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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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**STANDING COMMITTEE ON THE LAW OF TRADE MARKS,
INDUSTRIAL DESIGN AND GEOGRAPHICAL INDICATIONS**

Sixth Session
Geneva, March 12 to 16, 2001

REPORT

adopted by the Standing Committee

INTRODUCTION

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereinafter referred to as “the Standing Committee” or “the SCT”) held its sixth session, in Geneva, from March 12 to 16, 2001.

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, Australia, Austria, Bangladesh, Barbados, Bosnia and Herzegovina, Brazil, Brunei Darussalam, Bulgaria, Burkina Faso, Canada, Chad, Chile, China, Colombia, Costa Rica, Côte d’Ivoire, Croatia, Cuba, Czech Republic, Democratic People’s Republic of Korea, Denmark, Dominican Republic, Ecuador, Egypt, Estonia, Finland, France, Germany, Ghana, Greece, Guatemala, Guinea-Bissau, Hungary, India, Indonesia, Iran (Islamic Republic of), Iraq, Ireland, Italy, Japan, Jordan, Kenya, Kyrgyzstan, Latvia, Lebanon, Lithuania, Mauritius, Mexico, Morocco, Nepal, Netherlands, Nicaragua, Nigeria, Norway, Panama, Papua New Guinea, Peru, Philippines, Poland, Portugal, Qatar, Republic of Korea, Republic of Moldova, Romania, Russian Federation, Slovakia, Slovenia, Spain, Sri Lanka, Sudan, Sweden, Switzerland, Thailand, Tunisia, Turkey, Turkmenistan, United Kingdom, United States of America, Uruguay, Venezuela, Viet Nam (83). The European Communities were also represented in the capacity as member of the SCT.

3. The following intergovernmental organizations took part in the meeting in an observer capacity: African Intellectual Property Organization (AIPO), African Regional Industrial Property Organization (ARIPO), Benelux Trademark Office (BBM), International Vine and Wine Office (OIV), United Nations Conference on Trade and Development (UNCTAD), World Trade Organization (WTO) (6).

4. Representatives of the following international non-governmental organizations took part in the meeting in an observer capacity: American Bar Association (ABA), American Intellectual Property Law Association (AIPLA), European Brands Association (AIM), European Communities Trade Mark Association (ECTA), French Association of Practitioners in Trademark and Law Designs (APRAM), Institute of Intellectual Property (IIP), International Association for the Protection of Industrial Property (AIPPI), International Chamber of Commerce (ICC), International Federation of the Phonographic Industry (IFPI), International Federation of Industrial Property Attorneys (FICPI), International Trademark Association (INTA), International Wine Law Association (AIDV), Japan Intellectual Property Association (JIPA), Japan Patent Attorneys Association (JPAA), Japan Trademarks Association (JTA), Max-Planck-Institut für Foreign and International Patent, Copyright and Competition Law (MPI), World Association for Small and Medium Enterprises (WASME) (17).

5. The list of participants is contained in Annex I of this Report.

6. Discussions were based on the following documents prepared by the International Bureau of WIPO: "Agenda" (document SCT/6/1), "Draft Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet" (document SCT/6/2), "Geographical Indications: Historical Background, Nature of Rights, Existing Systems for Protection and Obtaining Effective Protection in Other Countries" (document SCT/6/3).

7. The Secretariat noted the interventions made and recorded them on tape. This report summarizes the discussions on the basis of all the observations made.

Agenda Item 1: Opening of the Session

8. The session was opened by Mr. Shozo Uemura, Deputy Director General, who welcomed the participants and gave a brief report on the recent WIPO Forum on Private International Law and Intellectual Property (January 30 - 31, 2001). Mr. Denis Croze (WIPO) acted as Secretary to the Standing Committee.

9. The SCT agreed that Ms. Lynn Beresford (USA), Chair of the previous sessions of the SCT should continue to preside over the discussion on the draft provisions on the protection of marks, and other industrial property rights in signs, on the Internet, in an *ad hoc* capacity, pending results of informal consultations regarding the election of the Chair.

Agenda Item 2: Draft Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet (see document SCT/6/2)

General

10. The SCT decided not to refer to "Section" but to use the word "Article" instead, in order to ensure conformity with the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, and the Joint Recommendation Concerning Trademark Licenses. This draft report will therefore refer to "Articles." The text of the adopted provisions is reproduced in Annex II to this report.

Joint Recommendation

11. Several delegations and the representative of an nongovernmental organization supported the texts suggested by the International Bureau and the principle of submitting the provisions for adoption as a joint recommendation to the WIPO Assemblies.

12. The Delegation of Brazil said that it considered premature the adoption of the provisions as a joint recommendation and wanted to have the confirmation that a joint recommendation is not binding. It also wanted to have its position reflected in the Report.

13. The International Bureau recalled that this approach was initiated in September 1999 with the adoption by the WIPO Assemblies of the Joint Recommendation concerning provisions on the protection of well-known marks and renewed in September 2000 with the adoption of the Joint Recommendation concerning trademark licences. The International Bureau confirmed that the position of the Delegation of Brazil will be reflected in the

Summary by the Chair, in the Report and in the documents submitting the proposed joint recommendation to the Assemblies.

14. The SCT adopted the following text and decided to propose the final text of the provisions to the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) in September 2001 for adoption as a Joint Recommendation.

“Proposed Joint Recommendation,

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO);

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property;

Recommend that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its sixth session, as guidelines concerning the protection of marks, and other industrial property rights in signs, on the Internet;

It is further recommended to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring the respective provisions to the attention of that organization.”

Preamble

15. For reasons of conformity with the general title and the text of the provisions, the International Bureau suggested to replace the two occurrences of the words “industrial property rights in marks or other signs” and the corresponding expression in the singular at one place by the words “marks and other industrial property rights in signs”.

16. Following an intervention by the Delegation of Mexico which asked why the Preamble did not refer to acts of unfair competition, the International Bureau suggested to include the words “, and existing laws relating to unfair competition, to the use of signs” in the first paragraph, and the words “, and existing laws relating to unfair competition,” in the second. This amendment was adopted by the SCT.

17. The Delegation of Switzerland noted that the Preamble did not seem to adequately cover the issues addressed by Articles 9 to 15. The International Bureau suggested to add the words “, and in the context of determining remedies” at the end of the fourth and last paragraph. This amendment was adopted by the SCT.

18. In response to a question raised by the Delegation of Australia, the International Bureau explained that, different from Article 1, the third paragraph of the Preamble did not attempt to define the Internet, but emphasized the particular feature of the Internet which challenges the territorial nature of laws on marks and other industrial property rights in signs, namely its global nature. It was, therefore, not necessary to reflect in the Preamble all amendments to the expression “Internet” in Article 1, unless these amendments had clear implications for the application of laws on marks and other industrial property rights.

19. The adopted text of the Preamble is contained in Annex II to this report.

Article 1

20. Following a suggestion made by the International Bureau, the SCT decided to rearrange the order of items by renumbering, for systematic reasons, item (vi) (“Act of unfair competition”) as item (iii), and item (iv) (“Internet”) as item (vi). As a result, item (iii) was renumbered as item (iv), and item (iv) as item (vi).

Item (i)

21. The Delegation of the EC noted that the term “Member State” would not seem to include intergovernmental organizations such as the EC, and proposed to change that word to “Contracting Party.” Another Delegation asked whether the provisions would also apply to intergovernmental organizations. In reply, the International Bureau explained that the term “Member State” had been used in the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, and the Joint Recommendation Concerning Trademark Licenses. The International Bureau also pointed out that the term “Contracting Party” referred to parties of international treaties, whereas the provisions would, at least as a first step, be adopted as a Joint Recommendation. The term “Member State”, therefore, referred to those States who were Members of the WIPO General Assembly or of the Assembly of the Paris Union. Since intergovernmental organizations were presently not members of these assemblies, the recommendation could not be addressed to them. Instead, the last paragraph of the Joint Recommendation recommended that Member States, which are also a member of a regional intergovernmental organization with competence in the area of trademarks, bring these provisions to the attention of that organization. Following this discussion, item (i) was adopted without amendment.

Item (ii)

22. One delegation proposed to refer to Article 1(2) of the Paris Convention for the Protection of Industrial Property (“Paris Convention”) in order to determine exactly which industrial property rights in signs were covered by the provisions. In response, the International Bureau referred to Explanatory Note 1.02 and stated that the provisions did not contain such a reference because some of the industrial property rights covered by the Paris Convention, such as patents or industrial designs, did not relate to signs, and because Member States should be free to go beyond the Paris Convention and to apply the provisions to rights in signs that were not mentioned in that Convention, such as geographical indications.

23. The delegation also asked whether the term “right” covered registered and unregistered rights, and whether it was sufficient if a sign was registrable but not actually registered. The International Bureau explained that the provisions referred to rights that already existed under the law of a Member State without giving an exhaustive list of such rights. Therefore, unregistered would be covered by the provisions if they existed under the law of a Member State. If, however, the right did not exist in that Member State without registration, mere registrability was not sufficient because it did not give rise to a right in that State. Another delegation proposed to add a clarification to the effect that unregistered rights recognized

under the law of a Member State were also covered by the provisions. As a result of this discussion, the SCT decided to add the words “whether registered or unregistered”, at the end of that item.

Item (iii), renumbered Item (iv)

24. One delegation proposed to replace the word “an” by “the” in order to emphasize that Member States were free to determine competence, and to better accommodate different legal systems. This proposal was opposed by a number of delegations and the representative of an observer organization who were in favor of preserving the conformity with the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks and the Joint Recommendation on Trademark Licenses which used a similar formulation. These delegations also pointed out that the formulation did not restrict the power of Member States to determine the competence of authorities. As a result of this discussion, the proposal received no support and was withdrawn.

Item (iv), renumbered Item (vi)

25. Several delegations questioned the need to define the term “Internet”, and stated that the Preamble already contained, in paragraph (3), a reference to the problematic feature of the Internet, whereas the definition in Article 1 might be too broad. The delegations also noted that there was, so far, no generally accepted definition of the Internet at the international level and expressed concern that any definition might soon be outdated because of the rapid technological development of that medium. Other delegations and the Representative of an observer organization favored the retention of the item. Some delegations proposed to make the definition even more specific in order to provide guidance to developing countries which had, so far, less experience in this area. The Chair noted that a more specific definition might prove to be too restrictive and exclude issues that should be covered by the provisions. One delegation observed that the explanation in Article 1 focused on the critical aspects of the Internet and could open the provisions for future developments in similar media that posed the same kind of problems. The delegations said that the provisions should not be limited to the current technical understanding of the Internet.

