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Subject:	39th Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications (SCT) (Geneva, 23-26 April 2018) - 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**

39th Session

(WIPO, Geneva, 23–26 April 2018)

Opening Statement

Chair,

1. The EU and its Member States would like to congratulate you and your Vice-Chairs on your re-election. We would like to thank you for your continuous efforts and dedication to the work of this Committee. We extend our thanks to the Secretariat for its excellent preparatory work for this session.
2. Looking back to the previous SCT session, we recall with appreciation the particularly constructive spirit shown by all delegations in our discussions. We believe that achieving consensus on a future work programme on Geographical Indications was a significant milestone in our work. The EU and its Member States actively contributed to the compilation of a Questionnaire and look forward to discussions of documents SCT/39/6, SCT/39/6 Rev. Corr. and SCT/39/7 at this session. We also made good progress on furthering understanding on the issues surrounding country names. We think that the information session in the form of a moderated roundtable organised by the Secretariat can facilitate that progress. We are hopeful that this session will succeed in building upon the positive results achieved at our last meeting.

3. 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 would like to thank again other delegations, the Chair and the Secretariat for helping to define the focus of the upcoming information session on office practices. We look forward to participating in the information session and further exploring various rationales underscoring the range of practices currently in place. We also note that a new proposal has been tabled in document SCT/39/8 and remain open to participate in discussions concerning these issues. We also take note of the proposal by Peru in document SCT/39/9.
4. As regards industrial designs, we refer to the discussions held in relation to the Design Law Treaty during the General Assembly last year. We reiterate our position that discussions on the DLT should not be held in this Committee.
5. In relation to graphical user interface, icon and typeface/type font designs, we found the information session held at the last session very useful. We would like to thank the Secretariat for an excellent summary of the main points emerging from that information session contained in document SCT/39/2. We also thank Member States and accredited Nongovernmental Organisations for submitting proposals regarding desirable further work on this topic, as compiled in document SCT/39/3.
6. We have studied these proposals with great interest, in particular where focussed on requirements for a connection between graphical user interfaces and physical products for protection of graphical user interfaces by design rights, and on methods allowed for representation of animated graphical user interfaces. We look forward to actively participating in discussing how we could best proceed on this topic. We also commend the delegation of France for presenting the European Union “Convergence Programme 6: Graphical Representation of Designs” at this session.

7. During this meeting of the SCT, we will continue to move forward according to our recently established work programme in relation to geographical indications. We thank the Secretariat for preparing a compiled list of questions contained in document SCT/39/6 Rev. We are impressed by the number of questions and the quality of many of them. Its extent manifests the high level of interest of the Member States and intergovernmental organisations.
8. Turning to the text of the questions, we would like to encourage the Chair to consider a creative merging of the proposed list in order to reach to manageable length. We recall that we would prefer a targeted questionnaire aimed at collecting useful information on specific topics of concrete interest to users and industry, to allow meaningful discussions for the benefit of stakeholders. We also reiterate that the SCT work programme should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act. Furthermore, we would like to provide more detailed comments on the list of questions during the discussions concerning agenda item 7 on Geographical Indications.
9. 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**

39th Session

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Graphical User Interface, Icon and Typeface/Type font Designs

(SCT/39/2 and SCT/39/3)

Chair,

1. The EU and its Member States are pleased to recall that the information session held at the last SCT was a fruitful exercise. We gained good insights on practices in different jurisdictions and heard interesting experiences from relevant stakeholders. This provides valuable input for the Committee's subsequent discussions on this issue. We would like to thank the Secretariat for an excellent summary of the main points emerging from that information session contained in document SCT/39/2. We also thank Member States and accredited Non-governmental Organisations for submitting proposals regarding desirable further work on this topic, as compiled in document SCT/39/3.
2. As regards the latter document, we have studied these proposals with great interest and have two general comments. First, it appears to us the proposals are not convergent as to their scope. Some of them cover forms of graphical user interface, icon and typeface/type font designs which are already well-established and subject to design registrations, while others mainly deal with "new age" designs on the horizon such as designs projecting outward from laser keyboards, or graphics which have been projected onto a road from an automobile for pedestrians outside the automobile. We believe that the SCT should have a common understanding on what exactly we intend to cover in this work strand.

