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Subject:	40th Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indication (SCT) (Geneva, 12-16 November 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**

40th Session

(WIPO, Geneva, 12–16 November 2018)

Opening Statement

Chair,

1. The EU and its Member States would like to welcome you in the role of Chair and we wish you every success in guiding our work this week. We would also like to thank the Secretariat for its excellent preparatory work for this session.
2. Looking back to the previous SCT session, we recall with appreciation some good progress made and the constructive spirit shown by all delegations. We believe that the finalisation of the questionnaires on Geographical Indications was a significant achievement and we would like to thank the Secretariat again for its substantial assistance in the process. Another important result was the agreement on the focus of future work concerning Graphical User Interface designs (GUIs). We believe that the Committee took the right choice in prioritising issues concerning the requirement for a link between GUIs and the product and the representation of animated designs. We also made some progress on furthering understanding on the topic of country names, both by means of a moderated roundtable discussing office practices and of some initial discussions on a new compromise proposal on this issue, contained in document SCT/39/8 Rev. 2.
3. Looking at the agenda of this meeting, first as regards industrial designs, we refer to the discussions held in relation to the Design Law Treaty during the General Assembly this year. Despite our willingness to engage in discussions on the facilitator's text, we had to note with regret that again this year no positive decision to convene a diplomatic conference could be achieved. We therefore reiterate our position that discussions on the DLT should not be held in this Committee.

4. In relation to GUIs, the Secretariat has prepared a draft questionnaire on the basis of the received inputs and questions, which is contained in document SCT/40/2. The EU contributed to the draft questionnaire with a description of the practice applied by the European Union Intellectual Property Office and the common practice on the graphical representation of designs developed with the EU Member States within the European cooperation network. We would like to thank the Secretariat for preparing the draft questionnaire in a clear, coherent and sufficiently detailed manner. We can support the draft questionnaire to serve as the basis for further work on selected pertinent issues concerning GUIs.
5. As regards the topic of trademarks, we would like to thank the Secretariat for preparing a Summary of the various examination practices regarding trademarks consisting of, or containing, country names, as contained in document SCT/40/3. We find that the summary accurately captures the main points emerging from the roundtable and we agree with its conclusions.
6. As to the joint proposal contained in document SCT/39/8 Rev.2, we made some initial comments at the last session in order to seek clarification as to how it would be implemented and applied in practice. We reiterate our appreciation of the spirit of seeking consensus that is reflected in the proposal and we are ready to participate in continued discussions to further explore its potential advantages. We also note a new proposal contained in document SCT/39/9 that was submitted at the last session by the delegation of Peru, concerning the recognition and protection of nation brands. We will make some initial comments regarding this proposal in the discussions concerning Item 6 of our agenda.
7. Finally, turning to geographical indications, the EU and its Member States submitted responses to both questionnaires following the last session. We welcome the provisional compilations of replies to Questionnaire I on the national and regional systems that can provide a certain protection to geographical indications and Questionnaire II on the use/misuse of geographical indications, country names and geographical terms on the Internet and the DNS, as contained in documents SCT/40/5 Prov. 2 and SCT/40/6 Prov. 2. We realise they do not comprise all contributions and thank the Secretariat for the work done so far and hope that they will be in a position to complete the task in due course before SCT 41. As we are not at the end of the Work Plan adopted at SCT 38, we regard this as a stocktaking exercise.

8. We can see already that the compilations will prove useful in informing debates on GIs in this forum and elsewhere for the countries covered. In respect of Questionnaire II, we note that protection systems for GIs in the DNS and on the internet, while they exist to a limited extent, are not well developed. Once the documents have been completed, in our view, it is opportune for the SCT to continue to work on the improvement of GI-protection and discuss the protection of GIs on the Internet and in the DNS, given that many issues still need to be addressed at the international level.
9. Chair, the EU and its Member States are hopeful to have a successful meeting under your guidance. We look forward to continuing work and contributing constructively in discussions in all three key areas of the SCT.

Thank you.

Graphical User Interface, Icon and Typeface/Type font Designs (SCT/40/2)

Chair,

1. Following a successful information session on Graphical User Interface (GUI), icon and type face/type font designs, at its last session the SCT looked into proposals for future work. Most delegations including the EU and its Member States were in favour of further work on the tie between the product and the design and on how that affects the scope of protection, as well as on representation of animated GUIs. We shared common understanding that currently existing divergences should be directly addressed and further work on these issues can pave the way for a more harmonised approach. At the same time, it appeared to be the majority view that issues concerning novel technological designs could be undertaken in a subsequent phase. We were content with the progress made at the last session and believe that the Committee managed to find the right focus for further work on GUIs.
2. In accordance with the decision taken at the last session, the Secretariat has prepared a draft questionnaire on the basis of the received inputs and questions, which is contained in document SCT/40/2. The EU contributed to the draft questionnaire with a description of the practice applied by the European Union Intellectual Property Office and the common practice on the graphical representation of designs developed with the EU Member States within the European cooperation network. We would like to thank the Secretariat for preparing the draft questionnaire in a clear, coherent and sufficiently detailed manner. We can support the draft questionnaire to serve as the basis for further work on selected pertinent issues concerning GUIs.
3. As regards the decision taken at the last session on a further exchange of views on related matters, such as other novel technological designs, we reiterate our view that although issues concerning novel technological 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 continue to believe that we should have a phased approach and first channel discussions around existing and well perceptible differences that can, and should be, immediately addressed. However, we also remain interested in hearing more about novel technological 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.

