

WIPO



SCT/2/5

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

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

Second Session, First Part
Geneva, March 15 to 17, 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, first part, in Geneva from March 15 to 17, 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, Andorra, Argentina, Armenia, Australia, Austria, Belgium, Benin, Brazil, Bulgaria, Canada, Chile, China, Côte d’Ivoire, Croatia, Czech Republic, Democratic People’s Republic of Korea, Denmark, Ecuador, Estonia, Ethiopia, Finland, France, Georgia, Germany, Greece, Guatemala, Hungary, India, Indonesia, Iran (Islamic Republic of), Israel, Italy, Japan, Jordan, Kazakhstan, Kenya, Lao (People’s Democratic Republic), Latvia, Lithuania, Mexico, Morocco, Nepal, Netherlands, Nigeria, Norway, Philippines, Poland, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Senegal, Slovakia, Slovenia, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Turkmenistan, Turkey, Ukraine, United Kingdom,

* Subject to adoption at the second session, second part, of the SCT. Following comments received on the Draft Report (document SCT/2/5 Prov.), paragraph 67 was modified.

United States of America, Uruguay, Venezuela, Vietnam, Yemen (71). The European Communities were also represented.

3. The following intergovernmental organizations took part in the meeting in an observer capacity: Organization of African Unity (OAU), Benelux Trademark Office (BBM).
4. Representatives of the following international non-governmental organizations took part in the meeting in an observer capacity: American Intellectual Property Law Association (AIPLA), Asian Patent Attorneys Association (APAA), Association of European Trade Mark Owners (MARQUES), European Brands Association (AIM), 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), Max-Planck-Institut (MPI), Union of European Practitioners in Industrial Property (UEPIP), Union of Industrial and Employers' Confederations of Europe (UNICE) (16).
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/2/1), "Rules of Procedure" (document SCT/2/2) and "Draft Provisions on the Protection of Well-Known Marks" (document SCT/2/3).
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 Mr. Albert Tramposch, Director, Industrial Property Law Division, who welcomed the participants.

Agenda Item 2: Rules of Procedure

9. The Standing Committee adopted the two special rules of procedure proposed in document SCT/2/2.

Agenda Item 3: Election of a Chair and two Vice-Chairs

10. The Standing Committee unanimously elected Ms. Lynne G. Beresford (United States of America) as Chair, and Mr. Knud Wallberg (Denmark) and Mrs. Graciela Road D'Imperio (Uruguay) as Vice-Chairs, for terms consisting of the calendar year 1999. Mr. Albert Tramposch (WIPO) acted as Secretary to the Standing Committee.

Agenda Item 4: Adoption of the Agenda

11. The Agenda (document SCT/2/1) was adopted without modification.

Agenda Item 5: Adoption of the Report of the First Session

12. The Report of the first session of the SCT (document SCT/1/6) was adopted, with the addition of a new sentence in paragraph (48), to be located after the first sentence, stating that the Delegations of Chile and Spain agreed in every respect with the position of the Delegation of Canada.

13. The SCT approved the suggestion of the International Bureau that the procedure for circulation of the draft Report for the present session be the same as for the first session, in particular, that the English version of the draft Report would be circulated on the Electronic Forum when it was completed, that the French and Spanish versions would be circulated on the Electronic Forum when they were completed, and that the deadline for submission of comments would be two weeks after the date of circulation of the French and Spanish versions of the Report.

Miscellaneous

14. The Delegation of Japan presented information concerning a new retrieval service for well-known marks operated by the Japanese Patent Office via the Internet. The purpose of that retrieval service was to make publicly available information concerning Japanese well-known trademarks which were either registered as defensive marks in Japan or which were found to be well-known marks by the Japanese Patent Office's appeal system or by Japanese courts. So far, the retrieval system contained several hundred well-known trademarks. The Delegation of Japan expressed its hope that the system would be widely used.

Agenda Item 6: Draft Provisions on Well-Known Marks

15. The Standing Committee discussed the draft provisions on the protection of well-known marks contained in document SCT/2/3.

