

# WIPO



SCT/2/12

ORIGINAL: English

DATE: September 24, 1999

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

## STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

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

REPORT\*

*prepared by the International Bureau*

### INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee”) held its second session, second part, in Geneva from June 7 to 11, 1999.

2. The following States members of WIPO and/or the Paris Union for the Protection of Industrial Property were represented at the meeting: Algeria, Argentina, Austria, Belarus, Belgium, Brazil, Canada, Chile, China, Colombia, Croatia, Cuba, Denmark, Egypt, Estonia, Finland, France, Georgia, Germany, Ghana, Greece, Guatemala, Hungary, India, Indonesia, Iran (Islamic Republic of), Ireland, Italy, Jamaica, Japan, Jordan, Kenya, Latvia, Lebanon, Lithuania, Mali, Malta, Mexico, Morocco, Netherlands, Nigeria, Norway, Oman, Pakistan, Philippines, Portugal, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Senegal, Slovakia, Slovenia, Spain, South Africa, Syria, Sudan, Sweden, Switzerland, Tajikistan, Ukraine, United Kingdom, United States of America, United Republic of Tanzania, Uruguay, Zimbabwe (66). The European Communities were also represented.

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\* Subject to adoption at the third session of the SCT. Following a comment received on the Draft Report (document SCT/2/12 Prov.), paragraph 85 was modified.

3. The following intergovernmental organizations took part in the meeting in an observer capacity: World Trade Organization (WTO), Benelux Trademark Office (BBM), International Vine and Wine Office (OIV).
4. Representatives of the following international non-governmental organizations took part in the meeting in an observer capacity: Agency for the Protection of Programs (APP), American Intellectual Property Law Association (AIPLA), Association of European Trade Mark Owners (MARQUES), Committee of National Institutes of Patent Agents (CNIPA), European Communities Trade Mark Association (ECTA), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of Industrial Property Attorneys (FICPI), International League of Competition Law (LIDC), International Trademark Association (INTA), International Wine Law Association (AIDV), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademark Association (JTA), Max-Planck-Institut (MPI), Union of European Practitioners in Industrial Property (UPEPI), Union of Industrial and Employers' Confederations of Europe (UNICE) (17).
5. The list of participants is contained in the Annex of this Report.
6. Discussions were based on the following documents prepared by the International Bureau of WIPO: "Agenda" (document SCT/2/6), "Organizational Matters and Overview of the Issues to be Considered by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications" (document SCT/2/7), "Draft Provisions on the Protection of Well-Known Marks" (document SCT/2/8), "Study Concerning the Use of Trademarks on the Internet" (document SCT/2/9) and "Summary of the Study Concerning the Use of Trademarks on the Internet, and Possible Principles for Discussion" (document SCT/2/10).
7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions without reflecting all the observations made.

## GENERAL DISCUSSION

### Agenda Item 1: Opening of the Session

8. The session was opened by the Chair, Ms. Lynne G. Beresford, United States of America, who welcomed the participants.
9. The International Bureau announced that the Director General had implemented a new policy by which active interpretation at all WIPO meetings would be provided in six languages, including Arabic and Chinese, and that, since it was impossible to implement the policy at the present meeting of the SCT, the new policy would be followed at future meetings.
10. The SCT approved the suggestion of the International Bureau to include the e-mail addresses of the participants in the list of participants, attached to the Report of this meeting,

and to the SCT Electronic Forum.

Agenda Item 2: Adoption of the Agenda

11. Referring to the recent decision of the Standing Committee of Patents (SCP) to adopt the report at the end of its session from April 12 to 23, 1999, the International Bureau presented various alternative procedures for the circulation and adoption of the report of the session, with consequent changes to the Agenda, which the SCT could consider.

12. 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 the subsequent presentation of the Report on the SCT Electronic Forum. In the absence of contrary opinions, the Agenda (document SCT/2/6) was adopted without modification. It was decided that the meeting would last from June 7 to 11, 1999.

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

13. The International Bureau noted that two corrections had been incorporated in the Draft Report of the second session, first part of the SCT (document SCT/2/5): an error in the numbering of paragraph 12 in SCT/2/5 Prov. was corrected with the result that all subsequent numbered paragraphs in SCT/2/5 decreased by one digit; the first part of the first sentence of paragraph 67 of SCT/2/5 Prov. was modified to read: "After some discussion, during which one delegation observed that the date on which the fact of registration was made public by the Office would be determined in accordance with the applicable law of a Member State, the following text was adopted for paragraph (3)(a) and (b):". The International Bureau also pointed out that in the text of the Joint Resolution, as quoted in paragraph 23 of SCT/2/5, the two occurrences of "Recommends" had to be changed to "Recommend."

14. The Delegation of the Philippines stated that its intervention, as set forth in paragraph 66 of SCT/2/5, should be modified by inserting "beyond five years" after "the period."

15. The Delegation of Brazil stated that paragraph 33 of SCT/2/5 should be modified by adding, as the final sentence: "One delegation expressed concern about the term 'use' covering the use of a mark on the Internet, pending discussion on the issue at WIPO."

16. The Report of the second session, first part of the SCT (document SCT/2/5) was adopted with the aforementioned modifications.

