

# WIPO



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

**Second Session, Second Part  
Geneva, 7 to 12 June 1999**

ORGANIZATIONAL MATTERS AND OVERVIEW OF THE ISSUES TO BE  
CONSIDERED BY THE STANDING COMMITTEE ON THE LAW OF TRADEMARKS,  
INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

*Memorandum prepared by the International Bureau*

### I. Organizational and Procedural Matters

1. At the session of the Standing Committee on the Law of Patents (SCP), held from April 12 to 23, 1999, a decision was taken, based on a proposal of one delegation supported by 10 delegations, that the report should be adopted at the end of the meeting, as at the meetings of the former Committees of Experts. This procedure was followed at that session of the SCP, which had been scheduled as a two-week meeting, and the report was adopted on Friday, April 23.

2. If the SCT decides, as had been done by the SCP, that it would change its procedure to adopt the report at the end of the session, the International Bureau would suggest that the following procedure be followed:

(i) Substantive discussions would be terminated as of Thursday afternoon, to allow time for drafting of the Report and translation into the three languages for distribution on early Saturday afternoon;

(ii) A report adoption session would be held on Saturday afternoon, for adoption of the Final Report (the dates of the present meeting include Saturday, June 12, so that the new procedure could, if adopted, be followed at the present meeting);

(iii) Since the Final Report would be adopted at the end of the session, there would be no need for a Brief Summary by the Chair; consequently, item 7 of the Agenda would be amended to read “Adoption of the Report.”

3. The consequence of this procedure is that the SCT would have four, rather than five, days available during a one-week meeting for substantive discussion.

## II. Issues to be considered by the Standing Committee

4. At its second session, first part, which took place in Geneva from March 15 to 17, 1999, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) decided that there would be an item on the agenda for the second session, second part, to discuss future work concerning geographical indications and other issues before the SCT (see the Summary by the Chair, document SCT/2/4, paragraph 8). The present document reviews the status of the issues to be considered by the SCT as set out in document SCT/1/2, and in document SCT/1/6, paragraphs 21 to 31.

### Provisions on Well-Known Marks

5. The SCT extensively discussed a set of draft provisions on the protection of well-known marks. At the second session, first part, of the SCT (March 15 to 17, 1999), the text of a draft joint resolution and of five out of six draft articles was adopted. The text of that joint resolution and the five draft articles is now before the Standing Committee for consideration of the accuracy of the redraft, on the understanding that they will not be reopened for substantive discussion. The text of the draft provisions is presented to the SCT for formal adoption and for submission to a joint session of the Assembly of the Paris Union and the WIPO General Assembly. A revised version of Article 6 will be discussed at the present session. A final decision as to whether this revised Article, without any further substantive amendment, will be recommended to the Assembly of the Paris Union and the WIPO General Assembly for adoption, or whether it will be omitted from the proposed Joint Resolution, will be taken.

6. In this respect, it is to be noted that the WIPO Report on “The Management of Internet Names and Addresses: Intellectual Property Issues” has been recently released and is now available on the WIPO web site: <http://wipo2.wipo.int>. Chapter 4 of the Report deals with the problem of notoriety regarding famous and well-known marks.

### Trademark Licensing

7. In February 1997, the Committee of Experts on Trademark Licenses discussed a memorandum, prepared by the International Bureau, dealing with the simplification and harmonization of formalities concerning the recordal of licenses for the use of marks, as well

as questions concerning the indication of licenses on products and their packaging or in connection with the providing of services or in advertising (documents TML/CE/I/2 and 3).

8. The recordal of a license being an administrative procedure relating to the registration of a mark, it was envisaged that it should be linked to the subject matter of the TLT which provides for the maximum requirements concerning application for registration and requests for the recordal of certain matters relating to an application or registration.

9. Five draft articles on Trademark Licenses as well as a Model International Form concerning the presentation of a request for the recordal of a trademark license, were discussed at the First session of the Committee of Experts on Trademark Licenses (February, 17 to 20, 1997). These draft articles were prepared by the International Bureau in the same treaty language as the TLT and do not repeat the provisions concerning formalities already contained in the TLT.

10. Since simplification of the formalities concerning the recordal of licenses should have been included in the TLT, it was proposed (document TML/CE/I/2) that the relevant provisions should be adopted in the form of a Protocol to the TLT. The adoption of such a protocol will necessitate the holding of a diplomatic conference, which could also approach other issues to be determined by the SCT.

11. At the first part of its second session, the SCT agreed that trademark licenses should be included on the agenda for the third session.

#### Trademarks and the Internet

12. At its first session, the SCT requested that the International Bureau prepare a study concerning the use of trademarks on the Internet, for discussion at the second part of the second session.

13. The SCT is invited to consider the said Study (document SCT/2/9) as well as a Summary of the Study and Possible Principles for Discussion (document SCT/2/10) under point 6 of the agenda of the second part of its second session.

#### Geographical Indications

14. In preparation of the first session of the SCT, it was proposed that WIPO prepare a study on the desirability and feasibility of establishing guiding principles on topical issues concerning the protection of geographical indications including

- (i) the definition of the subject matter to be protected;
- (ii) whether protection should be based on registration and, if so, the desirable essential features of the registration procedures (including the extent to which applications for registration should be examined); and
- (iii) possible solutions for conflicts between geographical indications and trademarks.

15. The result of that study would be presented to a future session of the SCT, which would then decide on any possible further action. Possible actions could include, for example, the preparation of a new model law on geographical indications, taking into account the relevant provisions of the TRIPS Agreement. The SCT agreed that the issue of protection of geographical indications would be revisited at its second session, second part.

In the meantime, the International Bureau has initiated the preparatory work for the organization of a worldwide symposium on the protection of geographical indications, to be held in the last quarter of 1999.

Trademarks and International Nonproprietary Names for Pharmaceutical Substances (INNs)

16. Following recent consultations between the World Health Organization (WHO) and WIPO concerning the protection of International Nonproprietary Names for Pharmaceutical Substances (INNs) against their appropriation through registration as trademarks, the SCT has added this subject to the list of issues which it is going to consider. It is recalled that the underlying reason for ensuring that proprietary rights, including trademarks, cannot be claimed in INNs is to protect the safety of patients by allowing them to identify a specific pharmaceutical substance under one single, globally available name. In this context, WHO has approached WIPO to explore possible ways of cooperation between the two Organizations in order to ensure that INNs are not misused or appropriated through registration as trademarks (for more details, see document SCT/1/2, paragraphs 33 to 36).

17. The SCT agreed that the International Bureau would conduct a survey among its Member States concerning trademark office practice as regards the examination of applications for trademark registrations as to conflicts with proposed or recommended INN(s). Preparations for the conducting of that survey are under way, and the results of that survey will be presented to the SCT at its third session.

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