26. The International Bureau explained that Article 1 in general and renumbered item (vi) in particular did not contain a generally applicable definition, but merely explained how the term was used in the provisions. This could be clarified by using the words “refer to” instead of the word “means”. This suggestion was welcomed by one delegation who proposed the wording “refer to any medium”. The Representative of an observer organization felt that the item explaining the term “Internet” did, for systematical reasons, not fit into Article 1, which dealt with “abbreviated expressions”. The Representative suggested either to delete the item or to move it into a separate article.

27. One delegation asked whether the term “Internet” as explained in Article 1 would also include satellite television or telephone. In response, the International Bureau stated that the particularity of the Internet, which distinguished it from telephone networks, was that its content was accessible to an undetermined number of individual users at their own discretion. Another particularity of the Internet was the ease with which information could be made available to a potentially worldwide audience, and that the person providing the information had normally no possibility of knowing in which particular country his information was actually accessed by Internet users. The Delegation of Hungary referred to Article 8 of the

WIPO Copyright Treaty and Article 14 of the WIPO Performances and Phonograms Treaty and stated that the fact that content on the Internet was “accessible to members of the public at a time and from a place individually chosen by them,” distinguished that medium from television and broadcasting.

28. In order to accommodate the concerns raised throughout the discussion, the International Bureau suggested redrafting the provision as follows:

29. “(vi) “Internet” refer to an interactive medium for communication which contains information that is simultaneously and immediately accessible irrespective of territorial location to members of the public from a place and at a time individually chosen by them;”

30. In response to an intervention by one delegation and the Representative of an observer organization, who held that the Internet was a medium for communication, and that, therefore, the words “contains information” might be misleading, the International Bureau explained that these words had been included in order to distinguish the Internet from the telephone system which was a medium for communication without giving a potentially unlimited worldwide audience access to certain content.

31. One delegation and the Representative of an observer organization expressed concern regarding the term “members of the public” which might be understood as excluding e-mail. The International Bureau stated that these terms were already contained in Article 8 of the WIPO Copyright Treaty and in Article 14 of the WIPO Performances and Phonograms Treaty. The term “public” was chosen to exclude private networks, such as Intranets, and the words “members of the public” referred to individual members of the public, not to the public at large, and would, therefore, also cover communications by e-mail.

32. Following this discussion, the SCT adopted the item with the amendments suggested by the International Bureau.

Item (v)

33. Following a proposal made by two delegations, the SCT decided to add a reference to unfair competition by inserting the words “under the applicable law,” after “a Member State can impose”, and “or an act of unfair competition” at the end of that item.

Item (vii)

34. The Delegations of France and Spain questioned the need for that item and pointed out that the previously adopted Joint Recommendations did not contain similar provisions. The International Bureau replied that this item had been included because it allowed for a simpler drafting of many of the provisions. It pointed out that the Patent Law Treaty (PLT) which had been adopted in September 2000 contained a similar provision in Article 1 (xv).

35. One delegation proposed to add an item explaining that references in the provision to individual users or right owners also covered legal entities. In response, the International Bureau stated that Member States should be free to determine the conditions for recognizing “legal entities”. The International Bureau suggested, and the SCT agreed, to clarify in the Explanatory Notes that legal entities recognized under the law of the Member State concerned are covered by any reference to individual “users” or “owners”.

36. As a result of this discussion, item (vii) was adopted without amendment.

37. The adopted text of Article 1 is contained in Annex II to this report.

Article 2

38. This provision was adopted as proposed, subject to a replacement of the word “Section” by “Article”.

Article 3

Paragraph (1)

The SCT adopted the introductory words (“chapeau”) of this provision without discussion.

Subparagraph (a)

39. This provision was adopted without discussion.

Subparagraph (b)

40. One delegation noted that the words “on the Internet” in the introduction to this subparagraph seemed to contradict the fact that some of the factors mentioned in this subparagraph actually referred to activity taking place outside the Internet. Following this intervention, the SCT decided to delete these words from the chapeau of subparagraph (b).

Item (i)

41. One delegation asked the International Bureau to clarify the words “other commercially motivated relationships”. In response, the International Bureau explained that this phrase was meant to cover any activity of the user that was, like advertising by direct mailing or the sending of updated product information, aimed at prospective customers in order to persuade them to conclude commercial contracts with the user.

Item (ii)

42. Following a proposal by one delegation, the SCT decided to replace the words “a particular” by “the” to make the wording conform to that of the other factors.

Items (iii) and (iv)

43. These items were adopted as proposed.

Subparagraph (c)

44. One delegation questioned the relationship between item (i) of subparagraph (c), and item (i) of subparagraph (b). The delegation asked whether there would be a commercial effect if a user furnished for example, gambling services to customers based in a country in

which gambling was illegal. In response, the International Bureau pointed out that a user who actually served customers in a Member State could not hide behind the illegality of his activities.

45. Following this discussion, the SCT adopted all of subparagraph (c).

Subparagraph (d)

46. The SCT adopted all of subparagraph (d) without discussion.

Subparagraph (e)

47. The Delegation of France observed that the factor contained in this item was phrased in subjective, intentional terms and diverged from all other items which contained objective factors for determining commercial effect. The delegation observed that “commercial effect” was an objective concept and should be determined in an objective way, not by reference to a particular motivation.

48. The International Bureau stated that this factor was supposed to cover cases of use in bad faith, such as cybersquatting. Such use might hardly have an objectively measurable commercial effect if the cybersquatter did not actually use the domain name for any commercial purposes, but merely intended to sell the domain name to the right owner. In such cases, the damage to the right owner would be the only measurable commercial effect. The representative of an observer organization stated that, taken as a whole, the provisions required a commercial effect in all cases, except in cases of bad faith use of a sign on the Internet. However, since the structure of the provisions would have to be changed in order to clarify this in the text of the provisions, the representative supported the proposal put forward by the Delegation of France.

49. The Representative of an observer organization noted that an additional problem with the current draft was that “the sign” would only cover the use of an identical sign, and would not cover bad faith use of a sign that was merely similar.

50. Several delegations and the representatives of two observer organizations felt that the meaning of the words “the subject matter of an existing right” was unclear and proposed their deletion. Another delegation stated that the idea according to which the use is motivated by the subject matter should however be maintained.

51. As a result of this discussion and following a suggestion made by the International Bureau, the SCT decided to replace the current wording by the text used in Article 4(2) which described bad faith use of a sign in an objective manner, and to make the following changes in subparagraph (e):

- To insert the words “in the Member State” after the words “in that sign” in the chapeau;
- To replace the word “a” by “that”, and to delete the words “in the sign in the Member State” in item (i);

- To replace the current draft of item (ii) by the following text: “whether, where the right belongs to another, the use would take unfair advantage of, or unjustifiably impair, the distinctive character or the reputation of the sign that is the subject of that right.”

Paragraph (2)

52. This provision was adopted without discussion.
53. The adopted text of Article 3 is contained in Annex II to this report.

Article 4

54. The Representative of an observer organization expressed doubts as to whether this provision was really necessary, and stated that liability for infringements should be independent of bad faith. In reply, one delegation pointed out that Article 4 did not have the effect of making liability for infringement dependent on bad faith. The delegation emphasized the necessity of explaining the concept of bad faith in Part II because several provisions referred to it.

Paragraph (1)

55. One delegation proposed to delete the words “or used” after “acquired” in both paragraphs, because it was the sign and not the right that was used. The Representative of an observer organization suggested reordering the clauses in paragraph (1). Following these interventions, the SCT adopted the following redraft, which had been suggested by the International Bureau:

“For the purposes of applying these provisions, any relevant circumstances shall be considered in determining whether a sign was used in bad faith, or whether a right was acquired in bad faith.”

Paragraph (2)

56. One delegation proposed to replace the words “another right” by “right of another” because the user would in most cases not own a right. Another delegation observed that only a sign could have a distinctive character, not a right as implied by the current draft.

57. Referring to the phrase in Note 4.02 according to which “Member States are [...] free to adopt different standards for determining bad faith”, one delegation observed that the harmonizing effect of this provision was rather limited.

58. After this discussion, the SCT decided in item (i)

- to delete the words “, or used” after “acquired”;
- to insert the words “knowledge of a right in an identical or similar sign belonging to another, “after the words “whether the person who used the sign or acquired the right in the sign had”;

- to delete the words “, at the time when the sign was first used or registered, or an application for its registration was filed, knowledge”;
- replace the word “another” by “that”;
- to insert the words “at the time when the person first used the sign, acquired the right or filed an application for acquisition of the right, whichever is earlier,” before the word “and” at the end of the item.

59. In item (ii), the SCT decided to insert the words “the sign that is the subject of” before the words “the other right” at the end of the subparagraph in order to clarify that the distinctive character relates to the sign, not to the right.

60. The adopted text of Article 4 is contained in Annex II to this report.

Article 5

61. The SCT adopted this provision without discussion.

Article 6

62. After some discussion as to whether the words “Rights” and “Acts” in the title of the articles should be used in the singular in accordance with Article 1(vii), the SCT adopted this provision without amendments.

Article 7

63. The Delegation of Brazil expressed concern regarding Note 7.01 according to which Article 7 “states the general principle that, with regard to liability for infringement or acts of unfair competition, use of a sign on the Internet that can be deemed to have taken place in a particular Member State [...] shall, under the applicable law, be treated in the same way as use in that Member State outside the Internet.” The Delegation explained that its country was presently studying the viability of adopting specific legislation concerning the use of signs on the Internet. The Delegation felt that the principle contained in Article 7 might prevent its country from doing so. It therefore reserved its position with regard to Article 7 as a whole.

64. In reply, the International Bureau stated that the provisions did neither require Member States to pass specific legislation for the use of signs on the Internet, nor prevented it from doing so, as long as the same general principles were applied to use of signs on the Internet as well as outside the Internet. The International Bureau also suggested to delete the sentence referred to by the Delegation of Brazil and to redraft Note 7.01 as follows:

“7.01 This provision states the general principle that the user of a sign on the Internet shall, under the applicable law, on distinctive signs or unfair competition of a Member State, be liable for such use which constitutes an infringement or an act of unfair competition if use of the sign on the Internet can be deemed to have taken place in that Member State in accordance with Sections 2 and 6. The only exceptions to that principle are provided for by

Section 8 (Exception and Limitation under the applicable law) and contained in Part V (Notice and Avoidance of Conflict).

