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Design Treaty, Country Names, Geographical Indications Next Week At WIPO

By Catherine Saez, Intellectual Property Watch on 12/03/2014 @ 1:23 pm

The World Intellectual Property Organization committee on trademarks will address three main issues next week. Among them, delegates will look to advance a draft treaty facilitating the international registration of industrial designs, and try to agree on how to address technical assistance in that draft treaty.

In addition, the United States has a proposal to invite into the committee discussions on a proposed revision of the Lisbon Agreement on the Protection of Appellations of Origins, and Jamaica is pursuing its effort at a stronger international soft law for the protection of country names against use as trademarks.

The [31st session](#) ^[1] of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), takes place from 17-21 March.

On 8-9 May, an Extraordinary General Assembly which has been convened to finalise the election of the WIPO director general is also expected to take stock of progress made next week on the industrial design treaty, and decide whether to convene a diplomatic conference in 2014, according to a source. A diplomatic conference is a high-level final treaty negotiation.

Drafting Efforts, Technical Assistance

Failing to agree on the convening of a high-level meeting to adopt a new treaty which is aimed at easing the registration process of industrial designs for international applicants at the Extraordinary General Assembly from 10-12 December, delegates will go back to the drafting table next week.

Industrial designs relate to an ornamental aspect of an object. It can consist of three-dimensional features, such as the shape of the object, or a two-dimensional features, such as its patterns. The potential treaty addresses the procedure by which applicants submit an application, and covers issues such as the filing date, applications including more than one industrial design, and the publication of a design. Currently, national intellectual property offices do not share the same procedures and requirements.

Delegates are expected to work on the [draft articles](#) ^[2] [pdf] and the [draft regulations](#) ^[3] [pdf] of the potential treaty.

Described as a "procedural" treaty by many, it nevertheless met a bone of contention in the form of how to address technical assistance with unyielding positions.

During the Extraordinary General Assembly in December, the African Group insisted that technical assistance be legally binding and built into the treaty, in an article. The United States maintained that it could not accept reference to "legally binding" and expressed questions on how a legally binding provision on technical assistance and capacity building could be drafted, according to the [Assembly report](#) ^[4] [pdf] (*IPW, WIPO, 13 December 2013* ^[5]).

The Extraordinary General Assembly's decision reads as follows:

"a) requests the SCT to finalize its work on the text of the basic proposal for a Design Law Treaty building upon the outcome of the thirtieth session of the SCT;

b) will at the Extraordinary Session of the General Assembly in May 2014 take stock of, and consider, the text, progress made, and decide on whether to convene a diplomatic conference in

2014 in Moscow. If the Extraordinary Session of the General Assembly in May so decides, a preparatory committee will be held immediately after that session of the General Assembly.”

Geographical Indications

The issue of geographical indications, which is an attribution given to goods with a specific geographical origin from which they derive particular qualities or characteristics, had been dormant for years at the SCT.

It had been hotly debated at the World Trade Organization Council for Trade-Related Aspects of Intellectual Property Rights (TRIPS), during “special sessions” of the Council, but ended in deadlock. The special sessions have not been convened lately.

During the last WIPO General Assemblies, in September, the Assembly of the Lisbon Union approved the convening of a diplomatic conference, which would be expected to adopt a revision of the Lisbon Agreement on the Protection of Appellations of Origins ^[6] in 2015. In particular, the agreement would be extended to cover geographical indications (IPW, WIPO, 01 October 2014 ^[7]).

At the last meeting (2-6 December) of the Working Group on the Development of the Lisbon System, working further on the draft revision, the United States, not a member of the system, voiced concerns over a possible expansion of scope and subject matter of the agreement. The review of the system ^[8], undertaken by the working group, was aimed at increasing the number of parties to the system, currently 28.

Historically, “older nations” are strong proponents of geographical indications, in particular European countries. GI industry proponents, such as the Organization for an International Geographical Indications Network (oriGIN), have also noted a growing interest in GIs in other countries, in particular developing countries.

The US has tabled a proposal ^[9] [pdf] to be discussed next week, in which they detail a “Work Plan for Exploring the Feasibility of a Geographical Indications Filing System.” The proposal also rather vehemently advocates against the revision of the Lisbon system, as currently undertaken, and calls for the SCT to step in.

“The process has sought to bypass objections of the wider WIPO membership to funding the revision effort (and the agreement’s ongoing operations), as well as objections to the proposed substantive harmonization standards,” the document says.

“In essence, this ‘revision’ process has allowed the Lisbon Union to advance its approach to GI protection toward a diplomatic conference in 2015 without meaningfully accepting input from other very interested WIPO delegations which in fact have an interest in the integrity of the process as well as the potential outcome” it says.

