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| Subject: | 38 th Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (Geneva, 30 October - 2 November 2017) - Final EU/Member States statements |

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

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

38th Session

(WIPO, Geneva, 30 October – 2 November 2017)

Opening Statement

Mr Chair,

1. The EU and its Member States would like to thank you for your continuous efforts and dedication to the work of this Committee. We believe it is important to hold fruitful discussions in all key areas covered by the SCT but, in the end, also to come to clear and tangible results that have a positive impact on stakeholders.
2. With regard to trademarks, the Committee has been discussing the protection of country names against registration and use as trademarks. The EU and its Member States share the view that it is important to ensure effective protection of country names and that there are legal means in place to secure appropriate protection in national legislations. In this regard, the work carried out in the Committee so far has not revealed a need for additional action other than awareness raising, which should focus in particular on the availability of grounds for refusal or invalidation of trademarks containing country names and on the possibility of addressing the relevant issues in trademark examination manuals. At the same time, we note calls for further work on this issue and remain open to paving the way for greater transparency of national practices. In order to further explore the implications of diverging solutions currently in place and to mutually explain the various rationales, we would like to propose that the Committee consider the possible merits of organising an information session dedicated to country names.

3. As regards industrial designs, we refer to the discussions held in relation to the Design Law Treaty during the General Assembly earlier this month. The EU and its Member States went to the Assemblies, aiming to break the political deadlock of last years which has prevented the GA from taking a decision on the convening of a diplomatic conference for the adoption of the DLT. Regrettably, despite our best endeavours and unprecedented level of flexibility from the side of the EU and its Member States, and despite coming very close, an agreement proved yet again out of reach. Instead, the GA decided that at its next session in 2018, it will continue considering the convening of a diplomatic conference on the DLT. In light of that unfavourable result, we refer to the discussions held during SCT 36, and the conclusion of the Chair that while the DLT would remain on its agenda, the SCT should abide by the decision of the General Assembly. Accordingly, we reiterate our position that discussions on the DLT should not be held in this Committee.
4. In relation to graphical user interface, icon and typeface/type font designs, we look forward to participating in the information session and learning about the practices of offices and the experience of users.
5. During this meeting of the SCT, we will also continue discussions on the work programme in relation to geographical indications, and specifically on the Chair's proposal [document SCT/38/4]. The EU and its Member States remain committed to developing a work programme that is acceptable to all WIPO members, in accordance with the SCT mandate and in line with the 2015 General Assembly decision that directed the SCT to examine the different systems for protection of geographical indications, within its current mandate and covering all aspects.
6. 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 build on, and 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.

7. We have studied the Chair's proposal in detail and can find much in it to commend, notably the proposal to discuss the protection of GIs on the internet and in the DNS. While not excluding a wider discussion, we reiterate that our work should be focused and relevant to the issues faced by stakeholders today. We look forward to discussing this question further with a view to reaching consensus.

8. In view of all these considerations, the EU and its Member States look forward to continuing work in all three key areas of the SCT.

Thank you.

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

38th Session

(WIPO, Geneva, 30 October – 2 November 2017)

Graphical User Interface, Icon and Typeface/Type font Designs

(SCT/36/2 Rev. and SCT/37/2 Rev.)

Mr Chair,

1. The EU and its Member States would like to thank the WIPO Secretariat for organising the information session on graphical user interface, icon and typeface/type font designs, addressing the practices of offices and the experience of users. We thank WIPO Member States as well as NGOs for their additional input to the questionnaire on this matter. We also thank the Secretariat for preparing a revised analysis of the returns to the questionnaire contained in document SCT/37/2 Rev.
2. The information session was a fruitful exercise. We gained good insights on practices in different jurisdictions and heard interesting experiences from relevant stakeholders. This will provide valuable input for the Committee's subsequent discussions on this issue.
3. During the last session of the SCT, the EU and its Member States welcomed that there was much common ground in the approaches taken on various issues addressed in the updated analysis of the replies to the questionnaire. At the same time, we also noted that a number of areas with some divergences had been identified. These remain to be relevant also on the basis of the revised analysis in document SCT/37/2 Rev. For example, there seem to be considerable differences in relation to additional or special requirements for the representation and eligible subject matter for protection of graphical user interface and icon designs appearing temporarily. It can also be observed that jurisdictions do not demonstrate a uniform tendency as to the scope of protection of graphical user interface and icon designs, in particular on whether protection is granted regardless of the product in question.

