

## Another Setback For Design Law Treaty At WIPO; GIs In Contention

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The fate of a potential treaty meant to harmonise international industrial design registration formalities took another turn this week, as African countries asked that the treaty include a safeguard against misuse and misappropriation of their traditional designs, which was seen by developed countries as a manoeuvre to delay the process.

The WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) met from 24-26 November.

For a number of years, no discussions on geographical indications (GIs) were carried out in the SCT, despite the committee's name. Those discussions were brought back into the SCT a separate working group of a WIPO-managed treaty protecting appellations of origin drafted a revision covering GIs.

This week, the intense disagreement that arose from plans to convene a high-level treaty negotiation (diplomatic conference) in May to adopt the revised version of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, found its way into SCT discussions on GIs, to the discontent of Lisbon members.

Non-Lisbon members continue to resent the fact that only Lisbon members will have voting power at the diplomatic conference. They insist that the revision of the treaty will potentially impact all WIPO members, since it is planning to include geographical indications (GIs) in the scope of the treaty ([IPW, WIPO, 6 November 2014](#) <sup>[1]</sup>).

### A Step Back for Industrial Design Treaty

In a closing statement, the European Union said it was "extremely disappointed with the outcome of this session." The delegate added that "not only have we not made progress, we have taken a step back." The convening of a diplomatic conference has repeatedly failed to gain consensus despite several attempts ([IPW, WIPO, 10 May 2014](#) <sup>[2]</sup>).

Proponents pointed fingers at the African Group. The EU said some broader issues are at stake and that "by introducing their amendment on disclosure requirement in the framework of the DLT [Design Law Treaty], the African Group has broken with the unwritten covenant which has hitherto provided a framework for constructive dialogue in this organisation." They called for the African Group to reconsider its position.

On the first day of the SCT, the African Group requested a new paragraph on disclosure requirement be added to the draft articles ([IPW, WIPO, 25 November 2014](#) <sup>[3]</sup>).

The Group of Central European and Baltic States and the Group B developed countries also said the African Group proposal was taking the process backward.

Kenya, on behalf of the African Group, replied that in negotiations, nothing is agreed until everything is agreed, and challenged the characterisation by the EU of Africa's proposed addition of a disclosure requirement in the draft DLT articles. A disclosure requirement, the delegate said, is an essential element when it comes to protecting traditional designs.

"It is not a myth or a far-fetched idea that traditional designs have been misused and misappropriated and registered by individuals who did not own them," and the community from which it was taken did not get any benefit sharing, he said.

"We have interests" in WIPO, the African Group delegate said, and "we are not passengers in this organisation, we are not escorting others to the party, we are part of the party. If IP works for all of us, we have to respect each other."

This was characterised by some developed countries as a manoeuvre to delay the decision on the convening of a diplomatic conference to approve the DLT. The main issue prior to this session of the SCT was whether technical assistance should be the subject of an article of the DLT, or a separate recommendation. The African Group reiterated this week that the decision to convene a diplomatic conference remained conditioned upon agreement on the inclusion of technical assistance in a devoted article. India remarked that other issues also are still under discussions in the draft text.

Group B developed countries expressed surprise at what they consider a last minute proposal on an essentially agreed draft DLT, and said the proposal had the risk to "drastically change" the discussions. They threatened that it could impact the flexibility that some members of the group had shown toward the technical assistance issue. Group B is made up of the countries holding the vast majority of the world's intellectual property rights.

They insisted that the DLT is merely a formalities treaty aimed at simplifying applications, and some, such as Germany and the EU, said the African Group proposal was not related to formalities.

Algeria argued that a requirement of disclosure is a formality, so it would fit in a formalities treaty.

It was decided, as reflected in the summary by the chair <sup>[4]</sup> [pdf], that the new proposed paragraph <sup>[5]</sup> [pdf] would be included in Article 3 (1)(a) (contents of applications) of the draft articles <sup>[6]</sup> [pdf], and a footnote would mention comments made by countries on the proposal.

