



Council of the
European Union

061860/EU XXVII. GP
Eingelangt am 21/05/21

Brussels, 21 May 2021
(OR. en)

9011/21

PI 39

NOTE

From:	General Secretariat of the Council
To:	Delegations
No. prev. doc.:	8352/1/21 REV 1
Subject:	44th Session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (Geneva, 17-19 May 2021) - 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.

**44th Session of the WIPO Standing Committee on the Law of Trademarks,
Industrial Design and Geographical Indication (SCT)
(Geneva, 17-19 May 2021)**

Agenda Item 5, 1st indent

Industrial Designs

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

(Documents SCT/41/1 Rev. 2 and SCT/43/2 Rev.)

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 containing 21 new or updated replies.
2. We also thank the Secretariat for revising the analysis of all returns as contained in document SCT/43/2 Rev. This analysis provides a very valuable summary and we support the conclusions in point 106 of the revised document.
3. We reiterate our view that in all the responses we see a wealth of information that will no doubt prove useful in further debates on GUIs, icons and typefaces in the committee. In particular, we welcome that highly relevant information has been thus available for helpful references made in the revised joint proposal by Israel, Japan and the United States of America on this topic, as contained in the endnotes to draft Recommendations in document SCT/43/10 Rev.
4. We can fully support document SCT/43/2 Rev to be used as reference for further work on selected pertinent issues for GUI designs.

Thank you.

Agenda Item 5, 2nd indent

Industrial Designs

Revised Proposal by the Delegations of Israel, Japan and the United States of America

(Document SCT/43/10 Rev.)

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 welcomed the proposal submitted by the delegations of Japan and the United States of America in document SCT/42/6. We 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, reiterating our support for the rationale to provide for at least a common base line for GUI protection. We also made some technical comments on that initial proposal.
3. We would like to thank the delegations of Israel, Japan and the United States of America for the revised proposal in document SCT/43/10 Rev. In general, we welcome the revised proposal and find that amendments have been made in the right direction. We support that the proposal has revised the draft recommendations to emphasize the non-obligatory nature of the joint recommendation, and to highlight in the footnotes the correlating questions and responses from WIPO SCT questionnaires relating to the particular subject matter. We also appreciate that the proponents have incorporated some recommendations on drafting language. Furthermore, we can endorse new Recommendations 6 and 7.

4. Going into more detail on previously discussed text, as to Recommendation 2 providing that industrial design protection is independent of operational/temporal limitations, we would like to thank the proponents for inserting endnote 6 to clarify that sufficiency of disclosure requirements regarding the visual characteristics of the design itself in the Party still would not be affected. At the last session, we commented 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. We also noted that 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. In this context, we consider the clarification in endnote 6 as helpful but not as sufficient. We suggest the following language for endnote 6:

„For greater clarity, sufficiency of disclosure or visibility requirements regarding the characteristics of the design itself in the Party still would not be affected.“

5. As to Recommendation 3 on the format of representation, we thank the proponents for inserting additional text providing flexibility for a Member State to require that a design for a GUI be represented by a single type of format of representation in each application, as well as for inserting endnote 8 to clarify that Member States may require applicants to avoid mixing formats of representation, such as combining colour and black and white photographs or combining line drawings and photographs, at their discretion.
6. As regards Recommendation 4, at the last session we requested clarification as to 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. We therefore appreciate the insertion of endnote 10 with the clarification that it is recommended that the applicant be able to claim the design without having to claim the product itself as part of the design, explaining that in considering a design for a GUI, issues can arise when applicants are required as a prerequisite for protection to claim the specific or entire product.

7. Chair, the EU and its Member States find the revised text to be an improved version of the original proposal. We look forward to working together with the proponents and other delegations to finalise the recommendations in order to foster a more harmonised approach.

Thank you.

Agenda item 5, 4th indent

Industrial Designs

Proposal by the Delegation of Spain for the Creation of a Database Collecting the Responses to the Questionnaire on the Temporary Protection of Industrial Designs at Certain International Exhibitions, in accordance with Article 11 of the Paris Convention for the Protection of Industrial Property

(Document SCT/44/5)

Chair,

1. The EU and its Member States would like to thank the delegation of Spain for preparing the proposal in document SCT/44/5 regarding further steps based on the Compilation of the Returns to the Questionnaire on the Temporary Protection of Industrial Designs at Certain International Exhibitions, in accordance with Article 11 of the Paris Convention for the Protection of Industrial Property.
2. In line with our support previously expressed for the Compilation prepared by the Secretariat as a useful tool for further work, we can endorse the new proposal by Spain. We think that it would be beneficial for the users to have a compilation of the replies to the questionnaire in an easily accessible and searchable format.
3. Nevertheless, we are in favour of the proposal with the caveat that the database should serve merely for information purposes, as a repository of information. It is our understanding that it should not have any other further ramifications on a policy or administrative level.

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

(Document SCT/43/6)

Chair,

1. On the topic of country names, the EU and its Member States would like to reiterate the interest in further discussing the proposal contained in document SCT/43/6.
2. While it remains pertinent 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.
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. We reiterate our more technical comments as previously submitted at the last session. 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. 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. It is our view 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, the goods and services should not be considered irrelevant in the case of non-distinctive signs.

5. With such considerations in mind, 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, 5th indent

Trade Marks

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

(Document SCT/43/8 Rev.)

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 in document SCT/43/8 Rev. We also thank Members that submitted 14 new or updated responses and we welcome that the compilation now contains 57 returns overall.
2. We continue to have the favourable 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

Proposals for topics for an Information Session on Geographical Indications

(Document SCT/44/3)

Chair,

1. The EU and its Member States would like to thank the Secretariat and Members of the SCT for the work in preparing and delivering the information sessions on geographical indications. We consider the process of advancing the international debate on geographical indications has been a valuable and constructive exercise. We look forward to the exercise to be continued with topics to be addressed in information sessions that we consider highly productive and informative.
2. We take note of the proposed topics listed in Document SCT/44/3 from the United States and from the Russian Federation, and we recall that we have proposed for our part the issue of the treatment of geographical indications on the internet, in particular in management of the domain names system (DNS). We consider that it is an area where there are significant lacuna, and unjustified divergences from treatment of other forms of IPR. This is a global challenge as much of the commerce on the internet knows no boundaries and is therefore an urgent topic for this Committee.
3. The current situation leaves GIs vulnerable to exploitation by operators acting in bad faith and thus fails to meet a fundamental purpose of IPR. We look forward to further exploring this matter under the information session.
4. We also consider information sessions should address the relevance of geographical indications for developing countries' economies as they are a unique form of IPR that protects local value at global level and would be pleased to facilitate such an information session if proposed by an interested Member.

5. The EU and its Member States would like to propose for a next information session on geographical indications the topic “Ways to prevent bad faith registration of domain names consisting of, or containing, geographical indications”. At the same time, we express our support to the proposal jointly submitted by the US and the Russian Delegations.

Thank you.
