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NOTE

From: General Secretariat of the Council
To: Delegations

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Subject: 43rd Session of the WIPO Standing Committee on the Law of Trademarks,
Industrial Designs and Geographical Indications (SCT) (Geneva,
23-26 November 2020)
- 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.

**43rd Session of the WIPO Standing Committee on the Law of Trademarks,
Industrial Design and Geographical Indication (SCT)**

(Geneva, 23-26 November 2020)

Agenda Item 1

Opening Statement

(submitted in writing)

Chair,

1. The EU and its Member States would like to congratulate you and your Vice-Chairs on your election and 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. With regard to participation in WIPO treaties, we are pleased to recall that on 26 November 2019 the EU deposited its instrument of accession to the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications. We welcome the recent entry into force of the Geneva Act of the Lisbon Agreement as a decisive step towards the establishment of a truly global, efficient and comprehensive protection system. We encourage therefore other WIPO Member States to accede as well.
3. Looking at the agenda of this session, first as regards industrial designs, we refer to the discussions held in relation to the Design Law Treaty during the 2019 General Assembly. We were pleased to engage in informal discussions initiated by the circulation of the facilitator's proposal for a possible compromise solution on outstanding issues. Nevertheless, we have to note with regret that again, no positive decision to convene a diplomatic conference on the adoption of a Design Law Treaty could be achieved and that the matter remains on the agenda for the extraordinary session of the General Assembly in the first half of 2021.

4. In relation to Graphical User Interfaces (GUIs), following the launch of a Questionnaire finalised at SCT 40, we endorsed the further extension of the deadline to submit additional responses by 10 January 2020. We would like to thank SCT members for further contributions and the Secretariat for compiling all responses received in document SCT/41/2 Rev. We also thank the Secretariat for preparing an analysis of all returns as contained in document SCT/43/2. This analysis provides a very valuable summary and we support the conclusions in point 105 of the document.
5. Concerning future work on this topic, at the last SCT session we noted with much interest the proposal submitted by the delegations of Japan and the United States of America in document SCT/42/6. We appreciate that this proposal remains on the table, as we endorse the aim of adopting this joint recommendation as a practical way forward to achieve a more harmonised approach in relation to industrial design protection for GUI designs. We reiterate our support for the rationale to provide for at least a common base line for GUI protection. At the same time, in our opinion the recommendations should leave it open for legislations to provide for more tailored or more advanced protection for GUIs than such a base line. In other words, the recommendations should only establish a common ‘floor’ but not a ‘ceiling’. We would like to make more detailed comments under Agenda item 5 and look forward to continuing discussions on this proposal.
6. As regards the topic of temporary protection provided to industrial designs at certain international exhibitions under Article 11 of the Paris Convention, at the last session we proposed the organisation of an information session to explore users’ needs and national experiences, and to share best practices among offices. We thank the Secretariat for organising such information session during this week and hope that it will prove to be a useful exercise.

7. Turning to the topic of trade marks, on the issue of country names we would like to thank the delegations of Georgia, Iceland, Indonesia, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland and the United Arab Emirates for preparing the proposal contained in documents SCT/43/6. We have studied this proposal with interest and we would like to make some initial technical comments under Agenda item 6. At the same time, we would like to seek some general clarification from the co-sponsors about the relationship between this proposal and previous proposals SCT/32/2 and SCT/39/8 Rev 3. We look forward to participating in discussions on this new proposal during this session.
8. As to the topic of nation-brand protection, we would like to thank the Delegations of Peru, Australia, Brazil, Ecuador and Switzerland for their contributions to the draft Questionnaire. We also thank the Secretariat for preparing a first compilation of questions in document SCT/43/3 Rev and for taking on board comments from members and observers, including comments from the EU, in the finalised Questionnaire on Nation Brand Protection in Member States in document SCT/43/7. We therefore welcome document SCT/43/8 containing the returns to the questionnaire by 45 respondents including the EU. We look forward to discussing the new document under Agenda item 6.
9. Finally, turning to geographical indications, we welcome the decision to organise an information session at this meeting to discuss two topics submitted by proponents of the lists of topics tabled at SCT 42. We look forward to engaging constructively on both selected topics in order to further clarify those topics.
10. Chair, the EU and its Member States are confident 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.

