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#### NOTE

From:	General Secretariat of the Council
To:	Delegations
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Subject:	WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 33rd Session (Geneva, 16 - 20 March 2015) - Final EU/Member States' statements

Delegations will find attached, for information, the statements pronounced on behalf of the European Union and its Member States at the above mentioned WIPO meeting.

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

**33<sup>rd</sup> Session  
(WIPO, Geneva, 16 - 20 March 2015)**

**Opening Statement**

Chairman,

The European Union and its Member States express our full support for your efforts to achieve consensus on a recommendation to the General Assembly to convene a Diplomatic Conference on the draft Design Law Formalities Treaty.

We cannot stress enough the significant advantages that alignment and simplification of design registration formalities and procedures bring to all users of the system. Users can be national offices, but also SME's worldwide.

At the previous SCT session, the EU stated that the DLT text is technically mature, and that there was no need to re-open the articles for discussion. During that meeting a proposal unrelated to design law formalities was however inserted. This proposal moves the text farther away from simplification and alignment of design registration formalities than ever.

The EU therefore can not support the reopening of a discussion on the Draft Articles and Regulations, and instead to focus our efforts this week on a decision on convening a diplomatic conference on the basis of the work done before the SCT that was held in November 2014. If there is no consensus on this, we would propose to suspend further substantive discussions.

Other topics this week concern the protection of country names and nation branding, as well as geographical indications.

In relation to country names, the EU and its Member States are looking forward to the side event on the protection of country names and nation branding. This event constitutes a substantial awareness raising activity on this important topic.

We are also looking forward to discussing the possible study on geographical indications and domain names. The study proposes new substantive elements in relation to GI's and the domain name system. The question has not been examined before and thus merits a study.

Chairman

We trust that you will guide us through this week's work with your customary sense of purpose. We would also wish to thank the WIPO Secretariat for its excellent preparatory work for this meeting. It should be noted that in the EU's view a three day meeting would have been sufficient in order to deal with the limited number of substantive items foreseen on our agenda. The experience gained during SCT 32 has set an important precedent in that regard and we would urge the Secretariat to take our views into account on the effective use of resources when planning future meetings of this Committee.

Thank you Chairman.

**Standing Committee on the Law of Trademarks, Industrial Designs and Geographical  
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**Industrial Design Law and Practice – draft articles (SCT/33/2)**

**Industrial Design Law and Practice – draft regulations (SCT/33/3)**

Chairman,

The EU and its Member States are of the view that the substantive provisions of the DLT are now settled. The question of how best to accommodate provision on technical assistance in relation to the implementation of the DLT remains to be resolved.

During the WIPO GA in May 2014 the African Group stated that the question of technical assistance had to be resolved in order to reach agreement on convening a Diplomatic Conference. We remain open on the idea of including provisions on technical assistance in the main body of the text.

At SCT 32 the African Group further requested the inclusion of a paragraph on disclosure requirement. This would move the text farther away from the objective of simplification and alignment of design registration formalities. This proposal is not relevant to industrial design formalities. We would therefore urge the African Group to withdraw its latest proposal which is extraneous to our purpose.

Chairman,

To ascertain that the text stays focused on the alignment and simplification of design registration formalities for all users, and is not diluted by unrelated matters, we should not re-open the text. We should focus our efforts this week solely on the decision on convening a diplomatic conference, based upon the previous stabilized text as it stood before the session of November 2014.

Thank you Chairman.

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**33<sup>rd</sup> Session**

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

Chairman,

On behalf of the EU and its Member States I would like to thank the Delegation of the United States for their preparation of the proposal outlined in document SCT/31/7, setting out a work plan for exploring the feasibility of a Geographical Indications filing system.

The US proposes to conduct a survey of existing national GI regimes. We believe that this proposal would add nothing 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, through *sui generis* systems.

The best way to accommodate this diversity of national systems is through the expansion of the relevant registration systems run by WIPO: namely the Lisbon and Madrid Systems.

Moving ahead with the revision of the Lisbon system should be WIPO's first priority on GIs , improving the diversity and flexibility allowed to Member States by the TRIPS Agreement. A key aim of this revision is to make the Lisbon System more attractive to countries that are currently not party, such that the system might expand, and reach a wider membership.

Indeed, the Revision constitutes an opportunity to consolidate the important function that the Lisbon System plays within the WIPO Global IP Systems, so that in the years to come all GIs producers will have an available avenue at WIPO, irrespective of the system they use at the national level.

The revised Lisbon Agreement will offer new members a modern multilateral instrument which will enable them to take advantage of the significant benefits stemming from the unique features of the producers' territory and assist them in transforming these features into marketable products.

Appellations of origin and geographical indications can turn producers of labour-intensive commodities into exporters of high-quality agro-business and handicraft products. This has the potential to provide a significant incentive for growth and employment.

