

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

Forty-Second Session
Geneva, November 4 to 7, 2019

REPORT

*adopted by the Standing Committee**

INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee”, “the Committee” or “the SCT”) held its forty-second session, in Geneva, from November 4 to 7, 2019.
2. The following Member States of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Algeria, Angola, Argentina, Australia, Austria, Bahamas, Bangladesh, Barbados, Belarus, Bhutan, Bolivia (Plurinational State of), Brazil, Burkina Faso, Cabo Verde, Cameroon, Canada, Chile, China, Congo, Costa Rica, Côte d’Ivoire, Croatia, Czech Republic, Democratic People’s Republic of Korea, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, Ethiopia, Finland, France, Gambia (the), Georgia, Ghana, Germany, Greece, Guatemala, Guyana, Hungary, Iceland, India, Indonesia, Iran (Islamic Republic of), Ireland, Israel, Italy, Jamaica, Japan, Kenya, Kuwait, Latvia, Lesotho, Lithuania, Mexico, Monaco, Morocco, Myanmar, Netherlands, Nicaragua, Nigeria, North Macedonia, Norway, Oman, Pakistan, Peru, Philippines, Poland, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Saudi Arabia, Serbia, Singapore, Slovakia, South Africa, Spain, Sudan, Sweden, Switzerland, Thailand, Trinidad and Tobago, Tunisia, Turkey, Uganda, Ukraine, Uruguay, United Arab Emirates, United Kingdom, United States of America, Venezuela (Bolivarian Republic of), Zambia (96). The European Union was represented in its capacity as a special member of the SCT.

* This Report was adopted at the forty-third session of the SCT.

3. The following intergovernmental organizations took part in the meeting in an observer capacity: Benelux Organization for Intellectual Property (BOIP) (1).
4. Representatives of the following non-governmental organizations took part in the meeting in an observer capacity: Centre for International Intellectual Property Studies (CEIPI), Consortium for Common Food Names (CCFN), European Brands Association (AIM), European Law Students' Association (ELSA International), Health and Environment Program (HEP), Inter-American Association of Industrial Property (ASIPI), International Federation of Intellectual Property Attorneys (FICPI), International Trademark Association (INTA), International Wine Law Association (AIDV), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), Knowledge Ecology International, Inc. (KEI), MARQUES - Association of European Trade Mark Owners, Organization for an International Geographical Indications Network (origIn) (14).
5. The list of participants is contained in Annex I to this document.
6. The Secretariat noted the interventions made and recorded them.

AGENDA ITEM 1: OPENING OF THE SESSION

7. Mr. Alfredo Rendón Algara, Chair of the SCT, opened the forty-second session of the SCT and welcomed the participants.
8. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), delivered opening remarks.
9. Mr. Marcus Höpperger (WIPO) acted as Secretary to the SCT.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

10. The SCT adopted the draft Agenda (document SCT/42/1 Prov. 2).

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE FORTY-FIRST SESSION

11. The SCT adopted the draft Report of the forty-first session of the SCT (document SCT/41/11 Prov.).

General Statements

12. The Delegation of Mexico, speaking on behalf of the Group of Latin American and Caribbean Countries (GRULAC), thanked the Secretariat for the preparation of the working documents and the organization of the session of the SCT. Concerning industrial designs, the Group regretted that, during the 2019 WIPO General Assembly, the consultations conducted by Ambassador Socorro Flores Liera (Mexico) had not led to a decision on the convening of a diplomatic conference for the adoption of a Design Law Treaty (DLT). In that respect, the Group reiterated its wish to deal with the topic with pragmatism, political will and flexibility, in order to achieve a mutually beneficial agreement. Concerning trademarks, given the importance that it attached to country names, the Group hoped that the Committee would be able to make progress on that topic, taking into account the proposals contained in documents SCT/32/2 and SCT/39/8 Rev. 3, and continue the discussion on the proposal put forward 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 in the Domain Name System (DNS), as contained in document SCT/41/6. Expressing concern about the domain name "Amazon", which affected the linguistic and cultural heritage of each of the eight Amazonian countries, the Group wished that Member States' interests be taken into consideration when deciding to grant domain names and when adopting other decisions relating to country and regional names. Moreover, the Group noted with interest the proposal put forward by the Delegation of Peru to Conduct a Survey on Nation-Brand Protection in Member States, as outlined in document SCT/42/4, as well as the proposal of the Delegation of the Republic of Korea on the Protection of Well-known Marks, as reflected in document SCT/42/5. Finally, concerning geographical indications, the Group expressed its interest in the presentation of the database reproducing all returns 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, and supported that the database be made publicly accessible. The Delegation concluded by announcing the Group's commitment to work with SCT members on all agenda items pertaining to the current SCT session.

13. The Delegation of Singapore, speaking on behalf of the Asia and the Pacific Group, expressed its appreciation to the Director General of WIPO and the Secretariat for the excellent preparation of the session, and stated that, although at the last WIPO General Assembly, no consensus on the DLT had been reached, the Group would continue working on the matter, as it remained optimistic that an agreed result could be achieved. With respect to technical assistance, the Delegation reported that most members of the Group favored the inclusion of an article in the treaty, while others could accept the inclusion of a provision on technical assistance either in the treaty or in a resolution. For the Group, what ultimately mattered was that developing countries, including Least Developed Countries (LDCs), would have the necessary capacity to implement the treaty. With respect to the disclosure of source issue, most of the Group's members supported the principle of such a disclosure and were of the view that countries should have the flexibility to include, as part of the design-application eligibility criteria, components that were important to complete the formalities for protection of industrial designs within their jurisdictions. The Group looked forward to further discussing both issues with SCT members. The Group also recognized the importance of the Questionnaires on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs and on the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions Under Article 11 of the Paris Convention for the Protection of Industrial Property, and hoped that the compilations would help the Committee further in its deliberations. Turning to agenda item 5 on trademarks, the Delegation, stressing the importance of providing sufficient protection for country names to prevent undue registration or use as trademarks, expressed the Group's general support for the proposal made by the Delegation of Jamaica. The Group looked forward to the development and future adoption of a joint recommendation on the topic by the SCT. The Delegation also informed the Committee that the Group welcomed the revised joint 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, and would continue to engage constructively on the issue. Finally, as regards geographical indications, the Delegation expressed the Group's appreciation to the Secretariat for the compilation of the 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. Finally, the Delegation indicated that the Group looked forward to actively discussing the three new proposals submitted, namely the proposal by the Delegation of Peru to Conduct a Survey on Nation-Brand Protection in Member States, outlined in document SCT/42/4, the proposal by the Delegation of the Republic of Korea on the Protection of Well-known Marks, contained in

document SCT/42/5, and the proposal by the Delegations of Japan and the United States of America for a Joint Recommendation on Industrial Design Protection for Graphical User Interface (GUI) Designs, reflected in document SCT/42/6.

14. The Delegation of Uganda, speaking on behalf of the African Group, thanked the Secretariat for its hard work in preparing the session and the delegations for their proposals. The Delegation stated that the Group looked forward to fruitful deliberations on all proposals, in a balanced and productive manner, and that it attached great importance to all agenda items of the SCT, mindful of their contribution to the progressive development of the international law on trademarks, industrial designs and geographical indications. Thanking the Secretariat for the organization of the Information Session on Geographical Indications on the margins of the Committee's session, the Delegation expressed the Group's hope that it would clarify a range of issues to enable the Committee to develop a concrete work program on geographical indications. Turning to the area of trademarks, the Group reaffirmed its strong support for all proposals and discussions on the protection of country names and geographical names of national significance against registration or use as word marks by private persons, as well as on the protection of country names and geographical names of national significance in the DNS. In the Group's view, country names should neither be monopolized by private persons, nor be used in a misleading manner in connection with products and services not originating in the country concerned. The Group also looked forward to discussing the proposal to conduct a survey on nation-brand protection in Member States, put forward by the Delegation of Peru, and the proposal by the Delegation of the Republic of Korea, aiming at enhancing the protection of well-known marks in Member States. Expressing gratitude to the Secretariat for document SCT/42/3 on the Update on Trademark-Related Aspects of the DNS, the Delegation pointed out that the document contained useful information for Member States with respect to the enforcement of intellectual property on the Internet. Finally, turning to the area of industrial designs, the Group regretted that, despite all Member States' best endeavors, the 2019 WIPO General Assembly had been –like the previous three general assemblies– unable to reach a consensus on the convening of a diplomatic conference for the adoption of a DLT. The Group was convinced that further efforts by all Member States and the integration and mutual understanding of each other's concerns would contribute to reaching a mutually agreed solution. While maintaining its position, particularly with regard to the inclusion of a substantive provision on an optional disclosure requirement, as well as on technical assistance, the Delegation expressed the Group's readiness to work constructively with all other groups with a view to reaching a consensus in the near future for the convening of a diplomatic conference. The Group welcomed the replies to the questionnaires on Graphical User Interface (GUI), Icon, Typeface/Type Font Designs, and hoped that there would be additional exploratory discussions to enable Member States to further understand other countries' experiences. While recognizing the right of Member States to submit proposals for normative work on the topic, the Group strongly cautioned against proceeding to norm-setting activities at the present stage, as the topic was yet to be examined substantially. In the Group's viewpoint, the Committee should continue its exploratory activities, including possible studies on the economic impact on innovation in developing countries of intellectual property rights on such technological designs. Finally, the Delegation expressed the Group's willingness to engage constructively in discussions on all agenda items to ensure the success of the Committee's work.

15. The Delegation of Croatia, speaking on behalf of the Group of Central European and Baltic States (CEBS), thanked the Secretariat for the preparation of the documents and noted with satisfaction that some progress had been achieved on key SCT issues. Regarding industrial designs, the Group welcomed the agreement on a more defined work on GUIs and the discussions on international exhibitions. The Delegation expressed the Group's hope that positions on the issue of geographical indications would be similarly narrowed, as that would be beneficial for the different stakeholders. The Group noted with regret that no decision on the convening of a diplomatic conference for the adoption of a DLT had been reached, although some flexibility as to different agenda items relating to the normative work within WIPO had

been shown during the last WIPO General Assembly. That had unfortunately not been the case as regards the DLT, although the Group had been ready to move even over its red lines on the subject. In the Group's viewpoint, since the treaty's text had been ready for a couple of years, it presently remained to be seen whether a certain amount of flexibility would be shown by others at the next General Assembly in 2020, in order to reach a decision on the convening of a diplomatic conference for the adoption of a DLT. Turning to the Compilation of the Returns to the Questionnaire on GUI, Icon and Typeface/Type Font Designs, contained in document SCT/41/2, the Delegation expressed the Group's hope that such work would provide a good basis for a constructive dialogue during the current SCT session. Thanking the Delegations of Japan and the United States of America for their proposal of a joint recommendation on industrial design protection of GUI designs, as outlined in document SCT/42/6, the Group held the view that discussions on official or officially recognized international exhibitions were equally important. In that respect, the Group thanked the Delegation of Spain for its proposal, Member States for their responses and the Secretariat for the compilation of the returns, as reflected in document SCT/42/2 Prov. Due to the existence of divergent positions, the Group considered that there was a need to discuss further the matter to exchange on best practices. Concerning the 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, as reflected in document SCT/39/8 Rev. 3, and the related discussions on the topic, the Delegation reiterated the Group's position on the need to continue discussing, with a view to reaching a common ground on certain technical issues. Stressing the importance of having documents serving as tools for policy discussions, the Delegation expressed the Group's gratitude to all delegations for their proposals, which contributed to the discussions under agenda item 5. The Group also acknowledged the work of the Secretariat and its promptness to inform Member States on developments in the DNS. Concerning agenda item 6 on geographical indications, the Delegation thanked the Secretariat for keeping up to date the database reproducing all returns to Questionnaires I and II on Geographical Indications. The Group looked forward to further discussing the issues that would be covered by the Information Session on Geographical Indications.

16. The Delegation of China, thanking the Secretariat for the preparation of the documents, observed that, for a long time, the SCT had been forming the work base of the multilateral guidance in the areas of industrial designs and trademarks. As China would continue to pay attention to those areas, the Delegation expressed its willingness to engage actively in all Committee's discussions. As regards the DLT, the Delegation urged all parties to show flexibility to make substantial progress on the matter of disclosure of source and technical assistance, with a view to convening a diplomatic conference. As regards the Questionnaire on Graphical User Interface (GUI), Icon, Typeface/Type Font Designs, the Delegation thanked the Secretariat for compiling the returns, which would contribute to the discussions, enable the Committee to understand the developments in that area and lay solid foundations for future studies. As regards the Digital Access Service (DAS) for Priority Documents, the Delegation supported its extension to industrial design priority documents and hoped that such service would enable Member States to provide better services to the users. Turning to the area of trademarks, the Delegation believed that discussing well-known marks would be beneficial to different parties, and therefore expressed the hope that the Committee would deliberate on the issue in a positive manner. Finally, concerning geographical indications, the Delegation believed that the Committee should further discuss the topic to enhance cooperation between countries.

17. The Delegation of the Russian Federation, speaking on behalf of the Group of Central Asia, Caucasus and Eastern European Countries (CACEEC) thanked the Secretariat for the preparation of the documents for the session and acknowledged the efforts made by Member States with a view to convening a diplomatic conference for the adoption of a DLT. Recalling that the Group supported the adoption of the DLT, the Delegation reminded the Committee that

Belarus had proposed hosting the diplomatic conference. Noting that the topic on GUIs would continue to be examined in the future, the Group thanked the Secretariat for document SCT/42/2 on the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions under Article 11 of the Paris Convention for the Protection of Industrial Property, which would be useful for the Committee's work. As regards the protection of country names and geographical names of national significance, the Delegation thanked Member States for their proposals. The Delegation also announced that the Group would follow closely the Information Session on Geographical Indications.

18. The Delegation of the European Union, speaking on behalf of the European Union and its member states, thanked the Secretariat for the excellent preparatory work for the session. The Delegation was pleased to confirm that the European Union had concluded its legislative procedure to become a contracting party to the Geneva Act of the Lisbon Agreement and that it would therefore be able to deposit its instrument of accession to the said Act with WIPO in the forthcoming weeks. Looking back to previous SCT sessions, the Delegation noted with appreciation that the Committee had moved forward on all key topics, in a constructive spirit. As regards trademarks, the Delegation observed that the Committee had held intense discussions and had made some progress in seeking a compromise solution on the topic of country names. As regards industrial designs, the SCT had agreed on a more defined scope of future work concerning GUI designs and had embarked on exploring the topic of international exhibitions. As regards geographical indications, expressing the hope that step-by-step progress on the topic would eventually lead to clear and tangible results within the SCT mandate and framework, with a positive impact on stakeholders, the Delegation reiterated that the SCT should not aim at interpreting or revising provisions of the Lisbon Agreement or the Geneva Act of the Lisbon Agreement. Looking more specifically at agenda item 4 on industrial designs, the Delegation recalled that it had been pleased to engage in informal discussions on the DLT during the 2019 General Assembly, initiated by the Facilitator's proposal for a possible compromise solution on the outstanding issues. Nevertheless, the Delegation noted with regret that, again this year, no positive decision to convene a diplomatic conference on the adoption of a DLT had been achieved. Hence, the matter remained on the agenda for the WIPO General Assembly in 2020. In relation to GUIs, recalling that it had endorsed the extension of the deadline to submit additional responses to a questionnaire on the topic by July 31, 2019, the Delegation thanked SCT members for their further contributions and the Secretariat for the compilation of all returns, contained in document SCT/41/2. The Delegation pointed out that the compilation included information on the common practice developed by the European Union Intellectual Property Office (EUIPO). As it saw a wealth of information in all the up-to-date and detailed responses, which would prove useful in further discussions, the Delegation supported that the compilation be used as reference for further work on selected pertinent issues for such designs. Concerning future work on that topic, having noted with much interest the proposal submitted by the Delegations of Japan and the United States of America, contained in document SCT/42/6, the Delegation welcomed that new initiative and lent its support to the aim of adopting a joint recommendation as a practical way forward to achieve a more harmonized approach in relation to industrial design protection for GUI designs. As regards the proposal submitted by the Delegation of Spain relating to official or officially recognized international exhibitions, recalling that it had supported the launch of a questionnaire on the topic, finalized at the previous SCT session, the Delegation thanked the Secretariat for the preparation of the compilation of returns, as reflected in document SCT/42/2 Prov. Observing that the compilation revealed considerable divergences in practices on a number of pertinent questions, the Delegation expressed its support for the continuation of discussions on the issue and suggested that an information session be organized to explore users' needs and national experiences and to share best practices among offices. Turning to agenda item 5 on trademarks, the Delegation recalled that a number of proposals on the topic of country names had been discussed at the last SCT session. As regards, in particular, the proposal contained in document SCT/41/6, the Delegation stated that it remained, in general, supportive of the underlying rationale outlined in pages one to four of the document. Reminding the Committee that, at its last session, the

proponents had elaborated a revised version of the text in document SCT/41/6, which had been subject to informal discussions, the Delegation reiterated its appreciation for the spirit of seeking consensus, as reflected in that joint proposal, and announced its readiness to participate in discussions to address certain technical issues in the context of the latest wording proposed by the co-sponsors. Finally, turning to agenda item 6 on geographical indications, the Delegation recalled that it had welcomed the decision to organize an Information Session at the current SCT session to discuss three topics, submitted by each of the proponents, of the list of themes tabled at the fortieth session of the SCT, and looked forward to engaging constructively on each of the selected topics. In order to advance the international debate on geographical indications, encouraging the wider membership to table proposals for debate on geographical indications on subjects of concerns, the Delegation hoped that the Committee would be able to agree on some particular topics for further discussions to be conducted at the forty-third session of the SCT. In conclusion, the Delegation looked forward to continuing work and contributing constructively in discussions in all three key areas of the SCT.

