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

Twenty-Sixth Session
Geneva, October 24 to 28, 2011, and February 1 to 3, 2012

DRAFT SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. The session was opened by Mr. Imre Gonda (Vice-Chair) who, in the absence of Mr. Seong-Joon Park (elected Chair of the twenty-fifth and twenty-sixth sessions of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), acted as Chair of the twenty-sixth session of the SCT.

2. Mr. Marcus Höpperger (WIPO) acted as Secretary to the SCT.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

3. The SCT adopted the draft Agenda (document SCT/26/1 Prov.) on the understanding that the sequence of the working documents under Agenda item 4 would be inverted so as to allow a debate on document SCT/26/4 during the morning of the first day of the meeting, to be continued, if necessary, after the consideration of documents SCT/26/2 and 3.

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE TWENTY-FIFTH SESSION

4. The SCT adopted the draft report of the twenty-fifth session (document SCT/25/7 Prov.) with amendments requested by the Delegations of Sudan and Switzerland and by the Representative of CEIPI.

AGENDA ITEM 4: INDUSTRIAL DESIGNS

Industrial Design Law and Practice - Draft Articles and Draft Regulations

5. Discussion was based on documents SCT/26/2 and 3.

6. The Chair stated that the Secretariat would note all interventions in the report of the twenty-sixth session. Moreover, the Secretariat was requested to prepare revised working documents for consideration of the SCT at its twenty-seventh session, which should reflect all comments made at the present session and highlight the different proposals put forward by delegations by using square brackets, strikethrough, underlining or footnotes, as appropriate.

7. In respect of each draft Article and Rule, the Chair concluded as follows:

Article 1
Abbreviated Expressions
and
Rule 1
Abbreviated Expressions

8. The Chair noted that there were proposals for amending items (v) and (xii) and for the addition of a statement that time limits expressed in months could be calculated by Parties in accordance with their national law.

Article 2
Applications and Industrial Designs to Which These Articles Apply

9. The Chair noted that Note 2.03 should be deleted.

Article 3
Application

10. The Chair noted a proposal to align the wording of the French and Spanish versions of paragraph (1)(v) with the English text.

Rule 2
Details Concerning the Application

Paragraph (1)

11. The Chair noted proposals to transfer items (i), (iii), (iv), (vi), (viii) and (ix) from Rule 2 to Article 3, to add an indication of the nature of the legal entity where the applicant is a legal entity, and to align the wording of item (ii) with item (i).

Paragraph (2)

12. The Chair noted that there were no comments on the draft of this provision.

Rule 3
Details Concerning Representation of the Industrial Design

13. The Chair noted that there was a proposal to redraft paragraphs 2(a) and 3(a) and (b).

Article 4
Representatives; Address for Service or Address for Correspondence

14. The Chair noted that there was a proposal concerning paragraph 2(b), in respect of which two different options would be presented as alternatives in the next draft.

Rule 4
Details Concerning Representatives, Address for Service or Address for Correspondence

15. The Chair noted that two different options concerning the time limit in paragraph (1)(d) would be presented as alternatives in the next draft.

Article 5
Filing Date

Paragraph (1)

16. The Chair noted proposals to add to this paragraph a claim, a description, an indication of the product and an indication of the identity of the creator to the list of filing date requirements.

Paragraphs (2) and (3)

17. The Chair noted that there were no comments on the draft of this provision.

Paragraph (4)

18. The Chair noted that there was a proposal by one delegation to replace the words "prescribed in the Regulations" by "within a reasonable time limit", and to omit Rule 5.

Paragraph (5)

19. The Chair noted a proposal to amend the wording of this provision to the effect that the filing date should be no later than the date on which all required elements were received by the Office.

Rule 5
Details Concerning the Filing Date

20. There was no discussion on this provision.

Article 6
Grace Period for Filing in Case of Disclosure

21. The Chair concluded that there was agreement on the principle of providing for a grace period in case of disclosure. He noted that a number of delegations expressed their preference for a period of six months, whereas other delegations and user representatives preferred a period of 12 months. The Chair further noted that a period of at least six months provided for a flexible approach to this issue. Moreover, he noted that there were different views as to the circumstances that would trigger the application of a grace period, as well as on its starting point.