Resolution

16. The International Bureau pointed out that while the present document suggested a resolution to be adopted by the General Assembly of the World Intellectual Property Organization, it would be preferable to adopt a joint resolution by the General Assembly of the World Intellectual Property Organization and the Assembly of the Paris Union. It explained that the scope of the joint resolution was limited to those Member States of the Paris Union and WIPO which were bound to protect well-known marks either under the Paris

Convention or the TRIPS Agreement. The intention of that limitation was to avoid the circumstance that countries which were actually not under an international obligation to protect well-known marks would be addressed by a resolution recommending application of the most advanced international standards in that area.

17. As regards the notes accompanying the provisions, the International Bureau stated that those notes would not be adopted by the Assembly of the Paris Union and the WIPO General Assembly. Rather, the notes would constitute an explanatory document prepared by the International Bureau, so that, in cases of conflict between the provisions and the notes, the provisions would prevail.

18. Three delegations and the representative of one observer organization supported the suggestion to adopt the draft provisions in the form of a joint resolution of the WIPO General Assembly and the Assembly of the Paris Union.

19. One delegation proposed to establish a procedure for reviewing the implementation, by Member States, of the Joint Resolution. In particular, it suggested that a review on a regular basis of implementation of the draft provisions would be helpful, and suggested that training programs and seminars be held.

20. In reply to two delegations who expressed their concern about any proposed review of the implementation of the draft provisions, the International Bureau explained that any such follow-up activity, including a review of the implementation of the provisions, would be of a solely informational nature, and would merely provide an opportunity for Member States to give and receive feed-back as regards the application of the draft provisions. In particular, it was pointed out that the resolution did not contain any obligation to implement the provisions.

21. One delegation asked whether there was any precedent concerning resolutions adopted by the WIPO General Assembly or the Paris Union, recommending substantive principles. In reply to that delegation, the International Bureau said that the Assembly of the Paris Union had adopted, in 1992, guidelines concerning the interpretation of Article 6*ter* of the Paris Convention (documents P/A/XIX/1 and 4), and that the WIPO General Assembly had adopted, in 1995, a resolution concerning the implementation of the cooperation Agreement between the World Trade Organization and WIPO (document WO/GA/XVI/7). The latter was accompanied by a Resolution of the Assembly of the Paris Union concerning interpretation of Article 6*ter* in the context of the cooperation Agreement (documents P/A/XXIV/1 and 2).

22. The representative of the European Communities stated that, while he supported the draft Resolution in principle, he suggested that the wording of the resolution be amended to take into account procedures within the European Communities with respect to recommendations.

23. In conclusion, it was agreed that the Resolution would be adopted with the following wording:

“Joint Resolution

The Assembly of the Paris Union, and the General Assembly of the World Intellectual Property Organization (WIPO),

Recognizing that protection for well-known marks must be provided, under the Paris Convention for the Protection of Industrial Property, and under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), by Member States of the Paris Union and of WIPO that are bound to apply the relevant provisions of those treaties, and by certain intergovernmental organizations;

Recommends, to each such Member State to protect well-known marks in accordance with the provisions contained herein;

Recommends, to each Member State of the Paris Union or of WIPO, which is also a member of an intergovernmental organization that has competence in the area of trademarks, to bring to the attention of that organization the possibility of protecting well-known marks in accordance, *mutatis mutandis*, with the provisions contained herein.”