19. The Delegation of Brazil, aligning itself with the statement made by the Delegation of Mexico on behalf of GRULAC, thanked the Secretariat for the preparation of the documents and the organization of the session. As regards the DLT, the Delegation called on Member States' flexibility to address the issue, underscoring the fact that demonstrating pragmatism would enable the Committee to reach an agreement on the convening of a diplomatic conference. Stressing the importance of the protection of country names and the active role that could be taken by the SCT in that regard, the Delegation expressed its readiness to engage in discussions on the proposals presented by Member States, especially the proposal submitted 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 in the DNS, contained in document SCT/41/6. The Delegation expressed its wish to co-sponsor the said proposal. Referring to the statement made by the Delegation of Mexico on behalf of GRULAC in relation to the DNS, the Delegation also expressed deep concern as to the allocation of the "Amazon" domain name by the Internet Corporation for Assigned Names and Numbers (ICANN), which had affected the cultural and linguistic heritage of each of the eight Amazonian countries. In the Delegation's viewpoint, SCT member States should no more allow similar situations to happen. If, today, Amazonian countries were being devoid of an important part of their heritage, tomorrow other countries could face the same situation as regards their own cities and regions. Reminding the Committee of its engagement on geographical indications, the Delegation expressed the willingness to contribute to the deliberations on the matter and hear about other members' experience in implementing that category of protection. The Delegation concluded by announcing that it looked forward to the Information Session on Geographical Indications.

20. The Delegation of Chile, thanking the Secretariat for the preparation of the documents, lent its support to the statement made by the Delegation of Mexico on behalf of GRULAC and expressed its interest in all documents put forward for the current session. In the industrial designs area, reiterating its concern as to the DLT, which did not come to fruition, the Delegation expressed the hope that a solution would be found next year. In the area of trademarks, the Delegation stated that it awaited with interest the presentation of the proposal by the Delegation of Peru to Conduct a Survey on Nation-Brand Protection in Member States and 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 in the DNS. Finally, in the area of geographical indications, the Delegation expressed its interest in the compilation of responses to Questionnaires I and II and in the presentation of a database by the Secretariat. The Delegation also felt that the Information Session on Geographical Indications would provide the Committee with additional information to determine future steps for a work plan on that topic. The Delegation concluded by expressing its support to facilitate dialogue within the SCT.

21. The Delegation of Trinidad and Tobago, after having thanked the Secretariat for the preparation of the working documents and the organization of the session, aligned itself with the statement made by the Delegation of Mexico on behalf of GRULAC. The Delegation indicated that it wholeheartedly supported the SCT continuing efforts in the areas of trademarks, industrial designs and geographical indications, reporting that issues arising from the Committee's deliberations continued to inform Trinidad and Tobago's legislative agenda. As regards industrial designs, the Delegation announced that Trinidad and Tobago's cabinet had, in principle, agreed to accede to the Hague Agreement Concerning the International Registration of Industrial Designs in 2020 and was working with WIPO to draft the relevant legislation for that accession. Regarding the DLT, echoing the opinion expressed by the Delegation of Mexico on behalf of GRULAC, the Delegation urged Member States to address the issue pragmatically and flexibly. With regard to geographical indications, the Delegation informed the Committee that the first geographical indication in Trinidad and Tobago had been registered in 2017 and that the IP Office of Trinidad and Tobago continued to engage stakeholders nationwide. The Delegation would therefore listen intently to the presentation on the database containing the replies to Questionnaires I and II on Geographical Indications. Realizing the great significance of the protection of country names, the Delegation hoped to see progression on the deliberations on that topic at the current SCT session. Looking forward to the Committee's continuing work, the Delegation expressed its gratitude to WIPO for its continued assistance and support and looked forward to working together with other Member States.

22. The Delegation of Iran (Islamic Republic of), associating itself with the statement delivered by the Delegation of Singapore on behalf of the Asia and the Pacific Group, commended the Secretariat for the preparation of the session. Turning firstly to agenda item 4 on industrial designs, the Delegation regretted the lack of consensus on the question of the convening of a diplomatic conference for the adoption of a DLT at the last General Assembly. The Delegation invited all delegations to constructively, open mindedly and by mutual respect, engage in discussions to overcome remaining differences, so as to submit the draft treaty to a diplomatic conference. As regards GUI, Icon and Typeface/Type Font Designs, the Delegation pointed out that the Committee's deliberations on the topic contributed positively to the objective of reaching a common understanding by Member States, by sharing experiences among delegations. The Delegation expressed the view that the current international framework already provided adequate flexibility for ensuring the protection for new technological designs. For the Delegation, discussions on that topic should preserve Member States' policy to adopt their national legal requirements. As to the next steps to be taken in that area, the Delegation expressed its openness to consider all options, although it was not convinced yet to start any norm-setting activity in that regard. Expressing its appreciation for the Secretariat's compilation of the returns to the Questionnaire on the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions Under Article 11 of the Paris Convention for the Protection of Industrial Property, as contained in document SCT/42/2 Prov., the Delegation looked forward to discussing the topic. Turning to agenda item 5 on trademarks, the Delegation said that the lack of protection of country names at the international level was a shortcoming in the international intellectual property system, and stressed the need to continue discussing the subject, as a matter of priority, and to develop a framework to prevent undue registration or use of country names as trademarks. The Delegation hoped that the Committee could conclude its discussions on that topic soon by making positive recommendations to the General Assembly. Finally, turning to agenda item 6 on geographical indications, the Delegation looked forward to the Information Session and strongly believed that the SCT work should not create any expectations for norm-setting activities in areas currently covered by the Lisbon Agreement or the Geneva Act of the Lisbon Agreement. Looking forward to the presentation of the database containing the replies to the Questionnaires on geographical indications, the Delegation concluded by welcoming the upcoming accession of the European Union to the Geneva Act of the Lisbon Agreement.

23. The Delegation of Jamaica, thanking the Secretariat for the preparation on the documents and the organization of the session, aligned itself with the statement of the Delegation of Mexico on behalf of GRULAC. The Delegation said that it looked forward to furthering discussions on the DLT. Furthermore, it indicated that it gave the utmost importance to the protection of country names. For that reason, the Delegation expressed the hope that, at the current session, the Committee could move forward on deliberations on such important issue, on the basis of its own proposal, contained in document SCT/32/2, as well as of the proposal submitted 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 in the DNS, reflected in document SCT/41/6. In addition, the Delegation looked forward to discussing, at the present session, the proposal put forward by the Delegation of Peru to Conduct a Survey on Nation-Brand Protection in Member States, contained in document SCT/42/4. With regard to geographical indications, the Delegation expressed its interest in the presentation on the database containing the replies to Questionnaires I and II, and supported the proposal aiming at making the database available to the public. The Delegation also looked forward to the Information Session on Geographical Indications. Trusting that, during the session, the Committee would make progress on several issues and, in particular, on the protection of country names and geographical names of national significance, the Delegation expressed its readiness to engage in constructive discussions towards solutions to those issues.

AGENDA ITEM 4: INDUSTRIAL DESIGNS

Industrial Design Law and Practice-Draft Articles and Draft Regulations

24. The Chair recalled that the WIPO General Assembly, on the occasion of its session in October 2019, had decided that, at its next session in 2020, it will continue considering the convening of a diplomatic conference on the Design Law Treaty (DLT), to take place at the end of the first half of 2021.

25. The Chair concluded that the SCT took note of all statements made by delegations on that item. The SCT noted the decision of the General Assembly to continue considering this matter at its next session in 2020.

Graphical User Interface (GUI), Icon and Typeface/Type Font Designs

26. Discussions were based on document SCT/41/2 (Compilation of the Returns to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs) and document SCT/42/6 (Proposal by the Delegations of Japan and the United States of America for a Joint Recommendation on Industrial Design Protection for Graphical User Interface (GUI) Designs).

27. The Secretariat recalled that, at the fortieth session of the SCT, the Chair had concluded that the Secretariat was requested to circulate a Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs, for returns by January 31, 2019. At the closing day to return the completed questionnaire, the Secretariat had received 31 replies from Member States and one reply from an Intergovernmental Intellectual Property Organization. Then, at its forty-first session, in April 2019, the SCT had decided to give more time to SCT members to submit additional or revised replies to the questionnaire, until July 31, 2019. By that date, new replies were received from eight SCT members, namely Azerbaijan, Chile, Ecuador, Japan, Kenya, Latvia, Norway and the European Union Intellectual Property Office (EUIPO). Finally, the Secretariat drew the attention of the Committee to the fact that document SCT/41/2 compiled all the 40 replies received.

28. The Delegation of Japan, expressing its sincere appreciation to the Secretariat for the preparation of document SCT/41/2 and to SCT members for their valuable replies, reported that, in Japan, the revision of the Design Act, which aimed at expanding the scope of protectable GUI designs, had been approved by the National Diet in May 2019 and that the revised Design Act would enter into force as of April 1, 2020. Whereas, under the current legislation, GUI designs had been treated and protected in close relation to a specific article, as a partial design of a physical product, the Delegation pointed out that, in contrast, the revised Design Act considered GUI designs *per se* as protectable subject matters. In other words, GUI designs not recorded or displayed on an article, GUI designs provided via network and GUI designs projected onto a wall would all be regarded as protectable industrial designs under the revised Design Act. As the new legislation would come into force next year, the Delegation informed the Committee that it had provided answers to the questionnaire based on both the existing and the revised law. The Delegation expressed the hope that the recent legislative change in Japan would serve as a good example on the approach in that emerging area of industrial design protection. The Delegation pointed out that the Committee had traditionally been known as the “SCT”, although it also addressed important issues concerning industrial designs, such as the DLT and the protection of GUI designs. The Delegation observed that, in the past, industrial designs had been given less attention than other IP rights, but today, more attention should be paid to the importance of protecting industrial designs, as they were a key factor of innovation and economic development. For that reason, the Delegation held the view that an abbreviation of the terms “industrial designs”, for example the letter “D”, should be added to the abbreviated title of the Committee. Such a small change could make a major contribution to the promotion of international discussions on the protection of industrial designs.

29. The Delegation of the European Union, speaking on behalf of the European Union and its member states, recalled that, at recent SCT sessions, most delegations, including the European Union and its member states, had been in favor of further work, in particular on the tie between the product and the design and its effect on the scope of protection, as well as on the representation of animated GUIs. Sharing the common understanding that existing divergences should be directly addressed and that further work on those issues could pave the way for a more harmonized approach, the Delegation had welcomed document SCT/41/2 Prov., considering that the document set out responses in a clear, coherent and appropriately detailed manner. The Delegation had also endorsed the extension of the deadline to submit additional responses and thanked SCT members for their further contributions and the Secretariat for the compilation, which included information on the common practice developed by the EUIPO. While the document did not constitute the first survey on the topic, the Delegation reiterated the view that it was the most up-to-date and detailed one. In its opinion, the new survey explored, by means of specified and additional questions, issues such as the link between GUI and icon designs with the product indication, the use and effect of disclaimers, prior art searches and requirements for animated designs. Considering that the wealth of information resulting from the responses would prove useful in further debates on GUI, Icon and Typeface/Type Font Designs within the Committee, the Delegation expressed its full support for the compilation, which could be used as a reference for further work on selected pertinent issues. Welcoming the proposal submitted by the delegations of Japan and the United States of America in document SCT/42/6, the Delegation expressed its support to the adoption of a Joint Recommendation, as a practical way forward to achieve a more harmonized approach in relation to industrial design protection for GUI designs. While fully endorsing the rationale to provide for at least a baseline standard of protection for GUIs, the Delegation looked forward to discussing that proposal and announced that it would make detailed suggestions on the text of the draft recommendations in a later stage. The Delegation reiterated the view that, although issues concerning novel technological designs were interesting and relevant, there was a need to first solve existing problems in the field of currently known forms of GUI and icon designs, and lent its support to a phased approach. Nonetheless, the Delegation remained interested in hearing more from users associations about other novel technological designs. Regarding the proposal submitted by the Delegation of Spain on the protection provided for by Article 11 of the

Paris Convention for the Protection of Industrial Property, the Delegation thanked the Secretariat for preparing a compilation of responses to the questionnaire, contained in document SCT/42/2 Prov. The Delegation held the view that the replies revealed considerable divergences in practice on a number of pertinent questions and most importantly on the criteria established to determine what qualified as an official or officially recognized international exhibition. Expressing its support for the continuation of the discussion on that issue, the Delegation proposed the organization of an information session on that matter to explore users' needs and national experiences and share best practices among offices.

30. The Delegation of Croatia, speaking on behalf of the CEBS Group, reiterated its support to further discussions on GUIs and thanked both the Member States for their responses to the questionnaire, and the Secretariat for the compilation, including information provided by the EUIPO. Considering that the results were relevant insofar as they clarified the link between the product and the design, as well as the use and effect of disclaimers, prior art searches and the representation of animated designs, the Delegation expressed the hope that the work would enable greater harmonization. The Group thanked the Delegations of Japan and the United States of America for their proposal contained in document SCT/42/6, which provided ideas for a practical way forward related to industrial design protection for GUI designs. Looking forward to discussing the issue, the Group was of the opinion that a baseline standard of protection for GUIs would be very useful. Nonetheless, the Group reiterated the need to address first unresolved differences in the field of GUI, Icon and Typeface/Type Font Designs, in order to reach a common understanding on current issues, and to explore, at a later stage, challenges linked with other novel designs. Finally, the Group thanked the Delegation of Spain for the proposal contained in document SCT/40/8 aiming at understanding how Member States implemented Article 11 of the Paris Convention, as well as the Secretariat for preparing a compilation of the responses in document SCT/42/2 Prov. As the answers revealed divergences in practices among Member States, the Group was in favor of further discussions, which could take the form of an informal session on official or officially recognized international exhibitions.

31. The Delegation of the Russian Federation, speaking on behalf of the CACEEC Group, thanked the Secretariat for the work on GUIs and noted the importance of sharing experience concerning their registration as industrial designs. The results of the survey comprehensively reflected the practice of GUIs protection in WIPO Member States and confirmed the growing interest in registering GUI, Icon and Typeface/Type Font Designs. The development of GUI designs in the context of large-scale digitalization processes encouraged both designers and intellectual property offices to envisage protecting new and creative designs. Considering that it was appropriate to determine the relationship between the GUI or icon design and the product, as well as to discuss the protection of animated designs, the Group believed that the results of the study constituted a good basis for further information exchange. In addition, the questionnaire could be supplemented with new problematic issues faced by intellectual property offices and designers when registering GUI designs. In particular, the Group expressed its interest in examining the form of representation of animated designs and explained that, in the countries of the region, those designs were represented by two-dimensional images showing the movement. However, the development of modern technologies and the existence of various technical solutions called for an expansion of the study in that regard. Finally, the Delegation thanked the Delegations of Japan and the United States of America for having prepared a draft Joint Recommendation and expressed the Group's support for the initiative aiming at generalizing effective national and regional GUI protection practices, including on the representation of animated GUIs.

32. The Delegation of the United States of America, echoing the comments made by other delegations, said that industrial designs, in particular GUIs, would continue to play an important role in intellectual property, as industries kept on modernizing and progressing. Thanking the

Secretariat for the questionnaire, which provided a valuable reference for offices and users in the international landscape, the Delegation looked forward to continuing the discussion on that topic.

33. The Delegation of Iran (Islamic Republic of) extended its gratitude to the Member States that had provided inputs to the questionnaire on GUI, Icon and Typeface/Type Font Designs, and its appreciation to the Secretariat for having compiled the replies. The Delegation suggested that the Secretariat prepare an analytical document based on the responses, to be considered by the SCT at its next session. In the Delegation's viewpoint, such document would be useful to better understand the divergences among Member States in order to decide on the way forward.

34. At the Chair's invitation, the Delegation of the United States of America, thanking the Delegation of Japan for its collaboration, introduced the Joint Recommendation proposal, underlining the increasing importance and uniqueness of GUI designs, given their use in new environments not envisioned decades ago. The Delegation recalled the work undertaken by the SCT since 2016 with two questionnaires on the topic and the holding of an Information Session focusing on practices of offices and experiences of users. Following the request for proposals for further work, the proposal contained in document SCT/42/6 had been prepared on the basis of the replies to both questionnaires, as well as users' recommendations. Highlighting that the document proposed a "recommendation", in line with the desire for flexibility expressed by a number of delegations, the Delegation clarified that the proposal would not oblige any jurisdiction to implement those recommendations. Finally, the Delegation looked forward to hearing from user associations.

35. The Delegation of Japan added that, in the context of the rapid increase in the use of GUIs, the importance of protecting GUI designs had been widely recognized by users of design systems around the world. As highlighted by the work of the Committee, the ways of protecting GUI designs significantly differed in respective jurisdictions. Therefore, with a view to ensuring international consistency of the protection of GUI designs and for the benefit of the users of the design system, the Delegation of Japan, in cooperation with the Delegation of the United States of America, wished to contribute to the discussion through a Joint Recommendation on Industrial Design Protection for GUI Designs.

36. The Delegation of the Republic of Korea thanked the Member States for their participation in the questionnaire, as well as the Delegations of Japan and the United States of America for having prepared the proposed Joint Recommendation contained in document SCT/42/6. The Delegation considered that such proposal was a progressive move towards a common practice in GUI design protection, enhancing the creation of new types of designs based on the development of technology. In the framework of the increasing demand for protection of GUI designs, the Delegation supported the initiative for a Joint Recommendation to promote GUI design protection, which would increase the credibility of their protection.

37. The Delegation of Canada, thanking the Delegations of Japan and the United States of America for the initiative outlined in document SCT/42/6, expressed its interest in engaging further on the issue of GUIs, as continued work would assist in developing and understanding the various approaches to provide rights for those designs. Expressing support for the proposal, the Delegation looked forward to commenting the text to advance the work on GUI designs.

38. The Delegation of Spain supported the proposal put forward by the Delegations of Japan and the United States of America, as outlined in document SCT/42/6, which introduced the important question of the protection of GUIs as designs and brought together the best practices around the world, including Convergence Practice 6 in the European Union.