4. Therefore, recognising the economic importance of ensuring adequate protection for these new technological designs, we remain open to considering further work on this topic. Even more so as this can currently be regarded as one of the most forward-looking fields of IP.

Thank you.

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

38th Session

(WIPO, Geneva, 30 October – 2 November 2017)

**Protection of Country Names against Registration and Use as Trademarks, Practices,
Approaches and Possible Areas of Convergence**

(SCT/37/3 Rev., SCT/38/2, SCT/32/2)

Mr Chair,

1. The EU and its Member States would like to thank the WIPO Secretariat for preparing a revised version of the document containing comments by members, and for the analysis of the comments concerning practices, approaches and possible areas of convergence in respect of the protection of country names against registration and use as trademarks, as contained in documents SCT/37/3 Rev. and SCT/38/2 respectively.
2. The EU and its Member States share the view that it is important to ensure the effective protection of country names and that there are legal means in place to secure appropriate protection in national legislations. In this regard, the work carried out in the Committee so far has not revealed a need for additional action other than awareness raising, which should focus in particular on the availability of grounds for refusal or invalidation of trademarks containing country names and on the possibility of addressing the relevant issues in trademark examination manuals.
3. At the same time, we note calls for further work on this issue and remain open to paving the way for greater transparency of national practices, so as to tackle misleading practices in international trade. In order to further explore the implications of diverging solutions currently in place and to mutually explain the various rationales, we would like to propose that the Committee consider the possible merits of organising an information session dedicated to the protection of country names both in the physical and digital environment, including the DNS.

Thank you.

**Standing Committee on the Law of Trademarks, Industrial Designs and
Geographical Indications**
38th Session
(WIPO, Geneva, 30 October – 2 November 2017)
Geographical Indications
(SCT/30/7, SCT/31/7, SCT/31/8 Rev7, SCT/34/6, SCT/38/4)

Mr Chair,

1. The EU and its Member States would again like to thank the WIPO Secretariat for organising the interesting and fruitful information session at our last meeting. We agree with the comments of the Secretariat [in document SCT/38/4] that the information session was a good basis on which to exchange views on GI protection systems and in particular on GIs in the DNS. We congratulate and thank the Chair for his management of the information session and for the Chair's Proposal for taking forward our work on GIs.
2. The EU and its Member States reiterate that the work programme should respect the SCT mandate, and in particular should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act. We further emphasize that the work programme should build upon, and avoid duplication of work already completed by the SCT or covered by existing Treaties and IP systems administered by WIPO.
3. 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 definition of the subject matter of protection. We also find that some elements in the Chair's proposal, such as those concerning the application and registration of geographical indications, are of a procedural nature and therefore too remotely related to the proposals on the table to be discussed in this Committee in accordance with the decision of the 2015 General Assembly.

4. In our opinion, we should marshal our time and resources in this Committee to ensure added value to our work. In order to do that, we should focus on specific topics, such as a substantive discussion on geographical indications in the DNS. We see this as a crucial topic and one of concrete concern for stakeholders. The discussion we had at the last session was the first time in the last decade this issue has been directly addressed in this Committee, setting the scene for further in-depth discussions.
5. Turning to the text of the Chair's proposal, we welcome the second item, on the DNS. However, we would like to propose some amendments to clarify that our work should focus on the protection of geographical indications, country names and geographical terms on the Internet and in the DNS, including under TLD, gTLD and ccTLD, based on the proposal in document SCT/31/8 Rev.7.
6. On the other hand, we are concerned that the first item in the Chair's proposal is rather general in scope. We would prefer it to be made more concrete and targeted on specific issues. The current text would result in an inventory of existing systems, which we all already know reasonably well (see documents SCT/8/4 and SCT/9/4 from 2002). Assuming that the Committee proceeds to develop a targeted questionnaire, we should aim for it to enable us to collect useful information so as to have meaningful discussions for the ultimate benefit of stakeholders. We emphasize that the preparation of the questionnaire should be a process driven exclusively by WIPO Members.
7. In the spirit of cooperation, the EU and its Member States wish to engage constructively in discussions concerning the text of point (I). In this respect, we propose to clarify that the indents of point (I) concern GIs by inserting specific references to geographical indications in each of the indents. This will help to focus the discussion. We also propose to add a reference to "enforcement mechanisms".
8. As regards the final section of the Chair's proposal containing a timeline, we note that the planned dates need to be modified to take into account the time passed since our previous discussions on the proposal and to ensure that the agreed timetable corresponds to practical needs.

