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

Fifth Session
Geneva, September 11 to 15, 2000

REPORT

prepared by the International Bureau

INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”) held its fifth session, in Geneva, from September 11 to 15, 2000.

2. The following States members of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Algeria, Andorra, Angola, Argentina, Australia, Austria, Azerbaijan, Belgium, Bhutan, Brazil, Bulgaria, Canada, Chile, China, Colombia, Congo, Costa Rica, Croatia, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Estonia, Finland, France, Germany, Greece, Guatemala, Guinea, Hungary, India, Indonesia, Iran (Islamic Republic of), Iraq, Ireland, Italy, Jamaica, Japan, Kenya, Latvia, Liberia, Libyan Arab Jamahiriya, Lithuania, Madagascar, Mauritius, Mexico, Morocco, Netherlands, New Zealand, Nicaragua, Nigeria, Norway, Pakistan, Panama, Paraguay, Philippines, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Rwanda, Saudi Arabia, Singapore, Slovakia, Spain, Sri Lanka, Sudan, Suriname, Swaziland, Sweden, Switzerland, Tajikistan, Thailand, The former Yugoslav Republic of Macedonia, Togo, Trinidad and Tobago, Turkey, Turkmenistan, Uganda, Ukraine, United Kingdom, United States of America, Venezuela (86). The European Communities were also represented in the capacity of a member of the SCT.

3. The following intergovernmental organizations took part in the meeting in an observer capacity: Benelux Trademark Office (BBM), International Vine and Wine Office (OIV), World Health Organization (WHO), World Trade Organization (WTO).
4. Representatives of the following international non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Benelux Trademark Office (BBM), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), European Spirits Producers (CEPS), Institute of Intellectual Property (IIP), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), International Wine Law Association (AIDV), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademarks Association (JTA), Union of Manufacturers for the International Protection of Industrial and Artistic Property (UNIFAB), World Association for Small and Medium Enterprises (WASME) (17).
5. The list of participants is contained in Annex I of this Report.
6. Discussions were based on the following documents prepared by the International Bureau of WIPO: “Agenda” (document SCT/5/1), “Protection of Trademarks and Other Distinctive Signs on the Internet” (document SCT/5/2), “Possible Solutions for Conflicts Between Trademarks and Geographical Indications and for Conflicts Between Homonymous Geographical Indications” (document SCT/5/3), and “Text of the Proposed Joint Recommendation Concerning Trademark Licenses” (document SCT/5/4).
7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

GENERAL DISCUSSION

Agenda Item 1: Opening of the Session

8. The session was opened by the Chair, Ms. Lynne Beresford (United States of America). Mr. Shozo Uemura, Deputy Director General, welcomed the participants. Mr. Denis Croze (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 2: Adoption of the Agenda

9. The Agenda (document SCT/5/1) was adopted without modification.

Agenda Item 3: Adoption of the Draft Report of the Fourth Session

10. The Delegation of Brazil stated that in its intervention, as set forth in paragraph 27 of SCT/4/6 prov.1., the reference to page 10 should be changed to page 12. The delegation added that its intervention, as stated in paragraph 47, should be modified by replacing “the

Patent Office” by “the Institute of Industrial Property”.

11. The Delegation of Spain stated that in paragraphs 35 and 38 of SCT/4/6 Prov.1, the reference to Spain should be deleted, since its national law did not require that the licence contract or a copy of the licence contract be filed together with a request for recordal.

12. The draft Report of the fourth session of the SCT (document SCT/4/6 Prov.1.) was adopted with the aforementioned modifications.

Agenda Item 4: Protection of Trademarks and Other Distinctive Signs on the Internet
(see document SCT/5/2)

General Observations

13. Following several interventions and a suggestion by the International Bureau, the SCT agreed to rename the provisions as “Protection of Marks and Other Industrial Property Rights in Relation to the Use of Signs on the Internet” in order to clearly indicate marks as the center of gravity of the provisions, and to avoid confusion with other activities of WIPO relating to the Internet and electronic commerce.

14. The representative of an observer organization asked whether “cybersquatting” was covered by the draft provisions, and how they related to anti-cybersquatting laws that had recently been passed in several legislations. The International Bureau replied that the use of distinctive signs as domain names was included in the concept of “use of a sign on the Internet” and that “cybersquatting” merely constituted one of the various problematic cases addressed by the provisions. One delegation suggested, and the International Bureau agreed, to explain in the notes how the draft provisions related to domain names, as well as to various other activities undertaken by, and in the framework of, WIPO.

15. The Delegation of Brazil stated that it was premature to envisage the adoption of the draft provisions as a joint recommendation, since many countries lacked experience regarding the use of the Internet. The Delegation of Sudan stated that its country had just recently been connected to the Internet and pointed to the practical difficulties that its country might face in implementing the provisions.

16. The representative of an observer organization said that the draft provisions have been substantially improved since the last SCT meeting, particularly relating to coexistence of rights, and that a consensus could be easily reached on the provisions. He stated that industry considered it as urgent to have these guidelines adopted and suggested that the SCT should propose the draft provisions for adoption as a joint recommendation, no later than at the WIPO Assemblies in 2001.

17. Revised draft provisions are contained in Annex II. This report will refer to the provisions using the numbering as contained in SCT/5/2, except for quotations of revised provisions which are renumbered as in Annex II.

Preamble

18. The Delegation of Brazil referred to conflicts between national law and the draft provisions and proposed to add, in the third sentence of Note 0.01, the word “may” before the words “require some modifications.” The International Bureau indicated that this would be done.

Section 1: Abbreviated Expressions

19. One delegation referred to the statement in Note 1.04 that “Member States are free to determine what kinds of industrial property rights in (distinctive) signs they recognize”, and asked how this statement related to the definition of “industrial property” in Article 1(2) of the Paris Convention. The International Bureau replied that Article 1(2) of the Paris Convention summarizes the subject matter of industrial property that Contracting Parties are required to protect as a minimum without precluding the protection of additional subject matter, such as rights in layout designs of integrated circuits, plant varieties or geographical indications. The draft provisions follow the same approach by leaving it to the Member States to decide which subject matter they want to protect as “industrial property” in addition to the subject matter mentioned in Article 1(2) of the Paris Convention.

20. Following a suggestion made by the International Bureau, the SCT decided to combine items (vii) and (viii) by deleting item (viii) and adding the words “for the Protection of Industrial Property, signed in Paris on March 20, 1883, as revised and amended” at the end of item (vii).

21. In response to a question by one delegation regarding the relationship between “mark” and “sign” as defined in items (ii) and (iii), the International Bureau explained that the concept of “sign” as defined in item (iii) referred to all distinctive signs irrespective of whether the sign was used to indicate the source of goods and services, or whether the user owned an industrial property right such as a trademark right in that sign. Hence “signs” included all indications on the Internet that could infringe an industrial property right, such as, for example, domain names, without implying a right. The definition of “mark” in item (ii) did not interfere with that definition but merely clarified that that term covers both trademarks and service marks. The International Bureau stated that it would review the draft for the next meeting with a view to decide whether the term “mark” could be deleted in various provisions. One delegation proposed to take the definition of “marks” from the TRIPS Agreement. The representative of an observer organization suggested to include the concept of right held by groups of persons, such as collective marks or geographical indications, in items (ii) and (iii).

22. One delegation proposed to state, in item (v), that use of a sign on the Internet should only be relevant under these provisions if it occurred in a Member State. The International Bureau agreed that this was one of the basic principles of the provisions, but explained that it had been WIPO’s policy not to include basic principles in the definitions.