39. The Delegation of Iran (Islamic Republic of), thanking the co-sponsors for their proposal contained in document SCT/42/6, recognized that document SCT/41/2, which compiled the inputs received from Member States, was an informative and helpful tool for future discussion in the Committee. However, the Delegation considered it difficult to identify in the document the current divergences and commonalities among Member States and the different national regimes. The Delegation reiterated the request that the Secretariat prepare an analytical document based on the responses and submit it for consideration by the Committee. Such a document would be a reference for discussion on the most appropriate action to be undertaken by the Committee on that agenda item, including in-depth discussion of the proposal contained in document SCT/42/6.

40. The Delegation of Morocco thanked the Secretariat for the compilation of responses in document SCT/41/2, which represented a very good information document on GUI designs. Expressing its appreciation to the Delegations of Japan and the United States of America for the proposal for a Joint Recommendation, the Delegation believed that the document deserved to be considered more deeply. In conclusion, the Delegation expressed its readiness to follow with interest exchanges and clarifications on the subject, in order to be able to give its opinion at a later stage.

41. The Delegation of Australia supported the proposal and thanked the Delegations of Japan and the United States of America for having prepared it. The Delegation informed the Committee that the Intellectual Property Office in Australia had undertaken a holistic review of the design system. The review considered, in particular, how to better accommodate new types of designs through legislative amendments and/or adjustments of practice. In addition, the Office had initiated a qualitative and quantitative research to identify areas for improvement of the design ecosystem from the users' perspective. The Delegation pointed out that one of the key issues identified was the role of design rights and the development of new technologies. Considering that the draft Joint Recommendation was very informative, the Delegation expressed its interest in hearing the opinion of other delegations.

42. The Delegation of China said that the protection of GUIs was a delicate issue and that users were calling for better protection of those designs. The Delegation was of the opinion that further study of that issue would lead to a better understanding and allow Member States to improve their own protection regime. Reporting that China had amended its patent examination guidelines, including GUIs, and had improved the protection for GUIs in order to respond to users' needs, the Delegation expressed its willingness to share its practice and learn from other Member States' best practices.

43. The Delegation of the Republic of Moldova, thanking the Delegations of Japan and the United States of America, supported the discussion on document SCT/42/6 and announced its readiness to continue working on the best way to protect GUI designs.

44. The Delegation of Uganda, speaking on behalf of the African Group, thanked the Secretariat for the compilation of the replies to the questionnaire on Graphical User Interface, Icon and Typeface/Type Font Designs, and the Member States for their responses. The Group also expressed its appreciation to the Delegations of Japan and the United States of America for the proposal of a Joint Recommendation on that issue. Observing that less than half of the WIPO membership had participated in the questionnaire, the Delegation said that a large majority of developing countries from all regions had not yet given any indication on whether GUIs were eligible for design protection in their jurisdictions. Considering that the questionnaire was not a sufficiently representative sample on which future work of the Committee on that issue could be based, the Group strongly warned against any norm-setting discussion on that matter at that stage. Therefore, the Delegation held the view that an exploratory work was necessary to build a common understanding in a broad membership of WIPO. In particular, the Group called for a demonstration of the need and rationale to extend the protection to such

technological designs. The Delegation expressed concerns about requests to deviate from the long-standing principle of fixing a design on a specific article, as there was no justification for making GUIs protectable as designs as such, rather than as part of a product on which they had been placed as an ornamental or aesthetic aspect. In addition, the Group expressed the view that the Committee should study the possible existence of gaps, or if GUIs could be sufficiently protected by existing intellectual property regimes (e.g., design laws, patents and copyrights). As requirements could vary between different jurisdictions, the Group suggested that Member States share their respective experiences with the implementation of GUI rights at the national level, as well as concerning the criteria for the determination of infringement. Suggesting that the Secretariat undertook a study on the economic implications, for the innovative efforts of micro, small and medium-sized enterprises in developing countries and least developed countries (LDCs), of extending GUIs protection, the Group announced its readiness to submit a formal proposal accordingly.

45. The Delegation of Israel welcomed the proposal made by the Delegations of Japan and the United States of America, as contained in document SCT/42/6. While the number of design applications for GUI designs under class 14.04 had increased in Israel, a further growth was expected after the entry into force of the Hague Agreement Concerning the International Registration of Industrial Designs, in the beginning of 2020. The Delegation expressed the view that sharing experiences and developing common practices would allow applicants to better protect their designs, enable users to plan their strategy and assist intellectual property offices with the registration process. The Delegation therefore supported the proposal for a Joint Recommendation and looked forward to the substantive discussion on the text and the opportunity to suggest improvements and additions. Moreover, the Delegation supported the proposal made by the Delegation of the European Union to keep the questionnaire on GUI, Icon and Typeface/Type Font Designs open for additional responses in order to get useful information on that important topic, in parallel to the normative work on the Joint Recommendation.

46. The Delegation of Chile, thanking the Delegations of Japan and the United States of America for the proposal contained in document SCT/42/6, recalled that it had closely followed the discussion on that item and had replied to the questionnaires. The Delegation expressed the wish to know more about the status of protection afforded in different Member States. Expressing the view that any proposal considered by the Committee should be sufficiently flexible so that each Member State could maintain the current protection established in its legislation, the Delegation suggested to look at the issue from different perspectives, for instance through a document on best practices. The Delegation expressed its readiness to continue working on industrial design protection for GUI, Icon, Typeface/Type Font Designs, and to consider the different legislations of all Member States.

47. The Delegation of Georgia expressed its appreciation to the Delegations of Japan and the United States of America for their proposal contained in document SCT/42/6 and supported further discussions regarding that important issue.

48. The Delegation of Ecuador, endorsing the statement made by the Delegation of Mexico on behalf of GRULAC, acknowledged the compilation of the replies to the questionnaire and welcomed the proposal made by the Delegations of Japan and the United States of America. The Delegation felt that new forms of protection for GUIs were important, reflecting the legislations of different members, without excluding those that did not have yet the capacity or ability to apply precise technical criteria to manage those creations through industrial designs. The Delegation considered that clear guidelines, easily understood and applied in the different States, would overcome any doubt or concern about the new forms of protection described in the document under consideration.

49. The Delegation of the United States of America explained that the purpose of the proposed Recommendation No.°1 was to encourage industrial design protection for new and original GUI designs. Stressing the fact that GUI designs could change over time, the Delegation said that the Recommendation No.°2 intended to prevent applicants, wishing to protect GUI designs, from being bound by the technical limitations of an underlying computer. As requested by users, Recommendation No.°3 aimed at providing applicants with more flexibility in the representation of the designs. However, recognizing that offices should have some discretion, the proposed recommendation provided, as a safeguard, that the representation should sufficiently disclose the industrial design claimed.

50. The Delegation of Israel supported the proposed Recommendation No.°3, which required offices to accept all kinds of representations, such as black and white photographs, color photographs, drawings, or other electronic or digital means of representations. Moreover, the Delegation suggested adding that Parties could require that a GUI design be represented by a single form of representation per application, in order to avoid mixing different types of representations.

51. The Representative of INTA welcomed the initiative of the Delegations of Japan and the United States of America and supported the proposal, in particular Recommendation No.°3, which was important for the users of the system.

52. The Delegation of the United States of America, recognizing that the Delegation of Israel had raised an important concept, indicated that, in practice, the national office applied limitations with regard to mixing different types of representations. The Delegation was therefore open to continue discussions on that issue. Then, turning to Recommendation No.°4, the Delegation observed that since GUI designs were frequently used in a number of different screen environments, requiring filing an application for every type of screen display would be costly for applicants. Indeed, some jurisdictions around the world allowed GUI designs to be protected in multiple screen environments, using for example disclaimers for the underlying product. The aim of the provision was to provide flexibility and to allow screen designs to be claimed, although a relation to a product or an article could still exist.

53. The Representative of INTA, supporting that item, stressed that it was a key element of the proposed Joint Recommendation and recalled that INTA had provided various contributions in that regard.

54. The Delegation of the United States of America, recalling previous discussions on transitional and moving images, said that the impetus behind Recommendation No.°5 was the importance of effective and accurate registration of GUI designs.

55. The Delegation of Israel, referring to Part III of the proposed Joint Recommendation entitled "Application for a Registered Industrial Design Right", suggested adding a recommendation for a requirement for the description of visual features of the GUI design. Informing the SCT that Israeli Design Regulations required that an application for GUI animated design contain a description of the visual presentation of the design, in addition to a sequence of images representing the progress of animation, the Delegation proposed that the recommendation stated that Parties could require that an industrial design application for a GUI design be accompanied by a description of the visual presentation of the design.

56. The Delegation of the United States of America expressed the view that the recommendations were broad and that the proposed wording by the Delegation of Israel would fall under those provisions. The Delegation, however, expressed its readiness to discuss the proposed wording.

57. The Delegation of Brazil, referring to the wording of Recommendation No.°5, namely the terms “moving image features or that include a number of views visually related and numbered to give a clear idea of the progression”, said that Brazil’s legislation provided for the protection of each static image separately in a moving sequence. In that sense, the Delegation should analyze how its legislation would fit into Recommendation No.°5.

58. The Delegation of the United States of America wondered if, to the extent an applicant wanted to protect a GUI design that had some transition, it would be acceptable under Brazil’s legislation to submit, whether via paper or a PDF file, a series of static images in a sequence to illustrate the movement of the design.

59. The Delegation of Brazil confirmed that that was the practice and that static images would be protected separately.

60. The Delegation of the United States of America, turning to Recommendation No.°6, said that its essence was to ensure the same treatment to GUI designs as for other industrial design applications. The phrase “and substance where applicable” merely indicated that the jurisdictions providing for substantive examination would examine GUI designs in the same way as other industrial designs. Recognizing that electronic exchange facilitated applicants’ work, the Delegation suggested providing, in Recommendation No.°7, some mechanisms which would allow applicants to electronically fulfill the requirement to provide certified copies and other documentation with respect to priority claims. As a non-exhaustive example, WIPO DAS was mentioned. The Delegation further indicated that Recommendation No.°8 stated that the right granted to GUI designs should be like other industrial design rights generally. Recommendation No.°9 recognized in a similar manner that GUI designs should be treated in the same way as other industrial designs with respect to infringement. The Delegation gave as example the test for infringement applicable in its country, namely the ordinary observer test which dated back to 1800 from a Supreme Court Case and which applied in the same way in respect to an automobile design and a GUI design. In conclusion, the Delegation said that Recommendation No.°10 provided that the duration of protection for a GUI design should be the same as for other industrial designs and no shorter than the time period provided for in The Hague Agreement Concerning the International Registration of Industrial Designs, *i.e.*, at least 15 years of protection, which included the initial term of protection of five years, renewable for two additional terms of five years.

61. The Delegation of Iran (Islamic Republic of), expressing the view that the discussion in the Committee at the current stage was about exploring country practices regarding the protection of new technological designs, believed that more time and preparatory work was necessary to reach a common understanding on different aspects before moving forward to any norm-setting practice. Pointing out that the discussion on the proposed draft Recommendations should not create any understanding that the Committee was in agreement to develop Joint Recommendations, the Delegation expressed its support for the proposal made by the Delegation of Uganda, on behalf of the African Group, to undertake a study on the economic implications of the extension of intellectual property rights protection to GUI designs on the innovation efforts of micro, small and medium-size enterprises in developing countries and least developed countries.

62. The Chair, thanking the Delegations of Japan and the United States of America for the presentation of document SCT/42/6, noted that the discussion of the proposal had been endorsed by several delegations. Different viewpoints had been expressed as to the nature of the document and as to the stage of discussions on GUI designs. Highlighting that the SCT had been discussing new technological designs over several sessions, two questionnaires had been circulated and an Information Session had been organized, the Chair proposed to continue the work on the document, while collecting additional information on the topic.

63. The Delegation of Spain, lending its support to the proposal by the Chair to collect additional information, encouraged delegations to analyze the draft recommendations and to compare them with the relevant provisions in their national legislation to find out the differences between the draft recommendations and national practices. The Delegation believed that, in that way, the SCT would have an overview of the real difficulties encountered and the impact of adopting those recommendations, and would be able to move forward.

64. The Delegation of the United States of America, expressing its appreciation to all the interventions made by delegations on the draft recommendations, said that it was amenable to continue the work as per the Chair's guidance. As it was a first discussion on the topic, the Delegation believed that the input of other SCT members was helpful and looked forward to further comments between the current and the next SCT session, to improve and to better address the needs of users as well as of intellectual property offices. The Delegation expressed its openness to the Chair's proposal and expressed its support for the intervention by the Delegation of Spain, considering that it was a thoughtful approach.

65. The Delegation of Iran (Islamic Republic of) asked the Chair whether the document would be updated by the co-sponsors, based on the comments received, and resubmitted at the next SCT session for discussion.

66. The Chair, in reply to the Delegation of Iran (Islamic Republic of), said that the original proposal to update the document had been enriched by the suggestion made by the Delegation of Spain.

67. The Delegation of Uganda, speaking on behalf of the African Group, said that it had not the opportunity to engage in the discussion of the proposed Joint Recommendations. As a general comment, the Delegation believed that the topic had not yet been substantially discussed in the Committee and that more exploratory work was needed, recalling that the Group had submitted a proposal for an additional study.

68. The Delegation of Iran (Islamic Republic of), in reply to the Chair's suggestion to collect additional comments on the document, as per the suggestions made by the Delegations of Spain and Uganda, reserved its right to decide, based on the Summary by the Chair in writing. The Delegation further requested the Secretariat to analyze and present document SCT/41/2 in a more user-friendly manner in order to better assist future discussions on GUI designs.

69. The Chair concluded that the Secretariat was requested to:

- keep document SCT/41/2 open until January 10, 2020, for further or revised replies by delegations;
- prepare a document analyzing all replies, for consideration of the SCT at its next session;

70. The Chair concluded that discussion on document SCT/42/6 would continue at the forty-third session of the SCT.

Temporary Protection Provided to Industrial Designs at Certain International Exhibitions Under Article 11 of the Paris Convention for the Protection of Industrial Property

71. Discussions were based on document SCT/42/2 Prov.

72. The Secretariat drew the attention of the Committee to the Annex of document SCT/42/2 Prov., which compiled the returns to the Questionnaire on the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions under Article 11 of the Paris Convention for the Protection of Industrial Property submitted by 48 Member States and two Intergovernmental Intellectual Property Organizations with observer status. The Secretariat highlighted the provisional nature of the document, in view of allowing responding SCT members to check whether their answers had been accurately reflected and other SCT members to submit their replies. The Secretariat announced that amendments and additional replies would be included in the final version of the document.

73. The Delegation of Spain, thanking the Secretariat for having drafted the questionnaire and having compiled the returns, said that it carried out a preliminary study. Noticing a lack of uniform interpretation amongst Member States on Article 11 of the Paris Convention, the Delegation raised the concern that that could lead to a variety of impacts on users as to the prolongation of the protection of their designs. Bearing that in mind, the Delegation called to continue the work on the study, encouraging the countries that had not submitted replies to do so. In addition, the Delegation suggested organizing an information session to allow users to raise their concerns and voice the difficulties they encounter in practice. The Delegation believed that those two measures would help the SCT to continue the debate in a constructive manner and enable to draw appropriate conclusions.

74. The Delegation of the Russian Federation, speaking on behalf of the CACEEC Group, thanked the Secretariat for the informative document on the application of Article 11 of the Paris Convention and informed the Committee that the legislation of the CACEEC Group countries provided for a grace period for filing applications for industrial designs if displayed in an exhibition. In that regard, the Delegation expressed its interest to learn about the practices of establishing the exhibition priority. The Delegation further noted that the lack of recommendations regarding the classification of exhibitions as official or officially recognized international had caused difficulties in the application of Article 11 of the Paris Convention in relation to both industrial designs and trademarks. The Delegation believed that for the applicants it was important to know that the right of priority arising in connection with the display of an industrial design in an exhibition would be recognized in other states when filing for registration. Expressing the view that it was relevant to study the practice of determining exhibitions as official or officially recognized international as per Article 11 of the Paris Convention, the Delegation concluded that the results of such a study could have practical value and could become a basis for preparing recommendations in respect of exhibition priority.

75. The Delegation of the United States of America, thanking the Secretariat for the preparation of the document, said that the compilation of the returns certainly added to the body of information and was a great resource for users to help navigate various intellectual property systems. Thanking also the Delegation of Spain for its leadership and for its proposal, the Delegation agreed that a possible way forward was to hear from users, those most knowledgeable, in an information session on that topic.

76. The Chair, in reply to a clarification sought by the Delegation of Chile on the possibility to submit additional replies to the Questionnaire, indicated that the document was provisional and additional replies were expected and would be incorporated in a final version of the document.

77. The Chair concluded that the Secretariat was requested to:

- keep the document open until January 10, 2020, for further replies by delegations;
- finalize the document thereafter and present it for consideration by the forty-third session of the SCT;

- organize a half-day information session that would take place during the forty-third session of the SCT, addressing (i) the practices of offices and (ii) the experience of users, with regard to the temporary protection provided to industrial designs under Article 11 of the Paris Convention.

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

78. The Chair, recalling that the SCT continued to take stock of the progress made in the use of the DAS for priority documents in respect of industrial design applications, invited the delegations to inform the Committee on latest developments.

79. The Delegation of Australia, announcing that the digital library on the DAS had been expanded on November 1, 2019, to include trademarks and industrial designs, believed that the expansion would benefit users as it would streamline processes when seeking protection in other countries. Encouraging other SCT members to consider implementing or extending the DAS to other intellectual property rights such as trademarks and designs to make the DAS an increasingly valuable tool for applicants globally, the Delegation thanked WIPO for its continued support and for working closely with IP Australia to ensure the smooth expansion of the DAS.

80. The Delegation of Israel, expressing the view that the DAS had important advantages for applicants and intellectual property offices, announced that the Israel Patent Office was taking steps towards the implementation of the DAS for industrial designs by July 2020.