9. In view of our detailed comments, we believe certain adjustments should be made to the text of the Chair's proposal, in particular in the wording of items I and II. We would also like to express our support for some amendments proposed by Switzerland at the last SCT session. Accordingly, the EU and its Member States would like to submit its own textual suggestions to be considered in further discussions on the Chair's proposal at this meeting in the form of a working document.

10. We are hopeful that our proposal can facilitate discussions aimed at adopting a work plan for the continuation of discussions on the protection of geographical indications in the SCT.

Thank you.

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

38th Session

(WIPO, Geneva, 30 October – 2 November 2017)

Closing statement

Mr Chair,

1. The EU and its Member States would like to congratulate you for making the SCT 38 such a success. Achieving consensus on a future work programme on Geographical Indications in SCT, a prize that has eluded us for so long, is a significant milestone in the work of this Committee.
2. But this was not our only success. We also made good progress on furthering understanding on the issues surrounding country names. We look forward to the information session at the next SCT meeting and trust that it will be as useful as the information session on graphical user interface, icon and typeface/type font designs that was held at this meeting.
3. We would like to salute the particularly constructive spirit shown by all delegations in our discussions this week.
4. Finally we would like to highlight the role of the Secretariat whose excellent work has allowed our proceedings to run so smoothly and also our interpreters and translators for contributing to our better understanding.

Thank you.

[Annex follows]

ANNEX:

**Text as proposed by the EU and its Member States for Consideration in Discussions on the
Chair's Proposal**

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

38th Session

(WIPO, Geneva, 30 October – 2 November 2017)

Geographical Indications

(SCT/30/7, SCT/31/7, SCT/31/8 Rev7, SCT/34/6, SCT/38/4)

The Information Session, which took place on March 28, 2017, provided useful information on (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 Domain Name System (DNS): gTLDs and ccTLDs. The Information Session was a good basis to initiate an exchange of views on points (i) and (ii) referred to above.

As a further step, and in order to share more information and foster a constructive dialogue on those two topics, the Chair requests the Secretariat to compile a list of questions proposed by Members, for consideration by the SCT, which could form the basis of a questionnaire to be distributed to Members. The list of questions will be structured according to the following topics:

I. The national and regional legislations which can provide a certain protection to geographical indications

- Basis for protection and scope of protection of geographical indications
- Enforcement of rights conferred by geographical indications

II. The protection of geographical indications, country names and geographical terms on the Internet and in the Domain Name System (basis for protection, protection mechanisms), including under TLD, gTLD and ccTLD, on the basis of the proposal contained in document SCT/31/8 Rev.7.

The Chair requests the Secretariat to prepare a study for the fortieth session that shall investigate and analyse protection/use and wrongful use of GIs in the DNS and how the existing legal and procedural framework could be improved.

The planning for the above is as follows:

- In December 2017, the Secretariat will send a circular inviting Members to propose the questions referred to above.

- Members are to propose their questions to the Secretariat by the end of March 2018.

- The Secretariat will issue, by the end of August 2018, a document compiling the questions, for consideration of the SCT at its fortieth session (to be held at the end of October).

- The SCT will consider, at its fortieth session, the above-mentioned document, with a view to issuing the questionnaire to Members, and, at its forty-first session, a document prepared by the Secretariat compiling all the replies to the questionnaire.