Article 7
Requirement to File the Application in the Name of the Creator

22. The Chair noted that there were no comments on the draft of this provision.

Article 8
Division of Application

Paragraph (1)

23. The Chair noted that there was agreement on the principle of providing for the division of an application, and that the wording of that paragraph would be clarified in accordance with the comments made.

Paragraph (2)

24. The Chair noted a proposal for replacing the words "if any" by the words "if applicable".

Paragraph (3)

25. The Chair noted that two Delegations reserved their position with regard to this draft provision.

Article 9
Publication of the Industrial Design
and
Rule 6
Details Concerning Publication

26. The Chair noted that the views of the Committee were divided between making this provision mandatory or optional. He also noted a drafting proposal for the omission of the term "request by the applicant". Furthermore, he noted unanimous support for this provision by all user representatives. He concluded that the next draft of the provision should reflect those positions.

Article 10
Communications

Paragraphs (1) to (3)

27. The Chair noted a comment by one delegation concerning paragraph 2(b) regarding the presentation of translations.

Paragraph (4)

28. The Chair noted a reservation by one delegation.

Paragraphs (5) to (7)

29. The Chair noted that there were no comments on the draft of this provision.

Rule 7
Details Concerning Communications

30. The Chair noted proposals to amend paragraph (5) and to add details corresponding to Rule 10(1) of the Patent Law Treaty (PLT). He noted the reservation by one delegation concerning paragraph (5). He also noted agreement to delete paragraph (10)(b).

Rule 8
Identification of an Application Without its Application Number

31. The Chair noted that there were no comments on the draft of this provision.

Article 11
Renewal
and
Rule 9
Details Concerning Renewal

32. The Chair noted a proposal to introduce the possibility of requesting the renewal of several registrations belonging to the same holder in one request.

Article 12
Relief in Respect of Time Limits

33. The Chair noted a proposal by one delegation to make paragraph (2) optional.

Rule 10
Details Concerning Relief in Respect of Time Limits

34. The Chair noted a proposal of one delegation to replace, in paragraph (2), the time limit of two months by one month.

Article 13
Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality

35. The Chair concluded that the next draft of this provision should present an optional and a mandatory alternative.

Rule 11
Details Concerning Reinstatement of Rights After a Finding by the Office of Due Care or Unintentionality

36. The Chair noted a proposal by one delegation to replace, in paragraph (2), the time limit of one month by two months.

Article 14
Request for Recording of a License or a Security Interest
Article 15
Request for Amendment or Cancellation of the Recording of a License or a Security Interest
and
Rule 12
Details Concerning the Requirements Concerning the Request for Recording of a License or a Security Interest or for Amendment or Cancellation of the Recording of a License or a Security Interest

37. The Chair noted the reservations of two delegations as well as a number of additional comments.

Article 16
Effects of the Non-Recording of a License
and
Article 17
Indication of the License

38. The Chair noted the reservation of one delegation.

Article 18
Request for Recording of a Change in Ownership
and
Rule 13
Details Concerning the Request for Recording of a Change in Ownership

39. The Chair noted a comment by one delegation concerning Rule 13(2).

Article 19
Changes in Names or Addresses
and
Rule 14
Details Concerning the Request for Recording of a Change in Name or Address

40. The Chair noted the comment of one delegation concerning the last sentence of Article 19(4). He also noted the request of one delegation to introduce a note accompanying Article 19 along the lines of Note 18.04 in document SCT/26/2.