81. The Delegation of the United States of America, congratulating the Delegation of Australia on the latest development, noted with interest that Israel would implement the DAS in the near future, which would bring the number of countries using the system to 10. The Delegation reported that stakeholders in the United States of America had expressed in meetings with the USPTO their deep appreciation for the DAS, and were closely monitoring the number of countries using that system, as it was important to their practice in pursuing design rights. Congratulating the delegations which had moved forward with the implementation of WIPO DAS, the Delegation expressed its appreciation for the new user-friendly interface, noting that it had become possible to do searches by the type of intellectual property right to identify the countries using that system.

82. The Delegation of Chile, informing the SCT that the Chilean Industrial Property Office had been successfully using the DAS in respect of patents and industrial designs since October 2018, announced that the Office was currently working with a technical unit in WIPO to implement the system for trademarks. Considering the benefits and usefulness of that tool, the Delegation encouraged other Member States to also make use of the DAS.

83. The Chair concluded that the SCT would revert for an update to this item at its next session.

Letter from the Chairman of the State Committee on Science and Technology of Belarus to the Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)

84. The SCT considered document SCT/42/7.

85. The Chair, recalling that the 2019 WIPO General Assembly had not reached an agreement to convene a diplomatic conference on the adoption of the DLT, said that several delegations had offered to host such a diplomatic conference if the General Assembly decided to convene one. Pointing out that the SCT could make a proposal to that end to the next WIPO

General Assembly in 2020, the Chair invited the Delegation of Belarus to present the offer from Belarus to host the diplomatic conference for the adoption of the DLT, contained in the letter from the Chairman of the State Committee on Science and Technology (document SCT/42/7).

86. The Delegation of Belarus presented the letter by Mr. Alexander Shumilin, Chairman of the State Committee on Science and Technology of Belarus, contained in document SCT/42/7. The Delegation said that the President of Belarus, in a meeting with WIPO Director General, held on June 4, 2019, had offered to host the diplomatic conference for the adoption of the DLT in Minsk, Belarus, if a decision to convene a diplomatic conference on the adoption of the DLT was taken by the WIPO General Assembly in 2019. The Delegation expressed the regret that the 2019 WIPO General Assembly had not reached an agreement on that issue and called upon all interested parties to collaborate and find a consensus on the outstanding issues.

87. The Chair, thanking the Delegation of Belarus for the invitation, said that the SCT could decide to make a proposal to the WIPO General Assembly in 2020 to convene a diplomatic conference, and invited the delegations to express their opinions on that regard during the SCT session.

AGENDA ITEM 5: TRADEMARKS

Revised Proposal by the Delegation of Jamaica (document SCT/32/2)

88. Discussions were based on document SCT/32/2.

89. The Delegation of Jamaica recalled that since the thirty-second session of the SCT in 2014, it had placed on the table a draft Joint Recommendation for the Protection of Country Names, so as to facilitate discussion, within the SCT, on possible solutions to that problem. Considering that several possible solutions had been presented to the SCT, the Delegation held the view that the Committee should conceive the most workable solution to the problem. Therefore, the Delegation asked for a constructive engagement of Member States. The Delegation added that, by reflecting on the provisions of the draft Joint Recommendation, the Committee could ensure that the areas of convergence were included into the draft and that a suitable language could be sought to address those areas where there was no convergence and where there was a need for flexibility and discretion at the national level, based on the existence of particular circumstances. Recognizing that there were exceptional circumstances, under most national trademark laws, in which a trademark with a country name in relation to goods or services not originating in the named country could nonetheless be registered, Jamaica's draft Joint Recommendation proposed language in Articles 6 and 7 that would provide agreed parameters for those exceptional circumstances. The Delegation reiterated that the aim of the proposed draft Joint Recommendation was not to create mandatory rules, but to establish a coherent and consistent framework to guide intellectual property offices through the issue. The Delegation said that it looked forward to the Member States' constructive engagement and remained hopeful that a solution could be found in such a way as to enjoy the consensus among SCT member States.

90. The Delegation of Switzerland recalled that it supported the proposal by the Delegation of Jamaica and its approach, stressed the importance for the Committee to work on the establishment of solutions to solve efficiently the issue of deceptive marks, namely marks consisting of, or containing, a country name in relation to goods or services not originating in the country indicated by the country name. The Delegation announced its commitment to continue working on the subject.

91. The Delegation of Monaco, sharing the concerns expressed by the Delegations of Iceland, Jamaica and Switzerland and other delegations, supported, as co-sponsor, the proposal contained in document SCT/39/8 Rev.3. Recalling that, since its first presentation in 2014, it was in favor of the main underlined principles of the proposal by the Delegation of Jamaica, the Delegation considered that the problem in the trademark system was that it did not offer a uniform and predictable protection to country names. Therefore, the Delegation hoped that the Committee could reach a tangible outcome for a better harmonization of practices in that area.

92. The Delegation of Jamaica, recalling that, because, over 30 years, concerns had been raised by States internationally about the lack of protection of country names, it had put forward a proposal on that matter, for the Committee's consideration, at the twenty-first SCT session, in June 2009. Then, the Secretariat had drafted a questionnaire on the protection of official names of States against registration and use as trademarks and had compiled the returns to that questionnaire in document SCT/24/6. As a result, at the thirty-first SCT session, in March 2014, the Delegation had presented a revised version of its proposal, as contained in document SCT/31/4. Based on comments received at that session, the proposal had been revised further, as reflected in document SCT/32/2. In essence, the Delegation pointed out that the proposed Revised Draft Joint Recommendation Concerning Provisions on the Protection of Country Names aimed at protecting country names against conflicting trademarks, business identifiers and domain names. Outlining that the proposal sought at preventing the use of indications consisting of, or containing, country names in relation to goods or services not originating in the country indicated by the country name, the Delegation indicated that the proposal's objective was to bring consistency into the examination of applications for trademarks that consisted of, or contained, country names, in order to promote consistent and comprehensive treatment and protection of country names among Member States. The Delegation observed that the joint recommendation in the proposal heavily drew from existing joint recommendations, namely the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, the Joint Recommendation Concerning Trademark Licenses and the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs on the Internet. Therefore, the proposal took from existing principles in other areas considered by the Committee in the past. Subsequently, in view of outlining the main provisions of the proposed joint recommendation, the Delegation firstly indicated that Article 1 contained definitions of terms used in the proposed text, which had been slightly adapted from the preexisting joint recommendations. Turning to Article 2 of the draft joint recommendation, the Delegation, pointing out that it related to the protection of country names in case of bad faith applications, recognized that the concept of bad faith was not necessarily defined in many Member States, so that the application of the provision would be left to broad national considerations. Observing that the revised proposal contained track changes showing the difference between the original proposal and the current proposal, the Delegation remained flexible to revert to any of the provisions contained in the original proposal, as it was aware that the latter could have offered more flexibility for Member States than the current revised proposal. Then, focusing on Article 3 of the draft joint recommendation as to conflicting marks, the Delegation stated that the provision aimed at guiding Member States in case of conflict between a trademark application and a country name. The Delegation pointed out that the revised proposal referred to goods or services not originating in the country indicated by the country name, whereas the original proposal had referred to other factors indicating a false connection and had as such offered more flexibility in accepting trademarks with a country name. Under Article 3, it should be permissible for the relevant Member State identifiable by a country name to take action under the trademark system where it perceived that its country name could be subject to misappropriation. Turning to Article 4 of the draft joint recommendation concerning conflicting business identifiers, and primarily business names, the Delegation draw the Committee's attention to the fact that the provision had been taken largely from the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks. Although it recognized that the proposed provision would not necessarily fit into existing trademark systems of most Member States –being more applicable to company or business

name registers— the Delegation nonetheless pointed out that the provision's principle was the same as it aimed at prohibiting and preventing business names which would conflict with established country names. Then, concentrating on Article 5 of the draft joint recommendation as to conflicting domain names, the Delegation stressed that its principle was to prevent conflicts where the domain name would consist of, or contain, a country name without any genuine connection between the domain name and the country indicated by the country name. Similarly, the objective was to enable Member States to prevent, invalidate or prohibit conflicting domain names not connected to the Member States. Referring to Article 6 of the draft joint recommendation, the Delegation indicated that it sought at providing guidance for Member States, but no prescriptive rules, as to whether to refuse a mark with a country name. The provision, based on the Study on the Protection of Country Names, contained in document SCT/29/5, listed some factors that would justify the refusal of a trademark. In contrast, the Delegation indicated that Article 7 of the proposed joint recommendation provided guidance as to whether accepting a trademark with a country name. The Delegation observed that both Articles 6 and 7 sought at streamlining circumstances where a trademark office would reasonably refuse or accept the registration of a mark with a country name. Then, the Delegation mentioned that Article 8 of the proposed joint recommendation concerned opposition and invalidity procedures and Article 9 related to unfair competition or passing-off, already contemplated in most Member States trademark laws. Finally, the Delegation observed that, in the original proposal, Article 10 of the proposed joint recommendation had listed factors for determining a false connection to a Member State, those factors having been taken from the Joint Recommendation Concerning Provisions on the Protection of Trademarks, and Other Industrial Property Rights in Signs on the Internet. While recognizing the support lent by some SCT members to its proposal and thanking other members for their comments, Delegation expressed its willingness to further revise its proposal based on the Member States' views expressed during the session.

93. The Delegation of the United States of America, after having thanked the Delegation of Jamaica for the explanation of its proposal, recalled that it had, in the past, already intervened on the proposal and its previous draft. The Delegation stated that it remained concerned about the breadth of the proposal, as the latter amounted to saying that the SCT would conclude that the use of a country name, in all the different forms mentioned in the proposal, would be likely to deceive the public as to the origin of the goods or services. In the Delegation's viewpoint, that was not factual in every case because the context of the use provided information on its perception and the consumer's perception was the key element to evaluate whether a sign was protectable and registerable. For that reason, the Delegation considered that stating that consumers would *per se* be deceived when seeing a country name in a mark, a trade name, a business identifier or a domain name, was not true. Although many delegations would like that to be real, the Delegation, expressing the view that a statement from the SCT claiming that it was true would be overstepping, declared that it was not in a position to align itself with such a statement. Quite the reverse, the Delegation stressed the need to work to avoid making such a statement and to prevent contemplating every possible permutation of a country name since that was overbroad. It would, in particular, be very difficult to reach to business identifiers, as many countries had different regulatory systems for those, which did not necessarily belong to the intellectual property system, and to domain names. Considering that, if the Committee would continue discussing the document, it should be narrowed, the Delegation expressed appreciation to the Delegation of Jamaica for thinking of revising the document and announced that it would be happy to participate in the process.

94. The Delegation of Japan stated that it understood that the proposal submitted by the Delegation of Jamaica created a rule protecting country names, even though they were not likely to be misunderstood by consumers. For the Delegation, such a rule would impose a heavy burden on trademark applicants and restrict the use of registered trademarks. Because

raising too many restrictions on the registration and the use of trademarks could hinder economic activities by companies, the Delegation believed that the matter should be discussed carefully.

95. The Delegation of Ethiopia indicated that, in its country, country names were already protected as the trademark law contained a provision on the protection of country name, symbols and designs used to represent a country.

96. The Delegation of Ecuador, highlighting the significance of the country names issue and their protection against registration and inappropriate use, reported that the matter was reflected in its legislation, at the constitutional level and at other levels. The Delegation referred, in particular, to Articles 411 to 414 of the Organic Code on the Social Economy of Knowledge, Creativity and Innovation that provided for the protection of country names. The Delegation outlined that, in Ecuador, a mark with a country name could be registered only where it did not create any confusion as to the applicant and the country at stake and no registration would be granted where consumers could believe that there was an official support from the country through the mark. Thanking the Delegation of Jamaica for its proposal and expressing support for the proposal contained in document SCT/39/3 Rev. 3, the Delegation announced its willingness to participate actively in the discussion.

97. The Delegation of China, thanking the Delegation of Jamaica for the presentation of its proposal, commended all delegations for the comments made at previous SCT sessions, which had helped the Committee to understand the means of protecting country names in different countries. Stressing the importance of the protection of country names, the Delegation held the view that the subject needed to be studied carefully. Considering that the law and practice on the topic which varied from country to country should be taken into consideration as they could have an impact on the proposal, the Delegation outlined the practice followed in China. Regarding the acceptance of a trademark consisting of a country name, the Delegation stated that the office checked the distinctiveness of the mark and its scope of protection. Since countries used different languages and did therefore understand country names differently, the Delegation pointed out that its practice related to official country names. In that respect, the Delegation stressed the need to define country names to provide a better basis for discussions and to carry out a larger study with a view of determining whether adjectives related to country names should also be protected.

98. The Delegation of Norway, after having thanked the Secretariat for the preparation of the session, acknowledged the importance attached by SCT members to discussions on protection of country names. The Delegation recalled that, over many years, the Committee had collected information, organized information sessions and issued a reference document on the Protection of Country Names Against Registration and Use as Trademarks. Considering that maintaining a trademark system efficient and flexible for users was essential and that the existing legislation was, in general, sufficient to prevent inappropriate monopolization and misuse of country names, the Delegation saw no merit in introducing new requirements. In the Delegation's viewpoint, such additional burdens put on users of the trademark system were not justified. As already stated at previous SCT sessions, the Delegation reminded the Committee that it did not support state's ownership of country names. While it did not support any norm-setting activities within WIPO on the protection of country names against registration and use as trademark, the Delegation did, however, not oppose to fact-finding, the collection of best practices or any other awareness-raising activities to be undertaken by the Committee.

99. The Delegation of the European Union, speaking on behalf of the European Union and its member states, reminding the Committee of its previously stated position about the proposal, reiterated that it was in favor of another work stream on the topic, as contained in document SCT/39/8 Rev. 3, and had therefore followed related-developments, as currently

reflected in document SCT/41/6. In conclusion, the Delegation stated that, like other Member States, it was not in favor of any kind of norm-setting exercise within WIPO on the matter, another way of moving forward being preferred.

100. The Delegation of Uganda, speaking on behalf of the African Group, thanked the Delegation of Jamaica for its proposed joint recommendation aiming at enhancing the protection of official names of countries against registration as trademarks. Recalling that concerns of Member States to ensure effective protection of their country names was a longstanding issue in WIPO, the Delegation reminded the Committee of the Study on the Protection of Country Names, which had been presented at its twenty-ninth session. The study had confirmed the existence of many loopholes in trademark law and practices, both at pre-grant and post-grant stages, which allowed the registration of country names as part of trademarks, some in a misleading manner for consumers. Adding that, at previous SCT sessions, the Committee had been informed of Member States' concrete examples of appropriation and monopolization of their country names by foreign companies, the Delegation considered that those examples squarely pointed at a failure or shortcomings of national trademark systems and, therefore, stressed the need for a coordinated approach on the issue, at the international level. Reverting to the draft joint recommendations proposed by the Delegation of Jamaica, the Delegation pointed out that it merely contained guidelines for trademark examiners to be used in processing applications for trademarks deriving from or using country names and did, as such, not impose an additional burden on trademark examiners. Although some delegations had held the view that putting some limitations on the registration and monopolization of country names would impose unnecessary burden on businesses, the Delegation believed that the burden was even much higher for persons or companies that could not use their country name if it was monopolized or if there was a misrepresentation as to the origin of products, to the detriment of citizens producing similar products. In the Group's viewpoint, the Committee had the duty to ensure a careful balancing of the interests of companies/citizens, seeking to use a foreign country name, and companies/citizens of the country whose name was at stake. There should, however, not be a bar to use a country name. The Delegation concluded by expressing the Group unanimous support for the proposed joint recommendations.

101. The Delegation of Morocco, re-affirming its interest for the protection of country names, found that the basis of the proposal by the Delegation of Jamaica, aiming at preventing a deceptive use of country names as trademarks, was interesting. However, the Delegation was not in favor of a constraining examination system that would automatically lead to the refusal of all uses of country names as trademarks, even where the use was not misleading for consumers. In conclusion, the Delegation considered that the issue should be examined carefully, taking into account the best practices gathered through the compilation of returns to previous questionnaires.

102. The Delegation of the United States of America, thinking of various trademarks that could be applied for, pointed out that, to the extent that, under the proposed joint recommendation, any use of a country name in a mark would be problematic and deceptive, certain marks would have to be refused in its country and other countries. For instance, that would imply that, in its country, marks such as "Lenox" for dinnerware, "American Girls" for dolls, "Wild Turkey" for spirits, "French Toast" for children clothing or "American Express" would have to be refused. For the Delegation, refusing applications for marks with those terms would increase the office's workload, reverse the burden of proof and disrupt the examination process and businesses, where the sign was not a country name, was not used as a country name or would not be perceived as a country name. Consequently, the Delegation stressed the need to back up from the idea of an automatic trigger implying the refusal of a mark where it referred to a country, as that was beyond what trademark systems did.

103. The Delegation of Chile, thanking the Delegation of Jamaica for its proposal, underlined the importance of the protection of country names and reported that its industrial property law provided for a strict protection of country names, considered as an absolute ground for refusal of a trademark application. Referring to the draft joint recommendations, the Delegation noted some inconsistencies between that draft and its own legislation, with respect, on the one hand, to the protection of country names as business identifiers and, on the other hand, the grounds for refusal. Finally, the Delegation expressed its willingness to continue working on the document to improve it and to solve issues, in order to reach a joint recommendation.

104. The Delegation of Guyana, endorsing the proposal of the Delegation of Jamaica for the protection of country names and other relative geographical names, wished to share its experience with respect to the loss of the right to use the words “Demerara sugar”. In the absence of protection of country names and related geographical names, the Delegation believed that further exploitation and infringement of country names and products from the countries would inevitably continue.