3. Secondly, we are of the view that although issues concerning “new age designs” are also interesting and relevant, there already exist problems to solve in the field of currently known forms of graphical user interface and icon designs. We believe that in seeking the way for the Committee to move forward with its work, we should have a phased approach and first channel discussions around existing and well perceptible differences that can, and should be, immediately addressed. Therefore, if we want to move forward at the global level, it would be more fortunate to limit ourselves to graphical user interface, icon and typeface/type font designs in order to find common understanding in the context of those existing designs. However, we also remain interested in hearing more about “new age designs” from user associations. That could guide our future work in the appropriate direction after we have been able to reach a common understanding on currently more prevailing issues.
4. In that framework of general comments, we now turn to specific proposals contained in document SCT/39/3. In particular, we would like to support proposal number 9 concerning “Requirement for a connection between graphical user interfaces and physical products for protection of GUIs by design rights, and for their depiction in applications”, and proposal number 10 concerning “Methods allowed for representation of animated GUIs”. In our understanding, these proposals directly address currently existing divergences and further work on these issues can pave the way for a more harmonised approach. We note that proposals 1 and 3 are also related to the connection between graphical user interfaces and the physical products to which they are applied. Therefore, it appears that future work on that topic is considered desirable by a number of participants in the SCT.
5. Along these lines, and recognising the economic importance of, and users’ increasing demand for, ensuring adequate protection for these new technological designs, we are supportive of considering further work on this topic. In our view, further work in the SCT on this topic should first of all focus on finding consensus about what can be protected under the current global IP regime, and how. We also remain open to exploring, at a later stage, the interesting issues about “new age designs” and how the IP framework can remain effective to ensure that future technological developments can be protected.

Thank you.

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

39th Session

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**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, SCT/39/8 and SCT/39/9)

Chair,

1. 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 would like to thank again other delegations, the Chair and the Secretariat for helping to define the focus of this morning's information session on office practices. The information session in the form of a moderated roundtable organised by the Secretariat was an interesting opportunity to learn about the various practices in place and the rationales underscoring those practices. All this information will certainly be useful for our discussions at this SCT.
2. We also note the new proposal contained in document SCT/39/8 Rev2. We acknowledge and commend the spirit of seeking consensus that is reflected in the proposal. At the same time, we would like to make some initial comments in order to seek clarification as to how the proposal would be implemented and applied in practice.
3. In particular, we would be interested to explore whether the proposal would necessitate any change in legislation either at the international or at the national or regional level, and whether it would be in conflict with some broadly accepted principles regarding descriptiveness.

4. We note with much interest that the proposal is also related to the Joint Proposal on protection of geographical indications and country names in the domain name system, as contained in document SCT/31/8 Rev.7. Against this backdrop, we would welcome some further explanation on what the new proposal would aim at as regards ongoing processes in ICANN, and what potential benefits it would imply in that context.

Furthermore, we note that the scope of the proposal extends not only to country names but also to geographical names of national significance. We would be interested to hear more from proponents on that particular feature.

5. As the EU and its Member States have stated in previous meetings, from the work already carried out by this committee it is clear that there are legal means available to secure protection in national legislations. The creation of a new “norm setting” instrument may not be the most appropriate way to address this issue. The SCT and its members should take into consideration other actions such as awareness raising, which should focus in particular on the availability of grounds for refusal or invalidation of trade marks containing country names and on the possibility of addressing the relevant issues in trade mark examination manuals.
6. We look forward to further explanations or clarifications on these issues and remain open to participate in discussions concerning the new proposal.
7. Finally, we note that another new proposal has been recently tabled by the delegation of Peru in document SCT/39/9. As we have not had the opportunity to study this detailed proposal, we are not yet in a position to give our views. We look forward to providing comments on it at the next SCT session.

Thank you.

