



Council of the  
European Union

Brussels, 31 March 2017  
(OR. en)

7899/17

PI 36

**NOTE**

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From:	Presidency
To:	Delegations
No. prev. doc.:	6201/2/17 PI 16 REV 2
Subject:	37 <sup>th</sup> Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (Geneva, 27- 30 March 2017) - Final EU/Member States statements

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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  
37<sup>th</sup> Session  
(WIPO, Geneva, 27 – 30 March 2017)  
Opening Statement**

Chair,

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

The EU and its Member States look to the upcoming General Assemblies to reach a positive decision on convening a diplomatic conference on a draft Design Law Treaty. We trust that this matter – which achieved the required level of maturity in 2014 – will be given the priority it deserves at the General Assemblies. In this vein, the EU and its Member States are committed to a constructive approach to overcome remaining differences among WIPO members.

In relation to Industrial Designs, we look forward to the discussions on the Questionnaire on Graphical User Interface and Icons, which is a very topical and important subject.

In relation to trademarks/country names, we would like to thank the WIPO secretariat for the compilation of the comments in relation to certain areas of convergence.

The SCT will continue discussions on the work programme in relation to geographical indications, and a number of documents on the broader aspects of geographical indications have been tabled in this regard.

The EU and its Member States are committed to developing a work programme that is acceptable to all WIPO members, in line with the 2016 General Assembly decision to "the holding of an exchange of views at the SCT regarding several proposals concerning the protection of geographical indications in national systems, and the protection of geographical indications and country names in the Domain Name System."

We note however, as we have done in the past, that the work of the SCT should respect the SCT mandate and framework, and should avoid duplication of work already completed by the SCT or covered by existing Treaties and IP systems administrated by WIPO. Furthermore, we should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act. Any future revision of the Geneva Act is the exclusive prerogative of the members of the Lisbon Union.

We believe that the work programme, in compliance with the SCT mandate, should focus on specific issues, such as on geographical indications in the Domain Name System, as contained in SCT/31/8 rev 6.

We look forward to the information session on geographical indications tomorrow, which will address (i) the features, experiences and practices of the different national and regional geographical indication protection systems, and (ii) the protection of geographical indications on the Internet, and geographical indications and country names in the DNS. The program of the information session contains a wide range of speakers from different geographical locations as well as different levels of development, addressing the various systems of geographical indication protection from several angles, and it therefore promises to be an interesting session.

Thank you Chair.

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

**37<sup>th</sup> Session (WIPO, Geneva, 27 – 30 March 2017)**

**Graphical User Interface, Icon and Typeface/Type font Designs (SCT/36/2 rev and SCT/37/2)**

Chair,

The EU and its Member States would like to thank the WIPO secretariat for the updated compilation of the replies to the questionnaire on graphical user interface (GUI), icon, and typeface / typefont designs contained in document SCT/36/2 rev, as well as for the analysis contained in document SCT/37/2.

We recognize the economic importance of ensuring adequate protection for these new technological designs. The paper and its annex provide a very useful overview and analysis of the systems used to protect GUI, icons etc.

It is encouraging to see much common ground in the approach taken on the various issues raised in the paper. However, it is true that the paper also identifies a number of areas with some divergences, such as in relation to additional or special requirements for the representation (question 5, para 24) and eligible subject matter for protection/ GUI and icon only appearing temporarily (question 10, para 35). The analysis also shows that jurisdictions do not show a clear tendency as to the scope of protection of GUIs and icons, in particular on whether protection is granted regardless of the product in question (question 17, para 49).

We would like to note that differences in the examination of substantial application requirements between the jurisdictions do not appear to be specific to GUIs and icons only, but may apply to all types of designs.

The EU and its Member States therefore remain open to considering further work on this topic, if considered useful by the Committee.

Thank you Chair.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical  
Indications  
37<sup>th</sup> Session**

**(WIPO, Geneva, 27 – 30 March 2017)**

**Protection of Country Names against Registration and Use as Trademarks, Practices,  
Approaches and Possible Areas of Convergence – comments by Members (SCT/37/3)**

**Note by the Delegation of Iceland (SCT/37/6)  
Revised proposal by the Delegation of Jamaica (SCT/32/2)**

Chair,

The EU and its Member States would like to thank the WIPO Secretariat for providing document SCT/37/3, which compiles comments by members in relation to possible areas of convergence.

