital Access Service for priority documents is WIPO's electronic system allowing for the exchange of priority documents and similar documents between IP offices. At the moment the system is used for patent documents only, however, it also allows for the exchange of other IP documents, including certified design priority documents.

In this regard, the EU and its Member states would like to acknowledge the importance of improved handling of priority documents in industrial design cases.

Thank you chair.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical
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36th Session**

(WIPO, Geneva, 17 – 19 October 2016)

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.5)**

Proposal by the Delegation of France (SCT/34/6)

Chair,

The EU and its Member States would like to address the broad range of issues in relation to Geographical Indications, since a wide variety of documents have been tabled under this agenda item.

A future work program on GIs within the SCT should respect the SCTs mandate. As a consequence, the work of the SCT should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act, since any future revisions the Geneva act is the exclusive prerogative of the members of the Lisbon Union. As a consequence, the proposal for a study examining 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.

We believe that for its future work the Committee should focus its substantive discussions on the question of GIs and the Domain Name System and/or GIs and the Internet names.

Thank you Chair.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical
Indications
36th Session**

(WIPO, Geneva, 25 – 27 April 2016)

**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,

I am speaking on behalf of the EU and its Member States

Under this agenda item, two documents have been tabled, namely the revised proposal by the Delegation of Jamaica, and the document on the Protection of Country Names against Registration and Use as Trademarks, Practices, Approaches and Possible Areas of Convergence, provided by the WIPO Secretariat.

We would like to stress that the paper from the WIPO Secretariat confirms that before, during and after the trademark registration process there are several opportunities available to third parties, where the protection of country names may be invoked. 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.

At the moment there are two concrete options readily available that can address very rapidly the concerns raised. First of all we would like to highlight awareness raising activities on the available mechanisms for the refusal or invalidation of trademarks containing country names as the most efficient way forward. Secondly, the protection of country names can 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 further work in those areas which relate to practice. Areas which are of a substantive nature, such as areas 3 (non registrable if considered misleading, deceptive or false) and 4 (consideration of other elements of the mark), should be outside the scope of our work at this stage as we believe progress here would be difficult. The EU and its Member States will have to reflect on whether discussions in this committee are likely to result in a consensus approach on these points.

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

Thank you Chair.