Draft Article 1: Definitions

24. *Item (i)*. This item was adopted as proposed, subject to redrafting for taking into account the fact that the draft provisions will be adopted in the form of a Joint Resolution of the WIPO General Assembly and the Assembly of the Paris Union.
25. *Item (ii)*. This item was adopted as proposed.
26. *Item (iii)*. After some discussion it was decided to adopt this item, subject to replacing the word “responsible” with the word “competent.” One delegation suggested that the notes could state that a competent authority was meant to refer to competence for the enforcement of well-known marks against conflicting marks, business identifier and domain names.
27. *Item (iv)*. It was pointed out that, since the resolution would not directly address intergovernmental organizations, the term “territory” was not needed in the draft provisions. As a consequence, it was decided that this item would be deleted, and that the term “territory” would be deleted throughout the draft provisions, with the appropriate consequential changes.
28. *Item (v)*. This provision was adopted as proposed.
29. *Item (vi)*. This provision was adopted as proposed.
30. *Note 1.5*. One delegation was of the opinion that the example for a domain name given at the end of note 1.5 was not correct and should therefore be deleted. The International Bureau replied that the example used (“wipo.int”) was composed of a second level domain name and a top level domain name, and that it was therefore a valid example of a domain name. The International Bureau further explained that a third level domain name or a sub-directory within a unified resource locator (URL) was not covered by the definition of

domain name, because those were aspects of a URL which did not depend on registration, but could be chosen by the user. Cases of conflicts between well-known marks and third level domain names or sub-directories would therefore be covered by Article 4 and not by Article 6.

Draft Article 2: Determination of Whether a Mark is a Well-Known Mark in a Territory of a Member State.

31. *Paragraph (1)(a).* One delegation declared that the words “any circumstances” would need clarification. Another delegation suggested to use the term “factor” instead of “circumstance.” A number of delegations and the representative of one observer organization supported the text as proposed. In particular, it was pointed out that the word “circumstances” was broader in its scope than the word “information” or the word “factor,” and that it should therefore be kept in the text. In conclusion, paragraph (1)(a) was adopted as proposed.

32. One delegation stated that, since Article 2(1)(a) referred to any circumstance, the wording of note 2.2 would have to be amended accordingly, in particular, the term “evidence” would have to be changed.

33. *Paragraph (1)(b).* This sub-paragraph was adopted as proposed. It was decided to keep, in note 2.6, the reference to use of the mark on the Internet.

34. *Paragraph (1)(c).* The Delegations of China and Brazil declared that, while they could support this sub-paragraph in principle, they had concerns about the inclusion of the case where none of the factors enumerated in Article 2(1)(b) would be relevant.

35. A number of representatives of observer organizations supported the proposed text. It was pointed out by those representatives that Article 2(1) did not constitute a checklist of exhaustive character which had to be complied with, but was merely of an illustrative nature.

36. In conclusion, the following wording for the second part of Article 2(1)(c) was adopted:

“In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors listed may be relevant, and the decision may be based on additional factors that are not listed in sub-paragraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in sub-paragraph (b), above.”

37. *Paragraph (2)(a).* This paragraph was adopted as proposed.

38. In reply to one delegation, the International Bureau explained that items (i), (ii) and (iii) in paragraph (2)(a) were of an illustrative nature, as expressed by the words “shall include, but shall not necessary be limited to,” and that note 2.12 would be amended in order to make that point clear.

39. *Paragraph (2)(b).* This paragraph was adopted as proposed.

40. The Delegation of the United States declared that it withdrew the reservation which it had previously expressed with regard to Article 2(2)(b), and said that it now supported the text as it was proposed.

41. The Delegation of Sweden opposed the drafting of Article 2(2)(a) and (b), on the grounds that each of the items would constitute a separate relevant sector of the public.

42. *Paragraph (2)(c)*. This sub-paragraph was adopted with the square brackets removed, subject to the replacement, in the Spanish text, of the words “será considerada” by the words “podría ser considerada.”

43. *Paragraph (2)(d)*. This sub-paragraph was adopted with the square brackets removed, and the text within square brackets retained.

44. The Delegation of Mexico declared that it did not support Article 2(2)(d), since under its national law, a mark had to be known by Mexican nationals in order to be considered to be well known. In reply to that Delegation, the Chair pointed out that Article 2(2)(d) was not an obligatory provision, and that a Member State would be permitted, but would not be required, to protect a mark as a well-known mark even if the mark was not well-known in that State.