65. The Delegation of Brazil maintained its reservation pending further consultation with its capital.

66. Several delegations proposed to replace the word “and”, linking infringement of rights and unfair competition, by the word “or”. This was opposed by another delegation on the grounds that the text might then be understood as obliging Member States to generally provide liability in both cases. Another delegation, supported by the Representative of an observer organization, proposed to use the words “and/or”. The International Bureau stated that the provision did not really provide two different types of liability, but aimed at covering two different types of facts that could lead to liability. In order to clarify that the provision was concerned with types of individual acts and not with general types of liability, the International Bureau suggested to replace the words “for the infringement of a right, and for acts of unfair competition committed,” by the phrase “when a right is infringed or an act of unfair competition is committed,”

67. After some discussion, the SCT adopted Article 7 with the amendments suggested by the International Bureau and subject to the reservation expressed by the Delegation of Brazil.

68. The adopted text of Article 7 is contained in Annex II to this report.

Article 8

69. One delegation, supported by another delegation, proposed to use the definite article “the” instead of an indefinite form. This was adopted by the SCT which also decided to replace the words “in respect of” by the word “to”.

70. The Delegation of Brazil referred to Note 8.01 and reiterated its concern that Articles 7 and 8 might prevent its country from introducing specific legislation concerning the use of signs on the Internet. The Delegation therefore reserved its position regarding Article 8 as a whole.

71. Two delegations pointed out that nothing in the provisions would prevent a country from adopting specific legislation with special rules as long as the general treatment of use on the Internet was the same as use outside the Internet. Another delegation added that Internet users should, under Article 8, benefit from all existing limitations or exceptions; Member States would, however, be free to introduce additional exceptions or limitations for use of a sign on the Internet. Another delegation emphasized that the purpose of these provisions was not to create a completely new law regulating the use of signs on the Internet, but to build on existing laws in order to create a link between these laws and the Internet.

72. The International Bureau suggested deleting the phrase referred to by the Delegation of Brazil and to redraft the first sentence of Note 8.01 as follows:

“8.01 This provision generally requires Member States to apply any existing exceptions and limitations under the applicable law in respect of liability that arises in connection with the use of a sign on the Internet, provided, of course, that the use on the Internet can be considered to have taken place in the Member State in question in accordance with Section 2.”

73. The Delegation of Brazil maintained its reservation pending further consultations with its capital.
74. After some discussion, the SCT adopted Article 8 with the amendments suggested by the International Bureau, and subject to the reservation expressed by the Delegation of Brazil.
75. The adopted text of Article 8 is contained in Annex II to this report.

Article 9

76. Delegations discussed the question whether the “notice and avoidance of conflict procedure” established by Articles 9 to 12 should be restricted to right owners, or whether it should be extended to every good faith user. Explanatory Note 9.06, contained in document SCT/6/2, had set out the following three options: (i) to open procedure for every user in good faith, (ii) to keep it generally restricting to right owners, but to include a provision (Article 12*bis*) expressly allowing Member States to open the procedure to every user in good faith, and (iii) restricting the procedure to right owners without including Article 12*bis*.

77. The Delegations of the European Communities, France and Japan, and the Representative of an observer organization were in favor of restricting this procedure to right owners and stated that they could accept a separate provision (Article 12*bis*) clarifying that Member States were free to go further and open the procedure for every user in good faith. These Delegations pointed out that the purpose of the “notice and avoidance of conflict” procedure was to resolve conflicts between right holders. The Delegation of Japan expressed concern that the “notice and avoidance of conflict procedure” might violate Article 17 of the TRIPS Agreement if it was extended to every good faith user, because Article 17 TRIPS only authorizes “limited exceptions to the rights conferred by a trademark.”

78. The Delegations of Netherlands, Norway and Switzerland, and the representative of the MPI expressed a preference for opening the procedure for every user in good faith. These delegations pointed out that the notice and avoidance of conflict procedure did not provide a complete exception to liability but merely entitled good faith users to a warning before they could be held liable for the infringement of a right. It was emphasized that users could hardly undertake a complete and reliable search for conflicting rights in potentially every country of the world. Article 12*bis* would not provide a practical solution to this problem since users of a sign would probably not be in position to determine exactly which countries had adopted to extend the notice and avoidance of conflict procedure.

79. The Delegation of Denmark proposed to open the procedure for good faith users permitted in the country of origin, as in Article 15(2)(i) (for the discussion of this provision, which had taken place earlier, see paragraphs 124–130 below). The Delegation proposed to add the following phrase at the end of item (i): “, or is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to

which the user has a close connection". The Delegation explained that its proposal would allow the use of a generic or descriptive term, or uses supported by a right in a personal name, on the same basis as uses supported by a right. It would provide a compromise between limiting the notice and avoidance of conflict procedure to right holders and opening it to every good faith user.

80. This proposal was supported by the Delegations of Australia, Canada, Spain, Switzerland, the United Kingdom, and the United States of America, as well as by the Representatives of AIPPI, AIPLA, and the MPI who stated that under this proposal, the user would have to have some sort of positive permission under the law of a Member State while the mere absence of a conflicting exclusive right would not be sufficient. The provision would thus require Member States to give recognition to the fact that a certain form of use was positively permitted in another Member State.

81. The Representative of AIPPI suggested to express this idea by using the term "legitimate interest" instead of the wording contained in Article 15 because this term had already acquired a clear meaning under the UDRP procedures for domain name disputes. In response, the International Bureau stated that the term "legitimate interest" was neither used in the context of any national law, nor by any intergovernmental organization, and that its interpretation was in the hands of private dispute settlement boards. It might, therefore, be problematic if the decisions of such boards would have to be treated as precedents for national courts and other competent authorities.

82. The Delegation of France stated that it could generally support the proposal made by the Delegation of Denmark if it was more clearly limited to use of personal names, and other terms that are considered generic or descriptive in the country of origin. Following a suggestion made by the representatives of two observer organizations which was supported by two delegations the SCT decided to make that clarification in the notes. The Representative of an observer organization further pointed out that the Notes should also clarify that Member States are free to open the "notice and avoidance of conflict procedure" to other forms of permitted use.

83. The Delegation of Japan requested a clarification in the Notes that the procedure did not derogate from existing obligations of Member States under international conventions and agreements.

84. As a result of this discussion, the International Bureau suggested to add the following sentences at the end of Note 9.07:

"It should be noted that the "notice and avoidance of conflict" procedure does not result in a permanent restriction or limitation of rights that are infringed by the use of a sign on the Internet; liability for infringement begins with the notification if the user does not comply with the requirements set out in Articles 10 to 12. If he complies, the right is no longer infringed. Nothing in this provision shall derogate from the existing obligation that Member States may have to each other under existing international conventions and agreements concerning industrial property."

85. The International Bureau also suggested replacing current Note 9.08 by the following text (notes 9.08 and 9.08 *bis* in Paper 7):

Item (i) Only users who own a right in the sign in another Member State, users who use the sign with the consent of the owner, or users who are otherwise permitted to use the sign can benefit from that procedure.

The phrase “otherwise permitted to use the sign” is understood to refer to:

(i) the use of the sign by a user who has a right in that sign which is, like his personal name, protected in a non-commercial context;

(ii) the fair use of generic or descriptive terms.

Member States may also apply the “notice and avoidance of conflict” procedure if the use is permitted in another Member State for other reasons or simply because no other person owns a right in the sign in that other Member State.”

86. The Delegation of France declared that it could accept the redrafted text of Article 9 with that Note. The Delegations of Australia, Croatia, Germany, the United Kingdom and the United States of America, and the Representative of AIPPI expressed or reiterated their support for the redraft of Article 9. These delegations held that, in light of that redraft, Article 12 *bis* was no longer necessary and proposed its deletion. 9

87. The Representative of AIPLA observed that it was common practice under most national laws to send cease and desist letters before filing an infringement suit, and that the “notice and avoidance of conflict procedure” reflected this practice. As amended, the Notes would, however, contain an unfair limitation to this common practice because, for example, use in the context of comparative advertising would not be benefiting from the “notice and avoidance of conflict procedure”. The representative regretted that the SCT was moving in the wrong direction by rewarding the absence of notice before an infringement suit. e,

88. The Delegation of the EC stated that it was still in favor of limiting the “notice and avoidance of conflict procedure” to right holders, and to leave it to each Member State whether to open this procedure also for other forms of permitted use. The delegation requested that its position be reflected.

89. The Delegation of Brazil stated that it would have difficulties in implementing the “notice and avoidance of conflict procedure” in its national law, and suggested to make Article 9 optional by replacing the word “shall” by “may”. The International Bureau pointed out that the same problem existed probably in all countries, but that the procedure provided a major step forward towards resolving conflicts which could not be resolved under one national law alone.

90. The Delegations of the European Communities and the Republic of Korea requested that the term “close connection” be clarified in the Notes. The International Bureau suggested to add the following note (Note 9.08 *ter* in Paper 7) after Notes 9.08:

“The term “close connection” describes a certain relationship between the user of the sign and the Member State under the laws of which he is permitted to use the sign.

Such a relationship is obvious in cases where the user owns a right in that sign under the laws of a particular Member State. If the user, however, does not own a right in the sign, he should not be able to rely on the laws of a country with which he has no relationship whatsoever for asserting that his use was permitted. He should have valid reasons for this assertion, which would have to be based on his relationship with a country that permits the use. Domicility would satisfy this requirement. Since the present provisions are concerned with use which has a commercial effect, the "close connection" would typically be of a commercial nature. Obvious examples for such a "close connection" would be the relationship with a country in which the user has his seat or headquarters, or a real and effective industrial or commercial establishment in the sense of Article 3 of the Paris Convention for the Protection of Industrial Property. The user would also have a "close connection" with a country in which he carries out a substantial part of his business."

91. With regard to the drafting of item (i) of Article 9, the International Bureau suggested deleting the word "and" at the end of item (i) because the fact that all items were cumulative was evident from the "and" at the end of item (i).

