

# WIPO



SCT/3/9

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
GENEVA

## **STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

### **Third Session Geneva, November 8 to 12, 1999**

#### SUMMARY BY THE CHAIR

##### Agenda Item 1: Opening of the Session

1. The session was opened by the Chair, Ms. Lynne G. Beresford, United States of America, who welcomed the participants.

##### Agenda Item 2: Adoption of the Agenda

2. The Agenda (document SCT/3/1) was adopted without modification.

##### Agenda Item 3: Adoption of the Report of the Second Session, Second Part

3. The Report of the second part of the second session (document SCT/2/12) was adopted without modification.

Agenda Item 4: Report on the Deliberations of the WIPO Assemblies Regarding the Joint Resolution on the Protection of Well-Known Marks

4. The Standing Committee was informed of the deliberations of the WIPO Assemblies, in September 1999, on the proposed Joint Resolution (document SCT/3/8) and their decision to adopt a Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, including the text of the provisions, without modification, as adopted by the SCT. The Joint Recommendation and provisions, together with the notes prepared by the International Bureau, will be published by WIPO in a bound form within the next few months.

Agenda Item 5: Use of Trademarks on the Internet

5. The International Bureau presented document SCT/3/3, and gave additional information on recent developments within the Hague Conference on Private International Law regarding the Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters.

6. On the basis of document SCT/3/4 and working papers subsequently submitted by the International Bureau, the SCT noted the results of the questionnaire containing hypothetical cases concerning the use of trademarks on the Internet summarized in document SCT/3/2, and discussed issues regarding the use of trademarks on the Internet.

7. With regard to issues of jurisdiction and private international law, the SCT agreed not to pursue these matters in depth, but instead to monitor the developments within the Hague Conference on Private International Law regarding the Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters. It was agreed that the International Bureau would prepare a paper for the next session of the SCT, which outlined the consequences of the Preliminary Draft Convention and proposed amendments for matters of jurisdiction regarding claims involving the validity or infringement of trademark rights. On the basis of this paper, the SCT would, at its next meeting, discuss whether WIPO should convey a position paper to the Hague Conference regarding trademark issues contained in the Preliminary Draft Convention.

8. With regard to issues outlined in document SCT/3/4, and on the basis of working papers subsequently submitted, the SCT agreed on a number of general principles, and decided that a set of provisions should be prepared by the International Bureau for discussion by the SCT at its next session.

Agenda Item 6: Trademark Licensing

9. The Standing Committee discussed the document concerning draft provisions on trademarks licenses (document SCT/3/5) and agreed, as follows:

Draft Article 1.

*Items (i), (ii), (iv) and (v)*, as well as the introduction of the definition of an application, as contained in the TLT, should be put between brackets, pending the decision of the SCT concerning the form of adoption of the provisions on trademark licences.

Draft Article 2.

*Paragraph (1)* was referred to the international bureau for further study concerning possible additional requirements (legal nature of the legal entity) and clarification of terminology (term of license).

*Paragraph (2)*. Following reservations raised by a number of delegations, this provision was referred to the International Bureau for further study concerning the possibility of redrafting the provisions along the lines of Article 11(1)(b) of the TLT, based on the discussions.

*Paragraph (3)* was referred to the International Bureau for amendment concerning the transmittal of communication to the Office by electronic means other than telefacsimile.

*Paragraph (4)* was referred to the International Bureau for further study.

*Paragraph (5)*. There was no opposition to this provision.

*Paragraph (6)* was referred to the International Bureau for further study.

Draft Article 3.

*Paragraph (1)*. There was no opposition to this provision.

*Paragraph (2)*. Following reservations raised by a number of delegations, this provision was put between square brackets and referred to the International Bureau for further study. The notes should be further developed.

Draft Article 4.

*Paragraph (1)* was referred to the International Bureau for clarification of the notes.

*Paragraph (2)*. One delegation entered a reservation on this provision, pending further reflection.

Draft Article 5.

This Article was referred to the International Bureau for redrafting.

Model International Form.

This form was referred to the International Bureau for amendments.

Agenda Item 7: Geographical Indications

10. It was agreed that the International Bureau would prepare the study suggested in paragraph 9(i) of document SCT/3/6, and that this study would be presented to the SCT for consideration at its fifth session.

Agenda Item 8: Trademarks and Nonproprietary Names for Pharmaceutical Substances (INNs)

11. It was agreed that the WIPO Secretariat would consult with the WHO Secretariat on a technical level in order to find ways to make available information on INNs in an electronic format to those offices of WIPO Member States wishing to obtain such information.

Agenda Item 9: Future work

12. The SCT agreed that its fourth session would tentatively be held from March 27-31, 2000, in Geneva, and would last five full days.

13. The SCT further agreed that the agenda of the next meeting would consist of the following substantive items:

- consideration of the paper prepared by the International Bureau on the Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters;
- Finalization of provisions on trademark licensing;
- Consideration of suggested draft provisions on the use of trademarks on the Internet.

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