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

17. The representatives of two observer organizations expressed support for further discussion on trademark licensing, noting its timeliness and its importance to trademark owners. The SCT, as agreed at the first part of its second session, decided to include this item in the Agenda for its third session.

18. The International Bureau announced that South Africa had offered to co-host a symposium on geographical indications and that this Symposium would take place on September 1 to 2, 1999, in Somerset West, Cape Province, South Africa. In response to a

query of the Delegation of Egypt, the International Bureau noted that any deliberation on geographical indications, as referred to in paragraph 15 of document SCT/2/7, would cover geographical indications for all products, irrespective of their nature. The SCT decided to consider at its third session a report on the South African Symposium.

19. The International Bureau recalled that, prior to the first meeting of the SCT, consultations had taken place between WIPO and the World Health Organization (WHO) regarding possible ways of improving protection of International Nonproprietary Names for Pharmaceutical Substances (INNs) against unauthorized registration or use as trademarks. In particular, the International Bureau would conduct a survey of Trademark Office practices with regard to conflicts between INNs and applications for the registration of trademarks. A questionnaire would be distributed to the Member States, and the SCT agreed that the results of that survey would be presented to the SCT at its the next meeting.

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

20. The SCT 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 conclusions of the first part of the second session of the SCT, should be given consideration.

21. In this respect, the International Bureau informed the SCT of the corrections to be made to document SCT/2/8: in the text of the Joint Resolution, the two occurrences of “Recommends,” in the singular, should be changed to “Recommend,” in the plural; the notes on Article 4 in the English text (page 22) should be renumbered so that note 4.7 becomes 4.8 with consequential changes until note 4.14 (page 24); note 5.3 of the English, French and Spanish texts should be deleted since it refers to previous paragraph 2 of Article 5 on cancellation which was deleted. As a consequence note 5.4 should become note 5.3 and read: “*Paragraphs (2) and (3). See note 5.2.*”

22. The Delegation of Spain pointed out that, in the Spanish text of the Joint Resolution, the same correction should be made as in the English text, with the consequence that the word “Recomienda” should be changed to “Recomiendan.”

23. Although the SCT agreed that substantive discussions should not be reopened, some delegations requested that their concerns on specific provisions be reflected in the Report.

#### *Articles 1 to 5*

24. The Delegation of Argentina said it could not join the consensus with respect to Article 5(2), specifically in relation to the time limits contained in that provision.

25. The Delegation of Brazil stated that it could not join the consensus with respect to sub-paragraphs (ii) and (iii) of Article 4(1)(b), Article 4(1)(c), sub-paragraphs (ii) and (iii) of Article 5(1)(a), Article 5(1)(b) and 5(2). With respect to Article 2(3)(a), it suggested to add

the following language in note 2.18: “It is understood that a Member State may, in the course of administrative or judicial proceedings require that an application for registration may be placed on file, for formal purposes, provided that the filing of that application would not cause any delay in the said proceedings.” This suggestion was not supported by any other delegations.

26. The Delegations of Chile, Cuba, Portugal and Spain said they could not join the consensus with respect to Article 4(1)(b), on the grounds that the protection of well-known marks against use for dissimilar goods or services should, as in Article 16.3 of the TRIPS Agreement, be based on registration.

27. The Delegation of Korea stated that it could not join the consensus with respect to sub-paragraphs (ii) and (iii) of Article 4(1)(b).

28. The Delegations of Mexico and Sweden said they could not join the consensus on Article 2(2)(b) since, when determining whether a mark was well known, it did not seem appropriate in all cases to refer to only one relevant sector of the public.

29. The Delegation of the Philippines indicated its objection to Article 4(3)(a) and said that it would propose an alternative text later.<sup>1</sup>

30. The Delegation of Uruguay said that it could not join the consensus with respect to sub-paragraphs (i) and (ii) of Article 2(3)(a) and Article 4(1)(b).

31. All members of the SCT joined in a consensus for adoption of Articles 1 to 5 as a whole. The following countries did not join the consensus as to the provisions referred to, namely:

- 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);
- 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).

32. The Delegation of Egypt stated that its Government needed additional time to examine these provisions.

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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.”

33. In order to reflect the agreement reached on the provisions on Well-Known Marks, the SCT agreed to add, after the words “in accordance with the provisions contained herein,” in paragraph 3 of the Joint Resolution, the following words: “which were adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its Second Session, Second Part.”

*Draft Article 6: Conflicting Domain Names*

34. The International Bureau gave an overview of the findings and the current status of the Final Report of the WIPO Domain Name Process. It was pointed out that this process referred to administrative procedures and did not attempt to affect national legal systems, whereas the purpose of the draft provisions on Well-Known Marks was to influence national laws.

35. A number of delegations, as well as representatives of observer organizations, considered the current draft of Article 6 too restrictive.

36. In this respect, various draft proposals were made by delegations and representatives, for example to add a reference to “bad faith,” to incorporate the concept of “abusive registration” used in the WIPO Domain Name Process, or to refer more generally to the obtention of financial gain from the illicit registration of the domain name. Also envisaged was the deletion of sub-paragraph (b) or merging sub-paragraphs (a) and (b).