92. With regard to item (ii), the International Bureau suggested to replace the current text by the following sentence: "any acquisition of a right in the sign, and any use of the sign, has not been in bad faith; and".

93. One delegation proposed replacing the word "he" in item (i) and (iii) by "the user" for consistency with Article 15(2).

94. Article 9 was adopted with these amendments, subject to the reservation expressed by the Delegation of Brazil and the Delegation of the EC. The revised text of Article 9 is contained in Annex II to this report.

Title of Part V

95. One delegation observed that the title "Coexistence of Rights" would no longer fit the substance of Part V that now also covered the permitted use of generic and descriptive terms without a right. Following a suggestion made by the International Bureau, the SCT decided to rename Part V as "Notice and Avoidance of Conflict".

Article 10

96. As a consequence of the amendments to Article 9, the SCT decided to add the following words at the end of item (i): "or that he is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to which he has a close connection". The SCT also decided to add the words "or permitted use" at the end of item (ii).

97. As a consequence of an amendment to Article 14 (1)(ii) which the SCT had adopted earlier (see paragraphs 114-116 below), it was decided to replace the phrase "an attempt to avoid confusion with the owner of the right referred to in the notification" by the words "or to avoid infringement of the right referred to in the notification."

98. The revised text of Article 10 is contained in Annex II to this report.

Article 11

99. The Delegation of Mexico proposed to insert a reference to unfair competition in item (i). The International Bureau replied that the “notice and avoidance of conflict procedure” only applied to infringements of rights through use of a sign on the Internet because only in such cases, the rightholder is clearly identified as the person that can use the “notice and avoidance of conflict procedure” as a first step in the process of enforcing his right. This was not the case with acts of unfair competition law, which oftentimes did not infringe a clearly specified right of another person. Further complication was added by the fact that unfair competition law diverged widely from country to country. Nothing would, however, prevent a Member State from going beyond the required minimum and applying the “notice and avoidance of conflict procedure” to acts of unfair competition as well. The Delegations of France and Mexico requested that this clarification be included in the Explanatory Note s.

100. The Representative of an observer organization suggested to move Article 11 before Articles 9 and 10 in order to avoid referring to previous provisions in the title and in the introductory words of Article 11. In reply, the International Bureau stated that the current order reflected the understanding that Article 11 dealt with a formal issue and was less important than Articles 9 and 10 which established the general principle. The International Bureau suggested deleting the words “of Infringement” from the title and to replace the words “Section 10” by the words “Articles 9 and 10”. This suggestion was adopted by the SCT.

101. The International Bureau observed that Article 11 did, so far, not specify the person who could send a notification. The Representative of AIPPI informed the participants that many notifications were actually sent by representatives and not the owners themselves, and emphasized that should also be possible under the provisions. The International Bureau suggested to insert in the chapeau of Article 11, the words “is sent by the owner of a right or his representative,” after the words “shall be effective if it”. This suggestion was supported by one delegation. The Representative of AIPPI stated that persons using the sign with the consent of the rightholder, such as licensees, were explicitly mentioned in Articles 9 and 10, but not in the redraft. The Representative wondered whether they would also be in a position to send a valid notification. The International Bureau said that it would be clarified in the Note that the term “representative” also includes licensees who are, under the applicable law, authorized to enforce the right. After this discussion, the SCT adopted the suggestion made by the International Bureau.

102. The Delegation of Jordan questioned the use of the term “in writing”. It observed that this term has a clearly defined meaning under many national laws, and that this meaning might not include all means of communication mentioned in item (ii). The Representative of AIPPI suggested either to mention in the chapeau all the means of communication referred to in item (ii), or to delete the words “in writing” altogether. Other delegations favored the retention of the words “in writing” stating that they could be interpreted in a comprehensive way; one delegation added that this could be clarified in Article 11. One delegation suggested replacing these words by the words “by correspondence”. After some discussion, the SCT decided to delete the words “in writing”, and to insert the words “, by mail, e-mail or telefacsimile,” in the chapeau.

103. One delegation proposed to insert the words “, the following” at the end of the introductory phrase, after the words “in conjunction with the use of the sign on the Internet”. This proposal was adopted by the SCT.

104. Following the proposal made by one delegation, the SCT decided to replace, in the English text, the words “electronic mail” by the words “e-mail” for consistency with other provisions.

105. The revised text of Article 11 is contained in Annex II to this report.

Article 12

106. The Delegation of Brazil expressed concern with regard to the mandatory character of this provision and stated that its national law did not presently provide a similar rule. It said that it had taken note of the fact that the Joint Recommendation, once adopted, would be a soft law instrument, but stated that it nevertheless had concerns about its legal nature.

107. The SCT adopted Article 12 with a replacement of the word “Section” by the word “Article” at four occurrences.

108. The revised text of Article 12 is contained in Annex II to this report.

Article 12bis

109. As a consequence of the amendment of Article 9, the SCT decided to delete Article 12bis as a whole.

Article 13

Paragraph (1)

110. The Delegation of the Russian Federation proposed, and the SCT agreed, to add a reference to acts of unfair competition.

Paragraph (2)

111. The SCT adopted this provision without discussion.

Paragraph (3)

112. The Delegation of Sweden stated that it could not accept the obligation that Paragraph (3) seemed to impose on national courts in every proceeding, and proposed to rephrase the provision as follows: “the users shall have the opportunity...”. This was supported by the Delegation of Denmark and by the representatives of two observer organizations. Following a suggestion made by the International Bureau, the SCT decided to add the words “, upon request,” after the words “the user of the sign shall”.

113. The Representative of an observer organization stated that Paragraph (3) should be drafted in a way that would not rule out the possibility of *ex parte* injunctions, which were required under Article 50.2 TRIPS. One delegation proposed to use the terminology of Article 41.3 TRIPS, and to add the words “prior to a decision on the merits of the case” at the end of Paragraph (3). This proposal was adopted by the SCT.

114. The Delegation of Japan asked the International Bureau to state, in the Explanatory Notes, that the provision was a mere application of the principle that defendants should have a right to be heard, as had been set out in paragraph 96 of the Report of the fifth session of the SCT (SCT/5/6). The International Bureau took note of the request, which will be reflected in the Explanatory Notes.

115. The revised text of Article 13 is contained in Annex II to this report.

Article 14

Paragraph (1)

116. One delegation proposed to add a reference to acts of unfair competition by inserting the words “or with the person affected by the act of unfair competition” at the end of item (ii). One delegation proposed to delete the words “the owner of” in item (ii) since that provision aimed at avoiding confusion with the other sign, not with the owner of the right in that sign. This was supported by another delegation. The Representative of AIPPI pointed out that this view reflected a concept which was contained in the BENELUX trademark law, but not universally shared in other countries. For this reason, the representative objected to the proposed deletion of the words “the owner of”. He stated that these words could be understood as referring to a particular business or origin of the products, not to a particular person.

117. The International Bureau cautioned against introducing a new standard of confusion and suggested to sidestep the problem by completely redrafting item (ii) as follows: “to avoid infringement of the right to avoid the act of unfair competition.” The representative of AIPPI welcomed this proposal because it clarified that users of a sign on the Internet had two ways of avoiding liability for the infringement of a right in a particular Member State: avoiding a commercial effect in that country, and thus, an infringement under Article 6 (see item i), and avoiding the infringement by other means, such as ceasing to use of the sign, but not the commercial activity in the Member State (see item ii).

118. After some discussion, the SCT adopted the suggestion made by the International Bureau.

Paragraph (2)

119. The International Bureau suggested to insert the words “, or the person affected by the act of unfair competition” in subparagraph (a) as a consequence of the amendment of paragraph (1). This suggestion was adopted by the SCT.

120. Following a proposal made by the Delegation of the Russian Federation, the SCT decided to delete the words “or in one of those Member States” as unnecessary in light of Article 1(vii).

121. The revised text of Article 14 is contained in the Annex to this report.

Article 15

122. The Representative of the MPI said that Article 15 still allowed prohibitions of use or “global injunctions”, and that this remedy seemed rather harsh. The Delegation of Australia observed that, for this reason, paragraph (1) required competent authorities to avoid “global injunctions” wherever that was possible. The Representative of an AIPPI added that paragraph (2) only stated in which cases a competent authority was not allowed to pass a “global injunction”.

123. The Delegation of Brazil explained that it had not yet addressed the Internet by specific legislation. It expressed concern with regard to the limitation of the authority of courts or other competent authorities, and declared that it reserved its position regarding Article 15(2).

Paragraph (1)

124. Following the proposal made by the Delegation of Mexico, the SCT decided to replace the word “protected” by the words “, or amount to an act of unfair competition,”

125. The Delegation of Jordan asked whether the phrase “prohibiting any future use of the sign on the Internet” was limited to use by the actual user, or included any use by any other user as well. The International Bureau replied that Article 15 referred to a proceeding between parties, and that the injunction could, therefore, only be valid between those parties.

Paragraph (2)

126. Following the suggestion made by the representative of an observer organization, the SCT decided to insert the words “, use the sign with the consent of the owner of such a right,” in item (i).

127. The Representative of AIPLA asked whether paragraph (2) was also applicable when the defendant actually owned a right in one or more countries. The International Bureau replied that this case was meant to be included in the phrase “is permitted to use”. In order to clarify this provision, the International Bureau suggested to insert the words “owns a right in the sign in another Member State, or” after the word “the user” in item (i). The SCT adopted this suggestion.

128. The Delegation of Japan referred to the phrase in item (i) “under the law of another Member State to which the user [has at least minimum contacts] [has a close connection] [has a significant relationship]”, and asked the International Bureau to clarify the difference between the three options in square brackets. The International Bureau explained that these terms described a certain link between the user and the country in which his use is permitted. This was necessary because in the cases covered by item (ii), such a link would not be provided by a right existing under the law of a particular Member State. In such cases, the user should not be able to rely on the law of a country with which he has no relationship

whatsoever for asserting that this use was permitted. The three terms were taken from different backgrounds which could not really be used as precedents. The term “minimum contacts” was taken from the law on jurisdiction in the United States of America (*International Shoe Co. v. Washington*¹) and is the least demanding of all three terms. The term “close connection” is used in Articles 4(1), 7(1) and the EEC Convention on the Law Applicable to Contractual Obligations². The term “(most) significant relationship” would seem to describe the most demanding concept. It appears, for example, in Article 10(a) of the United Nations Convention on Contracts for the International Sale of Goods (“Vienna Convention” or “CISG”), and is also used to describe the goal of Private International Law in general, which is to apply the law of the state that, with regard to the particular issue, has the most significant relationship with the parties and the dispute. In this sense, the term is used for example in Section 6 of the Restatement, Second, Conflict of Laws which had been published by the American Law Institute in 1971.