45. *Paragraph (3)(a)*. This sub-paragraph was adopted as proposed, subject to the replacement, in item (ii), of the words “any territory other than the territory of the Member State” by the words “any jurisdiction other than the Member State.”

46. The Delegation of Canada stated that it had reconsidered its position since the last meeting of the SCT, and that it could now accept that the rights of owners of well-known marks should be protected regardless of whether those well-known marks were registered or not. However, it retained its reservations concerning certain provisions of Article 4, which would be discussed later.

47. The Delegation of Uruguay reserved its position regarding Article 2(3)(a), since its national legislation did not provide for the protection of well-known marks without registration, or without the filing of an application for registration of the presumed well-known mark.

48. *Paragraph (3)(b)*. This sub-paragraph was adopted as proposed, subject to the replacement of the words "in one or more territories other than the territory of the Member State" by the words "in one or more jurisdictions other than the Member State."

Draft Article 3: Protection of Well-Known Marks; Bad Faith

49. *Paragraph (1)*. This paragraph was adopted as proposed.

50. *Paragraph (2)*. One delegation declared that it would prefer the use of the wording of the Paris Convention relating to “unfair” practices instead of “bad faith.” Various delegations, as well as a representative of an intergovernmental organization and a representative of an observer organization, supported the term “bad faith” which is explicitly mentioned in Article 6bis(3) of the Paris Convention. One delegation, endorsed by a representative of an

intergovernmental organization, considered this paragraph redundant in light of the provisions in Articles 4 and 5, and was concerned that the provision could be interpreted to require bad faith as a condition for determining that a mark is a well-known mark. It was agreed to clarify the latter point in the notes. The paragraph was adopted as proposed, subject to changing the words “this Part” to “Part II of these provisions.”

Draft Article 4: Conflicting Marks

51. *Paragraph (1)(a)*. This paragraph was adopted as proposed.
52. *Paragraph (1)(b)*. The introductory words of this paragraph were adopted as proposed.
53. The Delegation of Spain declared that, in its opinion, the protection provided for well-known marks under Article 4(1)(b) should be dependent on the registration of the well-known mark, and that it therefore opposed that provision.
54. *Item (i)*. This item was adopted as proposed.
55. *Items (ii) and (iii)*. These items were the subject of an extended debate. A number of delegations said that they were opposed to those items as they were presented because, in the opinion of those delegations, the protection provided for well-known marks under those items was too broad. Other delegations and the representatives of a number of observer organizations supported the text as it was proposed.
56. In conclusion, items (ii) and (iii) were adopted as proposed, subject to the addition of a new sub-paragraph (*bbis*), based on a joint suggestion of the Representatives of AIPPI and INTA, which would be worded as follows:

“(bbis) Notwithstanding Article 2(3)(a)(iii), for the purpose of applying sub-paragraph (b)(ii) and (iii), a Member State may require that the well-known mark be well known to the public at large.”

57. The Delegations of Brazil and Argentina declared that, before they could state their final position on this provision, they would have to consult the authorities in their capitals.
58. In reply to the question of one delegation, the International Bureau explained that it was not intended that the draft provisions would deal with conflicts between well-known marks and protected geographical indications or appellations of origin, and that this would be reflected in the notes. The notes would also emphasize that the provisions were a minimum standard.
59. *Paragraph (1)(c)*. The discussion of this sub-paragraph was based on the following redraft presented by the International Bureau:

“(c) Notwithstanding paragraphs (2) to (4), a Member State shall not be required to apply:

(i) paragraph (a) to determine whether a mark is in conflict with a well-known mark, if the mark was used or registered, or an application for its registration was filed, in or in respect of the Member State, in respect of goods and/or services which are identical or similar to the goods and/or services to which the well-known mark applies, before the well-known mark became well known in the Member State;

(ii) paragraph (b) to determine whether a mark is in conflict with a well-known mark, to the extent that mark was used, was the subject of an application for registration, or was registered, in or in respect of the Member State for particular goods and/or services, before the well-known mark became well known in the Member State;

except where the mark has been used or registered, or the application for its registration has been filed, in bad faith.”

