



WO/GA/50/5
ORIGINAL: ENGLISH
DATE: JUNE 25, 2018

WIPO General Assembly

Fiftieth (27th Extraordinary) Session
Geneva, September 24 to October 2, 2018

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-eighth session (October 30 to November 2, 2017) and the thirty-ninth session (April 23 to 26, 2018). Both sessions were chaired by Mr. Adil El Maliki (Morocco).

TRADEMARKS

2. At its thirty-eighth session, the SCT considered document SCT/32/2 (Revised Proposal by the Delegation of Jamaica), SCT/37/3 Rev. (Protection of Country Names Against Registration and Use as Trademarks: Practices, Approaches and Possible Areas of Convergence – Comments by Members) and SCT/38/2 (Analysis of the Comments by Members to the Possible Areas of Convergence on the Protection of Country Names Against Registration and Use as Trademarks). At the end of the session, the Chair requested the Secretariat to organize a half-day information session in the form of a moderated roundtable at the thirty-ninth session of the SCT, addressing the examination by offices of trademarks consisting of, or containing, country names and taking into account the perspectives of users, under the following structure: (i) Introduction; (ii) Specific legislation; (iii) Public domain *versus* distinctiveness; (iv) Word mark *versus* composite mark; (v) Perception of relevant consumer/secondary meaning/what is

considered a country name; (vi) Disclaimers/Limitations of goods and services/Exceptions/Other practices; and (vii) Concluding remarks.

3. The Information Session on Country Names was held at the thirty-ninth session of the SCT. It was moderated by Mr. David Musker, Professor, Centre for Commercial Law Studies, Queen Mary University of London, and featured panelists from the National Industrial Property Institute of Chile (INAPI), the National Intellectual Property Center of Georgia (SAKPATENTI), the United States Patent and Trademark Office (USPTO), the Registry of Trademarks, Intellectual Property Office of Singapore (IPOS), the Federal Intellectual Property Institute of Switzerland (IPI), the European Union Intellectual Property Office (EUIPO), the African Intellectual Property Organization (OAPI), the International Trademark Association (INTA), and the Federation of Intellectual Property Attorneys (FICPI).

4. The Chair noted the SCT's satisfaction with the Information Session on Country Names, and requested the Secretariat to prepare a document summarizing the various examination practices regarding trademarks consisting of, or containing, country names, as presented by the panelists.

5. In addition, at the thirty-ninth session of the SCT, a number of delegations expressed their initial views on a proposal made by 13 countries, entitled "Proposal by the Delegations of Georgia, Iceland, Indonesia, Italy, 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/39/8 Rev.2). Furthermore, the Delegation of Peru presented a proposal entitled "Proposal Concerning the Recognition and the Protection of Nation Brands" (document SCT/39/9 SCT), and further discussions continued on document SCT/32/2 (Revised Proposal by the Delegation of Jamaica). The Chair concluded that the SCT will hold further in-depth discussions under this agenda item at its next session.

6. At its thirty-ninth session, the SCT also considered document SCT/39/4 (International Nonproprietary Names for Pharmaceutical Substances (INNs)). The Chair requested the Secretariat to provide, at the next session, a progress report on the implementation of the agreement in principle reached between the World Health Organization (WHO) and the World Intellectual Property Organization (WIPO) Secretariat to integrate INN Data into the Global Brand Database.

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

INDUSTRIAL DESIGNS

8. Regarding the draft Design Law Treaty (DLT), reference is made to document WO/GA/50/6 (Matters Concerning the Convening of a Diplomatic Conference for the Adoption of a Design Law Treaty).

9. At the thirty-eighth session of the SCT, an Information Session on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs was held, addressing: (i) the practices of offices; and (ii) the experience of users. The Information Session featured panelists from the USPTO, the Ministry of Justice of Israel, the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Agency on Intellectual Property of the Republic of Moldova (AGEPI), the American Intellectual Property Law Association (AIPLA), the International Association for the Protection of Intellectual Property (AIPPI), Lenovo Group and the firm Mathys and Squire LLP.

