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#### NOTE

From:	General Secretariat of the Council
To:	Delegations
No. prev. doc.:	7120/24 REV1
Subject:	47th Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (Geneva, 18-20 March 2024) - Final EU/Member States statements

Delegations will find at annex, for information, the EU/Member States statements as delivered at the above-mentioned WIPO meeting.

**47th Session of the WIPO Standing Committee on the Law of Trademarks,  
Industrial Design and Geographical Indication (SCT)**

**(Geneva, 18-20 March 2024 – hybrid format)**

**Agenda Item 5 – 1<sup>st</sup> indent**

**Industrial Designs**

**Updated Proposal by the Delegations of Canada, Israel, Japan, the Republic of Korea, the  
United Kingdom, the United States of America and the European Union and its member  
states for a Joint Recommendation Concerning Industrial Design Protection for Designs for  
Graphical User Interfaces**

(Document SCT/44/6 REV.4)

Chair,

1. Regarding the topic of Graphical User Interface (GUI), icon and type face/type font designs, the EU and its Member States continue to be convinced that currently existing divergences should be directly addressed and further work on these issues can pave the way for a more harmonised approach.
2. As regards future work on this topic, we reiterate our endorsement of adopting the joint recommendation in document SCT/44/6 REV.4 as a practical way forward. While being non-obligatory for Member States, it would provide for at least a common base line for GUI protection and would further contribute to the modernisation of practices on designs.
3. Chair, we look forward to working together with other delegations to finalise the recommendations in order to foster a more harmonised approach.

Thank you.

## **Agenda Item 5 – 2<sup>nd</sup> indent**

### **Industrial Designs**

#### **Proposal by the African Group for a Study on the Impact of Design Protection for Graphical User Interface (GUI) Designs on Innovation**

(Document SCT/46/5)

Chair,

1. The EU and its Member States would like to thank the African Group for presenting their proposal in document SCT/46/5.
2. The EU and its Member States are not opposed in principle to conducting such a study, however, we would like to point out that the majority of topics envisaged for the study have already been studied through the questionnaires prepared by the WIPO Secretariat, the results of which have been published in documents SCT 37/2 Rev. and SCT/41/2 Rev.
3. It is also paramount that any inquiry into the impact of design protection of graphical user interface designs be based on objective criteria that allows collecting fact-based empirical data.
4. In light of the above, the EU and its Member States believe that opening the previous questionnaires for further responses would create a more solid basis for further work and we look forward to learning about legislative developments and new practices from all Member States.

Thank you.

## **Agenda Item 5 – 1st and 2nd indent**

### **Industrial Designs**

(Additional statement after informal session)

Chair,

1. The EU and its Member States would like to thank once again the African Group for presenting their proposal in document SCT/46/5.
2. While we can understand the need to gather additional information before taking a decision on supporting the joint recommendation, we would like to reiterate the following two considerations.
3. First, the adoption of the joint recommendation would not create any legal obligation for Members to adopt or follow it. Secondly, a substantial amount of information has already been made available by way of the questionnaires that were open for answering to all Members. While we are not opposed to opening the questionnaires for a further round of answers, we believe it is unlikely that the new answers would lead to a substantial revision of the recommendation. Therefore, from our perspective, additional information is not necessary for the adoption of the joint recommendation.
4. In light of the above, the EU and its Member States propose to continue working on these two topics in parallel, that is to proceed with adopting the joint recommendation while the study as proposed by the Chief Economist is being undertaken.

Thank you.

## **Agenda item 6 – 1<sup>st</sup> indent**

### **Trademarks**

#### **Revised Proposal by the Delegations of Georgia, Iceland, Indonesia, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland and the United Arab Emirates Concerning the Protection of Country Names and Geographical Names of National Significance**

(Document SCT/43/6 REV.2)

Chair,

1. The EU and its Member States would like to thank the co-sponsors for preparing a revised proposal. We appreciate all the efforts made to take into account comments made by other delegations.
2. We continue to be supportive of any endeavour that would neither imply a legislative exercise nor envisage diverging from existing practices on descriptiveness and distinctiveness. With that caveat, we have studied amendments in the revised proposal with interest.
3. Most importantly, we still believe that the logical basis of the trademark system should be the freedom of registration of trademarks, and not the opposite, provided that the sign in question is distinctive, non-descriptive and not misleading.
4. Nevertheless, it appears, that the latest amendments make it clear that the proposal would accommodate existing practices on descriptiveness and distinctiveness, including the approach established by EU jurisprudence. Under this approach, trademark applications containing a country name or geographical name need to be analysed in order to establish whether they have distinctive character. If the relevant consumer is considered not to identify the sign as a country name or geographical name, but instead perceive it as a distinctive badge of commercial origin in relation to the goods or services in question, the application should not be rejected. We therefore welcome the fact that the revised proposal does not foresee rejecting an application solely on the basis that the sign concerned is a recognised country name or a geographical name of national significance.