Agenda Item 5, 4th indent

Industrial Designs

Analysis of the Returns to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs

(SCT/43/2)

Chair,

1. As to the Questionnaire on Graphical User Interface (GUI), icon and type face/type font designs, the EU and its Member States welcomed the decision at the last SCT session that the Questionnaire should remain open for members to submit additional responses to further expand the volume of information available. We would like to thank SCT members for further contributions.
2. We also thank the Secretariat for preparing an analysis of all returns as contained in document SCT/43/2. This analysis provides a very valuable summary and we support the conclusions in point 105 of the document.
3. We would only like to make an editorial comment on point 102. It appears that the indication of the percentage of offices that accept documents for priority claim purposes in paper format only as indicated in the first bullet point (98%) is not in line with the corresponding indication underneath (31%).
4. We reiterate our view that in all the responses we see a wealth of information which will no doubt prove useful in further debates on GUIs, icons and typefaces in the committee. Therefore, we can fully support document SCT/43/2 to be used as reference for further work on selected pertinent issues for such designs.

Thank you.

Agenda Item 5, 5th indent

Industrial Designs

Proposal by the Delegations of Japan and the United States of America

(SCT/42/6)¹

Chair,

1. As to the topic of Graphical User Interface (GUI), icon and type face/type font designs the EU and its Member States share the 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.
2. As regards future work on this topic, at the last SCT session we noted with much interest the proposal submitted by the delegations of Japan and the United States of America in document SCT/42/6. We welcomed this new initiative and endorsed the aim of adopting this joint recommendation as a practical way forward to achieve a more harmonised approach in relation to industrial design protection for GUI designs.
3. We reiterate our support for the rationale to provide for at least a common base line for GUI protection. At the same time, in our opinion the recommendations should leave it open for legislations to provide for more tailored or more advanced protection for GUIs than such a base line. In other words, the recommendations should only establish a common ‘floor’ but not a ‘ceiling’. We consider this concept to be relevant, in particular, in the context of Recommendation 6, according to which GUI design applications shall be examined ‘under the same criteria’ as other types of design applications; and of Recommendation 8, according to which rights granted to GUI designs ‘shall not differ’ from rights granted to designs for other products. In our view, the recommendations should not inhibit or prevent members from providing specialised protection for GUIs.

¹ The delegations of Japan and the USA tabled a new version (SCT/43/10) of document SCT/42/6 a few days before the SCT meeting. The EU statement is based on SCT 42/6.

4. Another general comment we would like to make is that we support the observation of Spain submitted at the last session about the importance of addressing divergences as to formal requirements. Therefore, we welcome the fact that recommendation 3 already covers some formal requirements with regard to formats of representation. In addition, it should be ensured that the required minimum and maximum number of views for industrial design applications for GUI designs permit an accurate design representation. Formal aspects are relevant not only for the appropriate representation of GUIs (e.g. with respect to animation) but also for the interoperability of jurisdictions by means of priority claims. With particular reference to questions in the survey on GUIs addressing methods of representation and applicable formal requirements, we wonder if the recommendations could perhaps cover these aspects as well.
5. Finally, we would like to seek some clarification from co-sponsors as to Recommendations 2 and 4. First, as regards Recommendation 2 it is not clear to us what is meant by the wording ‘how the GUI was installed on a product’. This is mentioned as a criterion irrespective of which design protection shall be afforded to GUIs. Whereas we understand that the other two such criteria, ‘operating status of the underlying electronic device’ and ‘the amount of time the design is visually available’ are related to the merely transitional display of a GUI, we are not certain how this last element should be interpreted. We would like to ask for clarification whether it refers to the concept that protection for the underlying software does not extend to the graphic display produced by it, and vice versa.
6. Second, as regards Recommendation 4 it is not clear to us whether this provision allows for a party to require a product indication where such indication does not affect the scope of protection afforded to the GUI design, as it is the case for the EU’s design system.
7. Third, even if we agree on the overarching idea of having an independent design protection for GUIs pursuant to recommendations 2 and 4, we should bear in mind that aspects such as ‘the amount of time the design is visually available’ or ‘the use in multiple screen display environments’ can play a crucial role for the examination of the material requirements for design protection. The visibility of a design when used as intended and the way it is used and presented in different display environments can be important for determining whether the design is new or has individual character as well as for assessing an infringement of a design. A clarification at this point could be helpful.

8. We look forward to continuing discussions on this proposal and stand ready to work together with the proponents and other delegations to foster a more harmonised approach.

Thank you.

Agenda Item 5, 7th indent

Industrial Designs

Update by Member States on Digital Access Service (DAS) for Priority Documents

Chair,

The EU and its Member States would like to inform the SCT that EUIPO has been implementing WIPO Digital Access Service (DAS) as ‘office of first filing’ since July 2020, and as ‘office of second filing’ since September 2020.

Thank you.

