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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

STANDING COMMITTEE ON THE LAW OF TRADE MARKS, INDUSTRIAL DESIGN AND GEOGRAPHICAL INDICATIONS

Ninth Session
Geneva, November 11 to 15, 2002

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. The Chair opened the meeting and Mr. Shozo Uemura, Deputy Director General, welcomed the delegates on behalf of the Director General.

Agenda Item 2: Adoption of the Draft Agenda

2. The SCT adopted the Draft Agenda (document SCT/9/1 Rev.2) with modifications relating to the order of discussion of the issues on Domain Names.

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

3. The SCT adopted the Draft Report (document SCT/8/7 Prov.2) with some minor modifications.

Agenda Item 4: Geographical Indications

4. The SCT decided to request the International Bureau to prepare a study setting out the issues generally considered with regard to the protection of geographical indications, taking into account the elements contained in the definition of the TRIPS Agreement, in particular, the elements supporting a claim for quality, reputation or other characteristics, and what is

considered in evaluating a claim that these elements are “essentially attributable” to the geographical origin. The list of factors would be illustrative and not exhaustive and the purpose of the study itself would be to provide members with a general overview of issues considered by different systems of protection. In no case should this exercise be used to appreciate whether a particular system is in conformity with the TRIPS Agreement, nor would it provide a vehicle for examining whether a given geographical indication complies with the definition of Article 22.1 of the TRIPS Agreement. The study would only constitute a basis for discussion, and it would promote a better understanding of the definition in a more concrete way and provide information, especially for those members in the process of establishing their own systems. As such, it would not be an attempt to harmonize law on geographical indications, and it would not be an exercise in norm-setting or lead to a negotiation. It would simply constitute the basis for an exchange of information in a general manner without analyzing specific cases.

Internet Domain Names and Geographical Indications

5. The SCT decided to continue discussions on this issue and requested the International Bureau to prepare papers summarizing the state of the positions, drawing together work already done by the International Bureau and including the comments made by several delegations at the SCT.

Internet Domain Names and Country Names

The Chair concluded that:

6. Recalling the decision reached by the General Assembly at its meeting in September 2002, the majority of delegations favored amending the Uniform Domain Name Dispute Resolution Policy (UDRP) to provide protection for country names in the DNS.

7. As regards the details of such protection, * the delegations supported the following:

(i) protection should be extended to the long and short names of countries, as provided by the United Nations Terminology Bulletin;

(ii) the protection should be operative against the registration or use of a domain name which is identical or misleadingly similar to a country name, where the domain name holder has no right or legitimate interest in the name and the domain name is of a nature that is likely to mislead users into believing that there is an association between the domain name holder and the constitutional authorities of the country in question;

(iii) each country name should be protected in the official language(s) of the country concerned and in the six official languages of the United Nations; and

(iv) the protection should be extended to all future registrations of domain names in generic top-level domains (gTLDs).

* See WIPO Document (“Internet Domain Names”), WO/GA/28/3 (June 24, 2002).

8. The delegations supported continued discussion on:

(i) extension of protection to the names by which countries are familiarly or commonly known, and agreed that any additional such names be notified to the Secretariat before December 31, 2002;

(ii) retrospective application of the protection to existing registrations of domain names, and in which alleged rights may have been acquired; and

(iii) the question of sovereign immunity of States before the courts of other countries in relation to proceedings relating to protection of country names in the DNS.

9. The delegations requested the Secretariat to transmit the said recommendation to the Internet Corporation for Assigned Names and Numbers (ICANN).

10. The Delegations of Australia, Canada and the United States of America dissociated themselves from this decision.

11. The Delegation of Japan stated that, while it did not oppose the decision to extend protection to country names in the DNS, further discussion was required concerning the legal basis for such protection, and stated its reservation to paragraph 7 herein, except for subparagraph (iv).

Trademarks

Proposals for further harmonization of formalities and procedures in the field of marks

12. The SCT decided that the International Bureau should revise document SCT/9/2 according to the comments made by the SCT members at the ninth session on Article 8 and Article 13 *bis*, 13 *ter* and 13 *quater* and related rules.

Further development of international trademark law and convergence of trademark practices

13. The SCT decided that the International Bureau should circulate the questionnaire contained in document SCT/9/3 on the SCT Electronic Forum, inviting for comments by the end of January 2003. On the basis of these comments, the International Bureau shall finalize the questionnaire and circulate it for reply.

Industrial Designs

The Committee welcomed discussion on industrial designs at the SCT and expressed the wish to continue such discussion at future meetings.

Agenda Item 5: Future Work

14. The SCT discussed the need to establish priorities for its future work and decided that first priority should be given to work on trademarks, specifically the revision of the TLT, as well as the continuation of the discussions on the questionnaire on substantive trademark law.

Second priority would be given to work on geographical indications. The SCT further agreed that its tenth session would last five full working days and that the agenda of that session would devote three full days to trademarks, half a day to geographical indications in general, and half a day to geographical indications and domain names, leaving one day flexible for other issues including the adoption of the draft report of the previous session and preparation and adoption of the summary by the Chair. The tenth session of the SCT would tentatively be scheduled for April 28 to May 2, 2003, in Geneva.

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