

SCT/38/5/PROV.
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Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

Thirty-Eighth Session
Geneva, October 30 to November 2, 2017

DRAFT SUMMARY BY THE CHAIR

AGENDA ITEM 1: OPENING OF THE SESSION

1. Mr. Francis Gurry, Director General of the World Intellectual Property Organization (WIPO), opened the thirty-eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) and welcomed the participants.
2. Mr. David Muls (WIPO) acted as Secretary to the SCT.

AGENDA ITEM 2: ADOPTION OF THE AGENDA

3. The SCT adopted the draft Agenda (document SCT/38/1 Prov.).

AGENDA ITEM 3: ADOPTION OF THE DRAFT REPORT OF THE THIRTY-SEVENTH SESSION

4. The SCT adopted the draft Report of the thirty-seventh session (document SCT/37/9 Prov.).

AGENDA ITEM 4: INDUSTRIAL DESIGNS

Industrial Design Law and Practice-Draft Articles and Draft Regulations

5. The Chair recalled that “the [2017] WIPO General Assembly decided that, at its next session in 2018, it will continue considering the convening of a diplomatic conference on the Design Law Treaty (DLT), to take place at the end of the first half of 2019”.

6. The Chair concluded that, while the DLT would remain on its agenda, the SCT should abide by the decision of the General Assembly.

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

7. The Chair noted the SCT’s satisfaction with the Information Session on Graphical User Interface (GUI), Icon and Typeface/Type Font Designs and its desire to continue its discussions of the topic.

8. As next steps, the Chair requested the Secretariat to:

- prepare a document summarizing the main points emerging from the Information Session, with all presentations made at the Information Session to be included as an Annex;
- invite Member States and accredited NGOs to propose aspects of Graphical User Interface (GUI), icon and typeface/type font designs on which further work would be desirable, and compile all such proposals in a document, for consideration by the SCT at its next session;
- include on this agenda item, for the next session of the SCT, a presentation, by the Delegation of France, of the European Union “Convergence Programme 6: Graphical Representation of Designs”.

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

9. The SCT noted the progress in the implementation of the DAS for industrial designs by several delegations, as well as indications by other delegations that they are actively considering implementation in the near future.

10. While continuing to encourage a wider use of the DAS by Member States for both industrial designs and trademarks, the Chair concluded that the SCT would continue to take stock of the progress made in this regard at its future sessions.

AGENDA ITEM 5: TRADEMARKS

Protection of Country Names Against Registration and Use as Trademarks

11. The SCT considered documents SCT/32/2, SCT/37/3 Rev. and SCT/38/2.

12. Following an exchange of views, the Chair requested the Secretariat to organize a half-day information session in the form of a moderated roundtable at SCT/39, addressing the examination by offices of trademarks consisting of, or containing, country names and taking into account the perspectives of users, under the following structure: (i) Introduction; (ii) Specific legislation; (iii) Public domain *versus* distinctiveness; (iv) Word

mark *versus* composite mark; (v) Perception of relevant consumer/secondary meaning/what is considered a country name; (vi) Disclaimers/Limitations of goods and services/Exceptions/Other practices; and (vii) Concluding remarks.

13. Certain delegations stated that possible Areas of Convergence Nos. 3 and 4 should also be included in the analysis of document SCT/38/2 at the current stage, while others requested that the document remain unchanged.

14. Document SCT/37/3 Rev. remains open for further submissions and other contributions by delegations.

Update on Trademark-Related Aspects of the Domain Name System

15. The SCT considered document SCT/38/3 and requested the Secretariat to keep Member States informed of future developments in the DNS.

AGENDA ITEM 6: GEOGRAPHICAL INDICATIONS

16. The SCT adopted its workplan on geographical indications, as reflected in the Annex.

AGENDA ITEM 8: CLOSING OF THE SESSION

17. The Chair closed the session on November 2, 2017.

[Annex follows]

SCT Workplan on Geographical Indications

November 1, 2017

The Information Session, which took place on March 28, 2017, provided useful information on (i) the features, experiences and practices of the different national and regional geographical indication protection systems, and (ii) the protection of geographical indications on the Internet, and geographical indications and country names in the Domain Name System (DNS): gTLDs and ccTLDs. The Information Session was a good basis to initiate an exchange of views on points (i) and (ii) referred to above.

Following discussions at the thirty seventh and thirty eighth sessions of the SCT, and in order to share more information and foster a constructive dialogue on those two topics, the Chair requests the Secretariat to compile a list of questions proposed by Members and Intergovernmental Intellectual Property Organizations with observer status¹, for consideration by the SCT, which could form the basis of a questionnaire to be distributed to Members and the aforementioned Organizations². The list of questions will be structured according to the following topics:

- I. The national and regional systems that can provide a certain protection to GIs
 - Basis for protection (sign/indication subject of protection, goods/services covered, etc.).
 - Application and registration (entitlement to file, content of application, grounds for refusal, examination and opposition, ownership/right of use, requests for protection from other countries...).
 - Scope of protection, right to take action and enforcement.
- II. The use/misuse of geographical indications, country names and geographical terms on the Internet and in the DNS, including TLDs, gTLDs and ccTLDs (examples, cases, mechanisms to address misuse, basis for protection where appropriate).

The Chair also requests the Secretariat to describe the existing state of play of geographical indications, country names and other geographical terms in the DNS, with a view to further discussions on the matter by the SCT. Such description is to be added to the update on the DNS provided to the SCT.

¹ *i.e.*, organizations which, under their constituting treaty, have responsibility for the protection of industrial property rights.

² Review of multilateral agreements is outside the scope of this exercise.

The planning for the above is as follows:

- In November 2017, the Secretariat will send a circular inviting Members and the aforementioned Organizations to propose the questions referred to above.
- Members and the aforementioned Organizations are to propose their questions to the Secretariat by February 6, 2018.
- The Secretariat will issue, by the end of February 2018, a document compiling the questions, for consideration of the SCT at its thirty-ninth session.
- The SCT will consider, at its thirty-ninth session, the above-mentioned document, with a view to issuing the questionnaire to Members and the aforementioned Organizations, and, at its fortieth session, a document prepared by the Secretariat compiling all the replies to the questionnaire. Furthermore, at its thirty-ninth session, the SCT will consider the above-mentioned description of the state of play.

[End of Annex and of document]