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Geographical Indications

**(SCT/30/7, SCT/31/7, SCT/31/8 Rev7, SCT/34/6, SCT/38/4, SCT/39/6, SCT/39/6 Rev. Corr,
SCT/39/7)**

Mr Chair,

1. The EU and its Member States would again like to thank the WIPO Secretariat for organising the interesting and fruitful meeting at the last Committee. We acknowledge that the work at the last session gave value to the Committee and has been an example of constructive spirit allowing concrete results.
2. Turning to the Questionnaires, we thank the Secretariat for preparing a compiled list of questions contained in document SCT/39/6 Rev. We are impressed by the number of questions and the quality of many of them. Its extent manifests the high level of interest of the membership and intergovernmental intellectual property organisations. We are convinced that the Secretariat was correct to distribute all contributions without comment or editing. That has been an important step, as we progress this critical discussion on GIs in the SCT.
3. Turning to the text of the questions, which like others, we regard in its current form as rather unwieldy as a questionnaire, we would like to encourage the Chair to consider a creative merging of the proposed list in order to reach to manageable length. We recall that we would prefer a targeted questionnaire aimed at collecting useful information on specific topics of concrete interests to users and industry, to allow meaningful discussions for the benefit of stakeholders. We also wish to reiterate that it is important to ensure that the SCT work programme, in compliance with the SCT mandate, should not aim to interpret or revise the provisions of the Lisbon Agreement or the Geneva Act.

4. Having studied the compilation list of the questions in detail, we can see 4 areas for economy:
- some issues seem to fall outside of the scope of the present exercise and possibly could be dropped;
 - others look quite wide in scope and unclear and could present difficulties for all of us as Members in answering.
 - some questions cover essentially the same ground as others and could be merged.
 - other questions seem to duplicate work already completed by the previous SCT. We wonder if there is a real value added in reproducing, what is a reasonably well-known inventory of existing systems (see documents SCT/8/4 and SCT/9/4 from 2002).
5. In conclusion, Mr Chair, we are encouraged by the interest and substantial nature of the response to the Call for Questions. We now look to you and encourage you and the Secretariat, to fashion this raw material into an effective questionnaire that is manageable to answer and really will further our understanding of the state of GIs in the global arena. As a final step, SCT members should have the opportunity to validate the revised version of the Questionnaire before its distribution to Members.
6. In sum, we are heading in the right direction. But we need assistance from the Secretariat to convert this 'list of questions' into a coherent questionnaire. If the Secretariat can make a revised version, we would welcome seeing it already in this session.
7. With regard to the Survey prepared by the Secretariat on the existing state of play of GIs, country names and other geographical terms in the DNS as contained in document SCT/39/7, we certainly welcome and appreciate the effort to provide an objective overview of the situation in this complex and continuously evolving area.

8. While the document seeks to condense a lot of information in a concise form, we nevertheless believe that it would benefit from additional refinement and clarifications. We should not forget that the DNS is an area where an ecosystem of different stakeholders, including from the technical internet community, play an important role. The role of ICANN and of its Supporting Organisations and Advisory Committees, all of which play an important part in developing policies for generic top-level domains, country-code top-level domains and IP addresses, could be better reflected in the document.
9. One particular aspect mentioned in the document which in our view deserves more attention is the fact that “*unlike country names and other geographic terms, geographical indications are not as such addressed in ICANN’s Applicant Guidebook*”, which contains the set of rules governing the delegation of new gTLDs. As discussions in ICANN are now intensifying on possible changes in the Applicant Guidebook, we should consider ways in which this shortcoming could finally be addressed.

Thank you.

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Closing Statement

Mr Chair,

The EU and its Member States would like to congratulate you for making the SCT 39 such a success. Achieving consensus on the Questionnaire on Geographical Indications at this session as scheduled in the adopted Work Programme is a significant achievement. We would like to highlight the role of the Secretariat and commend their excellent work which has allowed our proceedings to run so smoothly.

We also made good progress on furthering understanding on the issues surrounding country names. We thank the Secretariat for organising the highly informative roundtable. We also thank the proponents of recently tabled proposals for providing further clarification.

We are content with the progress made on the topic of GUIs. We believe that the Committee managed to find the right focus for further work on these issues.

Finally, on this World Intellectual Property Day we would like to salute all delegations for maintaining the constructive spirit shown at our last session.

We are hopeful that the SCT will continue to have fruitful discussions on all three key topics at SCT 40.

Thank you.