60. The sub-paragraph was adopted as presented in the preceding paragraph.

61. It was noted that, in the Spanish text, items (i) and (ii) would have to be aligned in order to correspond to the English text.

62. *Paragraph (2)*. This paragraph was adopted as proposed. It was agreed that the notes would clarify that, in proceedings referred to in this and the subsequent paragraph, a Member State would apply the substantive rules under its own law.

63. *Paragraph (3)*. The Delegations of Japan and the Republic of Korea suggested that the time period which was allowed for initiating invalidation procedures should be counted from the date of registration rather than the date of publication of the trademark, thereby using the same method as set out in the Paris Convention. The representative of an observer organization pointed out that this caused practical difficulties in cases where there was a delay in publication of registration.

64. The Chair pointed out that the calculation of the time limit as of the date of publication of the registration seemed to be the most equitable solution, since this was the earliest time as of which the owner of a well-known mark could obtain knowledge of registration of a conflicting mark.

65. The Delegation of Canada proposed to replace the Latin words “ex-officio” in sub-paragraph (b) by the words “on its own initiative.”

66. The Delegation of the Philippines declared that it could not support the period provided for in sub-paragraph (3)(a), since under the law of its country an action for invalidation of the registration was prescribed after a five-year period.

67. 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):

“(3) [*Invalidation Procedures*] (a) The owner of a well-known mark shall be entitled to request, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the Office, the invalidation, by a decision of the competent authority, of the registration of a mark which is in conflict with the well-known mark.

(b) If the registration of a mark may be invalidated by a competent authority on its own initiative, a conflict with a well-known mark shall, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the Office, be a ground for such invalidation.”

68. *Paragraph (4)*. This paragraph was adapted as proposed, subject to the addition of the word “beginning” after the words “five years.”

69. It was agreed that the notes accompanying this provision would point out that the question of whether knowledge by a licensee of the use of a conflicting mark was attributable to the owner of the well-known mark would be dealt with under national law.

70. *Paragraph (5)*. Discussion of this paragraph was based on a redraft prepared by the International Bureau, in which the paragraph would be divided into two paragraphs, of which paragraph (5) would read as follows:

“(5) [*No Time Limit in Case of Registration or Use in Bad Faith*]

(a) Notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well-known mark if the conflicting mark was registered in bad faith.

(b) Notwithstanding paragraph (4), a Member State may not prescribe any time limit for requesting the prohibition of the use of a mark which is in conflict with a well-known mark if the conflicting mark was used in bad faith.

(c) In determining bad faith for the purposes of this paragraph, the competent authority shall take into consideration whether the person who obtained the registration of or used the mark which is in conflict with a well-known mark had, at the time when the mark was used or registered, or the application for its registration was filed, knowledge of, or reason to know of, the well-known mark.”

71. The text of paragraph (5) was adopted as reproduced in the preceding paragraph.

72. It was pointed out that, in the French text of sub-paragraph (5)(c), the words “ou du dépôt d’une demande d’enregistrement y relative” had to be added to conform to the English text.

73. With regard to note 4.12, it was agreed that the text of this note should be changed in order to reflect that sub-paragraph (5)(c) presented one possible criterion that could be used in order to determine bad faith, and was not the only applicable test for that purpose. The notes

would also reflect that the phrase “any time limit” in paragraphs (5)(a) and (b) referred to the time limit set out in paragraphs (3) and (4).

74. It was agreed that cases in which a mark could not be used because of *force majeure* should be dealt with under national law, in compliance with the existing international norms regulating that question.

75. *New Paragraph (6)*. After some discussion, new paragraph (6), which was suggested by the International Bureau based on part of former paragraph (5), was adopted as follows:

“(6) [No Time Limit in Case of Registration Without Use] Notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well known mark, if that mark was registered, but never used.”