129. The Delegations of Australia, France, Morocco expressed a preference for the term “close connection”. The Delegation of the European Communities said that it could accept either that term or the term “significant relationship”. The Representatives of AIPPI and ECTA were in favor of the term “significant relationship”. After some discussion, during which the International Bureau said that it would clarify the concept in the Notes, the SCT decided to use the term “close connection”.

130. The Delegation of Denmark proposed to replace the word “and” in item (ii) by “or”. The International Bureau stated that this would not seem to solve the problem and suggested rephrasing the item as follows: “any acquisition of a right in the sign, and any use of the sign, has not been in bad faith.” This suggestion was adopted by the SCT.

131. The proposed Joint Recommendation and the draft provisions were adopted by a consensus of the SCT, subject to reservations by Brazil with regard to Articles 7, 8, 9 and 15(2) and by the European Communities with regard to Article 9. The Delegation of the Republic of Korea stated that it could not join the consensus on Article 15(2) at this time pending further discussion and instruction from its capital. The SCT further agreed that the text of the provisions and the explanatory notes will be revised by the International Bureau and circulated on paper and on the SCT electronic forum for comments.

132. Therevised text, as adopted by the SCT, is contained in the Annex to this report.

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

133. The Delegation of Uruguay, on behalf of GRULAC countries, expressed its concern on the dangers of politicization of the SCT, illustrated by the informal discussions regarding the election of the Chair, and recalled the technical nature of the work of the SCT. It further suggested that a more transparent procedure be set up for the future election of the Chair and

¹326 U.S. 310, 66 S.Ct. 154, 90 L.Ed. 95 (1945).

²23 Official Journal of the European Communities No. L266/1 (1980).

Vice-Chairs of the Committee, taking into account the technical expertise of the candidates, regular alternation of the chair and respect of geographical balance among the candidates.

134. This proposal was endorsed by a number of delegations and noted by the International Bureau.

135. Ms. Debbie RØNNING (Norway), was elected as Chair. Mrs. María Teresa YESTE (Spain) and Mrs. Graciela ROADD' IMPERIO (Uruguay) were elected as Vice -Chairs.

Agenda Item 4: Adoption of the Draft Agenda

136. The Draft Agenda (document SCT/6/1) was adopted, with a change of order such that item 5 was renumbered as item 2, and items 2, 3 and 4 were renumbered as items 3, 4 and 5.

Agenda Item 3: Adoption of the Draft Report of the Fifth Session

137. The draft Report of the fifth session of the SCT (document SCT/5/6 Prov.) was adopted without modifications.

Agenda Item 6: Geographical Indications (See document SCT/6/3)

138. Practically all delegations and representatives of observer organizations expressed their satisfaction over document SCT/6/3 and commended the International Bureau for its preparation.

139. Two delegations stated their concern regarding the order in which the discussion on particular items of the agenda took place.

140. The International Bureau indicated that the following clerical errors in document SCT/6/3 needed correction: in paragraph 85 of the English, French and Spanish versions, the reference to TRIPS "Article 2.1" should read "Article 23.1," and in paragraph (116) of the English and Spanish versions, the reference to "Article 23.3" should read "Article 23.2."

141. The Delegation of the European Communities, speaking on behalf of the European Union and its Member States, stated that it wished to reiterate the doubts it had already expressed at the fourth session of the SCT regarding the work on geographical indications. These concerns were still valid, and the Delegation stated that it did not consider it worthwhile to continue to work on that topic. The Delegation further declared that in its opinion other issues as indicated in document SCT/6/4 (Future Work of the SCT), such as the future of the Trademark Law Treaty or the issue of domain names should be given priority in the work of the Standing Committee. In conclusion, the Delegation declared that the work on geographical indications should not be continued by the SCT for the time being.

142. The Delegation of Switzerland expressed great interest in the issue of geographical indications and said that it should stay on the agenda of the SCT. However, the Delegation recalled that the subject was currently under discussion within the Council for TRIPS of the World Trade Organization and given that work, it appeared to be premature to discuss the

issue within the SCT. Therefore, the work should be suspended while following the ongoing discussions in the Council for TRIPS, and taken up again when the time appeared to be ripe for it.

143. The Delegation of Sweden expressed its support for the position stated by the Delegations of the European Communities and Switzerland.

144. The Delegation of the United States of America considered that it was important for the SCT to discuss the issue of geographical indications. In particular, the Delegation pointed out that protection for geographical indications was based on different national systems, and that there existed a great deal of misunderstanding how those systems operated. The Delegation emphasized that it also wished to avoid duplication of work. Having attended meetings of the Council for TRIPS, the Delegation said that it thought that the discussions which took place in those meetings were highly political and not intellectual property oriented. The SCT should discuss the technical intellectual property law aspects of geographical indications rather than the trade aspects of that subject matter. This discussion was particularly necessary to determine how the protection of geographical indications warranted by international agreements could be fitted into the various national systems of Member States. A discussion of geographical indications from the intellectual property law standpoint by the SCT could help to clarify a number of important issues. It would also be helpful for Member States who were about to implement new legislation dealing with that matter.

145. The Delegation of Mexico stated that the issue of geographical indications should be discussed by the SCT. The Delegation pointed out that the discussion taking place in the Council for TRIPS was inevitably linked to trade issues such as the exclusion of certain products from a higher level of protection. The Delegation said that it was necessary to carry the discussion on geographical indications beyond the TRIPS Agreement of 1994 and that for that reason it had to stay on the agenda of the SCT.

146. The Delegation of Barbados said that it endorsed the statements made by Delegations of the United States of America and Mexico. The SCT provided a technical forum for approaching the issue of geographical indications. It informed the meeting that its country had recently implemented national legislation on geographical indications and that for this reason it would be particularly important for the Delegation to discuss that issue within the SCT.

147. The Delegation of France emphasized that geographical indications were a type of intellectual property applicable to many different products. It recalled that there was a variety of different national systems for the protection of geographical indications ranging from protection under unfair competition to more specific types of protection such as protected appellations of origin and that this type of protection would be applicable to all kinds of products. In conclusion, the Delegation expressed support for the position expressed by the Delegations of the European Communities and Switzerland and pointed out that, in its opinion, discussion on geographical indications within the SCT would be premature.

148. The Delegation of Portugal stated support for the position as expressed by the Delegation of France.

149. The Delegations of Spain, Germany and Turkey supported the position expressed by the Delegations of the European Communities and Switzerland and pointed out that, in their

view, the initiation of discussions on geographical indications within the SCT would be premature.

150. The Delegation of Australia stated that document SCT/6/3 should be the starting point for a discussion on geographical indications and not the end of such a discussion. It pointed out that complex technical and legal issues were linked to the subject of protection of geographical indications and that those issues needed improved understanding. This understanding would mainly benefit legislators and practitioners who would be advised by any work of the SCT on that matter. Like others, the Delegation was of the opinion that duplication of works should be avoided, and that it was particularly inappropriate to discuss specific provisions of the TRIPS Agreement. However, it was critical to provide technical advice to policymakers on various legal aspects of the protection of geographical indications and that, therefore, further discussion on this issue should take place within the SCT. s

151. The Delegation of Kenya stated that the SCT should discuss the protection of geographical indications. Such discussions were important to Kenya as a developing country and, in particular, since a draft law on geographical indications was currently considered by its parliament.

152. The Delegation of Algeria pointed at the ongoing work on geographical indications in the Council for TRIPS and said that, for this reason, it shared the point of view of the Delegations of the European Communities and Switzerland.

153. The Delegation of Canada said that it concurred with the position expressed by the Delegation of Australia. WIPO had the intellectual property expertise which was necessary for addressing the legal aspects of the protection of geographical indications. The SCT could provide much needed analytical work on geographical indications and address specific issues.

154. The Delegation of Morocco expressed support for the positions of the European Communities and Switzerland. It said that it was not opportune to deal with substantive question of geographical indications within the SCT. These questions could be dealt with later on and in a more technical manner. ith

155. The Delegation of Finland declared that the legislation on geographical indications of its country was different from those of many other Member States of the European Union. In addition, the negotiations that took place on that subject within the Council for TRIPS turned out to be very difficult. For that reason, the Delegations supported the position as expressed by the Delegations of the European Communities and Switzerland.

156. The Delegation of Burkina Faso emphasized the importance of the matter under consideration. The Delegation recalled that its country was a member of the Lisbon Agreement, that it had ratified the TRIPS Agreement and that it disposed of a national legislation in the field of geographical indications via its membership in the African Intellectual Property Organization (OAPI) and by virtue of the application of the Bangui Agreement. Referring to the various products on which geographical indications could be used, the Delegation indicated that its country was about to identify a number of products for which national geographical indications could be used, and that it was in favor of the largest possible approach to the question of product coverage. Turning to the aspect of document SCT/6/3 dealing with the historical development of geographical indications, the Delegate said that he was particularly interested to read about past initiatives suggesting some kind of

preferential treatment in the field of geographical indications for developing countries. In the opinion of the Delegation, this was an issue that would merit re-consideration. In conclusion, the Delegations said that it did not find it premature to initiate work on geographical indication within the SCT and said that it was looking forward to discuss the working document prepared by the International Bureau in detail.

157. The Delegation of Italy expressed support for the positions stated by the Delegations of the European Communities and its member States.

158. The Delegation of the Netherlands said that it agreed with the position stated by the Delegation of the European Communities. The work of the Standing Committee should not interfere with the current and future work of the Council for TRIPS on geographical indications.

159. The Delegation of Sri Lanka said that the working document on geographical indications prepared by the International Bureau for consideration by the SCT could be useful for the work of the TRIPS Council. However, the Delegation considered it premature for the SCT to carry out discussions on that subject. The Delegation did not agree with the view that the Council for TRIPS was only focussing on political dimensions of the issue. Although the Delegation thought it could be difficult to feed document SCT/6/3 into the discussions of the Council for TRIPS, it felt that it was important for the Council of TRIPS to gain knowledge on the matter.

160. The Delegation of Ireland said that it was in favor of a deferment of the discussion on geographical indications within the SCT.