105. The Delegation of Australia thanked the Delegation of Jamaica for the considerable work undertaken to address concerns about the inappropriate use of country names. Although recognizing the fact that joint recommendations were not binding since they aimed at providing guidance to examiners, the Delegation remained concerned that the breadth of the definition of country names would create problems for trademark users and examiners. In the Delegation’s viewpoint, a broad definition would be impractical to address at the examination level and would create a searching burden disproportionate to the risk that the proposal was trying to address. In conclusion, the Delegation, echoing the comments made by other delegations, observed that contextual considerations were sensible so that providing for an absolute protection without those considerations could amount to unnecessary restrictions to trade.

106. The Delegation of Switzerland, noting that some delegations had lent support to the proposal while others had expressed concerns, recalled that the topic of country names raised two issues. The first issue dealt with the monopolization of a country name, in case of filing of an application for a word mark consisting of a country name, without any other element. The other issue dealt with misrepresentation, in case of use of a country name in combination with other distinctive signs. The Delegation stressed that neither the joint proposal, contained in document SCT/39/8 Rev. 3, nor the proposal of the Delegation of Jamaica aimed at totally banning the use of country names. Reverting to the first question to address, as to the possibility for a company to monopolize a country name, the Delegation, considering that such monopolization was not possible, reminded the Committee that the joint proposal covered that question. Then, concerning the second question as to the use of a mark combining a country name with other distinctive signs, the Delegation held the view that such a combined mark should be used only with respect to goods or services originating in the country at stake.

107. The Delegation of Jamaica, thanking all delegations for their comments, reiterated that the proposal did not amount to an inflexible absolute prohibition. In the Delegation’s viewpoint, the proposal sought at streamlining the grounds for refusal, based on context, to be identified, agreed upon and commonly treated by Member States. Expressing gratitude for the remarks made during the session, the Delegation announced that it would present a more streamlined, clear and narrowly worded version of the proposal, at the next SCT session.

108. The Chair concluded that the Delegation of Jamaica would present a revised version of this document to the next session of the SCT in light of the comments made during this session.

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/39/8 Rev.3).

109. The SCT considered document SCT/39/8 Rev.3.

110. The Delegation of Switzerland recalled that the aim of the proposal contained in document SCT/39/8 Rev.3 was to prevent the monopolization of a country name or a geographical name of national significance by a private individual, unless authorized by the State concerned. The Delegation believed that certain geographical names should remain free and open for all market actors and that each actor on the market should be able to indicate the origin of its products or services. As concerns had been raised by some delegations, at previous sessions, concerning a reference to a list of names, the Delegation said that Switzerland and the co-sponsors of the proposal were reflecting on different approaches and alternatives.

111. The Delegation of Iceland said that it attached great importance to the proposal, as one of the most prominent roles of a country name was to designate the place of origin of goods. Observing that granting exclusive rights to a country name could seriously hinder trade and economic advances of the relevant country, the Delegation stressed the fact that the proposal did not pose an obligation of legal changes, but rather was relevant to recalibrate the view of distinctiveness of word marks consisting exclusively of country names. Underlining the fact that the proposal aimed at laying down a principle that was in line with rules already set for trademarks a long time ago, the Delegation thanked the Delegation of the European Union for the changes that had been made concerning the examination of country names as word marks. The Delegation expressed its willingness to continue discussing that matter in a constructive manner.

112. The Delegation of Jamaica recalled that, for many years, it had advocated within the Committee for a more consistent, adequate and effective protection for country names, similar to symbols of Statehood, such as flags and armorial bearings, which were already protected under the Paris Convention. The Delegation strongly believed that Member States were in fact verbal symbols and indicia of statehood, which ought to be protected by WIPO. The Delegation stated that, although some protection for country names was available through existing trademark laws, such protection was often leaving the ability for persons to freeride on the goodwill and reputation of a country name, without any genuine connection to the country named. Therefore, the Delegation stated that it would continue to support the joint proposal contained in document SCT/39/8 Rev.3, considering that it would provide a solution to the problem that was currently affecting many States. The Delegation looked forward to the continued support and engagement of Member States and welcomed discussions in the Committee towards a solution.

113. The Delegation of the United States of America informed the SCT that it did not support the proposal contained in document SCT/39/8 Rev.3, for many of the same reasons raised in its declaration concerning document SCT/41/6. The Delegation believed that, as with any geographic term, the context of use mattered. To divorce an analysis of the country name from its context did not fall in with trademark law, with consumer's perception and protection and with the protection of competitors and businesses. In the Delegation's viewpoint, reserving a country name as a public asset that could not be monopolized by anybody, presumed that the government owned it and that all the trademark offices of the world would be in a situation of either making country names non eligible for trademark protection entirely, or reserving it solely for the government to authorize those that it wished to authorize. The Delegation considered that the question raised concerns for existing commercial uses by businesses that identified accurately the origin of the goods or services, or for uses that were not misleading and not

deceptive and that, under existing principles of trademark law, were legitimate uses. The Delegation said that it would be pleased to share its Office's examination practice. Although, according to that practice, it was very difficult for entities to register country names by themselves or in conjunction with other matter, the Delegation stated that it did not support declaring that the WIPO General Assembly should say that a country name was a public asset that would be automatically considered a monopolization because there were consequences that followed from that legal conclusion that offices would need to implement. The Delegation concluded by adding that it was not in a position to do so because of the impact on existing commercial uses.

114. The Delegation of the European Union, speaking on behalf of the European Union and its member states, reiterated its concerns about a general prohibition of the registration of country names and geographical names of national significance as distinctive signs, such as trademarks, if the sign consisted exclusively of such a name or if it would amount to the monopolization of such a name.

115. The Delegation of China believed that the protection of country names was a major issue and that geographical names of national significance needed to be protected to some extent. The Delegation recalled that its national law very strictly protected country names when examining applications consisting of, or containing country names, and had adopted a number of measures to strengthen the protection of country names. While stating that the scope of protection of country names and geographical names of national significance was too broad, the Delegation expressed its commitment to actively participate in the discussions on the issue. As regards the drafting of specific provisions, the Delegation considered that more specific and tangible guidance should be given to examiners. The Delegation believed that those matters should be discussed carefully and in detail.

116. The Delegation of Japan concurred with the views concerning the importance of protecting country names and geographical names of national significance. The Delegation recalled that, in its country, trademarks consisting of country or geographical names were refused if they were deemed to indicate the place of origin or sale of goods or the location where services were provided, or if they were likely to be misunderstood by consumers as to the quality of the goods and services. The Delegation held the view that the list of names in items (1) to (5) of the proposal would serve as useful reference information for examination practices, provided that they were not legally binding. However, noting that the elements in item (6) had not been clarified, in particular as to the definition of geographical names of national significance, the criteria for selecting those names, the requirement of the agreement by countries in creating the list, and the method and process to file an objection, the Delegation considered that the Committee should continue discussing that matter. Furthermore, the Delegation believed that national systems and examination practices in each country should be free to determine whether to provide absolute protection to country names and geographical names, or to regard country names and geographical names as issues related to distinctiveness or misunderstanding. In conclusion, the Delegation stated that it was in favor of the consensus, provided that the lists on the proposal were not legally binding for Member States and that the elements in item (6) were carefully discussed.

117. The Delegation of Croatia, speaking on behalf of the CEBS Group, reiterated its concerns about a general prohibition of the registration of country names and geographical names of national significance as distinctive signs, such as trademarks, if the sign consisted exclusively of such a name or if it would amount to the monopolization of such a name, as laid out in document SCT/39/8 Rev.3.

118. The Delegation of the Republic of Korea stated that it was not in a position to support the joint proposal, since country names were already protected in its country under the Korean Trademark and Unfair Competition Prevention Acts. Considering that excessive restrictions on

the selection of trademarks should be avoided and that harmonization with prior trademark rights should also be considered, the Delegation recommended that the use of country names and geographical names be allowed if the country name constituted a minor part of a trademark. The Delegation added that the relevant positions should be limited to the case where the country name formed an essential part of the trademark.

119. The Delegation of Australia said that it did not support an obligation for an absolute prohibition of country names and geographical names of national significance from registration as a trademark or in a trademark. Echoing the declarations of some other delegations, the Delegation expressed the view that the protection sought in the proposal was too broad and could potentially create problems and costs bigger than the issue it tried to address. The Delegation indicated that mechanisms existed under Australian law to prevent granting exclusive rights over terms that others might have a legitimate desire to use and to prevent a deceptive or confusing use of terms. The Delegation added that its national practice had been updated to take a more stringent approach to trademarks that contained geographical references including country names. However, the updated practice noted the importance of context and whether the way the geographic term was included gave rise to a perception that the goods or services would be from that actual place.

120. The Delegation of Switzerland said that it would work on a new approach in the light of the different comments, in order to move forward in the debate at the next session.

121. The Chair concluded that the co-sponsors of document SCT/39/8 Rev.3 would present a revised version of their proposal to the next session of the SCT.

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 in the DNS (document SCT/41/6)

122. The SCT considered document SCT/41/6.

123. The Delegation of the European Union, speaking on behalf of the European Union and its member states, recalled that a number of proposals had been discussed at the last session of the SCT on the topic of country names. As regards the joint proposal contained in document SCT/41/6, the Delegation thanked the Delegation of Switzerland and the other proponents for having prepared a non-paper for the informal discussions at the last SCT meeting. The Delegation welcomed the separation into two documents of the two distinct policy objectives that had been covered together in the previous document SCT/39/8 Rev.2. Noting that the policy objective of protecting country names and geographical names of national significance against the delegation as top level domain names in the DNS was addressed in document SCT/41/6, the Delegation said that, by means of that clear divide, the original joint proposal had been further improved in the right direction. Concerning the proposal in document SCT/41/6, the Delegation remained supportive of the underlying rationale, explained on pages one to three of the document, and associated itself with the principles endorsed in the report of the Second Special Session on the Report of the Second WIPO Internet Domain Process, adopted by the SCT in 2002, and contained in document SCT/S2/8. Recalling that, at the previous session of the SCT, the proponents had elaborated a revised version of the text in document SCT/41/6, which had been subject to informal discussions, the Delegation reiterated its appreciation for the spirit of seeking consensus reflected in that joint proposal, and stood ready to participate in continued discussions to address certain technical issues in the latest wording proposed by the co-sponsors. Concerning the new proposal presented in document SCT/39/8 Rev.3, addressing the policy objective of protecting country names and geographical names of national significance against their registrations as distinctive signs such

as trademarks, the Delegation reiterated its concerns about a general prohibition of the registration of country names and geographical names of national significance as distinctive signs, such as trademarks, if the sign consisted exclusively of such a name or if it would amount to the monopolization of such a name. The Delegation, noting that those proposals did not imply any legislative exercise, nor envisaged any disruption of existing practices on descriptiveness and distinctiveness, was of the opinion that the creation of a new norm-setting instrument might not be the most appropriate way to address the issue. With regard to the proposal to conduct a survey on nation-brand protection in Member States, contained in document SCT/42/4, the Delegation recalled that it had raised a number of concerns during the fortieth session of the SCT in the context of a previous proposal by the Delegation of Peru concerning the recognition and protection of nation brands. The Delegation reiterated the view that the concept of nation brands covered not only signs consisting of country names but could also include figurative elements and any combination therewith; therefore, it appeared that the concept would significantly extend the scope of aspects to be taken into account when protecting symbols of sovereignty in the strict sense. Remaining unconvinced that further work in that direction would benefit the success of ongoing discussions on that topic, the Delegation expressed the view that the SCT should rather focus its efforts on proposals already on the table and try to seek consensual solutions on that basis. On the European trademark practice relating to country names, the Delegation informed the SCT that the EUIPO had further developed its practice in respect of geographical names, with special regard to some judgements of the Court of Justice of the European Union. In respect of country names, in particular, it would be assumed that the name of a country was in principle associated with the relevant goods and/or services and that the public would accordingly perceive a country name as an indication of the geographical origin of those goods and/or services.

124. The Delegation of Switzerland said that it preferred to discuss the different proposals on country names separately and suggested addressing firstly document SCT/41/6.

125. The Delegation of Croatia, speaking on behalf of the CEBS Group, thanked all the delegations that had contributed to the drafting of the joint proposal on the protection of country names, which had enabled discussions at the fortieth session of the SCT and resulted on two new proposals, contained in documents SCT/39/8 Rev.3. and SCT/41/6. The Delegation also appreciated the Committee's work and expressed the view that the two new proposals would constitute a solid base for constructive discussions. Underlining the non-binding approach of those proposals, the Delegation expressed the Group's support for the twofold approach taken in the documents. Furthermore, the Group expressed its support for the protection mechanism for geographical indications and country names at the second level of the DNS, as suggested in document SCT/41/6. At the same time, the Delegation expressed the Group's concerns over the idea of a general prohibition of the registration of country names and geographical names of national significance as distinctive signs, such as trademarks, when the signs consisted exclusively of such a name or when their registration or use would lead to the monopolization of such a name. The Delegation, looking forward to exchanging ideas on the topic, recalled that the Group was not in favor of an international binding instrument, but rather of a soft law approach.

126. The Delegation of Brazil reiterated its support for the proposal concerning the protection of country names and geographical names of national significance in the DNS, contained in document SCT/41/6, and expressed its willingness to co-sponsor it. The proposal urged members to prohibit, in their national laws, the allocation of domain names that coincided with protected terms and suggested that such disputes be included within the scope of the domain name arbitration mechanism of WIPO, the UDRP, which currently applied only to trademarks, in order to bring more balance and accountability to a matter with obvious implications for the public interest. The Delegation referred to the recent assignment by ICANN of the generic top-level domain name ".Amazon" to the American eCommerce Company. The Delegation stated that, within ICANN, the lack of State bargaining power seemed to have led to Amazon

rejecting a negotiated solution, despite the joint proposal by the Amazon Cooperation Treaty Organization. The Public Interest Commitment released last May had brought only very few exceptions on country benefits and insufficient shared management mechanisms. The Delegation said that the State use of the domain was almost entirely dependent of the company Amazon's consent. The attribution of a virtual monopoly over a term that was inseparable from the cultural and linguistic heritage of each of the eight Amazonian countries should serve as a red light to Member States. The Delegation considered that if Member States did not strive to take the lead on DNS-related decisions, in the sense of bringing them to a forum with a relevant government presence, their own names, the names of their cities and the names of their regions of historic significance could be the next to be controlled by a single company and subtracted from the public domain. The Delegation looked forward to discussing different approaches on that proposal, as well as the different sorts of instruments that could be enacted.

127. The Delegation of the Russian Federation, speaking on behalf of the CACEEC Group, thanked the Delegation of Jamaica for initiating the consideration of those issues, as well as the groups of countries that had prepared the other proposals with regard to the protection of country names and geographical names of national significance. The Delegation indicated that the discussions within the SCT on the international practices and different uses of country names had led to a broader understanding of the current registration practices, and use of such names, particularly how they related to trademarks. The Group stated that it remained interested in a more balanced approach to the use of country names and that the outcome of the work of the SCT on those issues should be the adoption of a recommendation.

128. The Delegation of Iceland, thanking the Secretariat for its work in preparing the session, said that protecting country names and other geographical indications in the DNS was as important as protecting them in the trademark system. The Delegation stressed the fact that the possibility of misappropriation of country names and geographical indications in the DNS was high and that it remained important that future rules on new top-level domain names should protect country names and geographical indications. The Delegation added that the existence of an active protection mechanism of the second level of the DNS for geographical indications and country names was equally important. The Delegation reiterated its commitment to bring the proposal forward and encouraged the support of other Member States.

129. The Delegation of Jamaica, recalling that several famous place names in Jamaica and in other countries had been appropriated, expressed its full support for the proposal contained in document SCT/41/6, which was co-sponsored by its country. The Delegation emphasized that the proposal concerning the protection of country names in the DNS was complementary to the proposal contained in document SCT/39/8 Rev.3. The Delegation explained that the proposal contained in document SCT/41/6 was to primarily enable countries to submit to the Secretariat existing lists of country names, capitals, regions and World Heritage sites, within a deadline of 18 months, according to each country's public policy or national law. The Delegation indicated that the objective was to agree on possible language that captured the areas of convergence, while leaving policy space for divergent approaches. The Delegation encouraged Member States to review the proposal contained in document SCT/41/6 with a view to agreeing on a workable solution to the pervasive problem of lack of protection of country names in the DNS.

130. The Delegation of Sudan, aligning itself with the statement delivered by the Delegation of Uganda, on behalf of the African Group, looked forward to productive deliberations on all proposals. The Delegation supported the proposals made by several countries, particularly on the protection of country names and geographical names of national significance in the DNS. The Delegation said that, in 1969, Sudan had avoided its name being appropriated, since Article 8 of the national trademark law prohibited that a trademark mimicked the first letters of any country or international governmental organizations, unless there was approval by the competent authorities. The Delegation looked forward to continuing the debate on the matter.

131. The Delegation of Venezuela (Bolivarian Republic of), aligning itself with the statement made by the Delegation of Brazil, stated that it disagreed with ICANN's indication that the name Amazon lay outside the cultural reference of the eight countries of the Amazon.

132. The Delegation of Monaco stated that the absence of adequate protection for country names and geographical names of national significance in the DNS was of particular concern to Monaco because of the risk of monopolization and appropriation of those names by private entities and the consequences for the communities concerned, as described in document SCT/41/6. The Delegation indicated that it fully supported that document, which aimed at establishing simple principles based on already existing and internationally approved lists. In addition, the proposal would constitute a first solution to the problems and difficulties faced by many States, including Monaco, in protecting their country name and other geographical names of national significance. For that reason, the Delegation had co-sponsored document SCT/41/6 in its entirety and hoped for a positive outcome on that document.

