

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

**Twenty-Sixth Session**  
**Geneva, October 24 to 28, 2011**

### **INFORMATION MEETING ON THE ROLE AND RESPONSIBILITY OF INTERNET INTERMEDIARIES IN THE FIELD OF TRADEMARKS**

*Document prepared by the Secretariat*

1. At the twenty-fifth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held in Geneva from March 28 to April 1, 2011, SCT Members were invited to submit to the Secretariat proposals for the modalities of an information meeting on the liability of Internet intermediaries before the end of the month of May 2011. The Secretariat was requested to compile all suggestions received and to present them to the twenty-sixth session of the SCT for consideration.
2. By May 31, 2011, the International Bureau received submissions from the following Member States: Denmark, Russian Federation and United States of America. The submissions were published on the SCT Electronic Forum Website at <http://www.wipo.int/sct/en/comments/>. A summary of the proposals contained in the submissions is presented hereunder.
3. The Delegation of the Russian Federation suggests that the meeting on liability of Internet intermediaries be held during half of a working day of the SCT and proposes the following topics for consideration, account being taken of the independence and neutrality of the SCT:
  - the role played by the Internet intermediary in relation to alleged trademark infringement;
  - the degree of knowledge and control by the Internet intermediary with respect to the allegedly infringing activity by a user or its services;

- the modalities of any response by the Internet intermediary when informed of such activity;
- the alleged liability of the Internet intermediary in case of trademark infringement;
- regulating the issue of liability of the Internet intermediary in case of trademark infringement in national legislation, and
- international judicial practice.

4. The Delegation of the United States of America suggested that the information meeting explore the different policy interests in order to better assist policy makers in evaluating the appropriate role of trademark law in the online environment. In particular, the Delegation proposed that informational sessions optional for delegates be held on various topics, back to back to the SCT meeting, either during one day or half a day or a series of hour long sessions each day of the week of the SCT, during the lunch break or prior to the start of the day's work.

5. The Delegation proposed that three categories of stakeholders make presentations as follows:

- Internet intermediaries operating in the sectors of social media, online marketplaces, search engines, domain name registries and registrars, and Internet service providers could discuss the roles they currently play in protecting trademarks, the legal and regulatory provisions that allow and do not allow their businesses to grow and the opportunity for collaboration between intermediaries and brand owners to ensure effective trademark protection.
- Trademark owners could discuss the challenges they face in protecting their marks in the online environment, including a discussion of the different challenges in the different environments (i.e., social media vs. search engines vs. auction sites, etc.) and what mechanisms or collaborations at the national or international level might prove useful for trademark enforcement efforts.
- Legal experts could discuss how issues related to copyright might or might not be relevant for addressing online trademark infringement or counterfeiting and how existing international mechanisms or national law provisions work to balance competing policy interests to ensure appropriate and fair trademark protection in the online environment.

6. The Delegation of Denmark, without addressing directly modalities for an information meeting on the liability of Internet intermediaries, suggested that the SCT should identify to what extent the Joint Recommendation Concerning Provisions on the Protection of Marks and other Industrial Property Rights in Signs, on the Internet has been implemented into national law and how national courts have applied the principles laid down in it. In this respect, the Danish Patent and Trademark Office considered it useful to focus on the implementation and application in national law and practice of Articles 2, 3 and 9 of the Joint Recommendation, and in particular on the interpretation of the terms "use of a sign" in Article 2, "user" in Article 3 and "bad faith" in Article 9. Following a survey conducted in October 2010 amongst trademark users in Denmark, the Office expressed its preference for a clarification of the rules regarding trademarks on the Internet, in particular on the liability of Internet intermediaries and of the term "user" in Article 3 in the Joint Recommendation.

7. *The SCT is invited to consider the contents of the present document and to decide on the format, duration and possible agenda items of the proposed information meeting.*

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