Article 20
Correction of a Mistake
and
Rule 15
Details Concerning the Correction of a Mistake

41. The Chair noted that there were no comments on the draft of these provisions.

Article 21
Regulations

42. The Chair noted that there were no comments on the draft of these provisions.

Information on the Work of the SCT on Industrial Design Law and Practice in Relation to the WIPO Development Agenda Recommendations

43. Discussion was based on document SCT/26/4.

44. The Chair noted that a number of delegations considered that, while the document contained useful information, a study by the Secretariat with the involvement of the Chief Economist, on the impact of the draft Articles and draft Rules on developing countries was required. Other delegations declared that they would not oppose such study, provided that its scope was precisely defined and that it did not delay the work of the SCT. After informal discussions, the SCT agreed to request the Secretariat to prepare an analytical study, in accordance with the terms of reference contained in Annex II.

AGENDA ITEM 5: TRADEMARKS

Information Meeting on the Role and Responsibility of Internet Intermediaries in the Field of Trademarks

45. Discussion was based on document SCT/26/5 and on a non-paper prepared by the Chair.

46. The Chair concluded that the SCT agreed to the modalities of the information meeting contained in the non-paper prepared by the Chair and reproduced in Annex I of this document.

Update on Trademark-Related Aspects of the Expansion of the Domain Name System

47. Discussion was based on document SCT/26/6.

48. The Chair noted that the SCT emphasized the need for the envisaged trademark rights protection mechanisms in ICANN's New gTLD Program to be effective, and expressed concern about ICANN processes which risk destabilizing the WIPO-initiated UDRP as an existing, globally relied-upon mechanism. He also noted that the SCT requested the Secretariat to keep Member States informed on developments in the new Domain Name System.

Draft Reference Document on the Protection of Names of States Against Registration and Use as Trademarks

49. Discussion was based on document SCT/25/4. It was also based on a proposal submitted by the Delegations of Barbados and Jamaica and on a further proposal by the Delegation of Jamaica concerning specific terms of reference for the first phase of the former proposal.

50. The Chair concluded that a number of delegations had expressed support for the proposal of the Delegations of Barbados and Jamaica. Other delegations expressed the need for more information and time for reflection. The SCT requested all members to communicate to the Secretariat cases and case studies relevant to the protection of names of States, as well as information on any nation branding scheme in which they have engaged, including problems encountered in their implementation. Such communications should reach the Secretariat by March 15, 2012. The Secretariat was requested to compile those communications in the form of a working document to be presented at the next session of the SCT. This working document should also provide information on nation branding available at WIPO.

Information on Electronic Communications in the Article 6ter Express Database

51. The Chair concluded that the SCT took note of the contents of document SCT/26/7.

AGENDA ITEM 6: GEOGRAPHICAL INDICATIONS

52. The Chair noted that no intervention was made under that Agenda item.

AGENDA ITEM 7: ADOPTION OF THE SUMMARY BY THE CHAIR

[53. The SCT approved the Summary by the Chair as contained in the present document.]

AGENDA ITEM 8: CLOSING OF THE SESSION

54. The Chair closed the session on February 3, 2012.

[Annexes follow]

NON-PAPER BY THE CHAIR OF SCT/26 ON THE INFORMATION MEETING ON THE ROLE AND RESPONSIBILITY OF INTERNET INTERMEDIARIES IN THE FIELD OF TRADEMARKS

I. INTRODUCTORY NOTES

At its 26th session, the SCT discussed document SCT/26/5 (Information Meeting on the Role and Responsibility of Internet Intermediaries in the Field of Trademarks). In addition to the three suggestions presented in the document (by the Delegations of the US, the Russian Federation and Denmark), several comments and suggestions were made by delegations with regard to the modalities for such a meeting. In order to conduct the discussion of the SCT in a time saving manner and to avoid addressing questions of micromanagement in the plenary session, the Chair announced to hold informal consultations on the basis of a non-paper which will reflect the basic ideas and principles from the proposals and comments made by Member States.

II. PURPOSE OF THE NON-PAPER

The aim of the non-paper is to summarize the proposals made by delegations and to provide a draft proposal for establishing modalities to guide the Secretariat in convening the information meeting.