133. The Delegation of the United States of America expressed its concerns about the relevance of the Committee to send a recommendation to ICANN that would undermine the work that ICANN had been doing, particularly in the Work Track 5, which examined how geographic names would be addressed in subsequent rounds of gTLD expansion. The Delegation, indicating that ICANN was currently meeting at Montreal, said that the Work Track 5 had submitted its final report with a conclusion that the 2012 Applicant Guidebook should stand. The consensus decision had been supported by the Delegation of the United States of America, although, as already stated, the Delegation did not support the Applicant Guidebook 2012, considering that it went too far. In its view, there was no inherent governmental right in a geographical name. The Delegation expressed concern about the fact that such right in the DNS could interfere with existing uses by businesses all over the world. Furthermore, as regards the issue concerning the use of UDRP for geographical indications, the Delegation expressed concerns about such a recommendation. The Delegation, pointing out that some disagreements existed on the notion of bad faith concerning geographical indication infringement or geographical indication use in the DNS, stated that it was premature to make such a recommendation while the question of bad faith had not been discussed within the Committee. Therefore, the Delegation could not support a recommendation to ICANN.

134. The Delegation of Australia said that it remained sympathetic to the concerns about monopolization of country names and names of national significance in the DNS. Considering that proposal quite sweeping and going beyond the protection provided by ICANN's applicant Guidebook, the Delegation expressed the view that the proposal would likely have consequences for ordinary business. The Delegation further sought clarification of a number of points, including the mechanism proposed by the delegations. In addition, the Delegation said that it was unclear how the proposal would deal with names existing in more than one jurisdiction, for example, "Orange" or "Roma". The Delegation believed that principles of coexistence should allow the use of such names by other registrants, provided that such use was not misleading.

135. The Delegation of Canada, informing the Committee that, in the domain name context, it had experienced issues related to the misuse of the domain name "Canada", said that it was sympathetic to the issue. While recognizing that countries might have a legitimate interest in names closely aligned with heritage and culture, the Delegation continued to have concerns about some elements of the proposal, such as the concept that geographical names had a broader scope and the potential to restrain innovation in the domain name space. The Delegation also noted that the proposal contained language that could confer rights to countries going beyond internationally recognized legal principles. Moreover, the proposal had the potential to create unintended effects, for example disputes between countries, groups or individuals, which shared experiences and heritage. For the Delegation, any way forward on the matter should take into consideration the impact on applicants and ensure that

administratively burdensome processes be avoided. The Delegation concluded by underlining that those issues, as well as the potential impact on Member States and the domain name space, should be considered in more detail.

136. The Chair concluded that discussion on document SCT/41/6 would continue at the forty-third session of the SCT.

Proposal by the Delegation of Peru to Conduct a Survey on Nation-Brand Protection in Member States (document SCT/42/2)

137. The SCT considered document SCT/42/4 and a presentation made by the Delegation of Peru.

138. The Delegation of Peru noted that the number of nation-brands of both developed and developing countries had significantly increased and displayed an image showing various nation-brands. Internationally, indices had been established to measure the importance of nation-brands, their contribution to economic growth and development, and to the increase of tourism and trade. In the index called Future Brands 2019, the brand of Peru was ranked in the 37th place. The issue of nation-brands had received the attention of WIPO since 2006, when Professor Simon Anholt provided consulting work to the Organization, and thereafter the Secretariat prepared several documents on the subject. The Delegation recalled the proposal contained in document SCT/39/9 for the recognition and protection of nation-brands that it had submitted to the SCT in April 2018. It also mentioned the presentation entitled “Analysis of the International Regime for Nation-Brands”, made by the Secretariat during the Sub-regional Seminar on Nation-Brands and Their Legal Protection, held in Lima in 2018, the text of which was published on the website of the National Institute for the Defense of Competition and Protection of Intellectual Property (INDECOP). The Delegation stated that the nation-brand “*Marca Peru*” had the potential of developing a strong identity, as it embraced the colors of the national flag, recreated the style and iconography of one of Peru’s most important archeological treasures, namely the Nazca lines, and evoked a fingerprint. The Delegation pointed to the lack of a standard definition of nation-brand and the absence of a norm explicitly dealing with such signs. That caused countries to either register them as trademarks, or communicate them to the States party to the Paris Convention, in accordance with the terms of Article 6 *ter* of that Convention. In view of these difficulties, the Delegation proposed to develop and present at the next session of the SCT, a questionnaire addressing some important aspects that would allow the Committee to gather as much information as possible about nation-branding strategies. Questions could cover, for example, changes made to nation-brands in the preceding decades or Member States’ practices regarding the State institutions responsible for nation-brand management, as well as the type of legislation that SCT members had put in place to regulate the use, registration and licensing of such brands. The Delegation considered it important to learn about the steps members had undertaken towards the international registration of nation-brands, as well as the relationship between nation-brands and other national signs. Additional issues included licensing schemes and most importantly, the protection afforded in each member under Article 6 *ter* of the Paris Convention.

139. The Delegation of the Russian Federation, speaking on behalf of the CACEEC Group, supported the proposal made by the Delegation of Peru. The Delegation considered that although regional and national brands were protected in accordance with the legislation of the CACEEC Group members; certain issues pertaining to them still required clarification, starting with the definition of such signs, the extent of their use and whether or not they could be considered intellectual property. Additional questions related to the form of use of such brands, whether individually or collectively and the type of protection afforded to them. The Delegation considered that although these issues had been discussed in several international fora, agreement had yet to be reached. The SCT seemed to be the appropriate forum to discuss the

protection of nation-brands, as well as their modalities of use in order to individualize and distinguish products from different regions.

140. The Delegation of the Republic of Korea understood that the proposal concerned a survey on nation-brands among SCT members, in view of the recent development and use of such brands, aiming at building a competitive advantage for the country concerned. However, the proposal would be more persuasive if actual cases of misuse of nation-brands were shared with SCT members.

141. The Delegation of Uganda, speaking on behalf of the African Group, stated that in the global market place, a country's image could be one of its most valuable assets, with potential long-lasting implications on the said country's economic prospects and its ability to attract investment and tourism. Countries were dedicating sizeable resources to build their nation-brands and use such brands in advertising, conveying their national values, attributes and reputation. The Delegation noted that the aim of the proposal was to explore an otherwise grey area in the international intellectual property architecture. Although it posed a number of questions such as the definition of nation-brand or the modalities for promotion and protection of such brands, the proposal had lot of merit and deserved to be discussed in a positive light. The SCT should nevertheless undertake the proposed study for information purposes only, without the expectation of a norm-setting exercise at that point. Otherwise, the African Group endorsed the proposal presented by the Delegation of Peru.

142. The Delegation of Ecuador said it wished to cosponsor the proposed survey among SCT members regarding their policies and strategies to develop a brand representing national values. There was a key interest in developing the fundamental criteria for the protection of nation-brands. One important question would be whether SCT members had provided legal means for the protection of nation-brands.

143. The Delegation of the European Union, speaking on behalf of the European Union and its member states, took note of the proposed survey on how SCT members treated, developed and protected nation-brands, both inside and outside their respective jurisdictions. The Delegation recalled that in the context of the previous proposal by the Delegation of Peru concerning the recognition and protection of nation-brands, it had voiced a number of concerns. One of them was that the concept of nation-brands covered not only signs consisting of country names but it also included any elements in any combination therewith. In the view of the Delegation, the concept presented by the Delegation of Peru would significantly expand the scope of aspects taken into account when protecting symbols of sovereignty. Accordingly, the Delegation remained unconvinced that further work would benefit the ongoing discussions on the topic and concluded that the SCT should focus its efforts on proposals that were already on the table, seeking to reach consensus and solutions to them.

144. The Delegation of Iran (Islamic Republic of) believed there was a lot of merit in the proposal and declared itself in favor of conducting a survey to explore the members' current practice concerning the protection of nation-brands. Noticing that was already the second session during which that topic was discussed, the Delegation hoped members would consider the issue in a positive spirit and agree on concrete actions to move forward.

145. The Delegation of Mexico noted the importance that many countries attached to the issue underlying the proposal, over which it seemed necessary to continue gathering information. The Delegation supported the idea of a survey, noting that in the past, that type of initiative had proved extremely useful to inquire on the various issues of concern to SCT members.

146. The Delegation of China underlined the importance of national brands in the promotion of the image of a country, and observed that a survey would be helpful to gather additional information on the issue. The Delegation noted that provisions dedicated to the protection of

national signs already existed in the Paris Convention. In comparison, the concept of nation-brand was still a bit general and ambiguous, especially when it came to their assessment during the trademark examination process. There did not seem to be agreement among SCT members on the protection afforded to these signs, and hence there was merit in studying the scope of protection of nation-brands.

147. The Delegation of Chile recalled the previous proposal presented by the Delegation of Peru and contained in document SCT 39/9, indicating various approaches that SCT members could adopt for protecting nation-brands. As a preliminary question, the Delegation believed it was necessary to understand the normative systems and practices that members had in place to eventually determine whether new regulations were necessary. The Delegation supported the idea of giving all SCT members the opportunity to participate in the survey and reflect their own interests.

148. The Delegation of Colombia supported the proposed questionnaire and noted it would be particularly helpful to learn about Member's legislation on the matter. Colombia had developed a nation-brand, considered a tool of great importance for promoting its national identity and that of its products and services.

149. The Delegation of Argentina associated itself with the statement made by the Delegation of Mexico on behalf of GRULAC, and thanked the Delegation of Peru for the proposed survey that would allow SCT members get a better understanding of the current situation concerning the protection of their nation-brands.

150. The Delegation of Japan considered that the details of the proposal needed to be further clarified. For example, the notion of nation-brand was itself unclear and the Delegation was concerned that the scope of the survey would extend beyond the topic of trademarks.

151. The Delegation of Guatemala joined in support for the proposal to issue a questionnaire on nation branding and noted the importance of collecting information on that important issue.

152. The Delegation of Belarus considered that the proposal was timely and bearing in mind the explanations provided by the coordinator of the CACEEC Group, looked forward to actively participating in the work.

153. The Delegation of Iceland added its support to the proposal and believed that the survey would be beneficial for the future discussions on nation-brands and the use of country names, and country indicators in such brands. The Delegation explained that based on its own efforts at protecting the Iceland nation-brand, it noted there was no adequate protection mechanism. Article 6^{ter} of the Paris Convention did not seem to cover these brands, and the trademark system was ill fit to deal with them. The discussion on that matter was welcome since nation-brands reflected the identity and reputation of nations in a similar way as country names.

154. The Delegation of the United States of America aligned itself with the positions expressed by the Delegations of the European Union and Japan. In the view of the Delegation, governments had perceived the benefits of the intellectual property system for their own businesses and wished to recover those benefits by influencing public opinion. In its own jurisdiction, federal agencies had proposed special statutes to protect symbols and signs, but the national intellectual property agency recommended they should use the trademark system that businesses knew and relied on. The Delegation recalled it was not the first time the SCT discussed nation branding and over the years, such discussions had not yielded any result and doubted whether a new survey on the matter would bring about any elements that were not already discussed. As one Delegation pointed out, bringing instances of misuse of nation-brands to the attention of the SCT would be helpful in understanding why the establishment of new rules was advocated.

155. The Delegation of Costa Rica supported the proposal to prepare a survey on nation branding and believed it would be useful to continue discussing that issue.

156. The Delegation of Switzerland declared itself in favor of undertaking a survey on nation branding and suggested that the questionnaire include questions dealing with the scope of protection granted under the national laws of States party to the Paris Convention to signs communicated by other parties under Article 6 *ter* of the Paris Convention. The Delegation noted that according to document SCT/42/4, various countries had used the system provided by Article 6 *ter* to protect their nation-brands. The system established under Article 6 *ter* was free of charge, it offered a protection that was not limited in time and the procedure was very simple and efficient, as it only required one communication to the International Bureau of WIPO, which was thereafter transmitted to the other Members of the Paris Convention. The protection intervened automatically in every country, except in those countries that had raised an objection within the set time. Therefore, it seemed that *a priori*, the Article 6 *ter* system responded to the issues raised by the Delegation of Peru. In the view of the Delegation, the only unknown element was the effective protection that these signs enjoyed in the territory of the different States. Consequently, the Delegation of Switzerland proposed to include in the proposed survey, should it be agreed by the SCT, questions dealing with the scope of protection provided by States party to the Paris Convention to signs communicated under Article 6 *ter* of that Convention. The Delegation also proposed that every delegation be given the possibility to participate in the elaboration of the survey by providing questions on that matter.

157. The Delegation of Jamaica supported the proposed survey and considered that the protection of nation-brands was linked to the protection of country names and geographical names of national significance. Many countries had nation-branding schemes that included marketing campaigns aimed at benefitting the national economy and population. Without the ability to control the use of country names and geographical names, nation-branding schemes would become futile and could not provide the return on investment expected by the States using such schemes. The proposed survey would add clarity to elements included in nation-branding schemes and would allow SCT members to appreciate the importance of the matter and the need to provide it with intellectual property protection.

158. The Delegation of Morocco associated itself with the declaration made by the Delegation of Uganda, on behalf of the African Group. In the view of the Delegation, work in the area should concentrate on the definition of nation-brand and any outcome resulting from the survey should be for informative purposes only.

159. The Delegation of Indonesia declared its support for the proposed survey and endorsed the intervention made by the Delegation of Switzerland with regard to the content of the questionnaire and the suggestion made that all SCT members contribute with questions that they considered should be included.

160. The Delegation of the European Union, speaking on behalf of the European Union and its member states noted that after having listened to the interventions made on the subject in the plenary, it recognized that a majority of delegations supported the proposed survey. In a spirit of compromise, the Delegation endorsed the Chair's proposal to ask the Delegation of Peru to present a draft questionnaire for discussion at the next session of the SCT, thus providing SCT members with an opportunity to comment on and further elaborate the questions.

161. The Delegation of Croatia, speaking on behalf of the CEBS Group supported the preparation and discussion of the questionnaire at the next session of the SCT.

162. The Delegation of Switzerland requested confirmation of its understanding that SCT members were expected to send to the Secretariat questions that they would like to see included in the survey. At its next session, the SCT would consider a compilation of all the questions received from members and determine those that would be kept in the final version of the survey.

163. The Representative of ASIPI declared that the members of the association and more generally speaking, Latin American countries welcomed the support that the Delegation of the European Union and its member states had given to the proposed survey.

164. The Delegation of the United States of America said that it could endorse a proposal to send draft questions to the Secretariat for compilation in a draft survey.

165. The Delegation of Peru thanked all delegations that intervened on the proposal and took note of their comments and contributions, which would be considered in the future draft questionnaire. It believed that it was worth collecting relevant information that would allow the SCT to have a fact-based discussion for the benefit of all.

166. The Chair concluded that:

- the Delegation of Peru would send to the Secretariat, before December 31, 2019, a proposal for a draft questionnaire on nation-brand protection in Member States;
- members were invited to send to the Secretariat, before December 31, 2019, questions they would like to include in the draft questionnaire;
- the Secretariat was requested to compile all questions, for consideration of the draft questionnaire by the SCT at its next session.

Proposal by the Delegation of the Republic of Korea on the Protection of Well-known Marks (document SCT/42/5)

167. The SCT considered document SCT/42/5.

168. The Delegation of the Republic of Korea introduced the proposal by mentioning that well-known trademarks brought significant commercial value to their owners. Therefore, demands for effective protection of such marks were increasing, as such marks also played an important role as marketing tools. Trademarks that became widely known contributed to increase the sale of the products covered by them, due to the exceptional attraction power they had on consumers. It seemed, however, that coping with the current need for protection of well-known marks required an expansion of the traditional legal principles. In recent years, trends imitating the culture and brands of Korean companies were gaining momentum among regional businesses due to the increasing number of Korean businesses that had risen to prominence in the global market and the impact of *Hallyu* (Korean Wave). In many countries, the number of cases of imitation of Korean well-known marks was rapidly increasing, thereby preventing such companies from accessing those markets. In addition, that also meant foreign trademark holders were improperly protected in those countries. Against that background, there was an urgent need to determine measures for protecting well-known marks from the risk of infringement. In the view of the Delegation, the current international standards, namely the Paris Convention for the Protection of Industrial Property, the World Trade Organization Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS Agreement), and the WIPO Joint

Recommendation Concerning Provisions on the Protection of Well-known Marks, did not provide the necessary level of protection to famous marks. Therefore, the Delegation proposed that a fact-finding survey be undertaken to inquire about the protection of well-known marks in WIPO members and based on the results of the inquiry determine solutions for enforcing more robust and stricter protection of trademarks worldwide. Elaborating on its analysis of the current international standards, the Delegation noted that according to the TRIPS Agreement the registration of well-known marks was mandatory for the protection to apply in respect of dissimilar goods. While the WIPO Joint Recommendation stipulated a relatively high level of protection of well-known marks, it was not a binding standard. In comparison, the Trademark Act and the Unfair Competition Prevention and Trade Secret Protection Act of the Republic of Korea provided a high level of protection to well-known marks. As to the proposal itself, its objective was to inquire on Member States' current practices in relation to internationally well-known marks and present ideas for improvement, given the increasing number of well-known marks that had been preemptively used in certain countries. The proposal contained an Action Plan including three phases, namely: presenting the proposal at the current SCT session, implementing the fact-finding survey in 2020 and discussing ideas to improve the protection of well-known marks, including a new international treaty in 2021.

169. The Delegation of the Russian Federation, speaking on behalf of the CACEEC Group, noted that protection of well-known marks and of ordinary trademarks were significant topics covered by the laws of the Group's members, based on the Paris Convention. The Russian Federation had broad experience with the protection of well-known marks, which it could share with other SCT members. Twenty years had transpired since the adoption of the WIPO Joint Recommendation and it remained to be seen if the Member States could once again come up with a recommendation on well-known marks. Nevertheless, the CACEEC Group supported the proposal to develop a survey on the protection of well-known marks.

170. The Delegation of the Republic of Moldova joined in supporting the proposal to discuss the protection of well-known marks. It was important for national offices to learn about the practice of other offices and find better ways to make a determination of the well-known character of a mark.