The Lisbon System Working Group has established, in a process which was open to all WIPO Members and allowed observer members to table amendments, a basic proposal for the revision of the Lisbon System for the International Registration of Appellations of Origin, as a means for obtaining geographical indication protection internationally, through a single registration. The Diplomatic Conference for the Adoption of a Revised Lisbon Agreement on Appellations of Origin and Geographical Indications in May this year will pronounce itself on the basic proposal. The SCT is not the appropriate forum to deal with the revision process.

Consequently, we do not feel that such a work program would add value at the present time, and are not in a position to endorse it.

Thank you Chairman.

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

Chairman,

On behalf of the EU and its Member States, I would like to thank the delegations of the Czech Republic, France, Germany, Hungary, Italy, the Republic of Moldova, Portugal, Spain and Switzerland for their excellent proposal for work on GIs in the Domain Name System.

The EU and its Member States attach great significance to the protection of geographical indications, because of their economic importance. As stated before, we are especially interested in the study on geographical indications and domain names as proposed in the document.

The topic and the proposed study poses new substantive questions in relation to geographical indications and the domain name system. Those questions are of a very different nature than the questions posed by the US in their proposal. For that reason we do not support a merger of the two studies.

We note that this proposal has already gained support from a number of other delegations, and we think the proposal should serve as the basis for our future work on this issue under this agenda item.

Thank you Chairman.

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**Revised proposal by the Delegation of Jamaica and related documents  
(SCT/32/2, SCT/29/5 Rev, SCT/31/5, SCT/30/4)**

Chairman,

On behalf of the EU and its Member States we would like to thank the Delegation of Jamaica for the revised proposed joint recommendation of the treatment of country names, as outlined in document SCT/32/2.

We would also like to thank the WIPO secretariat for organising a side event on this topic. We were pleased to see so many people attending the event. We have been listening with great interest to the presentations made, and the discussion that followed.

We understand the interest that Jamaica and other countries attach to the protection of country names. We should however not forget that the existing trademark laws already provide a solid level of protection to country names, as was highlighted in the study conducted by WIPO, SCT/29/5 rev., before we embark on a Joint Recommendation.

Chairman,

From the European Trade Mark Law perspective the proposed Joint recommendation poses some difficulties. The draft Joint Recommendation establishes a very broad protection for country names which would impose an interpretation of the grounds for refusal under Article 7 CTMR against an established practice and case-law.



For instance, as regards descriptiveness, Article 3 ‘Conflicting marks’ as revised by Jamaica indicates that “Irrespective of the goods and/or services for which a mark is used, is the subject of an application for registration, or is registered, that mark shall be deemed to be in conflict with a country name where the mark, or a part thereof, consists of or contains a country name, and the mark is being used or intended to be used in relation to goods or services which do not originate in the country indicated by the country name.”

This article contradicts with European case law, as mentioned in paragraph 25 of the Study on the protection of Country Names, SCT/29/5 rev which states that situations should be judged on a case-by-case basis.

A principle which precludes the registration of geographical names does not exist under European Law.

The EU and its Member States believe it is necessary to look at the issue from all perspectives, not just from the point of view of states and consumers, but also from the current users of country names in trademarks, who may legitimately use a country name which has become well-known and recognised in the market place. By investigating and taking account of this we could prevent upsetting legitimately held business practices.

Awareness raising activities could be usefully undertaken to publicise the available mechanisms for the refusal or invalidation of trademarks containing country names.

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

Thank you Chairman.

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**Closing Statement**

Chairman,

The EU and its Member States would like to express their continued sense of disappointment at the insistence by the African Group to include new provisions on a disclosure requirement in the draft Design Law Treaty.

A disclosure requirement is simply not compatible with the objectives that this committee has set itself in relation to reaching agreement on simplifying design registration formalities in the framework of the DLT.

This week has provided an opportunity for both formal and informal dialogue with the African Group on the scope and objective of their proposal. Nothing we have heard so far allows us to believe that we will be in a position to find the common ground that would allow us to move forward towards our common objective of simplifying design registration formalities. That being said, the EU remains open to further informal dialogue with the African Group on the occasion of SCT 34 in order to gain a better understanding of respective positions. We will then need to take stock at SCT 34 of prospects for the DLT and decide on our future course of action.

The game changing nature of the African group proposal which reached us at a time when the text was adjudged by all at SCT 31 to be stabilized, places this Committee in an awkward position. It is clear that this new hurdle must now be cleared before we can reach a decision on the final destination of our work on DLT.

Chairman we would like to commend both you and the secretariat on the organisation of a successful side event on country names and nation branding. We look forward to your future proposals on the way forward on this issue.

Finally chairman, experience gained during SCT 32 and 33 has clearly demonstrated that as the agenda currently stands a three day meeting is amply sufficient for our work. We would be most grateful to you and the WIPO secretariat if you could inform the Director General that the duration of future meetings should be adjusted accordingly.

Let me close by thanking you and the co-chairs for the leadership you have provided in our debates and the secretariat for its support.

Thank you Chairman.

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