23. One delegation expressed concern with regard to the definition of “use of a sign on the Internet” in item (v) and stated that it might cause confusion in relation to the concept of “use of a sign on the Internet in a Member State” used in Section 2. The International Bureau stated that item (v) was in fact a definition of the Internet, and suggested to think about a straightforward definition of “Internet”. Following a proposal made by one delegation, the

SCT decided to delete item (v), to add the following new paragraph to the Preamble: “*Recognizing* that a sign used on the Internet is simultaneously and immediately accessible irrespective of territorial location”, and to reserve the possibility of defining “Internet” in Article 1.

24. The revised provision appears in Annex II.

Section 2: Use of a Sign on the Internet in a Member State

25. In response to concerns expressed by two delegations, the SCT agreed to replace the word “defined” by “described.” It was also decided to replace the word “determining” by the word “these provisions” and to delete the remaining words on the grounds that they merely stated what was more specifically set out in Sections 4 and 7.

26. Three delegations noted that the provision did not strictly restrict the notion of “use of a sign on the Internet in a Member State” to use that had a commercial effect in that State, but that it left room for use that did not have a commercial effect. This might undermine provisions that used the term “use of a sign on the Internet in a Member State” as a shorthand expression for use that had a commercial effect in that Member State. Following a suggestion made by the representative of an observer organization, the SCT decided to further redraft the provision as follows:

“Use of a sign on the Internet shall constitute use of the sign in a Member State for the purposes of these provisions, only if the use has a commercial effect in that Member State as described in Section 3.”

27. One delegation proposed to include the contents of Sections 4 and 7 in Section 2 in order to create a provision that dealt with use of a sign on the Internet in a comprehensive manner. In response, the International Bureau pointed out that such a provision might be very dense, and that it might be easier for future readers to understand if the provisions first set out the general principle in Section 2, and then turned to its application in specific situations, such as referred to in Sections 4 and 7.

28. The revised provision appears in Annex II.

Section 3: Factors for Determining Commercial Effect in a Member State

29. In response to a question by one delegation, the Chair explained that it was left to the competent authority to decide which factors were relevant in a given case. The competent authority was, however, obliged to take every factor into account which it had identified as being relevant. Following a proposal made by one delegation, the SCT decided to replace the words “, including but not limited to:” by the following new sentence: “Circumstances that may be relevant include, but are not limited to:” in order that a competent authority would not feel compelled to express an opinion about every factor listed in paragraph (1) irrespective of its relevance.

Paragraph (1)(a).

30. No comments were made on this provision.

Paragraph (1)(b).

31. In response to interventions from a number of delegations relating to item (ii), the International Bureau explained the difference between the concepts of “disclaimer” used in Section 3(1)(b)(ii) and in Section 10. It stated that Section 10 concerned a particular situation in which the user of the sign not only held a right in that sign, but was also already aware of one or more particular conflicting rights. If, in such a case, the user not only excluded delivery to certain countries, but also complied with that statement and, in addition to that, avoided confusion with the conflicting right, he or she could effectively avoid liability for infringement of the conflicting right. Section 3(1)(b)(ii), on the other hand, merely recognized that statements excluding delivery to certain countries might be a factor for avoiding a commercial effect in a particular country without in any way prejudicing the findings of the competent authority. Two delegations and the representative of an observer organization explicitly supported the retention of Section 3(1)(b)(ii). Following the proposal put forward by the representative of an observer organization, it was agreed to add the words “and whether the user adheres to that stated intent” at the end of item (ii).

32. Two delegations pointed to the practical difficulties if users were obliged to provide the statement in the languages of all countries with which they did not want to establish a commercial relationship; in most cases, the user would not even know in which countries conflicting rights existed and would therefore, as a precautionary measure, have to provide disclaimers in an unreasonable number of languages. These delegations held that it should be left to the competent authorities of Member States to determine the efficiency of a disclaimer under Section 3(1)(b)(ii) with regard to the language used in an individual case, and not to restrict its determination by any reference to languages in item (ii). As a result, the SCT decided to delete the words “, in the language or in the languages, used on that web site, and in the language, or in the languages, used in the Member State or Member States disclaimed.”.

Paragraph (1)(c).

33. No comments were made on this provision.

Paragraph (1)(d).

34. Following the proposal made by one delegation, the SCT decided to clarify item (i) by adding the word “Internet” before the word “users”.

35. The SCT also agreed to add the words “, or is otherwise directed to customers in that Member State” at the end of item (ii), as had been proposed by one delegation, on the grounds that customers in one country could be targeted by using a telephone number in a neighboring country where the same or a similar language is spoken.

36. With respect to item (v), the representative of an observer organization stated that visits to a particular web site might very well be relevant when a great number of visits has taken place. He suggested to replace, in Note 3.14, the word “will” by “may” so that the relevant sentence would read: “It should be noted that the fact alone that a particular web site had been visited by Internet users located in a particular Member State may not suffice for concluding that use of a sign on that web site has a commercial effect in that Member State.”

Paragraph (1)(e).

37. No comments were made on this provision.

Paragraph (1)(f).

38. Following an intervention by one delegation, which stated that subparagraph (f) unnecessarily repeated what was already set out in the chapeau of paragraph (1) and in paragraph (2), the SCT decided to delete this subparagraph and the corresponding note.

Paragraph (2).

39. No comments were made on this provision.

40. The revised text of Section 3 appears in Annex II.

Section 4: Consideration of Use of a Sign on the Internet in a Member State for Determining Acquisition and Maintenance of Industrial Property Rights in Marks or Other Signs in that Member State

41. The International Bureau explained that this provision required Member States to treat use of a sign on the Internet that has a commercial effect in a Member State in the same way as use in that Member State outside the Internet. It noted that the words “Irrespective of any other requirements under the applicable law” might give rise to misinterpretation. Two delegations proposed to delete these words. Another delegation proposed to use a shorter title.

42. Another delegation noted that the provisions did not explicitly require Member States to take “new forms of use” into account when determining whether the relevant criteria for acquiring or maintaining an industrial property right under the applicable law have been met, whereas Section 6 contained such an obligation with regard to infringement of rights. The Chair stated that “new forms” of use, such as metatags, were often invisible and would thus not qualify under most laws for acquiring or maintaining industrial property rights. Two delegations objected to the inclusion of a provision dealing specifically with “new forms of use” and stated that the term “use of a sign” in Section 4 would already include such “new forms.” The International Bureau pointed out that a specific provision might nevertheless be necessary in order to avoid *e contrario* arguments from Section 6 to the effect that “new forms of use” would only have to be taken into account for the purposes of determining infringement under the applicable law, but not for the deciding whether the criteria for acquiring or maintaining an industrial property right have been met. After one delegation had expressed concern that such a provision might require Member States to take even “hidden” forms of use into account, such as use as metatags, the SCT agreed that the final determination as to whether a particular “new form of use” could be taken into account would be left to the applicable law.

43. After some discussion, the SCT decided to redraft Section 4 as follows, subject to review by the International Bureau for clarity and accuracy of drafting:

*“Section 4**Use of a Sign on the Internet and Acquisition and Maintenance of Rights*

(1) Use of a sign on the Internet in a Member State shall be taken into consideration for determining whether any criteria relating to use under the applicable law of the Member State for acquiring or maintaining industrial property rights in marks or other signs have been met.

(2) Forms of use that are made possible by technological advances shall be taken into consideration under paragraph (1) if they contribute to fulfilling the requirements under the applicable law of the Member State for acquiring or maintaining industrial property rights in marks or other signs.”

Section 5: Liability for Infringement Under the Applicable Law

44. In response to a question by the representative of an observer organization, the International Bureau explained that the liability of online service providers was not specifically addressed in the draft provisions but was left to the applicable laws of Member States.

45. Two delegations stated that “liability” as addressed in Section 5 had to be distinguished from “infringement” as covered by Sections 6 and 7. Since liability was the logical consequence of infringement, these delegations proposed to move Section 5 after Sections 6 and 7. This was supported by other delegations and the representative of an observer organization, who also proposed to move Section 7 before Section 6 and to merge Sections 5 and 8.