171. The Delegation of Chile had reservations with regard to the manner in which the proposal was formulated. While it seemed useful to have a survey to see whether the protection of well-known marks was a problem for SCT members and how they dealt with it, one could not anticipate the results. Therefore, the Delegation could not support the idea of a treaty in 2021 and suggested that the proposal be reformulated accordingly. In addition, SCT members should be able to discuss the questions before circulating the survey.

172. The Delegation of the United States of America shared some of the discomfort expressed by the Delegation of Chile with regard to the scope and focus of the proposal. In the opinion of the Delegation, the protection of well-known marks raised issues linked to priority for purposes of trademark infringement against such marks. Priority needed to be established in the country making the well-known mark determination, not in the country of origin and in that context, priority could be established through first registration, first use or reputation. The general rule in the United States of America was that use established priority and only recently national courts had to deal with a case where there was no registration, no use but only reputation of a foreign mark in the relevant market. The case had raised questions such as, where a foreign mark was not registered or used, could the holder suffer injury and could she/he have standing to bring an action in court. To remedy the situation, Courts in the United States of America looked at unfair competition and bad faith. The latter seemed to be a real problem for the national office, which was recently receiving a sizeable number of bad faith applications that prompted national authorities to use various tools. One of them was the requirement for any foreign applicant to hire a licensed legal representative, so that the local licensed attorney would apply due diligence and prevent bad faith behavior. In the United States of America, well-known marks

were handled under the common law system, thus competent authorities applied the likelihood of confusion standard in a very flexible way, allowing for cross-class refusals based on the strength of the mark as well as presuming confusion in cases where the mark was really strong. Therefore, the Delegation was interested in a survey that looked more broadly at the bad faith behavior of applicants and suggested that the proposal focus not only on well-known marks but also on all marks.

173. The Delegation of Japan noted that well-known trademarks from foreign countries filed for unclear purposes in Japan were refused under the legal framework applied in that country. Such refusals included applications filed to prevent owners of well-known marks entering the local market or offering to sell national registrations at a high price, while profiting from the fact that those marks remained unregistered in Japan. The Delegation believed it would be beneficial to have a discussion on the protection of internationally well-known marks and supported the proposed fact-finding survey, which should also cover the regulations and examination practices of SCT members.

174. The Delegation of Iran (Islamic Republic of) stated the view that the current international legal framework for the protection of well-known marks seemed appropriate. The Delegation said it saw no gaps that needed to be filled in the system established by the Paris Convention, the TRIPS Agreement and the WIPO Joint Recommendation. Having read the proposal, the Delegation could not perceive the need to depart from the current system or establish a new legal instrument. The Delegation could nevertheless support the idea to explore the current practices of SCT members on the matter.

175. The Delegation of Uganda, speaking on behalf of the African Group said there was already a high level of protection for well-known marks in the previously stated international instruments. After a critical review of the proposal, the African Group had identified certain issues about the proposal by the Delegation of the Republic of Korea. For instance, a number of well-known traditional marks, owned by indigenous peoples and local communities were not protected in foreign markets because they were not registered. The conventional intellectual property rights system was not sufficient to protect them. While the proposal had not articulated gaps existing in the current international framework with regard to well-known marks, the proposed fact-finding study on national laws and practices could offer member states an opportunity to further understand the issue. The study could perhaps be useful to identify best practices and benchmarking at the national level, and on that premise, the Group could support only those elements of the proposal relating to fact-finding for information purposes, without the expectation of norm-setting at that stage.

176. The Delegation of Switzerland noted that the proposal presented by the Delegation of the Republic of Korea shed light on an important problem to which Switzerland was sensitive. There were a number of very well-known distinctive signs belonging to Swiss enterprises or Swiss collective associations of producers. These signs did not always enjoy adequate protection abroad. Therefore, the Delegation favored the elaboration of an inquiry among SCT members in order to learn about the different national practices relating to well-known signs. However, conceptually, the proposal raised a question: according to the currently applied rules, for a mark to be protected as a well-known mark, such foreign mark should be well-known in the territory of a country where the protection is being claimed. It was not sufficient that the mark be well-known solely abroad, i.e., in another country. That rule, which derived from the principle of territoriality, prevailed also for the registration of the mark. At previous sessions of the SCT, various delegations had indicated that it was excluded to protect certain names based on a pre-existing list, precisely on the grounds that trademark examination was based on the consumer and public perception of the country where registration was sought. If the Delegation of Switzerland had correctly interpreted the sense of Article 34.1.13 of the Trademark Law of the Republic of Korea, reproduced in document SCT/42/5, such article provided protection to marks that were well-known only abroad. If SCT members should

discuss a similar rule at the international level, the Delegation of Switzerland wondered whether the principle of the consumer or public perception of the country where registration was sought would be put into question and hence what the impact of that paradigm change would be on other topics discussed by the Committee.

177. The Delegation of China declared that the protection of well-known marks merited the attention of the SCT. It was an issue of concern in China, where national companies had seen their marks used in other countries without authorization. For that reason, the Delegation was interested in learning the practices of other countries relating to the protection of well-known marks. Pursuant to the legal standards included in the Paris Convention and in the TRIPS Agreement, countries had developed their national systems for the protection of well-known marks, which were appropriate to their local circumstances. The Delegation felt it would be positive to better appreciate the systems worldwide and declared itself ready to participate in the discussions, and to present the national provisions and practice.

178. The Delegation of the European Union, speaking on behalf of the European Union and its member states, said that having listened to the discussion and following some internal deliberations, it would like to support the work proposed by the Delegation of the Republic of Korea, subject to certain limitations. As indicated by the Delegation of Uganda, on behalf of the African Group and the Delegation of Iran (Islamic Republic of), it would be helpful and useful to explore the topic of well-known marks, but there was no need to engage in a norm-setting exercise. Therefore, the Delegation would join other delegations that had suggested stopping the proposal at phase two of the Action Plan, on page 5 of document SCT/42/5.

179. The Delegation of Morocco concurred with previous speakers on the point that there was already an international framework for the protection of well-known marks, starting with Article 6*bis* of the Paris Convention. The Delegation informed the SCT that national legislation in Morocco included a number of provisions relating to the protection of well-known marks and the actions that trademark holders could take to prevent misuse. However, for the national office it was sometimes difficult to decide whether or not a mark was well-known in the territory of Morocco, based on the information provided by the trademark holder. That point needed to be resolved prior to applying the legal standards on well-known marks. The Delegation believed that the proposal presented by the Delegation of the Republic of Korea was interesting and suggested to include in the survey several questions dealing with best practices for the determination of the well-known character of a mark. Some examples included the type of proof that should be accepted for making that determination, whether it was proof of use in the territory where the protection was claimed, or recognition by the wider consumer public, or publicity linked to the mark.

180. The Delegation of Croatia, speaking on behalf of the CEBS Group said that the Group supported the fact-finding survey on foreign well-known marks contained in Phase two of the proposal presented by the Delegation of the Republic of Korea. However, the Group saw no need to develop a treaty on the subject for the year 2021.

181. The Delegation of the Republic of Korea thanked SCT members for the comments made to its proposal concerning the protection of well-known marks. Pursuant to those comments, it seemed that members were generally favorable to conducting a survey, although for some members, the scope of the survey was debatable. The Delegation of the United States of America had suggested broadening the scope of the survey to cover the issue of bad faith filings in SCT members. Indeed, understanding bad faith trademark applications across jurisdictions might include issues such as, firstly, preemptive filing of a trademark where the prior user did not have a registered right in the relevant jurisdiction. Secondly, filing an application for a trademark that was confusingly similar to a famous or well-known mark before deploying to the market of registration the covered goods or services, with the objective of taking unfair advantage of the trademark owner's goodwill or as a strategy against the owner

taking action to stop sellers with a product using look-alike branding. Thirdly, filing applications for trademarks without any intention to use them, perhaps with the intention to block a prior user from market entry, or in order to negotiate payment of a license fee or an assignment of rights fee. Against that background, the Delegation of the Republic of Korea declared itself ready to hold consultations with SCT members and the WIPO Secretariat to develop the contents of the survey. The Delegation suggested that interested SCT members send suggestions to it before the end of January 2020, so that an amended version of the proposal, including specific questions reflecting their comments, be presented at the upcoming session of the SCT.

182. The Chair concluded that:

- the Delegation of the Republic of Korea would present a revised version of its proposal on Member States' practices in relation to the protection of internationally well-known marks, taking into account the comments made by delegations, for consideration of the SCT at its next session;
- members were invited to communicate their contributions to the Delegation of the Republic of Korea before January 31, 2020.

Update on Trademark-Related Aspects of the Domain Name System (DNS)
(document SCT/42/3).

183. The SCT considered document SCT/42/3 and requested the Secretariat to keep Members informed of future developments in the DNS.

AGENDA ITEM 6: GEOGRAPHICAL INDICATIONS

184. Discussions were based on documents SCT/40/5 and SCT/40/6.

185. The Secretariat presented a test version of a database reproducing all returns 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.

186. The Delegation of Iran (Islamic Republic of) expressed its appreciation to the Secretariat for having developed the database on the basis of the responses received from Member States, and considered it as a very useful tool to better understand and compare national legislations on that topic. The Delegation believed that making the database publicly available would be useful and benefit the relevant authorities of the Member States as well other users or beneficiaries.

187. The Delegation of the European Union, speaking on behalf of the European Union and its member states, thanked the Secretariat for the compilation of the replies to the two questionnaires on geographical indications and for the preparation of a user friendly online database. The Delegation considered that the work of the SCT was a valuable and constructive exercise in advancing the international debate on geographical indications, and looked forward to its continuation with new topics, to be addressed in future information sessions. Concerning the protection of geographical indications in the DNS, the Delegation held the view that geographical indications should not be too mixed with the issue of the protection of country names and geographical names of national significance. Considering that the treatment of geographical indications as intellectual property rights on the Internet presented significant lacunae and unjustified divergences from the treatment of other forms of intellectual property

rights, the European Union and its member states looked forward to further exploring that matter in the Information Session. Moreover, the Delegation was of the opinion that the information session process should be advanced, in particular to address relevant issues of geographical indications, for instance for developing countries or for empowering women farmers. Calling for proposals for future sessions, the Delegation said that it had transmitted proposals for further topics to the Secretariat.

188. The Delegation of Switzerland aligned itself with the statement made by the Delegation of the European Union and thanked the Secretariat for the compilation of the information in the database. Nevertheless, the Delegation said that it was still interested in the issue of protecting country names in different contexts. In addition, the Delegation wondered about the relevance of the data included in the online tool, to the extent that the answers could already no longer be valid, given that legislations on geographical indications evolved. The Delegation therefore suggested indicating the date of validity of the information provided for each country, so that users of the database could evaluate the reliability of the information.

189. The Delegation of Croatia, speaking on behalf of the CEBS Group, extended its gratitude to the Member States that had sent replies to the two questionnaires on geographical indications, and thanked the Secretariat for the compilation of the replies and the presentation of the database. Finding the exchange of ideas on those topics very relevant, it stressed the need for an international discussion on geographical indications. The Delegation expressed its appreciation for the work already undertaken and looked forward to continuing discussions on topics such as geographical indications as intellectual property titles in the operation of the DNS and in dispute resolution policies.

190. The Delegation of the Republic of Moldova thanked the Secretariat for the database, which it found very useful for Member States and producers. The Delegation wondered whether, in the future, the compilation of replies to different questionnaires could be made in the form of a similar database.

191. The Delegation of the Russian Federation, speaking on behalf of the CACEEC Group, thanked the Secretariat for the work on the protection of geographical indications, as well as all the countries that had participated in the questionnaires. Noting that the database was very helpful to understand the complexity of geographical indication systems, the Delegation expressed its support to the exchange of information on the protection for geographical indications in different countries. In addition, the Delegation informed the Committee that a new law, entering into force in the summer of 2020, would grant protection to geographical indications as new subjects of intellectual property, and that the national office would provide updated information to the Secretariat.

192. The Chair concluded that the database would be published on the SCT webpage, and that members were invited to submit new contributions or updates, as the case may be.

193. The Chair asked delegations' views on the planning of the thematic program for future information sessions on geographical indications, given the fact that the SCT had decided to hold several information sessions in the future.

194. The Delegation of the United States of America, expressing its deep appreciation for the organization of information sessions on geographical indications and thanking the Delegation of the European Union for being supportive of future sessions, said it would be interested to hear about national examination practices of geographical indications. Reflecting on the most constructive way to agree on a program for the next information session and following a discussion with a group of delegations on possible topics, the Delegation proposed to explore what happened to the geographical indication protection if the original conditions that had led to its establishment, for example, quality, reputation or geographical link, could not be maintained

in the country of origin. The Delegation believed that that was an examination question and asked what were the policy considerations and processes that intellectual property offices should follow to evaluate the amendments and communicate them to consumers. The Delegation also wondered whether a geographical indication might be subject to cancellation if the conditions that had led to its creation ceased to exist entirely, or ceased to exist for a period of time in the country of origin. The Delegation said that that question had arisen when a request for an amendment of a registration had been filed with the USPTO in respect of different standards that had changed for various reasons. The Delegation wondered whether intellectual property offices would share how they evaluated those requests, and whether consumers would not be deceived or expectations would be met by a product when the original conditions had changed. Mindful of the need to limit the information session to a half-day, the Delegation said that too many topics would mean no time for discussion and called upon trying to keep the topics to a minimum so that the SCT could have a robust discussion about the different practices.

195. The Delegation of Switzerland, thanking the Delegation of the United States of America for taking the initiative to launch the debate on the subjects for the next information session on geographical indications, said that the proposed topic seemed to be of interest to a large number of delegations. Considering that the topic was related to the examination of the link between the characteristics or the quality of a product and its geographical origin, the Delegation suggested that the subject could be addressed in a wider panel, which would include the initial assessment of the link and its further evolution or change, no matter whether the changes had been determined by producers or due to natural causes. That assessment would also mean looking at different mechanisms for regulating products benefiting from geographical indications, competent bodies and criteria for assessment. Aligning itself with the statement made by the Delegation of the United States of America, the Delegation called upon new proposals from the SCT members that had mentioned their interest in information sessions.

196. The Delegation of the European Union, speaking on behalf of the European Union and its member states, looked forward to attending the Information Session on Geographical Indications, scheduled for the next day, and proposed to submit all topics in writing and to discuss them after the Information Session.

197. The Delegation of Brazil, thanking the Delegation of the United States of America for the proposal, expressed its support for the statement made by the Delegation of the European Union.

198. After the holding of the Information Session on Geographical Indications, the Chair congratulated the Secretariat for the excellent organization of said Information Session, pointing out that it had been a very fruitful meeting, which had allowed participants to share views, and representatives of national intellectual property offices to draw beneficial conclusions.

199. The Delegation of Chile concurred with the views expressed by the Chair on the Information Session and asked whether the presentations would be made available.

200. The Delegation of the European Union, speaking on behalf of the European Union and its member states, echoed the comments by the Chair and the Delegation of Chile and congratulated the panelists for the very high standard of the panels. In the Delegation's view, WIPO, like many other international organizations, was interested in gender equality, and it was worth noting that all the six excellent speakers had been women.

201. The Chair, in reply to the question raised by the Delegation of Chile, confirmed that the presentations would be available.

202. The Delegation of the European Union, speaking on behalf of the European Union and its member states, referred to the second proposal of the non-paper and explained that it was a direct follow from the Information Session held that morning, concerning the recognition of intellectual property rights and geographical indications in the DNS. Observing that two speakers had pointed to certain ways that some top level domain controllers had taken in order to respect prior geographical indication rights, the Delegation believed that it might be worth exploring ways that could be used to prevent operators profiting from bad faith use. The Delegation stressed the fact that the proposal was limited to bad faith use and registration of domains and intended to explore what action or creative policy solutions were available to authorities looking after the top level domains, within the current constraints, to prevent operators profiting from bad faith use and registering geographical indications in the DNS.

203. The Delegation of the United States of America, thanking the Delegations of the European Union and Switzerland, announced that they had come together with a joint proposal for the next information session during the forty-third session of the SCT. The Delegation recalled that it was interested to hear about examination practices of requests for amendment to registrations of geographical indications when the original conditions that had led to their creation could no longer be maintained for various reasons. Recalling that the Delegation of Switzerland had raised the issue of initial evaluation of the original request for geographical indication protection as to the quality, link or the definition of geographical indication, the Delegation said that a joint proposal on those two topics could be integrated in one panel. The Delegation wished to ensure that both panelists would have plenty of time to speak and the audience to ask questions and share their experiences and best practices. Reaffirming that the information session had been very interesting and the presentations had raised and answered many questions at the same time, the Delegation wished to continue with those exchanges, useful for its own and other intellectual property offices in figuring out how to deal with certain issues and for learning from other experiences.

204. The Delegation of Brazil, expressing support for the proposals made by the Delegations of Switzerland, the United States of America and the European Union, voiced its own proposal for a topic for discussion at a future information session. Informing the SCT that the Brazilian intellectual property law allowed the registration, as geographical indications, of signs consisting exclusively of names and signs composed of names and other elements, such as designs, drawings and images, the Delegation wished to explore the practices of other Member States in protecting geographical indications consisting exclusively of names and geographical indications composed of names and other elements.

205. The Delegation of Australia, echoing the statements on the usefulness and the informative character of the Information Session, expressed support for the proposals by the Delegations of Switzerland, the United States of America and the European Union. The Delegation further wondered whether Member States would be interested to submit topics for the information session in conjunction with the forty-fourth session of the SCT in advance, and if those could be discussed and decided at the forty-third session of the SCT.

206. The Delegation of Croatia, speaking on behalf of the CEBS Group, lent its support to the proposals by the Delegations of Switzerland, the United States of America and the European Union.

207. The Delegation of Canada, expressing its support for the proposals by the Delegations of Switzerland, the United States of America and the European Union, expressed the view that the Information Session had been highly productive and informative and allowed an exchange of best practices where all could learn from. Expressing also support for the proposal made by the Delegation of Australia, the Delegation said that advanced submission, review and consideration of the topics would facilitate the discussions and would lead to finalized topics in an efficient manner.

