

WIPO General Assembly

Forty-Ninth (23rd Ordinary) Session Geneva, October 2 to 11, 2017

REPORT ON THE STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS (SCT)

prepared by the Secretariat

1. During the period under consideration, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held two sessions, namely the thirty-sixth session (October 17 to 19, 2016) and the thirty-seventh session (March 27 to 30, 2017). Both sessions were chaired by Mr. Adil El Maliki (Morocco).

TRADEMARKS

2. At its thirty-sixth session, the SCT considered document SCT/35/4 (Protection of Country Names Against Registration and Use as Trademarks: Practices, Approaches and Possible Areas of Convergence) and document SCT/32/2 (Revised Proposal by the Delegation of Jamaica). At the end of the session, the Chair requested the Secretariat to invite Member States to submit, in priority, comments and observations to Areas of Convergence No. 1 (Notion of Country Name), No. 2 (Non-registrable if Considered Descriptive), No. 5 (Invalidation and Opposition Procedures) and No. 6 (Use as a Mark), including practical examples of how these principles are applied in their jurisdictions.

3. Following the receipt of the above-mentioned comments and observations, the Secretariat prepared document SCT/37/3 (Protection of Country Names Against Registration and Use as Trademarks: Practices, Approaches and Possible Areas of Convergence – Comments by Members) and presented it to the SCT for discussion at its thirty-seventh session. At this session, the SCT also considered documents SCT/37/6 (Note by the Delegation of Iceland) and SCT/32/2 (Revised Proposal by the Delegation of Jamaica). At the end of the session, the Chair requested the Secretariat to: (i) invite Member States to submit further comments and

observations, in priority, to Areas of Convergence Nos. 1, 2, 5 and 6; (ii) compile all comments and observations received in a revised document^{*}; and (iii) prepare an analytical document for consideration at the thirty-eighth session of the SCT.

4. At its thirty-seventh session, the SCT also considered document SCT/37/4 (Trademarks and International Nonproprietary Names for Pharmaceutical Substances (INNs)). After discussions, the Chair requested the Secretariat to liaise with the World Health Organization (WHO) to explore whether, and how, national and regional industrial property offices of WIPO Member States could make use of the Internet-based mechanisms made available by WHO to access INN data directly online and, in the meantime, to continue its existing practice of informing offices each time that lists of proposed and recommended, as well as cumulative lists, of INNs are published by WHO.

5. Furthermore, the Secretariat presented during both sessions updates on trademark-related aspects of the Internet Domain Name System (DNS) of which the SCT took note with a request to be kept informed of future developments.

INDUSTRIAL DESIGNS

6. Regarding the draft Design Law Treaty (DLT), reference is made to document WO/GA/49/8 (Matters Concerning the Convening of a Diplomatic Conference for the Adoption of a Design Law Treaty).

7. The thirty-sixth session of the SCT considered document SCT/36/2 (Compilation of the Replies to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs). After discussions, the Chair requested the Secretariat to: (i) invite Member States and accredited Non-Governmental Organizations (NGOs) to submit additional inputs on the Questionnaire; (ii) compile all received inputs in a revised document; and (iii) prepare a document analyzing all replies, comments and observations received for consideration at the thirty-seventh session of the SCT.

8. At its thirty-seventh session, the SCT considered document SCT/36/2 Rev. (the revision of the above-mentioned Compilation) and document SCT/37/2 (Analysis of the Returns to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs). After discussions, the Chair requested the Secretariat to prepare a further revision of the Compilation, based on additional inputs to be sought by the Secretariat from Member States and accredited NGOs, as well as a revision of the Analysis, taking into account these additional inputs. Furthermore, the Chair requested the Secretariat to organize an information session, to take place at the thirty-eighth session of the SCT, addressing: (i) the practices of offices; and (ii) the experience of users with regard to graphical user interface (GUI), icon and typeface/type font designs.

9. Finally, at its thirty-sixth session, the SCT also considered document SCT/36/3 (Information on the Digital Access Service for Priority Documents (DAS)). While encouraging Member States to consider using the DAS for the exchange of priority documents for industrial designs and trademarks, the Chair concluded that the SCT would take stock of the progress made in this regard at its future sessions. At the thirty-seventh session, the Chair noted the statements of certain delegations, which indicated that they are taking steps towards the implementation of the DAS for industrial designs in the short term.

^{*} Any comments and observations to Areas of Convergence Nos. 3 and 4 are to be moved to an Annex to the revised document.

GEOGRAPHICAL INDICATIONS

10. Three proposals for work on geographical indications are currently on the Agenda of the SCT, namely a proposal by the Delegation of the United States of America to prepare a current survey of existing national geographical indication regimes (document SCT/31/7), a joint proposal by the Delegations of Bulgaria, the Czech Republic, France, Germany, Hungary, Italy, Poland, Portugal, Republic of Moldova, Romania, Spain and Switzerland, concerning the protection of geographical indications and country names in the DNS (document SCT/31/8 Rev.7), and a proposal by the Delegation of France on a study on the protection of geographical indications in national systems and a study on the protection of geographical indications in the DNS (document SCT/34/6).

11. It is recalled that, in 2015, the WIPO General Assembly directed the SCT to: “[...] examine the different systems for protection of geographical indications, within its current mandate and covering all aspects.” Options for a work program on geographical indications were discussed at the thirty-sixth session of the SCT, and the Chair concluded that:

- “(a) at SCT/37, an information session will take place in two parts addressing:
 - “(i) the features, experiences and practices of the different national and regional geographical indication protection systems, and
 - “(ii) the protection of geographical indications on the Internet, and geographical indications and country names in the DNS;
- “(b) further discussions regarding the work program to support the [WIPO] General Assembly mandate will follow the information session; and
- “(c) all proposals on this item will remain on the Agenda.”

12. The above-mentioned information session took place at the thirty-seventh session of the SCT (namely, on March 28, 2017). After the information session, the SCT discussed, based on a proposal by the Chair, a possible work program to support the WIPO General Assembly mandate reflected in paragraph 11, above. At the end of these discussions, the Chair noted that:

“the Information Session [...] provided useful information on (i) the features, experiences and practices of the different national and regional geographical indication protection systems, and (ii) the protection of geographical indications on the Internet, and geographical indications and country names in the DNS. The Information Session was a good basis to initiate an exchange of views on points (i) and (ii) referred to, above.”

13. The Chair concluded that “at its next session, the SCT will consider further steps based on his proposal on the matter. All proposals on this item will remain on the Agenda.”

14. The WIPO General Assembly is invited to take note of the “Report on the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications” (document WO/GA/49/7).

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