46. One delegation proposed to clarify in the text that the provision dealt only with liability in a particular Member State. The delegation also proposed to include a reference to unfair competition. The SCT decided to insert the word “in a Member State” after the word “liability”, and the words “in that Member State” at the end of the provision. The SCT also asked the International Bureau to consider how liability for acts of unfair competition could be addressed in the context of the next redraft of this provision.

47. After some discussion, the SCT decided to rename Part IV as “Infringement and Liability”, and to create a new Part V “Coexistence of Rights” including Sections 9 to 11, with consequential renumbering of the existing Part V “Remedies” as Part VI. It was also decided to merge Sections 6 and 7. Section 5 was therefore renumbered as new Section 6 (see Annex II).

Section 6: New Forms of Uses Made Possible by Technology

48. In response to a question raised by one delegation, the Chair explained that Section 6 did not require Member States to pass specific laws dealing with “new forms of use” on the Internet, but left it to the applicable law to find adequate responses to new technology. The International Bureau said that the provision was aimed at preventing competent authorities from generally refusing to consider certain forms of use as infringement merely because they

are new. Another delegation supported the provision and stated that it obliged Member States to monitor new and emerging, and possibly circumventive, forms of use, and to provide protection under their national laws.

Paragraph (1).

49. The SCT decided to move the content of this paragraph to a new paragraph (2) of Section 7, in order to ensure consistency with Section 4 that was structured in the same way. For the same reason it was decided to reword the provision along the lines of new paragraph (2) of Section 4 (see Section 5(2) in Annex II).

Paragraph (2).

50. Following the proposal made by two delegations, the SCT decided to delete this provision and to move its contents into the Notes.

Section 7: Consideration of Use of a Sign on the Internet in a Member State as Infringement of Industrial Property Rights in Marks or Other Signs Protected in that Member State

51. Three delegations stated that the provisions should be closely linked to Section 2, either by a direct reference or by using the expression “use of a sign on the Internet in a Member State” as defined in Section 2. This was supported by the representative of an observer organization. Other delegations proposed to draft the provision along the lines of redrafted Section 4(1).

52. One delegation proposed to include a reference to unfair competition in the title of the provision in order to reflect more clearly its contents.

53. After some discussion, the SCT decided to add a new paragraph as paragraph (2) and to reword the provision as follows, subject to review by the International Bureau for clarity and accuracy of drafting:

Section 5

Use of a Sign on the Internet, Infringement of Rights and Acts of Unfair Competition

(1) Use of a sign on the Internet shall be taken into consideration for determining whether industrial property rights under the applicable law of a Member State have been infringed, or whether the use amounts to an act of unfair competition under the law of that Member State, only if that use constitutes use of the sign on the Internet in that Member State under these provisions.

(2) Forms of use that are made possible by technological advances shall be taken into consideration under paragraph (1) if they contribute to fulfilling the requirements under the applicable law of the Member State concerning the industrial property right in question.

54. As a consequence of the changes in the order of Sections 5 to 8, Section 7 was renumbered as Section 5(1) (see Section 5(1) in Annex II).

Section 8: Exceptions and Limitations

55. One Delegation stated that this provision was relevant for all provisions of the draft and proposed to include it in the Preamble. This proposal received no support.

56. One delegation expressed concern that the provision might be understood as requiring Member States to provide specific exceptions and limitations for the use of signs on the Internet. In order to clarify that the provision was merely intended to place use on the Internet in a Member State on the same footing as use outside the Internet, the SCT decided to insert the word “existing” before the words “under the applicable law” and to amend the title to read “Exceptions and Limitations Under the Applicable Law.”

57. As a consequence of the decision to merge previous Sections 7 and 6, Section 8 was renumbered as Section 7 (see Annex II).

Section 9: Simultaneous Use of Signs

58. Following the interventions of one delegation and the representative of an observer organization that expressed doubts as to whether the title “Simultaneous Use of Signs” adequately reflected the contents of the provision, the SCT decided to replace that title by “Use Supported by an Industrial Property Right”.

59. After some delegations and the representative of an observer organization had raised concerns regarding the word “exception” in the subtitles, the SCT decided to replace the current titles of paragraphs (1) and (2) by “*Use Prior to Notification*” for paragraph (1) and “*Use After Notification*” for paragraph (2).

Paragraph (1).

60. One delegation proposed to broaden item (i) by including licensees and other legitimate users. This was supported by another delegation and the representative of an observer organization. After some discussion, it was decided to include the words “, or uses the sign with the consent of the owner of,” after each occurrence of the words “he owns” throughout the provisions.

61. In response to a question posed by the representative of an observer organization as to whether applicants were covered by item (i), the Chair responded that this was only the case if applicants were treated as right holders under the applicable law.

62. Item (iii). Following a suggestion made by one delegation, the SCT decided to place the words “to establish his identity, and” in square brackets for possible deletion at the next SCT meeting.

Paragraph (2).

63. One delegation asked whether the user of a sign on the Internet could be held liable for his use prior to notification. In response, the International Bureau explained that the user would be exempt from liability for any infringing use prior to notification, provided that he complied with the requirements set out in paragraph (1). He would continue to be exempt for any use after notification “if he expeditiously takes the measures” as described in paragraph (2).

64. In response to another question from that delegation, the International Bureau confirmed that the disclaimer set out in Section 10 was only one measure to avoid a conflict under Section 9, and that the parties to a dispute were free to agree on other measures which would be effective to avoid a commercial effect, and to avoid confusion with the owner of the conflicting right.

65. Two delegations questioned the need for measures to avoid confusion required under item (ii), stating that it was difficult to imagine confusion in cases where there was no commercial effect, and that it would be harsh to require two sets of measures in cases where it was sufficient to remove the commercial effect. The delegations proposed to delete item (ii). Other delegations objected and stated that items (i) and (ii) were intended to describe the objectives of measures, and that one measure, such as the disclaimer described in Section 10, could realize both objectives set out in Section 9(2). The SCT decided to clarify in the notes that paragraph (2) did not necessarily require two distinct measures.

66. One delegation proposed to replace the word “expeditiously” by a specific time period such as, for example, one month. This proposal received no support.

67. Following a suggestion of the International Bureau, and after some discussion, the SCT decided to reword paragraph (2) as follows:

(2) [*Use After Notification*] If the user referred to in paragraph (1) has received a notification that his use infringes an industrial property right in a mark or other sign protected under the law of another Member State (“conflicting right”) he shall not be held liable if he indicates to the holder of the conflicting right that he owns, or uses the sign with the consent of the owner of, an industrial property right in the sign in another Member State, gives relevant details of that right, and expeditiously takes measures which are effective

(i) to avoid a commercial effect in that Member State without unreasonably burdening his commercial activity, and

(ii) to avoid confusion with the owner of the conflicting right.

Paragraph (3).

68. One delegation noted that the provision did not specify the language of the notification and proposed to require that the notification be drafted in the language or the languages used on the web site. The delegation explained that this might on first sight seem burdensome for holders of conflicting rights, but that it was justified in view of the fact that the user of the sign would be required under paragraph (2) to act under time pressure and would, therefore, have to understand the notification. This was supported by another delegation and by the

representative of an observer organization. One delegation pointed out that a sign would not necessarily have to be used on a web site in order to be considered infringing, but that it could also appear in a different context, such as in an e-mail header. Following these interventions, the SCT decided to add, after the words “in writing”, the following phrase: “, in the language, or in one of the languages, used in conjunction with the use of the sign on the Internet”. In addition, the International Bureau indicated that it would investigate broader language to replace the words “web site” throughout the provisions.