At the outset we would like to note that at SCT 36, after discussions, you mr Chair concluded that this item would remain on the Agenda of the SCT; and you requested the Secretariat to invite Members to submit, in priority, comments and observations in relation to Areas No. 1 (Notion of Country Name), No. 2 (Non-registrable if Considered Descriptive), No. 5 (Invalidation and Opposition Procedures) and No. 6 (Use as a Mark). During SCT 36 we have stated clearly that we wanted to focus only on those areas that relate to practice and that any convergence in relation to areas 3 (non registrable if considered misleading, deceptive or false) and 4 (consideration of other elements of the mark) would be difficult.

We therefore request that those comments that have been submitted in relation to areas 3 and 4 be dealt with in an annex.

Turning to areas 1, 2, 5, and 6, we notice that the replies from members explain to a certain extent how the system works. According to the large majority of the replies, protection is provided against descriptive use of country names.

We note the relatively low number of replies contained in document SCT/37/3. We therefore believe the document is not able to demonstrate whether there is a relevant degree of discrepancy which would make convergence desirable. The comments are not appropriate or sufficient either to show that there is a need for a norm setting instrument. As regards the EU's domestic trademark regime, the EU and its Member States continue to believe that the protection currently provided by the EU trademark laws is sufficient to appropriately deal with the matter. We would also recall the low number of cases related to country names.

The most appropriate and efficient way forward would be to highlight awareness raising activities on the available mechanisms for the refusal or invalidation of trademarks containing country names, as well as addressing the protection of country names 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.

Thus, if the Committee were to consider further work on the basis of SCT/37/3, we believe that work should mainly focus on and promote best practices. In this regard, we suggest that the comments contained in SCT/37/3 could be clarified in order to promote a dialogue, for instance in relation to the criteria to be applied to assess the geographical significance of a country name. Further, the deadline to submit comments should be extended to facilitate a wider and more complete overview of the law in force in the widest possible number of WIPO Members.

The EU and its Member States believe that the legal framework in place in the EU is robust enough to deal with cases such as the one presented by the Delegation of Iceland in SCT/37/6. We are confident this is in good hands of the EUIPO. We note in this regard that the opposition against the “inspired by Iceland” trademark has been refused. This decision has, however, been appealed. We would like to further stress that appeal possibilities are available at the Court of Justice of the European Union. We emphasize that the EU and its Member States appreciate this opportunity, within the limits of the SCT mandate, to shed light on conflicts between country names and trademarks that concretely affect the private business. However, we would like to stress that we can't prejudge the outcome of the proceedings in any way.

Thank you.

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

**37<sup>th</sup> Session**

**(WIPO, Geneva, 27 – 30 March 2017)**

**International Nonproprietary names for Pharmaceutical Substances (INN) (SCT/37/4)**

Chair,

The EU and its Member States would like to thank the WIPO Secretariat for the document in relation to trademarks and INNs.

We fully support the proposal by the Secretariat contained in para 6 to replace to current paper practice of sending the cumulative list of INNs to trademark offices, by electronic communications. We look forward to hearing more about the practical implications of the proposals contained in para 8.

Thank you.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical  
Indications  
37<sup>th</sup> Session  
(WIPO, Geneva, 27 – 30 March 2017)**

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

Chair,

The EU and its Member States would like to thank the WIPO secretariat for organizing the information session. We would also like to thank all the participants yesterday for an interesting session, and the valuable contributions that were made to our further debate.

In scoping a future work programme in relation to geographical indications, the EU and its Member States would like to stress that the work programme should respect the SCT mandate, and especially should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act, since any future revisions of the Geneva Act is the exclusive prerogative of the members of the Lisbon Union. The work programme should avoid duplication of work already completed by the SCT or covered by existing Treaties and IP systems administered by WIPO.

As a general comment, the EU and its Member States would like to point out that the work programme should not focus on general topics, such as the scope and different means of geographical indication protection which are well established in the WIPO Treaties.

Instead, we should focus exclusively on more specific topics, such as a substantive discussion on the question of geographical indications in the Domain Name System. This crucial topic is of concrete concern for stakeholders, and the SCT has not discussed this topic in depth during the course of the last decade.



Conducting a study on geographical indications in the Domain Name System, as proposed in WIPO/SCT/31/8 rev 6, would fall both within the scope of the decision by the General Assembly to examine the different systems for protection of geographical indications, and within the SCTs current mandate. We would therefore support such a study by the WIPO secretariat, which would investigate:

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

Thank you Chair.

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