37. The Delegation of Canada was of the opinion that it was premature to adopt a provision such as Article 6 and proposed to remove Article 6 from the draft provisions. While the Delegation shared concerns about abusive practices taking place on the Internet and supported the WIPO Domain Name Process, it believed that further reflection was needed as to important substantive and jurisdictional considerations before an attempt could be made to include any further requirements in respect of domain names.

38. After some discussion, the following revised paragraph 6(1) was suggested by the International Bureau:

“(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 had been registered or used in bad faith.”

39. A large number of delegations supported adoption of Article 6(1) as revised, in particular, with the words “registered or used”, and the deletion, proposed by one delegation, of the reference to Articles 1 to 5 in Article 6(1) in order to ensure consistency with Articles 4 and 5.

40. In response to concerns expressed by the Delegations of the European Communities and Uruguay regarding the deletion of the introductory words of sub-paragraph (a), the International Bureau explained that the language of Article 6(1)(a) was inconsistent with the language of Article 3(1) in that the latter already listed the protection against conflicting domain names as part of the protection to be provided to well-known marks. Furthermore, the International Bureau noted that Article 3(1) was the appropriate place for such a reference since Articles 1 to 3 set forth the basis for the protection of well-known marks.

41. The International Bureau also noted that, as a consequence of the adoption of Article 6(1), the square brackets around Article 1 item (v) would be removed and the reference to domain names in Article 3(1) would be retained.

42. The Delegation of Spain maintained that the scope of Article 6 should be broadened to list any other type of abusive or prejudicial use, e.g. in metatags and web links, against which well-known marks should be protected.

43. The Delegation of Japan maintained that it was premature to adopt Article 6, given the issues left on the Agenda, but indicated that Japan could join a consensus on the understanding that the discussion regarding the protection of well-known marks against conflicting domain names would continue.

44. Article 6(1), as revised by the International Bureau, was adopted on the understanding that delegations waiting for instructions from their capitals could join the consensus or enter objections later.

45. In response to concerns raised by several delegations and representatives of observer organizations relating to Article 6(2), the International Bureau noted that the phrase “competent authority” did not refer to a registrar of domain names since, in most instances, domain name registrars are not under government control. The International Bureau further suggested that the language of Article 6(2) provide that the registrant of a domain name could be ordered to cancel or transfer his or her domain name registration. The International Bureau also stated that, of the two remedies provided for in Article 6(2), transfer was the most important since cancellation would not prevent another party from registering the same domain name almost instantly. The International Bureau noted that, while all registrars have procedures to cancel a domain name registration, they might not have procedures to transfer a domain name registration.

46. The Delegation of Sweden stated that Article 6(2) was problematic since the effectiveness of the remedies listed therein ultimately depended on the voluntary compliance by the domain name registrars, most of which were private entities. The Delegation also pointed out that forcing a registrar to cancel or transfer a domain name registration might amount to an expropriation of rights.

47. In response to interventions of several delegations and representatives of two observer organizations, the International Bureau proposed modifications of Article 6(2).

48. Some delegations suggested to include other remedies such as damages or prohibition of use, although others preferred to address such remedies in the context of the discussion on the use of trademarks on the Internet (documents SCT/2/9 and 10).

49. The SCT decided to change the word “holder” in English and “titular” in Spanish, meaning the person who holds the registration of the conflicting domain name, to “registrant” in English and “persona que detenta” in Spanish.
50. The Delegation of Sweden said that, in its opinion, it was not appropriate to create rules which would entitle owners of well-known marks to request the transfer of a domain name. That Delegation added that this was particularly problematic in cases where the domain name registrar was a private entity and therefore declared that it could not join the consensus on that point.
51. The Delegation of Japan stated that even though it shared the concerns expressed by the Delegation of Sweden with regard to Article 6(2), it did not want to block the consensus.
52. The following revised draft of Article 6 paragraph (2) was submitted for consideration by the SCT:
- “(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.”
53. The Delegation of Argentina declared that it reserved its position concerning the redrafted text while awaiting instructions, but later withdrew its objection. The Delegation of Japan declared that it viewed Article 6 as a minimum standard provision and that further study was needed concerning more effective protection of well-known trademarks against domain names.
54. Following these comments, Article 6 was adopted as part of the Provisions on Well-Known Marks to be submitted for consideration by the WIPO General Assembly and the Assembly of the Paris Union. The Delegation of Brazil declared that it was not able to join the consensus at this stage with respect to Article 6. The Delegation of Sweden noted that it was not able to join the consensus with respect to Article 6(2). The Delegation of Egypt stated that its Government needed additional time to examine Article 6.