69. One delegation proposed to include an item requiring that the user of the sign has in fact received the notification. The International Bureau stated that the requirements regarding notification were of a cross-cutting nature and had not yet been harmonized. While some countries required receipt for a notification to be effective, others regarded it as effective once it had been sent. The International Bureau therefore suggested, and the SCT agreed, to leave this question to the applicable law under which liability is determined.

70. Following a suggestion made by the representative of an observer organization, the SCT decided to add the words “or States” after the word “State” in item (iii), and to add the word “conflicting” before the word “right”.

71. One delegation expressed concern with regard to item (iv) because of its vagueness and proposed to require that the owner of the conflicting right specify the goods and services which are covered by his or her right. This was opposed by the representative of an observer organization who pointed out that the conflicting right could also be a registered trade name or other right that did not refer to particular goods or services. After some discussion, it was decided to redraft item (iv) as follows: “relevant details of such protection allowing the user to assess the existence, nature and scope of the right; and”.

72. As a consequence of the decision to merge previous Sections 6 and 7, Section 9 was renumbered as Section 8 (see Annex II). The SCT further decided to add the words “industrial property” before the word “right” throughout the provisions, where appropriate.

Section 10: Disclaimer

73. Two delegations proposed to expressly link Section 10 to Section 9(2). Another delegation held that it was necessary also to refer to the requirements set out in Section 9(1) in order to avoid the impression that users in bad faith could avail themselves of the disclaimer in order to avoid liability. After some discussion, it was decided to refer to both paragraphs by including the words “under Section 8(2)” after the word “disclaimer” and the words “referred to in Section 8(1)” after the word “user”.

74. One delegation proposed to clarify in the text of Section 10 that a mere statement could not shield users of signs on the Internet from liability for infringement, but that they were expected to take action. The International Bureau stated that items (iii) and (iv) determined what the user had to do in order to adhere to his stated intent. To clarify this, it suggested to insert the words “in fact” before the word “refuses” in item (iv). Another delegation proposed to improve the drafting of the provision by inverting the order of the subparagraphs (a) and (b), and by clearly drafting items (iii) and (iv) as conditions. Both proposals were accepted by the SCT.

75. One delegation proposed to add, in a new subparagraph (c), a reference to “gateway pages” as in Section 13. This was opposed by another delegation which pointed out that Section 13 dealt with remedies that could be imposed by a court, whereas Section 10 described the measures that the user of a sign on the Internet could take on its own initiative in the pre-trial stage in order to avoid liability; the establishment of gateway pages, however, had to be done with the consent of all parties, which might not be available at the pre-trial stage.

Subparagraph (a).

76. Since a sign can not only be used on a web site but also in other contexts such as in an e-mail header, it was decided to delete item (i), on the understanding that the disclaimer would have to be used “in conjunction with the use of the sign on the Internet” as provided in the chapeau of subparagraph (a). In response to a question from one delegation the International Bureau stated that the SCT had not yet decided where exactly the disclaimer had to be placed, whether it was sufficient to provide a link to a web page containing the statements, or whether the statement had to appear each time the sign in question was used. As currently worded, the provision would leave this decision to the competent authorities of Member States.

77. One delegation held that item (ii) imposed an unreasonable burden on Internet users by requiring a disclaimer not only in the language(s) of the web site, but also the language(s) of all countries disclaimed. This was supported by three other delegations who stated that if a commercial effect had been caused by using a particular language in conjunction with the sign, a disclaimer should be effective if it used the same language. As a result, it was decided to delete in the second part of the sentence, the words “, and in the language, or in the languages, used in the Member State or Member States disclaimed,”.

78. One delegation expressed concern with regard to the use of the word “address” in item (iii) noting that this word would also cover e-mail addresses which could not serve as an indication of territorial location. As a consequence, it was decided to refer to the territorial location of the customers instead of “address”, as was done in item (iv), but using the term “located” instead of “based”.

79. One delegation and the representative of an observer organization noted that customers might not indicate their territorial location correctly, in particular when the whole commercial relationship takes place over the Internet as in the case of delivery of digital goods. The International Bureau stated that, if payments were made via credit card, companies would require a billing address in most cases. In the remaining cases, it had to be decided whether to place the risk of fraudulent behavior on the user of the sign, or on the holder of the conflicting right. It was also pointed out that measures to avoid conflict should not unreasonably burden the commercial activity of the user of the sign.

Subparagraph (b).

80. No comments were made on this provision.

81. As a result of the discussions on Section 10(a) and (b), the SCT decided to redraft the Section as follows, subject to redrafting for clarity by the International Bureau:

“Member States shall accept, *inter alia*, a disclaimer under Section 8(2), by a user referred to in Section 8(1), as a measure to avoid a commercial effect in a Member State and to avoid confusion with the owner of a conflicting right, if the disclaimer includes a clear and unambiguous statement in conjunction with the use of the sign, written in the language or in the languages used in conjunction with the use of the sign on the Internet, to the effect that the user

- (i) has no relationship with the owner of the conflicting right, and
- (ii) does not intend to deliver the goods or services offered to customers located in a particular Member State, or in particular Member States,

provided that the user inquires, before the delivery of the goods or services, whether customers are located in that Member State or in one of those Member States, and in fact refuses delivery to customers who have indicated that they are located in that Member State or in one of those Member States.”

82. As a consequence of the decision to merge previous Sections 6 and 7, Section 10 was renumbered as Section 9 (see Annex II).

Note 10.05 Question (i)

83. Question (i) in Note 10.05 of document SCT/5/2 asked whether a user of a sign on the Internet should be able to avoid liability for infringement of a particular conflicting right by using the disclaimer described in Section 10, even without having been notified by the holder of that conflicting right. Two delegations and the representative of an observer organization were in favor of this possibility, while four delegations objected. The latter delegations stated that Section 10 should be clearly linked to the situation envisaged in Section 9(2). These delegations also pointed out that an extension of Section 10 was not necessary because someone who complied with all requirements set out in Section 10 would most probably not produce a commercial effect in a given country, and could therefore not be considered to have infringed rights protected in that country. It was agreed to clarify the latter point in the notes.

Note 10.05 Question (ii)

84. Question (ii) in Note 10.05 of document SCT/5/2 asked whether the possibility of avoiding liability for the infringement of a conflicting right should be made available to all good-faith users of a sign even if they did not own an industrial property right in that sign. This extension was supported by ten delegations who stated that, from the perspective of the conflicting right, it did not matter whether the user held a right in the sign in another country because the right was not recognized in that country. The real dividing line should, therefore, not be drawn between those who have an industrial property right in the sign used, and those who have not, but rather between good faith and bad faith users. It was also pointed out that good faith users might have other legitimate reasons for using the sign. For example, a right which, as a personal name, was not considered an industrial property right in its country of origin, or that the use was covered by an exception (recognized under Section 8) in the country of origin, or that they were using a sign which was considered generic in their country of origin. One delegation said that Section 4, which allowed users to acquire rights through use, would be much more difficult to apply if users were facing liability for the infringement

of conflicting rights in other countries. Another delegation stated that owners of conflicting rights would effectively enjoy a stronger position on the Internet than in the real world if good faith users of a sign could not avoid liability with the instruments outlined in Sections 9(2) and 10.

85. The extension was opposed by six delegations which stated that Sections 9(2) and 10 addressed the issue of coexistence of rights, i.e. the question as to how owners of rights in different countries could use their rights on the Internet without mutual liability. For this reason, Sections 9(2) and 10 accorded a privilege to owners of industrial property rights. Allowing every good faith user to avail itself of Sections 9(2) and 10 would destroy the structure of the draft provisions. The appropriate places to address good faith use was Section 3 on the one hand, and Section 13 on the other: if someone complied with all conditions set out in Sections 9(2) and 10, he would most probably not produce a commercial effect in particular country under Sections 2 and 3 and could therefore not be held liable for infringement of a conflicting right in that country according to Section 7. If, however, a good faith user infringed a conflicting right, courts would not issue a prohibition under Section 14, but would rather limit use under Section 13 which could include a disclaimer. The representative of an observer organization noted that the issue boiled down to the question as to who would have to bear the cost of infringement proceedings.