Group B also proposed language <sup>[7]</sup> [pdf] at the beginning of the session on the convening of the diplomatic conference, which was not supported by some countries, such as those in the African Group.

### **US Calls on Members to Submit Comments on Lisbon**

The United States submitted a proposal <sup>[8]</sup> [pdf] in October 2013 to request in particular that the WIPO secretariat undertake a study "to examine the various national law approaches to specific GIs topics where there is a lack of international understanding." The proposal also suggested that the SCT explore "the feasibility of a geographical indications filing system that would be inclusive for all national law protection mechanisms."

A number of countries supported the US proposal, such as El Salvador, Argentina, Uruguay, Guatemala, Japan, South Korea, Australia, Russia, Chile, Canada and Turkey.

On the second day of the SCT, the US delegate, presenting the proposal and linking the issue with the revision of the Lisbon Agreement, said that it "has been an active participant at the Lisbon Working Group," and has "attempted to assist with the Working Group goal to make the text more inclusive ... and compatible with trademark systems used for the protection of GIs."

The EU remarked that the work of the working group on the revision of the Lisbon Agreement had been "inclusive and of a transparent nature."

The EU said the work programme as proposed in the US document would not present added value and did not endorse it. This position was also shared by Italy, France, Switzerland, Hungary, Greece, Portugal, the Czech Republic and Iran. Italy said the SCT was not the appropriate place to discuss the work of another WIPO body, to which Hungary concurred.

The US then launched into a detailed explanation of the potential consequences of the revision of the Lisbon Agreement and called governments into action. "The Lisbon Union indicated that proposals submitted before February 1, 2015 will be considered during the Diplomatic Conference," the US delegate said (IPW, WIPO, 31 October 2014 <sup>[9]</sup>).

"If your government has not been able to study the draft text, we encourage you do so," the delegate said, adding, "If there are changes that you would need to be able to accede to the New Act of the Lisbon Agreement, we urge you to let the Lisbon Union know before February 1," he said in his statement.

The delegate said from the perspective of the US, the Lisbon Agreement and its revision "continue to reflect a historical and fundamental feature of the old appellation of origin systems of the world."

"These systems are dependent on the involvement and influence of governments in the whole protection process," the US delegate noted. The US interventions on the draft revised Lisbon Agreement "have been aimed at allowing the private party GI owner to prosecute its own application through the foreign GI system without having to rely on its government to do it for them, or otherwise minimizing the need and the influence of a foreign government and the use of public funds in obtaining exclusive GI protection in various territories," he said.

### **Protection of GIs, Country Names in Domain Names**

Separately, [a proposal](#) <sup>[10]</sup> [pdf] tabled at the last SCT meeting by the Czech Republic, Germany, Hungary, Italy, Moldova and Switzerland, later joined by France and Spain, on the protection of GIs and country names in the domain name system, received both support and opposition.

Hungary, on behalf of the proponents, said country names and GIs are popular targets of cybersquatting, and the current Uniform Domain Name Dispute Resolution (UDRP) system remains limited to trademarks. [The UDRP](#) <sup>[11]</sup> is managed by WIPO.

The proponents are concerned about the introduction of new generic top-level domain names (gTLDs), "which resulted in new undesirable possibilities for registration and use of domain names that violate intellectual property rights," according to the proposal.

The proposal suggests in particular that a study be prepared to investigate whether the need of users for the protection of GIs in the domain name system has changed, and if the measures available for holders of GIs against infringing domain names are sufficient.

The co-sponsors also proposed further discussions in the SCT "with a view to making a recommendation to modify the UDRP so as to permit complaints to be made concerning registration and use of domain names in violation of the protection of geographical indications and to confirm the need of the extension of UDRP to country names..."

The co-sponsors are also asking the SCT to request the WIPO secretariat to prepare a working document presenting the difficulties of GI protection against wrongful registration and use of domain names "with a view to adopt a joint recommendation to revise the ICANNs [Internet Corporation for Assigned Names and Numbers] Application Guidebook [defining important geographical names] accordingly."