#### Agenda Item 6: The Use of Trademarks on the Internet

55. The Standing Committee discussed the “Study Concerning the Use of Trademarks on the Internet” (document SCT/2/9) and the “Summary of the Study Concerning the Use of Trademarks on the Internet, and Possible Principles for Discussion” (document SCT/2/10).
56. The Delegation of the United States of America stated that, in its view, the use and protection of trademarks on the Internet had taken on urgency with the recent, explosive growth of the Internet. In particular, the use of the Internet for commercial and consumer-oriented purposes made it essential that the SCT work to identify common understandings with respect to the use of commercial identifiers in cyberspace. The Delegation added that it was necessary to focus the work of the SCT on use of trademarks on the Internet, and not on use of Internet domain names, since the difficult but important task of addressing issues related to the use and protection of trademarks incorporated in Internet domain names



had already begun with WIPO's April 1999 Final Study on this topic. With respect to what the SCT could accomplish at this session, given a topic so potentially vast, the Delegation suggested that it might be helpful to establish early in the discussion the goals of the meeting and that the SCT should answer two fundamental questions: first, whether the SCT wished eventually to identify international standards for establishing likelihood of confusion between trademarks used, broadly speaking, on the Internet, and second, whether the SCT wished eventually to identify international standards for determining jurisdiction over a trademark dispute involving use of a mark or marks on the Internet. If the SCT answered in the affirmative to either or both of these questions, it could proceed to studying answers and options, while a negative response would remove an area or areas of concern from the Agenda and the SCT would be able to focus on other aspects of the trademarks and Internet issue. However, whatever the focus would be, the SCT should not develop a set of trademark standards separate from existing internationally-recognized standards. Although the Internet could involve new and yet unknown circumstances, in which case it might be necessary to elaborate on current standards to address Internet-specific issues, existing standards could and should be applied to any unique situation presented by use of trademarks on the Internet. Thus, internationally recognized standards of trademark protection, such as those articulated in the Paris Convention and the TRIPS Agreement, should be applied to the trademark issues raised by the Internet. Finally, the Delegation stated that it believed that the SCT was taking an important initiative with its work on the topic of trademarks and the Internet and was confident that any results would offer governmental bodies, consumers, trademark-holders and businesses valuable guidance.

57. The Delegation of the United Kingdom pointed out that, according to its experience, common law legal system had proved flexible enough to deal with problems resulting from the use of trademarks on the Internet. It was of the opinion that reference to particular technical features in any draft legal provisions should be avoided. To be able to respond to new challenges, the law should be kept flexible.

58. The representative of one observer organization welcomed that several parts of the study had been extended to geographical indications including their utilization as domain names, particularly when addressing cases of cybersquatting for geographical indications.

59. The SCT started its discussion on the topic of the establishment and maintenance of rights through the use of trademarks on the Internet. The representative of an observer organization proposed to distinguish between cases where the sign related to goods or services which were actually advertised or sold on the web page, and other cases such as metatagging, framing, linking, and domain names. The representative pointed out that, in most legislations, the mere use of a trademark as a domain name or as a metatag would not qualify as being sufficiently related to goods and services for the purposes of establishment and maintenance of rights. However, there was some degree of flexibility in the law of certain European countries so that it was no longer essential that the mark be affixed to a product in order to have connection with it and fulfill the use requirements.

60. The representative of another observer organization suggested that questions of metatagging, linking and framing should be discussed separately from questions of territoriality, establishment, and the enforcement of rights.

61. A representative of one observer organization suggested to distinguish between passive web sites, only delivering information about goods, and active web sites where goods could be ordered or delivered. A passive web site would be analogous to advertising goods and services, and use of a trademark on such a site would, for example under US law, not be sufficient to establish or maintain trademark rights with respect to goods, although it could be sufficient to maintain rights in a mark which is used for services. The Delegation of Canada pointed out that this was also true under Canadian law. The representative of an observer organization explained that, in Japan, use of a trademark in advertising could be sufficient for maintaining a trademark right. According to the Delegation of Uruguay, the same is true for Uruguayan law. The Delegation of China stated that, under Chinese law, stricter criteria would be applied to use of a trademark in advertising. The Delegations of Finland, France, Brazil and Spain said that, according to their national legal systems, mere use of a trademark without selling goods or providing services would not be sufficient for maintaining a trademark right. This view was shared by the representative of an observer organization in respect of German law. The Swedish Delegation reported that, according to a recent court decision in Sweden, mere use in advertising could be sufficient to maintain a trademark right if the goods or services identified by the trademark were made available within a short time after the advertisement.

62. The Delegation of Denmark stated that use of a trademark on a passive web site could be regarded as one factor among others for establishing a relationship with goods and services and could be sufficient for the maintenance of trademark rights if the web site was visited from a country where such goods or services are offered. The Delegation of Brazil pointed out that a receipt issued by the seller after the delivery of goods could be sufficient evidence to prove that, in fact, trade had occurred via the Internet. This would establish a relationship between the trademark with particular goods as well as a relationship with a particular country or territory.

63. The Delegation of Germany and the representative of an observer organization pointed out that, in their view, the situations referred to under paragraphs (1) and (2) of Principle X in document SCT/2/10 did not pose particular problems. Only in cases where goods or services were directly delivered through the Internet, as in the situation referred to under paragraph (3) of Principle X, may one doubt whether, and how, a relationship with particular goods or services can be established. The Delegation of Germany stated that paragraph 93 of the study sufficiently explained that such a relationship would exist even in such cases. The representative of an observer organization suggested that an international rule might be necessary to address the situation envisaged in paragraph 3.

64. The SCT discussed the Possible Principles for Discussion Towards Future Draft Provisions (Section III of document SCT/2/10).

