

WIPO



SCT/16/8

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Sixteenth Session
Geneva, November 13 to 17, 2006

SUMMARY BY THE CHAIR

Agenda Item 1: Opening of the Session

1. Mr. Ernesto Rubio, Assistant Director General of the World Intellectual Property Organization (WIPO), opened the session and welcomed the delegates on behalf of the Director General of WIPO.

Agenda Item 2: Election of a Chair and two Vice-Chairs

2. Mr. Michael Arblaster (Australia) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT). Mr. Maximiliano Santa Cruz (Chile) and Mrs. Karima Farah (Morocco) were elected as Vice-Chairs.

Agenda Item 3: Adoption of the Agenda

3. The SCT adopted the Draft Agenda (document SCT/16/1 Prov.2) without modifications.

Agenda Item 4: Adoption of the Draft Report of the Fifteenth Session

4. The SCT adopted the Draft Report (document SCT/15/5 Prov.2) without modifications.

Agenda Item 5: Trademarks

Questionnaire on Trademark Law and Practice

5. The SCT took note of document WIPO/Strad/INF/1.
6. The Chair concluded that this document would be updated periodically on the basis of information provided by SCT Members.

New Types of Marks

7. Discussion was based on document SCT/16/2.
8. In relation to new types of marks, the SCT agreed to build upon document SCT/16/2 by undertaking further work in two areas:
- the representation and description of these signs; and
 - the application of trademark principles to them.
9. The SCT agreed that it would ask the Secretariat to develop two papers for discussion at the next session based on submissions from SCT Members (to be submitted to the Secretariat by January 7, 2007):
- a paper setting out existing methods of representation and description of new types of marks in SCT Members, identifying where there are areas of convergence and any issues raised including the possibility of additional costs, particularly in developing countries;
 - a paper exploring in greater detail the relation of established trademark principles to new types of marks. All principles including, *inter alia*, functionality, specialty and distinctiveness would be considered, as well as issues of public interest, including safeguarding the public domain.

Marks and International Nonproprietary Names for Pharmaceutical Substances (INNs)

10. Discussion was based on document SCT/16/3.
11. The Committee approved the proposals outlined in paragraphs 9 to 11 of document SCT/16/3.

Trademark Opposition Procedures

12. Discussion was based on document SCT/16/4.
13. The Committee agreed to ask the Secretariat to prepare a working document on trademark opposition procedures for discussion at the next session, based on submissions by SCT Members (to be submitted to the Secretariat by January 7, 2007), to facilitate an exchange of information in order to identify key learnings.
14. Submissions would focus on providing information about opposition procedures, grounds of opposition, SCT Members' experience with pre-registration or post-registration opposition, and on a discussion of the relationship between a particular type of examination system and the related opposition procedure.

Trademarks and Their Relation With Literary and Artistic Works

15. Discussion was based on document SCT/16/5.
16. The SCT agreed to ask the Secretariat to develop a paper for consideration by the SCT at its eighteenth session, based, *inter alia*, on submissions by SCT Members (to be submitted to the Secretariat by the end of April 2007), providing an overview of jurisprudence on the overlap between copyright and trademarks, including new types of marks, with a particular focus on identifying existing and potential problems.

Article 6ter of the Paris Convention

17. Discussion was based on document SCT/15/3.
18. The SCT agreed to request the Secretariat to prepare a working document for consideration by the SCT at the next session, dealing with certain procedural aspects of Article 6ter communications, in particular:
 - information on the nature of goods and services on which official signs and hallmarks indicating control and warranty are used;
 - information concerning the constituting charter or agreement of international intergovernmental organizations availing themselves of Article 6ter(1)(b);
 - relevant contact details concerning a party requesting a communication under Article 6ter;
 - ways of making the content of Article 6ter notifications available through means of electronic communication; and
 - draft forms for requesting communications.

19. The Committee noted that there were still some areas where clarification would be beneficial, namely:

- clarification of eligible subject matter;
- duration of protection (term);
- grounds of refusal;
- effect of prior trademark rights;
- role of the International Bureau as intermediary;
- procedure for withdrawal of a communication;
- clear understanding of the status of the database.

20. The Committee agreed to request the Secretariat to provide further information about these issues as a second part of the paper being prepared on Article 6ter for the next session.

Communication from the Permanent Mission of Brazil

21. Discussion was based on document SCT/16/7.

22. The Committee noted the “Non-Exhaustive List of Customary Names Used in Brazil Associated with Biodiversity”, presented by the Delegation of Brazil. The Committee thanked that Delegation for the substantial work done and for bringing this list to the Committee’s attention.

23. The Committee also agreed that the Secretariat would maintain that list as an SCT paper, adding material submitted by other delegations.

Agenda Item 6: Industrial Designs

Formalities Concerning Procedures for Design Registration

24. Discussion was based on document SCT/16/6.

25. The Committee agreed to an exchange of information with a view towards promoting better understanding of the various systems. In order to do this the Committee requested the Secretariat to develop a questionnaire relating to the formalities of industrial design registration, for consideration at the next session.

Industrial Designs and Their Relation with Works of Applied Art and Three-Dimensional Marks

26. Discussion was based on document SCT/9/6.
27. The SCT requested the Secretariat to expand the draft questionnaire in order to further explore the borderlines between all types of marks and industrial designs.
28. The SCT further requested the Secretariat to expand and update document SCT/9/6 for consideration by the SCT at its eighteenth session in response to:
- submissions from SCT Members (to be submitted to the Secretariat by the end of April 2007) wanting areas to be dealt with in greater detail, including the relationship between industrial designs and certain expressions of traditional knowledge, such as works of handicraft;
 - submissions from SCT Members (to be submitted to the Secretariat by the end of April 2007) concerning areas where the paper no longer corresponded with their law; and
 - answers to the expanded questionnaire.

Agenda Item 7: Geographical Indications

29. The Chair noted that there were no working documents or proposals for discussion at this meeting.
30. The Committee agreed that this item would remain on the agenda as one of the three standing items, i.e., trademarks, industrial designs and geographical indications.

Seventeenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/17)

31. The Chair announced as tentative dates for SCT/17, May 7 to 11, 2007.

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