

# WIPO



SCT/17/7

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

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

Seventeenth Session  
Geneva, May 7 to 11, 2007

### SUMMARY BY THE CHAIR

#### Agenda Item 1: Opening of the Session

1. Mr. Ernesto Rubio, Assistant Director General, opened the session and welcomed the participants on behalf of the Director General of WIPO.
2. Mr. Marcus Höpferger (WIPO) acted as Secretary to the Standing Committee.

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

3. Mr. Michael Arblaster (Australia) was elected as Chair of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) for the year 2007. Mr. Maximiliano Santa Cruz (Chile) and Mr. Louis Chan (Singapore) were elected as Vice-Chairs for the same period.

#### Agenda Item 3: Adoption of the Agenda

4. The SCT adopted the Draft Agenda (document SCT/17/1 Prov.) without modifications.

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

5. The SCT adopted the Draft Report of the Sixteenth Session (document SCT/16/9 Prov.2) with modifications as requested by the Delegations of Brazil, France, Italy, the Russian Federation, Sweden and the Representative of the African Intellectual Property Organization (OAPI).

Agenda Item 5: Trademarks

*Methods of Representation and Description of New Types of Marks*

6. The Chair concluded that the SCT had considered certain portions of document SCT/17/2 namely those relating to three-dimensional marks, color marks, and sound marks. The SCT noted that nothing in the document or the subsequent discussion implied an obligation on any Member to protect any type of mark.

7. The SCT requested the Secretariat to prepare a working document for consideration at its 18<sup>th</sup> session, taking into account the deliberations of the present session and presenting key learnings for Member States in relation to the representation of those types of marks that the SCT had considered during the 17<sup>th</sup> session. As regards the portions of document SCT/17/2 that could not be dealt with during the present session, the SCT would resume work at the 18<sup>th</sup> session.

8. The Committee further agreed to invite delegations that had not yet done so to make submissions on those subjects by the end of June 2007, at the latest.

*Relation of Established Trademark Principles to New Types of Marks*

9. The Chair concluded that the discussion of document SCT/17/3 was postponed to the 18<sup>th</sup> session of the SCT.

*Trademark Opposition Procedures*

10. Discussion was based on document SCT/17/4.

11. The Committee noted that document SCT/17/4 was designed as a basis for discussion and provided a broad overview of the key features of the different types of opposition procedures. To the extent that the document identified the approach in specific jurisdictions, it was purely illustrative and was not intended to serve as a comprehensive or authoritative guide.

12. The Committee noted that the additional information provided during the meeting would be reflected in the report, and accordingly decided not to revise the document.

13. The SCT requested the Secretariat to draft a new document for the next meeting setting out key learnings in this field. The first draft of this document would be drawn from:

- submissions already received;
- the report of the current session;
- and any further submissions from SCT Members specifically addressing the issue of key learnings.

14. The SCT further requested the Secretariat to provide a draft of the document which would be posted on the SCT Electronic Forum by August 11, 2007, seeking comments from Member States to be used for the final version of that document.

*Article 6ter of the Paris Convention*

15. Discussion was based on document SCT/17/5.

Relevant Contact Details Concerning the Requesting Party

16. The SCT recommended that contact details be provided as part of the communication under Article 6ter(3)(a) and (b) in order to enable offices and third parties to contact the beneficiary of protection.

17. With regard to existing communications, the SCT requested the Secretariat to invite States and International Intergovernmental Organizations (“IGOs”) to provide contact details for the sake of completeness.

Information Concerning the Constituting Charter or Agreement of International Intergovernmental Organizations

18. The SCT recommended that the communications from IGOs should contain a reference to a website where the constituting agreement or charter of a given IGO could be accessed. This information could also be obtained by requesting it from the International Bureau which would provide it, for example, in paper form or PDF format.

Information on the Nature of Goods and Services on Which Official Signs and Hallmarks are Used

19. The SCT recommended that an indication of the goods and services should be a standard requirement for communications in relation to official signs and hallmarks indicating control and warranty.

### Electronic Communication

20. The SCT noted that the existing paper-based communication procedure should not be replaced by electronic means of communication. However, the Committee agreed to ask the Secretariat to implement the option outlined in paragraph 25 of document SCT/17/5 (i.e., individual download from FTP server), it being understood that this would allow Contracting Parties to the Paris Convention to download this information monthly.

### Review of Existing Communications

21. The SCT recommended that each Member of the Paris Union undertake, when resources permit, a review of the signs communicated on behalf of that Member, in order to determine whether protection is still required or if any details needed to be updated.

### Draft Requests

22. The SCT expressed agreement with Annexes I to III of document SCT/17/5 with the following changes:

– The request for the communication of official signs and hallmarks indicating control and warranty should include a reference to the enclosed list of goods and services to which that official sign or hallmark pertains.

– The enclosure should contain contact details of the requesting party.

23. Furthermore, the SCT requested the Secretariat to prepare a document for the 18<sup>th</sup> session of the SCT containing a status report on the implementation of the recommendations concerning Article 6<sup>ter</sup> agreed at the current session, including, where necessary, a proposal for decision by the Paris Union Assembly.

### Agenda Item 6: Industrial Designs

#### *Questionnaire Relating to Formalities of Industrial Design Registration*

24. Discussion was based on document SCT/17/6.

25. Following an extended exchange of views, the SCT requested the Secretariat to modify the questionnaire according to the proposals made by Members of the Committee.

26. The SCT agreed that the revised questionnaire would be distributed to Members as soon as possible. Replies to the questionnaire should be provided to the Secretariat by November 2, 2007. The Secretariat would present a document based on these replies to the 19<sup>th</sup> session of the SCT in May 2008.

27. The SCT further agreed that Members would provide additional questions to the Secretariat for inclusion in a second questionnaire dealing with substantive issues such as those suggested by the Delegations of Japan and Slovenia, and the issues relating to the borderline between industrial designs and other intellectual property rights, in particular copyright. Questions should be provided to the Secretariat by the end of June. The Secretariat would present the second questionnaire to the 18<sup>th</sup> session of the SCT with a view to having the results of both questionnaires available at the 19<sup>th</sup> session.

Agenda Item 7: Geographical Indications

28. The Chair noted that there were no working documents or proposals for discussion at this meeting.

*Eighteenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/18)*

29. The Chair announced as tentative dates for SCT/18, November 12 to 16, 2007.

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