86. The International Bureau stated that nothing would prevent a Member State from extending the exemption under Sections 9 and 10 to any user in good faith. Two representatives of observer organizations suggested to clarify this by including a “may” provision. This was supported by four delegations which stated that such a provision would provide a chance to balance all legitimate interests. The suggestion was opposed by six delegations who questioned the need for a non-binding provision and proposed to include a clarification in the notes.

87. After some discussion, the SCT asked the International Bureau to extend the notes in order to further guide the discussions, and to include, in square brackets, the following new paragraph (4) in Section 8:

“[(4) A Member State may apply paragraphs (1) to (3) and Section 9, *mutatis mutandis*, in cases where the user of the sign does not own an industrial property right in that sign in any Member State.]”

88. It was further agreed that the International Bureau should prepare a second alternative, in square brackets, for discussion at the sixth session of the SCT.

Section 11: Bad Faith

Paragraph (1).

89. The SCT decided to include the words “industrial property” before the word “right”.

Paragraph (2)

90. One delegation proposed to clearly indicate the user of the sign at the relevant point in time under item (i), and to add another factor covering cases in which the user acquires a right

in a sign in order to raise entry barriers by preempting others from using the sign. This suggestion was not accepted by the SCT.

91. One delegation noted that knowledge is almost impossible to prove in legal proceedings. It proposed to add an indication that “reason to know” can be sufficient without, however, allowing this indication to be understood as including broad constructive notice provisions under certain national laws. Following a proposal made by another delegation the SCT decided to add the words “; or could not have reasonably been unaware,” after the word “knowledge”, subject to redrafting for clarity.

92. As a consequence of the decision to merge previous Sections 6 and 7, Section 11 was renumbered as Section 10 (see Annex II).

Section 12: Remedy Proportionate to Use in Member State

93. One delegation noted that the remedy should be proportionate to the commercial effect caused in a Member State and that the title would seem to obscure this. As a consequence, the SCT decided to replace the word “use in Member State” by “commercial effect”.

Paragraph (1).

94. No comments were made on this provision

Paragraph (2).

95. The representative of an observer organization expressed concern that paragraph (2) might invite a judge to consider factors beyond the commercial effect of an infringing use, and, as a consequence, to adopt a more wide-ranging remedy than justified by the commercial effect. He stated that paragraph (2) seemed to divert from the general principle according to which the remedy should be proportionate only to the commercial effect and suggested its deletion. This was supported by one delegation and the representative of another observer organization. One delegation said that, since Section 12 is not only limited to coexistence of rights, legitimate interests should also be taken into account in this provision. After some discussion, the SCT decided to delete the second sentence of paragraph (2) and to include its contents in the notes, and to delete the words. “If possible under the applicable law” as unnecessary.

Paragraph (3).

96. Several delegations were concerned that this provision might be read as allowing the defendant to adopt a different remedy on his own behalf after the decision of the competent authority, and proposed to clarify that the provision only applied to suggestions proffered by the user, and that the final decision, at the end of the infringement procedures, was entirely left to the competent authority. It was agreed that the provision was a mere application of the principle that defendants should have a right to be heard. After some discussion, the SCT decided to delete the words “equally” and “alternative”, to add the words “for consideration by the competent authority” at the end of paragraph (3), and to reflect the background more clearly in the notes.

97. Following an intervention by one delegation, the SCT decided to replace the word “defendant” by the words “user of the sign”.

98. As a consequence of the decisions to merge previous Sections 6 and 7, Section 12 was renumbered as Section 11. As a consequence of the creation of a new Part V (Coexistence of Rights), Part V (Remedies) was renumbered as Part VI (see Annex II).

Section 13: Limitations of Use of a Sign on the Internet

Paragraph (1).

99. No comments were made on this provision.

Paragraph (2).

100. The SCT decided to align the wording of paragraph (2)(a) and (b) with that of redrafted Section 10 paragraph (2) while retaining subparagraph (c). The Delegation of Finland objected to the deletion of the words “and in the language, or in the languages, used in the Member State or Member States disclaimed.” The delegation explained that Section 13 differed from Section 10 in that, under the former provision, the competent authority, not the user himself, had to determine the language of the disclaimer. The delegation pointed to national laws regulating the use of languages by official authorities and said that these might conflict with a restriction under Section 13(2). As a consequence, and following a suggestion made by the International Bureau, the SCT decided to replace the words “and in the language, or in the languages, used in the Member State or Member States disclaimed” by the words “, and any other language indicated by the competent authority.”

101. One delegation proposed to clarify the relationship between Section 10 and Section 13 in the notes. While Section 10 dealt with measures that the user in good faith, who also held a right in the sign, could adopt by himself in order to avoid liability, Section 13 addressed all cases in which a court had found an infringement and clarified the application of the principle of proportionality.

102. Following a suggestion made by the International Bureau, the SCT decided to delete the words “providing links to all owners of conflicting rights” from subparagraph (c), on the grounds that a court could decide only in relation to the parties of the procedure and not with regard to right owners who had not been involved in the procedure.

103. As a consequence of the decision to merge previous Sections 6 and 7, Section 13 was renumbered as Section 12 (see Annex II).

Section 14: Prohibition to Use a Sign on the Internet

104. Following an intervention from one delegation, the SCT decided to delete the word “demonstrable” in sub-paragraph (i) as unnecessary.

105. Two delegations stated that prohibitions to use a sign on the Internet would always be against the principle of proportionality and should completely be prohibited. In response, the International Bureau stated that a prohibition to use might be the only viable remedy in certain

cases, particular in cases of “bad faith”. The representative of an observer organization suggested to clarify the contents of the provision by restating, in a separate paragraph, that prohibitions to use a sign on the Internet should be avoided, before addressing the case in which such prohibitions are completely prohibited.

106. Two delegations and the representative of an observer organization proposed to delete the words “industrial property” before the word “right” in order to cover cases in which defendants held other types of rights to use the sign, such as personal names, and could, therefore, not avail themselves of the measures set out in Sections 9(2) and 10. They explained that an exception from the wide-ranging remedy of prohibition to use under Section 14 should be available more broadly than the exception from liability under Sections 9 and 10 which was limited to owners of industrial property rights. Another delegation proposed to protect any holder of a “legitimate interest” from prohibitions to use. This was supported by another delegation which said that use of a term that was in the public domain in one country should not subject its user to a global injunction. The representative of an observer organization cautioned against including the new and rather vague concept of “legitimate interest” in the provisions and pointed out that these cases could be addressed under the general principle of proportionality and new paragraph (1); the strict exception from liability should be limited to clear-cut cases.

107. Following a suggestion made by the International Bureau, the SCT decided to delete the words “as defined in Section 11” on the grounds that, even though Section 11 was applicable throughout the provisions anyway, the word “defined” might be understood too restrictively.

108. In response to a question by one delegation as to who determined bad faith, the International Bureau explained that the competent authority that determined the remedy in a given case would have to decide whether the user had acted in bad faith. However, the competent authority would have to make this determination in accordance with the private international law rules of its country. This meant that it had to apply the law of the country in which the right of the defendant had been acquired for determining whether the right had been acquired in bad faith. In order to determine that the sign had been used in bad faith, however, the competent authority could apply the law of the country in which the conflicting right was protected. It was decided to include an explanation of the relevant private international law rules in the Notes.