208. The Delegation of Iran (Islamic Republic of), expressing its agreement for the topics for discussion at the next information session, lent its support to the proposal made by the Delegation of Australia to submit topics in advance of the meeting, thereby giving more time to consider the issues and make the best decision during the session.

209. The SCT considered a non-paper with proposals for topics for a half-day information session to take place during the forty-third session of the SCT.

210. The Chair concluded that the SCT agreed:

- to hold one half-day information session on geographical indications in conjunction with the forty-third session of the SCT;
- that the program for that information session would comprise two panels on the following topics: (i) evaluation of the conditions that created the basis for the geographical indication protection and evaluation of any changes to those conditions; (ii) ways to prevent operators profiting from bad faith use and registration of GI intellectual property rights in the DNS.
- to invite Members to present to the forty-third session of the SCT proposals for topics for an information session on geographical indications, to be held in conjunction with the forty-fourth session of the SCT.

AGENDA ITEM 7: ADOPTION OF THE SUMMARY BY THE CHAIR

211. The SCT approved the Summary by the Chair as presented in document SCT/42/8.

AGENDA ITEM 8: CLOSING OF THE SESSION

212. The Delegation of Uganda, speaking on behalf of the African Group, thanked the Chair for his excellent leadership, the Vice-Chairs and the Secretariat, interpreters and conference services for their support and all Member States for their constructive engagement. The Delegation recalled that, at the opening of the session, it had looked forward to a successful conclusion of the session and to mutually agreeable outcomes, which addressed the diverse interests of all SCT members and other stakeholders in a balanced manner. The Delegation noted with satisfaction that some progress had been achieved in some areas, with respect notably to the successful Information Session on Geographical Indications, the agreement on the topics to be discussed at the next SCT session, as well as on some proposals for further exploratory studies, which, in the Delegation's viewpoint, would contribute to Member States' enhanced understanding of issues being discussed within the Committee. However, the Delegation regretted that a number of longstanding issues remained unresolved, in particular the issue of the protection of country names from being monopolized by private companies or being used in a misleading manner, as well as the Draft Articles for a Design Law Treaty. Once again, the Delegation wished to strongly caution against moving to normative work on areas on which little exploratory work had been undertaken by the Committee, and where only a limited number of WIPO members had participated. The Group also recalled that the WIPO Development Agenda, Recommendations 21 and 22, enjoined WIPO to "conduct informal, open and balanced consultations, as appropriate, prior to any new norm-setting activities, through a member-driven process, promoting the participation of experts from Member States, particularly developing countries and LDCs" and that "WIPO's norm-setting activities should be supportive

of the development goals agreed within the United Nations system, including those contained in the Millennium Declaration". Finally, the Delegation expressed its willingness to continue engaging in a constructive manner on all outstanding issues in future SCT sessions.

213. The Delegation of the European Union, speaking on behalf of the European Union and its member states, congratulated the Chair for successfully guiding the Committee during the session. On the topic of industrial designs, the Delegation welcomed the decision that both the questionnaire on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs and the questionnaire on the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions under Article 11 of the Paris Convention should remain open for members to submit additional responses, in order to further expand the volume of information available. Expressing its appreciation for the fact that the proposal submitted by the Delegations of Japan and the United States of America would remain on the table at the next session, the Delegation thanked the proponents for their flexibility and readiness to take on board the comments made. The Delegation also noted with satisfaction that a consensus to organize an information session on the topic of international exhibitions at the next session had been reached. As regards trademarks, in particular the discussion on country names, the Delegation thanked all delegations and the proponents for their continued efforts to reach a consensus. The Delegation expressed its openness to continue discussing the issue, in particular as regards the joint proposal contained in document SCT/41/6, and looked forward to the preparation and discussion of questionnaires on nation brands and on the protection of well-known marks at the next session. Concerning geographical indications, the Delegation welcomed the finalization of the database reproducing all returns to Questionnaires I and II. Finally, the Delegation held the view that the Information Session had allowed the Committee to hear from three expert panels on important aspects of geographical indications, considering that those sessions met an important need to exchange experiences in order to advance the global conversation on geographical indications in a constructive and business-like manner. In addition, the Delegation welcomed the decision to organize future information sessions at the next SCT to discuss two topics, one submitted by the Delegations of the United States of America and Switzerland, and the other, by the European Union. Welcoming also with satisfaction further proposals tabled from the wider membership, the Delegation expressed its support to also discuss Brazil's proposal at the next session, as well as other proposals for the forty-fourth session. The Delegation was also pleased to announce that the European Union was planning to deposit its instrument of accession to the Geneva Act of the Lisbon Agreement on November 26, 2019. Finally, the Delegation hoped that the Committee would continue to have fruitful discussions on all three key areas at the next session.

214. The Delegation of Singapore, speaking on behalf of the Asia and the Pacific Group, commended the Chair and the Vice-Chairs for their able and effective leadership in guiding Member States' discussions during the session of the SCT. The Group wished to thank the Secretariat, interpreters and conference services for their excellent work in supporting the Committee. On industrial designs, the Delegation looked forward to further discussions on GUIs at the next session of the SCT. Taking note of the fact that the Questionnaire on Graphical User Interface, Icon and Typeface/Type Font Designs was open for further replies from members, the Delegation looked forward to continuing discussions with Member States. Stating that it was unfortunate that the discussions on the DLT had yet to yield consensus, the Delegation looked forward to further discussions towards a diplomatic conference for the DLT. Turning to trademarks, reiterating the importance of providing sufficient protection for country names to prevent undue registration or use as trademarks, the Delegation looked forward to further discussions, as well as in relation to the various proposals contained in documents SCT/32/2, SCT/42/4 and SCT/42/5. Expressing the view that the Information Session on Geographical Indications had provided an excellent opportunity for members to share best practices, the Delegation looked forward to the continued sharing of experiences through information sessions at future SCT meetings.

215. The Delegation of Mexico, speaking on behalf of GRULAC, thanked the Chair for his professionalism in guiding the work of the Committee. With regard to the protection of country names, the Delegation expressed its readiness to continue discussions on the revised proposals contained in documents SCT/32/2 and SCT/39/8 Rev.3, as well as on any other initiative that may be presented in relation to the topic at the next session of the SCT. The Delegation indicated, furthermore, that GRULAC would follow with interest the debate on the proposal concerning the Protection of Country Names and Geographic Names of National Significance in the Domain Name System, co-sponsored by the Delegations of Georgia, Iceland, Indonesia, Jamaica, Liechtenstein, Malaysia, Mexico, Monaco, Peru, Senegal, Switzerland, United Arab Emirates and more recently Brazil, and its possible revision. The Delegation welcomed the decision to present a revised version of Peru's proposal to conduct a survey on nation-brand protection in Member States, based both on the comments made during the session and those that might be received by the Secretariat later. The Delegation indicated that GRULAC supported the spirit of the Peruvian proposal, as it could provide relevant information for the work of the SCT. The Group noted with appreciation the decision to publish the database containing the replies to the two questionnaires on geographical indications on the Committee's webpage and to invite SCT members to submit new contributions or update the information if necessary. Expressing its appreciation for the organization of the Information Session on geographical indications, the Group said that it had been a fruitful meeting, which had allowed the Committee to learn about different approaches. GRULAC took note of the topics which would be considered within the framework of the Information Session at the forty-third session of the SCT, as well as the invitation for Member States to submit additional topics to be considered at the forty-fourth session of the SCT. The Delegation also looked forward to the Information Session addressing the practices of offices and the experience of users with regard to the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions Under Article 11 of the Paris Convention. The Delegation concluded by thanking the Secretariat, as well as the conference services and interpreters, for the support provided to facilitate the meeting.

216. The Delegation of Brazil thanked the Chair and the Secretariat for the work in the Committee, as well as the interpreters. Regarding industrial designs, the Delegation regretted that, during the Committee and the 2019 WIPO General Assembly, it had not been possible to reach an agreement on the issue of the DLT. The Delegation hoped that Member States could reach consensus on the convening of a diplomatic conference as soon as possible. Concerning trademarks, the Delegation stressed the importance of a balance that took into account the legitimate interests of Member States on the protection of country names, pointing out that the SCT could take an active role on that issue. In that spirit, the Delegation co-sponsored the proposal concerning the protection of country names and geographical names of national importance in the DNS, contained in document SCT/41/6. The Delegation added that the fundamental difference between the use of country names and regions in trademarks and their use in domain names was that, in the case of trademarks, the granting of the right did not completely prevent the use of those names by other enterprises or even governments in other contexts, whereas in the case of Internet domain names, a monopoly was created to the exclusion of a whole community of people. In the view of the Delegation, that was staggeringly unbalanced. After having carefully heard members' views on the proposal contained in document SCT/41/6, the Delegation reiterated its commitment to work towards consensus on a solution that matched private interests, while safeguarding public concerns and principles. On geographical indications, the Delegation thanked the Secretariat and the panelists for sharing their work at the Information Session on Geographical Indications, pointing out that the relationship between trademarks and geographical indication was a very interesting topic and would merit further discussions within the Committee. The Delegation expressed the wish to know more about the experiences of other Member States and indicated its readiness to make contributions at the next sessions of the SCT. Expressing support for the topics approved for discussion at the forty-third session of the SCT, especially the "evaluation of the conditions that

created the basis for the geographical indication protection and the evaluation of any changes to those conditions”, the Delegation stated that it would present a proposal for topics for discussion at the next session, to be considered at the forty-fourth session of the SCT.

217. The Delegation of France, in its national capacity, aligned itself with the statement made by the Delegation of the European Union and offered its congratulations on the upcoming accession of the European Union to the Geneva Act of the Lisbon Agreement, particularly as each of its member states would be able to accede to the Act in accordance with the decision of the European Council published in the official journal of the European Union on October 24, 2019. Moreover, the Delegation welcomed the conclusions of the political agreement between the European Union and China on geographical indications. That agreement had been announced at an international trade fair in Shanghai in the presence of the President of the French Republic and the President of the People’s Republic of China. From its entry into force in 2020, that agreement would make it possible to bestow a high level of protection on 100 European geographical indications (of which 26 were French) and 100 from China. French geographical indications would benefit from strong guarantees. Firstly, the guarantee that the names of the geographical indications would be translated and transliterated into Chinese. Secondly, the refusal to third parties to register the protected geographical indications as trademarks. Thirdly, the automatic rejection of trademark applications that included the geographical indications contained in the agreement, including references to the geographical indications. The Delegation added that the agreement contributed to promoting the rural development model that brought together the local areas, producers and consumers that were the embodiment of geographical indications. It also represented an important step in the recognition of the French system for the protection of geographical indications by the world’s second largest trading power. In conclusion, the Delegation stated that the Geneva Act of the Lisbon Agreement, together with the political agreement with China on geographical indications, significantly paved the way for a more comprehensive recognition and protection of geographical indications.

218. The Chair closed the session on November 7, 2019.

[Annexes follow]



SCT/42/INF/1
ORIGINAL : FRANÇAIS/ANGLAIS
DATE : 7 NOVEMBRE 2019/NOVEMBER 7, 2019

Comité permanent du droit des marques, des dessins et modèles industriels et des indications géographiques

**Quarante-deuxième session
Genève, 4 – 7 novembre 2019**

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

**Forty-Second Session
Geneva, November 4 to 7, 2019**

**LISTE DES PARTICIPANTS
LIST OF PARTICIPANTS**

*établie par le Secrétariat
prepared by the Secretariat*

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(dans l'ordre alphabétique des noms français des États/in the alphabetical order of the names in French of the states)

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* Based on a decision of the Standing Committee, the European Communities were accorded member status without a right to vote.

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MARQUES - Association des propriétaires européens de marques de commerce/

MARQUES - The Association of European Trade Mark Owners

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Secrétaire/Secretary:	Marcus HÖPPERGER (M./Mr.) (OMPI/WIPO)

IV. SECRETARIAT DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ
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[Annex II follows]



SCT/42/8
ORIGINAL: ENGLISH
DATE: NOVEMBER 7, 2019

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

Forty-Second Session
Geneva, November 4 to 7, 2019

SUMMARY BY THE CHAIR

adopted by the Committee

AGENDA ITEM 1: OPENING OF THE SESSION

1. Mr. Alfredo Rendón Algara, Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), opened the forty-second session of the SCT and welcomed the participants.
2. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), delivered opening remarks.
3. Mr. Marcus Höpperger (WIPO) acted as Secretary to the SCT.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

4. The SCT adopted the draft Agenda (document SCT/42/1 Prov. 2).

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE FORTY-FIRST SESSION

5. The SCT adopted the draft Report of the forty-first session of the SCT (document SCT/41/11 Prov.).

AGENDA ITEM 4: INDUSTRIAL DESIGNS

Industrial Design Law and Practice-Draft Articles and Draft Regulations

6. The Chair recalled that the WIPO General Assembly, on the occasion of its session in October 2019, had decided that, at its next session in 2020, it will continue considering the convening of a diplomatic conference on the Design Law Treaty (DLT), to take place at the end of the first half of 2021.

7. The Chair concluded that the SCT took note of all statements made by delegations on that item. The SCT noted the decision of the General Assembly to continue considering this matter at its next session in 2020.

Graphical User Interface (GUI), Icon and Typeface/Type Font Designs

8. The SCT considered document SCT/41/2 (Compilation of the Returns to the Questionnaire on Graphical User Interface (GUI), Icon and Typeface/Typefont Designs).

9. The Chair concluded that the Secretariat was requested to:

- keep the document open until January 10, 2020, for further or revised replies by delegations;
- prepare a document analyzing all replies, for consideration of the SCT at its next session.

10. Furthermore, the SCT considered document SCT/42/6 (Proposal by the Delegations of Japan and the United States of America for a Joint Recommendation on Industrial Design Protection for Graphical User Interface (GUI) Designs).

11. The Chair concluded that discussion on document SCT/42/6 would continue at the forty-third session of the SCT.

Temporary Protection Provided to Industrial Designs at Certain International Exhibitions Under Article 11 of the Paris Convention for the Protection of Industrial Property (document SCT/42/2 Prov.)

12. The SCT considered document SCT/42/2 Prov. (Compilation of the Returns to the Questionnaire on the Temporary Protection Provided to Industrial Designs at Certain International Exhibitions Under Article 11 of the Paris Convention for the Protection of Industrial Property).

13. The Chair concluded that the Secretariat was requested to:

- keep the document open until January 10, 2020, for further replies by delegations;
- finalize the document thereafter and present it for consideration by the forty-third session of the SCT;

- organize a half-day information session that would take place during the forty-third session of the SCT, addressing (i) the practices of offices and (ii) the experience of users, with regard to the temporary protection provided to industrial designs under Article 11 of the Paris Convention.

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

14. The SCT noted the progress in the implementation of the DAS for industrial designs by members.

15. The Chair concluded that the SCT would revert for an update to this item at its next session.

AGENDA ITEM 5: TRADEMARKS

Revised Proposal by the Delegation of Jamaica (document SCT/32/2).

16. The SCT considered document SCT/32/2.

17. The Chair concluded that the Delegation of Jamaica would present a revised version of this document to the next session of the SCT in light of the comments made during this session.

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/39/8 Rev.3).

18. The SCT considered document SCT/39/8 Rev.3.

19. The Chair concluded that the co-sponsors of document SCT/39/8 Rev.3 would present a revised version of their proposal to the next session of the SCT.

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 in the DNS (document SCT/41/6).

20. The SCT considered document SCT/41/6.

21. The Chair concluded that discussion on document SCT/41/6 would continue at the forty-third session of the SCT.

Proposal by the Delegation of Peru to Conduct a Survey on Nation-Brand Protection in Member States (document SCT/42/4)

22. The SCT considered document SCT/42/4.

23. The Chair concluded that:

- The Delegation of Peru would send to the Secretariat, before December 31, 2019, a proposal for a draft questionnaire on nation-brand protection in Member States;
- Members were invited to send to the Secretariat, before December 31, 2019, questions they would like to include in the draft questionnaire;
- The Secretariat was requested to compile all questions, for consideration of the draft questionnaire by the SCT at its next session.

Proposal by the Delegation of the Republic of Korea on the Protection of Well-known Marks (document SCT/42/5)

24. The SCT considered document SCT/42/5.

25. The Chair concluded that:

- The Delegation of the Republic of Korea would present a revised version of its proposal on Member States' practices in relation to the protection of internationally well-known marks, taking into account the comments made by delegations, for consideration of the SCT at its next session;
- Members were invited to communicate their contributions to the Delegation of the Republic of Korea before January 31, 2020.

Update on Trademark-Related Aspects of the Domain Name System (DNS)

26. The SCT considered document SCT/42/3 and requested the Secretariat to keep Members informed of future developments in the DNS.

AGENDA ITEM 6: GEOGRAPHICAL INDICATIONS

27. The SCT considered documents SCT/40/5 and SCT/40/6.

28. The Secretariat presented a test version of a database reproducing all returns 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.

29. The Chair concluded that the database would be published on the SCT webpage, and that Members were invited to submit new contributions or updates, as the case may be.

30. The SCT considered a non-paper with proposals for topics for a half-day information session to take place during the forty-third session of the SCT.

31. The Chair concluded that the SCT agreed:
- to hold one half-day information session on geographical indications in conjunction with the forty-third session of the SCT;
 - that the program for that information session would comprise two panels on the following topics: (i) evaluation of the conditions that created the basis for the geographical indication protection and evaluation of any changes to those conditions; (ii) ways to prevent operators profiting from bad faith use and registration of GI intellectual property rights in the DNS.
 - to invite Members to present to the forty-third session of the SCT proposals for topics for an information session on geographical indications, to be held in conjunction with the forty-fourth session of the SCT.

AGENDA ITEM 8: CLOSING OF THE SESSION

32. The Chair closed the session on November 7, 2019.

[End of Annex II and document]