“The Lisbon “revision” process has taken place not only without apparent regard for the Lisbon Union’s own mandates but without regard for important procedural rules and financial interests of WIPO as an organization that exists to serve the interests of its membership at large, not a narrow few,” the document says.

The US proposes that the WIPO secretariat prepare a survey of existing national GI regimes for the next session of the SCT, and asks that “the SCT should take up transparent and inclusive discussions on this issue, including on a filing system.”

“Additionally, it appears necessary for the SCT to discuss the work of the WIPO Working Group on the Development of the Lisbon System (Lisbon Working Group) to determine how to ensure that the broader WIPO membership is not forced to fund the Lisbon Union’s diplomatic conference and continuing operations of the Agreement – an agreement that many WIPO members cannot join and philosophically with which many strongly disagree – while the SCT considers whether to explore a possible Lisbon replacement or alternative that represents a more inclusive GI filing system,” it says.

Protection of Country Names

Also on the plate of the SCT next week is a new proposal ^[10] [pdf] by Jamaica for a joint recommendation on the protection of country names.

The issue has been discussed for some time in the SCT and Jamaica’s joint recommendation “aims at harmonizing the examination and determination of trade mark applications for the

registration of trademarks which consist of or contain country names, in order to promote consistent and comprehensive treatment and protection of country names among Member States."

According to the proposal, including the draft joint recommendation in annex, the recommendation "incorporates language and definitions largely from the previous Joint Recommendations (including well-known marks and marks on the Internet), as well as from Article 6ter of the Paris Convention, the WIPO Study (document SCT/29/5) and the Revised Draft Reference Document on the Protection of Country Names Against Registration and Use as Trademarks (document SCT/30/4)."

Jamaica also tabled a [submission](#) ^[11] [pdf] in which they analyse a [study](#) ^[12] [pdf] undertaken by WIPO. Jamaica establishes that the results of the study confirm "that the practice of States, as it relates to the protection of country names, is neither uniform nor comprehensive. Many loopholes exist in trademark law and practice, both pre-grant and post-grant, which permit the possibility of country names being registered as part of trademarks."

The results of the study, they said, confirm "the need for stronger, more comprehensive and internationally consistent protection for country names, through consistent and agreed approaches to examination of trademarks with country names."

Related Articles:

- [WIPO: Protection Of Country Names Inspires Delegates; Designs Conference Elusive](#) ^[13]
- [Country Names An Easier Road Than Technical Assistance For WIPO Trademark Committee](#) ^[14]
- [WIPO: ISP-Trademark Meeting Agreed; Industrial Design Treaty, Country Names Still On Table](#) ^[15]

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URLs in this post:

- [1] 31st session: http://www.wipo.int/meetings/en/details.jsp?meeting_id=32083
- [2] draft articles: http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_2.pdf
- [3] draft regulations: http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_3.pdf
- [4] Assembly report: http://www.wipo.int/edocs/mdocs/govbody/en/wo_ga_44/wo_ga_44_6.pdf
- [5] *IPW*, WIPO, 13 December 2013: <http://www.ip-watch.org/2013/12/13/wipo-assembly-potential-design-treaty-misses-train-to-russia-in-june-still-on-track-for-2014/>
- [6] Lisbon Agreement on the Protection of Appellations of Origins: http://www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.html
- [7] *IPW*, WIPO, 01 October 2014: <http://www.ip-watch.org/2013/10/01/plurilateral-agreement-on-geographical-indications-on-its-way-at-wipo/>
- [8] review of the system: <http://www.wipo.int/lisbon/en/review.html>
- [9] a proposal: http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_7.pdf
- [10] new proposal: http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_4.pdf
- [11] a submission: http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_5.pdf
- [12] a study: http://www.wipo.int/edocs/mdocs/sct/en/sct_29/sct_29_5.pdf
- [13] WIPO: Protection Of Country Names Inspires Delegates; Designs Conference Elusive: <http://www.ip-watch.org/2012/09/20/wipo-protection-of-country-names-inspires-delegates-designs-conference-elusive/>
- [14] Country Names An Easier Road Than Technical Assistance For WIPO Trademark Committee: <http://www.ip-watch.org/2013/05/30/country-names-an-easier-road-than-technical-assistance-for-wipo-trademark-committee/>

[15] WIPO: ISP-Trademark Meeting Agreed; Industrial Design Treaty, Country Names Still On Table:
<http://www.ip-watch.org/2012/02/04/wipo-isp-trademark-meeting-agreed-industrial-design-treaty-country-names-still-on-table/>