The basic purpose of the information meeting is to provide information on the role and responsibility of Internet intermediaries in relation to the use of trademarks on the Internet. Due to its informal nature, the meeting is not intended to constitute a forum for examining the issue, preparing proposals or making recommendations, decisions of any kind. The information meeting will not form part of a formal session of the SCT.

III. TIMEFRAME

Taking into account the proposals made for the timeframe of the information meeting and also bearing in mind that Member States expressed their flexibility in this respect, the duration of one day for the meeting to be held immediately prior to SCT/27 seems to be an effective compromise and would be suitable for meeting the different expectations.

IV. SPEAKERS

A large number of comments have been made underlining the importance of the choice of speakers. Despite the different views expressed, some common principles have been addressed in the comments. A balanced representation of geographical regions, business areas and interests was a broadly accepted principle as it is an important requirement for providing the proper presentation of different points of view.

With regard to the categories of stakeholders that would be invited to participate in the meeting, Internet intermediaries, trademark owners, trademark professionals, academia, civil society and government authorities should be represented.

V. PROGRAM

The program for the information meeting should remain within the scope of work of the SCT and should mainly focus on issues of use of trademarks on the Internet. The program should also take into account the relevant WIPO Development Agenda Recommendations and could cover similar initiatives in other fora. The Secretariat is requested to organize a briefing on the program prior to the information meeting. Along the lines of the proposals and comments made by Member States, the program should cover:

- the point of view of brand owners regarding the role and responsibility of Internet intermediaries in the field of trademarks;
- the position of Internet intermediaries and online service providers concerning the role and responsibility of Internet intermediaries in the field of trademarks;
- the point of view of academia;
- the views of users;
- national and regional experiences, including experience with alternative dispute resolution and public-private-partnerships (PPP).

[Annex II follows]

TERMS OF REFERENCE FOR A STUDY BY THE WIPO SECRETARIAT ON THE POTENTIAL IMPACT OF THE WORK OF THE SCT ON INDUSTRIAL DESIGN LAW AND PRACTICE

In the context of the SCT's work on Industrial Design Law and Practice (documents SCT/26/2 and 26/3) and the commitment of WIPO Member States to the Development Agenda Recommendations, in particular Cluster B relating to Norm-Setting, the Secretariat with the involvement of the Chief Economist is requested to prepare an analytical study on:

1. The potential benefits, constraints and costs for SCT members, particularly Developing Countries, Least Developed Countries (LDCs) and Countries in Transition, of the application of the draft Articles and draft Rules on Industrial Design Law and Practice (documents SCT/26/2 and 3), with regard to:

- applicants (natural and legal persons, particularly SMEs);
- national and regional Offices' administrative capacity and legal expertise;
- national and regional jurisdictions, as concerns the implementation of legislative changes to their design system;
- Developing Countries and LDCs' needs for capacity building, investment in infrastructure and technical assistance.

2. The impact, if any, of the draft Articles and draft Rules on Industrial Design Law and Practice (documents SCT/26/2 and 3) on:

- the access to design systems for SMEs;
- fostering creativity, innovation and economic development and efficiency in Developing Countries;
- technology transfer and access to knowledge.

3. Flexibilities for SCT members in the draft Articles and draft Rules on Industrial Design Law and Practice (documents SCT/26/2 and 3), deepening the analysis contained in the relevant portions of document SCT/26/4, and examining special provisions for developing countries and LDCs.

STATISTICAL INFORMATION/ANALYSIS

The study will offer statistical information, within the scope of available data, about the designs system, with particular reference to access by SMEs from developing countries, and should include three levels of detailed information, in order to provide factual information on the current trends relating to protection of industrial designs.

- Level 1: general observed trends in protection of industrial designs;
- Level 2: statistical analysis on the demand for protection of industrial designs;
- Level 3: statistical analysis on the origin, destination and class of protection of industrial designs.

The study should reflect recent periods of data display.

TIME FRAME

The study should aim to be published two months prior to the next session of the SCT, with a view to helping informed discussions on the work of the SCT on industrial designs.

[End of Annex II and of document]