### *Part 1: General Concepts*

#### *I. Commercial Use of a Sign on the Internet*

65. The Chair noted that use of a sign on the Internet could be legally relevant in three different ways: for acquiring a right, for maintaining a right, and use that would constitute infringement of a right. The Chair invited comments with regard to what constituted

commercial use of a sign on the Internet, whether a definition of commercial use of a sign would be useful in this context, and whether the discussion should be limited to commercial use.

66. The Delegation of the United States of America proposed that the heading of the principle be changed from “commercial use” to “use” because laws around the world differ as to whether commercial use is required. The Delegation of France supported the proposal of the Delegation of the United States of America, and stated that since it was very difficult to distinguish between commercial and non-commercial use on the Internet, e.g. in the case of sporting clubs, it would be better to speak of use in general.

67. The Delegations of Belgium and the Netherlands suggested that an interesting definition may be found in their case law: commercial use would be any use that takes place, other than for a purely scientific purpose, within the framework of a company, profession, or any other activity with the objective of achieving some economic advantage. The Delegations also stated that, under their legislation, use on the Internet could be sufficient to maintain trademark rights, provided that the use is commercial and sincere. While recognizing that there might be instances of non-commercial use that could constitute infringement, the representative of an observer organization maintained that, when dealing with trademark law proper, there is a widespread belief that use should be commercial use. However, given the difficulty in distinguishing between commercial and non-commercial use, the representative supported the approach of using a “negative” definition as proposed by the Delegations of Belgium and the Netherlands. The Delegations of Spain, Germany and Nigeria, and the representative of another observer organization were in favor of keeping the definition of commercial use since it is a central concept in trademark law. The Delegations of the United Kingdom and France and the representative of an observer organization maintained that, although they had no objection to defining commercial use, it was premature to do so until the purpose of that definition was known, i.e. what the legal consequences of the presence or the absence of commercial use would be. Furthermore, that representative did not believe that only commercial use is relevant, noting that there are various types of non-commercial use by which trademark rights could be infringed under US law.

68. The Chair indicated that, although many Delegations stated that non-commercial use could not be a basis for infringement under the law of their countries, this was not the case in the United States of America.

## *Part 2: Relationship of the Use of a Mark with a Particular Territory or Country*

### *II. Determination of Whether the Use of a Sign on the Internet has Established a Relationship With a Particular Country or Territory*

69. The Delegations of Belgium and the Netherlands referred to a recent judgment according to which it was necessary that the web site specifically addresses the Benelux countries in order to establish a relationship with that territory. The representative of an observer organization stated that there are no clear-cut provisions listing such factors in Japanese law. That representative pointed out that the use of disclaimers should be given great weight when addressing the territoriality issue. The representative from another observer organization maintained that the factors, although of great value, must be considered in context (e.g. in the

acquisition of rights, the establishment of jurisdiction over a defendant, or in determining substantive violations of trademark law). In response, the Chair observed that discussion of these issues in case law would probably focus mostly on the infringement of trademark rights and not on creation or maintenance.

70. The Delegation of France pointed out that such criteria could only serve as an indication since it was up to the courts to decide whether use on the Internet related to a given territory. The Delegation also expressed reservations regarding the use of disclaimers mentioned in factor 11 of the list of factors, since, although the factor could be useful in determining the good faith of a site owner, it could not remove that site owner's responsibility with respect to the infringement of rights.

71. The Delegation of Germany indicated that the list of factors would be of use to the courts in deciding future cases. No factor should be excluded as irrelevant until more cases had been decided. The Delegation expressed some reservations about factor 11 with regard to discrimination in international trade.

72. The representative of an observer organization reported that recently a German court simply assumed jurisdiction because a web site could be accessed in Germany, but that it was generally felt that a more thorough analysis of various factors was necessary when deciding such issues. The representative therefore maintained that it was valuable to have a list of factors, but acknowledged that distinctions must also be made between various situations. The representative was also of the opinion that factor 11 was very valuable, but that it could not be applied equally in every case; while it might figure prominently in cases of infringement, for example, it would be of lesser importance regarding questions of jurisdiction.

73. The Chair agreed with the general opinion regarding the uniqueness of factor 11, noting, in particular, the many questions the use of disclaimers would raise, for example: What should an effective disclaimer look like? In how many languages should a disclaimer appear? What if goods are sold in a country that is the subject of a disclaimer? What if consumers ignore the disclaimers?

74. The Delegation of Denmark proposed to consider, in the context of factor 11, two additional factors: first, structuring a web site in such a way that a user is forced to choose a country-specific home page, and second, using software edits which prevent sales to users from the territories excluded in a disclaimer. The representative of an observer organization, supported by the representative of another observer organization, indicated that the idea of the use of disclaimers was very important and should be further considered.

75. The Delegation of the European Communities indicated that the factors should be weighted differently, and that disclaimers, in particular, should be just another factor that should be taken into account in each specific case.

76. The representative of one observer organization suggested that a disclaimer on a passive web page could constitute *prima facie* evidence of the absence of a relationship, whereas disclaimers on an active web page could not. The representative further suggested to include, in the list of factors, cases in which the goods or services marketed on a web site were specifically tailored to meet particular local requirements.

77. The Delegation of the United States of America, supported by the Delegation of Germany, maintained that the list of factors should not be treated as exhaustive but as representative examples of some of the evidence that parties to a dispute could introduce in a dispute, on the understanding that the decision as to the weight of each item of evidence would ultimately be made by a decision maker.