The proposal was supported by several countries such as those in the EU, Monaco, Mexico, Portugal, Jamaica, and Croatia.

Some countries, such as the US and South Korea, did not support the proposal. This included Australia, which said the existing safeguards in ICANN are appropriate and sufficient to prevent misuse of GIs in domain names.

The private-sector Organization for an International Geographical Indications Network (oriGIn) said the protection of GIs in domain names is a major issue for the sector and supported the study. The oriGIn representative said the new gTLDs are increasing opportunities for bad faith use of GIs.

The summary by committee Chair Adil El Maliki was slightly reworded before its adoption, in particular on Item 6 concerning the revised proposal by Jamaica on the protection of country names. The text now refers to the chair requesting the secretariat to organise a side event to the next session of the SCT, instead of implying that member states made that request.

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### **Related Articles:**

- [No Deal For Now On WIPO Design Treaty, Patent Law Work Plan](#) <sup>[13]</sup>
  - [WIPO Members Near Agreement To Negotiate Design Law Treaty](#) <sup>[14]</sup>
  - [New Document On Technical Assistance, But WIPO Design Treaty Still In Trouble](#) <sup>[15]</sup>
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URL to article: <http://www.ip-watch.org/2014/11/27/another-setback-for-design-law-treaty-at-wipo-gis-in-contention/>

URLs in this post:

- [1] *IPW*, WIPO, 6 November 2014: <http://www.ip-watch.org/2014/11/06/us-wipo-plan-to-negotiate-higher-gi-protection-sets-deeply-troubling-precedent/>
- [2] *IPW*, WIPO, 10 May 2014: <http://www.ip-watch.org/2014/05/10/no-wipo-industrial-design-treaty-in-2014-technical-assistance-still-in-the-way/>
- [3] *IPW*, WIPO, 25 November 2014: <http://www.ip-watch.org/2014/11/25/wipo-new-proposal-on-disclosure-requirement-in-design-applications/>
- [4] summary by the chair: <http://www.ip-watch.org/weblog/wp-content/uploads/2014/11/SCT-Chair-Summary-Nov-2014.pdf>
- [5] proposed paragraph: <http://www.ip-watch.org/weblog/wp-content/uploads/2014/11/SCT-AG-Proposal-Disclosure-Nov-2014.pdf>
- [6] draft articles: [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_31/sct\\_31\\_2\\_rev.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_2_rev.pdf)
- [7] proposed language: <http://www.ip-watch.org/weblog/wp-content/uploads/2014/11/SCT-Group-B-proposal-Nov-2014.pdf>
- [8] a proposal: [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_30/sct\\_30\\_7.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_30/sct_30_7.pdf)
- [9] *IPW*, WIPO, 31 October 2014: <http://www.ip-watch.org/2014/10/31/geographical-indications-at-wipo-members-dissent-on-participation-in-treaty-talks/>
- [10] a proposal: [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_31/sct\\_31\\_8\\_rev\\_2.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_8_rev_2.pdf)
- [11] The UDRP: <http://www.wipo.int/amc/en/domains/>
- [12] WIPO Flickr: <https://www.flickr.com/photos/wipo/15681915968/>
- [13] No Deal For Now On WIPO Design Treaty, Patent Law Work Plan : <http://www.ip-watch.org/2012/10/08/no-deal-for-now-on-wipo-design-treaty-patent-law-work-plan/>
- [14] WIPO Members Near Agreement To Negotiate Design Law Treaty : <http://www.ip-watch.org/2013/09/28/wipo-members-near-agreement-to-negotiate-design-law-treaty/>
- [15] New Document On Technical Assistance, But WIPO Design Treaty Still In Trouble : <http://www.ip-watch.org/2014/03/20/new-document-on-technical-assistance-but-wipo-design-treaty-still-in-trouble/>