161. The Delegation of Nigeria said that, in its view, a discussion on geographical indications within the SCT came timely and was desirable in order to develop a common understanding of the matter. In particular, such a discussion was needed in order to clarify certain technical aspects like terminology used and national systems of protection. Therefore, the discussion on geographical indications should go forward within the SCT. The Delegation did not feel that such discussions would compromise the work of the Council for TRIPS.

162. The Delegation of Ecuador said that the SCT should not allow itself to be trapped in a debate on the appropriate forum for discussing geographical indications. A full discussion of all points of views, including technical and political issues, would only add to the knowledge of all delegations. The Delegations said that it would like to be better informed about the various aspects of geographical indications, such as the difference between geographical indications, appellations of origins, certification marks and others. Furthermore, it was important to deal with specific questions of intellectual property law, and whether the protection of geographical indications was based on registration or notification, and what the products for which geographical indications could be protected were. These questions were relevant and had implications in other international agreements. Countries like Ecuador depended on the specific characteristics of geographical indications and the concepts for their protection. It was very important for its country to obtain the relevant technical expertise.

163. The Delegation of Denmark expressed its support for the position of the Delegation of the European Communities.

164. The Delegation of Bangladesh said that it was looking forward with interest to further discussing geographical indications.
165. The Delegation of Austria declared that, in its opinion, initiation of the work on geographical indications would appear to be premature and, with a view to the work currently ongoing in the Council for TRIPS, said that it would support the position expressed by the Delegations of the European Communities and Switzerland.
166. The Delegation of Panama expressed interest in the issue of geographical indications to be discussed within WIPO. Such a discussion would be particularly important for a developing country such as Panama. The Delegation further said that the link between protection of folklore and geographical indications was of particular importance for its country. Just because a discussion on a specific issue would be ongoing in a different organization did not necessarily mean that this issue would not be discussed by another body. Therefore, the Delegation was in support of a continuing discussion of geographical indications within the SCT.
167. The Delegation of Egypt said that the SCT should be careful with its deliberations and await the outcome of the discussion on geographical indications that took currently place in other fora.
168. The Delegation of the Republic of Korea stated that the WTO had initiated a study on the issue of geographical indications. It pointed out that, although many members of the World Trade Organization were also member States of WIPO, WIPO was an independent organization. Although, the results of the work of the Council for TRIPS on geographical indications could be a valuable reference, the Delegation was in favor of discussing the matter of geographical indications within the SCT.
169. The Delegation of Brazil said that it shared the opinion of other Delegations that it was opportune to avoid duplication of work. However, the Delegation felt that a technical discussion of the issue would be a good opportunity to clarify and to develop certain issues relating to the protection of geographical indications. For this reason, the Delegation supported the continuation of the work on geographical indications of the SCT.
170. The Delegation of India said that the SCT should await the outcome of the ongoing discussion in the Council for TRIPS.
171. The Delegation of Barbados said that it had considerable sympathy for the concern expressed by other Delegations that duplication of work would be avoided. However, the continued work within WIPO on geographical indications would also lead to a greater understanding of that issue within the Council for TRIPS, without necessarily prejudging that work. The Delegation would expect all other delegations to continue their *bonafide* discussions in the Council for TRIPS in order to resolve outstanding issues. However, the Delegation was concerned that it could constitute an unfortunate precedent to let the World Trade Organization set the agenda for the work of WIPO.
172. The Delegation of Cuba, pointing to the current work of the Council for TRIPS on geographical indications, said that it felt it was premature to continue that work within the SCT.

173. The Delegation of Romania stated that, in view of the ongoing work in the Council for TRIPS, it was in favor of suspending the work on that issue within the SCT, and expressed support for the position expressed by the Delegation of the European Communities.

174. The Delegation of Venezuela said that the item on geographical indications should be kept on the agenda of the SCT. In the view of this Delegation, it was the right time to deal with the matter.

175. The Delegation of Uruguay announced that a symposium on the protection of geographical indications jointly organized by Uruguay and WIPO would be held in Uruguay in November of this year. The Delegation recalled that WIPO was the specialized agency competent for dealing with that matter. However, it appeared to be advisable to postpone discussions on the issue until the next meeting in order to gain sufficient time for thought and for holding consultations.

176. The Delegation of China said that it was in support of examining the protection of geographical indications, because its country was currently revising its legislation in marks and the relationship between geographical indications and trademarks appeared to be a problem that needed to be overcome. The Delegation said that it would appreciate a continuing discussion and that awaiting the outcome of the work that was currently undertaking on geographical indications within the Council for TRIPS was not necessarily satisfactory.

177. The Delegation of the Czech Republic expressed support for the position stated by the Delegation of the European Communities.

178. The Delegation of Argentina stated that WIPO was the appropriate body for discussion of the technical aspects of intellectual property issues.

179. The Delegation of Guatemala stated that, since the issue of geographical indications was of an exclusively technical nature, it should be dealt with within WIPO.

180. The Delegation of the European Communities stated that, although everybody agreed that WIPO was a technical forum, it was not wholly correct to describe the Council for TRIPS as a purely political organ. The Delegation suggested that the SCT look at the work of the Council for TRIPS and urged the SCT to avoid duplications since technical decisions had to be consistent. In any case, discussion on geographical indications could not be carried out without taking into account of the political aspect under discussion that was currently ongoing in the Council for TRIPS.

181. The Delegation of Australia supported the view that duplication of work should be avoided. However, the Delegation felt that there was enough scope for discussion of technical aspects of the protection of geographical indications within the SCT without the work overlapping.

182. The Delegation of the United States of America said that it was problematic to wait for the outcome of the work of the Council for TRIPS on geographical indications, since such an outcome could easily take 10 years. The Delegation said that its main concern was that there appeared to exist a general misunderstanding on the nature of geographical indications and that it was important for countries who were in the process of redrafting or developing legislation in that matter to be educated. It was of importance for every country to have a

strong and effective intellectual property system and it was certainly possible to discuss technical problems arising with the protection of geographical indications without a fear of interfering with the ongoing work of the Council for TRIPS.

183. The Representative of the ICC said that he was fully in support of initiating discussion on geographical indications within the SCT. Those discussions would not necessarily have to lead to any formal decisions, but would be a way of studying the topic.

184. The Representative of ICC referred to the resolution adopted by the AIPPI concerning geographical indications according to which existing geographical indications cannot be appropriated. He recalled that discussing a certain topic did not necessarily mean to take decisions on it, and expressed his support for continuing work on geographical indications within the SCT.

185. The Representative of the OIV said that there appeared to be a multiplicity of forums that were discussing protection of geographical indications and recalled that the matter was also under consideration within the organization represented by him.

186. The Representative of AIDV pointed out that unlike the Council for TRIPS, the SCT provided an opportunity for non-governmental organizations to contribute to the debate by being present. He informed the SCT that the AIDV would hold its annual meeting in Spain in the week following the SCT meeting and that this annual conference would also discuss the protection of geographical indications. The Delegates suggested that the portion of document SCT/6/3 dealing with the historical development of the protection of geographical indications could be further developed and that WIPO would be in a good position to accomplish that work. A better understanding of the historical background of the protection of geographical indications could be helpful for finding possible solutions in the future.

187. The Representative of the INTA stated that his organization represented more than 4000 members in more than 120 different countries. One of the major aims of the INTA was to educate and to assist countries in implementing TRIPS-complying legislation. The Representative noted that a great deal of confusion and misunderstanding concerning the protection of geographical indications existed and that the work of the SCT on that matter would have a great educational effect. This effect would be equally efficient for trademark owners. The Representative could not see any reasons why the subject should not be discussed within the SCT. He also informed the meeting that the INTA had adopted a model law for countries who wish to implement legislation on the protection of geographical indications. He said that he would like the meeting to find out what the exact nature of the work on geographical indications was work that was undertaken within the Council for TRIPS should be monitored, so as to avoid duplication and to make the work of the SCT on geographical indications complementary to that which was being done in the WTO.

188. The Representative of WASME said that in his opinion all delegations would derive benefits from discussing documents SCT/6/3 and, therefore, this discussion should take place within the SCT.

189. The Representative of AIPPI said that the SCT should engage in discussion of document SCT/6/3.

190. The International Bureau informed the SCT that under the WIPO Program and Budget for the 2000/01 biennium, there was the possibility for the SCT to set up working groups dealing with specific issues if the SCT so wished and decided.

191. The Delegation of Australia said that it did not support the creation of a working group, since it considered that work on geographical indications should be a regular part of the work of the SCT. However, it could be considered to set aside, on a regular basis, time of the SCT that would be devoted to discuss issues without an objective *per se*. Such discussions could help to further understanding of certain technical issues such as, various national protection systems for geographical indications. The discussion could take place without a specific mandate from governments and would not necessarily have to result in the adoption of any formal decision.

192. The Delegation of Mauritius expressed support for the positions of the Delegation of the European Communities.

193. The Delegation of Barbados expressed its support for the statement made by the Delegation of Australia. It said that it had taken note of the concerns of the European Communities but believed that there would be great value in having a forum for discussion without necessarily binding governments.

194. The Delegation of Peru said that the item of geographical indications should be included in the work of the SCT. The Delegation felt that it was necessary that a technical discussion take place which could prepare the ground for developing standards and enable delegation to engage in a political discussion later on. Such technical discussion could take place in the form of an *ad hoc* working group or by keeping geographical indications as an agenda item. One problem that deserved particular attention was the relation between trademarks and geographical indications and the Delegation encouraged WIPO to carry out further study projects in that field. The Delegation recalled that the protection of geographical indications was not necessarily related to a registration procedure but any study project undertaken by WIPO which may be of assistance for future work in the area.

195. The Delegation of Ecuador said that it agreed with the Australian proposal and that it was not in favor of setting up a small group. The Delegation thought that discussion on geographical indications should continue on the level of the entire SCT which would certainly be conducive to arriving at fruitful ideas.

196. The Delegation of the European Communities said that it had sympathy for the suggestion of the Delegation of Australia. Here recalled that a practice of informal discussion already existed within the SCT and referred to the "informal lunchtime meetings" one of which had already been devoted to a discussion of geographical indications.