109. Following some discussion, the SCT decided to redraft Section 14 as follows:

“(1) Where the use of a sign on the Internet in a Member State infringes an industrial property right in a mark or other sign protected under the laws of that Member State, the competent authority of the Member State should avoid, wherever possible, imposing a remedy that would prohibit future use of the sign on the Internet.

(2) The competent authority shall not, in any case, impose a remedy that would prohibit future use of the sign on the Internet, where

(i) the user is the owner of a right in the sign under the law of another Member State, or is using the sign with the consent of the owner of such a right; and

(ii) the right has not been acquired, and the sign has not been used, in bad faith.”

110. As a consequence of the decision to merge previous Sections 6 and 7, Section 14 was renumbered as Section 13 (see Annex II).

Conclusion

111. The SCT decided that the International Bureau would refine the text of the draft provisions for its sixth session. If adopted at that session, the SCT may envisage to submit the provision for adoption as a Joint Recommendation by the WIPO Assemblies in September 2001.

International Nonproprietary Names for Pharmaceutical Substances

112. The representative of the World Health Organization (WHO) referred to the survey which WIPO had conducted among its Member States upon a request by the SCT, and which had revealed great interest by authorities competent for the registration of trademarks to receive, in an electronic format, updated information on International Nonproprietary Names for Pharmaceutical Substances (INNs). He informed the Committee that WHO was now offering an extranet service allowing access to the INN database established by WHO. The database could be accessed free of charge via the following address: <http://mednet.who.int>.

Agenda Item 5: Possible Solutions for Conflicts Between Trademarks and Geographical Indications and for Conflicts Between Homonymous Geographical Indications (see document SCT/5/3)

113. The Delegation of the European Communities, speaking on behalf of the European Communities and its Member States, expressed doubts as to whether it was appropriate to discuss, within the framework of the SCT, questions relating to the protection of geographical indications. Although the study presented in document SCT/5/3 was interesting, the Representative said that he would be opposed to work leading to the adoption of a recommendation in the area covered by the study. This was mainly because the European Communities and its Member States were in the process of developing legislation concerning the protection of geographical indications in the context of the Agreement on TRIPS. Having been adopted only six years ago, the TRIPS Agreement was still relatively new and, in many WTO Members, the process of adopting the relevant legislation to the standards defined by that Agreement was still ongoing. Raising legal issues relating to the TRIPS Agreement at a time when its implementation was not fully completed could lead to confusion in those WTO Members which still had to adopt their relevant legislation. There was no doubt that the work of the SCT in the field of geographical indications could be constructive, but this work should be undertaken at a later stage.

114. The Delegation of the United States of America stated that it considered geographical indications as an appropriate subject for the work of the SCT. It felt that the timing was exactly right to take up work on that issue in the SCT, that Committee being a leading group of intellectual property experts. The Delegation recalled that the Preamble to the TRIPS Agreement expressly recognized that intellectual property rights were private rights. As far as the implementation of the TRIPS Agreement by the Members of the WTO was concerned, it would be certainly helpful to provide guidance coming from a body of intellectual property

experts. The Delegation felt that, for this reason, the SCT should engage in discussing geographical indications.

115. The Delegation of Chile said that geographical indications were an important issue. However, before the SCT could discuss rules in that area, further study was needed. To that end, the Delegation requested that document SCT/5/3 be expanded to cover additional issues, such as, an analysis of the protection of trademarks and geographical indications from a historical perspective, the degree of acceptance of the concept of geographical indications, the different existing conceptual approaches concerning the recognition of geographical indications, or the question as to what degree of recognition could be required in order to resolve a conflict between a trademark and a geographical indication following the principle of priority or the principle of coexistence. It stated that concepts existing in trademark law were not universally applicable to geographical indications. The Delegation concluded by saying that a more detailed analysis concerning the exceptions to the protection for geographical indications in the TRIPS Agreement was required. Without additional information concerning the issues mentioned, the Delegation felt that it was premature to enter into a discussion of detailed rules and principles.

116. The Delegation of Kenya said that the protection of geographical indications was a matter of concern for the Government of its country. It informed the SCT that the Geographical Indications Bill 2000, which had been prepared with the assistance of WIPO, had been introduced into parliament.

117. The Delegation of Switzerland believed that continued discussion concerning geographical indications should take place within the framework of the SCT. For that reason, this item should stay on the agenda of the SCT.

118. The Representative of the International Vine and Wine Office (OIV) recalled the interest that his Organization had in the subject matter under discussion. This interest was manifested in a number of OIV Resolutions concerning geographical indications. He felt that the SCT was the proper forum for the discussion of geographical indications, and that it could define guidelines for further consideration. Referring to the cooperation agreement between OIV and WIPO, he reiterated the readiness of his Organization to assist with its technical knowledge in any future work that the SCT would undertake concerning that subject.

119. The Representative of the Confederation of European Spirit Producers (CEPS) said that that future work should build on existing principles. In particular, he felt that trademark concepts should be kept apart from concepts applying to geographical indications, and called for caution to avoid effecting what appeared to be the evolving law under the TRIPS Agreement.

120. The Delegation of the Islamic Republic of Iran said that, in its opinion, the SCT was the relevant forum for discussing geographical indications and that the timing to hold such discussion was right.

121. The Chair stated that there appeared to be a number of possibilities for discussing protection of geographical indications within the framework of the SCT. One possibility would be to expand the working document presented to the fifth session of the SCT and to include further issues for study at the sixth session. Another option would be to look at possible ways for harmonizing existing national systems of protection for geographical indications and to define maximum requirements, such as were already existing in the field of

trademarks under the Trademark Law Treaty (TLT). A third possibility would be to establish a framework document which would help parties owning rights to geographical indications in one system obtaining effective protection in other systems.

122. The representative of the International Trademark Association (INTA) said that his Organization was in full support of any effort by the SCT to establish rules that would lead to more transparency in the various systems for protection of geographical indications. Such rules should also help to overcome existing problems in establishing rights to geographical indications in various systems.

123. The representative of the International Association for the Protection of Intellectual Property (AIPPI) expressed support for the idea of harmonizing rules concerning the protection of geographical indications. However, he said that work of the SCT should be complementary to the work of the Council for TRIPS and any overlapping of efforts should be avoided.

124. The Delegation of Australia said that the SCT should be cautious in order to avoid interference with the ongoing work of the Council for TRIPS, but that it could support an expansion of document SCT/5/3.

125. The Delegation of Canada declared that work on geographical indications was within the mandate of the SCT, and that the Members of the SCT could gain from the discussion that took place in that forum. It therefore supported the continuation of work on geographical indications by the SCT.

126. The Delegation of Argentina said that it could agree on an expansion of the working document to cover the areas outlined already by other delegations.

127. The Delegation of the European Communities said that it was opposed to the broadening of the discussion of the issues contained in document SCT/5/3, but that it was not opposed to supplementing that document with a more detailed study of the historical aspects of geographical indications and their specific legal nature. However, this work should not interfere with Article 23.4 of the TRIPS Agreement.

128. The Delegation of the United States of America stated that it did not see any incompatibilities between the work of the SCT on geographical indications and Articles 23.4 and 24.2 of the TRIPS Agreement. In particular, the Delegation thought that it would be worthwhile to clarify issues such as the specific nature of geographical indications, and to address what it felt was a lack of transparency that was prevailing with regard to various national systems of protection. The SCT appeared to be best suited to take up that work and to give input into the work of the Council for TRIPS from an intellectual property perspective.

129. The Delegation of Mexico recalled that WIPO was the expert organization for intellectual property and that for that reason it had the competence to take up matters relating to the protection of geographical indications.

130. The Chair concluded that the Committee had reached agreement that, in order to create a better understanding of the legal issues related to the protection of geographical indications, the International Bureau should supplement document SCT/5/3 for discussion at the sixth session of the SCT. The supplement would deal with the following issues: the historical background of the protection of geographical indications; clarification of the nature of the rights in geographical indications; description of the different existing systems for the protection of geographical indications; and investigation of the problems existing in obtaining effective protection for geographical indications in other countries.