76. The Delegation of Uruguay declared that it could not yet give its final approval to that paragraph.

77. The Delegation of the United Kingdom asked whether this provision would conflict with a provision under its national law allowing an owner to register a trademark without using it for a certain time. The International Bureau responded that paragraph (6) simply ensured that proceedings could be brought, but that existing national principles would be applied in those proceedings.

Draft Article 5: Conflicting Business Identifiers

78. The representatives of several observer organizations suggested that this Article could be accommodated into Article 4 with a re-wording of the latter Article.

79. *Paragraph (1)(a)*. The introductory words of this provision were adopted as proposed.

80. *Item (i)*. This item was adopted as proposed.

81. *Items (ii) and (iii)*. These items were adopted as proposed, subject to the addition of the following new sub-paragraph (*abis*) to paragraph (1)(a):

“(abis) Notwithstanding Article 2(3)(iii), for the purposes of applying paragraph (a)(ii) and (iii), a Member State may require that the well-known mark be well known to the public at large.”

82. The delegations of Brazil and Argentina declared that, before they could state their final position on this provision, they would have to consult the authorities in their capitals.

83. *Paragraph (1)(b)*. This provision was adopted with the same modifications as those adopted in Article 4, resulting in the following text:

“(b) A Member State shall not be required to apply paragraph (a) to determine whether a business identifier is in conflict with a well-known mark if that business

identifier was used or registered, or an application for its registration was filed, in or in respect of the Member State, before the well-known mark became well known in or in respect of the Member State, except where the business identifier was used or registered, or the application for its registration was filed, in bad faith.”

84. *Paragraph (2)*. It was agreed to delete this paragraph in its entirety.

85. *Paragraph (3)*. This paragraph was adopted as proposed, subject to addition of the word “beginning” after the words “five years.”

86. The Delegation of Argentina expressed a reservation as regards the adoption of this paragraph.

87. The Delegation of Brazil declared that it could not express any opinion on this paragraph and thus would reserve its position.

88. *Paragraph (4)*. In consequence of the omission of paragraph (2), text referring to cancellation of a business identifier was deleted from this paragraph. A redraft, suggested by the International Bureau, of the remaining text of the paragraph was adopted as follows:

“(4) [*No Time Limit in Case of Registration or Use in Bad Faith*]

(a) Notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the prohibition of the use of a business identifier which is in conflict with a well-known mark if the conflicting business identifier was used in bad faith.

(b) In determining bad faith for the purposes of this paragraph, the competent authority shall consider whether the person who obtained the registration of or used the business identifier which is in conflict with a well-known mark had, at the time when the business identifier was used or registered, or the application for its registration was filed, knowledge of, or reason to know of, the well-known mark.”

Draft Article 6: Conflicting Domain Names

89. The International Bureau made a presentation on the current status of the WIPO Domain Name Process.

90. A number of delegations were of the opinion that adoption of Article 6 was premature at this point in time, and that the subject needed further discussion within the SCT. In particular, questions relating to jurisdiction and applicable law needed to be answered before work could progress in that area. It was suggested by one delegation that the work should be put on hold until other relevant work in WIPO was completed.

91. A substantially equal number of delegations, and a number of representatives of observer organizations, supported adoption of the text as it was proposed. It was said by those delegations and representatives of observer organizations that the problem of misappropriation of well-known marks through unauthorized domain name registration was pressing and that international action was urgently needed. It was further pointed out that

omitting proposed Article 6 would send an erroneous message concerning the willingness of the international community to take firm action against acts of trademark piracy on the Internet.

92. After discussion and informal consultations, and based on the proposal of one delegation, supported by several other delegations, it was decided that the International Bureau would redraft Article 6 in order to limit its scope to protection of well-known marks against acts of domain grabbing or cybersquatting, as referred to in the final clause of paragraph (1)(a)(ii). The International Bureau would make a provisional redraft of Article 6 available on the SCT Electronic Forum for further comments and discussion, and the resulting text would be included in square brackets. It was further agreed that Article 6 would be discussed at the second session, second part, of the Standing Committee. At that meeting, the Standing Committee would take a final decision, without any further substantive amendment, whether it would recommend the redrafted Article 6 to the Assembly of the Paris Union and the WIPO General Assembly for adoption, or whether it would omit that Article from the proposed Joint Resolution.