10. At the thirty-eighth session, the SCT requested the Secretariat to prepare a document summarizing the main points emerging from the Information Session, with all presentations made at the Information Session to be included as an Annex, as well as to invite Member States and accredited Non-Governmental Organizations (NGOs) to propose aspects of Graphical User Interface (GUI), icon and typeface/type font designs on which further work would be desirable, and compile all such proposals in a document, for consideration by the SCT at its next session. The SCT also requested the Secretariat to include on this agenda item, for the thirty-ninth session of the SCT, a presentation, by the Delegation of France, of the European Union “Convergence Programme 6: Graphical Representation of Designs”.

11. At the thirty-ninth session of the SCT, the Delegation of France made a presentation on the “European Union Convergence Program 6: Graphical Representation of Designs.” Furthermore, the SCT considered documents SCT/39/2 (Summary of the Main Points Emerging from the Information Session on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs) and SCT/39/3 (Compilation of Proposals by Member States and Accredited Non-Governmental Organizations (NGOs) on Aspects of Graphical User Interface (GUI), Icon and Typeface/Type Font Designs on Which Further Work Would Be Desirable).

12. After an exchange of views, the SCT decided that further work is desirable on certain existing issues identified in those documents, in particular on proposals 1, 3, 9 and 10 in document SCT/39/3, while other issues related to novel technological designs could be undertaken in a subsequent phase. The Chair requested the Secretariat to invite Members, Intergovernmental Intellectual Property Organizations with observer status and accredited NGOs to submit further inputs, including detailed questions which they would like to see answered, concerning (1) the requirement for a link between GUIs, Icons, Typeface/Type Font Designs and the article or product and (2) the methods allowed by offices for the representation of animated designs. The Chair further requested the Secretariat to prepare a draft questionnaire on the basis of the received inputs and questions, for consideration of the SCT at its fortieth session. The SCT also decided that, at its next session, it will have a further exchange of views on related matters, such as other novel technological designs.

13. Finally, at both sessions, the SCT noted the progress in the implementation of the Digital Access Service for Priority Documents (DAS) for industrial designs by Members, as well as by the Secretariat. 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 continue to take stock of the progress made in this regard at its future sessions.

GEOGRAPHICAL INDICATIONS

14. At its thirty-eighth session, the SCT adopted its Workplan on Geographical Indications.

15. At the same session, in accordance with the Workplan, the Chair requested the Secretariat to compile a list of questions proposed by Members and Intergovernmental Intellectual Property Organizations with observer status, for consideration by the SCT, which could form the basis of a questionnaire to be distributed to Members and the aforementioned Organizations¹. The Chair also requested the Secretariat to describe the existing state of play of geographical indications, country names and other geographical terms in the DNS, with a view to further discussions on the matter by the SCT.

¹ Review of multilateral agreements is outside the scope of this exercise.

16. At its thirty-ninth session, the SCT considered documents SCT/39/6 Rev. (Compilation of List of Questions Proposed by Members and Intergovernmental Intellectual Property Organizations with Observer Status on Topics Referred to in the Workplan on Geographical Indications), SCT/39/6 Rev. Corr. (Corrigendum to document SCT/39/6 Rev.) and SCT/39/7 (Survey of the Existing State of Play of Geographical Indications, Country Names, and Other Geographical Terms in the Domain Name System (DNS)).

17. Consistent with its Workplan on Geographical Indications, the SCT decided, at the thirty-ninth session, to request the Secretariat to issue to Members and Intergovernmental Intellectual Property Organizations with observer status, by June 11, 2018, a first Questionnaire on the national and regional systems that can provide a certain protection to geographical indications and a second Questionnaire on the use/misuse of geographical indications, country names and geographical terms on the Internet and in the DNS. The responses to both questionnaires were to be received by the Secretariat by September 10, 2018.

18. Finally, the SCT requested the Secretariat to issue, by October 15, 2018, a document compiling the responses to both Questionnaires, for consideration by the SCT at its fortieth session.

19. 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/50/5).

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