78. The representative of an observer organization suggested with respect to jurisdiction that, as an additional factor, the place where the harm from an infringement is felt should be included in the list of factors. The representative cited, as an example, cases where a cybersquatter registers someone else's well-known mark as a domain name. In response, the representative of another observer organization suggested, and the International Bureau confirmed, that factor 10 was intended to protect rights, including trademark rights, in the countries where such rights may be found. A representative from an observer organization pointed out, however, that factor 10 appeared to require that a trademark be registered for it to be protected, which would be inconsistent with the well-known marks resolution.

### *III. Jurisdiction*

79. With regard to this part, the Delegation of France, supported by the Delegation of the United Kingdom and the representative of an observer organization, expressed its preference for giving the plaintiff the choice of the competent forum because the defendant might otherwise choose a "safe haven" as his place of residence or business. The delegation stated that it was also necessary to determine the scope of competence of the court, which could be either specific jurisdiction to judge infringements in one territory and with regard to the damage suffered in that territory, or general jurisdiction encompassing infringements committed in other countries as well. The representative of an observer organization explained that under US law, general jurisdiction would lie with the courts in every country with which the defendant had established continuous and systematic contacts, and that the plaintiff could choose between several such fora.

80. According to the representative of another observer organization, it was necessary to distinguish between general and specific jurisdiction. The former would cover all infringements involving the same parties irrespective of the territory in which such infringements occurred. Under the European system, only the courts in the country of the defendant's place of residence or business would have general jurisdiction, without any further choice for the plaintiff. Specific jurisdiction would only be available in so far as the use of a sign on the Internet had established a relationship with that territory. The court would be competent to consider the case only in so far as it had an impact on the territory concerned, and the plaintiff might have to bring his case in more than one jurisdiction in order to obtain full recovery. The plaintiff could bring the case, at his or her choice, either at a court of general jurisdiction or at one or more courts of specific jurisdiction.

81. The Delegation of the European Communities noted that, in this context, it was useful to consider the system under the European Community Trademark Regulation. This system was, first of all, based upon the assumption that the national courts designated by each EU Member State to decide alleged infringements of community trademarks had joint jurisdiction on the infringement and cancellation of community trademarks. Secondly, there was jurisdiction in the Member States of the European Communities according to the domicile of the defendant

and there was no additional requirement of a relationship with a particular territory. Here, the International Bureau's proposal seemed to be more restrictive. The alternative jurisdiction at the place of the plaintiff only applied if the defendant was not domiciled within the European Community. The representative added that further reflection was needed on paragraph 3 concerning the impact of counterclaims or declarations of nullity of the trademark. Additionally, a differentiated answer was required for cases involving claims based on unfair competition, national or regional trademarks.

#### *IV. Choice of Law*

82. While some delegations maintained that their national courts only applied the respective national law, others explained that national rules of private international law (or on choice of law) might require a court to apply a foreign law. In trademark law, this could be the case if a court of general jurisdiction had to decide a dispute in which the plaintiff alleged that the defendant's use of a sign on the Internet infringed various trademark rights established under various national laws, e.g. a German trademark, a Swiss trademark and a Spanish trademark.

83. After further discussion and, given the lack of expertise of the SCT in this area, the Chair took up a suggestion made by the International Bureau to establish a contact with the Permanent Bureau of the Hague Conference on Private International Law because of its expertise in the area of choice of law and probably also in the fields of jurisdiction and enforcement of foreign judgments.

#### *VI. Infringement*

84. The Chair observed that the use of disclaimers might be compared to a situation in which a business puts up a billboard in a particular country, advertising goods but explicitly stating that these goods are not available in that particular country. The representative of an observer organization pointed out that in the billboard example, the business would only use a token disclaimer, whereas on the Internet, use of disclaimers might be the only way for a business to avoid infringing conflicting rights in a particular country. This was supported by the representative of another observer organization who added that the user of the billboard actively targeted some activity at a particular country, whereas the effects that the use of a sign on the Internet may have with respect to a particular territory, in many cases, may not be foreseeable.

85. The Delegation of Germany explained that, in its view, it would be necessary to show that the use of a sign on the Internet had created a relationship to the country in which the conflicting right enjoyed protection and that, although solutions on the national level would already be helpful, international rules to that effect would be preferable. In a case involving the international distribution of journals, the German Federal Court of Justice had held that only foreseeable contacts with a particular country could have legal relevance. The Delegation was of the opinion that the legal relevance of disclaimers merited further examination. The Delegation of France stated that the mere appearance of a sign on the Internet would not be sufficient to judge whether a right protected in a particular country was infringed by such use, but that it was necessary to establish a relationship with that country. The legal relevance of disclaimers should be studied carefully. In its view, disclaimers could not totally exempt the

user of a sign on the Internet from every liability in the country where a conflicting right existed. In any case, it would be necessary that the user abided by the disclaimer, and that he or she acted in good faith. The Delegation of the United Kingdom pointed out that in its view, use of a sign on an active web site would be sufficient to establish a relationship with a particular country, whereas use on a passive web site would not. This distinction was opposed by the representative of an observer organization who stated that a passive web site could also infringe trademark rights; if, for example, a German business established a web site containing information directed to US customers in the United States of America on how to order goods by using a 1-800 telephone number, such use could be considered to infringe conflicting trademark rights in the United States of America. The Delegations of Cuba and the United Kingdom expressed some concern with regard to disclaimers and pointed out that disclaimers should be real, not artificial.