Thank you.

Protection of Country Names against Registration and Use as Trademarks
(SCT/32/2, SCT/39/8 Rev.2, SCT/40/3, SCT/37/3 Rev., SCT/38/2 and SCT/39/9)

Chair,

1. On the topic of country names, the information session in the form of a moderated roundtable organised by the Secretariat at the last session was an interesting opportunity to learn about the various practices in place and the rationales underscoring those practices. We would like to thank the Secretariat for preparing a Summary of the various examination practices regarding trademarks consisting of, or containing, country names, as contained in document SCT/40/3. We find that the summary accurately captures the main points emerging from the roundtable and we agree with its conclusions.
2. At the last session of the SCT we also noted the joint proposal contained in document SCT/39/8 Rev.2, and we made some initial comments in order to seek clarification as to how it would be implemented and applied in practice. The EU and its Member States would like to thank the delegation of Switzerland and other proponents for providing more information in this respect. In particular, we note with interest that the proposal would not imply any legislative exercise, nor does it envisage any disruption of existing practices on descriptiveness. We reiterate our appreciation of the spirit of seeking consensus that is reflected in the proposal and we are ready to participate in continued discussions to further explore its potential advantages.
3. A new proposal that was submitted at the last session by the delegation of Peru, contained in document SCT/39/9, concerns the recognition and protection of nation brands. We have studied this proposal thoroughly, and in our understanding it aims at establishing protection that would be provided for signs not only consisting of country names but could include, for example, any figurative elements, in any combination therewith. Therefore, it appears that the underlying concept of “nation brand” would greatly extend considerations taken into account when protecting symbols of sovereignty in the strict sense. Furthermore, the protection to be provided for nation brands would not be limited to any specific product or service, and it would be indefinite in time, while at the same time nation brands would not be subject to any use requirements as a condition for maintaining their recognition and protection.

4. In our opinion, such protection would be extraordinarily strong without any conceivable balances to safeguard the interests of the holders of trademarks, trade names, banners, slogans, geographical indications or other signs the registration of which could be refused even ex officio.
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 for country names in national legislations. We reiterate that the creation of a new “norm setting” instrument may not be the most appropriate way to address this issue. While acquiring further knowledge of the issues involved 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 trademarks containing country names and on the possibility of addressing the relevant issues in trade mark examination manuals.
6. In this context, we would like to inform the Committee that EUIPO has recently held a roundtable with the IP offices of the EU on country names in the framework of the Liaison Meeting on Trade Marks. Discussions concerned issues of distinctiveness and descriptiveness, and of how the criterion of the reputation of the country in respect of the goods or services specified in the application is assessed. We will keep the SCT informed about any further developments on this ongoing process.

Thank you.

Geographical Indications

(SCT/30/7, SCT/31/7, SCT/31/8 Rev8, SCT/34/6, SCT/40/5 Prov.2, SCT/40/6 Prov.2)

Chair,

1. The EU and its Member States would again like to thank the WIPO Secretariat for producing the provisional compilation of replies to Questionnaires I and II respectively.
2. Already in the responses to Questionnaire I compiled so far, we see a wealth of information on systems and instruments used to protect GIs. While this is not the first such survey, it is surely the most up-to-date. It will prove useful in informing debates on GIs in this forum and elsewhere for the countries covered. In respect of Questionnaire II, we note that protection systems for GIs in the DNS and on the internet, while they do exist to a limited extent, are not well developed.
3. As these are provisional documents, we understand that we have not come to the end of the Work Plan adopted at SCT 38 and that work should be accomplished at SCT 41.
4. At that point we shall need to consider the next steps. In our view, it is essential that the SCT continues to work focusing on specific topics related to the protection of GIs in the DNS and on the Internet, given that many issues still need to be addressed at international level.
5. In conclusion, we commend the work of Members, who have contributed, and of the Secretariat for the compilation and look forward to seeing the final versions of Documents SCT/40/5 and SCT/40/6, including all missing contributions and late submissions, in time for our next meeting.

Thank you.

Closing statement

Chair,

1. The EU and its Member States would like to congratulate you for guiding us through our agenda successfully this week. We note with appreciation that we have moved forward on all key topics at this meeting.
2. We welcome the finalisation of a Questionnaire focussed on pertinent issues related to Graphical User Interface designs. We would like to thank the Secretariat for their efforts to take on board all comments made by delegations at this meeting, as reflected in document SCT/40/2 Rev.
3. We also made some progress in seeking a compromise solution as regards the issue of country names. Our informal discussions have helped identify some outstanding issues concerning the joint proposal contained in document SCT/39/8 Rev.2. We thank the proponents, in particular the delegation of Switzerland, for their efforts to facilitate reaching consensus and for preparing the non-paper discussed at this session. We are open to continue discussions on this issue.
4. On the topic of Geographical Indications, we all agree that further work is desirable on the basis of the wealth of up-to-date information compiled by the Secretariat. We are hopeful that the provisional compilations prepared for this session can be finalised by our next meeting, thus also completing available information. We thank the Chair for offering flexibility in our discussions to address the continuation of work, in particular as regards some means of methodology and the selection of topics to structure our future work. We look forward to discussing next steps at SCT 41.
5. Finally, we would like to thank all delegations for maintaining the positive spirit shown at our recent SCT sessions. We are hopeful that this Committee will continue to have fruitful discussions on all three key areas at our next meeting.

Thank you.