197. The Delegation of Canada said that it believed that the protection of geographical indications was an important and topical intellectual property issue for consideration by WIPO, and more particularly, by the Standing Committee on the Law of Trademarks, Industrial Designs and, of course, Geographical Indications. The Delegation was persuaded that it should be a matter on which a full discussion could occur along with the reporting of that discussion. Work on geographical indications in other fora and especially in the Council for TRIPS of the World Trade Organization would only become beneficial if the SCT was to engage in a thorough discussion of substantive questions related to geographical indications.

Similarly, members of the SCT who were not WTO Members would derive substantial benefit from such a work. In this respect, Canada offered two observations: first, the WTO had been constituted as a forum for developing norms in relation to trade. In the context of this activity, the opportunity to fully explore the basis of geographical indications protection were circumscribed. Secondly, in another area of intellectual property, many WTO Members, including the European Communities and its Member States, and Canada, supported the proposal that WIPO establish the means whereby questions pertaining to the protection of traditional knowledge may be fully explored before the WTO contemplated any possible norm-setting in that regard. The basis of that request was that the protection of traditional knowledge was fundamentally an intellectual property question and a particularly complex one. Quite appropriately, in Canada's view, WIPO had established an inter-governmental committee for that purpose, given that no formal group other than an *ad hoc* working group existed before to deal with this question. The Delegation saw no reason, in principle, why important questions relating to geographical indications, which were equally complex, should be somehow dealt with on another footing, especially since they were already within the mandate of the Standing Committee. For these reasons, the Delegation of Canada urged the SCT to continue its considerations of geographical indications as a part of its regular agenda.

198. The Delegation of Japan referred to the work on geographical indications currently undertaken within the Council for TRIPS and, in particular, the review of the application of geographical indications under Article 24.2 of the TRIPS Agreement. It informed the SCT that the TRIPS Council had elaborated a questionnaire on the subject of geographical indications and sent that questionnaire to the members of the Council for TRIPS for reply. Replies to the questionnaire have been compiled into a paper established by the Secretariat of WTO. Against this background, the Delegation of Japan raised concern for avoidance of duplication of work.

199. The Delegation of Uruguay said that it supported the proposal by the Delegation of Australia to discuss geographical indications within a technical framework but not necessarily to define the positions.

200. The Delegation of Mexico insisted that geographical indications should be considered within the SCT. Although there were similarities between the WTO and the WIPO, the Delegation recalled that WTO was formed as a result of trade negotiations, which had nothing to do with the technical discussion that should take place within the SCT. The Delegation concluded by saying it did not understand why an approach similar to those chosen for the question of traditional knowledge could not be adopted for geographical indications.

201. The Delegation of Bulgaria said that it supported the position expressed by the Delegation of the European Communities.

202. The Delegation of Chile recalled that it attached great importance to studying the issue of geographical indications. In particular, there was a practical interest as concerned the implication of the protection of geographical indications in the context of the TRIPS Agreement. Detailed analysis was needed since the matter was linked to a WTO debate based in a trade context. Therefore, the SCT analysis should be broad in nature and an examination of the various issues could take place in the SCT. In this respect, the Delegation recalled the vital role of WIPO in developing new intellectual property norms and international legal texts. WIPO should continue to play that role and as far as geographical indications were concerned, discussion could take place within the SCT.

203. The Delegation of Morocco wished to clarify that it felt that the protection of geographical indications was of great importance. It believed that the issue could be examined after the work was accomplished in the Council for TRIPS. It considered it further useful to invite a representative of the WTO Secretariat in order to brief the SCT on the ongoing work on geographical indications in the Council for TRIPS.
204. The Delegation of the United States of America said that it supported the proposal made by the Delegation of Australia. Maybe a way forward would be to hold informal discussions without records or interpretation, if such discussions would not lead to binding decisions. The Delegation thought it was more important to discuss the real issues rather than to place statements on records. It could also support to have a working group on that matter. The Delegation recalled that document SCT/6/3 raised a number of fundamental points and that the SCT would be a very useful framework for discussing and establishing principles for a better understanding of the subject matter of geographical indications and existing approaches to geographical indications, taking into account important and well-established rules of intellectual property law like territoriality. Furthermore, questions that would have to be addressed would be whether protection of geographical indications should be universal and international, or how competing claims to the same sign should be dealt with on the basis of priority. The Delegation then went on to briefly present and introduce the protection system for geographical indications existing in the United States of America. The system was basically established on common law and on case law and was tied to the law of trademarks. The last aspects reflected a choice as to whether the burden of enforcement was placed on the owner of the right or on an institution of public law. The Delegation wished to promote the idea of continuing technical discussions which would help to develop a common understanding for the different approaches to the protection of geographical indications, which would help to develop and enhance their protection.
205. The Delegation of the European Communities reiterated its concern to avoid duplication of work and, in that respect, pointed out that for many countries the same delegates participated in meetings of the WTO as the WIPO. In that respect, the Delegation said it could not avoid to speak of a "déjà vu" effect. There was a danger of increasing such an effect in case the discussion on geographical indications continued within the SCT. If the SCT could not reach a decision on the question on whether or not to pursue discussion on geographical indications, the matter would probably have to be referred to a higher body within the WIPO, such as the Assemblies.
206. The Delegation of Venezuela proposed to suspend discussion on geographical indications until a consensus as to how this discussion should take place could be reached. Maybe such a consensus could only be reached at the next meeting of the SCT. However, the item could not be eliminated from the agenda.
207. The Delegation of Slovenia, referring to the ongoing discussion on geographical indications in the Council for TRIPS, said that work on geographical indications in the SCT should be postponed.
208. The Delegation of Egypt expressed support for the position stated by the Delegation of Venezuela and suggested deferring discussion on geographical indications.

209. The Delegation of Switzerland recalled that all delegations felt that there was a common goal in further discussions on geographical indications. However, the question of timing was not resolved. In the view of the Delegation, that issue should be taken up once it appeared to be opportune.

210. The Delegation of Argentina expressed support for the position of Australia. However, the Delegation said it was concerned that the SCT would be turned from a technical into a political committee.

211. The Representative of the ABA pointed out that references in document SCT/6/3 should be made to "certification marks" rather than to "certification trademarks." Furthermore, the representative suggested that document SCT/6/3 should be circulated in the widest possible manner.

212. The Representative of AIPLA stated that the issue of geographical indications was essential and that WIPO should proceed with work on that topic on an official basis.

213. The Representative of the ICC expressed its support for the position of the Delegation of the United States of America. However, if no consensus could be reached on how to deal with the matter within the SCT, work on the agenda item would have to be postponed.

214. The Chair concluded that it was not possible to reach a consensus on how to proceed with this item. Therefore, the item was continued on the Agenda for the seventh session of the SCT, and the Chair asked the International Bureau to undertake informal consultations with the members of the SCT in preparation for that session.

Agenda Item 7: Future Work (see document SCT/6/4)

215. The SCT agreed that its seventh session would tentatively be held from September 10 to 14, 2001, in Geneva, and would last five full days.

216. The SCT then discussed the list of possible issues it suggested at its fifth session, as detailed by the International Bureau in Document SCT/6/4, and the possible work that may be undertaken within this Committee in the future.

217. The Delegation of France said that three topics should be discussed in the future: the revision of the Trademark Law Treaty (SCT), a study on the extent to which new types of marks, such as sound marks or three-dimensional marks, constitute registrable marks, and the nature of rights in domain names.

218. The Delegation of the United States of America declared that geographical indications would constitute the first priority, followed by the revision of the TLT, substantive harmonization of trademark law, and then substantive harmonization of design law.

219. The Delegation of Switzerland stated that the revision of the TLT as well as a study on the criteria for determining the registrability of new types of marks should be dealt with by the SCT in the future. A more global exercise of substantive harmonization of trademark law might be however a bit premature. Substantive harmonization of design law could also be an interesting topic to discuss.

220. The Delegation of Uruguay stressed that problems relating to new types of marks were growing and that a study on this topic could be very useful as well as the initiation of a harmonization of criteria of protection and a revision of the TLT.

221. The Representative of an organization said that the revision of the TLT should be the first priority of the SCT. He added that the nature of rights in domain names should be addressed within this Committee.

222. The SCT agreed that the agenda of the seventh session would consist of the following substantive items:

- Revision of the Trademark Law Treaty;
-
- Substantive harmonization of trademark law;
-
- Geographical indications.

Agenda item 8: Brief Summary by the Chair.

223. The SCT adopted the Summary by the Chair (Document SCT/6/5 Prov) incorporating a number of suggested amendments.

Agenda item 9: Closing of the Session

224. The Chair closed the sixth session of the Standing Committee.

[Annexes follow]

ANNEXE/ANNEXI

LISTE DES PARTICIPANTS/ LIST OF PARTICIPANTS

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† Based on a decision of the Standing Committee, the European Communities were accorded Member status without a right to vote.

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[Annex II follows]

ANNEXII

PROPOSEDJOINTRECOM MENDATION
CONCERNINGTHEPROTE CTIONOFMARKS,
ANDOTHERINDUSTRIAL PROPERTYRIGHTSIN SIGNS,
ONTHEINTERNET

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Proposed Joint Recommendation

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO);

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property;

Recommend that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its sixth session, as guidelines concerning the protection of marks, and other industrial property rights in signs, on the Internet;

It is further recommended to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring these provisions to the attention of that organization.

Provisions follow.

Preamble

Recognizing that the present provisions are intended to facilitate the application of existing laws relating to marks and other industrial property rights in signs, and existing laws relating to unfair competition, to the use of signs on the Internet;

Recognizing that Member States will apply, wherever possible, existing laws relating to marks and other industrial property rights in signs, and existing laws relating to unfair competition, to the use of signs on the Internet, directly or by analogy;

Recognizing that a sign used on the Internet is simultaneously and immediately accessible irrespective of territorial allocation;

The present provisions are intended to be applied in the context of determining whether, under the applicable law of a Member State, use of a sign on the Internet has contributed to the acquisition, maintenance or infringement of a mark or other industrial property right in the sign, or whether such use constitutes an act of unfair competition, and in the context of determining remedies.

