

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
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## **STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

**Second Session, Second Part**  
**Geneva, June 7 to 11, 1999**

### SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the session

1. The session was opened by the Chair, Ms. Lynne G. Beresford, United States of America, who welcomed the participants.

Agenda Item 2: Adoption of the Agenda

2. The International Bureau presented various alternative procedures for the presentation and adoption of the Report of the session, which could require consequent changes to the Agenda. The Delegations of the United States and Germany, as well as the representative of an observer organization, supported a five day meeting of substantive discussion and presentation of the draft Report on the electronic forum. In the absence of contrary opinions, the Agenda (document SCT/2/6) was adopted without modification.

Agenda Item 3: Adoption of the Draft Report of the Second Session, First Part

3. The Report of the first part of the second session (document SCT/2/5) was adopted with the addition of the following sentence in paragraph 33: “One delegation expressed concern about the term ‘use’ covering the use of a mark on the Internet, pending discussion on the issue at WIPO” (upon request of the Delegation of Brazil), as well as the addition of the words “beyond five years” after “the period” in paragraph 66 (upon request of the Delegation of the Philippines).

Agenda Item 4: Issues to be Considered by the Standing Committee

4. The Standing Committee discussed the issues to be considered by that Committee under Part II of document SCT/2/7, as follows:

Trademark Licensing

5. Two representatives of non-governmental organizations expressed support for further discussion on this issue, and the SCT agreed that it should be included in the agenda for the next session.

Geographical Indications

6. The International Bureau informed the SCT of the joint organization by WIPO and the Government of South Africa of a symposium on geographical indications, to be held in Somerset West, Cape Province, South Africa, on September 1 and 2, 1999. The SCT agreed to consider a report on this Symposium at its next meeting.

Trademarks and Nonproprietary Names for Pharmaceutical Substances (INNs)

7. The International Bureau informed the SCT on the work currently undertaken on this issue and recalled that, at its first meeting, the SCT had decided to further discuss that issue at its third meeting.

Agenda Item 5: Proposal on Joint Resolution on Provisions for the Protection of Well-Known Marks

8. The Standing Committee discussed the document concerning the draft provisions for the protection of well-known marks (document SCT/2/8) and agreed that substantive discussions should not be reopened on Articles 1 to 5. Only the accuracy of the redrafted provisions of these articles, based on the conclusion of the first part of the second session of the SCT, should be given consideration. In this respect, the International Bureau informed the SCT of a correction made on document SCT/2/8, notably in the text of the Joint Resolution: the two occurrences of “Recommends” in the singular were changed to “Recommend” in the plural.

9. The Delegation of Spain suggested that the same correction be made in the Spanish version of document SCT/2/8 to read “Recomiendan” instead of “Recomienda,” in the text of the Joint Resolution.

10. Articles 1 to 5 of the Provisions were adopted by the SCT on the understanding that the objections raised by various delegations with respect to some provisions would be reflected in the Report as follows:

“All members of the *Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)* joined in a consensus for adoption of the provisions as a whole. However, the following countries did not join the consensus as to the provisions referred to hereafter:

- Argentina in respect of Article 5(2);
- Brazil in respect of Article 2(3)(a)(i), Article 4(1)(b) (ii) and (iii), and 4(1)(c), Article 5(1)(a)(ii) and (iii), and 5(1)(b), and 5(2);
- Chile in respect of Article 4(1)(b);
- Cuba in respect of Article 4(1)(b);
- Mexico in respect of Article 2(2)(b);
- Philippines in respect of Article 4(3)(a);<sup>1</sup>
- Portugal in respect of Article 4(1)(b);
- Republic of Korea in respect of Article 4(1)(b)(ii) and (iii);
- Spain in respect of Article 4(1)(b);
- Sweden in respect of Article 2(2)(b);
- Uruguay in respect of Article 2(3)(a)(i) and (ii) as well as Article 4(1)(b).”

11. After further discussion, Article 6 was adopted as follows, with the consequent removal of the square brackets around Article 1 item (v), and retention of the mention of domain names in Article 3(1):

*Article 6*  
*Conflicting Domain Names*

“(1) [*Conflicting Domain Names*] A domain name shall be deemed to be in conflict with a well-known mark at least where that domain name, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration of the well-known mark, and the domain name has been registered or used in bad faith.

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<sup>1</sup> Subsequent to the adoption by the SCT of the Summary by the Chair, the International Bureau received a communication from the Permanent Mission of the Philippines stating that “the Philippines joins the consensus for the adoption of the Draft Provisions on the Protection of Well-Known Marks as a whole. However, the Philippines cannot join the consensus in respect of the following Articles, namely: Article 2(d); Article 2(3)(a)(i); Article 4(1)(b); Article 4(3)(a); Article 4(3)(b); Article 4(4); and Article 4(6). With regards to Article 6, the Philippines is unable to join the consensus on this Article at this stage.”

(2) [Cancellation; Transfer] The owner of a well-known mark shall be entitled to request, by a decision of the competent authority, that the registrant of the conflicting domain name cancel the registration, or transfer it to the owner of the well-known mark.”

12. The Delegation of Brazil declared that it was not able to join the consensus on Article 6 at this stage, as well as the Delegation of Sweden in respect of Article 6(2).<sup>1</sup> The Delegation of Egypt stated that its government needed additional time to examine all of the provisions.

13. After discussion on the modalities of adoption of the Joint Resolution by the SCT, it was agreed that a phrase should be added to the text of the Resolution, such that the third paragraph would read as follows:

*“Recommend to each such Member State to protect well-known marks in accordance with the provisions contained herein, which were adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its Second Session, Second Part; and”*

14. On this basis, the SCT agreed to recommend the Joint Resolution concerning Provisions on the Protection of Well-Known Marks, for adoption by the Paris Union Assembly and the WIPO General Assembly in September 1999.

#### Agenda Item 6: The use of trademarks on the Internet

15. The SCT discussed the Study Concerning the Use of Trademarks on the Internet (SCT/2/9) by following the Possible Principles for Discussion Towards Future Draft Provisions (SCT/2/10, Section III).

16. The SCT noted that the existing trademark general principles were sufficient to apply to the Internet and that no new rule should be created in this respect, although the impact of new techniques (hyperlinks, framing and metatags) merits further consideration. The Standing Committee therefore asked the International Bureau to revise the Possible Principles, taking into account the discussions in the Standing Committee, and present a revised draft at its next session.

#### Future work

17. The SCT agreed that its third session would be held in November in Geneva and would last five full days, with adoption of the Summary by the Chair on the last day. The SCT also decided that the Report of the session should be available on the SCT Electronic Forum within two weeks after the SCT meeting.

18. The SCT further agreed that the agenda of the next meeting would consist of three substantive items: Trademark Use on the Internet, Trademark Licensing, Geographical Indications and INNs. Two and half days, two days and one half day respectively will be devoted to these items.

Agenda item 7: Brief summary by the Chair

19. The Committee adopted the Summary by the Chair (SCT/2/11) with an amendment to paragraph 13 (“at its Second Session, Second Part” instead of “on June 11, 1999”).

20. Although the SCT concluded its work on Thursday afternoon, the Committee decided that the dates of the Second Session, Second Part should remain unchanged for the purpose of the Summary by the Chair and the Report.

Agenda item 8: Closing of the session

21. The Chair closed the Second Session, Second Part of the SCT.

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