

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

**Thirtieth Session
Geneva, November 4 to 8, 2013**

PROPOSAL BY THE DELEGATION OF THE UNITED STATES OF AMERICA

Document prepared by the Secretariat

In a communication dated October 31, 2013, the Delegation of the United States of America transmitted to the International Bureau of the World Intellectual Organization (WIPO) the proposal contained in the Annex to the present document.

[Annex follows]

**Proposal from the United States of America
To the Standing Committee on Trademarks, Geographical Indications, and Industrial
Designs (SCT) of the World Intellectual Property Organization (WIPO)**

Under the agenda item for “Geographical Indications,” the delegation of the United States proposes a new two-pronged work program for the Standing Committee on Trademarks, Geographical Indications, and Industrial Designs (SCT).

Proposal: The Delegation of the United States suggests two avenues of work: 1) to explore the feasibility of a geographical indications filing system that would be inclusive for all national law protection mechanisms; and 2) to request the Secretariat to undertake a study, or a series of studies, to examine the various national law approaches to specific geographical indications topics where there is a lack of international understanding. For example, the Secretariat could research and solicit input from WIPO Members as to the tests for evaluating whether an applied for geographical indication is generic in a territory.

Background: Many will recall that the work of the SCT on geographical indications has been stymied for nearly a decade on the stated basis that no delegation wished to prejudice ongoing negotiations in other fora, such as, for example, the World Trade Organization (WTO). In deference to the work of these other international organizations on the topic of geographical indications, the delegation of the United States and others determined that the SCT might be more productive by focusing on other topics. Unfortunately, the lack of open discussion by IP experts coincided with an enormous push for inclusion of GI provisions in trade agreements, thus creating a climate of confusion and misunderstanding regarding the scope of protection, along with unanswered questions as to examination practices. The resulting national systems for the protection of GIs are divergent, leaving the question of how to protect GIs in this global economy the most unsettled and uncertain for businesses than it has ever been.

It appears that the Lisbon Agreement Working Group of WIPO has proposed to reconcile these uncertainties with a revised and expanded Lisbon Agreement on Appellations of Origin that would include geographical indications. The Lisbon Assembly proposes to institutionalize a specific type of implementation of WTO TRIPS Agreement obligations - a *sui generis* system for GI protection with perpetual protection driven solely by the existence of protection in the country of origin - even though the TRIPS Agreement clearly contemplates no singular implementation mechanism. We find that the draft revision text is incompatible with trademark protection systems for GIs for a multitude of reasons, even though the stated rationale for the revision is to be more inclusive.

For years the SCT has been mindful about not prejudicing the work of other organizations or the negotiating positions of the SCT delegations in those other fora. However, we now face the situation where the work of the Lisbon Working Group has supplanted the work of the SCT on subject matter that is clearly within the mandate of the SCT, and clearly outside of its own mandate. We did not intend to relinquish work on this subject matter to any other WIPO body, but merely suspended it out of deference to the productive work of the SCT in other substantive areas as well as the work in other international organizations.

With that in mind, this delegation respectfully proposes that the SCT consider a two-pronged work program that would explore and educate on the different GI systems around the world – a role in which the SCT excels – to attempt to create some transparency for our mutual understanding of Members' systems of GI protection in the global marketplace. Also, we propose a work program that would explore the feasibility of a more inclusive filing system that does not favor any particular national law implementation system over others.

The Delegation of the United States is very grateful to the delegations to the SCT for constructive and meaningful dialogues on a variety of topics in past sessions, designed to better understand each other's practices and to share experiences so that we can learn from each other. We hope to engage in future dialogues on this critically important issue.

[End of Annex and of document]