PART I
GENERAL

Article I
Abbreviated Expressions

For the purposes of these Provisions, unless expressly stated otherwise:

- (i) “Member State” means a State member of the Paris Union for the Protection of Industrial Property, of the World Intellectual Property Organization, or of both;
- (ii) “Right” means an industrial property right in a sign under the applicable law, whether registered or unregistered;
- (iii) “Act of unfair competition” means any act of competition contrary to honest business practices in industrial or commercial matters as defined in Article 10bis of the Paris Convention for the Protection of Industrial Property, signed in Paris on March 20, 1883, as revised and amended.
- (iv) “Competent authority” means an administrative, judicial or quasi-judicial authority of a Member State which is competent for determining whether a right has been acquired, maintained or infringed, for determining remedies, or for determining whether an act of competition constitutes an act of unfair competition, as the case may be;
- (v) “Remedies” means the remedies which a competent authority of a Member State can impose under the applicable law, as a result of an action for the infringement of a right or an act of unfair competition;
- (vi) “Internet” refers to an interactive medium for communication which contains information that is simultaneously and immediately accessible irrespective of territorial location to members of the public from a place and at a time individually chosen by them;
- (vii) except where the context indicates otherwise, words in the singular include the plural, and *vice versa*, and masculine personal pronouns include the feminine.

PART II
USE OF A SIGN ON THE INTERNET

Article 2
Use of a Sign on the Internet in a Member State

Use of a sign on the Internet shall constitute use in a Member State for the purposes of these provisions, only if the use has a commercial effect in that Member State as described in Article 3.

Article 3
Factors for Determining Commercial Effect in a Member State

(1) [*Factors*] In determining whether use of a sign on the Internet has a commercial effect in a Member State, the competent authority shall take into account all relevant circumstances. Circumstances that may be relevant include, but are not limited to:

(a) circumstances indicating that the user of the sign is doing, or has undertaken significant plans to do, business in the Member State in relation to goods or services which are identical or similar to those for which the sign is used on the Internet.

(b) the level and character of commercial activity of the user in relation to the Member State, including:

(i) whether the user is actually serving customers located in the Member State or has entered into other commercially motivated relationships with persons located in the Member State;

(ii) whether the user has stated, in conjunction with the use of the sign on the Internet, that he does not intend to deliver the goods or services offered to customers located in the Member State and whether he adheres to his stated intent;

(iii) whether the user offers post-sales activities in the Member State, such as warranty or service;

(iv) whether the user undertakes further commercial activities in the Member State which are related to the use of the sign on the Internet but which are not carried out over the Internet.

(c) the connection of an offer of goods or services on the Internet with the Member State, including:

(i) whether the goods or services offered can be lawfully delivered in the Member State;

(ii) whether the prices are indicated in the official currency of the Member State.

(d) the connection of the manner of use of the sign on the Internet with the Member State, including:

(i) whether the sign is used in conjunction with means of interactive contact which are accessible to Internet users in the Member State;

[Article 3(1)(d), continued]

(ii) whether the user has indicated, in conjunction with the use of the sign, an address, telephone number or other means of contact in the Member State;

(iii) whether the sign is used in connection with a domain name which is registered under the ISO Standard country code 3166 Top Level Domain referring to the Member State;

(iv) whether the text used in conjunction with the use of the sign is in a language predominantly used in the Member State;

(v) whether the sign is used in conjunction with an Internet location which has actually been visited by Internet users located in the Member State.

(e) the relation of the use of the sign on the Internet with a right in that sign in the Member State, including:

(i) whether the use is supported by that right;

(ii) whether, where the right belongs to another, the use would take unfair advantage of, or unjustifiably impair, the distinctive character or the reputation of the sign that is the subject of that right.

(2) [*Relevance of Factors*] The above factors, which are guidelines to assist the competent authority to determine whether the use of a sign has produced a commercial effect in a Member State, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. 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 may be relevant, and the decision may be based on additional factors that are not listed in paragraph (1), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in paragraph (1), above.

Article 4
Bad Faith

(1) [*Bad Faith*] For the purposes of applying these provisions, any relevant circumstances shall be considered in determining whether a sign was used in bad faith, or whether a right was acquired, in bad faith,.

(2) [*Factors*] In particular, the competent authority shall take into consideration, *inter alia*:

(i) whether the person who used the sign or acquired the right in the sign had knowledge of a right in an identical or similar sign belonging to another, or could not have reasonably been unaware of that right, at the time when the person first used the sign, acquired the right or filed an application for acquisition of the right, whichever is earlier, and

(ii) whether the use of the sign would take unfair advantage of, or unjustifiably impair, the distinctive character or the reputation of the sign that is the subject of the other right.

PART III
ACQUISITION AND MAINTENANCE OF RIGHTS IN SIGNS

Article 5

Use of a Sign on the Internet and Acquisition and Maintenance of Rights

Use of a sign on the Internet in a Member State, including forms of use that are made possible by technological advances, shall in every case be taken into consideration for determining whether the requirements under the applicable law of the Member State for acquiring or maintaining a right in the sign have been met.

PART IV
INFRINGEMENT AND LIABILITY

Article 6
Use of a Sign on the Internet, Infringement of Rights and Acts of Unfair Competition

Use of a sign on the Internet, including forms of use that are made possible by technological advances, shall be taken into consideration for determining whether a right under the applicable law of a Member State has been infringed, or whether the use amounts to an act of unfair competition under the law of that Member State, only if that use constitutes use of the sign on the Internet in that Member State.

Article 7

Liability for Infringement and Acts of Unfair Competition Under the Applicable Law

Except where otherwise provided for in these provisions, there shall be liability in a Member State under the applicable law when a right is infringed, or an act of unfair competition is committed, through use of a sign on the Internet in that Member State.

Article 8
Exceptions and Limitations Under the Applicable Law

A Member State shall apply the exceptions to liability, and the limitations to the scope of rights, existing under the applicable law when applying these provisions to the use of a sign on the Internet in that Member State.

PART V
NOTICE AND AVOIDANCE OF CONFLICT

Article 9
Use Prior to Notification of Infringement

If the use of a sign on the Internet in a Member State is alleged to infringe a right in that Member State, the user of that sign shall not be held liable for such infringement prior to receiving a notification of infringement, if:

- (i) the user owns a right in the sign in another Member State or uses the sign with the consent of the owner of such a right, or is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to which the user has a close connection;
- (ii) any acquisition of a right in the sign, and any use of the sign, has not been in bad faith; and
- (iii) the user has provided, in conjunction with the use of the sign on the Internet, information reasonably sufficient to contact him by mail, e-mail or telefacsimile.

Article 10
Use After Notification of Infringement

If the user referred to in Article 9 has received a notification that his use infringes another right, he shall not be held liable if he

(i) indicates to the person sending the notification that he owns a right in the sign in another Member State, or uses the sign with the consent of the owner of such a right, or that he is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to which he has a close connection;

(ii) gives relevant details of that right or permitted use; and

(iii) expeditiously takes reasonable measures which are effective to avoid a commercial effect in the Member State referred to in the notification, or to avoid infringement of the right referred to in the notification.

Article 11
Notification Under Articles 9 and 10

The notification under Articles 9 and 10 shall be effective if it is sent by the owner of a right or his representative, by mail, e-mail or telefacsimile, and indicates, in the language, or in one of the languages, used in conjunction with the use of the sign on the Internet, the following:

- (i) the right which is alleged to be infringed;
- (ii) the identity of the owner of that right and information reasonably sufficient to contact him or his representative by mail, e-mail or telefacsimile;
- (iii) the Member State in which that right is protected;
- (iv) relevant details of such protection allowing the user to assess the existence, nature and scope of that right; and
- (v) the user that is claimed to infringe that right.

Article 12
Disclaimer as a Measure Under Article 10

Member States shall accept, *inter alia*, a disclaimer, by a user referred to in Article 9, as a reasonable and effective measure under Article 10, if:

- (i) the disclaimer includes a clear and unambiguous statement in conjunction with the use of the sign, to the effect that the user has no relationship with the owner of the right which is alleged to be infringed, and does not intend to deliver the goods or services offered to customers located in a particular Member State where the right is protected;
- (ii) the disclaimer is written in the language or in the languages used in conjunction with the use of the sign on the Internet;
- (iii) the user inquires, before the delivery of the goods or services, whether customers are located in the Member State referred to in item (i); and
- (iv) the user in fact refuses delivery to customers who have indicated that they are located in that Member State.

PART VI
REMEDIES

Article 13
Remedy Proportionate to Commercial Effect

(1) The remedies provided for the infringement of rights or for acts of unfair competition in a Member State, through use of a sign on the Internet in that Member State, shall be proportionate to the commercial effect of the use in that Member State.

(2) The competent authority shall balance the interests, rights and circumstances involved.

(3) The user of the sign shall, upon request, be given the opportunity to propose an effective remedy for consideration by the competent authority, prior to a decision on the merits of the case.

Article 14
Limitations of Use of a Sign on the Internet

(1) In determining remedies, the competent authority shall take into account limitations of use by imposing reasonable measures designed:

- (i) to avoid a commercial effect in the Member State, or
- (ii) to avoid infringement of the right to avoid the act of unfair competition.

(2) The measures referred to in paragraph (1) may include, *inter alia* :

(a) a clear and unambiguous statement in conjunction with the use of the sign on the Internet, to the effect that the user has no relationship with the owner of the infringed right or the person affected by the act of unfair competition, written in the language or in the languages used in conjunction with the use of the sign on the Internet, and any other language indicated by the competent authority;

(b) a clear and unambiguous statement in conjunction with the use of the sign on the Internet to the effect that the user does not intend to deliver the goods or services offered to customers located in a particular Member State, written in the language or in the languages used in conjunction with the use of the sign on the Internet, and any other language indicated by the competent authority;

(c) an obligation to inquire, before the delivery of the goods or services, whether customers are located in that Member State, and to refuse delivery to customers who have indicated that they are located in that Member State;

(d) gateway webpages.

Article 15
Limitation on Prohibition to Use a Sign on the Internet

(1) Where the use of a sign on the Internet in a Member State infringes a right, or amounts to an act of unfair competition, under the law of that Member State, the competent authority of the Member State should avoid, wherever possible, imposing a remedy that would have the effect of prohibiting any future use of the sign on the Internet.

(2) The competent authority shall not, in any case, impose a remedy that would prohibit future use of the sign on the Internet, where

(i) the user owns a right in the sign in another Member State, uses the sign with the consent of the owner of such a right, or is permitted to use the sign, in the manner in which it is being used on the Internet, under the law of another Member State to which the user has a close connection; and

(ii) any acquisition of a right in the sign, and any use of the sign, has not been in bad faith.

[End of Annex II and of document]