Future work

93. The SCT agreed that the second part of the second session of the SCT would be held from June 7 to 11, in Geneva, and that the agenda would consist of two substantive items. The first item would be consideration of the accuracy of the redrafted provisions of Articles 1 to 5, based on the conclusion of the present meeting, on the understanding that they would not be reopened for substantive discussion; adoption of those Articles as a Proposed Joint Resolution concerning Provisions on the Protection of Well-Known Marks, to be submitted for adoption by the Paris Union Assembly and the WIPO General Assembly in September 1999; and the taking of a decision on whether to include Article 6, without substantive amendment, in the Proposed Joint Resolution. The second item would be a discussion concerning the use of trademarks on the Internet. In addition, there would be an item on the agenda to discuss future work concerning geographical indications and other issues currently before the SCT.

94. One delegation suggested that, in future meetings of the SCT, participants could informally meet during the second hour of the lunch break in order to exchange views on issues of common interest relating to industrial property. The International Bureau took note of that suggestion, and declared that the possibility of providing meeting rooms for those meetings would be studied.

Agenda Item 7: Brief summary by the Chair

95. The Chair presented a draft Summary (document SCT/2/4 Prov.) and received comments from the participants.

Agenda Item 8: Closing of the Session

96. The chair closed the second session, first part, of the Standing Committee.

[Annex follows]

ANNEXE I/ANNEX I

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États)
(in the alphabetical order of the names in French of the States)

ALGÉRIE/ALGERIA

Chems-Eddine ZELACI, Conseiller, Mission permanente, Genève

ALLEMAGNE/GERMANY

Jutta FIGGE (Mrs.), Counsellor, Trademark Division, Ministry of Justice, Berlin

Hans-Christian METTERNICH, Head, Trademark Division, German Patent and Trademark Office, Munich

ANDORRE/ANDORRA

Eusebi NOMEN, Advisor to the Governor for I.P., Ministry of the Presidency, Andorra La Vella

ARGENTINE/ARGENTINA

Marta GABRIELONI (Sra.), Consejero, Misión Permanente, Ginebra

ARMÉNIE/ARMENIA

Sarkis KHANTARDJIAN, President, Armenian Patent Office, Yerevan

AUSTRALIE/AUSTRALIA

Ross WILSON, Registrar of Trade Marks, IP Australia, Trade Marks Office, Woden ACT

Barbara BENNETT (Mrs.), Deputy Registrar of Trade Marks, IP Australia, Trade Marks Office, Woden ACT

AUTRICHE/AUSTRIA

Robert ULLRICH, Senior Legal Officer, Legal Division, Austrian Patent Office, Vienna

Ewald GLANTSCHNIG, Minister Counsellor, Permanent Mission, Geneva

BELGIQUE/BELGIUM

Monique PETIT (Mme), conseiller adjoint, Ministère des affaires économiques, office de la propriété industrielle, Bruxelles

BÉNIN/BENIN

Lola Juliette AYITÉ (Mme), directrice, Centre national de la propriété industrielle (CENAPI), Ministère de l'industrie et des petites et moyennes entreprises, Cotonou

BRÉSIL/BRAZIL

Luiz Cesar GASSER, Second Secretary, Permanent Mission, Geneva

Augusto Sergio DO ESPIRITO SANTO CARDOSO, Director for Trademarks, National Institute of Industrial Property, Ministry of Industry, Commerce and Tourism, Rio de Janeiro

Márcio Heidi SUGUIEDA, Specialist in Public Policy and Governmental Administration, Ministry of Development, Industry and Commerce, Brasilia

BULGARIE/BULGARIA

Chtiriana VALTCHANOVA-KRASTEVA (Mrs.), Legal Adviser, Disputes Department, Patent Office, Republic of Bulgaria, Sofia

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