Agenda item 6, 1st indent

Trade Marks

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

(SCT/43/6)

Chair,

1. On the topic of country names, the EU and its Member States would like to thank the delegation of Switzerland and other proponents for preparing the proposal contained in document SCT/43/6.
2. We have studied this new proposal with interest. First, we would like to seek clarification from the co-sponsors about the relationship between this new proposal and previous proposals SCT/32/2 and SCT/39/8/Rev 3. We would welcome an attempt to merge some concepts underlying previously submitted and long debated proposals on the table. We also would appreciate the effort to simplify discussions by reducing the number of competing revised proposals and we commend the spirit of seeking consensus reflected in this new joint proposal.
3. As we commented before, we continue to appreciate any endeavour that would neither imply a legislative exercise nor envisage any disruption of existing practices on descriptiveness and distinctiveness. With that caveat, we would like to seek clarification from the co-sponsors about whether their new revised proposal aims at establishing new grounds for refusal in trademark laws.

4. As to our more technical comments, firstly, we note that the proposal puts on equal footing country names and geographical names of national significance for the purpose of the examination of trademark applications. This raises concerns for us. As we have informed the SCT previously, the EUIPO has already adapted its practice in a way that reflects the recognition of more enhanced protection for country names. Nevertheless, it appears problematic for us to have the same approach to the much broader and less homogenous category of ‘geographical names of national significance’. As to this category, it is to be highlighted that our examination practice as supported by case law of the Court of Justice of the EU differentiates the concept of Geographical Indications from a ‘simple indication of geographical provenance’. For the latter, there is no direct link between a specific quality, reputation or other characteristic of the product and its specific geographical origin.
5. Secondly, we wonder why the criteria listed in points 5(b)(i)-(iv) to be applied in respect of misleading signs are not referred to in respect of non-distinctive signs in point 4. We notice the distinction of, on the one hand, stronger protection in case of trade marks consisting solely of a country name or a geographical name of national significance and, on the other hand, a more flexible approach in case of trade marks containing a country or a geographical name of national significance. It is our view, however, that considerations such as whether or not the name has lost its geographical meaning or is perceived as a fanciful name are of equal relevance in assessing both non-distinctiveness and misleading character. Furthermore, in our opinion the goods and services should not be considered irrelevant in the case of non-distinctive signs but instead, like in the case of misleading signs where the goods and services are referenced in both points 5(a) and 5(b)(ii), they could in principle be taken into consideration.
6. With these initial comments made, we look forward to continuing discussions on this new proposal and stand ready to further explore it in cooperation with the co-sponsors and other delegations.

Thank you.

Agenda Item 6, 6th indent

Trade Marks

Proposal by the Delegations of Ecuador and Peru to conduct a Survey on Nation-Brand Protection in Member States

(SCT/42/4, SCT/43/3 Rev., SCT/43/7 and SCT/43/8)

Chair,

1. The EU and its Member States would like to thank the Delegations of Peru, Australia, Brazil, Ecuador and Switzerland for their contributions to the draft questionnaire on nation-brand protection. We also thank the Secretariat for preparing a first compilation of questions in document SCT/43/3 Rev. and for taking on board comments from members and observers, including comments from the EU, in the finalised Questionnaire on Nation Brand Protection in Member States in document SCT/43/7. We therefore welcome document SCT/43/8 containing the returns to the questionnaire by 45 respondents including the EU.
2. Having studied the returns to the questionnaire with interest, we are happy to have the impression that nation brands identified in the responses can benefit from being protected as trade marks 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 7

Geographical Indications

Compilation 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 in the DNS

(SCT/40/5 and SCT/40/6)

Chair,

Responding to your request to delegations to suggest topics for discussion at the next information sessions on Geographical Indications, the EU proposes the following: *'Ways to prevent bad faith registration of domain names consisting of or containing GIs'*. The idea behind this proposed topic is to focus the discussion on the risk that the allocation of a GI as a 'domain name' within the DNS to bad-faith operators implies for the GI's reputation or otherwise undermines the GI. For example, under this topic, we would hope to address questions such as: what kinds of risks to GI usurpation stem from the allocation of the new 'generic top-level domains'? How many of these generic-top-level domains are being released and when?

Thank you.

(The following statement has been submitted in writing)

Chair,

1. The EU and its Member States express their thanks and congratulations to the Secretariat for having completed the compilation of the replies to the two Questionnaires on geographical indications and for publishing the on-line database on the SCT webpage.

2. We consider this process has been a valuable and constructive exercise in advancing the international debate on geographical indications. We look forward to the exercise to be continued with topics to be addressed in information sessions that we consider highly productive and informative.
3. On the issue of the treatment of geographical indications on the internet, the EU believes that it is an area where there are significant lacuna, unjustified divergences from treatment of other forms of IPR, and of global significance. We look forward to further exploring this matter under the information session on Tuesday 24 November.
4. We consider information sessions should be advanced, in particular to address relevance of geographical indications for developing countries' economies and for empowering women farmers. We have transmitted proposals for further topics to the Secretariat.

Thank you.