Agenda Item 6: Text of the Proposed Joint Recommendation Concerning Trademark Licenses (see document SCT/5/4)

131. The Chair reminded the SCT that the provisions concerning trademark licences, which were adopted by the SCT at its fourth session, would be submitted for adoption as a Joint Recommendation by the Paris and WIPO Assemblies in September 2000, pursuant to a decision taken by the SCT at the named session. She said that, although it would not be possible to make any change to the adopted provisions at this stage, the SCT had the opportunity to clarify certain points or ask questions to the International Bureau on the provisions before their adoption by the WIPO Assemblies.

132. The Delegation of the European Communities said that, although it was not entirely satisfied with Article 3, it announced the withdrawal of its reservation relating to that article.

133. The Delegation of the Russian Federation stated that the text in Russian submitted to the Assemblies (Document A/ 35/10) required various changes which it asked the International to take into account. The delegation said it would give a corrected version of the text in Russian to the Secretariat.

Agenda Item 7: Future Work

134. The SCT agreed that its sixth session would tentatively be held in March 2001, in Geneva, and would last five full days.

135. The SCT agreed that the agenda of the sixth session would consist of the following substantive items:

- Draft provisions on the protection of marks and other industrial property rights in relation to the use of signs on the Internet,
- Geographical indications.

136. With respect to possible issues to be taken up after completion of the above-mentioned items, the delegation of Australia suggested that the SCT also consider the nature of rights deriving from domain names, as well as the legal precedents of the Unified Dispute Resolution Procedure decisions.

137. The International Bureau enumerated a list of four projects which could be addressed by the SCT. First, revision of the Trademark Law Treaty to address, at least, the creation of an Assembly, the introduction of provisions on electronic filing, and the incorporation of the Joint Recommendation Concerning Trademark Licenses would be a possibility. Subject to the approval of the Member States, a Diplomatic Conference on the revision of the TLT could be envisaged during the next bienium, possibly in 2003. Second, the SCT could investigate the possibility of expanding the scope of the TLT to include substantive harmonization of trademark law. Third, the SCT could deal with substantive and procedural harmonization of industrial design law, following the momentum of the Geneva Act of the Hague Agreement concerning the International Deposit of Industrial Designs. Fourth, the SCT could investigate the practicality of establishing a principle of internationally or globally well-known marks.

138. The Delegation of Australia stated that the revision of the TLT, on the basis of the amendments suggested by the International Bureau, seemed the most important and should be given priority. As far as substantive harmonization of trademark law is concerned, he said that it would be very ambitious to envisage such an exercise to be concluded for the diplomatic conference in the next biennium and that the International Bureau should first identify the issues, if possible for the next meeting of the SCT.

139. The Delegation of the United States of America said that priority should be given to the revision of the TLT.

140. The SCT agreed that the International Bureau would prepare a paper concerning future work on the basis of the proposals made above, to be presented at the sixth session.

Agenda Item 8: Brief Summary by the Chair

141. The SCT adopted the Summary by the Chair (document SCT/5/5), incorporating a number of suggested amendments.

Agenda Item 9: Closing of the Session

142. Mr. Shozo Uemura, Deputy Director General, informed the SCT of the planned organisation by WIPO, in January, 2001, of a Forum on Private International Law and Intellectual Property.

143. The Chair closed the fifth session of the Standing Committee.

[Annex follows]

ANNEXE I/ANNEX I

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

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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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[Fin du Annex I/End of Annex I]

ANNEX II

DRAFT PROVISIONS ON THE
PROTECTION OF MARKS AND OTHER INDUSTRIAL PROPERTY RIGHTS IN
RELATION TO THE USE OF SIGNS ON THE INTERNET

Preamble

Recognizing that the present provisions are intended to facilitate the application of existing laws relating to industrial property rights in marks or other signs to the use of signs on the Internet;

Recognizing that Member States will apply, wherever possible, existing laws relating to industrial property rights in marks or other signs to the use of signs on the Internet, directly or by analogy;

Recognizing that a sign used on the Internet is simultaneously and immediately accessible irrespective of territorial location;

The present provisions are intended to be applied in the context of determining whether, under the applicable law of a Member State, use of a sign on the Internet has contributed to the establishment, maintenance or infringement of an industrial property right in a mark or other sign, or whether such use constitutes an act of unfair competition.

PART I
GENERAL

Section 1
Abbreviated Expressions

For the purposes of these Provisions, unless expressly stated otherwise:

- (i) “Member State” means a State member of the Paris Union for the Protection of Industrial Property, of the World Intellectual Property Organization, or of both;
- (ii) “Mark” means a mark relating to goods, to services or to both goods and services;
- (iii) “Sign” means a sign that distinguishes or that is capable of distinguishing, in a commercial context, one person from other persons, one undertaking from other undertakings, or the goods or services of one undertaking from those of other undertakings;
- (iv) “Competent authority” means an administrative, judicial or quasi-judicial authority of a Member State which is competent for determining whether an industrial property right in a mark or other sign has been established, maintained or infringed, for determining remedies, or for determining whether an act of competition constitutes an act of unfair competition, as the case may be;
- (v) “Internet” [reserved];
- (vi) “Remedies” means the remedies which a competent authority of a Member State can impose as a result of an action for the infringement of an industrial property right in a mark or other sign;
- (vii) “Act of unfair competition” means any act of competition contrary to honest business practices in industrial or commercial matters as defined in Article 10*bis* of the Paris Convention for the Protection of Industrial Property, signed in Paris on March 20, 1883, as revised and amended.

PART II
USE OF A SIGN ON THE INTERNET

Section 2
Use of a Sign on the Internet in a Member State

Use of a sign on the Internet shall constitute use of the sign in a Member State for the purposes of these provisions, only if the use has a commercial effect in that Member State as described in Section 3.

Section 3
Factors for Determining Commercial Effect in a Member State

(1) [*Factors*] In determining whether use of a sign on the Internet has a commercial effect in a Member State, the competent authority shall take into account all relevant circumstances. Circumstances that may be relevant include, but are not limited to:

(a) circumstances indicating that the user of the sign is doing, or has undertaken significant plans to do, business in the Member State in relation to goods or services which are identical or similar to those for which the sign is used on the Internet.

(b) the level and character of commercial activity of the user in relation to the Member State, including:

(i) whether the user is actually serving customers in the Member State or has entered into other commercially motivated relationships with persons in the Member State;

(ii) whether the web site contains a clear and unambiguous statement to the effect that the user does not intend to deliver the goods or services offered to customers located in a particular Member State, or in particular Member States, and whether the user has adhered to the stated intent;

(iii) whether the user offers post-sales activities in the Member State, such as warranty or service;

(iv) whether the user undertakes further commercial activities in the particular Member State which are related to the use of the sign on the Internet but which are not carried out over the Internet.

(c) the connection of the offer of goods or services with the Member State, including:

(i) whether the goods or services offered can be lawfully delivered in the Member State;

(ii) whether the prices are indicated in the official currency of the Member State.

(d) the connection of the web site on which or for which the sign is used with the Member State, including:

(i) whether the web site offers means of interactive contact which are accessible to Internet users in the Member State;

[Section 3(1)(d), continued]

(ii) whether the web site indicates an address, telephone number or other means of contact in the Member State, or is otherwise directed to customers in that Member State;

(iii) whether the web site is registered under the ISO Standard country code 3166 Top Level Domain referring to the Member State;

(iv) whether the text of the web site is in a language predominantly used in the Member State;

(v) whether the web site has actually been visited by Internet users located in the Member State.