5. Once again, we thank the co-sponsors for taking on board these considerations. In order to reach a consensus and to address our remaining concerns, the EU and its Member States would like to invite the committee to explore the following options.
6. First, we believe that the concept of acquisition of distinctive character should be explicitly mentioned in the proposal as a case where the trademark is not perceived by the public as a country name or a geographical name of national significance. Acquired distinctiveness is an important and widely accepted concept of EU trademark law that cannot be overlooked in the daily practice of IP offices. For this reason, we propose to amend the first indent of point 4 paragraph (a) of the proposal with the following wording: “[...] *This is for instance the case when the country name as used in the mark is translated or transliterated in a language which is unknown to a large majority of the relevant public **or when it has acquired distinctive character through its use as a trademark in the territory of application; or [...]***”
7. Secondly, we propose to change the title of the proposal to “Joint Recommendation”, instead of “Examination Guidelines” as this would be more in line with the nature of the proposal. Examination guidelines are usually documents published by IP offices that describe the practice of the office in broad cases, targeting users and serves information purposes only. Using this term could also give the impression that substantive examination of trademark applications is carried out by WIPO, which is not the case.
8. Thirdly, we believe that the proposal should contain a preamble outlining its context, stating its purpose and the issue it aims to address. In this respect a joint recommendation may also be more adequate, as it makes clear the lack of legal binding force of the proposal.
9. We look forward to continuing working with the sponsors to finalise the proposal, based on the fruitful bilateral exchanges we have had during this session.

Thank you.

## **Agenda Item 6 – 4<sup>th</sup> indent**

### **Trademarks**

#### **Returns to the Questionnaire on Nation-Brand Protection in Member States**

(Document SCT/43/8 REV.4)

Chair,

1. The EU and its Member States would like to thank the Secretariat for preparing a revised compilation of returns to the Questionnaire on Nation Brand Protection in Member States. We also thank Members that submitted 20 new or updated responses and we welcome that the compilation now contains 78 returns overall.
2. We continue to have the favourable impression that nation brands identified in the responses can benefit from being protected as trademarks as well as by means of Article 6ter of the Paris Convention and significant problems relating to the protection of such identified national brands are not immediately apparent from the responses.
3. We are looking forward to hearing the views of other delegations and we remain open to continue exploring the state of play as regards nation brand protection in Member States.

Thank you.

## **Agenda Item 6 – 5<sup>th</sup> indent**

### **Trademarks**

#### **Update on Trademark-Related Aspects of the Domain Name System (DNS)**

(Document SCT/47/2)

Chair,

1. The EU and its Member States would like to thank the Secretariat for preparing document SCT/47/2.
2. We continue to attach great importance to the protection of intellectual property rights in the online environment, including the domain name system. In this regard, we welcome the continued efforts of the WIPO Arbitration and Mediation Center, especially its commitment to working with stakeholders to attempt to safeguard the observance of general principles of IP protection in new generic top-level domains; and the planned report on jurisprudential and operational experiences with the Uniform Domain Name Dispute Resolution Policy (UDRP).
3. We would also like to stress the importance of the protection of non-trademark identifiers, especially geographical indications in the domain name system, as mentioned in paragraphs 17-24 of the report. This is crucial to safeguard interests of IP right holders, especially in light of the 2023 decision taken by the ICANN Board to open the next round of applications for new generic top-level domains. For the same reason, we consider it timely to renew long standing discussions within WIPO regarding the incorporation of geographical indications into the UDRP.
4. In the EU, Regulation 2023/2411 on the protection of geographical indications for craft and industrial products will require country-code top-level domain name registries to ensure that any alternative dispute resolution procedures for domain names recognise registered geographical indications as a right that can be invoked in those procedures. The Regulation will be applicable from 1 December 2025. The same provision is included in the revised Regulation on the protection of geographical indications for agricultural products and foodstuffs, wine and spirit drinks which is expected to enter into force in the spring 2024.

Thank you.



## Agenda Item 7

### Geographical Indications

Chair,

1. The EU and its Member States would like to thank the Secretariat and Members of the SCT for their continuous work in preparing and delivering the information sessions on geographical indications and thank the Secretariat for preparing doc. SCT/47/2.
2. For the next information session, we would like to propose the following topic: *“Recognition of geographical indications as valid rights in the domain name dispute resolutions procedures: recent developments and prospects”*. GIs are not recognized as valid rights under the Uniform Domain Name Dispute Resolution Policy (UDRP) administered by ICANN and the discussions at WIPO have not progressed to concrete proposals for a long time. Therefore, these recent developments could also pertain to the future revision of the UDRP, and the potential challenges associated with incorporating GIs into this system. This topic would be a good opportunity to reopen discussions in the info session on the prospects and needs for GIs being included in the UDRP.

Thank you.

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