86. The representative of an observer organization was of the opinion that disclaimers might be useful tools for limiting the territorial scope of the use of trademarks on the Internet. They could provide *prima facie* evidence which, in a dispute, could be rebutted by the plaintiff showing that the user of the sign in fact established contacts with the territory in which the conflicting sign enjoyed protection. The representative of another observer organization stated that it was necessary to distinguish between the use of disclaimers with regard to jurisdiction on the one hand, and the finding of an infringement on the other. For the purposes of jurisdiction, it would seem that disclaimers could not destroy a link to a particular country established by other factors (language, availability of goods, etc.). They would, however, often be the only possibility for users of distinctive signs on the Internet to avoid the infringement of conflicting rights established in a particular country. To this end, the user would also have to take the necessary technical steps to implement the disclaimer. The representative of another observer organization supported the view that disclaimers may sometimes not be sufficient to exclude jurisdiction, but could be an effective means for avoiding the infringement of conflicting rights in a particular territory.

87. The Delegation of the United States of America questioned whether there was a need for a uniquely different law for the Internet. The most important questions, e.g., where to bring a suit, and what evidence was needed to prove an infringement, could be answered on the basis of traditional legal methods. It was up to the parties of a dispute to present the relevant evidence to a competent court of justice. Disclaimers could constitute one piece of evidence.

## VII. *Enforcement of Judgments*

88. The SCT discussed the problems relating to the global effect of judgements, given the omnipresent nature of the Internet. It was pointed out that courts might charge the defendant to take reasonable steps for limiting access to his web site from territories in which conflicting rights existed. Such measures, if technically efficient, however, would be burdensome and costly.

*Part 3: Issues of Substantive Law Relating to the Use of a Sign on the Internet*

*IX. Establishment or Maintenance of Trademark Rights by Virtue of the Use of a Sign on the Internet*

89. The Delegation of Canada suggested to consider third party use, with regard to the establishment or maintenance of trademark rights. The Delegation of Denmark stated that use of a trademark on the Internet would not only be relevant for the establishment or maintenance of trademark rights, but could also be a factor for determining whether a mark had become well known. The representative of an observer organization said that, in his view, how use on the Internet could be proved should also be examined.

90. The Delegation of Cuba explained that, under its new national trademark law, trademarks would have to be registered in order to enjoy protection. Effective use of a trademark could, under certain circumstances, also give rise to a trademark right. It would always be relevant for the maintenance of registered trademark rights. A similar observation was made by the Delegation of Uruguay with regard to its national law.

91. The Delegation of France was of the opinion that the mere display of a mark on the Internet would never be enough to maintain a trademark right in a particular country, but that a link to that country would always be needed which depended on the contents of the web site and the goods or services offered. This was supported by the Delegation of Germany, which also stated that under its national law a trademark would have to be used to identify particular goods or services, and that the establishment of a trademark right would additionally require knowledge in interested circles.

92. The representative of an observer organization said that it was necessary to clarify the possible impact of the principle stated in V. If it meant that a country could demand a link to its territory as a minimum requirement, and could add other requirements for the establishment or maintenance of a trademark right, the principle was almost self-evident and acceptable. If, on the other hand, the principle required Member States to regard use of a sign on the Internet as such to be sufficient for the establishment or maintenance of trademark rights, this would be far reaching and probably not acceptable for many countries.

*VIII. Relationship between the Use of a Sign on the Internet and Particular Goods or Services*

*IX. Establishment or Maintenance of Trademark Rights by Virtue of the Use of a Sign on the Internet*

93. The representative of an observer organization observed that linking, framing and metatagging, as referred to in paragraph (4) of Principle VIII, could in some cases be relevant with respect to dilution. The representative of another observer organization stated his agreement with the analogies in paragraphs (1) and (2) of Principle VIII. The sale of digital goods through an interactive web page referred to in paragraph (3) might be analogous to a point of sale display of a trademark. With regard to linking, framing and metatagging referred to in paragraph (4), he pointed out that such practices could, under certain circumstances, give rise to confusion, at least in the form of “initial interest confusion” recognized under US trademark law. The Chair observed that under US law, use of a trademark in a mail order



could be sufficient to establish or maintain a trademark right, as evidenced by the “Lands End” case.

*X. Infringement of Trademark Rights by Virtue of the Use of a Sign on the Internet*

94. The Delegation of France observed that the situation referred to under Principle X would not seem to pose any Internet-specific problems but could adequately be dealt with on the basis of traditional legal concepts, and that there was no need to redraft national trademark laws in general. This was supported by the Delegations of the United States of America, Belgium, Germany, the Netherlands and the representatives of two observer organizations. The Delegation of the Netherlands stated that, rather than trying to restate substantive trademark law for the Internet, it would seem more appropriate to focus on problems resulting from the global nature of the Internet, for example in the area of jurisdiction. The Delegation of Denmark stated that, while it was necessary to begin by applying the traditional principles of trademark law, it was equally necessary to face the challenges posed by the globality of the Internet. For example, non-commercial use might acquire a different importance when, on the Internet, non-commercial texts would be accessible by a far greater number of people. The Delegate referred to "new" problems, such as the sale of searchwords for search-engines that are identical with or similar to trademarks, or the use of a trademark as an invisible metatag, and presented a case in which a Danish court had enjoined a producer of coffee filters from using the trademark of a competitor as a metatag in such a way that it was listed first by a search engine.