(e) the relation of the use of the sign with an industrial property right, including:

(i) if the use is supported by an industrial property right, whether that right is protected in the Member State;

(ii) if the use is not supported by an industrial property right but motivated by the subject matter of an existing industrial property right that belongs to another, whether that right is protected under the laws of the Member State.

(2) [*Relevance of Factors*] The above factors, which are guidelines to assist the competent authority to determine whether the use of a sign has produced a commercial effect in a Member State, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in paragraph (1), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in paragraph (1), above.

PART III
ACQUISITION AND MAINTENANCE OF INDUSTRIAL PROPERTY RIGHTS IN
MARKS OR OTHER SIGNS

Section 4

Use of a Sign on the Internet and Acquisition and Maintenance of Rights

(1) Use of a sign on the Internet in a Member State shall be taken into consideration for determining whether any criteria relating to use under the applicable law of the Member State for acquiring or maintaining industrial property rights in marks or other signs have been met.

(2) Forms of use that are made possible by technological advances shall be taken into consideration under paragraph (1) if they contribute to fulfilling the requirements under the applicable law of the Member State for acquiring or maintaining industrial property rights in marks or other signs.

PART IV
INFRINGEMENT AND LIABILITY

Section 5

Use of a Sign on the Internet, Infringement of Rights and Acts of Unfair Competition

(1) Use of a sign on the Internet shall be taken into consideration for determining whether industrial property rights under the applicable law of a Member State have been infringed, or whether the use amounts to an act of unfair competition under the law of that Member State, only if that use constitutes use of the sign on the Internet in that Member State under these provisions.

(2) Forms of use that are made possible by technological advances shall be taken into consideration under paragraph (1) if they contribute to fulfilling the requirements under the applicable law of the Member State concerning the industrial property right in question.

Section 6
Liability for Infringement Under the Applicable Law

Except in the cases provided for in Sections 7 and 8 below, there shall be liability in a Member State, under the applicable law, for the infringement of an industrial property right in a mark or other sign through use of a sign on the Internet in that Member State.

Section 7
Exceptions and Limitations Under the Applicable Law

A Member State shall apply exceptions to liability, or limitations to the scope of industrial property rights in marks or other signs, existing under the applicable law to use of a sign on the Internet in that Member State.

PART V
COEXISTENCE OF RIGHTS

Section 8
Use Supported by an Industrial Property Right

(1) [*Use Prior to Notification*] If the use of a sign on the Internet in a Member State infringes an industrial property right in a mark or other sign in that Member State in accordance with Section 5, the user of that sign shall not be held liable for such infringement prior to receiving a notification that his use infringes an industrial property right in a mark or other sign protected under the law of another State if

- (i) he owns, or uses the sign with the consent of the owner of, an industrial property right in the sign in another Member State;
- (ii) he has not acquired the right or used the sign in bad faith; and
- (iii) he has provided, on the web site on which or for which the sign is used, information reasonably sufficient [to establish his identity, and] to contact him by mail, e-mail or telefacsimile.

(2) [*Use After Notification*] If the user referred to in paragraph (1) has received a notification that his use infringes an industrial property right in a mark or other sign protected under the law of another Member State (“conflicting right”) he shall not be held liable if he indicates to the holder of the conflicting right that he owns, or uses the sign with the consent of the owner of, an industrial property right in the sign in another Member State, gives relevant details of that right, and expeditiously takes measures which are effective

- (i) to avoid a commercial effect in that Member State without unreasonably burdening his commercial activity, and
- (ii) to avoid confusion with the owner of the conflicting right.

(3) [*Notification*] The notification shall be effective under paragraphs (1) and (2) if it indicates in writing in the language, or the languages, used in conjunction with the use of the sign on the Internet:

- (i) the right which is claimed to have been infringed by the use of the sign on the Internet;
- (ii) the owner of the right and information reasonably sufficient to contact him by mail, electronic mail or telefacsimile;
- (iii) the State or States in which the right is protected;
- (iv) relevant details of such protection allowing the user to assess the existence, nature and scope of the right; and
- (v) the use that is claimed to infringe the right.

[Section 8, continued]

ALTERNATIVE 1:

[(4) A Member State may apply paragraphs (1) to (3) and Section 9, *mutatis mutandis*, in cases where the user of the sign does not own an industrial property right in that sign in any Member State.]

ALTERNATIVE 2:

[Reserved]

Section 9
Disclaimer

Member States shall accept, *inter alia*, a disclaimer under Section 8(2), by a user referred to in Section 8(1), as a measure to avoid a commercial effect in a Member State and to avoid confusion with the owner of a conflicting right, if the disclaimer includes a clear and unambiguous statement in conjunction with the use of the sign, written in the language or in the languages used in conjunction with the use of the sign on the Internet, to the effect that the user

(i) has no relationship with the owner of the conflicting right, and

(ii) does not intend to deliver the goods or services offered to customers located in a particular Member State, or in particular Member States,

provided that the user inquires, before the delivery of the goods or services, whether customers are located in that Member State or in one of those Member States, and in fact refuses delivery to customers who have indicated that they are located in that Member State or in one of those Member States.

Section 10
Bad Faith

(1) [*Bad Faith*] In determining whether a sign was used, or whether an industrial property right was acquired or used, in bad faith for the purposes of applying these provisions, any relevant circumstance shall be considered.

(2) [*Factors*] In particular, the competent authority shall take into consideration, *inter alia*:

(i) whether the person who used the sign, or acquired or used the right in the sign, had, at the time when the sign was first used or registered, or an application for its registration was filed, knowledge, or could not have reasonably been unaware, of the other right; and

(ii) whether the use of the sign would take unfair advantage of or unjustifiably impair the distinctive character or the reputation of the conflicting right.

PART VI
Remedies

Section 11
Remedy Proportionate to Commercial Effect

- (1) The remedies provided for the infringement of industrial property rights in marks or other signs in a Member State, through use of a sign on the Internet in that Member State, shall be proportionate to the commercial effect of the use in that Member State.
- (2) The competent authority shall balance the interests, rights and circumstances involved.
- (3) The user of the sign shall be given the opportunity to propose an effective remedy for consideration by the competent authority.

Section 12
Limitations of Use of a Sign on the Internet

(1) In determining remedies, the competent authority shall consider limitations of use by imposing measures designed:

(i) to avoid a commercial effect in the Member State without unreasonably burdening the user's commercial activity, and

(ii) to avoid confusion with the owner of the conflicting right.

(2) The measures referred to in paragraph (1) may include, *inter alia*:

(a) a clear and unambiguous statement in conjunction with the use of the sign on the Internet, to the effect that the user has no relationship with the owner of the conflicting right, written in the language or in the languages used in conjunction with the use of the sign on the Internet;

[Section 12(2), continued]

(b) a clear and unambiguous statement in conjunction with the use of the sign on the Internet, in the language or in the languages used in conjunction with the use of the sign on the Internet, and any other language indicated by the competent authority, to the effect that the user does not intend to deliver the goods or services offered to customers located in a particular Member State, or in particular Member States, provided that the user inquires, before the delivery of the goods or services, whether customers are located in that Member State or in one of those Member States, and in fact refuses delivery to customers who have indicated that they are located in that Member State or in one of those Member States;

(c) gateway web pages.

Section 13
Prohibition to Use a Sign on the Internet

(1) Where the use of a sign on the Internet in a Member State infringes an industrial property right in a mark or other sign protected under the laws of that Member State, the competent authority of the Member State should avoid, wherever possible, imposing a remedy that would prohibit future use of the sign on the Internet .

(2) The competent authority shall not, in any case, impose a remedy that would prohibit future use of the sign on the Internet, where

(i) the user is the owner of a right in the sign under the law of another Member State, or is using the sign with the consent of the owner of such a right; and

(ii) the right has not been acquired, and the sign has not been used, in bad faith.

[End of Annex II and of document]