95. The Delegation of Belgium suggested to add another paragraph concerning the use for other purposes than for the identification of goods or services.

96. The representative of an observer organization suggested also to study the issue of exhaustion and offered the following example: the mail order sale and shipment of a pair of LEVIS® jeans by a legitimate US seller to a European buyer could be seen as an infringement of the rights of the owner of the LEVIS® mark in Europe. Consequently, the representative maintained that a person who merely establishes a mail order web site without a disclaimer might be accused of being an infringer. The representative suggested a variation on its example wherein the product was of the type that could be transmitted electronically, e.g., recorded music. This was opposed by the Delegations of the United States of America, France and Spain, which maintained that exhaustion concerned the movement of goods into a particular territory and not use of the mark on the Internet. The Delegations also disagreed with any suggestion that the appearance of a mark on the Internet would exhaust the rights of that trademark owner.

97. Referring to principle X(1), the representative of an observer organization stated that fair use of a sign should be limited to those situations in which it is absolutely necessary, given the potential for abuse in the counterfeit trade.

98. The representative of one observer organization maintained that the statement in Principle X(2) that trademarks can only be infringed by commercial use was an incorrect statement of the law, at least in the United States of America, regardless of whether that use was on the Internet or not. Referring to the definition of non-commercial use in paragraph 11 of document SCT/2/9, the representative stated that, in the United States of America, such

“non-commercial” use, e.g., use for charitable purposes, for sports clubs, or by governmental agencies, could infringe trademarks.

#### *XI. Remedies and Conflicts Between Rights*

99. The Chair stated that trademark owners would find Alternative A (the owner of a right with the earliest priority anywhere in the world would prevail) unacceptable since it entailed a consequent loss of national rights.

100. The representative of an observer organization, supported by the representative of another observer organization, suggested that the SCT consider the establishment of an international dispute resolution system that would decide issues of use of trademarks on the Internet. As a precedent, the representative cited Chapter 2 of the Patent Cooperation Treaty which provides for a non-binding international examination of a patent, and noted that Chapter 3 of the PCT, which has not yet been implemented, would make that examination binding.

101. The Delegation of Germany observed that, rather than creating a special enforcement system for trademark infringements on the Internet, it would be preferable to remain closer to the traditional approach and to create international procedures for the recognition and enforcement of foreign judgments. The Delegation of France stated that the proposal put forward by the representatives of observer organizations was attractive only on first sight. Such a dispute resolution system could not cover the whole range of claims arising from the use of a trademark on the Internet, such as counterclaims challenging the validity of the trademark. The International Bureau explained that mediation services were already offered by WIPO's Arbitration and Mediation Center. The panels could apply, within a limited jurisdiction, accepted international principles of law. It would, however, be the task of the SCT to determine acceptable international principles with regard to the use of trademarks on the Internet, and to decide whether these principles should be applied by the national courts. This work could greatly contribute to creating a stable legal environment for global electronic commerce.

102. The representative of one observer organization objected to the distinction between commercial and non-commercial use in paragraph (2) of principle XI.

#### Future Work

103. The SCT asked the International Bureau to redraft the Possible Principles for Discussion contained in section III of document SCT/2/10, taking into account discussions so far. The SCT also asked the International Bureau to prepare a questionnaire with hypothetical situations concerning legal issues relating to the use of trademarks on the Internet. The questionnaire could be answered by each delegation on the basis of its national law in preparation for the next meeting.

104. The SCT decided that its third session be held in November and that it should last for five full days with adoption of the Summary by the Chair on the last day. The Report should be made available on the SCT Electronic Forum within two weeks following that session. The Report of the third session of the SCT should be adopted at its fourth session.

105. The SCT further agreed that the Agenda of its next session would consist of four substantive items: use of trademarks on the Internet, trademark licensing, geographical indications, and international nonproprietary names (INNs). Two and a half days would be devoted to issues relating to use of trademarks on the Internet, two days to trademark licensing, and a half day to geographical indications and international nonproprietary names (INNs).

Agenda Item 7: Brief Summary by the Chair

106. The Chair presented a draft Summary by the Chair (SCT/2/11 Prov.) and received comments from the participants. On the understanding that such comments would be reflected in the final Summary, the SCT approved the Chair's Summary.

Agenda Item 8: Closing of the Session

107. The Chair closed the second session, second part of the Standing Committee.

[Annex follows]

ANNEXE I/ANNEX I

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

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<sup>†</sup> Sur une décision du Comité permanent, les communautés européennes ont obtenu le statut de membre sans droit de vote.

<sup>†</sup> Based on a decision of the Standing Committee to accord the European Communities status as a Member without a right to vote.

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